

strict. *Buck v Cobb*, 9 Law Rep., O. S., 347.—CONKLING, J.; N. Y., 1846.

9. Whether in a bill praying for an injunction, a misjoinder of parties as plaintiffs would defeat the prayer for an injunction to use a machine in which any of them are interested. *Woodworth v. Hall*, 1 Wood. & Min., 258.—WOODBURY, J.; Mass., 1846.

10. An assignee of an invention by virtue of an assignment made before patent issued, may file a bill in his own name, under § 10 of the act of 1839, amending § 16 of the act of 1836, against a patentee to whom a patent issued, upon the interfering applications of his assignor and such patentee, for the purpose of annulling the patent issued, and having one granted to him as assignee. *Gay v. Cornell*, 1 Blatchf., 507, 509.—NELSON, J.; N. Y., 1849.

11. And such assignment need not be recorded before suit brought; it will be sufficient if it is recorded before patent issued. *Ibid.*, 500.

12. An objection to the joinder of an assignor with an assignee, as complainants in a bill, cannot be taken on appeal, it being then too late. It should have been taken by demurrer, before the hearing on the merits. *Livingston v. Woodworth*, 15 How., 557.—DANIEL, J.; Sup. Ct., 1853.

13. G. filed his bill against B. for an infringement of a patent, and an injunction was granted thereon. G. afterward moved to amend by adding other parties plaintiff, averring that under an agreement made between himself and such parties, and still in force, they became the owners of an exclusive interest in the patent which B. had infringed, and that B. was aware of their interest in the patent; *Held*, that such amendments could not be allowed, as they

would amount to the institution of a new suit, both as to plaintiffs and the right of action, and that that exceeded the power of amendment. *Goodyear v. Bourne*, 3 Blatchf., 268.—NELSON, J.; N. Y., 1855.

14. A motion to dismiss the bill of the complainants, filed for an injunction, on the ground that the defendants had parted with all their interest in the suit, will be denied if such assignment has been made after the time when a computation of profits ended. *Dean v. Mason*, 20 How., 204.—MCLEAN, J.; Sup. Ct., 1857.

15. A bill is not multifarious because it embraces more than one patent, which it is alleged the defendant infringes; at least, such will not be the case if the defendant's machines infringe all the patents, or contain the improvements embraced in the several patents alleged to be infringed. *Nourse v. Allen*, 4 Blatchf., 377.—NELSON, J.; N. Y., 1858.

16. A bill was filed to restrain the infringement of four separate patents, and was demurred to on the ground that the matters set up were distinct and separate and compelled the defendant to unite separate and distinct matters of defence; *Held*, that although the objection to the bill on the ground of multifariousness, in a general sense, might be well founded, yet as all the patents were charged to be infringed by the defendants, they were to that extent connected together, and that the convenience of parties, as well as the saving of expense in the litigation, justified the embracing of all the patents in one suit. *Ibid.*, 377.

17. *Query*, Whether several patents could be embraced in one suit, if the improvement described in one patent had been used in one machine, and as

SUPPLEMENTAL AND CROSS BILL; BILL OF DISCOVERY.

improvement described in another patent had been used in a different machine. *Ibid.*, 378.

18. It is not necessary that the bill should set forth the deduction of title in the complainant. A simple averment that the title to the patents is in the complainant is sufficient. *Ibid.*, 378.

19. Where one person has the legal title to a patent, and another person has an equitable right in the same, and a suit in equity is instituted for an infringement, and asking an injunction and an account, the person having the legal title, and the one having the equitable right, should join as complainants. *Stimpson v. Rogers*, 4 Blatchf., 337.—INGERSOLL, J.; Ct., 1859.

20. Where an inventor died before application for a patent, and devised his property to A and B, and afterward his executor applied for and obtained a patent for an invention of the devisor, and then sold the patent to C, who afterward sold it again to A, *Held*, in a bill filed against D for an infringement and an account, that B should be made a party complainant with A, as having an equitable title and interest under the will. *Ibid.*, 337.

21. A party who relies upon the verdict of a jury and the judgment of a court of law for the establishment of his title, as a foundation of his claim, to be quieted in the possession and enjoyment of it, and for protecting him against infringement by others, must aver in his bill that such proceedings have taken place. *Parker v. Brant*, 1 Fisher, 39.—GRIER, J.; Pa., 1850.

3. *Supplemental and Cross Bill; Bill of Discovery.*

1. Where an injunction has been

granted on an original patent, and during its existence the patent is surrendered and a new one issued, a supplemental bill, founded on the renewed patent, is necessary, in order to continue such injunction. *Woodworth v. Stone*, 3 Story, 750.—STORY, J.; Mass., 1845.

2. Where on an original bill a provisional injunction had been granted restraining the defendant from further making and selling a certain article, and subsequent to the filing of the original bill and the issuance of such injunction, another party had become connected with the subject matter of the suit, and it was alleged that he was doing those things which the court had previously restrained, and a discovery was sought, *Held*, such party was properly brought before the court by a supplemental bill. *Parkhurst v. Kinsman*, 2 Blatchf., 73-75.—BETTS, J.; N. Y., 1848.

3. A supplemental bill may be filed at any stage of the cause, even after decree rendered. *Ibid.*, 76.

4. It is essential to a valid bill of discovery, in respect to a patent, that it set forth a title in the party which is sufficient to support or defend a suit, and that it pray a discovery pertinent to that title and nothing beyond. *Young v. Colt*, 2 Blatchf., 377. BETTS, J.; N. Y., 1852.

5. A defendant in a suit in equity founded on an infringement of a patent, cannot by a cross bill, which sets up no title in himself, demand a discovery from the plaintiff in the original suit, who has a *prima facie* title, as to the source or validity of that title. *Ibid.*, 377.

6. Where such a bill cannot be sustained as a bill of discovery, it cannot be retained for the purpose of relief, unless the bill makes out a case for re-

lief independently of the discovery sought for. *Ibid.*, 378.

4. Demurrer.

See also PLEADING.

1. A special demurrer to a bill should point out specifically, by paragraph, page, or folio, or other mode of reference, the parts of the bill to which it is intended to apply, or it will be held insufficient. *Atwill v. Ferrett*, 2 Blatchf., 43, 44.—BETTS, J.; N. Y., 1846.

2. An objection to the form of a bill, as that no oath was filed with it, or that it was not supported by evidence, should be made when the respondents appear. It is too late to make it after a hearing and order to file evidence. *Woodworth v. Edwards*, 3 Wood. & Min., 124.—WOODBURY, J.; Mass., 1847.

3. On a special demurrer to a bill, the allegations of fact in the bill, will, on the hearing of the demurrer, be considered as true. *Ibid.*, 126.

4. In a general sense, a bill in equity is demurrable on the ground of multifariousness, if it set up matters which are distinct and independent, and which call for separate defences; but where a bill was filed for the infringement of several patents, all of which were infringed by the defendant's machine, *Held*, that to this extent the several patents were all connected together, and that the convenience of parties, as well as a saving of expense in the litigation, justified embracing all the patents in one suit. *Nourse v. Allen*, 4 Blatchf., 377.—NELSON, J.; N. Y., 1858.

5. Whether several patents could be embraced in one suit, if one patent was used in one machine, and another in a different machine; *query*. *Ibid.*, 378.

6. It is not a ground of demurrer that such a bill does not contain the deduction of title in the complainant. A simple averment of title is sufficient. *Ibid.*, 378.

5. *Answer; what to set forth; when considered only as an affidavit; amendment of.*

See also DEFENCES; GENERAL ISSUE.

1. Exceptions to an answer should state the charges in the bill, and the interrogatory applicable thereto, to which the answer is addressed, and then the terms of the answer, verbatim, so that the court may at once perceive the ground of the exception, and ascertain its sufficiency. *Brooks v. Byam*, 1 Story, 300.—STORY, J.; Mass., 1840.

2. In the case of an interrogatory pertinent to a charge in the bill, and requiring the defendant to answer it "as to his knowledge, remembrance, information and belief," it is not sufficient for the defendant to answer as to his knowledge, but he must answer also as to his information and belief. *Ibid.*, 301.

3. An answer to such an interrogatory "that the defendant had no knowledge, information, and belief, that the charge was not true," is liable to exception that it did not state whether the defendant believed it to be true. *Ibid.*, 301.

4. Whenever a defendant does not deny any particular allegation of fact, but states his belief thereof, he either admits that it is true, or that he does not mean to controvert it. But a mere statement by the defendant in his answer that he has no knowledge that the fact is as stated, without any answer as to his belief concerning it, is not such

an admission as can be received as evidence of the fact. *Ibid.*, 302.

5. The defendant in equity is bound to answer in direct and unequivocal terms as to the state of his mind with regard to every fact stated in the bill to which he is interrogated, either that he does believe, or that he does not believe the matter inquired of, or that he cannot form any belief, or has not any belief concerning the matter; and according as the answer shall be one way or the other, that he calls upon the plaintiff for proof thereof, or that he admits it, or that he waives any controversy about it. *Ibid.*, 304.

6. If a defendant to a bill filed for an infringement of a patent wish to avail himself of the defence of abandonment or acquiescence of the plaintiff in the public use of his invention, he must set forth such defence in his answer, and put it in issue. If the point is not put in issue, any evidence as to it will be irrelevant, and cannot be looked to. *Wyeth v. Stone*, 1 Story, 284.—STORY, J.; Mass., 1840.

7. In a motion as to an injunction, the answer of the defendant is to be considered only as an affidavit. *Cooper v. Matthews*, 8 Law Rep., O. S., 415.—BALDWIN, J.; Pa., 1842.

8. On a motion for an injunction, if the complainants have called in their bill for the defendants to answer, and they have filed such answer, though voluntarily and before the entry of any rule to answer, it seems that such answer will be treated as an answer, and not merely as an affidavit. *Brooks v. Bicknell*, 3 McLean, 254.—MCLEAN, J.; Ohio, 1843.

9. Where an answer is responsive to the bill and under oath, and denies the infringement, something more than the

evidence of one witness must be produced to overcome it, and justify an injunction. *Woodworth v. Hall*, 1 Wood. & Min., 252.—WOODBURY, J.; Mass., 1846.

10. Where a bill asks for an injunction against the use of a patent and for an account, an answer denying the validity of the patent and the infringement is sufficient for the purpose of obtaining an order for an issue at law to try the validity of the patent, though it does not set out the names of the persons who used the thing patented, or knew it before the patentee, nor the names of the places where known or used. *Orr v. Merrill*, 1 Wood. & Min., 378.—WOODBURY, J.; Me., 1846.

11. But the answer, if intended to form an issue to try the validity of a patent, because the thing patented was not original, should set out the names of places and persons where and by whom the thing had been used before the plaintiff's invention. *Ibid.*, 378.

12. If a demurrer is overruled the respondent may still have leave to answer the bill on payment of costs. *Woodworth v. Edwards*, 3 Wood. & Min., 130.—WOODBURY, J.; Mass., 1847.

13. In equity, where a bill contains no interrogatories, when they are necessary, the defendant is not bound to answer it, and he cannot legally be in default for not answering, and consequently no decree *pro confesso* can be entered against him. *Wilson v. Stolley*, 4 McLean, 274.—MCLEAN, J.; Ohio, 1847.

14. The practice of treating an answer upon a motion for an injunction directly and unequivocally denying the facts set forth in the bill, merely as an affidavit, which might be contradicted by other affidavits, and should not have

the technical effect of precluding contradictory testimony, is a relaxation of the settled rules of practice in English courts of equity, which should be followed, unless changed by the written rules of the Circuit Courts, as established by the Supreme Court or by themselves. *Parker v. Sears*, 1 Fisher, 95.—GRIER, J.; Pa., 1850.

15. The affidavit and answer, especially if accompanied with one or two depositions of witnesses, denying the infringement, should be considered as conclusive on motions for preliminary injunctions. *Ibid.*, 96.

16. Even after a trial at law and a verdict for the plaintiff upon his patent, and the denial of a motion for a new trial, and a bill filed for a perpetual injunction, an amendment to the answer will be allowed, where new and important evidence has been discovered affecting the novelty of the plaintiff's invention, and an order granted for a feigned issue. *Foot v. Silbys*, 1 Blatchf., 545, 548.—NELSON, J.; N. Y., 1850.

17. An assertion in an answer to a bill filed for the infringement of a patent, that the defendant had not used the compound in the proportions described in the plaintiff's patent, but has used other and better compounds, is a mere evasion, or rather an admission that he has been attempting to evade while actually infringing the patent. *Goodyear v. Day*, MS.—GRIER, J.; N. J.; 1852.

18. A defendant who appears and puts in an answer, waives all objections to the regularity of the service upon him of the subpoena to appear and answer. *Goodyear v. Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

19. A motion to allow an answer to be filed in a patent case made after the

bill has been taken *pro confesso*, is addressed to the discretion of the court. *Dean v. Mason*, 20 How., 204.—MCLEAN, J.; Sup. Ct., 1857.

C. JURISDICTION AS TO TRADE-MARKS.

See also INJUNCTION, C.

1. A party has a right to call upon a court of equity to restrain a defendant from fraudulently using the words and devices which he has previously taken for the purpose of distinguishing his property. *Taylor v. Carpenter*, 2 Sand., Ch., 612.—BEARDSLEY, J.; N. Y., 1846.

2. A court of equity is not bound to protect the purchaser of another's secret for preparing a specific article, and of the right to use his name as a trade-mark in the sale of such article in the name of the original manufacturer. *Partridge v. Menck*, How. App. Cas., 559, 561.—GARDINER, J.; N. Y., 1848.

3. It is no answer that the complainant obtained the secret from the original manufacturer, or that the article sold is in all respects equal to that offered by the original proprietor. *Ibid.*, 559.

4. The privilege of deceiving the public, even for its own benefit, is not the subject of commerce. *Ibid.*, 559.

5. Such a proceeding is a deception upon the public, inducing the belief they are purchasing the goods of the original manufacturer, when in truth he has no concern in it. *Ibid.*, 560.

6. The jurisdiction that courts of equity exercise in respect to trade-marks is of recent origin, but is now established upon just and reasonable grounds. *Amoskeag Manuf. Co. v. Spear*, 2 Sand., S. C., 604, 605.—DUER, J.; N. Y., 1849.

7. A party is entitled to the protection of the law in the exclusive use of his trade-mark, and the interests of the public as well as his own require that it should be given. *Ibid.*, 605.

8. A court of equity in refusing to restrain the violation of another's trade-mark would violate the principles upon which a large portion of its jurisdiction is founded. *Ibid.*, 606.

9. A court of equity will restrain a wrongdoer in such cases, on the ground of protecting a party in the exercise of a legal right, the suppression of fraud, and preventing a mischief which might otherwise prove irreparable. *Ibid.*, 606.

10. A complainant cannot claim the protection of a court of equity to restrain a fraudulent use of his trade-mark on the ground either of having an exclusive right as an inventor in the thing manufactured by him, or an exclusive right as author in his label. *Coffeen v. Brunton*, 4 McLean, 517.—McLEAN, J.; Ind., 1849.

11. An intentional fraud is not necessary to entitle a plaintiff to such protection. *Ibid.*, 519.

12. The fact that the use of words as trade-marks, indicating *quality* merely, may to some extent mislead purchasers, or induce them to believe that articles manufactured by one person are those manufactured by another, will not justify the court in affording protection to the use of such names, if such impression is not one which was intended to be derived from them. *Stokes v. Landgraff*, 17 Barb., S. C., 612.—STRONG, J.; N. Y., 1853.

13. The ground upon which a court of equity exercises jurisdiction in trade-mark cases is the prevention of fraud, and of damages consequent upon it, that might be irreparable. *Gillett v.*

Kettle, 3 Duer, 626.—BOSWORTH, J.; N. Y., 1854.

14. Courts of equity do not interfere by injunction in cases of violation of trade-marks, except in aid of a legal right. If the fact of the plaintiffs' right in a trade-mark, or the defendants' interference with it, be doubtful, the plaintiffs will be left to establish their title at law. *Merrimack Manuf. Co. v. Garner*, 4 E. D. Smith's Rep., 390.—DALY, J.; N. Y., 1855.

15. It may be that a party would not be permitted to manufacture and vend an inferior article, and put it forth to the public as of the same quality and kind as that of another, but whether he could be restrained by injunction is doubtful. *Ibid.*, 392.

16. When the power of a court of equity has been invoked, it has been to restrain the defendant from making his goods and selling them as and for the goods manufactured by the plaintiff, on the ground that such a fraud was an injury to the plaintiff, and tending to mislead and deceive the public. *Samuel v. Berger*, 24 Barb., S. C., 165.—DAVIES, J.; N. Y., 1856.

17. The plaintiff, a manufacturer of watches, claimed the right, as assignee, to stamp his watches with the name of one Iberson Brindle. The defendants sold watches manufactured by said Brindle himself, and stamped with his name. *Held*, that the plaintiff was not entitled to an injunction to restrain the defendants from selling the original article, and thus protect the plaintiff in selling the simulated. *Ibid.*, 165.

18. A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular by another. It is enough for

him to show that the representations employed bear such resemblance to his as to be calculated to mislead the public generally, who are purchasers of the article, and to make it pass with them for the article sold by him. *Walton v. Crawley*, 3 Blatchf., 447.—BETTS, J.; N. Y., 1856.

19. If a plaintiff comes into a court of equity to claim relief against the fraud of others, he must be free himself from the imputation. *Fetridge v. Wells*, 13 How. Pr., 389.—DUER, J.; N. Y., 1857.

20. If sales of an article made by a plaintiff are effected, or sought to be, by misrepresentation and falsehood, he cannot be listened to when he complains that by the fraudulent rivalry of others his own fraudulent profits are diminished. An exclusive privilege for deceiving the public is not one that a court of equity will aid or sanction. *Ibid.*, 389.

21. Where the plaintiffs were engaged in manufacturing and selling an article called the "Balm of a Thousand Flowers," and which they represented as "the very balm and extract of healing blossoms," but which in fact was only a liquid soap, and sought to restrain the defendants from doing the same thing, *Held*, that the name was intended to deceive the public, and that the plaintiff could not be protected in such a privilege. *Ibid.*, 390-392.

22. The protection of trade-marks originated with the common law doctrine that he who sold his own ware as another's, was responsible both to the party whose custom he had fraudulently obtained, and to him from whom he drew it away; and it was immaterial in what way he carried on the imposition, whether by verbal representations, or

simulations of marks, used to designate the wares, or other *indicia* of ownership. *Corwin v. Daly*, Upton on Trade-Marks, 193, 194.—ROBERTSON, J.; N. Y., 1860.

23. Two principles are adhered to in all cases in equity as to restraining the use of trade-marks; first, the intent to pass off the goods of the defendant as those of the plaintiff must exist, though names may be used, equally with other devices, as instruments of such fraud. 2d, that the mere use of the name alone, not indicating any ownership, origin, or manufacture of the article sold, and therefore by itself not instrumental in representing to a purchaser that the goods bought by him, of the supposed pirate, were those of the complainant, and only designating or exaggerating the materials, kind, quality, destined use, or class of customers of the articles sold, cannot be protected, without proof of fraudulent intent in such use. *Ibid.*, 192.

24. A court of equity will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices which are claimed to constitute wholly or in part such trade-marks. An intent to deceive the public is not favored. *Hobbs v. Francais*, 19 How. Pr., 571.—BOSWORTH, J.; N. Y., 1860.

25. Where the plaintiff manufactured a skin powder called "Meen Fun," which was represented as made in London, and "patronized by her majesty the Queen," when in fact it was made in New York, and the defendant manufactured a like article, representing it as "patronized by her majesty the Empress," *Held*, that the court would not

grant an injunction; not because of any regard for the defendant, but not to assist in deceiving the public. *Ibid.*, 571.

26. Chancery will not interfere by injunction in questions of trade-mark between the venders of patent medicines, being quack medicines; such questions having too little to commend them on either side. *Heath v. Wright*, 3 Wall, Jr.—GRIER, J.; Pa.

EQUIVALENTS.

See also FORM; INVENTIONS, C.

1. The substitution or application of a known mechanical equivalent, as the endless screw and wheel to the periphery of a quadrant to steering vessels, to which it had never before been applied, is not invention. It is only the application of an ordinary power to an ordinary purpose, and does not entitle the party making the application to a patent. *Cochrane v. Waterman*, MS. (App. Cas.) —CRANCH, Ch. J.; D. C., 1844.

2. The substitution of one mechanical power in a machine, as the wheel and axle, in the place of a screw, to accomplish the same result, is a mere formal alteration and no invention. *Blanch. Gun-Stock Fac. v. Warner*, 1 Blatchf., 278.—NELSON, J.; Ct., 1846.

3. So also in Blanchard's machine for turning irregular forms, it was considered immaterial whether the lateral motion was given to the pattern and rough material, or to the cutter and friction wheels, the parts acting upon each other relatively the same. *Ibid.*, 278.

4. A mere change in form or proportion, or a substitution of mechanical

means or equivalents, in any one or all the elements of a combination, producing the same results, does not constitute a substantial difference. *Gorham v. Mixer*, 1 Amer. Law Jour., N. S., 543.—SPRAGUE, J.; Mass., 1849.

5. By equivalents in machinery is meant the substitution of merely one mechanical power for another, or one obvious and customary mode for another of effecting a like result. *Smith v. Downing*, 1 Fisher, 87.—WOODBURY, J.; Mass., 1850.

6. If two machines are equivalents, with slight changes, the one may be made to do what can be performed by the other. *Ibid.*

7. If the same general plan of a machine be taken and applied for the same purpose, although the mode of construction may be varied, it will be substantially the same, and is only what is called a mechanical equivalent, or another way of doing the same thing, by means of mechanical skill, which, however meritorious and creditable, is not an invention. *McCormick v. Seymour*, 2 Blatchf., 246, 248.—NELSON, J.; N. Y., 1851.

8. The use of a known equivalent is an infringement; although the patentee has not expressly claimed equivalents, he is understood to embrace them, and in contemplation of law does embrace them, without any express mention. *Byam v. Farr*, 1 Curt., 263.—CURTIS, J.; Mass., 1852.

9. But the patentee is not obliged to embrace equivalents in his claim. He may, if he choose, confine himself to the specific ingredients or things, and expressly exclude all others, or expressly exclude some or one other. If he does so, the use of the thing disclaimed is no infringement. *Ibid.*, 263.

10. The doctrine of the use of mechanical equivalents is not confined to those elements which are strictly such in the science of mechanics. There are different well-known devices, any one of which may be adapted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another does not belong to the subject of invention, but of construction. *Foster v. Moore*, 1 Curt., 291.—CURTIS, J.; Mass., 1852.

11. A machine, constructed to accomplish a particular object or purpose, may often be materially changed from its original construction, and yet work very well. There are mechanical equivalents by the use of which the whole features may be changed, and a great departure made from the apparent principle and combination of the machine, and yet it may operate well. *Blanchard v. Beers*, 2 Blatchf., 419, 420.—NELSON, J.; Ct., 1852.

12. The substitution of a mechanical equivalent is not a substantial change. There are many devices in construction that can be made by a skilful mechanic, differing very much in appearance, but which in the eye of the patent law are regarded as identical. *Tatham v. Le Roy*, 2 Blatchf., 486.—NELSON, J.; N. Y., 1852.

13. Any machine which has been constructed may be very materially changed in its mechanical arrangement and construction, and yet it may accomplish the object and purpose for which it was designed. *Ibid.*, 487.

14. When a power is necessary for working a machine, the inventor or proprietor has a right to make his selection of any description of power known to the mechanic arts. It is of no importance whether such power is hand,

steam, horse power, electricity, or any other power. The substitution and use of one power, as electricity, in the place of another, as hand power, does not make the machine different, or prevent its infringing on another. The one is but an equivalent of the other. *Crehore v. Norton*, MS.—NELSON, J.; N. Y., 1853.

15. The doctrine of mechanical equivalents depends upon the truth that the *identity of purpose*, and not of form or name, is the true criterion of judging of the similarity or dissimilarity of two pieces of mechanism. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

16. Where two devices are capable each of doing the same thing, and in substantially the same way, they must be equivalents of each other, and when one has been used, the other is not patentable. *Boughton, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

17. Whether one thing is a mechanical equivalent for another, is an inference to be drawn from all the circumstances of the case, by attending to the consideration whether the contrivances used by the one party are *used for the same purpose*, performs the *same duties*, or is applicable to the same object as the contrivance used by the other party *Ibid.*

18. The phrase "or the equivalent therefor," in machinery, extends to improvements substantially the same as those described, involving the same principle, and embracing all alterations merely colorable, but does not include a claim to any other invention, equivalent or equal to the one described. This would be to include all modifications or improvements in the machine. *McCor-*

mick v. Manny, 6 McLean, 557.—McLEAN, J.; Ill., 1855.

19. The substitution of one mechanical equivalent as a rod in place of an endless chain, to accomplish a like purpose and with like effect, is not the subject of a patent. *Spain v. Gamble*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

20. By an abuse of this doctrine of mechanical equivalents, experts can demonstrate every machine which effects a certain purpose to be substantially the same with every other which effects the same purpose. *Sickles v. Glou. Man. Co.*, 1 Fisher, 234.—GRIER, J.; N. J., 1856.

21. If the patentee be an original inventor of a machine or thing, he has the right to treat as infringers all who make a like invention operating on the same principles, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement on the original and patented one. *McCormick v. Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

22. But if his invention be but an improvement on a known machine, he cannot treat another as an infringer who has improved the original machine by using a different form or combination performing the same function. The inventor of a first improvement cannot invoke the doctrine of mechanical equivalents to suppress all other improvements which are not mere colorable invasions. *Ibid.*, 405.

23. The use, in a combination, of one equivalent for another, does not render it new in the sense of the patent laws, but some new mode of operation must be introduced. *Forbush v. Cook*, 10 Mo. Law Rep., 664.—CURTIS, J.; Mass., 1857.

24 Substantial identity excludes im-

material variations or fraudulent evasions. That is a substantial identity which comprehends the application of the *principle* of the invention. If a party adopts a different mode of carrying the *same* principle into effect, and the principle admits of a variety of forms, there is an identity of principle, though not an identity of mode. *Page v. Ferry*, 1 Fisher, 310.—WILKINS, J.; Mich., 1857.

25. The same principle may be used without an exact identity, by mechanical equivalents or contrivances, and if so there would be a substantial identity, or such an arrangement of mechanism which produces the same service, or produces the same effect in the same way, or substantially in the same way. *Ibid.*, 311.

26. If a change introduced constitute a mechanical equivalent in reference to the means used by another, and besides being such an equivalent accomplishes some other advantages beyond the effect or purpose accomplished by such patentee, such further advantage may make it a patentable subject, or an improvement upon the former invention. *Hibbard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

27. The substantial equivalent of a thing is the same as the thing itself, so that if two machines do the same work in substantially the same way, and accomplish substantially the same result, they are the same; and so if parts of the two machines do the same work, in substantially the same way, and accomplish substantially the same result, those parts are the same, although they may differ in form or shape; but in both cases, if the two things perform different work, or in a way substantially different, or do not accomplish substantially the same

result, then they are substantially different. *Cahoon v. Ring*, 1 Fisher, 420.—CLIFFORD, J.; Me., 1859.

28. Slight differences in degree cannot be regarded as of weight in determining questions of substantial similarity, or substantial difference. One may be longer or shorter, work better or worse, and yet the two be substantially the same; whether the difference in degree constitutes a substantial difference is a question for the jury. Mere difference in degree is, however, entitled to but little weight. *Ibid.*, 420.

29. The term equivalent has two meanings. The one relates to the results that are produced, and the other to the mechanism by which those results are produced. *Johnson v. Root*, 1 Fisher, 363.—SPRAGUE, J.; Mass., 1858.

30. Two things may be equivalent as producing the same results, when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that merely produce the same results. *Ibid.*, 363.

31. A mechanical equivalent, as generally understood is where the one may be adopted instead of the other, by a person skilled in the art, from his knowledge of the art, as producing a pressure in a machine by a spring, or by a weight. *Ibid.*, 363.

32. But there may be equivalents to produce the same results, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents, as the invention and use of a pump to raise water instead of drawing the water by a rope and pulley. *Ibid.*, 363.

33. However the appearance of a thing may be altered, if the aspect, the form, the appearances presented, are changed only by the use of mechanical

equivalents, then it is substantially the same thing. *Ibid.*, 364.

34. And, if an invention is a substitution for the original invention, then it is not substantially the same. *Ibid.*, 364.

35. Whether two things are or are not equivalent is matter of skill and sound judgment (for the determination of the office), which can in no way be limited, or restrained by the admissions or denials of parties. *Hutchinson v. Meyers*, MS. (App. Cas.)—MERRICK, J.; D. C., 1861.

ESTOPPEL.

1. An offer to take a license from a patentee to use his invention does not take away the right of the person making such offer to deny that the patentee was the original inventor. *Evans v. Eaton*, Pet. C. C., 347.—WASHINGTON, J.; Pa., 1816.

2. A grant of a subsequent patent for an invention is an estoppel to the patentee to set up any prior grant for the same invention, which is inconsistent with the terms of the last grant. *Barrett v. Hall*, 1 Mas. 473.—STORY, J.; Mass., 1818.

3. If several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. *Ibid.*, 474.

4. An inventor can have but a single valid patent for his invention. The first he obtains, while it remains unrepealed, is an estoppel to any future patent for

the same invention. *Odiorne v. Amesbury Nail Fac.*, 2 Mas., 31.—STORY, J.; Mass., 1819.

5. In an action of covenant broken, the declaration averred that the parties were *joint* inventors of a machine, and that they covenanted to co-operate to secure the benefit thereof, and that one should have secured to him certain states, and the other certain other states, and that neither should use or sell the machine in the territories of the other; and then alleged covenant broken, *Held*, that the defendant in such action could not plead that neither party was the inventor, or that separate patents had been issued to each. *Stearns v. Barrett*, 1 Pick., 443, 447.—WILDE, J.; Mass., 1823.

6. And after having obtained a joint patent, neither party could set up the prior separate patents; and that neither was estopped by the separate patents from asserting that the invention was joint. *Ibid.*, 447.

7. An assignment of an invention before a patent is obtained is a good transfer of the right of the patentee when he obtains a patent, and he would be estopped from setting up any adverse title. *Herbert v. Adams*, 4 Mas., 15.—STORY, J.; Mass., 1825.

8. Whether a disclaimer of all title under a former patent, as to the parts claimed in a subsequent patent, would not operate as an estoppel to any remedy which might be prosecuted for a violation of such former patent; *query*. *Treadwell v. Bladen*, 4 Wash., 709.—WASHINGTON, J.; Pa., 1827.

9. A disclaimer, at the close of a specification, estops the patentee from setting up any privilege to the part disclaimed. *Whitney v. Emmett*, Bald. Rep., 313.—BALDWIN, J.; Pa., 1831.

10. If a defendant, in an action respecting a patent, has advertised the thing patented, and which had been sold by him as a useful invention, and one that has superseded others, he will not, in any action against him, be allowed to deny its utility. *Stanley v. Whipple*, 2 McLean, 39.—MCLEAN, J.; Ohio, 1839.

11. Where a party claims to establish his rights merely by an estoppel, the instrument by which the estoppel is supported should be precise, clear, and unequivocal, and not depending on doubtful inference. *Rich v. Hotchkiss*, 16 Conn., 418.—WILLIAMS, Ch. J.; Ct., 1844.

12. The taking of a license, to use a patent-right for a time, cannot be considered as an acknowledgment of a right in the licensor beyond the termination of such license. *Ibid.*, 418.

13. Where it was stipulated between A and B, that B should be entitled to use A's patent three days in a week until a given date, and that A would not prosecute any action against B for any former violation, provided B should not use such patent after the specified date, or by any other machine infringe A's right, *Held*, that such proviso, introduced by the plaintiff, and not placing any personal obligation on the defendant, did not operate as an estoppel against B to prevent him showing the truth in regard to the validity of the right of A. *Ibid.*, 419, 420.

14. The bringing of an action for arrears due on a license to use a patent is no waiver of a right to enforce a forfeiture of such license for the non-payment of the price agreed for such use. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs., 45.—BERTS, J.; N. Y., 1844.

15. But the confession of a judgment

APPLICATION OF DOCTRINE OF, IN PATENT CASES.

in a suit brought to recover such arrears is an admission of such payments being in arrear, and the defendant will not afterward be allowed to go behind such judgment, and prove that there was no default in payment. *Ibid.*, 45.

16. If a licensee or grantee acknowledge, under his hand and seal, the validity of the grantor's title; *query*, Is he not estopped from denying it? *Brooks v. Stolley*, 3 McLean, 526.—McLEAN, J.; Ohio, 1845.

17. If a patentee used certain words in his first specification, and afterward withdraw them in his amended specification in a reissued patent, he is not estopped by the words which have been so withdrawn and cancelled. *Allen v. Blunt*, 2 Wood. & Min., 143, 144.—WOODBURY, J.; Mass., 1846.

18. K. purchased an interest in a patent, and agreed with the patentee, upon certain conditions, to give his personal attention to manufacturing of machines under the patent; afterward he made a second agreement with the patentee, whereby he, K., agreed to discontinue such manufacture, and the patentee was to carry it on, rendering to K. a certain proportion of the profits; *Held*, that by virtue of such agreements K. was estopped, in an action brought against him by the patentee for continuing such manufacture, and for an account, from setting up the defence that such patentee was not the original and first inventor of the thing patented. *Parkhurst v. Kinsman*, 1 Blatchf., 490, 495.—NELSON, J.; N. Y., 1849. [Affirmed, *post* 21.]

19. Declarations on the part of an inventor, that he did not intend to take out a patent, but to let the public have his invention, would estop such party, or any one holding under him, from as-

serting his right, as by action of infringement, against a person acting on the faith of such declarations, which are equivalent to a license. *Pitts v. Hall*, 2 Blatchf., 237, 238.—NELSON, J.; N. Y., 1851.

20. D. having, during the pendency of certain actions against him, brought by G. for the infringement of G.'s patents, made a settlement with G., and having secured the exclusive right to use said G.'s patents, and also consenting that a judgment should be taken against him in one of such suits; *Held*, that D. had thereby admitted the validity of G.'s patents, and that he was estopped from denying their validity in any subsequent suit that might be brought against him by G. *Goodyear v. Day*, MS.—DICKERSON, GRIER, JJ.; N. J., 1852.

21. An agreement made with a patentee to manufacture his patented machines upon certain conditions, and making and selling such machines under the patentee's title, estops such party, in an action for an account brought by the patentee, from alleging the invalidity of the patent. *Kinsman v. Parkhurst*, 18 How., 293.—CURTIS, J.; Sup. Ct., 1855.

22. H. purchased of B. the right to construct and use an alleged patented machine, and covenanted "to receive the said right as good and available to all intents and purposes, and that the same and the transfer shall not be liable to any objections for any supposed defect in, or objection to, the said letters patent, if such supposed defect or objection should at any time arise." *Held*, that the vendee in an action for the price, was estopped from alleging the invalidity of the patent. *Heilner v. Battin*, 27 Penn., 517, 520, 524.—WOODWARD, J.; Pa., 1856.

23. And such estoppel applies as well to the objection that the reissued patent was not for the same invention as the original, as to that against the originality of the invention. *Ibid.*, 524.

24. An assignment of an interest in a patent precludes the assignor from asserting that what he sold was useless. *Thomas v. Quintard*, 5 Duer, 82.—DUEK, J.; N. Y., 1855.

25. Where the defendant purchased an interest in a patent, and gave his note for the agreed price, and afterward assigned his interest in the invention and patent, and such assignment recited the assignment to himself of the patent-right, and purported to transfer it as it was transferred to him, *Held*, in an action on such note, against the defendant, that he could not set up that the invention was of no value, but that he was estopped by his own assignment from questioning the patent and invention. *Ibid.*, 82.

26. There is nothing to estop the government of the United States from showing a patent, which it had granted, to have been a nullity *ab initio*, owing to the non-existence of the condition precedent of novelty of the invention. *King v. United States*, 10 Mo. Law. Rep., 631. (Ct. Claims, 1857.)

27. Where admissions are made by a party to induce others to act upon them, such admissions do not operate *merely* as presumptive evidence of the actual truth of the facts, which must give way to positive proof of the contrary, but preclude or estop the party, on grounds of policy. *Carroll v. Gambrill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

28. If the defendants have used the plaintiff's invention, or something substantially like it, they are estopped from denying its utility, for use implies utili-

ty, and it is fair to presume that they would not use it if they thought it of no utility. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

29. The mere taking a license does not estop the licensee denying the validity of a patent. *Mitchell v. Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

30. In order to establish a right by estoppel, the instrument in support of the estoppel must be precise and certain, and must cover a range as wide as the effect sought to be given to it. *Ibid.*

31. The use by a defendant of the plaintiff's invention, or something substantially like it, estops him denying the utility of such invention; the use of the thing patented, implies that the party thought it of some utility. *Vance v. Campbell*, MS.—LEAVITT, J.; Ohio, 1860.

32. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring v. Leffingwell*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

33. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation, it will be treated as if it had never been made. *Ibid.*

EVIDENCE IN PATENT CASES.

A. BURDEN OF PROOF, ON WHOM LIES...	282
B. PRESUMPTIONS.....	283.

BURDEN OF PROOF, ON WHOM LIES.

C. DEPOSITIONS

1. *De bene esse, under Acts of Congress*..... 285
2. *Under Rule of Court or Commission*..... 287
3. *Under Rules of the Patent Office*. 288

D. DECLARATIONS AND ACTS OF PARTIES, AND THIRD PERSONS..... 290**E. PAROL, AND SECONDARY EVIDENCE**.... 293**F. PUBLIC RECORDS AND PAPERS; VERDICT**..... 294**G. WITNESSES**

1. *Competency and Credit of*
 - a. *Of Witnesses generally* 295
 - b. *Of Assignor of Invention in Interferences*..... 298
2. *Examination and Impeachment of*..... 298
3. *Parties, Examination of*..... 300

H. RULES AS TO PARTICULAR FACTS AND ISSUES

1. *Abandonment*..... 300
2. *Fraudulent Intent*.... 302
3. *Infringement*..... 302
4. *Invention, and Originality and Priority of*..... 304
5. *Invention, Novelty, and Utility of* 307

A. BURDEN OF PROOF, ON WHOM LIES.

1. In a proceeding under § 10 of the act of 1793, the burden of proof lies upon the plaintiff to show that the patent was obtained surreptitiously, or upon false suggestions. *Stearns v. Barrett*, 1 Mas., 175.—STORY, J.; Mass., 1816.

2. In a patent case, the *onus probandi* is on the defendant to show that the proper notice has been given under the statute to enable him to examine witnesses to show that the invention of the plaintiff had been known or used before his invention; and if the notice is not given, such evidence cannot be received. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 459.—STORY, J.; Sup. Ct., 1840.

3. Though doubt and uncertainty are fatal to a motion to grant an injunction, they are good cause for continuing it on a motion to dissolve; the burden of proof being on the plaintiff in one case, and on the defendant in the other. *Cooper v. Matthews*, 8 Law Rep., 416.—BALDWIN, J.; Pa., 1842.

4. Where the defence is, that the invention is not so described as to enable a skilful mechanic to construct a machine, the burden of proof rests on the defendants to show such to be the case. *Brooks v. Bicknell*, 3 McLean, 445, 447.—MCLEAN, J.; Ohio, 1844.

5. So also when the defence is made that the patentee is not the original inventor of the thing patented to him. *Ibid.*, 451.

6. As to whether the defendants have infringed the plaintiff's patent, the burden of proof lies on the plaintiffs. *Ibid.*, 453.

7. If a defence of prior invention is made to an action of infringement, the burden of proof as to such point lies with the defendant. He must satisfy the jury beyond a reasonable doubt, that there was a prior invention, because the plaintiff has a right to rest upon his patent, until its validity is overthrown. *Washburn v. Gould*, 3 Story, 142.—STORY, J.; Mass., 1844.

8. The burden of proof is upon the plaintiff to show that there has been an infringement of his right. *Ibid.*, 146.

9. The burden of proof that a combination is not new, is on the party denying that it is new. *Hovey v. Henry*, 3 West Law Jour., 154.—WOODBURY, J.; Mass., 1845.

10. If a party set up a sale for more than two years before the application for a patent, the burden of proof lies on the party making such defence, and

PRESUMPTIONS.

he must establish the fact of such sale so as to justify a jury in taking away the property of the plaintiff. *Ibid.*, 155.

11. Where a plaintiff has made out a *prima facie* case of infringement, and the defendant undertakes to make out a special defence, as that the invention had been used at different places before plaintiff's invention, the defendant must render these particulars probable, and must turn the scales in his favor. *Allen v. Blunt*, 2 Wood. & Min., 145.—STORY, J.; Mass., 1846.

12. If A make a machine for B, at B's request, for his benefit and at his expense, the presumption is, that it was made according to B's directions, and if such fact is denied by A, the burden of proof is on A, to show that it was not made according to B's directions. *Warner v. Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

13. The constructor of a machine is presumed to be the inventor; and the burden of proof is on him who denies the fact and claims to be the inventor. *Atkinson v. Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

14. It rests upon those who seek to defeat a patent granted to an alien, on the ground that it has not been put on sale within the time prescribed by the statute, to show that such a patentee neglected or refused to sell the invention for reasonable prices when application was made to purchase. *Tatham v. Lowber*, 2 Blatchf., 51.—NELSON, BETTS, JJ.; N. Y., 1847.

15. On the question of infringement, the burden of proof is on the plaintiff. He must show satisfactorily that the defendant has violated his exclusive right. *Parker v. Stiles*, 5 McLean, 62.—LEAVITT, J.; Ohio, 1849.

16. Where an equitable title to an interest in a patent is set up against a *bona fide* purchaser of and the holder of the legal title, the burden of proof lies with him impeaching the legal title. *Gibson v. Cook*, 2 Blatchf., 151.—NELSON, J.; N. Y., 1850.

17. The presumption of law is that a patentee is the first inventor of the thing patented to him, and the burden of proof is on the party denying it to disprove the fact. *Pitts v. Hall*, 2 Blatchf., 231.—NELSON, J.; N. Y., 1851.

18. The burden of showing that a patentee was not the first and original inventor, and of the inutility of the patent, rests upon the defendant. *Winans v. N. Y. & Har. R. R.*, 31 Jour. Fr. Inst., 3d Ser., 320.—NELSON, J.; N. Y., 1855.

19. If the defence is set up, that the patentee is not the first and original inventor of the thing patented to him, the burden of proof is on the defendant to show a prior invention, and, if he does not, the verdict must be for the plaintiff. *Cahoon v. King*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

20. On the question of infringement, the burden of proof is on the plaintiff. *Ibid.*, 403. Also *Johnson v. Root*, *Ibid.*, 364.—SPRAGUE, J.; Mass., 1858. And *Latta v. Shawk*, *Ibid.*, 469.—LEAVITT, J.; Ohio, 1859.

21. It is incumbent upon the plaintiff to make out affirmatively, by proof, that his invention has been infringed, before he can recover. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

B. PRESUMPTIONS.

See also PATENT, P. 2; REISSUE OF PATENT, C.

1. It is a presumption of law, that

PRESUMPTIONS.

DEPOSITION; WHAT IS.

when a patent has been obtained, every man who subsequently takes out a patent for a similar machine, has a knowledge of the preceding patent. *Odiorne v. Winkley*, 2 Gall., 55.—STORY, J.; Mass., 1814.

2. It is also a presumption of fact, that every man having within his power the means of information, and desirous of securing to himself the benefit of a patent, will ascertain whether any one on the public records has acquired a prior right. *Ibid.*, 55.

3. It is a presumption of law, that all public officers perform their proper official duties, until the contrary is proved. Where an act is to be done, as a patent to be granted or reissued upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act, or granted the patent, is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 458.—STORY, J.; Sup. Ct., 1840.

4. If a person *construct* a machine, in the absence of all evidence to the contrary, the presumption is that he is also the *inventor*, and the burden of proof is thrown upon another claiming to be the inventor, to show that he suggested the idea, or made the invention. *Atkinson v. Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

5. It is a presumption of law that a patentee is the first inventor of the thing patented to him. *Pitts v. Hall*, 2 Blatchf., 231.—NELSON, J.; N. Y., 1851.

6. It is a presumption of law that what the patentee does not distinctly assert to be his invention was known before. *Smith v. Higgins*, MS.—BERTS, J.; N. Y., 1857.

7. It is to be assumed, that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books, or by machines built and put in use, and evidence is not admissible to prove the contrary; nor is it matter of inquiry whether machines described in printed works were ever practically put to use or not. *Ibid.*

8. The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. *Hussey v. McCormick*, 1 Fisher, 515.—MCLEAN, J.; Ill., 1859.

9. All persons are bound to take knowledge of the doings of the Patent Office, in relation to inventions. *Marcy v. Trotter*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1860.

10. The law requiring that an inventor should describe his invention with a accuracy and fulness, and it being the duty of the Commissioner of Patents to see this is done, the presumption is that the patent has been issued upon sufficient foundation; and the court must be well satisfied there is a material insufficiency or defect in the specification, before it will pronounce any patent a nullity and void. *Judson v. Cope*, 1 Fisher, 622.—LEAVITT, J.; Ohio, 1860.

11. There is a presumption arising from the patent itself, that an invention is of some degree of utility; but this is not conclusive, and the other party may show that it is useless and worthless. *Lee v. Blandy*, 2 Fisher, 95.—MCLEAN, LEAVITT, JJ.; Ohio, 1860.

C. DEPOSITIONS.

1. In legal language a *deposition* is evidence given by a witness under in-

DEPOSITIONS; DE BENE ESSE.

terrogatories, oral or written, and usually written down by an official person; while an affidavit is the mere voluntary act of the party making the oath, and is generally taken without the acquiescence of the one against whom it is to be used. *Stimpson v. Brooks*, 3 Blatch., 456.—BETTS, J.; N. Y., 1856.

2. Deposition is a generic expression, embracing all written evidence, verified by oath, and includes affidavits, but in legal language a distinction is maintained in courts of law and chancery between depositions and affidavits. *Ibid.*, 456.

1. *De bene esse*.

1. The act of Congress—judiciary act of 1789—relating to taking of depositions *de bene esse*, must necessarily be so construed, as to confine its operation to depositions taken *within the district* where the witness lives, *more than one hundred miles* from the place of trial; because process to compel attendance could run to any greater distance *within the district*; on that account the deposition is to be *de bene esse*. A subpoena could not at that time run into another district. *Evans v. Hettick*, 3 Wash., 417.—WASHINGTON, J.; Pa., 1818.

2. The act of March 2, 1792, which declared that process for the attendance of witnesses in one district might run into another, provided the witnesses did not live more than one hundred miles from the place of trial, does not affect the construction above given of the judiciary act of 1789. *Ibid.*, 417.

3. Depositions may however be taken differently from what the law or rules of court prescribe under the agreement of the parties, or under any special rule of the court, in any particular case. *Ibid.*, 418.

4. A deposition taken *de bene esse* which has been read in evidence without objection, cannot be subsequently objected to and rejected, because the court after it had been so read refused to allow another deposition to be read, on account of an exception which would have applied to and excluded the deposition actually read, had it been taken. *Ibid.*, 419. [Affirmed, *post* 9.]

5. Where a deposition *de bene esse* is offered in evidence, the party offering it must prove that he has used due diligence to procure the attendance of the witness, and particularly that he has made inquiries at the last place of abode of witness, in order to have him served with a subpoena. *Pettibone v. Derringer*, 4 Wash., 219.—WASHINGTON, J.; Pa., 1818.

6. It is no objection to reading the deposition of a witness residing more than one hundred miles from the place of trial, that he had been in the place where the court sat during its sitting, it appearing that the fact of the witness being so present was unknown to the party at whose instance the deposition was taken. Whether the case would have been altered if the party had known of the presence of the witness; *query*. *Ibid.*, 219.

7. Depositions taken without a commission or rule of court, in another state, more than one hundred miles from the place of trial, but conforming in all respects to § 30 of the judiciary act of 1789, may be read in evidence. *Ibid.*, 219.

8. A deposition taken under § 30 of the act of 1789 cannot be read, unless the judge certifies that it was reduced to writing, either by himself or by the witness *in his presence*. *Ibid.*, 219.

9. A deposition which has once been

introduced in a cause with the acquiescence and consent of the opposite party, cannot be afterward objected to. *Evans v. Hettick*, 7 Wheat., 470.—STORY, J.; Sup. Ct., 1822.

10. No practice, however convenient, can give validity to depositions which are not taken according to law, unless the parties expressly waive the objection, or by previous consent agree to have them taken and made evidence. *Evans v. Eaton*, 7 Wheat., 426.—STORY, J.; Sup. Ct., 1822.

11. The act of Congress (act of 1789, ch. 20, § 30, 1 Stat. at Large, 100) as to the taking the testimony of witnesses residing more than one hundred miles from the place of trial by depositions, is not peremptory, that under such circumstances their depositions shall be taken and used, but only that they may be taken and used. It is a mere option given to the party who wishes to use the testimony of the witnesses. The witnesses may be produced and if so produced, full costs of their personal travel and attendance will be allowed in the costs. *Prouty v. Ruggles*, 2 Story, 200.—STORY, J.; Mass., 1842.

12. A deposition should not be taken during the sitting of the court at which the cause is to be tried, except by consent of parties or order of the court. *Allen v. Blunt*, 2 Wood. & Min., 137.—WOODBURY, J.; Mass., 1846.

13. *Semble*, That if the opposite party had counsel residing where the deposition was taken, and who had acted in a former trial, though such counsel was not entered on the record, if this fact was known to the party taking the deposition, that notice of its taking should have been given to such counsel. *Ibid.*, 137.

14. Whether, if the suit is against

two, though only one has been served with process, it will be sufficient if the caption of the suit in the deposition describes the suit as only against the one served; *query. Ibid.*, 137.

15. If a deposition is taken without notice, a continuance will be allowed to enable the other party to cross-examine the witness or repel his testimony. *Ibid.*, 138.

16. Where prior to the taking of depositions *de bene esse*, the opposite party had had notice of the names and places of residence of the witnesses intended to be examined, and had also been notified that if they would designate agents at those places, on whom fuller notices could be served of the particular times and places of their examination, but such party refused to appoint any such agents, and declined to take any part in the proceedings, *Held*, that such party was not entitled to a stay to cross-examine such witnesses. *Van Hook v. Pendleton*, 2 Blatchf., 94, 95.—BETTS, J.; N. Y., 1848.

17. Under rule 68 in equity it is in the discretion of the court whether the cause shall be stayed to allow a party to cross-examine a witness, or take a new deposition of the witness, whose testimony has been taken *de bene esse*, without notice under § 30 of the judiciary act of 1789. *Ibid.*, 95.

18. Before such discretion will be exercised, facts, as that the testimony of the witness was adverse to such party, or that there are facts within the knowledge of the witness not stated, which may be important in the cause, must be laid before the court showing the necessity or propriety of a further examination of the witness. *Ibid.*, 95.

19. Depositions (in a patent suit) taken under the act of Congress, even

DEPOSITIONS, UNDER RULE OF COURT, OR COMMISSION.

though taken *ex parte*, are recognized as legal testimony by the act of Congress, and are available for either side. *Judson v. Cope*, MS.—LEAVITT, J.; Ohio, 1860.

2. Under Rule of Court, or Commission.

1. A deposition of a witness residing *within* a district more than one hundred miles from the place of trial, taken under a rule of court, not in conformity with the requirements of § 30 of the act of 1789, cannot be read in evidence. *Evans v. Hettick*, 3 Wash., 418; *Evans v. Eaton*, 3 Wash., 444.—WASHINGTON, J.; Pa., 1818.

2. Where witnesses live out of a district, and more than one hundred miles from the place of trial, their depositions, if taken, must be under a commission, and will be absolute. *Evans v. Hettick*, 3 Wash., 418.—WASHINGTON, J.; Pa., 1818.

3. Depositions may be taken differently from what the law or the rules of court prescribe, under the agreement of the parties, or under any special rule of the court, in any particular case. *Ibid.*, 418.

4. Where depositions are taken under an order of court requiring notice to be given to the opposite party, and the notice was so short that the party and his counsel were unable to see each other and confer together before the time arrived, and reach the place of taking them, time will be allowed to such party to take the depositions over again, and cross-examine the witnesses, if desired. *Aiken v. Bemis*, 3 Wood. & Min., 351.—WOODBURY, J.; Mass., 1847.

5. An examiner to take testimony is not created or appointed at the instance of suitors, but is an officer of the court,

to execute the functions appropriate to his office, however his appointment may be made. *Van Hook v. Pendleton*, 2 Blatchf., 90.—NELSON, BETTS, JJ.; N. Y., 1848.

6. The same power which enables the court to name commissioners, suffices for the appointment of masters and examiners. The process acts of 1792 and 1842 gave this power of appointment, to be exercised pursuant to the directions of the Supreme Court. *Ibid.*, 91.

7. Rule 82 in equity sanctions the appointment of standing masters and of masters *pro hac vice*. But the Circuit Courts could, without this rule, have appointed masters *pro hac vice*, in their discretion. *Ibid.*, 92.

8. The language of rule 78 is satisfied by designating in a common order, or by mere notification, the officer before whom the examination is to be taken. This is in effect appointing him examiner in the cause, although he should not be commissioned anew. *Ibid.*, 92.

9. It is a matter of discretion with the court whether there shall be appointed standing examiners, to take depositions, or whether they shall be named as the occasion arises for their services in any cause. *Ibid.*, 934.

10. Where the plaintiff in a suit at equity, after the cause was at issue, proceeded to take his proofs before one of the standing examiners of the court, without his having been specially appointed as examiner in the cause, *Held*, that the examiner was competent to take the proof. *Ibid.*, 86, 93.

11. An oral examination of a witness before an examiner, without any agreement between the parties to waive written interrogations, is, under rule 67 in equity, Supreme Court rules, irregular. *Ibid.*, 93.

12. And such an agreement ought to be in writing. *Ibid.*, 93.

13. Where a party has had notice that an examination was to be taken, or had been taken, orally, and acquiesced in it, he waives his legal right to require written interrogatories to be filed. *Ibid.*, 93.

14. Where more than ten months had elapsed since an oral examination had been taken, of which the defendant had notice, and more than five months had elapsed since publication, *Held*, that the defendant had been guilty of laches, and that it was too late to raise the objection that the testimony had been taken orally. *Ibid.*, 93, 94.

3. Under Rules of the Patent Office.

1. Evidence taken under the rules established by the Commissioner of Patents, under the statute, must not only be taken agreeably to those rules, but must be evidence competent in law. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

2. After a deposition has been taken under such rules, a revocation of them cannot affect that deposition, and will affect only subsequent proceedings. *Ibid.*

3. Lateness of time of notice of taking depositions under the rules of the Patent Office is no cause for rejecting the depositions taken; but it may, perhaps, be good ground for an application to the Commissioner to allow further time to take other testimony. *Ibid.*

4. But if the magistrate before whom a deposition is taken fails to certify thereon that it was sealed up by him, it is sufficient ground for excluding such deposition from the consideration of the Commissioner. *Ibid.*, 28.

5. A notice of taking depositions at a place four hundred miles distant, served eleven days before the time for taking such depositions, is sufficient. *Smith v. Flickenger*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1843.

6. Where depositions had been correctly taken, but had not been transmitted in the form required, so that they could, under rule 4, be *considered* by the Commissioner, *Held*, nevertheless, that the Commissioner had a right to postpone the hearing, to allow the parties to cure the informality, if he deemed such action necessary to further the ends of justice. There is nothing in the laws or rules of the Patent Office preventing the Commissioner from so doing. *Ibid.*

7. The rule referred to does not prohibit the Commissioner from *looking into* the deposition informally transmitted, or reading it and ascertaining its contents; but only prohibits him from *considering* it as evidence touching the matter in issue. *Ibid.*

8. By an agreement of parties, the testimony of witnesses otherwise incompetent may be received and considered. *Warner v. Goodyear*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

9. Depositions, to be used in a matter of interference before the Commissioner of Patents, taken without notice to the opposing party, cannot be used against him, unless he has waived his right to notice, and agreed to admit them to be read in evidence. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

10. And notice given by such party to the opposing counsel to produce such depositions to a Commissioner for examination, and an offer by such counsel to again produce the witnesses for cross-

DEPOSITIONS, UNDER RULES OF PATENT OFFICE.

examination, and a refusal to cross-examine them when produced, is not a waiver of notice. *Ibid.*

11. Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. *O'Reilly v. Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

12. Such an application is in the discretion of the Commissioner, and it will be presumed that his decision on it has been soundly exercised. *Ibid.*

13. Depositions taken on the part of A in an interference between the applications of A and B—the latter as assignee of C—may be read in evidence upon a second interference declared between such application of A and B, and a subsequent application of D, of whose application B was also the assignee, and the real party in interest—all such applications being in respect to the same subject. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

14. It would be unnecessarily oppressive to require the party, merely to gratify form, to take the testimony anew. *Ibid.*

15. Depositions cannot be taken before a magistrate or person who is the attorney or of counsel for either party, or interested in the event of the action. *Nichols v. Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

16. The rules of the Patent Office as to the taking of testimony, prescribed under § 12 of the act of 1839, are to be *just and reasonable*, according to the

established principles and precedents in like cases. *Ibid.*

17. Where an interference has been declared between certain parties, and testimony taken, and then another application is made by another party, and he is made a party to the interference, but the subject matter of all the applications is the same, the testimony taken on the first interference may be used on the second, without being retaken. *Carter v. Carter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

18. It seems that testimony taken on a former interference is admissible on a second one, and this though the second interference is declared after an assignment to another party. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

19. A second interference is only a rehearing of the same case. *Ibid.*

20. The rules and regulations of the Patent Office as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and until abrogated, are as binding upon the Commissioner himself, as if enacted by the statute itself. *O'Hara v. Hawes*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

21. The rules of the Patent Office as to the taking of depositions, give to either of the litigant parties the right to take depositions, *without restraint*, up to the day of hearing fixed by the Patent Office, or to a day near enough to give time for the transmission of the evidence to the Patent Office. *Spear v. Abbott*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1859.

22. The proceedings in the Patent Office in contested cases, have no resemblance to trials at law; a party cannot be compelled to examine all his wit-

DECLARATIONS AND ACTS OF PARTIES AND THIRD PERSONS.

nesses in chief before he closes his opening examination. *Ibid.*

23. The officer before whom testimony is taken, should stand indifferent between the parties, in no such relation to either of them as to bias him in favor of one more than the other; more especially he should not be interested in the questions at issue. *Collins v. White*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

24. A stockholder in a company cannot legally act as an officer to take depositions in an interference, in the result of which such company is interested. *Ibid.*

25. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to raise the objection as to his competency, on appeal. *Allen v. Alter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

26. Where no notice of the taking of depositions has been given to the opposite party, but such opposite party or his counsel are present when they are taken, such depositions will not be excluded because of want of notice, and particularly if taken by consent of parties. *Walker v. Forbes*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

27. The object of notice is to bring the adverse party before the examining officer. Where the party attends before such officer, such notice is mere form, and technicality, which is covered by rule 90. *Ibid.*

D. DECLARATIONS AND ACTS OF PARTIES AND THIRD PERSONS.

1. The declarations of a party, at a given time, that he had invented a machine afterward patented, and which he

then described, may be received in evidence; but they are not proof that he was the inventor, but only that he said he was. *Evans v. Hettick*, 3 Wash., 410.—WASHINGTON, J.; Pa., 1818.

2. A witness cannot be called to testify as to what third parties may have stated as to an invention—such being mere hearsay evidence. The parties from whom the witness received the information should have been called. *Ibid.*, 414.

3. The letters of a party to the proper officer of the government applying for a patent for his invention, are admissible as evidence as to the fact of his being the inventor, on a suit brought under his patent. *Pettibone v. Derringer*, 4 Wash., 219.—WASHINGTON, J.; Pa., 1818.

4. The fact of making and exhibiting an article never before seen or heard of by the witnesses, is at least *prima facie* evidence of invention on the part of the maker, until other evidence is given to prove that the same article was invented, known, or in use, at a prior time, and that the patentee had only embodied the conceptions and ideas of some other persons. *Pennock v. Dialogue*, 4 Wash., 541.—WASHINGTON, J.; Pa., 1825.

5. But if the maker make no claim to being the original inventor, this fact may be opposed to such *prima facie* evidence, and from it may be urged the probability that he did no more than give form and substance to the invention of some other person. *Ibid.*, 542.

6. The testimony of a witness that he suggested an invention to a patentee, is in the nature of confessions, and this is always regarded as an uncertain kind of evidence. *Alden v. Dewey*, 1 Story, 339.—STORY, J.; Mass., 1840.

DECLARATIONS AND ACTS OF PARTIES AND THIRD PERSONS.

7. The declarations and conversations of a patentee, merely affirming that at some former period he invented that particular machine, are not admissible; but his declarations and conversations, stating that he had made an invention, and describing its details, and explaining its operations, are properly evidence of an assertion of his right, at that time, as an inventor, to the extent of the facts and details made known by him, though not of their existence at an antecedent date. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 432.—STORY, J.; Sup. Ct., 1840.

8. Such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ* and legitimate evidence that the invention was then known to and claimed by him, and fixes its origin, at least, as early as that period. *Ibid.*, 462.

9. The mere declaration of an inventor, that at a certain time he had made the invention, is not evidence. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. The declarations of a party, made before a dispute arose, and proving the existence of certain inventions in connection with certain acts before a particular date, may be received, as developing a link in a transaction. *Hovey v. Stevens*, 1 Wood. & Min., 292.—WOODBURY, J.; Mass., 1846.

11. In cases of interfering applications, the declarations of the parties themselves in their own favor, in the absence of each other, are not competent evidence for any purpose but to ascertain when and what they respectively claimed to have invented. *Atkinson v. Boardman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

12. The declarations of an agent in relation to a business to which his agency extended, are a part of the *res gestæ*, and bind the principal as if made by himself. *Aiken v. Bemis*, 3 Wood. & Min., 350, 355.—WOODBURY, J.; Mass., 1847.

13. On this ground, the admissions and declarations of a foreman of the defendant as to the number of articles made which were an infringement on the plaintiff's patent, were held admissible; but it should be made to appear that his agency extended to the particular business, and whether the declarations were made while he was engaged in it, and not afterward. *Ibid.*, 350, 355.

14. The declarations and admissions of an assignor of a patent, after he has parted with his interest in it, are inadmissible either to show a want of title in him, or to affect the quality of the article, or to impair the rights of the purchaser in any respect. *Many v. Jagger*, 1 Blatchf., 376.—NELSON, J.; N. Y., 1848.

15. Where in an action for the infringement, the defendant offered to show that one of the patentees of an article, after he had assigned all his interest in the patent, had declared that the thing patented had been abandoned, and had failed, and was worthless, *Held*, that such declarations were inadmissible. *Ibid.*, 376.

16. The declarations of a patentee who had parted with all his interest under the patent, that he had never completed his invention, is only hearsay evidence, and therefore not admissible; but if admissible, are not evidence which would disparage the right or title of those holding under him, without notice of the facts alleged in

DECLARATIONS AND ACTS OF PARTIES AND THIRD PERSONS.

such declarations. *Wilson v. Simpson*, 9 How., 121, 122.—WAYNE, J.; Sup. Ct., 1849.

17. The declarations of a party describing, at a particular time, an alleged invention, are admissible to show what he knew, or had invented at the time such declarations were made, provided they were made before a dispute or contest had arisen. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

18. The declarations of a third party in an interference that he was a part inventor, are admissible to show that neither of the applicants are entitled to a patent; but such declarations would not be evidence for such party in an application for himself. *Ibid.*

19. It seems that evidence as to the conversations and declarations of an inventor as to his invention, and which referred to a specimen or model of his invention which had been actually made by him, and which was in his possession at the time of such conversations and declarations, cannot be received without the production of such original model or specimen, or without its non-production being accounted for. *Richardson v. Hicks*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

20. Nor can an exhibit be introduced in evidence for the purpose of showing that it is like such original model or specimen, but the original must be produced, or its non-production accounted for. *Ibid.*

21. The conversations and declarations of a party as to an invention are evidence of his right at that time only to the extent of the facts and details which he then describes and makes known. *Garrett v. Davidson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

22. Admissions or declarations as to an invention made in a way of compromise, and without the admission of any particular facts, are not admissible as evidence; but if made voluntarily, without any pending negotiation, it seems they are admissible. *Gibbs v. Johnson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

23. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring v. Leffingwell*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

24. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation it will be treated as if it had never been made. *Ibid.*

25. Where A, when acting as an agent to sell the patent of another, made an invention of his own in respect to the same article, but thinking that his agency was a bar to his making any effort to introduce his own, and being also poor, made an agreement with B to manufacture such invention and sell it as B's, and did so, representing it in certain places as B's invention, and B afterward applied for a patent for such invention, and set up that such representations estopped A from claiming the invention as his own; *Held*, that under the circumstances such representations of A would have only the effect to give, in such places, the same validity to such sales as if made in A's own name and no further, and did not preclude A from showing that he was in fact the original inventor over B, and

PAROL AND SECONDARY EVIDENCE.

that as such he was entitled to a patent for the said invention. *Ibid.*

E. PAROL AND SECONDARY EVIDENCE.

1. The letters of a party when applying for a patent, are properly admissible in evidence in his own behalf. *Pettibone v. Derringer*, 4 Wash., 219.—WASHINGTON, J.; Pa., 1818.

2. In an action for infringement of a patent, the minutes of a company of which the plaintiffs were members, and at whose suggestion and expense the subject of the patent was claimed to have been invented, may be read in evidence to prove that the plaintiffs were not the original inventors of the thing patented; but not to show that the plaintiffs had surreptitiously obtained the patent for another's invention, unless notice of such defence and intention had been given to the plaintiffs. *Pennock v. Dialogue*, 4 Wash., 545.—WASHINGTON, J.; Pa., 1825.

3. But other entries in such book of minutes cannot be read by the plaintiffs to show that the company acknowledged the plaintiffs to be the inventors of the thing patented, the defendants in the suit not being members of such company. *Ibid.*, 545.

4. The books of a party are not evidence as to invention, unless called for by the other party, or their contents inquired of by him. *Stanley v. Whipple*, 2 McLean, 39.—MCLEAN, J.; Ohio, 1839.

5. Parol evidence bearing upon written contracts, or papers in respect to patent interests, ought not to be admitted without the production of such contracts or papers to enable the court and jury to see whether the admission of the parol evidence will trench upon the

rule that parol evidence is not admissible to vary or contradict written contracts or papers. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 461.—STORY, J.; Sup. Ct., 1840.

6. A letter of a third party, though sent under cover of one from the inventor to the Commissioner of Patents, is not evidence as to priority of invention. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

7. A deed or documentary exhibit, showing that a witness had parted with all his interest in an invention, may be allowed to be put in evidence in a suit after the general evidence has been published. *Nesmith v. Calvert*, 1 Wood. & Min., 42.—WOODBURY, J.; Mass., 1845.

8. Parol evidence is not admissible to prove the contents of papers, as a letter and drawings, alleged to have been sent by mail to the plaintiff until proof is furnished to the court that they have been lost, or have gone into plaintiff's custody. If sent by mail they must be shown to have been received, particularly where the party to whom mailed denies on oath that they ever were received. *Allen v. Blunt*, 2 Wood. & Min., 130, 131.—WOODBURY, J.; Mass., 1846.

9. The mere putting of letters in the post-office is not sufficient evidence of their being received, when such fact of reception is endeavored to be made a ground for the introduction of secondary evidence as to the contents of the letters so sent. *Ibid.*, 131.

10. Oral evidence of the intent and meaning of parties in explanation of a written instrument respecting a patent-right is wholly inadmissible; the agreement being in writing must speak for itself. *Troy Iron & Nail Fac. v. Cor-*

ning, 1 Blatchf., 472.—NELSON, J.; N. Y., 1849.

11. Certificates of manufacturers and others as to an invention, in order to be received and considered upon an application for a patent should be taken under oath. *Jillson v. Winsor*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

12. Copies of original memorandums and drawings are not admissible in evidence as confirmatory of the testimony of the party who made them (see 10 Pet., 438, 439); the originals might have been used to refresh the memory of the witness. *Jones v. Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

F. PUBLIC RECORDS AND PAPERS; VERDICT.

1. An exemplification of a *specification* of a patent is made evidence by § 2 of the act of Congress of 1793. The exemplification of the *patent* itself stands upon the common law, as being an exemplification of a record of a public document, and is always to be received as evidence. *Peck v. Farrington*, 9 Wend., 44.—SAVAGE, Ch. J.; N. Y., 1832.

2. A certified copy of a patent, surrendered and cancelled, is admissible in evidence, to show that an improvement subsequently patented is not original, though it does not specify when it was cancelled, or how, or for what defect. *Delano v. Scott*, Gilpin, 496.—HOPKINSON, J.; Pa., 1834.

3. A former and defective certified copy of a patent may be corrected by another full and corrected certified copy, and the defective one cannot affect the one that is complete. *Brooks v. Bicknell*, 3 McLean, 434.—MCLEAN, J.; Ohio, 1844.

4. Certified copies of assignments of patents on record are competent evidence of the originals, and the production of the originals cannot be compelled. *Ibid.*, 436.

5. Papers or drawings on file in the Patent Office are public records, and certified copies of them must be received in evidence when offered. If they are discordant, one may destroy the effect of the other. But they need not concur in every particular. *Emerson v. Hogg*, 2 Blatchf., 12.—NELSON, BETTS, JJ.; N. Y., 1845.

6. A verdict upon an issue ordered by a court of equity is in no just sense final upon the facts it finds, or binding upon the judgment of the court, until a subsequent hearing upon its merits, and a decree rendered thereon by the court. *Allen v. Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

7. Whether a verdict given in a suit at law is ever evidence of any thing but the fact that it was rendered, unless a judgment has been duly rendered thereon. *Ibid.*, 746.

8. If copies of a patent are erroneous, the Commissioner of Patents has the power, and ought to make them conform to the patent itself and to the record. *Woodworth v. Hall*, 1 Wood. & Min., 260.—WOODBURY, J.; Mass., 1846.

9. Whether original letters of the Commissioner of Patents, coming from a public officer, under an official oath, and on official business, are not legal and competent evidence in the light of a public record or document, as to the matters referred to therein; *query*. *Allen v. Blunt*, 2 Wood. & Min., 128, 129.—WOODBURY, J.; Mass., 1846.

10. A former verdict of dismissal between the same parties on an issue out

WITNESS. COMPETENCY AND CREDIT OF; GENERALLY.

of chancery in a bill asking for an injunction, and upon an original specification, is not admissible in evidence in a suit at law for damages for violation of the patent, with corrected specifications, and in no case is such a verdict a bar to the second action, unless judgment was rendered on such verdict against the plaintiff, or such verdict of dismissal was on the merits. *Ibid.*, 132, 134.

11. A verdict in a patent case and sustaining a patent, can in no case be evidence at law or in equity, and in another action brought by a witness called by the plaintiff on the trial in the former action, and who was interested in the same patent, for the purpose of establishing his title to the patent, as it is a proceeding *inter alios*. *Buck v. Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

12. But such verdict would be admissible on a motion for a provisional injunction, as affording strong evidence of the validity of the patent, and of his title. It is evidence, however, only in cases where his own deposition would be competent; cases in which the application is to the sound discretion of the court. *Ibid.*, 324, 325.

13. Certified copies of papers in the Patent Office must be received as *prima facie* evidence of the genuineness of the originals on file, and absolute evidence of the correctness of the copies from the record. *Parker v. Haworth*, 4 McLean, 371.—McLEAN, J.; Ill., 1848.

14. The rendition of a verdict in a patent case in favor of a plaintiff is not conclusive upon the right of such party to an injunction. *Many v. Sizer*, 1 Fisher, 43.—WOODBURY, SPRAGUE, JJ.; Mass., 1849.

15. Where a patentee and his assignee brought a suit in equity, in the

Circuit Court in Louisiana, under § 16 of the act of 1836, against a junior patentee, to declare such junior patent void, on the ground of its interference with the plaintiffs' patent; and afterward the same plaintiffs brought an action at law in another circuit for an infringement of their patent, against a party who was not a party to the suit in Louisiana, but who had obtained an interest in the junior patent, sought to be set aside by that suit, after the commencement of that suit and before judgment rendered therein; *Held*, that the parties to such suit at law were within the proviso of said § 16, and that their rights would be bound by a decision in the suit in Louisiana, declaring that such patents interfered, or that either of them was valid or invalid. *Tyler v. Hyde*, 2 Blatchf., 309, 312.—BERTS, J.; N. Y., 1851.

16. A certified copy from the Patent Office of an assignment recorded therein, will be received as *prima facie* evidence of the genuineness of the original assignment, and the production of the original may be dispensed with. *Parker v. Bigler*, MS.—GRIER, J.; Pa., 1857.

17. A certified copy of an assignment of a patent from the Patent Office of the United States, is *prima facie* evidence of the genuineness of the original. *Lee v. Blandy*, 2 Fisher, 91.—McLEAN, LEAVITT, JJ.; Ohio, 1860.

G. WITNESS.

1. Competency and Credit of.

See also EXPERTS; EVIDENCE, G. 3.

a. Of Witnesses generally.

1. When a witness offered in a patent suit is sworn on his *voir dire*, no evidence can be given to prove him to be

WITNESS. COMPETENCY AND CREDIT OF; GENERALLY.

incompetent, except such as arises from his own acknowledgment. But if it should, in any subsequent stage of the examination, appear by other evidence that he is not a competent witness, the court will set him aside. *Evans v. Eaton*, Pet. C. C., 338.—WASHINGTON, J.; Pa., 1816.

2. A person was offered as a witness in behalf of a defendant, in an action for the infringement of a patent, such person being also a defendant in another suit brought for an infringement of the same patent, and such witness had also contributed, with other defendants, to defray his expenses in attending the trial, where he was called as a witness, but there was no agreement between the contributors as to damages or costs. *Held*, that the witness had no interest that was dependent on the event of the suit, and that he was therefore competent. *Evans v. Hettick*, 3 Wash., 412, 413.—WASHINGTON, J.; Pa., 1818. [Affirmed 1822, *post* 7.]

3. It is for the jury to say, what credit is to be given to the testimony of opposing witnesses, in determining which, they must take into calculation every circumstance affecting their veracity, whether it concern their moral character, or arise from interest or from feeling favorable to either party. *Ibid.*, 423, 424.

4. Where a fact in controversy may exist, without a violation of probability, and the proof is by witnesses exclusively on one side, there is nothing against which to weigh their credit; if an objection to their credit be worth any thing, it must be to the full extent of rejecting their testimony. The jury cannot compromise the matter. They must decide that the fact is so or is not so. *Ibid.*, 424.

5. A person having an interest only in the question, and not in the event of a patent-suit, is a competent witness. *Evans v. Eaton*, 7 Wheat., 425.—STORY, J.; Sup. Ct., 1822.

6. In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and will not exclude the witness. *Ibid.*, 425.

7. It is no objection to the competency of a witness, that he is sued in another action for an infringement of the same patent. *Evans v. Hettick*, 7 Wheat., 468.—STORY, J.; Sup. Ct., 1822.

8. In an action for an infringement, the defendant, to prove that the plaintiff was not the original inventor of the thing patented, gave in evidence a prior patent for an alleged similar machine as that of plaintiff, and then offered the patentee of such prior patent as a witness to prove the priority of his invention, *Held*, that the witness was competent, as he had no interest in the event of the suit. *Treadwell v. Bladen*, 4 Wash., 704.—WASHINGTON, J.; Pa., 1827.

9. A workman employed by a person to make articles which are alleged to infringe a patent, is a competent witness to prove such making, as he is not liable, as such workman, to an action for infringement. *Delano v. Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

10. If a witness is interested, he is excluded, however small the amount of his interest may be. *Arnold v. Bishop*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1841.

11. But where the interest of the witness in the patent applied for was

WITNESS. COMPETENCY AND CREDIT OF; GENERALLY.

the same, whether the patent should be granted to one applicant or to the other, *Held*, that he was a competent witness. *Ibid*.

12. By an agreement of parties, the testimony of witnesses otherwise incompetent may be received and considered.

Warner v. Goodyear, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1846.

13. The fact that a person called as a witness in behalf of the plaintiff is interested in the same patent on which suit is brought, but in other sections of the country, but none in the county where the plaintiff's right is, does not render him an incompetent witness for the plaintiff. *Buck v. Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

14. The usual test of the interest of a witness is, whether he is interested in the event of the suit or issue—whether he is to lose or gain by the event—that is, whether he has interest, legal or equitable (if real), which will be secured or continued to him in the event of the success, or lost, in the event of the non-success of the party in whose favor he is called. *Cresler v. Custer*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

15. Therefore an assignee of an interest in an invention is not a competent witness for the inventor, in an interference on an application for a patent for such invention, such assignee using such improvement with the consent of the inventor and the assignee, regarding that he had bought it. *Ibid*.

16. The presumption of law is that a witness on oath testifies honestly, until the contrary is shown. Credit ought to be given to his testimony, unless it is so grossly improbable as to show that he is not to be trusted. *N. E. Screw*

Co., v. Sloan, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

17. Contradictions and inconsistencies in the testimony of a witness, it not appearing that they proceeded from corrupt motives, and the witness standing unimpeached by extrinsic circumstances, may lessen, but will not entirely destroy his testimony. *Ibid*.

18. The mistake of a witness as to an immaterial fact, as for example who were present at a particular conversation, will not discredit him. The maxim, *falsum in uno, falsum in omnibus*, does not apply. That can only apply where there is wilful, corrupt falsehood in one particular, amounting to perjury, in which case all the other testimony of the witness is to be rejected. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

19. The testimony of a witness, directly or indirectly interested in the patent, or its benefits, is not admissible, in an interference, as to the question of priority of invention. *Ibid*.

20. In considering testimony, weight should be given to it in proportion to the competency of the witness to judge of the matters sworn to. *Allen v. Hunter*, 6 McLean, 310, 312.—MCLEAN, J.; Ohio, 1855.

21. The refusal of a witness to answer on his cross-examination, questions which are material and proper, will affect the credit of his testimony. *Cornell v. Hyatt*, MS. (App. Cas.)—MORSELL, J.; D. C., 1856.

22. Where a witness in other respects stands fair and free of suspicion, his statement under oath as to the fact of invention, will not be rejected because he may have made contradictory statements elsewhere; but where the relation in which he stands to the cause is

such as to make it reasonable to suppose he is under a strong bias in favor of one of the parties, the rule is different, especially when he testifies as to things taking place when no one else was present. *Sanders v. Parsons*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

23. If objection is not made to the competency of a witness on his examination, and both parties examine him, it will be too late to take the objection afterward. *Allen v. Alter*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

b. Of Assignor of Invention in Interferences.

1. A person who is nominally a party to the proceeding in an application for a patent, cannot be a witness in such case, even though he has parted with all his interest in the matter. *Yearsley v. White*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

2. Where, therefore, one of two joint inventors was called as a witness in a case of interference, between such joint inventors, and that of another party, *Held*, notwithstanding that he had assigned all his interest in the invention, that he was not a competent witness. *Ibid*.

3. An inventor who had assigned all his interest in the invention to another, was offered as a witness in favor of his assignee, upon an interference, to prove priority of invention, and was objected to as being interested, *Held*, although he was not affected by pecuniary interest or advantage to render him incompetent, yet he must in the nature of things be supposed to view most favorably the success of his assignee, and to feel a prejudice against the other side. *O'Rielly v. Smith*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. In an interference, a party to the proceeding, as an inventor, cannot be made a witness, even though he has assigned all his interest in his invention to another. *Hill v. Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

5. In an interference case, the testimony of the inventor himself, though he has assigned his invention, cannot be received—he is in form and substance a party to the issue. *Eames v. Richards*, MS. (App. Cas.)—MERRICK, J.; D. C., 1859.

6. The testimony of a party to the record, as of an inventor, though he had actually transferred all his interest in the invention, is not admissible upon an interference. *Gibbs v. Johnson*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

7. The assignor who has sold his invention, is not competent as a witness for his assignee, to prove priority of invention, upon an interference declared. *Barstow v. Swan*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

2. Examination and Impeachment of.

1. A witness cannot be asked as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer which might, by other evidence, be shown incorrect, and thereby to discredit him. *Odiorne v. Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

2. Evidence to discredit a witness of the opposite party, cannot be introduced if the court consider that it cannot have such an effect. *Evans v. Eaton*, Pet., C. C., 338.—WASHINGTON, J.; Pa., 1816.

3. Plaintiff's counsel cannot inquire of a witness, whether third persons had offered to take a licence from the plaintiff, for the use of his invention, and pay

for the same, it not having been proved that such persons had used an invention similar to plaintiff's. *Evans v. Hettick*, 3 Wash., 413.—WASHINGTON, J.; Pa., 1818.

4. A witness cannot be called to testify as to what third parties may have stated, as to an invention, such being mere hearsay evidence. The parties from whom the witness received the information should have been called. *Ibid.*, 414.

5. Plaintiffs' counsel cannot inquire of witnesses as to acts between plaintiffs and third persons or strangers as to his patent; these ought not to prejudice the defendant. *Evans v. Hettick*, 7 Wheat., 469, 470.—STORY, J.; Sup. Ct., 1822.

6. It is incumbent upon those insisting upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterward at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose, not then suggested to the court. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 460.—STORY, J.; Sup. Ct., 1840.

7. A party cannot cross-examine a witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him as to other matters, he must do so by making the witness his own. *Ibid.*, 461.

8. If a party is called to prove a fact, as to which he is a competent witness—as the loss of a paper or drawing—and is then cross-examined by the opposing counsel, at large, as if he were a competent witness in chief, his answers are thereby made evidence for himself.

Perry v. Cornell, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

9. The law gives no color to the practice which not unfrequently appears in judicial proceedings, of besetting a witness with impertinent inquiries, which are not shown to have any legitimate bearing upon the case. *Day v. Bost. Belting Co.*, MS.—BETTS, J.; N. Y., 1854.

10. Whether a witness may claim exemption from answering a question, because his knowledge of the matter inquired of was obtained by him as an attorney in such character; *query. Ibid.*

11. Whether under any circumstances a witness has a right to refuse to answer a question, on the ground that it would expose his private affairs; *query.* Such a right cannot, however, be claimed, if the witness on his direct examination has referred to the matter inquired of on his cross-examination. *Nichols v. Harris*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

12. Upon the cross-examination of a witness, it is not necessary for the party examining him to state the purpose of any particular question, as such rule might defeat the very object had in view by such party. *Ibid.*

13. Upon the re-examination of a witness, it is only proper to question him as to the things inquired of him on his cross-examination; the party re-examining him has no right to go further, and introduce new matter. The witness cannot be examined as to new matter, or substantially on the points he has before been examined upon. *Hill v. Dunklee*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

3. *Parties, Examination of.*

See also EVIDENCE, G. 1. *a*.

1. A party to an interference is competent to prove the loss of a paper or drawing of his invention. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

2. As a general rule, a party cannot be a witness in his own cause. *Buck v. Hermance*, 1 Blatchf., 324.—NELSON, J.; N. Y., 1848.

3. Nor will he be permitted to avail himself, by indirect means, of evidence which would be rejected as incompetent if offered directly. *Ibid.*, 324.

4. A party to an interference is a competent witness to prove the loss of a paper, if lost out of his own possession, and not destroyed by fraud, the existence and contents of such paper being proved by other testimony. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

5. If two persons, from their relationship to each other, have had access to such paper, they should both join in the deposition as to its loss. *Ibid.*

6. Upon a reference to a master, in an equity suit for the infringement of a patent, to take an account, a defendant cannot be examined as a witness in his own favor, if objected to by the plaintiff. *Foot v. Silsby*, 3 Blatchf., 508.—HALL, J.; N. Y., 1856.

7. Nor can a defendant be so examined on his own behalf by his own counsel, even though he has been called and examined as a witness by the plaintiff, or was sworn by the master upon the plaintiff's application. *Ibid.*, 510.

8. In an action for an invasion of plaintiff's trade-mark, the plaintiff is not privileged from answering a question

which may reveal the *secret* of his trade, as such a question may be pertinent to the issue in determining the amount of profits. *Burnett v. Phalon*, 19 How. Pr., 531, 532, 535, 536.—HOFFMAN, J.; N. Y., 1860.

9. A defendant cannot be required to testify whether he has used labels or trade-marks like the plaintiff's, if his affirmative answers thereto may tend to convict the witness of an offence punishable by statute. *Byass v. Sullivan*, 21 How. Pr., 52.—BONNEY, J.; N. Y., 1860.

10. Where a state law made it a misdemeanor to vend goods with a forged label, *Held*, that the defendant could not be required to testify whether he had sold goods with a label like that of the plaintiff's. *Ibid.*, 52.

11. The judiciary act of September 1789, § 34 (1 Stat. at Large, p. 92), adopting the laws of the several states as rules of decisions in the courts of the United States, embraces laws relating to evidence. *Haussknecht v. Claypool*, 1 Black, 431.—NELSON, J.; Sup. Ct., 1861.

12. Where, therefore, under the laws of any state, parties may be examined as witnesses in their own behalf, a plaintiff, in an action in the United States courts, for infringement of his patent, is a competent witness as to the issues raised therein. *Ibid.*, 431.

13. A like decision was also made in *Vance v. Campbell*, 1 Black, 427.—NELSON, J.; Sup. Ct., 1861.

H. AS TO PARTICULAR ISSUES.

1. *Abandonment.*

See also ABANDONMENT, B.

1. If, before a patent is taken out, the inventor looks on and sees his invention

ABANDONMENT.

going into general use, without objection on his part, the court will treat his conduct as equivalent to an abandonment or transfer of his exclusive right to the public. *Treadwell v. Bladen*, 4 Wash., 708.—WASHINGTON, J.; Pa., 1827.

2. The question of abandonment does not turn upon the intention of the inventor. Whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent, obtained under such circumstances, protect his right. *Shaw v. Cooper*, 7 Pet., 323. McLEAN, J.; Sup. Ct., 1833.

3. There must be evidence of a distinct character as to abandonment, showing such an intention. The natural presumption is, that a person who has invented a machine would not give it to the world. *Hovey v. Henry*, 3 West. Law Jour., 155.—WOODBURY, J.; Mass., 1845.

4. Where it was alleged that a patentee had abandoned his invention, and the lapse of time between the grant of the patent and the commencement of suit was urged as a proof of that fact, *Held*, that the plaintiff was entitled to rebut any presumption of abandonment by showing acts prosecuting or asserting his discovery. *Emerson v. Hogg*, 2 Blatchf., 12, 13.—BERTS, J.; N. Y., 1845.

5. Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during his application for a patent, is an abandonment, or such a use as gives it to the public. The inventor may do this without vitiating his claim. *Sparkman v. Higgins*, 1 Blatchf., 209.—BERTS, J.; N. Y., 1846.

6. Whether the sale and manufacture for some few months before the application for a patent, of an article, as an ornamental button, for the design of which letters patent had been granted, and which design was apparent on the article itself, would amount to an abandonment, is a question of fact to be settled by the jury. *Booth v. Gareilly*, 1 Blatchf., 249, 250.—NELSON, J.; N. Y., 1847.

7. Where experiments as to an invention were imperfect and unsatisfactory, and subsequently the inventor threw aside his temporary model, and wholly neglected for years to follow up his experiments, so as to produce a perfect machine, *Held*, that such acts afforded strong and decisive evidence of an abandonment of the thing as a failure. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

8. Abandonment or dedication is in the nature of a forfeiture of a right which the law does not favor, and it should be made out beyond all reasonable doubt. *Pitts v. Hall*, 2 Blatchf., 238.—NELSON, J.; N. Y., 1851.

9. Those who rely upon the ground that a party has forfeited a legal right, secured to him in due form of law, for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily, beyond any reasonable doubt or hesitation; because the law does not favor an abandonment, and throws upon a party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. *McCormick v. Seymour*, 2 Blatchf., 256.—NELSON, J.; N. Y., June, 1851; S. C., MS., Oct., 1851.

10. The question of abandonment must always depend in a great measure on the peculiar nature of the subject

FRAUDULENT INTENT.

INFRINGEMENT.

matter. The mere sale of a peculiar manufacture—as vulcanized rubber—which does not, on its face, disclose the nature of the compound, or the mode of producing it, is not such an abandonment. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

11. A patentee, subsequent to his patent, may abandon his invention to the public, and waive the exclusive privileges secured to him; and the jury may infer such an abandonment from an acquiescence in the use of his invention by others—a neglect to assert his claims by suit or otherwise, an omission to sell licenses, a neglect to make efforts to realize any advantage from his patent, and similar circumstances. *Ransom v. Mayor, &c.*, 1 Fisher, 273.—HALL, J.; N. Y., 1856.

2. *Fraudulent Intent.*

1. The degree of evidence required to prove a fraudulent intent in a defective specification rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances—as if the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic skilled in the art could reasonably be expected to understand the subject so as from the description given to make the machine. But such a presumption would be weakened by the testimony of skilful persons that they could not hesitate in supplying the omissions. *Gray v. James*, Pet. C. C., 402.—WASHINGTON, J.; Pa., 1817.

2. Under the act of 1793, if a defendant seeks to annul the patent, he must proceed in precise conformity to § 6, and fraudulent intent “must be found by the jury to justify a judgment

of *vocatur* by the court.” The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in § 6. *Grant v. Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. Under § 9 of the act of 1837, declaring a patent valid, though embracing something not the invention of the patentee, if such excess has been inserted in the specification by mistake, and without any fraudulent intent, the patentee is not bound to prove affirmatively that such excess was inserted by mistake, and without a fraudulent intent, as the law presumes no one to have acted illegally or fraudulently. *Hotchkiss v. Oliver*, 5 Denio, 318.—McKISSECK, J.; N. Y., 1848.

4. The party charging the wrong and attacking the patent, is bound to prove the fraud, &c. *Ibid.*, 318.

3. *Infringement.*

See also COMBINATION, B.; COMPOSITION OF MATTER, C.; INFRINGEMENT.

1. In an action for the infringement of a patent testimony is not admissible on the part of the plaintiff, that the persons of whose prior use defendant had given evidence, had taken licenses from the plaintiff. *Evans v. Eaton*, Pet. C. C., 523.—WASHINGTON, J.; Pa., 1816. [Overruled, *post* 2.]

2. It is competent for the plaintiff to introduce testimony to show that the persons, of whose prior use of the machine defendant had given evidence, had paid the patentee for licenses to use his machine, though such testimony is entitled to but little weight. *Evans v. Eaton*, 3 Wheat., 505.—MARSHALL, C. J.; Sup. Ct., 1818.

INFRINGEMENT.

3. In an action for infringement of a patent, evidence is not admissible on the part of the patentee that third persons had offered to take licenses of him, it not having been shown that such person used a machine similar to that of the patentee. *Evans v. Hettick*, 3 Wash., 413.—WASHINGTON, J.; Pa., 1818.

4. Under the plea by the defendant of not guilty, the plaintiff must prove not merely that the defendant had made, used, or sold an article of the same general nature with his patented invention, but that it substantially resembled the one for which he had so obtained a patent. But if the difference between them be only in form, or proportions, they are the same in legal contemplation. *Dixon v. Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

5. The plaintiff must show that the infringement took place after the time of his application, or the date of his patent. But if the defendant attempts to avoid the patent by showing that the patentee was not the original discoverer of the thing patented, the patent will be considered as reverting back to the time of the original discovery. *Ibid.*, 72.

6. In an action for an infringement of a patent, evidence that the invention of the defendant is better than that of the plaintiff is inadmissible, except so far as it goes to show a substantial difference between the two. *Alden v. Dewey*, 1 Story, 337.—STORY, J.; Mass., 1840.

7. To show an infringement by the defendant the proof rests upon the plaintiff. *Brooks v. Bicknell*, 3 McLean, 453.—MCLEAN, J.; Ohio, 1844.

8. To show an infringement, the burden of proof is upon the plaintiff.

To maintain his case he must show that there has been a substantial invasion of his patent by the defendant. *Washburn v. Gould*, 3 Story, 146.—STORY, J.; Mass., 1844.

9. Where a plaintiff has made out a *prima facie* case of infringement, and the defendant undertakes to make out a special defence, as that the invention had been used at different places before plaintiff's invention, it is proper to instruct the jury that the defendant, in respect to these particulars, must render them probable, and must turn the scales in his favor. *Allen v. Blunt*, 2 Wood. & Min., 145.—WOODBURY, J.; Mass., 1846.

10. In order to make out the fact of infringement, the plaintiff must prove that the defendant has used his invention, either in the precise form in which it is constructed, or in a form and on principles substantially the same. *Parker v. Stiles*, 5 McLean, 62.—LEAVITT, J.; Ohio, 1849.

11. It is not, however, necessary that the structure or machine used by the defendant should be the same in appearance, form, or proportions, as that invented and patented by the plaintiff. If the operative principles of the two machines be the same, the substantial identity contemplated by the patent law is established. *Ibid.*, 62, 63.

12. Where the defence that a machine claimed to be essentially similar to that of the plaintiff's is set up, and the proof relied on is a description of such machine, contained in a written publication, such description must be sufficiently full and precise to enable a mechanic to construct it, and must be in all material respects like that covered by, or described in the plaintiff's patent. Proof of a previous structure, bearing some re-

INVENTION; AND ORIGINALITY AND PRIORITY OF.

semblance in some respects to the plaintiff's improvements, and which might have been suggestive of ideas, or led to experiments resulting in the discovery and completion of his invention, will not invalidate his patent. *Parker v. Stiles*, 5 McLean, 61, 62.—LEAVITT, J.; Ohio, 1849.

13. The burden of proof is upon the plaintiff to show that there has been an infringement. *Johnson v. Root*, 1 Fisher, 364.—SPRAGUE, J.; Mass., 1858.

14. It is incumbent upon the plaintiff in an action for an infringement of a patent to make out affirmatively to the satisfaction of the jury that his invention has been infringed, before he is entitled to a verdict. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

4. *Invention; and Originality and Priority of.*

1. The declarations of an inventor, at a particular time, that he had discovered and constructed the machine patented, and the parts of which he then described are admissible to prove, not that he was the discoverer, but that he then asserted that he was, and described his invention. *Evans v. Hettick*, 3 Wash., 410.—WASHINGTON, J.; Pa., 1818.

2. In an action of infringement letters of the plaintiff to the Patent Office, containing his application for a patent, and enclosing a specification substantially agreeing with his patent afterward issued, and asserting his claim as inventor to the invention described, are properly admissible in evidence to show the existence of such facts. *Pettibone v. Derringer*, 4 Wash., 216, 219.—WASHINGTON, J.; Pa., 1818.

3. In an action for a violation of

plaintiff's patent, proof that the plaintiff at a certain time had made the thing patented, and which had never before been seen or heard of by the witnesses, is *prima facie* evidence that it was invented by the patentee, until other evidence is given to show it had been previously known. *Pennock v. Dialogue*, 4 Wash. 541.—WASHINGTON, J.; Pa., 1825.

4. The silence, however, of such party as to his claim of original invention at such time may be opposed to such evidence, but whether it will be sufficient to outweigh it, the jury are to decide *Ibid.*, 542.

5. The testimony of a witness that he had seen before plaintiff's invention articles resembling those produced by plaintiff's invention, but had no knowledge how they were made, is not sufficient evidence to invalidate plaintiff's patent, on the ground that he was not the original discoverer of the invention, or that the same had been in use before his invention, unless the jury can safely conclude from the appearance of such articles that they were made by an instrument having the improvement, or embodying the principle of plaintiff's patent. *Treadwell v. Bladen*, 4 Wash., 706 —WASHINGTON, J.; Pa., 1827.

6. The priority of knowledge and use of an invention is a question of fact, which a jury may decide from one witness; the question is on the credibility and not on the number of witnesses. *Whitney v. Emmett*, Bald., 310.—BALDWIN, J.; Pa., 1831.

7. In considering the question of originality the oath of the inventor, made prior to the issue of the letters patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness, offered to show that the invention was not original. *Alden*

v. *Dewey*, 1 Story, 339, 341.—STORY, J.; Mass., 1840.

8. The declarations and conversations of a patentee, stating that he had made an invention, and describing it and its operations, are evidence of an assertion of his right at that time to the extent of the details made known by him, though not of their existence at any former period. *Phil. & Tren. R. R. v. Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

9. The declaration of a party that at a certain time he had invented a certain thing is not evidence. *Cochrane v. Waterman*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1844.

10. Upon the question of priority of invention, it is for the defendant to show beyond a reasonable doubt that there was a prior invention, because the plaintiff has a right to rest upon his patent for his invention till its validity is overthrown. If there is a reasonable doubt as to the priority of invention, the patentee is entitled to the benefit of it.

Washburn v. Gould, 3 Story, 142.—STORY, J.; Mass., 1844.

11. The time of the invention of an improvement to a machine must necessarily precede the time when the invention is applied to a machine in operation. *Cundell v. Parkhurst*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

12. Priority of application for a patent does not decide priority of invention. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

13. In a question as to the originality of an invention, where one party has a patent, the proof of want of originality must be specific and decisive to overthrow such patent. *Troy Iron & Nail Fac. v. Corning*, 1 Blatchf., 472.—NELSON, J.; N. Y., 1849.

14. When a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent at that time. *Parker v. Hulme*, 7 West. Law Jour., 424.—KANE, J.; Pa., 1849.

15. Where the patentee discovered, in 1827, that to direct water into a reaction wheel so as to give it circular motion within the wheel in the direction of its rotation, would increase the useful effect, and the application then was to a horizontal wheel, and after, in 1828, an application of this principle was made to a vertical wheel, and the latter arrangement was the one patented, *Held*, that if the difference of time had been material, the discovery of the more important part of the patented improvements would have been referred to the date of 1827. *Ibid.*, 424.

16. Dates in an account book, in which was made a drawing of an invention, are not conclusive evidence that the invention was made at the time of such dates. *Jillson v. Winsor*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

17. Proof that a drawing of an invention was shown by A at a certain time *before*, as to which, however, the witnesses were not positive, but without any model, and without proof that any articles were manufactured until long *after* the well established invention of the same thing by B, is not sufficient to establish priority of invention in A. *Ibid.*

18. A defendant in a patent suit, using a machine patented to him will have the benefit of a like presumption in his favor, as to the originality of his invention, as the plaintiff has by reason

INVENTION; AND ORIGINALITY AND PRIORITY OF.

of his patent. *Corning v. Burden*, 15 How., 271.—GRIER, J.; Sup. Ct., 1853.

19. A witness to prove priority of invention need not be an expert—it will be sufficient if he has knowledge and memory to enable him to state truly what he had seen and heard. *N. E. Screw Co. v. Sloan*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

20. As respects the subjects of novelty and invention, the difference between the English and American cases relates rather to the kind and degree of evidence by which these may be shown or established. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

21. The English cases hold that the *result alone*, when the effects produced are more economical, useful, and beneficial, or a better article, is a conclusive test of novelty and invention; while the American cases go to show that the *result alone* will not be sufficient, but it must appear that the effect was produced by some new process, device, machinery, &c., though where an improved result or effect is produced, slight evidence only of novelty and invention will be required. *Ibid.*

22. But slight evidence of invention is required when it is shown in what the invention consists, and proof is given of its practical utility, this being the main and principal test. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

23. The measure of proof requisite to show the date of an invention, depends upon the nature of the invention, whether complicated or not, the capacity of the witnesses, the distance of time when the facts occurred. *Stephens v. Salisbury*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

24. Verbal descriptions, without models or drawings, may be sufficient for such purpose. *Ibid.*

25. The patent is *prima facie* evidence that the plaintiff was the first and original inventor of the improvement claimed, and of its utility. *Winans v. N. Y. & Harlem R. R.*, 31 Jour. Fr. Inst. (3d Ser.), 320.—NELSON, J.; N. Y., 1855.

26. A caveat is evidence as to an invention, so far as it extends to the *description* of the invention, and the machinery which was then constructed. *Jones v. Wetherell*, MS. (App. Cas.)—MORSELL, J.; D. C., 1855.

27. A patent is *prima facie* evidence of the facts of first and original invention and utility, and must prevail, unless there is other evidence to overcome such *prima facie* presumption; and where there has been a renewal, such renewal is also *prima facie* evidence as to such matters, and of course adds weight to the *prima facie* evidence furnished by the original patent. *Ransom v. Mayor &c.*, 1 Fisher, 258.—HALL, J.; N. Y., 1856.

28. The patent raises a presumption of the originality of the invention. *Bell v. Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

29. The question of priority of invention is for the jury to determine. *Bartholomew v. Sawyer*, MS.—INGERSOLL, J.; N. Y., 1859.

30. The patent is *prima facie* evidence that the patentee is the first and original inventor of the improvements described. *Cahoon v. Ring*, 1 Fisher, 403.—CLIFFORD, J.; Me., 1859.

31. Where original drawings of an invention were made, they are the best evidence of such invention, and on the non-production of them, unless le-

INVENTION, NOVELTY AND UTILITY OF.

gally accounted for as by being lost, the legal presumption is, that if produced they would show the facts to be unfavorable. *Beech v. Tucker*, MS. (App. Cas.)—MORSELL, J. ; D. C., 1860.

32. The *prima facie* force of a patent, as to priority of invention on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. *Barstow v. Swan*, MS. (App. Cas.)—MERRICK, J. ; D. C., 1860.

33. Time, as to an invention, cannot, any more than a straight line be measured by the senses, by regarding its continuity, but is fixed in the memory by the relation or succession of events. When, therefore, a person can affirm that he can and does recall the succession of an event to another, which other is susceptible of independent ascertainment, the certainty of the latter is fully reflected upon the former. *Sherwood v. Sherman*, MS. (App. Cas.)—MERRICK, J. ; D. C., 1860.

34. It is not proof of the want of originality or novelty in an invention for which an American citizen has obtained a patent, that it may have been known or used in a foreign country, unless it appears that the invention or improvement was patented in such foreign country, or there described in some public work. *Judson v. Cope*, 1 Fisher, 623.—LEAVITT, J. ; Ohio, 1860.

35. But to make such a defence available, it must appear that the improvement which has been known in a foreign country has been so clearly and intelligibly described, that the invention could be made or constructed by a competent mechanic. A mere suggestion or imperfect description of an invention would

not be sufficient to defeat the American patent. *Ibid.*, 623.

36. Evidence cannot be received of actual use and knowledge of an invention in a foreign country, prior to the time of the invention here, in order to defeat the American patent, but the defendants must be confined to the description of the invention as found in printed publications or patents ; they cannot go beyond such publication or patents, because no prior use abroad, unless the invention has been described in a printed publication or has been patented, will affect the validity of the patent in this country. *Ibid.*, 617-18.

37. The mere fact that a party is a witness to the application of another for a patent for a particular invention, does not estop such party from afterward claiming to be himself the original inventor of such invention. *Herring v. Leffingwell*, MS. (App. Cas.)—DUNLOP, J. ; D. C., 1861.

38. It is competent for such party to show that he was deceived as to the character of the paper he was witnessing, and if his signature was obtained by misrepresentation it will be treated as if it had never been made. *Ibid.*

5. *Invention, Novelty and Utility of.*

1. Whether an invention is new or not is a question for the jury. *Park v. Little*, 3 Wash., 197.—WASHINGTON, J. ; Pa., 1813.

2. Of the novelty and utility of an invention the patent is to be considered only as *prima facie* evidence of a very slight nature. *Lowell v. Lewis*, 1 Mas., 185.—STORY, J. ; Mass., 1817.

3. Where it becomes a matter of inquiry whether the benefits of an invention are of sufficient consequence to be

protected, it is proper to leave the question of utility to the jury. *Langdon v. De Groot*, 1 Paine, 204.—LIVINGSTON, J.; N. Y., 1822.

4. But when the invention on the plaintiff's own showing is not only of no use, but an imposition on the public, it may be doubted whether a court would transcend its powers to consider and decide upon the question of utility as matter of law. *Ibid.*, 204.

5. Where the defendant had advertised the plaintiff's invention as one of the most useful, and had published certificates of its great utility, *Held*, in an action of infringement against him, that he could not deny the utility of the invention, and that it was unnecessary for the plaintiff to introduce evidence other than such admissions. *Stanley v. Whipple*, 2 McLean, 39.—MCLEAN, J.; Ohio, 1839.

6. To determine whether an invention is new, the jury may inquire whether the machines had been extensively built and used, or whether they had been tried and thrown away; and if they had been extensively used, whether this could happen if their mode of operation was not new. *Davoll v. Brown*, 3 West. Law Jour., 151.—WOODBURY, J.; Mass., 1845.

7. The presumption of novelty and usefulness, arising from the *prima facie* character of the patent, may be rebutted by affidavits, on the application for an injunction where the patent is not ancient. *Query*, Whether it may be when the patent has been (reissued) renewed under the act of 1836. *Wickershaff v. Jones*, 2 Wharton's Dig., 413.—KANE, J.; Pa., 1848.

8. The oath of the patentee, required upon his application for a patent, constitutes a part of the letters patent, and

is in evidence to a jury, and forms a legal ground for the presumption of the novelty and utility of the patentee's claim until the contrary is proved; the burden of proof being on the defendant. *Parker v. Stiles*, 5 McLean, 60.—LEAVITT, J.; Ohio, 1849.

9. It is the province of the court to decide what constitutes novelty, and of the jury to determine from the evidence adduced, whether the patentee's invention is new. *Ibid.*, 60.

10. An invention must be to some extent useful. But courts are not rigid or strict on this point. In the absence of proof by the defendant, that the thing patented is absolutely frivolous and worthless, the presumption of utility raised by the patent itself is sufficient to sustain the patent. *Ibid.*, 62.

11. Where in an action for an infringement of plaintiff's patent, it was proved that a machine was constructed before the plaintiff's invention, and identical with it, for a person who lived some distance from the place of construction, and was taken away by him to be put up, and was never afterward seen by the witness, who assisted in its construction, *Held*, that the evidence, if believed, was sufficient to establish the fact of a want of novelty in the plaintiff's invention, though there was no proof to show that the prior machine was ever used. *Parker v. Ferguson*, 1 Blatchf., 408.—NELSON, J.; N. Y., 1849.

12. A patentee took a patent for a new process, mode, or method of converting puddler's balls into blooms in rolling mills, which consisted in rolling the ball between reciprocating plates or tables, or between a revolving cylinder, and a stationary curved segmental trough. Evidence was given of previ-

ous use of machines for milling and condensing the edges of coin and buttons, precisely like plaintiff's reciprocating tables, and also of other machines for similar uses; and of a machine for making bullets by pressure, which were like the revolving cylinder and curved segmental trough of plaintiff, except that the peripheries of both were grooved; *Held*, that such machines for making bullets and milling buttons and coin did not show a want of novelty in the patentee, because the process used in them, the purpose for which it was used, and the objects accomplished, were substantially different. *Burden v. Corning*, MS.—CONKLING, J.; N. Y., 1850.

13. The opinion of experts or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

14. It appearing that a mill for grinding bark constructed according to the specification would grind, when in not very rapid operation, a cord of bark an hour, and double the quantity that could be ground by the old mills, *Held*, that it was evidence enough of utility. *Wilbur v. Beecher*, 2 Blatchf., 137.—NELSON, J.; N. Y., 1850.

15. The novelty of an invention can be defeated by a prior use only by showing that such prior use accomplished the same result in the same manner. Hence, where a patent was for the application of the principle of the expansion and contraction of a metallic rod to regulate the heat of a stove, *by means of the heat produced by the stove itself*, it will not be defeated by showing a prior application of the expansion and contraction of such a rod, heated *indirectly* by the heat of the

furnace, by being immersed in hot water. *Foot v. Silsby*, 2 Blatchf., 266, 271.—NELSON, J.; N. Y., 1851.

16. But it is not necessary that such prior application should have been made by the very best apparatus that could be devised. The question does not depend on the *degree of usefulness*. If the application operated successfully, and so as to be practically useful, though it may not have been the very best, it will be sufficient. *Ibid.*, 274.

17. Under the act of 1793, a patent was not even *prima facie* evidence that the invention patented was new or useful; but under the act of 1836, a patent issued after the inquisition or examination, required by that act, is received as *prima facie* evidence of the facts asserted in it. *Corning v. Burden*, 15 How., 270, 271.—GRIER, J.; Sup. Ct., 1853.

18. Upon an application for a patent, the applicant cannot be required to furnish evidence of the practical result of his invention. To entitle an inventor to a patent, the invention need not be in use or reduced to actual practice otherwise than by a model, drawings, and specification containing a written description of the invention, and of its manner of operation. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

19. And it is enough if it is capable of use, for some beneficial purpose; the degree of utility, whether larger or smaller, is not a subject of consideration. *Ibid.*

20. According to the American cases, the result alone, when the effects produced are more economical, useful, and beneficial, or a better article, is not conclusive evidence of the novelty of an invention, but it must appear that the re-

INVENTION, NOVELTY AND UTILITY OF.

sult is produced by some new process, device, or machinery, though in such case but slight evidence of novelty will be required. *Yearsley v. Brookfield*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

21. Under the English cases, the result alone, under like circumstances, is conclusive evidence of invention. *Ibid.*

22. The jury are to determine from the facts in the case as to the novelty of the invention. *Battin v. Taggart*, 17 How., 85.—MCLEAN, J.; Sup. Ct., 1854.

23. The fact of the use of a patented invention by a defendant, is evidence of its utility, and will subject such person to damages. *Simpson v. Mad. Riv. R. Co.*, 6 McLean, 604.—MCLEAN, J.; Ohio, 1855.

24. The patent is *prima facie* evidence of the novelty of the thing patented. *Teese v. Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

25. Whether there is any novelty in an invention or arrangement of parts, is a question of fact for the jury to determine, upon a view of all the evidence in the case. *Sickles v. Borden*, 3 Blatchf., 540.—NELSON, J.; N. Y., 1856.

26. A patent, when introduced in evidence, whether it be an original or re-issued one, is *prima facie* evidence that the thing granted was new and useful, and that the patentee was the inventor or discoverer thereof. *Serrell v. Collins*, MS.—INGERSOLL, J.; N. Y., 1857.

27. A foreign patent is only *prima facie* evidence, as a patent granted by our own government, that the invention was of some probable value. *Gatling v. Newall*, 9 Ind., 582.—PERKINS, J.; Ind., 1857.

28. The report of a committee of a state fair, as to an invention, is not admissible as to the utility of the inven-

tion, as being but hearsay evidence. *Ibid.*, 582.

29. A medal awarded by an incorporated body, as the *American Institute of New York*, is evidence of the same character as to utility. *Ibid.*, 582.

30. A patent is *prima facie* evidence that the thing described in it is new, and must control the question, unless countervailed by the defendant's evidence. *Waterbury Brass Co. v. N. Y. & B. Brass Co.*, 3 Fisher, 48.—INGERSOLL, J.; N. Y., 1858.

31. A patent is *prima facie* evidence that the grant of right in it is valid; that the things described in it are new and useful; that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect, unless rebutted by sufficient countervailing evidence. *Potter v. Holland*, 4 Blatchf., 242.—INGERSOLL, J.; Ct., 1858.

32. A patent is *prima facie* evidence that an invention is new and useful. *Poppenhausen v. N. Y. G. P. Comb. Co.*, 2 Fisher, 67.—INGERSOLL, J.; N. Y., 1858.

33. The fact that a defendant has used the thing patented, is very strong evidence as to the utility of the thing patented; if it is not useful, why does he use it? *Ibid.*, 69.

34. The degree of the utility of an invention, is not a matter of consideration. If it was useful at the time the patent was granted, the patent is valid; that it has become useless by the discovery of some other method dispensing with it, gives no other person the right to use it. *Ibid.*, 72.

35. But if the invention is useless as to the particular thing used by defendants, they are not liable. *Ibid.*, 72.

36. The patent raises the presumption

of novelty and utility, but courts will not be very rigid in inquiring as to the *degree* of such utility. *Bell v. Daniels*, 1 Fisher, 375.—LEAVITT, J.; Ohio, 1858.

37. The patent itself affords *prima facie* evidence of utility; but the defendant may rebut this presumption by evidence, and if he makes it appear that the invention is utterly worthless, it is a good defence. *Vance v. Campbell*, 1 Fisher, 485.—LEAVITT, J.; Ohio, 1859.

38. There is a presumption arising from the patent itself in favor of the novelty of the invention which it covers. But this presumption may be overcome by showing that the thing had been previously known. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

39. There is a presumption arising from the patent, that the invention is of some degree of utility; but this is not conclusive, and defendant may show that it is useless and worthless. *Lee v. Blandy*, 2 Fisher, 95.—LEAVITT, J.; Ohio, 1860.

40. A greater degree of utility being achieved by one machine is evidence, sometimes conclusive, of novelty in the means or instrumentalities used. *Eames v. Cook*, 2 Fisher, 149.—SPRAGUE, J.; Mass., 1860.

41. In an action for infringement where there is doubt upon the question of novelty, or where the evidence of the witnesses leave it uncertain, the plaintiff may offer evidence going to show that his invention in its practical operation produces results never before produced, and that it is superior to other inventions of the same character. Such evidence, though perhaps inadmissible if offered by the plaintiff as to the question of *utility*, may still be received, as helping to lead the jury to just conclusions upon the question of *novel-*

ty. Judson v. Cope, 1 Fisher, 624.—LEAVITT, J.; Ohio, 1860.

42. In other words, if the jury are satisfied that the invention patented produces a result decidedly and clearly different from any which had been produced by the action of former inventions designed for like uses, and that it was decidedly superior in its operation, it would afford ground for the presumption that the thing itself had not been known before. *Ibid.*, 624.

43. As to the point whether an invention furnishes either a new article or a better or *cheaper* one, it seems that the testimony of competent, disinterested witnesses, who are practical persons, and capable of judging as to the matter in issue, will be received, and are entitled to credit as to whether the invention is better or cheaper. *Arthur, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

44. As to the novelty and utility of an invention, the testimony of disinterested, competent witnesses experienced in the invention will be received, and, it seems, will overcome apparent resemblances to other inventions. *Hoyt, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1860.

45. Upon the application for a patent, the testimony of practical men as to the utility of the invention is entitled to consideration. *Hayden, Ex parte*, MS. (App. Cas.)—MERRICK, J.; D. C., 1860.

EXAMINERS OF PATENT OFFICE.

1. The officer of the Patent Office, who may attend before the judge on an

OFFICIAL POSITION AND DUTIES OF.

SALE OF PATENTS AND COPYRIGHTS UNDER.

appeal, under the provisions of § 11 of the act of 1839, is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

2. The examiners in the Patent Office are only the assistants of the Commissioner in the discharge of his duties, and cannot be constituted a “board of examiners,” with power to affirm or reverse the decision of the Commissioner. The Commissioner cannot transfer to them his power. *Aiken, Ex parte (Propeller)*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

3. On an appeal to the justices of the Circuit Court of the District of Columbia, an examiner of the Patent Office may be inquired of as to the nature and features of the invention under consideration, and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. *Seeley, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

4. The provisions of § 11 of the act of 1839 as to the examination, on appeal, of the Commissioner or examiners of the Patent Office on appeals, must be considered in connection with the provision in § 7 of the act of 1836, as to the powers of the old board of examiners. *Richardson v. Hicks*, MS. (App. Cas.)—MORSELL, J., D. C., 1854.

5. The language of the statute means that the explanation authorized to be required of the Commissioner and examiners may be so full and clear an explanation of the *principles* of the thing as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be

limited to a mere exposition of the terms used, and such explanations, so given, the judge is bound to respect as a part of the case. *Ibid.*

6. Previous to the act of March 2d, 1861, all judicial acts done in the Patent Office by the primary examiners or the board of appeals were, in intendment of law, the judicial acts of the Commissioner, and had no legal validity until sanctioned by him. They were the organs of the Commissioner to *inquire and enlighten* his judgment, and till the Commissioner gave validity to their judicial acts by his *fiat*, they had no legal evidence as judgment. *Snowden v. Pierce*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1861.

7. Under the act of 1861, the primary examiners and examiners in chief are recognized as *judicial officers*, acting independently of the Commissioner, who can *only control them* when their judgment in due course, comes before the Commissioner on appeal. *Ibid.*

8. Their acts are not the acts of the Commissioner, but their own acts. They are no longer *mere* organs of the Commissioner, but independent officers. He can only reach and overrule them when their judgments come regularly before him *on appeal*. *Ibid.*

9. The Commissioner can give no judgment till the appeal reaches him, and this cannot be done till the judgment of the primary examiners has been submitted to the examiners in chief. *Ibid.*

EXECUTION, SALE OF PATENTS AND COPYRIGHTS UNDER.

1. The levy and sale, under an execution, of the *materials* of a patented

machine, does not convey to the purchaser any right to use the machine in the manner pointed out in the patent. *Sawin v. Guild*, 1 Gall., 487. STORY, J.; Mass., 1813.

2. An author, who has obtained a copyright under the act of Congress cannot be deprived, against his will, and in favor of his creditors, of any of the rights secured to him by such acts; and possibly they cannot, against his will, seize and sell the books themselves, the exclusive right of vending which is vested in him. *Cooper v. Gunn*, 4 B. Mon., 596.—MARSHALL, J.; Ky., 1844.

3. But this protection does not extend to the proceeds of the sale of his copyright, whether existing in his own hands or held by another for his use. *Ibid.*, 596.

4. A patented machine, and the right of use attached to it, may pass, by sale, devise, or levy of execution, or assignment of an insolvent's effects. *Woodworth v. Curtis*, 2 Wood. & Min., 530.—WOODBURY, J.; Mass., 1847.

5. The incorporeal right, copyright, secured by the statute to the author, being intangible and secured by grant, is not the subject of seizure or sale by execution, at least at common law; but it may be reached by a creditor's bill, and be applied to the payment of the debts of the author. *Stephens v. Cady*, 14 How., 531.—NELSON, J.; Sup. Ct., 1852.

6. It may however be doubted whether a transfer by a sale under a decree of court would pass the title so as to protect the purchaser, unless by a conveyance, in conformity with the requirements of the statute. *Ibid.*, 532.

7. The sale of a copper-plate of a map, on an execution against the owner of the copyright, does not carry with

it, or pass to the purchaser, the right to print and publish the map engraved upon it. *Ibid.*, 532.

8. It may well be doubted whether patents and copyrights, held under the laws of the United States, are subject to seizure and sale on execution; such incorporeal rights do not exist in any particular state or district, but are co-extensive with the United States. *Stevens v. Gladding*, 17 How., 451.—CURTIS, J.; Sup. Ct., 1854.

EXPERIMENTS.

1. It is clearly immaterial whether experiments as to an invention are made by the inventor himself or by others; the question being, who is the original inventor. *Pennock v. Dialogue*, 4 Wash., 542.—WASHINGTON, J.; Pa., 1825.

2. A patentee may take a reasonable time to try experiments with his invention, even of a public nature, when its character requires it, without invalidating his patent under § 6 of the act of 1793. *Whitney v. Emmett*, Bald., 310.—BALDWIN, J.; Pa., 1831.

3. Whoever first perfects a machine and makes it capable of useful operation, is entitled to a patent, and is the real inventor, though others may have previously had the idea, and made some experiments toward putting it in practice. *Washburn v. Gould*, 3 Story, 133.—STORY, J.; Mass., 1844.

4. *Semble*, that he would be entitled to a patent, although the antecedent experiments of others were known to and used by him in perfecting his machine. *Ibid.*, 133.

5. Though others may have had the

idea of a machine, and made experiments toward putting it into practice, the person who finally perfects it, and renders it capable of useful operation, is entitled to a patent. *Ball v. Murry*, 10 Penn, 112.—ROGERS, J.; Pa., 1848.

6. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor, who has perfected his improvement and obtained his patent. *Parkhurst v. Kinsman*, 1 Blatchf., 494.—NELSON, J.; N. Y., 1849.

7. In order to entitle a person to the character of an inventor, and his invention to become the subject of a patent, he must not stop at unsuccessful experiments, but continue until he has brought out a machine producing a useful result, and without this his invention will be worthless to the community, and undeserving the protection of the law. *McCormick v. Seymour*, MS.—NELSON, J.; N. Y., 1851.

8. A patentee or an inventor has a right to try his machine, and continue his experiments until he has perfected his improvement. *Ibid.*

9. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiment, when some new compound, art, manufacture, or machine, has been thus produced which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent. *Goodyear v. Day*, 2 Wall, Jr., 299.—GRIER, J.; N. J., 1852.

10. An imperfect and incomplete invention, resting in mere theory, or an intellectual notion, or in uncertain experiment, and not actually reduced to

practice, and embodied in some distinct machinery, apparatus or the like, is not patentable under our laws. *Marshall v. Mee*, MS. (App. Cas.)—DUNLOP, J.; D. C., 1853.

11. A long course of *mere fruitless* experiments to reduce a principle to practice, will not be sufficient to prevent a subsequent, original inventor, who has perfected his invention, without knowledge of the prior invention, from receiving a patent. *McCormick v. Ketchum*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

12. But where a prior inventor has been using due diligence to perfect his invention, and adapt it to practical use, his right will be preserved and protected, although his success may not be perfect. *Ibid.*

13. A machine, in order to anticipate any subsequent discovery, must be perfected, that is, made so as to be of practical utility; and not to be merely experimental, and end in experiment. Until of practical utility, the public attention is not called to the invention; it does not give to the public that which the public lays hold of as beneficial. *Howe v. Underwood*, 1 Fisher, 166.—SPRAGUE, J.; Mass., 1854.

14. If an invention is an experiment only, and ends in experiment, and is laid aside as unsuccessful, however far it may have been advanced, however many ideas may have been combined in it, which, subsequently taken up, might, when perfected, make a good machine, still not being perfected, it has not come before the public as a useful thing, and is therefore entirely inoperative as affecting the rights of those coming afterward. *Ibid.*, 166.

15. Where a person is engaged in producing some new and useful instru-

ment or contrivance, and has embodied it into a machine, and endeavored to reduce it to practice by experiment—if those trials fail—if he fail in success and abandon it, and give it up, that consideration affords no impediment to another person who has taken up the same idea, or class of ideas, and who has gone on perseveringly in his studies, trials, and experiments, until he has perfected the new idea, and brought it into practical and useful operation. He is the person, the meritorious inventor, who is entitled to the protection of the law.

Winans v. N. Y. & Har. R.R., 31 Jour. Fr. Inst., 3d Ser., 322.—NELSON, J.; N. Y., 1855.

16. If a person having some vague idea of a principle, make numerous trials and experiments, if those trials and experiments do not result in such a knowledge upon his part as enables him to put in successful practice the idea of which he has such vague notion, he does not become an inventor in the sense of the patent law. *Ransom v. Mayor, &c.*, 1 Fisher, 270.—HALL, J.; N. Y., 1856.

17. Such a person has never embodied the principle so as to make it available for practical use; and the party who embodies the principle and makes it available for practical use, is the party who is entitled to a patent, and to protection. *Ibid.*, 270-271.

18. An unsuccessful experiment abandoned, although involving the same idea or principle, will not invalidate a patent granted to a subsequent inventor who has reduced the invention to successful practice, and published it by obtaining letters patent. *Ibid.*, 270.

19. The use of a patented invention as a matter of business, and the product of which is thrown into market for the

purpose of being sold, cannot be called experimental, but is such a use as will make the party liable. *Poppenheusen v. N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

20. Experiments made, equivocal in their results, and given up for years, will not be permitted to prevail against an original inventor who has reduced his invention to practice, and has without fraud obtained a patent. *Ellithorpe v. Robertson*, 4 Blatchf., 309.—INGERSOLL, J.; N. Y., 1859.

21. An experiment as to the production of a machine, which was unsatisfactory and had been abandoned, is not such an invention as entitles a person to the benefit of the patent laws. *Winans v. Danforth*, MS.—NELSON, J.; N. Y., 1860.

22. Where a person has attempted to invent a certain device, and after trial and experiment has in his own judgment failed and abandoned the experiment, this fact removes all impediments in the way of any future inventor who may follow in the same line. *Ibid.*

23. Experiments of another, even if known to a patentee, will not defeat the claims of such patentee to originality of invention, if it appear that such patentee has prosecuted such experiments to success. *Judson v. Moore*, 1 Fisher, 555.—LEAVITT, J.; Ohio, 1860.

24. Neither the patent law nor the decisions of our courts have fixed any precise period applicable to the experimental use of new inventions. The period for experiments must depend upon the nature of the invention, and the opportunities of the inventors. *Seeley v. Bean*, MS. (App. Cas.)—MORSELL, J.; D. C., 1861.

25. What would not constitute proper diligence under some circumstances,

TESTIMONY OF, WHEN ADMISSIBLE, AND FORCE OF.

when the experiments went over a few months, would not amount to abandonment under other circumstances, though the experiments might have gone over a number of years. *Ibid.*

26. The nature and extent of this right depends on circumstances, and must be used consistently with the policy, spirit, and nature of the patent laws requiring vigilance, and newness at the time of application for a patent. *Ibid.*

EXPERTS, TESTIMONY OF.

1. The opinions of skilful persons, whether the principles of two machines are the same, are competent evidence to be introduced in a patent cause. *Barrett v. Hall*, 1 Mas., 470.—STORY, J.; Mass., 1818.

2. But although the testimony of witnesses be admissible to prove the identity or diversity of machines in principle, yet, after all, it is but matter of opinion, and its weight must be judged of by all the other circumstances of the case. It is infinitely more satisfactory to ascertain, if it be possible, the precise differences and agreements; and when these can be subjected to the eyes, they almost supersede all the evidence of mere opinion. *Ibid.*, 471.

3. In actions for violation of patents, persons acquainted with the particular art to which the controversy relates, are usually examined for the purpose of pointing out and explaining to the jury the points of resemblance, or of difference, between the thing patented and that which is the alleged cause of the controversy; and the opinions of such witnesses, in relation to the materiality

of apparent differences, are always entitled to great respect. But after all, the jury must judge for themselves, as well upon the information so given to them, as upon their own view, where the articles, or models of them, are brought into court. *Dixon v. Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

4. It is competent to show by experts that there are material differences between an original and a reissued patent, and to explain what those differences are. *Phila. & Tren. R. R. v. Stimpson*, 14 Pet., 462.—STORY, J.; Sup. Ct., 1840.

5. Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. *Washburn v. Gould*, 3 Story, 138.—STORY, J.; Mass., 1844.

6. The opinions of professional men, are evidence as to matters which relate to their profession, and on such subjects only. And this rule applies to mechanics as well as to any other profession or business. *Brooks v. Bicknell*, 3 McLean, 447.—MCLEAN, J.; Ohio, 1844.

7. The patent acts look to two classes of persons, not only as competent, but as peculiarly appropriate witnesses, but for different purposes. 1. Artisans, or persons practically engaged in the trade, employment, or business of the particular branch of mechanics to which the patent-right applies, as to whether the specification sufficiently described the invention so that it could be constructed and used. And 2. Persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science, as to the questions of novelty of invention, or identity or diversity of mechanical apparatus,

and contrivances, and equivalents—and as to these questions, scientific mechanics are the very highest witnesses. *Allen v. Blunt*, 3 Story, 747–749.—STORY, J.; Mass., 1845.

8. The patent act contemplates two classes of persons as peculiarly appropriate witnesses in patent cases. 1st. Practical mechanics, to determine the sufficiency of the specification as to the mode of constructing, compounding, and using the patent; and 2d. Scientific and theoretic mechanics to determine whether the patented thing is substantially new in its structure and mode of operation, or a mere change of equivalents. The second is by far the higher and more important of the two. *Olcott v. Hawkins*, 2 Amer. Law Jour., N. S., 321.—MILLER, J.; Wis., 1849.

9. Great respect is due to the views and opinions of scientific individuals, and practical mechanics, on the question of the identity of different mechanical structures, as from their acquaintance with the elements of mechanical science, they are enabled satisfactorily to decide this question, while, to others, it might seem to be involved in obscurity and doubt. *Parker v. Stiles*, 5 McLean, 64.—LEAVITT, J.; Ohio, 1849.

10. The opinion of experts, or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. *Winslow, Ex parte*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

11. The opinions of scientific men upon topics within their own departments of knowledge, are especially desirable in patent cases, and when duly supported by reasonings founded on ascertained fact, are to be valued highly. *French v. Rogers*, 1 Fisher, 150.—GRIER, KANE, JJ.; Pa., 1851.

12. But it is a mistake to suppose that, even on a question of science, opinion can be dignified with the mantle of authority. Still less, when it assumes contested facts, or volunteers to aid in determining written instruments. *Ibid.*

13. Experts may be examined as to the meaning of terms of art, &c., on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments. *Corning v. Burden*, 15 How., 270.—GRIER, J.; Sup. Ct., 1853.

14. Models may be referred to as ocular demonstration of features connected therewith, and such demonstration, or evidence, will be more satisfactory than the opinion of experts in opposition thereto. *Bell v. Hill*, MS. (App. Cas.)—MORSELL, J.; D. C., 1854.

15. In patent cases, the mere opinions of experts, when not sustained by pointing out clearly the particulars of difference or coincidence between pieces of machinery constructed to produce the same results, and working out those results by means so nearly identical as to create a strong presumption of a common origin, will not afford very satisfactory proof that such opinions ought to be adopted by the Court. *U. S. Annunciator & Bell Tel. Co. v. Sanderson*, 3 Blatchf., 186.—BETTS, J.; N. Y., 1854.

16. In matters of science, a person cannot be considered as an expert unless he has a knowledge of the science involved. *Allen v. Hunter*, 6 McLean, 307, 308, 310.—MCLEAN, J.; Ohio, 1855.

17. In considering testimony, the jury are to give weight to it in proportion to the competency of the witnesses to judge of the matters sworn to. *Ibid.*, 310.

18. The testimony of a chemist, who has analyzed the ingredients of a com-

position of matters, and who testifies as to the result of such analyzation, is not matter of opinion, but of a fact demonstrated. *Ibid.*, 312.

19. Analysis is the only mode by which the human judgment can rest upon absolute certainty. There are but few questions which may be decided by the power of analysis, chemically or mathematically. But when this is done satisfactorily, truth is attained. *Ibid.*, 312.

20. Models are evidence superior to and unaffected by the interests or prejudices of partisans, or by the opinions (the reveries, they may often be called) of a class of men called experts; men as often skilled and effective in producing obscurity and error, as in the elucidation of truth. *McCormick v. Talcott*, 20 How., 409.—DANIEL, J.; Sup. Ct., 1857.

21. The statute defines the character of an expert, as one "*skilled in the art or science*" to which his opinion or judgment appertains, or in a business or art most nearly connected with that to which his judgment or opinion is applied. A practical operator, and not a scientific theorist is, properly speaking, such an expert. *Page v. Ferry*, 1 Fisher, 306.—WILKINS, J.; Mich., 1857.

22. In medical science, a physician is an expert; in navigation, a sailor. But the judgment of, either, if an expert, may be—*ought* to be—rejected by the jury, if they are satisfied it is unworthy of credence. *Ibid.*, 315.

23. Experts may be examined to explain terms of art, and the state of the art, at any given time, and may explain to the court and jury the machines, models, or drawings exhibited, and may point out the difference or identity of the mechanical devices involved in

their constuction. The maxim of "*cuique in sua arte credendum*," permits them to be examined to questions of art or science peculiar to their trade or profession. *Winans v. N. Y. & E. R. R. Co.*, 21 How., 100, 101.—GRIER, J.; Sup. Ct., 1858.

24. But they cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may however obtain information from them, if he desire it, on matters which he does not clearly comprehend. *Ibid.*, 101.

25. A witness in order to be competent to testify as to whether a specification contains a sufficient description of the invention, must be one *skilled in the art*: one not so skilled is not a fit person to determine as to the sufficiency of the description. *Poppenhausen v. N. Y. G. P. Comb Co.*, 2 Fisher, 70.—INGERSOLL, J.; N. Y., 1858.

26. Neither the testimony of witnesses generally, nor of professors, experts, or mechanics, can be received to prove what is the proper or legal construction of a patent. *Day v. Stellman*, 1 Fisher, 492.—GILES, J.; Md., 1859.

27. On questions of the mechanical difference of machines, the opinions of experts may be given in evidence; when they are qualified and free from bias, their testimony is entitled to great respect. *Morris v. Barrett*, 1 Fisher, 463.—LEAVITT, J.; Ohio, 1858. *Latta v. Hawk*, *Ibid.*, 470.—LEAVITT, J.; Ohio, 1859.

28. In general, witnesses testify only as to facts, from which the jury form their opinion. But there are various classes of cases which depend upon the knowledge of a peculiar art or science for their solution, requiring a peculiar knowledge, in order to form a satisfac-

tory judgment of the question involved; in such cases the law allows testimony to be given from those skilful in the particular art, science, or profession, and permits them to give their opinions as results which they arrive at from an examination of the questions of fact that are before the jury. *Johnson v. Root*, 1 Fisher, 361.—SPRAGUE, J.; Mass., 1858.

29. The jury should not, however, allow themselves to be bound by such opinions. They are only introduced to aid. The opinion of an expert is to be considered like that of any professional man; reference being had to his ability, the fairness of the opinion, its impartiality, and the reasons assigned for it. *Ibid.*, 361.

30. The testimony of experts is to be received implicitly, only on points of a really scientific kind; and the persons offered as experts must be really men of science. Even in matters which are of a scientific nature, the court and jury will exercise their own intelligence to a certain degree, the matters of science involved not being of a recondite nature. *Livingston v. Jones*, 3 Wall. Jr.—GRIER, J.; Pa., 1861.

EXTENSION OF LETTERS PATENT.

A. WHO MAY APPLY FOR AND OBTAIN; IN WHAT CASES.....	319
B. POWER OF COMMISSIONER ON APPLICATION FOR; CONCLUSIVE NATURE OF ACTION OF.....	320
C. RIGHTS OF ASSIGNEES AND OTHERS IN EXTENSION.....	321
D. AUTHORITY AND FORCE OF EXTENDED PATENT.....	327
E. EXTENSION BY SPECIAL LAWS, AND RIGHTS UNDER.....	328

A. WHO MAY APPLY FOR AND OBTAIN; IN WHAT CASES.

1. Under § 18 of the act of 1836, the Board of Commissioners appointed to grant an extension of a patent, may allow such extension to the legal representatives of a patentee upon their application, in the same manner as though the application had been made in the lifetime of the patentee. *Nyman's Case*, 3 Opin., 446.—GRUNDY, Atty. Gen., 1839.

2. An administrator or executor may make the application for the extension of a patent where the grantee is dead, and the patent may lawfully be extended on such an application. *Van Hook v. Scudder*, MS.—THOMPSON, J.; N. Y., 1843. [Cited in 3 Story, 132, and 3 McLean, 438.]

3. If a patentee is dead, his administrator may apply for and obtain an extension of the patent, under the provisions of § 18 of the act of 1836. *Brooks v. Bicknell*, 3 McLean, 258-260.—MCLEAN, J.; Ohio, 1843.

4. The administrator of a deceased patentee may apply for and obtain a renewal of his patent. *Brooks v. Bicknell*, 3 McLean, 436, 438.—MCLEAN, J.; Ohio, 1844.

5. An extension of a patent may be taken out by an administrator of a deceased patentee. *Washburn v. Gould*, 3 Story, 133, 137.—STORY, J.; Mass., 1844.

6. An administrator is competent to apply for and receive a renewal or extension of a patent. *Woodworth v. Sherman*, 3 Story, 172.—STORY, J.; Mass., 1844.

7. The provisions of § 18 of the act of 1836 as to extensions is not limited

to cases of renewals of future patents, but applies to the past also. *Ibid.*, 179, 180.

8. The right of renewal is limited to the patentee, whether he retains or has sold his invention. The provision of renewal extends as well to a case where the patent has been assigned, as where it has not been. *Brooks v. Bicknell*, 4 McLean, 66, 69.—McLEAN, J.; Ohio, 1845.

9. The right of extension under § 18 of the act of 1836, applied to patents granted before the passage of that act, as well as to those thereafter issued. *Wilson v. Turner*, 7 Law Rep., 529.—TANEY, J.; Md., 1845.

10. The right of extension is given by the law, chiefly with a view to the advantage of the inventor, and not of his assignee or grantee; and the patent, if extended at all, must be extended on the application of the inventor and not of his assignee. *Ibid.*, 531.

11. § 18 of the act of 1836 authorizes the extension of a patent on the application of the executor or administrator of a deceased patentee. *Wilson v. Roseau*, 4 How., 675, 676, 687.—NELSON, J.; Sup. Ct., 1845.

12. And such extension may be applied for and obtained by the administrator, although the original patentee had in his lifetime disposed of all his interest in the then existing patent, having at the time of his death no right or title to, or interest in the original patent. *Ibid.*, 686, 688, 690.

13. An administrator may, under § 18 of the act of 1836, apply for, and take an extension of a patent. *Woodworth v. Wilson*, 4 How., 716.—NELSON, J.; Sup. Ct., 1845.

14. The renewal of a patent in the name of an administrator is good, as an

invention is personal property. *Woodworth v. Hall*, 1 Wood. & Min. 254.—WOODBURY, J.; Mass., 1846.

B. POWER OF COMMISSIONER ON APPLICATION FOR; CONCLUSIVE NATURE OF ACTION OF.

1. Under § 18 of the act of 1836, the notice of an application for an extension of a patent is intended to protect the public, and give all an opportunity to appear and oppose. Where a patent was to expire on the 7th day of December, 1840, and the applicant did not apply until the 21st of November, *Held*, that there was not time sufficient to give the notice required by law. *Gale's Case*, 3 Opin., 594.—GILPIN, Atty. Gen.; 1840.

2. The decision of the Board, upon an application for an extension of a patent, is conclusive within the scope of its jurisdiction, there being no superior supervising tribunal; but it is not conclusive on the question of law, as to the right of renewal by the party applying. *Brooks v. Bicknell*, 3 McLean, 258.—McLEAN, J.; Ohio, 1843.

3. The proceeding before the Board, as to the extension of a patent, is not necessarily *ex parte*; those who contest the right of the applicant have the right to appear and oppose the renewal of the patent. *Brooks v. Bicknell*, 3 McLean, 435.—McLEAN, J.; Ohio, 1844.

4. The function of such Board is, in its nature, judicial: the parties, as well those who oppose the extension of the patent as those who apply for it, are brought before them; and evidence on both sides being heard, the board pronounce judgment. *Ibid.*, 435.

5. The proceeding, therefore, is not like a tax sale, where every step mus

be proved, or the title fails. But it is in the nature of a judicial action where, jurisdiction being acquired, no subsequent errors can affect the title of a purchaser. *Ibid.*, 435.

6. The decision of the Board, upon an application for an extension of a patent, is not conclusive upon the question of their jurisdiction. *Wilson v. Rosseau*, 4 How., 688.—NELSON, J.; Sup. Ct., 1845.

7. The extension of a patent to a person as administrator is proof that the Board was satisfied of the fact of his being such administrator, and such decision is conclusive. In an action upon such patent, the letters of administration need not be produced. *Woodworth v. Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

8. The act of 1848, conferring the power of extending patents upon the Commissioner, was not a repeal of § 16 of the act of 1836, providing for the extension of patents, but simply a repeal of so much of it as related to the action of the Secretary of State, and the Solicitor of the Treasury in the matter. It simply devolved upon the Commissioner the whole of the duty which was previously divided with the Secretary and the Solicitor, and directed that he should be governed by the same principles and rules that had governed the board composed of the three. *Colt v. Young*, 2 Blatchf., 473.—NELSON, J.; N. Y., 1852.

9. Where an application for an extension of a patent, under § 18 of the act of 1836, was pending at the time of the passage of the act of 1848, which conferred upon the Commissioner of Patents solely the power previously vested in the board created by the act of 1836, *Held*, that it was not necessary to renew the application, but that the

Commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. *Ibid.*, 473.

10. The decision of the Commissioner as to the regularity of the proceedings before him, on an application for an extension are conclusive, except perhaps in a case of fraud. *Ibid.*, 473, 474.

11. In respect to the entire merits of the patentee, and the existence of the legal grounds for an extension, the law makes the Commissioner the judge, and in the absence of fraud his adjudication is conclusive. *Clum v. Brewer*, 2 Curt., 518.—CURTIS, J.; Mass., 1855.

C. RIGHTS OF ASSIGNEES AND OTHERS IN EXTENSION.

1. Under the act of 1836, by which "the benefit of a renewal extends to the assignee to the extent of his interest," where an assignment of the whole right has been made by a patentee, whether such patentee could have any interest in the renewal; *query*. *Brooks v. Bicknell*, 3 McLean, 257.—MCLEAN, J.; Ohio, 1843.

2. Under the patent laws, prior to 1836, a license or assignment of a patent expired with the limitation of the original patent, unless it was expressly so granted as to be applicable to any renewal of the patent afterward. The licensee's or assignee's right was bounded by the same limits as that of the licensor or assignor, that is, the original term granted.—*Washburn v. Gould*, 3 Story, 135.—STORY, J.; Mass., 1844.

3. A renewed patent under those laws was a new grant, and the patentee was entitled to the sole and exclusive benefit thereof, unless the licensees or

assignees had, by their original contract, secured to themselves, by express covenant or grant, a right to the benefit of the renewed patent. *Ibid.*, 135.

4. Previous to the act of 1836 every license and assignment expired with the limitation of the original patent, unless it was expressly, in terms, so granted as to be applicable to any renewal of the patent afterward. The doctrine proceeded upon the ground that a man can pass by grant or assignment only that which he possesses, and which is in existence at the time. His grant, therefore, is limited to what is then in existence, unless he uses other language, importing an intention to grant what is not then possessed or in existence. *Woodworth v. Sherman*, 3 Story, 174.—STORY, J.; Mass., 1844.

5. And this doctrine is expressly applicable to licenses and assignments under the act of 1836, the whole design of which is confined to the inventor, and for his benefit, and not for the benefit of his licensee or assignee. *Ibid.*, 175.

6. The word "patentee" in § 18 of the act of 1836 is used as equivalent to "inventor," and the law meant to reward him, and him alone, for his time, ingenuity, and expense in perfecting his invention. *Ibid.*, 176.

7. The clause as to assignees "to the extent of their respective interests therein," does not mean to enlarge the rights of assignees beyond the extent of the interest originally granted to them. If such interest was limited to the original term, they would have no benefit in the extended patent; but if the original assignment conferred, expressly, or by just implication, an interest in the renewed patent, that interest was to be protected. *Ibid.*, 177.

8. Under § 18 of the act of 1836, the renewal of a patent does not inure to an assignee, unless by the assignment of the original patent it is so specified. *Brooks v. Bicknell*, 4 McLean, 66, 67.—McLEAN, J.; Ohio, 1845.

9. The provision that the "benefit of the renewal shall extend to the assignees of the patent to the extent of their interests therein," gives a legal effect to the provision of any assignment, stipulating for an interest in the event of a renewal. Without such provision, the assignment might have been considered an agreement to convey, but it would not have been a legal conveyance of the patentee's right, as he could not convey a legal title to that which was not in existence. *Ibid.*, 68.

10. This is a fair construction of the statute, harmonizing its provisions, and giving effect to the intention of the parties. *Ibid.*, 68.

11. The object of the clause in § 18 of the act of 1836, as to assignees, is to preserve any previous contract of assignment, in the sense in which both parties understood and intended at the time it was made, and to secure to the purchaser the right he had intended to buy, and which the patentee intended to sell. *Wilson v. Turner*, 7 Law Rep., 530.—TANEY, J.; Md., 1845.

12. The legislature obviously intended to guard a party who had purchased from the patentee the right to use the invention until the expiration of the exclusive privilege, from the necessity of buying it again. *Ibid.*, 531.

13. The object of the law is to do justice between the inventor, who has failed to obtain a reasonable remuneration within the fourteen years, for the time, ingenuity, and expense bestowed upon his invention, and the public,

while it protects assignees and grantees in the rights previously acquired by them. *Ibid.*, 532.

14. The extension of a patent under § 18 of the act of 1836, does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any exclusive right. But the benefits of such renewal extended to assignees or grantees by such section is limited to those who were in the use of the patented article at the time of the renewal, and saves to such persons the right to use the machines held by them at the time of such renewal "to the extent of their interests," be that interest in one or more machines. *Wilson v. Rosseau*, 4 How., 682, 683.—NELSON, J.; Sup. Ct., 1845. [But see *post* 43 to 47, 1856.]

15. McLEAN and WOODBURY dissented, holding that such an extension would inure to the benefit of such assignees, who had by express agreement secured an interest in the extension. *Ibid.*, 692, 694.

16. WAYNE dissented from such part of the opinion of the court as gave to assignees the right to continue the use of the patented machines in use at the time of the extension. *Ibid.*, 693.

17. A covenant as to a benefit in a "renewal" of a patent must be construed by a reference to the law as it stood at the time of such covenant, and will not embrace any right in a new grant, secured by after legislation. *Ibid.*, 685.

18. Where, in an assignment of a patent, made in 1828, before there was any provision in the patent laws authorizing a renewal, there was a covenant that any "renewal" should inure to the benefit of the assignees, *Held*, that such term "renewal," could be satisfied by a reference to the law as it then stood, and

that in a subsequent renewal of the patent, by virtue of subsequent acts of Congress, no right was acquired by virtue of the assignment or covenant. *Ibid.*, 685, 686.

19. If an extension is taken by an administrator of a deceased patentee, it inures to the benefit of such administrator, and to him in that capacity exclusively. *Ibid.*, 685, 687.

20. The assignees and grantees of the right to use a patent, who are by § 18 of the act of 1836, as interpreted by the Supreme Court, to have the benefit of the renewal of a patent, are those holding the right, at the time of the renewal. *Woodworth v. Curtis*, 2 Wood. & Min., 530.—WOODBURY, J.; Mass., 1847.

21. A reservation in an act of Congress extending a patent in favor of assignees, does not make the act unconstitutional, but such power of reservation is incidental to the general power conferred to promote the progress of the useful arts. *Blanch. Gun-Stock Co. v. Warner*, 1 Blatchf., 260, 271, 275.—NELSON, J.; Ct., 1846.

22. The direct question whether Congress can grant in an extension, rights to assignees, was not involved in the cases of *Wilson v. Rosseau*, *Simpson v. Wilson*, *Wilson v. Turner*, and *Woodworth v. Wilson*, 4 How., 646–712, but was discussed and considered as connected with the matters in controversy in those cases, and the right of Congress to reserve rights and privileges to assignees, was conceded as incidental to the general power conferred by the constitution on Congress, to promote the progress of the useful arts. *Ibid.*, 276.

23. A general assignment of an interest in a patent, or a part of a patent, gives the assignee no interest in the re-

newal of the patent. But such an interest may be assigned, if the terms of the assignment clearly embrace the renewed patent. *Phelps v. Comstock*, 4 McLean, 355.—McLEAN, J.; Ind., 1848.

24. But where the assignment is of an interest in letters patent, which "are or may be granted," it embraces any subsequent renewal of the patent whether it should be under the statute, or by act of Congress. *Ibid.*, 355.

25. If the whole of the patent has been assigned, it would seem that, under the decision of the majority of the Supreme Court in *Wilson v. Rosseau*, 4 How., 646, 1845, there could be no renewal for the benefit of the patentee. *Ibid.*, 355.

26. The extension of a patent is for the benefit of the original inventor or his representatives, to compensate him for his expenditure, labor, and ingenuity in the invention, and in perfecting it. *Case v. Redfield*, 4 McLean, 528.—HUNTINGTON, J.; Ind., 1849.

27. An ordinary assignment of a right in a patent will not convey any right in the extended or renewed patent. But such an interest when intended to be assigned, must be expressed. *Ibid.*, 528.

28. Under § 18 of the act of 1836, as construed by the Supreme Court in *Wilson v. Rosseau*, 4 How., 682, a licensee may continue to use an invention actually in use by him at the time of an extension, during the term of such extension; but no such right exists under an extension by act of Congress, unless specially provided for. *Bloomer v. Stolley*, 5 McLean, 163.—McLEAN, J.; Ohio, 1850. [But see *post* 33.]

29 If Congress upon an extension

imposes no restriction in favor of a licensee, and there is no provision in the contract of license, beyond the term of the patent, none can be implied. *Ibid.*, 164.

30. The right of an assignee to continue to use, during an extension of a patent, machines existing and in use at the expiration of the first term, as declared in *Wilson v. Rosseau* (4 How., 646), is derived wholly from the proviso in § 18 of the act of 1836, in favor of assignees. If there had been no such reservation, the rights of assignees acquired during the first term would have expired with its termination, and the exclusive right would have vested in the patentee. *Gibson v. Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

31. To enable an assignee to derive any benefit from an extension by an act of Congress, an express provision should be inserted in the grant or assignment, looking to such a renewal. *Gibson v. Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

32. Unless there be such a stipulation, showing that a renewal was contemplated, the court is bound to construe the instrument as relating to the existing right, in respect to which the parties are considered as contracting with each other. *Ibid.*, 146.

33. Under the decision of *Wilson v. Rosseau*, 4 How., 688, one in the lawful use and ownership of a patented machine, under a purchase made during the original term of the patent, may continue to use such a machine during an extension of the patent, under the provisions of § 18 of the act of 1836; and is also entitled, within the spirit and intention of the patent laws, to continue to use such machine during an

after extension made by special act of Congress, unless there is something in the language of the act requiring a different construction. *Bloomer v. McQuewan*, 14 How., 550.—TANEY, Ch.; Sup. Ct., 1852.

34. The inchoate right of an inventor to an extension of a patent for his invention, is the subject of a contract of sale. *Clum v. Brewer*, 2 Curt., 520.—CURTIS, J.; Mass., 1855.

35. The sale of the "invention" does not necessarily carry with it this inchoate right, but the sale of "my invention, and of all rights and property that I may have from any *letters patent* for the same," would include the extended letters patent. *Ibid.*, 521.

36. Where a patentee made an agreement with a person, that in case of the *renewal* of the patent, or of the obtaining of other or further letters patent, after the expiration of the existing patent, such person should have a certain interest in the rights secured by such renewed patent, *Held*, that the parties had in view an extension under § 18 of the act of 1836. *Pitts v. Hall*, 3 Blatchf., 204.—HALL, J.; N. Y., 1854.

37. Where an agreement was entered into between a patentee and another person, that in case of the extension of the patent, such person should have and be entitled to the equal undivided one-fourth part of all the rights and benefits that should be secured by such renewed patent, for certain states, on paying the proportional one-fourth part of the expenses of obtaining such extension, which agreement was also recorded; and the patent was extended, and such person endeavored to learn from the patentee the costs of such extension, and expressed himself ready to pay his proportional share thereof, *Held*,

that the agreement was a valid executory agreement, entitling such person to the undivided interest in such patent, on the performance of the condition precedent of the payment of the specified portion of such expenses. *Ibid.*, 204.

38. Whether the terms of such an agreement are not words of grant and conveyance, and whether the agreement itself would not be a sufficient assignment of the interest in the extension, if the condition was performed; *query. Ibid.*, 204.

39. *Held*, also, that the offer to pay the proportional part of such expenses did not vest in such person the interest in such extension, although it may have enabled him to bring his action and recover damages for the non-performance of the agreement. *Ibid.*, 205.

40. Under the provisions of § 18 of the act of 1836, an assignee or person in use of the invention at the time of the expiration of the original patent, has a right to continue, under an extension of such patent, the use of "the thing patented," whether the patent be for a process, and a machine to be used in such process, or for a process alone, or for a machine alone, and whether the identical machinery in use by such person under the extended patent was or was not in existence prior to the renewal of the patent. *Day v. Union Rub. Co.*, 3 Blatchf., 491, 504.—HALL, J.; N. Y., 1856.

41. Where, at the expiration of the original term of the patent, A had a right to use the patented invention for the manufacture of certain articles, and continued, during an extension of the patent granted under § 18 of the act of 1836, the use of the invention, to the extent he was entitled at the time the original patent expired, *Held*, that he

had the right to continue such use during the extended patent, as against B, an assignee of the original patentee. *Ibid.*, 497.

42. The language of § 18 of the act of 1836, as to the rights of assignees and grantees of an original patent, under an extended term thereof, is broad enough to cover and protect, and was intended to cover and protect, the right to use the patented invention during the extension, whether such right arose from a direct assignment or grant from the patentee, of a limited or unlimited right to use, or from the purchase of a machine. *Ibid.*, 497.

43. The words of this section as to assignees and grantees seem to convey the impression that something more than the mere ownership of existing machines was intended, and that they were intended to embrace all classes of such assignees and grantees and all inventions, whether of machines, processes, or compositions of matter, and to embrace rights and interests which were different in extent, either of time or territory, or both. *Ibid.*, 497.

44. But such right is limited to a right to use, although the person holding it may also have held, during the original term, an exclusive right to use, to make and vend. And such right to use is secured only to the extent of the respective interests of the assignees or grantees therein. *Ibid.*, 502.

45. If the right to use before the extension was limited to a single state, county, town, or smaller district, it continues during the extension, subject to the same limitations; and if the right was to use a certain specified number of machines within a particular district, the limit in number and restriction continues. *Ibid.*, 503.

46. If the only right to use was one which resulted from the purchase of a machine, the right to use is co-extensive with the existence of the machine, and expires with it. *Ibid.*, 503.

47. Under § 18 of the act of 1836, the assignees and grantees of a right to use a patented process are continued in the right to use it during an extension of the patent, equally with the assignees and grantees of a right to use a patented machine. *Ibid.*, 503.

48. Though the cases of *Wilson v. Rosseau*, 4 How., 646; *Wilson v. Simpson*, 9 How., 109; and *Bloomer v. McQuewan*, 14 How., 539, appear to decide that by virtue of § 18 of the act of 1836, the right of assignees and grantees of an original patent is limited, under the extended patent, to the use of the particular machines which they had in use at the time of the expiration of the original term, such precise question did not arise in their consideration, and was not necessarily decided in either one of them. *Ibid.*, 491, 493.

49. An agreement made between a patentee, who is about to apply for a renewal of his patent, with another, that in case of renewal he will convey to him such renewed patent, in consideration of a certain sum, is valid, and if the patent is renewed, such agreement conveys to the assignee an equitable interest or title, which can be converted into a legal title, by paying or offering to pay the agreed consideration. *Hartshorn v. Day*, 19 How., 220.—NELSON, J.; Sup. Ct., 1856.

50. Where a patent had been extended, and the patentee then conveyed all his interest therein to another person, who brought suit against certain parties for an infringement of the patent, and such parties claimed, under a license

from the patentee, under the original patent, *Held*, that it was necessary for the defendants to show a connected chain of title to themselves, in order to justify, under the clause of § 18 of the act of 1836, as to assignees, their use of the improvements secured by the patent. *Chaffee v. Bos. Belting Co.*, 22 How., 223, 224.—CLIFFORD, J.; Sup. Ct., 1859.

D. AUTHORITY AND FORCE OF EXTENDED PATENT.

See also EXTENSION OF PATENT, B.

1. A renewed patent has the same obligation, and confers the same rights with an original patent. The inchoate property, which, vested by the discovery, is prolonged by the renewed patent, as well as by the original patent. *Evans v. Jordan*, 1 Brock., 254.—MARSHALL, Ch. J.; Va., 1813.

2. It is not essential to the validity of a renewed patent, that all the proceedings connected with the renewal should be set out at length. *Brooks v. Bicknell*, 3 McLean, 435.—MCLEAN, J.; Ohio, 1844.

3. It is sufficient if it appear that the subject was before the proper officer, and that the decision was in favor of a renewal. *Ibid.*, 435.

4. No prior use of a defective patent can authorize the use of the invention, after the emanation of the amended patent under this section. *Stimpson v. West Ches. R. R. Co.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

5. In an action by an administrator on a renewed patent, it is not necessary to produce the letters of administration. The patent is proof that the board (or

Commissioner) was satisfied that the applicant was an administrator, and it is not competent to go behind their or his decision. *Woodworth v. Hall*, 1 Wood. & Min., 254.—WOODBURY, J.; Mass., 1846.

6. After the extension of a patent, under § 18 of the patent act of 1836, the original patent becomes virtually a patent for the term of twenty-one years. *Gibson v. Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

7. Upon the extension of a patent and the proper certificate, under § 18 of the act of 1836, the original patent is treated as for one seven years longer. And so if further extended by special act of Congress. If extended in both ways the original patent becomes one for twenty-eight years. *Woodworth v. Edwards*, 3 Wood. & Min., 125.—WOODBURY, J.; Mass., 1847.

8. And it becomes such a patent, for such term, under one and the same original specification. *Ibid.*, 125.

9. There is a marked and well recognized difference between a *renewed* and a *reissued* patent. The former grants a wholly new term, the latter legalizes and confers the right during the continuance of the original term. *McBurney v. Goodyear*, 11 Cush., 571.—MERRICK, J.; Mass., 1853.

10. The jury are to determine from the facts in a case, whether a renewed patent is for the same invention as the original patent. *Battin v. Taggart*, 17 How., 85.—MCLEAN, J.; Sup. Ct., 1854.

11. If a patentee has established his title under his original patent, he is entitled to a temporary injunction under an extension of such letters patent, without a further trial at law. *Clum v. Brewer*, 2 Curt., 517, 518.—CURTIS, J.; Mass., 1855.

E. EXTENSION BY SPECIAL LAWS, AND RIGHTS UNDER.

1. A patentee under the acts of Congress may have the time of his monopoly extended by the legislature of any state beyond the term allowed by the acts of Congress. Congress may secure for a limited time an exclusive right throughout the Union; but there is nothing in the constitution to take away from the states the power to enlarge the privilege within their respective jurisdictions. *Livingston v. Van Ingen*, 9 John., 581.—KENT, Ch. J.; N. Y., 1812.

2. Congress may renew a patent-right, or refuse to do so. The grant of an exclusive privilege to an invention for a limited time does not imply a binding and irrevocable contract, that at the expiration of the period the invention shall become public property. *Evans v. Eaton*, Pet. C. C., 337.—WASHINGTON, J.; Pa., 1816.

3. A private act of Congress, authorizing the issue of a patent, is to be considered as engrafted on the general laws for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Evans v. Eaton*, 3 Wheat., 518.—MARSHALL, Ch. J.; Sup. Ct., 1818.

4. Congress has the right and power, in extending a patent by act of Congress, to modify or control the interests of assignees under the original patent, and to dispose of the whole subject as they think proper. *Blanchard's Case*, Opin., Gilpin's Ed., 1841, p. 1125.—BUTLER, Atty. Gen., 1837.

5. There is no restriction which limits the power of Congress in extending a patent to cases where the invention had not been known or used by the public. All that is required is, that the patentee

should be the inventor. *Blanchard v. Sprague*, 3 Sumn., 541.—STORY, J.; Mass., 1839.

6. An act of Congress granting a patent is not unconstitutional, because it acts retrospectively to give a patent for an invention which was in public use. *Ibid.*, 541.

7. The extension of a patent, after an extension under § 18 of the act of 1836, by an act of Congress, is as effectual and operative as the extension under that section, and the patent when so extended, becomes a patent for twenty-eight years instead of twenty-one years. *Gibson v. Harris*, 1 Blatchf., 169.—NELSON, J.; N. Y., 1846.

8. Congress may by special act extend a patent even after the expiration of the original patent. *Blanch. Gun-Stock Turning Fac. v. Warner*, 1 Blatchf., 274, 276.—NELSON, J.; Ct., 1846.

9. Congress has the constitutional right to confer a new and further term on the patentee, and that even after the expiration of the first. *Blanchard v. Haynes*, 6 West. Law Jour., 83.—WOODBURY, J.; N. H., 1848.

10. Congress has the constitutional power to grant an extension of a patent after it has been once extended under § 18 of the act of 1836. The power of Congress was not exhausted in this respect by the act of 1836. *Bloomer v. Stolley*, 5 McLean, 160, 161.—MCLEAN, J.; Ohio, 1850.

11. There is no provision against a second extension. The policy of the law is to compensate the inventor, and if this object be not attained by a first extension, there would seem to be justice in a second. But this can only be done by act of Congress. *Ibid.*, 162.

12. Under an extension granted by

act of Congress, there is no right on the part of an assignee or licensee to continue the use of an invention before used by them, unless such right is specially provided for and secured by the act. *Ibid.*, 163. [But see *post* 16.]

13. If Congress imposes no restriction in favor of a licensee, and there is no provision in the contract of license beyond the then existing term of the patent, none can be implied. *Ibid.*, 164.

14. If there is no reservation in an act of Congress extending a patent in favor of assignees, they have no right under the term thereby created, and they cannot even continue in the use of machines lawfully constructed before such term, and actually existing and in use when the former term expired. *Gibson v. Gifford*, 1 Blatchf., 531.—NELSON, J.; N. Y., 1850.

15. To enable an assignee to derive any benefit from an extension by act of Congress, an express provision should be inserted in the grant or assignment, looking to such a renewal. *Gibson v. Cook*, 2 Blatchf., 146.—NELSON, J.; N. Y., 1850.

16. One in the lawful use of a machine under a purchase during the original term of the patent, is entitled, within the spirit and intention of the patent laws, to continue such use during an extension made by an act of Congress, unless there is something in the language of the act requiring a different construction. *Bloomer v. McQueen*, 14 How., 550.—TANEY, Ch. J.; Sup. Ct., 1852.

17. A special act in relation to any particular patent is to be considered as engrafted upon the general acts relating to patents; they are statutes *in pari materia*, and all relate to the same sub-

ject and must be construed together. *Ibid.*, 550.

FEIGNED ISSUE IN PATENT ACTIONS.

A. WHEN ORDERED, AND PRACTICE ON... 329

B. EFFECT OF VERDICT IN..... 331

A. WHEN ORDERED, AND PRACTICE ON.

1. Where witnesses differ as to the fact of infringement, the question should be submitted to a jury, either by an action at law, or an issue directed by the court. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

2. Where, on a bill filed to restrain a defendant from infringing a patent-right, the infringement is denied and the evidence is conflicting, the court will send an issue to a jury, or refer the cause to a master to hear further testimony, and make a report as to the points in issue. *Parker v. Hatfield*, 4 McLean, 62.—MCLEAN, J.; Ohio, 1845.

3. A feigned issue, directed by the chancery side of a court, is not a mere form, but such issue is sent out to relieve the court, in matter of doubt, or because from the nature of the case, and the conflict of testimony, it is fit for a jury to decide. *Brooks v. Bicknell*, 4 McLean, 72.—MCLEAN, J.; Ohio, 1845.

4. In patent cases, involving the structure of complicated machinery, the sufficiency of their description, and their identity in principle with other machines, an issue is appropriately sent to a jury. *Ibid.*, 72.

5 An answer, if intended to form an issue to try the validity of a patent, because not original, should set out the names of places and persons, where and by whom a like invention or thing had been used. *Orr v. Merrill*, 1 Wood. & Min., 378.—WOODBURY J.; Me., 1846.

6. A trial to test the validity of a patent, is not usually tried by the court in chancery, nor often in issues sent from there to the law side of the court to be settled by a jury, unless requested by the respondent. *Ibid.*, 378.

7. But where issues are sent to be tried at law, it is proper, under those issues, to have all the specific notices given by the defendant in detail of persons and places connected with the former use of the plaintiff's invention. *Ibid.*, 378.

8. On the question of the infringement of a patent, in a suit at equity, a feigned issue will not be awarded, unless the court have doubts as to the identity of the two machines. *Van Hook v. Pendleton*, 1 Blatchf., 194.—NELSON, J.; N. Y., 1846.

9. It is not a matter of course, to order a feigned issue; but the party applying must lay a foundation for it. A feigned issue is not to be granted unless the opinion of the jury on a question is found to be needed. *Ibid.*, 195.

10. Chancery may order an issue to be tried at law to help itself as to facts, and to be retried, if dissatisfied with the verdict, or may decide facts for itself. *Woodworth v. Rogers*, 3 Wood. & Min., 149.—WOODBURY, J.; Mass., 1847.

11. If the parties do not agree as to the issue to be tried by a jury in respect to the validity of a patent, the court will direct a suit at law to be tried speedily, to settle the conflicting title. *Ibid.*, 151.

12. In the third circuit, where a feigned issue for the trial of a fact by a jury is ordered by the court, the case can be put on the trial list at once, and the jury be sworn to try in the form and in the words of the order itself. No declaration or pleading of any sort is requisite. *Wilson v. Barnum*, 1 Wall, Jr., 343.—GRIER, J.; Pa., 1849.

13. After a verdict for the plaintiff, in an action at law for an infringement, and the denial of a motion for a new trial on the ground of surprise in rejecting testimony, the plaintiff filed a bill for a perpetual injunction, and an account. The defendants put in their answer, setting up substantially the matters used on the motion for a new trial. Afterward they moved for leave to put in an amended answer, on the ground of the discovery of new and important evidence, affecting the novelty of the plaintiff's invention—the only question litigated on the former trial being that of infringement—and also moved for a feigned issue to try the question of the novelty of the plaintiff's invention, *Held*, that the originality of the plaintiff's invention being denied, it was a proper case for the granting of an order allowing a feigned issue. *Foot v. Silsby*, 1 Blatchf., 545, 546, 548.—NELSON, J.; N. Y., 1850.

14. Where on a bill for an injunction, it appeared that there had been three trials at law, in which there had been a verdict in favor of each party plaintiff and defendant, and a divided jury on the other trial, and originality of invention was denied, *Held*, that the question of originality could not be considered settled, and therefore decision was suspended on the injunction, and an account was ordered, and an issue was sent to be tried before a jury as to the ques-

tion of originality. *Allen v. Sprague*, 1 Blatchf., 567, 568.—NELSON, J.; N.Y., 1850.

15. A feigned issue rests in the discretion of the court. A trial at law is ordered to inform the conscience of the court, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact, or of legal titles. *Goodyear v. Day*, 2 Wall, Jr., 296.—GRIER, J.; N. J., 1852.

16. In the courts of the United States the practice of sending parties to a trial at law is by no means as common as in England, or as it would be if the trouble of trying issues at law devolved upon a different court; and such courts do not always consider it a proper exercise of their discretion to order such issues to be tried at law before granting an injunction. *Ibid.*, 297.

17. Where the court, therefore, after the hearing of a cause on exhibits and proofs, and a careful consideration of the testimony, felt no doubt or difficulty on the questions of the originality of the invention, and of the fact of infringement, and the regularity of the patent, it will not send the case to the jury prior to granting a final injunction; and especially if the questions in the case do not depend so much on the credibility of witnesses, or the weight of oral testimony, as on the application of principles of science and law to admitted facts, and where a jury trial would be long and costly, and more than probable that no verdict would be obtained. *Ibid.*, 298.

18. A feigned issue to try the validity of a patent will not be granted at the request of a defendant, who has been guilty of frequent infringements, and who has before allowed judgments

to be taken against him in actions at law, and taken a license under the patent, and when no mistake or misrepresentation is alleged, nor the discovery of new evidence, nor that anybody but himself disputes the validity of the patent. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

19. Where on a bill filed for the infringement of a patent, and for an injunction, the defence was set up that the invention had been known and used prior to the invention thereof by the patentee, but the evidence was so uncertain and insufficient that no satisfactory judgment could be founded upon it, *Held*, that an issue should be ordered to decide, First, whether the patentee was the discoverer or inventor of the thing patented to him, and, Second, whether such invention was known and used by others two years before the application for a patent. *Sickles v. Pacific Mail Steamship Co.*, MS.—INGERSOLL, J.; N. Y., 1857.

B. EFFECT OF VERDICT IN.

1. A verdict upon an issue ordered by a court of equity is in no just sense final upon the facts it finds, or binding upon the judgment of the court. *Allen v. Blunt*, 3 Story, 746.—STORY, J.; Mass., 1845.

2. The court may at its pleasure set it aside and grant a new trial, or disregarding it, may proceed to hear the cause and decide in contradiction to the verdict, or it may adopt the verdict *sub modo*, and give it a limited effect only, *Ibid.*, 746.

3. But it can never be known what effect is given to the verdict, or whether any is given to it, until a subsequent

hearing upon the merits, and a decree rendered thereon by the court. *Ibid.*, 746.

4. Whether a verdict in a suit at law is ever evidence of any thing, but the fact that it was rendered, unless a judgment has been duly rendered thereon; *query. Ibid.*, 746.

5. A verdict on an issue at law, directed by a court of chancery, will not be set aside on the ground it is against the weight of evidence, unless the preponderance is very clear. *Brooks v. Bicknell*, 4 McLean, 72, 74.—McLEAN, J.; Ohio, 1845.

6. After a jury have passed upon the questions submitted to them on a feigned issue, it is for the court to say whether the verdict is right; and the court may set it aside. *Van Hook v. Pendleton*, 1 Blatchf., 195.—BETTS, J.; N. Y., 1846.

7. A verdict rendered by the jury on a feigned issue is not necessarily conclusive or controlling upon the court directing such issue; but such verdict may be disregarded, and a decree entered in opposition to it, if the court deem it proper. *Foot v. Silsby*, 2 Blatchf., 275.—NELSON, J.; N. Y., 1851. [Affirmed, *post* 10.]

8. Where after a suit at law, determined in favor of the plaintiffs, the plaintiffs filed their bill against the same defendants for an injunction, and a feigned issue was ordered, upon the trial of which a verdict was rendered for the defendants, the court entered a decree for the plaintiffs, notwithstanding such verdict. *Ibid.*, 275.

9. A verdict at law, or a finding in case of a feigned issue, is never conclusive upon a judge sitting in equity. The judgment of the judge upon the law and the evidence must determine

his action, and not the judgment of the jury. *Day v. Hartshorn*, 3 Fisher, 36.—PITMAN, J.; R. I., 1855.

10. The decision of the court in *Foot v. Silsby*, 2 Blatchf., 275, affirmed, thus in fact sustaining the position that a court of equity may disregard the finding of a jury upon the trial of feigned issues, and enter a decree in opposition to such finding. *Silsby v. Foot*, 20 How., 385.—NELSON, J.; Sup. Ct., 1857.

FOREIGN PATENT.

1. The issue of a foreign patent to one American inventor, to affect the issue of a home patent to an alleged prior inventor, on the ground that such foreign patent had been granted more than six months before the application of the latter (acts of 1836, § 8, and 1839, § 6), will be considered as having reference to the time of the original application of such prior inventor. *Wade v. Matthews*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1850.

2. Where M. made his first application for a patent in May, 1848, which application was afterward withdrawn, but was instantly renewed, and in the same words, and W. obtained foreign patents for the same invention in July, 1848, and before the date of such second or renewed application, *Held*, that the two applications of M. were to be considered as a continuous application, so that six months had not expired, after the issue of such foreign patents, before M.'s application. *Ibid.*

3. It seems, however, that the foreign patent, to affect the issue of a home patent to the original and first inventor,

CHANGES IN; WHEN PATENTABLE, AND WHEN NOT.

must be issued before the American discovery. *Ibid.*

4. A British patent, being authenticated by the great seal, proves itself; but is only *prima facie* evidence, as a patent issued by our own government, that the invention was of some probable value. *Gatling v. Newall*, 9 Ind., 582.—PERKINS, J.; Ind., 1857.

5. A foreign patent, in order to defeat an American patent for the same invention, must have been *patented* before the discovery or invention here; and not merely before the application. *Howe v. Morton*, 13 Mo. Law Rep., 70.—SPRAGUE, J.; Mass., 1860.

6. An invention is not "patented" in England, within the meaning of the acts of Congress (act of 1836, § 15), until the complete specification has been enrolled, until the invention shall have been made patent to the world. *Ibid.*

7. Where letters patent were granted in England to F. and G. for improvements in sewing machines, in December, 1844, but the specification was not enrolled until June, 1845, and H. completed an invention for a similar improvement or arrangement as that described in F. and G.'s specification, in May, 1845, but his application for a patent was subsequent to June, 1845, *Held*, that F. and G.'s invention was not *patented* until after H.'s invention, and that H. was entitled to a patent under the provisions, and within the meaning of, § 15 of the act of 1836. *Ibid.*

FORM.

See also COLORABLE ALTERATIONS.

1. Whether an improvement is on the

principle of a machine, or on the *form* or *proportions* merely, is a question of fact for the jury. *Rutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. An improvement in the *form* or *proportions* of a machine gives no right to use the original machine. *Ibid.*, 171. Also, *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

3. A mere change of former proportions will not entitle a party to a patent. *Woodcock v. Parker*, 1 Gall., 440.—STORY, J.; Mass., 1813.

4. If a discovery or improvement be only in the form or proportions of a machine, it has not the merit of a discovery which can entitle the party to a patent. *Evans v. Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816.

5. A mere change of the form or proportions of any machine cannot, *per se*, be deemed a new invention. *Lowell v. Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

6. If the difference between a patented article and the thing made by another be only in form or proportions, they are the same in legal contemplation. *Dixon v. Moyer*, 4 Wash., 71.—WASHINGTON, J.; Pa., 1821.

7. Improvements in the form or proportions of an invention, adopted in consequence of the suggestions of the mechanic employed to make the specimen, or of others, are not inventions or improvements for which a patent could be obtained, nor can they invalidate the patent for the thing to which they were applied. *Pennock v. Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

8. Suggestions of alterations in the form or proportions of a machine are not such a discovery as will entitle the party making them to a patent therefor.

Watson v. Bladen, 4 Wash., 582.—WASHINGTON, J.; Pa., 1826.

9. It is not every change of form and proportion which is declared (under the act of 1793, § 2) to be no discovery, but such as is *simply* a change of form and proportion, and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but of change of principle also. *Davis v. Palmer*, 2 Brock., 310.—MARSHALL, Ch. J.; Va., 1827.

10. In every case, it is a question for the jury, whether the change of form and proportion in an invention has produced a different effect, and is a new invention. *Ibid.*, 310.

11. A difference in the manner or form of applying an invention, if it be the same in principle, will not justify a patent. *Delano v. Scott*, Gilpin, 500.—HOPKINSON, J.; Pa., 1834.

12. A mere formal difference cannot be protected by a patent; the difference must be substantial. *Stanley v. Whipple*, 2 McLean, 38.—MCLEAN, J.; Ohio, 1839.

13. A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle, and the application of it, to constitute such an improvement as the law will protect. *Smith v. Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

14. A machine substantially the same in operation and construction with one patented, though differing somewhat in form and arrangement, is still an infringement upon it. *Wyeth v. Stone*, 1 Story, 280.—STORY, J.; Mass., 1840.

15. A mere difference of form will not entitle a party to a patent. *Carver*

v. Braintree Manuf. Co., 2 Story, 440.—STORY, J.; Mass., 1843.

16. A change in the manner of attaching several knives, for the purpose of grinding them, on a cylinder, instead of one, or in attaching that one to a flange on the cylinder by screws instead of attaching it to the cylinder by rings at the end; *Held*, not to be a sufficient change in form, or principle, or results, to justify a patent. *Hovey v. Stevens*, 1 Wood. & Min., 299, 300.—WOODBURY, J.; Mass., 1846.

17. There must be difference in principle to constitute a patentable difference. A mere change of form will not do, unless form is a part of the thing invented, and is essential to its value. *Many v. Jagger*, 1 Blatchf. 386.—NELSON, J.; N. Y., 1848.

18. If, however, the form is a material part of the discovery, and is essential to its value, then a departure from the form would be a substantial departure, because form is essential to the invention. *Ibid.*, 386, 387.

19. There are, however, many new manufactures, where the particular form of the thing is not essential to its utility, and there may be a departure from that form, and still be no substantial change, because the particular form is not essential to the production of the manufacture. *Ibid.*, 386, 387.

20. An improvement in a burring machine consisted of hooked teeth, cut upon rings or plates, and these so arranged upon the cylinder that the wool or cotton, when taken up by the teeth, would be drawn into the interstices between the teeth, leaving the burrs and other foreign substances on the surface, to be knocked off by the beater; *Held*, that the change of form of the teeth from that of gullet teeth, having large slots

at the bottom, to that of the letter V, so as to make the slots at the bottom smaller, to operate better on the cotton, &c., was not a substantial change in the construction, but a modification of form, which was a natural result of working the machine. *Parkhurst v. Kinsman*, 1 Blatchf. 491, 497, 498.—NELSON, J.; N. Y., 1849.

21. Form and structure are very important matters in machinery: if they enable the operator to do the work in a better manner, or with more ease, or less expense, or in less time, they are not an interference, but constitute a patentable improvement. *Bain v. Morse*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1849.

22. When the application is for a patent for a combination of machinery and materials, form and structure become *substance*. Form and structure constitute the identity of machinery. *Ibid.*

23. A mere difference in form or size is not a difference in principle. *Foot v. Silsby*, 1 Blatchf., 459.—NELSON, J.; N. Y., 1849.

24. A formal change in a machine by a defendant, will not distinguish the invention or thing used from that of the plaintiff. That is an evasion. The change must be substantial. It must be a difference in the mechanical structure, in the physical existence of the thing, and also in its practical operation and effect in producing the result. *Buck v. Hermance*, 1 Blatchf., 406.—NELSON, J.; N. Y., 1849.

25. A mere change in form or proportion, or a substitution of mechanical means or equivalents in any one or all the elements of a combination producing the same results, does not constitute a substantial difference. *Gorham v. Mixer*, 1 Amer. Law Jour., N. S., 543.—SPRAGUE, J.; Mass., 1849.

26. A formal change, such as a change in proportions, a mere change of form, or a different shape, is not a change, within the meaning of the patent law, sufficient to support a patent. *Hall v. Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

27. A change in the form of a machine, embodying, however, the principle and substance of a prior invention, and which is only the result of practical experience in the use of such prior invention, is not an improvement upon such former invention. *Tracy v. Torrey*, 2 Blatchf., 278.—NELSON, J.; N. Y., 1851.

28. A change in form from the construction of an existing machine, or in its proportions, is not a substantial change, in the eye of the patent law. Such changes require no great ingenuity, and do not call for the exercise of the inventive faculty; they are simply the work of a mechanic. *Tutham v. Le Roy*, 2 Blatchf., 485, 486.—NELSON, J.; N. Y., 1852.

29. Under our law, a patent cannot be granted for merely a change of form. § 2 of the act of 1793 so declared in express terms, and though this declaratory law was not re-enacted in the law of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. *Winans v. Denmead*, 15 How., 341.—CURTIS, J.; Sup. Ct., 1853.

30. Merely to change the form of a machine is the work of a constructor, not an inventor: such a change cannot be deemed an invention. *Ibid.*, 341.

31. Where a patent was granted for constructing the body of a railroad car in the form of the frustum of a cone, and the claim was for making it in such form whereby certain specified advan-

tages were secured, and a new and useful result produced, and the defendants constructed the body of their car *octagonal*, the effect of which was, however, the same as when made circular, as described in the plaintiff's patent; *Held*, that it was an infringement upon plaintiff's patent, and that the plaintiff's patent, though describing only the form of a frustum of a cone, embraced every such variation of form as substantially embodied his mode of operation, and thereby attained the same result. *Ibid.*, 341-344. (TANEY, Ch. J.; CATRON, DANIEL, and CAMPBELL, JJ., dissenting.)

32. Where a particular geometrical form is alone capable of embodying a patentee's invention, if the form is not used, the invention is not copied, and there is no infringement; otherwise where that particular form is the best, but other forms may and do embody the invention. *Ibid.*, 343.

33. Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. *Ibid.*, 343.

34. Where a patentee describes a machine, and then claims it as described, he is generally understood to claim, and does, by law; actually cover, not only the precise forms he has described, but all other forms which embody his invention. *Ibid.*, 343.

35. There may be cases, as in *Davis v. Palmer*, 2 Brock., 309, where the letters patent include only the particular form described and claimed; but the reason why such a patent covers only one geometrical form is not that the patentee has described and claimed

that form only, but because such form only is capable of embodying his invention; and consequently, if the form is not copied, the invention is not used. *Ibid.*, 343.

36. Where form and substance are inseparable, it is enough to look at the form alone. Where they are separable—where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement, and it is no defence that it is embodied in a form not described, and in terms not claimed by the patentee. *Ibid.*, 343.

37. It is a well settled principle of law, that the mere change in the form of machinery (unless a particular form is specified as the means by which the effect described is produced), or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation, or organization, will not make the machine a new invention. *O'Reilly v. Morse*, 15 How., 123.—TANEY, Ch. J.; Sup. Ct., 1853.

38. A mere change in the form of machinery, or the means specified by which the result or effect described is produced, or an alteration in some unessential parts, or a substitution or use of known mechanical powers, not varying essentially the machine, or its mode of operation or organization, is not invention. *Amer. Pin Co. v. Oakville Co.*, 3 A. i. R., 138; 3 Blatchf., 192.—NELSON, JAGER-SOLL, JJ.; Ct., 1859.

39. Where in a patent for improvements in cooking stoves, the claim was

WHAT DEEMED TO BE; EFFECT OF.

"the placing the fire-chamber in the middle of the oven, so that the latter may receive the heat on three sides at once," but there was no peculiarity in the oven or fire-chamber, and the invention appeared to be, that instead of forming three ovens or compartments around the fire-chamber as usual, the inventor removed the partitions behind the fire-chamber, and made a single cooking space instead of three; *query*, whether the change is a patentable discovery. *Wilson v. Jones* 3 Blatchf., 229.—BETTS, J.; N. Y., 1854.

40. A change of form merely, or of mechanical structure, the practical effect of which is small, and from which no new or materially improved result is obtained, is not the subject of a patent. *Sargeant v. Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

41. A patent for an improvement in apple-paring machines, consisted in so attaching the knife-block to the rod, which moves it, as to allow the knife-block to rotate round the rod at right angles, to accommodate itself to any irregularities in the surface of the fruit. The defendants, instead of making the knife movable in the rod, made the rod movable in its socket, but the knife-block had the same motion; *Held*, that it was only a change of form, and an infringement on the patent. *Ibid.*, 349.

42. If the article produced is substantially the same with the one patented, the variations being in form and not in substance, or where no new or substantial result is produced, it will not affect the right of the patentee, but is an infringement on his rights. *Teese v. Phelps*, 1 McAllis., 49.—MCALLISTER, J.; Cal., 1855.

43. Mere formal changes of machinery do not evade a patent. *Sickles v.*

Borden, 3 Blatchf., 541.—NELSON, J.; N. Y., 1856.

44. However different apparently the arrangements and combinations of a machine may be from the machine of an inventor, it may in reality embody his invention, and be as much an infringement as if it were a servile copy of the plaintiff's machine. *Ibid.*

45. A change in the forms or proportions of instrumentalities—a substitution of one motive power for another—a different position or gearing of the working apparatus—a superior finish in any other particular, resting in mere mechanical skill or taste, and not involving invention—does not render machines appearing to the eye exceedingly unlike, substantially different in judgment of law. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

46. Although there may be a difference in form between two devices adopted for a given purpose, yet if there is no substantial difference in principle, a patent will not be granted. *Chatfield & Dutcher, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1859.

47. Differences in size and proportions, so long as the construction, arrangement, principles, and mode of operation are substantially the same, are entirely immaterial. *Cahoon v. Ring*, 1 Fisher, 411.—CLIFFORD, J.; Me., 1859.

FRAUD AND FRAUDULENT INTENT IN RESPECT TO PATENTS.

1. If, of two joint inventors of a machine, one of them, without the other relinquishing his interest to a joint interest in the patent-right, obtains a pat-

ent in his own name, he will be deemed guilty of a fraud, and will in equity be considered as a trustee for the other.

Reutgen v. Kanowrs, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. Under § 6 of the act of 1793 no defect or concealment in a specification will avoid a patent unless it arose from an intention to deceive the public.

Whittemore v. Cutter, 1 Gall., 437.—STORY, J.; Mass., 1813.

3. In an action for fraud in the sale of a patent-right, it is competent for the party to show that a previous patent had been granted for the same invention as that sold by the defendant. *Bull v. Pratt*, 1 Conn., 346.—SWIFT, Ch. J.; Ct., 1815.

4. The refusal of a defendant to submit his claim for a patent to arbitration, under § 9 of the act of 1793, and subsequently obtaining a patent after the plaintiff had obtained his, is not of itself *conclusive* proof, in an action brought under § 10 of the same act, that the patent of the defendant had been obtained surreptitiously or upon false suggestion. *Stearns v. Barrett*, 1 Mas., 174.—STORY, J.; Mass., 1816.

5. Under the act of 1793 if a specification is materially defective, it will not invalidate the patent unless the jury are satisfied that the concealment of the circumstances was intended to deceive the public. *Gray v. James*, Pet. C. C., 401.—WASHINGTON, J.; Pa., 1817.

6. What degree of evidence will be required to prove such fraudulent intention rests with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. It may be presumed from circumstances, which would be sufficient to authorize the jury to find the fact. *Ibid.*, 402.

7. If the specification is not so full,

clear, and exact as to enable a skilful person to compound and use the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective concealment or description has been made for the purpose of deceiving the public. *Lowell v. Lewis*, 1 Mas., 190.—STORY, J.; Mass., 1817.

8. A patent cannot be said to have been obtained surreptitiously or in fraud of another's right, under § 6 of the act of 1793, if the inventor gave up his right of discovery to the patentee, by expressly or impliedly permitting him to encounter the trouble and expense of obtaining a patent. *Dixon v. Moyer*, 4 Wash., 71, 72.—WASHINGTON, J.; Pa., 1821.

9. If a patentee include in his patent along with his own invention the invention of another person previously patented, and sell the whole to a person ignorant of these facts, and who supposed he was buying an exclusive right to the whole, the sale is a fraud upon such person, and the vendor cannot recover a note given for the purchase. *Turner v. Johnson*, 2 Cra. C. C., 287.—CRANCH, J.; D. C., 1822.

10. If an inventor suffer his invention to go into general and public use without objection, and assert no title to it for years, and then afterward attempts to gain the exclusive right by a patent, and secure it by a patent, such attempt would operate as a fraud upon the public. *Mellus v. Silsbee*, 4 Mas., 111.—STORY, J.; Mass., 1825.

11. If the public, with the knowledge and tacit consent of the inventor is permitted to use an invention without opposition, it is a fraud upon that public afterward to take out a patent. *Pennock v. Dialogue*, 4 Wash., 544.—WASHINGTON, J.; Pa., 1825.

12. Under the act of 1790, if an inventor allowed his invention to go into public use, it was deemed a fraud in law if after such use he took out a patent, such use being considered as an abandonment. *Whitney v. Emmett*, Bald., 309, 310.—BALDWIN, J.; Pa., 1831.

13. Under the act of 1793, evidence of fraudulent intent as to the concealment or addition of something contained in the specification of a patent, is required only in the particular case, and for the particular purpose stated in § 6, that is, to annul the patent. *Grant v. Raymond*, 6 Pet., 247.—MARSHALL, Ch. J.; Sup. Ct., 1832.

14. If a party should seek to include several distinct improvements in one patent, so that there should be but one surrender, and the payment of but one fee under § 13 of the act of 1836, and take out several new patents, it would be such a "fraudulent and deceptive intention" as would prevent the issuing of a patent after the surrender. *Anon.*, 3 Opin., 165.—BUTLER, Atty. Gen., 1836.

15. A offered to sell a patent-right to B, who declined to purchase unless C would join with him. A then went to C and agreed with him that he should join with B, and that he, A, would take the notes of each for half the agreed sum; but as soon as the business was closed he would give back to C his note, and pay him for thus inducing B to buy. B was thus induced to buy, but he afterward sold his interest for more than he gave for it. In an action by B against A for the fraud, *Held*, that B had a right to recover against A any damages he might have suffered by not having C as a joint owner to aid or assist in making sales of the patent, and that the fact that he had sold his interest for more than he gave for it,

did not show that he had not sustained damage. *Culver v. Webb*, 12 Conn., 441, 443.—WAITE, J.; Ct., 1838.

16. An inventor who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using reasonable diligence in adapting and perfecting the same. *Reed v. Cutter*, 1 Story, 599.—STORY, J.; Mass., 1841.

17. The defence authorized by § 15 of the act of 1836, that the plaintiff had "surreptitiously or unjustly obtained his patent for that which was in fact invented or discovered by another," is only applicable in the case of a patent so obtained, while the "first inventor was using reasonable diligence in adapting and perfecting his invention;" and if pleaded, it may be necessary for the defendant to show, in order to vacate such patent, that he was using reasonable diligence, when the patent was obtained. *Perry v. Cornell*, MS. (App. Cas.)—CRANCH, Ch. J.; D. C., 1847.

18. Though the provision rendering a patent valid, notwithstanding too much is claimed in the specification, is limited to cases where the excessive claim was made by mistake and without fraudulent intent, still, as fraud is not to be presumed, the patentee claiming the benefit of the provision, need not prove that he acted under a mistake and from honest motives. Those who attack the patent must establish the fraud. *Hotchkiss v. Oliver*, 5 Denio, 318.—McKISSECK, J.; N. Y., 1848.

19. Where fraud is charged upon a party, in respect to his patent, it must be made out at least *prima facie*. *Good-year v. Day*, MS.—GRIER, J.; N. J., 1850.

20. The fact of procuring a patent for a new and useful machine, under the assumption of a reissue, which was not useful as patented in the surrendered patent, for want of some parts used in the reissued patent, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby overreaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brooks v. Fiske*, 15 How., 220.—CATRON, J.; Sup. Ct. 1853.

21. A question of fraud in the granting of a patent will not be passed upon by the justices of the Circuit Court of the District of Columbia, on an appeal from the decision of the Commissioner of Patents, but such question is to be tried by a jury. *Burlew v. O'Neil*, MS.—MORSELL, J.; D. C., 1853.

22. Where a party seeks in equity to have an assignment of a patent rescinded, and the consideration restored to him, on the ground of fraud, but he has acted under such assignment by making sales under it, he should aver that any such proceeds were received by him prior to the discovery of the fraud, and he should return, or offer to return, the consideration received by him. He that asks, must do equity. *Edmunds v. Myers*, 16 Ill., 210, 211.—SCATES, J.; Ill., 1854.

23. If fraud has been practised, as in the sale of a pretended patent, a court may rescind the contract, and compel a return of what has been paid; but it will at the same time compel the complainant to account for what he has received, and the profits derived from the use or sale of it. *Ibid.*, 211.

24. Parties defrauded, or those in-

jured by the fraud, can alone take advantage of it, to annul a contract. *Edmunds v. Hildreth*, 16 Ill., 215.—SCATES, J.; Ill., 1854.

25. Parties to a fraud cannot avoid the act for the fraud. *Ibid.*, 215.

26. If the party injured acquiesce in, or confirm the contract with a knowledge of the fraud, no one can have a right to annul it for him. *Ibid.*, 216.

27. A contract for the purchase of a patent, may be rescinded for false and fraudulent representations, constituting an inducement to it, and whether the party making them knew them to be false or not. *Gatling v. Newall*, 9 Ind., 576.—PERKINS, J.; Sup. Ct., Ind., 1857.

28. But such representation must be as to a fact or facts, and go to a material issue; and must be one on which the party to whom it is made has a right to, and does rely. *Ibid.*, 576.

29. A party, however, who would rescind a contract on the ground of fraud, must offer to do so within a reasonable time after the fraud is discovered. *Ibid.*, 577.

30. The defence that the plaintiff had "surreptitiously and unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same," does not necessarily imply bad faith on the part of the patentee, against whose patent this defence is set up. The injustice relied on is rather injustice in the abstract, than resulting from any intentional wrong of such patentee. The words were intended to be used, and are used in their broadest sense. *Phelps, Dodge & Co. v. Brown Bros.*, 4 Blatchf., 364.—NELSON, J.; N. Y., 1859.

GENERAL ISSUE AND NOTICE
OF SPECIAL MATTER.

A. EVIDENCE UNDER GENERAL ISSUE.....	341
B. WHEN NOTICE REQUIRED; WHAT TO CONTAIN.....	342
C. WHEN SPECIAL PLEAS ALLOWABLE....	346

A. EVIDENCE UNDER GENERAL ISSUE.

1. There is no limitation of time in which a defendant may not plead the general issue and give in evidence that the plaintiff was not the original inventor of the thing for which the patent was granted. *Evans v. Eaton*, Pet. C. C., 348.—WASHINGTON, J.; Pa., 1816.

2. Whether in an action for an infringement of a patent-right under the general issue, the objection can be taken to the validity of the patent, that the thing patented was not useful, and had been abandoned; *query*. The defence is by no means involved in the general issue. *Gray v. James*, Pet. C. C., 402.—WASHINGTON, J.; Pa., 1817.

3. The originality of an invention is not in issue on a plea of not guilty. *Evans v. Hettick*, 3 Wash., 411.—WASHINGTON, J.; Pa., 1818.

4. Under the plea of the general issue, the defendants may give in evidence the act of Congress without notice; but this permission extends no further than to exempt the defendant from the necessity of pleading the statute specially, which, where it is of a private nature, it would otherwise be necessary to do. *Kneass v. Schuylkill Bank*, 4 Wash., 11.—WASHINGTON, J.; Pa., 1820.

5. Matters of a special nature, other than those enumerated in § 6 of the act of 1793, as alienage of the plaintiff, and

a license by him to use the patented invention may also be given in evidence under the general issue. *Ibid.*, 11.

6. The defences enumerated in § 6 of the act of 1793, that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the desired effect, and this with a view to deceive the public, cannot be set up at the trial, unless due notice has been given to the plaintiff. *Ibid.*, 13.

7. But under the general issue without notice, the defence may be made that the patent is broader than the discovery; that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original invention; that the suggestions of the petition are not recited in the patent, and others similar in principle. *Ibid.*, 13.

8. Evidence on the part of the defendant as to whether the machine used by him is like the model of plaintiff's machine, produced in court, is proper under the general issue, and no notice is necessary to authorize such inquiry. *Evans v. Hettick*, 7 Wheat., 469.—STORY, J.; Sup. Ct., 1822.

9. Under the plea of the general issue, without a notice to that effect, or special pleas setting up such defence, evidence tending to show a want of novelty in the invention claimed by the plaintiff, is not admissible. *Root v. Ball*, 4 McLean, 180.—MCLEAN, J.; Ohio, 1846.

10. A witness cannot be asked whether there are not other machines in use similar to that patented by the plaintiff, unless notice is given, as the statute requires. *Parker v. Haworth*, 4 McLean, 371.—MCLEAN, J.; Ill., 1848.

11. Under a plea of the general

issue, evidence may be introduced to show fraud or fraudulent representations on the part of the plaintiff as to the subject matter of the suit. *Good-year v. Day*, MS.—GRIER, J.; N. J., 1850.

B. WHEN NOTICE REQUIRED; WHAT TO CONTAIN.

1. § 6 of the act of 1793, does not enumerate all the defences of which the defendant may legally avail himself; he may give in evidence that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. *Whittemore v. Cutter*, 1 Gall., 435.—STORY, J.; Mass., 1813.

2. Under § 6 of the act of 1793, in an action for a violation of a patent, if the general issue be pleaded with notice of special matter that the patentee is not the original inventor, it will be sufficient in such notice to state that the plaintiff is not the first inventor, without setting forth who was the inventor, or specifying where the machine had been used. *Evans v. Kremer*, Pet. C. C., 215.—WASHINGTON, J.; Pa., 1816.

3. If the notice specify where the machine had been used, evidence may be given of its use in other places than those particularly specified. *Ibid.*, 215.

4. Under a notice of special matter, specifying certain places in which a machine like that of which the plaintiff claimed to be the inventor, had been in use anterior to the supposed discovery of the plaintiff; *Held*, that the plaintiff could give in evidence that such machine had been used in places other than those particularly named in the notice. *Evans v. Eaton*, Pet. C. C.,

338.—WASHINGTON, J.; Pa., 1816. [Affirmed *post* 11.]

5. All matters of defence or of objection to a patent are not enumerated in §§ 6 and 10 of the act of 1793. *Lowell v. Lewis*, 1 Mas., 186.—STORY, J.; Mass., 1817.

6. But it is not a matter of defence that the invention of the patentee is not of such general utility as to supersede others of the same kind in use. *Ibid.*, 186.

7. The object of the statute of 1793, ch. 9, § 6, was to guard against defeating patents by the setting up a prior invention which had never been reduced to practice. If it was the mere speculation of a philosopher or a mechanic, which had never been tried by the test of experience, and never put in actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. *Bedford v. Hunt*, 1 Mas., 305.—STORY, J.; Mass., 1817.

8. Although in the statute, § 6 of the act of 1793, a prior patent is not mentioned in the notice of special matter to be given in evidence, this omission does not afford sufficient ground to reject such evidence, but it furnishes a reason to require the defendant to give a satisfactory explanation of the principles of the machine described in such patent, and the manner in which it is operated. *Gray v. James*, Pet. C. C., 400.—WASHINGTON, J.; Pa., 1817.

9. The section of the patent act relative to notices of special matter with the general issue, appears to have been drawn on the idea that the defendant would not be at liberty to contest the validity of a patent on the general issue;

and intends to relieve the defendant from the difficulties of pleading, by allowing him to give in evidence matter which affects the patent. Such notice is however for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of the privilege.

Evans v. Eaton, 3 Wheat., 503, 504.—MARSHALL, J.; Sup. Ct., 1818.

10. And such notice need only be given when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course, but may set up the special matter, by special pleas, and then the plea is the only notice the plaintiff can claim. *Ibid.*, 504.

11. Under such notice evidence may be given as to previous use, not only as to the places specified in the notice, but also as to other places not specified. *Ibid.*, 504, 505.

12. Under a notice that evidence would be offered to prove that the patentee was not the original discoverer of the thing patented, but that it had been in use in various places in the *United States*, evidence cannot be given of a prior use in England. *Dixon v. Moyer*, 4 Wash., 74.—WASHINGTON, J.; Pa., 1821.

13. No notice is necessary to authorize the inquiry by defendant of a witness on his examination in chief, whether the machine used by defendant was like the model of plaintiff's machine exhibited in court. Such inquiry is perfectly proper under the general issue. *Evans v. Hettick*, 7 Wheat., 469.—STORY, J.; Sup. Ct., 1822.

14. If the notice of special matter mention the names of certain persons who had used the invention before plaintiff's patent, evidence may be given of

its prior use by persons other than those named. *Treadwell v. Bladen*, 4 Wash., 705.—WASHINGTON, J.; Pa., 1827.

15. § 6 of the act of 1793 does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. *Pennock v. Dialogue*, 2 Pet., 23.—STORY, Sup. Ct., 1829.

16. It is not inconsistent with the principle or meaning of such section that a defence may be made, that, although the patentee is the first as well as the true inventor, he has abandoned or dedicated his invention to the public. *Ibid.*, 23.

17. A party who only seeks to defend himself, may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793. If he shows that the patentee has failed in any of the prerequisites on which the authority to issue the patent is made to depend, his defence is complete, and he is entitled to the verdict of the jury and the judgment of the court. *Grant v. Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

18. But if not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to § 6 of the act of 1793, and "fraudulent intent" must be found by the jury to justify a judgment of *vacatur* by the court. *Ibid.*, 247.

19. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which that section requires. *Ibid.*, 247.

20. Where a defendant in a patent suit relies on the fact of previous invention, knowledge, or use of the thing patented, he must, under § 15 of the act of 1836, give notice of the persons by whom he intends to prove such fact. Without such notice he cannot examine witnesses relative thereto, and the *onus probandi* is on the defendant to show that the notice has been given. *Phil. & Tren. R.R. v. Stimpson*, 14 Pet., 459.—STORY, J.; Sup. Ct., 1840.

21. The language of the act of 1836, § 15, requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the names of the places at which it had been used. The names and residences of all the witnesses who are to be summoned need not be given. *Wilton v. The Railroads*, 1 Wall, Jr., 195.—GRIER, J.; Pa., 1847.

22. This provision was intended to guard against surprise from such evidence as was given in Whitney's case, the cotton gin; one witness testifying that he had seen such an invention in England, seventeen years before; and another, that he had seen a like machine in Ireland. *Ibid.*, 195.

23. In the notice of special matter, the defendant is only required to give notice of the name of the person having a prior knowledge, and need not give the names of the witnesses by whom such prior knowledge is to be proved. *Many v. Jagger*, 1 Blatchf. 376.—NELSON, J.; N. Y., 1848.

24. The defendants, in their notice of special matter, under § 15 of the act of 1836, had given notice that one Baldwin had had prior knowledge of the plaintiff's invention before his patent therefor. On the trial, they called one

Fry as a witness to prove that Baldwin had such prior knowledge. The witness was objected to, because his name was not in the notice; but the court held he was a competent witness to prove such fact, and that it was not necessary to insert his name in the notice. *Ibid.*, 376.

25. In the notice of special matter given under § 15 of the act of 1836, reference was made to a certain work as "Ure's Dictionary of Arts, Manufactures, and Mines," the title-page of which read, "A Dictionary of Arts, Manufactures, &c., by Andrew Ure, M. D., &c., London, &c., 1840;" *Held*, that the title was sufficiently correctly indicated in the notice. *Foot v. Silsby*, 1 Blatchf., 451, 452.—NELSON, J.; N. Y., 1849.

26. *Held*, however, that no part of the work could be read in evidence, because the notice did not specify any page or heading to which reference would be made. The volume contained 1,334 pages, and was arranged alphabetically. A general reference to a work is calculated to mislead and embarrass a party; there should be a particular reference to the part of the book intended to be relied on. *Ibid.*, 454, 462. [Affirmed *post* 30.]

27. *Held*, also, that under such notice the book was not admissible for the purpose of showing that the invention was previously known to Dr. Ure, the author of the work. *Ibid.*, 454, 462.

28. *Held*, also, in the case of such a defective notice, that it was not competent, with a view to show that the notice was sufficiently explicit and specific and thus allow the book to be read in evidence, to prove by experts and scientific men that they could, in seeking information as to the subject matter of the

plaintiff's patent, without difficulty find the portions proposed to be read, without special reference to them. *Ibid.*, 454, 462.

29. Nor can a public work be read in evidence to show a want of novelty in the plaintiff's invention, the only notice of which volume was given in a special plea, which had, before the trial, been stricken out by the court. *Ibid.*, 454, 462.

30. A general reference, in a notice of special matter with the general issue, to a volume, as "Ure's Dictionary of Arts, Manufactures, and Mines," in which an invention has been described, is not sufficient, but there must be a more particular reference to the part relied on, either by pages, titles, or otherwise. *Silsby v. Foote*, 14 How., 222.—CURTIS, J.; Sup. Ct., 1852.

31. Nor can such book, under such a notice, be referred to as evidence of prior knowledge and use, by said Ure, the notice not stating where the thing was used. *Ibid.*, 224.

32. In an action of infringement, a defendant will not be allowed to surprise a patentee by evidence of a prior invention, of which no notice has been given, even though such evidence is contained in a volume of law reports, which are usually cited as of course. *O'Reilly v. Morse*, 15 How., 110.—TANNEY, Ch. J.; Sup. Ct., 1853.

33. A notice of special matter may be filed, or served, in term-time, but it must be filed full thirty days before trial. *Brunswick v. Holzalb*, MS.—LEAVITT, J.; Ohio, 1858.

34. Notices of special matter, in the seventh circuit, as to the prior use of the invention, the places where used must specify the street or factory where the structure was used, which was claim-

ed to be the same as that patented, or the name of the person or owner using it should be given; the name of the city or town is not sufficiently definite as to place. *Latta v. Sharok*, 1 Fisher, 467.—LEAVITT, J.; Ohio, 1859.

35. It is always presumed from the patent itself that the invention is new, and if a party sued would avail himself of the want of such novelty, it is incumbent upon him to prove it by giving a proper notice to the plaintiff to prevent surprise. *Coleman v. Leisor*, MS.—LEAVITT, J.; Ohio, 1859.

36. The provision of the statute requiring notice of the previous use of a patented thing is designed to give the patentee the benefit of an examination into the facts of the supposed prior use. *Ibid.*

37. In the seventh circuit such notice must specify the particular place of such prior use; a reference merely to the county in which such prior use happened is not sufficient. *Ibid.*

38. Under the provision of § 15 of the act of 1836, a defendant may, under the general issue, and with notice as required by that act, give any special matter in evidence, tending to prove that the patentee was not the original and first inventor or discoverer of the thing patented, or a substantial or material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery by the patentee, or had been in public use or on sale, with the consent and allowance of the patentee, before his application for a patent. *Teese v. Huntingdon*, 23 How., 7.—CLIFFORD, J.; Sup. Ct., 1859.

39. But whenever the defendant relies on the fact of a previous invention, or knowledge, or use, he must state in

WHEN SPECIAL PLEAS ALLOWABLE.

his notice the names and places of residence of those who had such prior knowledge of the thing, and where the same had been used. *Ibid.*, 7.

40. No order of court is necessary to entitle a defendant to serve and file the notice of special matter required in § 15 of the act of 1836. It is only necessary that such notice be in writing, and be served more than thirty days before the trial. *Ibid.*, 10.

41. And if a first notice is defective, or not sufficiently comprehensive to admit the proper defence, the defendant may give other notices to remedy such defect, or supply the deficiency. *Ibid.*, 10.

42. Under such notice, depositions taken before the notice was served, as well as those taken afterward, are admissible, provided the depositions are applicable to the matters thus put in issue. *Ibid.*, 10.

43. In the seventh circuit, in the notice given of the prior use of a patented invention, it is necessary not only to state where and by whom it was so used, but such notice should also set forth the name of the person who had knowledge of such use, and by whom such fact is to be proved. *Judson v. Cope*, 1 Fisher, 617.—LEAVITT, J.; Ohio, 1860.

44. Notice of the time when the person possessed the knowledge or use of the invention is not required by the act; the name of the person, and of his place of residence, and the place where it has been used, are sufficient. *Phillips v. Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

C. WHEN SPECIAL PLEAS ALLOWABLE.

1. The notice mentioned in the statute is required only to be given when

it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. And a plea would not be defective which did not state the places in which the thing alleged to have been previously used was placed or used. *Evans v. Eaton*, 3 Wheat., 504.—MARSHALL, Ch. J.; Sup. Ct., 1818.

2. If the defendant only seeks to defend himself, he may either plead specially or plead the general issue, and give the notice required by § 6 of the act of 1793 of any special matter he means to use at the trial. If he shows that the patentee has failed in any of the prerequisites on which the authority to issue the patent is made to depend, his defence is complete. *Grant v. Raymond*, 6 Pet., 246.—MARSHALL, Ch. J.; Sup. Ct., 1832.

3. But if he seeks to annul the patent, he must proceed in exact conformity to § 6 of the act of 1793. *Ibid.*, 246.

4. The defendant is permitted to proceed according to § 6, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which that section requires. *Ibid.*, 247.

5. Instead of pleading the general issue, and giving notice of special matter as authorized by the statute, the defendant may plead special pleas, setting up the matters of which he could give notice. The right to plead the general issue, and give notice, is an enlargement of the defendant's mode of defence, but does not take away his right to plead

specially. *Phillips v. Comstock*, 4 McLean, 525.—McLEAN, J.; Ind., 1849.

6. In an action for the infringement of a patent, the defendants pleaded the general issue, and also numerous special pleas, and also gave notice of special matter under § 15 of the act of 1836. The matters set forth in the special pleas were those of which notice might have been given under § 15. On motion the special pleas were struck with costs. *Wilder v. Gayler*, 1 Blatchf., 597, 598.—NELSON, J.; N. Y., 1850.

7. The matters required by § 15 to be set forth in the notice accompanying the general issue, cannot be plead specially as matters of defence. *Ibid.*, 598. [Overruled, 1853, *post* 12, 13.]

8. There may, however, be grounds of defence not specified by § 15, which might be set up in bar of the action, by special plea. *Ibid.*, 598.

9. The defences, mentioned and allowed by § 15 of the act of 1836, to be given in evidence with the general issue, by way of notice, need not, however, be made in such particular manner, but may also be set up by special pleas. *Smith v. Ely*, 15 How., 141.—TANEY, Ch. J.; Sup. Ct., 1853.

10. A defendant is not limited to the plea of the general issue, even if his defence rests upon matters which may by statute be given in evidence under the general issue, but he may plead those matters specially. *Day v. N. E. Car Spring Co.*, 3 Blatchf., 181.—BETTS, J.; So. N. Y., 1854.

11. To an action for the infringement of a patent brought by an assignee of the patentee, the defendant, with the general issue, pleaded special pleas, not impeaching the validity of the patent, or denying his use of the patented invention, but setting up a license under

the patentee paramount to the right of the plaintiff; *Held*, that such pleas did not amount to the general issue, and should not be stricken out on motion. *Ibid.*, 182.

12. Under the decisions of the Supreme Court, *Evans v. Eaton*, 3 Wheat., 504, and *Grant v. Raymond*, 6 Pet., 246, in actions at law for the infringement of a patent, a defendant is not limited in his defence to the plea of the general issue, even if his defence rests upon matters which the statute authorizes to be given in evidence under § 15 of the act of 1836, but he may plead those particulars specially. *Ibid.*, 181.

13. The case of *Wilder v. Gayler*, 1 Blatchf., 598, in so far as it is in conflict with those cases must be considered erroneous and not a binding authority. *Ibid.*, 181.

14. Where notice of special matter is given under the general issue, special pleas cannot also be filed; at least, such seems to be the practice in the seventh circuit. *Latta v. Shawk*, 1 Fisher, 467.—LEAVITT, J.; Ohio, 1859.

GOOD-WILL OF BUSINESS.

1. The good-will of an established trade, the custom of an inn, and the right of a publisher of books, may be injured by acts of deception and piracy; but the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment or upon the public. *Snowden v. Noah*, Hop. Ch., 352.—WALWORTH, Chan.; N. Y., 1825.

2. The good-will of a trade does not survive, but is partnership property. The continuing partners cannot be com-

pelled to take the lease and good-will at a valuation, as that would be compelling them to become purchasers. *Dougherty v. Van Nostrand*, 1 Hoff. Ch., 69.—HOFFMAN, V. Ch.; N. Y., 1839.

3. If not disposed of by consent, the good-will must be sold as other partnership property. *Ibid.*, 69.

4. The good-will of a business built up by the several partners belongs equally to all, and is an important and valuable interest, which the law recognizes and will protect. *Williams v. Wilson*, 4 Sand. Ch., 380.—SANDFORD, V. Ch.; N. Y., 1846.

5. Unless otherwise arranged between the partners, such good-will will be sold with the lease of the place where carried on, and either of the partners may become purchasers. If neither purchase, all will be restrained from conducting the same business, either directly or indirectly, in the same place. *Ibid.*, 381.

6. It is a well settled rule that the good-will of a partnership business does not survive to a continuing partner. It belongs to a firm as much as the ordinary stock-in-trade, and must be disposed of in some manner for the benefit of the firm. *Howe v. Searing*, 19 How. Pr., 17.—HOFFMAN, J.; N. Y., 1860.

7. Good-will resolves itself into reputation. *Ibid.*, 17.

8. The sale of the good-will of a business does not transfer a right to the use of the vendor's *name of trade*. *Ibid.*, 25.

9. Where the plaintiff sold to the defendant's assignor his lease of the premises known as "Howe's Bakery," together with the stock-in-trade, and the "good-will of the business of baking, now or heretofore carried on by me

in the city of New York," *Held*, that the plaintiff was entitled to an injunction to restrain the defendant from designating his bakery establishment as "Howe's Bakery," and from otherwise using the name of *Howe* in his business, so as to induce the public to believe that the business carried on by him was carried on by the plaintiff. *Ibid.*, 25.

10. It is a principle of public policy that any business should be transacted under the name of the actual partners doing it, and not under other names. *Ibid.*, 25.

11. The neglect of a party to carry on his business for a number of years does not prevent him from resuming the same, or entitle another to use the name of his business. *Ibid.*, 25.

GRANTEE OF PATENT, WHO IS.

See ASSIGNEE, B. 1.

IMPROVEMENTS.

A. WHAT PATENTABLE; AND TO WHAT EXTENT.....	348.
B. HOW SHOULD BE SET FORTH.....	352.
C. PATENT FOR; WHAT SECURED BY; CONSTRUCTION OF.....	355.

A. WHAT PATENTABLE; AND TO WHAT EXTENT.

1. An improvement on the *principle* of a machine is patentable, but an improvement in *form* or *proportions* is not. *Reutgen v. Kanows*, 1 Wash., 171.—WASHINGTON, J.; Pa., 1804.

2. An improvement in the *principle*

of a machine is no invasion of the rights of the inventor and patentee of such machine—otherwise, if it is only an improvement in the *form*. *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

3. It is difficult to define the cases, where the whole machine may be deemed a new invention, and where only an improvement; the cases often approach very near each other. In the present improved state of machinery, it is almost impracticable not to employ the same elements of motion, and in some particulars, the same manner of operation, to produce any new effect. *Whittemore v. Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

4. If a person is not an inventor of the whole machine, but only of an improvement thereof, he is entitled to only a patent for the improvement. *Ibid.*, 479.

5. Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine, to produce the same effects in a better manner, a patent cannot be taken for the whole machine, but for the improvement only. *Ibid.*, 480.

6. On the other hand, if well-known effects are produced by machinery, in all its combinations *entirely new*, a patent may be claimed for the whole machine. *Ibid.*, 480.

7. If a machine substantially existed before, and a person has made an improvement only thereon, he is entitled to a patent for such improvement only, and not for the whole machine. *Woodcock v. Parker*, 1 Gall., 439.—STORY, J.; Mass., 1813.

8. If a person invent an improvement on a machine, he is entitled to a patent for such improvement only, and not

for the original machine. *Odiorne v. Winkley*, 2 Gall., 53.—STORY, J.; Mass., 1814.

9. If the discovery be of an *improvement* only, it must be an improvement of the principle of a machine, art or manufacture, before known or in use. If only in the form or proportions, it has not the merit of a discovery which can entitle the party to a patent. *Evans v. Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816..

10. A machine or improvement may be new, and the proper subject of a patent, although the parts of it were before known and in use. *Ibid.*, 343.

11. Where an inventor makes an addition or improvement to a combination of machinery, he must confine his patent to the improvement; if he takes a patent for the whole machine as improved, not limiting it to the improvement, it is void, because as so claimed, it is not his invention. *Barrett v. Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

12. If an invention consist in a new combination of machinery, or in improvements upon an old machine, to produce an old effect, the patent should be for the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. *Ibid.*, 476.

13. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded together. *Evans v. Eaton*, 3 Wheat., 516.—MARSHALL, Ch. J.; Sup. Ct., 1818.

14. If the same combinations existed before, in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of

operating, to the old, the patent should be limited to such improvement. *Evans v. Eaton*, 7 Wheat., 430.—STORY, J.; Sup. Ct. 1822.

15. If an improvement is new and useful, and has not been known or used before, it constitutes an invention within the terms and meaning of the patent acts, and the inventor is entitled to a patent. *Earle v. Sawyer*, 4 Mas., 7.—STORY, J.; Mass., 1825.

16. A machine, and an improvement on a machine, or an improved machine, must not be confounded; a grant of the exclusive use of an improvement in a machine, principle, or process, is not a grant of the improvement only, but the improved machine: an improvement on a machine and an improved machine, are the same. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

17. If the same combination existed before, up to a certain point, and the invention consists in adding some new machinery, in some improved mode of operation, or some new combination, the patent must be limited to the improvement. *Ibid.*, 314.

18. A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle, and the application of it, to constitute such an improvement as the law will protect. *Smith v. Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

19. An improvement, to entitle a person to a patent, must not only be new, but useful; it must be a substantial, material improvement. Mere colorable or slight improvements cannot affect the rights of the original inventors. *Street v. Silver*, Brightly, 99, 100.—ROGERS, J.; Pa., 1846.

20. If an improvement be made on an original invention, a patent may be obtained for such improvement. But a substantial part of an original invention cannot be patented as an improvement. *Smith v. Ely*, 5 McLean, 88.—MCLEAN, J.; Ohio, 1849.

21. An improvement upon an old contrivance, in order to be the subject of sufficient importance to support a patent, must embody some originality, and something substantial in the change, producing a more useful effect and operation. *Hall v. Wiles*, 2 Blatchf., 200.—NELSON, J.; N. Y., 1851.

22. In determining this question, the jury have a right to take into consideration, in connection with the change, the result which has been produced; because the result, if greatly more beneficial than it was with the old contrivance, reflects back, and tends to characterize, to some degree, the importance of the change. *Ibid.*, 200.

23. In an action of infringement, it was objected that the arrangement and combination of the plaintiff's improvement was so simple and obvious, that it was not the subject of a patent; *Held*, that novelty and utility in the improvement was all that the statute required as a condition to granting a patent. *McCormick v. Seymour*, 2 Blatchf., 243, 244.—NELSON, J.; N. Y., 1851.

24. A change of construction in a machine, which is only the result of practical experience in the use of such machine, is not, in law, an improvement on it. *Tracey v. Torrey*, 2 Blatchf., 278.—NELSON, J.; N. Y., 1851.

25. An improvement of a machine, for which a patent may issue, may consist in the introduction of a new element into an old machine, so as to produce new power or greater facility in

the application of power. *Rheem v. Holliday*, 16 Penn., 352.—COULTER, J.; Pa., 1851.

26. *Seemle*, that improvements made by workmen, working under the pay of an inventor, and making experiments under his directions, are to be considered for the credit and benefit of such inventor. *Goodyear v. Day*, MS.—DICKERSON, J.; N. J., 1852.

27. An improvement on a combination is the subject of a patent, but at the same time the improvement cannot be used without the consent of the original patentee. *Foster v. Moore*, 1 Curt., 293.—CURTIS, J.; Mass., 1852.

28. One may discover an improvement in a process, irrespective of any particular form of machinery. *Corning v. Burden*, 15 How., 267.—STORY, J.; Sup. Ct., 1853.

29. A patent for an improvement of a machine, is the same as a patent for an improved machine. *Fultz, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1853.

30. Improvement applied to machinery is where a specific machine already exists, and an addition is made to produce the *same effects* in a better manner, or some new combinations are added to produce *new effects*. *Ibid.*

31. Under § 13 of the act of 1836, a patentee may, if he desires it, annex an improvement upon a former invention, already patented, to his former specification, so as to make it from that time a part of the original patent. But there is nothing in the act which forbids him taking out a new patent for the improvement, if he prefers it. *O'Reilly v. Morse*, 15 How., 122.—TANEY, Ch. J.; Sup. Ct., 1853.

32. Nor is he bound in his new patent, to refer specially to his former one. All that is required is that he shall not

claim as new what is covered by a former invention. *Ibid.*, 122.

33. An improvement upon a machine to constitute it an invention, must be new and useful. *McCormick v. Seymour*, 3 Blatchf., 213.—NELSON, J.; N. Y., 1854.

34. There must be novelty in the arrangement of the improved machinery—novelty created by the mind of the person claiming to be the inventor—and in connection with that novelty there must be utility. *Ibid.*, 213.

35. Improvements and discoveries the most important in their consequences and in their beneficial effects on the business interests of the community, are oftentimes among the simplest ideas of the mind; and again, improvements of less magnitude in their consequences and in their beneficial effects, indicate the most laborious and complex exertion of the mind of the inventor. *Ibid.*, 213.

36. An improvement on a combined machine is patentable. *Pitts v. Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

37. An improvement has *essential* reference to a subject matter to be improved. It is not an original, but embraces, and either adds to or alters the original. *Page v. Ferry*, 1 Fisher, 301.—WILKINS, J.; Mich., 1857.

38. When an alleged invention purports to be an improvement on an existing machine, the inquiry as to what is new and what old, must be, not whether the same elements of motion or the same component parts are used, but whether the given *effect* is produced substantially by the same mode of operation, and the same combination of powers in both machines; or whether some new element, combination, or feature, had been added to the old machine, which produces either the same

effect in a cheaper or more expeditious manner, or an entirely new effect, or an effect in some material respect *superior*, though in other respects similar to that produced by the old machine. *Hibbard, Ex parte*, MS. (App. Cas.)—MORSELL, J.; D. C., 1857.

39. If a change introduced constitute a mechanical equivalent in reference to the means used by another patentee and besides being such an equivalent, accomplishes some other advantages beyond the effect or purpose accomplished by the patentee, such further advantage may make it a patentable subject or an improvement upon the former invention. *Ibid.*

40. If a person invent a new mechanical device or arrangement, to be used in the place of a former device or arrangement, which was a part of a certain combination, and which new device is independent of all other similar devices, and is not to be used in conjunction with, or in aid of, or in addition to, such old device, which made one of the elements of the old combination, he may have a patent for a combination containing his new device or arrangement, in connection with the remaining parts of the old combination, as such combination constitutes a new machine, and not an improvement merely on the machine containing the combination of the old elements. *Potter v. Holland*, 4 Blatchf. 244.—INGERSOLL, J.; Ct., 1858.

41. But if such new mechanical device is but an improvement on the old or former one, and is to be used in conjunction with, or in aid of, or in addition to, the old one, then, it seems, he could only have a patent for his improvement, in that element of the combination, and not for the whole combination. *Ibid.*, 245.

B. HOW SHOULD BE SET FORTH.

1. The patentee must describe in full and exact terms in what his invention consists; and if it be an improvement only upon an existing machine, he should distinguish what is new and what is old, in his specification, so that it may clearly appear for what the patent is granted. If, therefore, the description mixes up the old and the new, and does not distinctly ascertain for which in particular the patent is claimed, it is void. *Lowell v. Lewis*, 1 Mas., 188.—STORY, J.; Mass., 1817.

2. It is sufficient, however, if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty; for it is not to be left to minute inferences and conjectures as to what was previously known or unknown; since the question is not what was before known, but what the patentee claims *as new*. *Ibid.*, 188.

3. If, however, the invention is described with such reasonable certainty as to distinguish the same from all things before known, but the specification is not in such full, clear, and exact terms as to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same, this, under § 6 of the act of 1793, does not avoid the patent, unless the defective description or concealment has been made for the purpose of deceiving the public. *Ibid.*, 188, 189.

4. If a patent be for an improved machine, or for an improvement on a machine (the terms meaning substantially the same), the patent must state in what the improvement specifically consists,

and it must be limited to the improvement. *Barrett v. Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

5. A general statement that the patented article is in all respects, without stating what these are, an improvement on an old article, is no specification at all. *Ibid.*, 478.

6. Where a patent is for an improvement the specification must describe in full, clear, and exact terms what the improvement is: 1st, to enable the public to enjoy the full benefit of the discovery when the monopoly is expired, by having it so described on record that it can be constructed, and 2d, to put every citizen on his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee. *Evans v. Hettick*, 3 Wash., 425, 426.—WASHINGTON, J.; Pa., 1818.

7. If the improvement be on a patented machine, it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvement consists; if, however, the improvement be on a machine not patented, it would be necessary to describe the original machine and also the improvement. *Evans v. Eaton*, 3 Wash., 454.—WASHINGTON, J.; Pa., 1818.

8. The nature and extent of the improvement must be clearly and fully stated, or the patent will be void. *Ibid.*, 452, 455.

9. If the patent be for an improvement, the specification should distinguish what is new from what was old and before in use, and point out in what the improvement consists. It is not sufficient that the improvement should be apparent from testimony introduced by the plaintiff, or even for the jury to perceive it by examining the thing patent-

ed and comparing it with others before in use. No description of the discovery secured by a patent will fulfill the demands of justice and of law, but such as is of record, and of which all the world may have the benefit. *Dixon v. Moyer*, 4 Wash., 73.—WASHINGTON, J.; Pa., 1821.

10. A specification which mixes up the old and the new, but does not explain what is the nature or limit of the improvement, which the party claims, cannot be sustained. *Evans v. Eaton*, 7 Wheat., 434.—STORY, J.; Sup. Ct., 1822.

11. A party should describe what his improvement is, and limit his patent to such improvement, and if he does not his patent is defective. *Ibid.*, 435.

12. When the specification does not describe the invention so as to show in what respect the plaintiff's invention or improvement differs from what had been known or used by the patent is void. *Langdon v. De Groot*, 1 Paine, 207.—LIVINGSTON, J.; N. Y., 1822.

13. If a patent be for an improvement, it should describe the thing previously in use, so that it can be clearly seen in what the improvement consists. *Sullivan v. Redfield*, 1 Paine, 451.—THOMPSON, J.; N. Y., 1825.

14. A patent was taken for an improvement in the mould board of ploughs; *Held*, that a particular description of former mould boards was not necessary. A general reference, either in general terms which are not untrue, or a reference to a particular mould board commonly known, accompanied by such a description of the improvement as will enable a workman to distinguish what is new will be sufficient. *Davis v. Palmer*, 2 Brock., 309.—MARSHALL, Ch. J.; Va., 1827.

15. The improvement patented must be the improvement invented. The patentee must show the extent of the improvement, so that a person who understands the subject may know in what it consists. *Whitney v. Emmett*, Bald., 314.—BALDWIN, J.; Pa., 1831.

16. When a patent is for an improvement in a machine already in use, the specification need not describe the original machine, unless there is no other way in which it can be ascertained with reasonable certainty in what the improvement consists, and how it is to be applied. *Harmon v. Bird*, 22 Wend., 14.—BRONSON, J.; N. Y., 1839.

17. If the specification contain such a description of the nature of the invention and the manner in which it is to be performed, as will enable persons of competent skill, by following the directions, to practice the invention without the labor or expense of trial or experiment, the patentee need not go further and describe the original machine. *Ibid.*, 115.

18. To secure the benefits of § 9 of the act of 1837, and save a patent from becoming absolutely void, by reason of the patentee claiming more than he has invented, the specification must state in what the improvement consists. *Peter-son v. Wooden*, 3 McLean, 249.—McLEAN, J.; Ohio, 1843.

19. In describing an improvement, the structure in detail of the entire and improved machine need not be given. It is only necessary to describe the improvement, by showing the parts of which it consists, and the effects which it produces. *Brooks v. Bicknell*, 3 McLean, 261.—McLEAN, J.; Ohio, 1843.

20. In a patent for an improvement, it may not be necessary to describe the machine before it was improved, though

it gives greater distinctness to do so; but it is essential that the part improved should be so distinctly stated as to be distinguished from every other part of the machine. It is not enough that the invention can be made apparent at the trial, by a comparison of the new with the old. *Brooks v. Bicknell*, 3 McLean, 444.—McLEAN, J.; Ohio, 1844.

21. In a patent for an improvement, the patentee should not only describe the machine, with all its parts, but he should distinguish what is new. Whatever is the particular improvement must be clearly stated; both that the public may know what he claims as new, and that parties may know what they are to defend against. *Hovey v. Stevens*, 3 Wood. & Min., 25, 26.—WOODBURY, J.; Mass., 1846.

22. Where a patent was for an improvement on an old and known thing, as for the substitution of double plates in the place of spokes in a car wheel, and the objection was made that the old wheel was not fully described, *Held*, that it was sufficient for the patentee to refer in general terms to the old wheel, as a spoke wheel, as that afforded all the information necessary to a person skilled in that department. *Many v. Jagger*, 1 Blatchf., 380.—NELSON, J.; N. Y., 1848.

23. If the specification includes as well the original discovery as the alleged improvement, and does not point out in what the improvement consists, the patent is void. *Street v. Silver*, Brightly, 101.—ROGERS, J.; Pa., 1846.

24. Where a patent is for an improvement on an old machine, if the whole of it, the old and the new, is described in the specification, the patentee must distinguish what part he claims, or the pat-

ent will be void for ambiguity. *Wintermute v. Redington*, 1 Fisher, 246.—WILSON, J.; Ohio, 1856.

25. If the whole machine, in its improved state, is claimed, the patent will be void for claiming too much. *Ib.*, 246.

26. In specifying an improvement in a machine, it may be necessary, and when so, it is proper to describe the whole machine, as it operates with the improvement, in order to make the description understood to a person of the trade to which it belongs, and if this is not done, the patent fails for obscurity. *Ibid.*, 246.

27. Where an invention consists of an improvement on a machine, the specification should distinguish the new parts from the old; and the claim should exclude the old parts, and claim only the new, by which the old were adapted to the new use, producing the new result. *Phillips v. Page*, 24 How., 168.—NELSON, J.; Sup. Ct., 1860.

C. PATENT FOR; WHAT SECURED BY; CONSTRUCTION OF.

1. If an inventor be not an inventor of the whole machine, but only of an improvement thereof, and the patent is for the whole machine, the patent is too broad and is utterly void. *Whittemore v. Cutter*, 1 Gall., 479.—STORY, J.; Mass., 1813.

2. If an inventor obtain a patent for an entire machine, when he is the inventor only of an improvement thereon, his patent is too broad and therefore void. *Odiorne v. Winkley*, 2 Gall., 53.—STORY, J., Mass., 1814.

3. If a patent be taken out for an entire machine, when the invention consists only of an improvement on such machine, the whole patent is not void, but the patentee is not entitled to more

than his improvement; nor can he make or use the original discovery, nor prosecute any person for using such original discovery without engrafting on it the improvement invented by the patentee. *Goodyear v. Matthews*, 1 Paine, 302.—LIVINGSTON, J.; Ct., 1814.

4. The grant can only be for the discovery as recited in the patent and specification. If the patent is for the whole of a machine, and the discovery was only of an improvement, the patent is void. *Evans v. Eaton*, Pet., C. C., 342.—WASHINGTON, J.; Pa., 1816.

5. If improvements be made upon an invention which has been patented, by any person other than the inventor or patentee, the inventor of the original thing, and those claiming under him, have no right to use the improvements without a license from the inventor thereof; nor can the inventor of such improvements, or any other person lawfully use the principal machine without the license of the inventor thereof. *Gray v. James*, Pet., C. C. 399.—WASHINGTON, J.; Pa., 1817.

6. If the terms of a patent are so obscure or doubtful that the court cannot say what is the particular improvement which the patentee claims, and to what it is limited, the patent is void for ambiguity. *Barrett v. Hall*, 1 Mas., 476.—STORY, J.; Mass., 1818.

7. A patent for an improvement in a machine, which had been previously patented to another, cannot protect the subsequent patentee, unless there is a substantial difference in the principle, and in the application of the improvement. *Smith v. Pearce*, 2 McLean, 177, 178.—MCLEAN, J.; Ohio, 1840.

8. If a person makes an improvement upon the invention of another, such improvement gives him no author-

ity to use the machine upon which it is an improvement. *Washburn v. Gould*, 3 Story 150.—STORY, J., Mass., 1844.

9. It is well settled that no one can make an improvement on a patented machine, and use important parts of the original invention, while the original term, or the remnants of it, exist, without the license of the original patentee, or a purchase from him of the right so to use what belongs to him. *Woodworth v. Rogers*, 3 Wood. & Min., 141.—WOODBURY, J.; Mass., 1847.

10. Nor can one, having the right to use the original machine, use an improvement upon it, without a license or purchase from the inventor of such improvement. *Ibid.*, 141.

11. An addition or an improvement of a combination, or of any element thereof, gives no right to appropriate or use the original combination. *Gorham v. Mixer*, 1 Amer. Law Jour., 543.—SPRAGUE, J.; Mass., 1849.

12. If an improvement is engrafted on a machine or manufacture before made and patented, it gives no right to use what had been previously patented, without obtaining a license or purchase from the patentee. But if the invention amounts not merely to an improvement, but to more, and constitutes a new and useful combination, the inventor has a right to use it without license from others. *Smith v. Downing*, 1 Fisher, 83.—WOODBURY, J.; Mass., 1850.

13. A patent for an improvement in a machine is not void, though it appears from the description or specification that a part of the elements included in the description were not new, but which are claimed to be newly combined with the new elements. *Rheem v. Holliday*, 16 Penn., 352.—COULTER, J.; Sup. Ct., Pa., 1851.

14. A combination may be improved, and a patent taken for such improvement, but at the same time the improvement cannot be used without the consent of the original patentee. *Foster v. Moore*, 1 Curt. 292.—CURTIS, J.; Mass., 1852.

15. A patent for an improvement embraces nothing more than the improvement described and claimed as new, and any one who afterward discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. *O'Reilly v. Morse*, 15 How., 119.—TANEY, Ch. J.; Sup. Ct., 1853.

16. There may be an improvement upon a useful machine, which entitles the party making it to a patent; but the fact of having made an improvement on an old machine, does not absorb the original machine, nor give any right to the use of it. *Crehore v. Norton*, MS.—NELSON, J.; N. Y., 1853.

17. The original inventor has no right to use the improvement without the license of the inventor; neither has the inventor of the improvement a right to use the original machine. *Ibid.*

18. An improvement on a combined machine may be patentable; but in such a case, the patentee cannot use the combined machine without a license, nor can the owner of such machine use the improvement, without a license. *Pitts v. Wemple*, 6 McLean, 561.—MCLEAN, J.; Ill., 1855.

19. Where the parts of a combination have been invented, whether such invention be of a new machine, or a combination of mechanical powers, it is protected in its distinctive character. *Ibid.*, 562.

20. If a patentee has invented only

an improvement on a known machine, he cannot treat as an infringer one who has improved the original machine by using a different form or combination, performing the same function. *McCormick v. Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

21. The inventor of a first improvement, cannot invoke the doctrine of mechanical equivalents to suppress all other improvements, which are not mere colorable invasions of the first. *Ibid.*, 405.

22. A mere addition to a patented invention, will not justify the use of the invention first patented. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

23. An improvement on a machine gives no right to use the original, but the use of such original machine is an infringement, although with the improvements, the machine may be much more useful than it would be without them. *Howe v. Morton*, 13 Mo. Law Rep.—SPRAGUE, J.; Mass., 1860.

INFRINGEMENT.

A. OF COPYRIGHT.....	357
B. OF PATENTS	
1. General principles as to.....	360
2. What held to amount to.....	365
3. What held not to amount to.....	370
4. Actions for, and Defences in.....	373
5. Evidence as to, and by whom decided.....	373
C. OF TRADE-MARKS.....	373

A. OF COPYRIGHT.

1. The question as to the violation of a copyright by an unlawful sale of the books, as to which a copyright has been secured, is not affected by the fact that such books may have been printed by

one who had an interest in such copyright, and a right to publish and sell them. *Hudson v. Patten*, 1 Root, 133.—CURIAM; Ct., 1789.

2. The plaintiff's had purchased of W. his copyright to vend and sell a certain work within the state of Connecticut; C. also purchased of W. a like right for New York. C. employed plaintiffs, who resided in Connecticut, to print for him a number of copies, which they did, and delivered in New York. The defendant bought some copies from C., and then brought them to Hartford, and sold them. *Held*, that such sale was against the statute, and the same as if C. had himself printed them. *Ibid.*, 134.

3. This suit was brought under a copyright law of the state of Connecticut, passed January 8, 1783, and similar in its provisions, as to the term of copyright, to the act of Congress of 1790. Such act, however, gave the power, in case the author of a work put so high a price upon it as to discourage its sale, to the Supreme Court of the state to regulate and fix the price at which the work should be sold. (*Ed.*)

4. The intent with which a work is reprinted cannot be taken into consideration; the act of reprinting is prohibited by the statute. *Nichols v. Ruggles*, 3 Day, 158.—CURIAM; Ct., 1808.

5. Though the original sources of information are open to all, subsequent parties have no right to use and copy the compilation of a former person. Where a person has made original surveys, and prepared a more perfect map therefrom, though he cannot supersede the right of any other person to make similar surveys, no one, without such surveys, has a right to copy the map. *Gray v. Russell*, 1 Story, 18.—STORY, J.; Mass., 1839.

6. It is of no consequence, as to the question of infringement, in what form the works of another are used, whether it be by a simple reprint, or by incorporating the whole or a large portion thereof in some other work. *Ibid.*, 19.

7. The incorporation of a treatise in an encyclopædia is just as much a piracy upon a copyright as if it were published in a single volume. *Ibid.*, 19.

8. In many cases of violation of copyright, the question may turn upon the point, not so much of the quantity, as of the value of the selected materials. *Ibid.*, 19.

9. In many cases it is a very nice question what amounts to a piracy, as in a review, whether the extracts are designed *bona fide* for the purpose of criticism, or were designed to supersede the original work, under the pretence of a review. *Ibid.*, 20.

10. The author of an edition of a Latin grammar made alterations and additions in the work, and also collected and prepared notes to it, some of which were not original; such notes were copied and used by a subsequent editor of the same work: *Held*, that such use was an infraction of the copyright as to the notes, which had been first collected together and arranged by the former editor. *Ibid.*, 21.

11. If a copyright can be secured for a work when the author has printed it in a newspaper before he has obtained a copyright, although with notice that he had secured a copyright; *query*, whether, under such circumstances, one can be charged with an infringement upon such right if he has in fact never seen or copied from the book so entered and secured, or in any manner used it in his publication, but has reprinted the same matter, in part or whole, from such

newspaper, in which the author had himself published it, and in which paper neither the author nor any other had any copyright. *Miller v. McElroy*, 1 Amer. Law Reg., 204, 205.—HOPKINSON, J.; Pa., 1839.

12. To constitute an invasion of copyright, it is not necessary that the whole of a work should be copied, or even a large portion of it, in form or in substance. *Folsom v. Marsh*, 2 Story, 115.—STORY, J.; Mass., 1841.

13. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially, to an injurious extent, appropriated, that is sufficient, in point of law, to constitute a piracy. *Ibid.*, 115.

14. The entirety of the copyright is the property of the author, and it is no defence that another has appropriated a part and not the whole of such property. *Ibid.*, 116.

15. Nor does it necessarily depend upon the quantity taken, whether it is an infringement of the copyright or not. It is often affected by other considerations, the value of the materials taken and the importance of it to the sale of the original work. *Ibid.*, 116.

16. Where A published a "Life of Washington," in two volumes, containing 866 pages, of which 353 were copied from the last eleven volumes of "Sparks' Life and Writings of Washington," in twelve volumes, 64 pages being *official* letters, and 255 being *private* letters of Washington, and originally published by Sparks, under a contract with the owners of the original papers of Washington, *Held*, that the work of A was an invasion of the copyright of Mr. Sparks. *Ibid.*, 103, 104, 108, 109, 118.

17. Intention cannot be taken into

view in reference to an infringement of a copyright; if a copyright has been invaded, whether the party knew it was copyrighted or not, he is liable to the penalty. *Millett v. Snowden*, 1 West. Law Jour., 240.—BETTS, J.; N. Y., 1843.

18. The omission of a word, a line, or paragraph in the book, &c., published in violation of a copyright, cannot change it so as to avoid the statute. *Ibid.*, 240.

19. A defendant may show that the work copyrighted was not original with the author, or that it was an abbreviation or alteration, and the jury can determine whether it is calculated to infringe the copyright or not. *Ibid.*, 240.

20. It is not sufficient, to constitute a piracy of a copyright, to show that one work may have been suggested by another, or that some parts or pages of it have resemblances, either in method, details, or illustrations. It must be further shown that such resemblances are so close, full, uniform, and striking, as to lead to the conclusion that the one is a substantial copy of the other, or mainly borrowed from it. *Emerson v. Davies*, 3 Story, 787.—STORY, J.; Mass., 1845.

21. A copy is one thing, an imitation or resemblance is another. *Ibid.*, 787, 788.

22. In many cases it is a very nice question, what degree of imitation constitutes an infringement of a copyright in a particular work. *Ibid.*, 788.

23. If the similitude can be supposed to have arisen from accident, or necessarily from the nature of the subject, the defendant is not liable. *Ibid.*, 791.

24. The true test of piracy or not is, whether the defendant has in fact used

the plaintiff's work, with colorable alterations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and sources of knowledge open to all. In other words, whether the defendant's book is, *quoad hoc*, a servile or evasive imitation of the plaintiff's work, or a *bona fide* original compilation from other common or independent sources. *Ibid.*, 793.

25. Similarities and some use of prior works, even to copying of small parts, are tolerated in some kinds of books, as dictionaries, gazetteers, grammars, maps, arithmetics, almanacs, cyclopædias, itineraries, guide-books, and similar publications, if the main design and execution are in reality novel and improved, and not a mere cover for important piracies from others. *Webb v. Powers*, 2 Wood. & Min., 512.—WOODBURY, J.; Mass., 1847.

26. Where two books were somewhat similar in design and execution, and the one was to some extent copied from the first, but was smaller and cheaper, and in many respects of a different arrangement, *Held*, that the leading inquiry was, whether the book of the defendant, taken as a whole, was substantially a copy of the plaintiff's; whether it had virtually the same plan and character throughout, and was intended to supersede the other in the market, with the same class of readers and purchasers, by introducing no considerable new matter, or little or nothing new except colorable deviations. *Ibid.*, 514, 515.

27. When the main design in the defendant's book is different in important respects from that of the plaintiff's, and in several things varying in material

details with a view to make it less expensive and to circulate among a different class of readers, rather than be a substitute with the same class, it will be no infringement on the copyright of the plaintiffs. *Ibid.*, 518, 519.

28. If the leading design is truly to abridge a work and cheapen the price, and that by mental labor is faithfully done, it is no ground for a prosecution by the owner of a copyright of the principal work. But it is otherwise if the abridgment or similar work be colorable, or a mere substitute. *Ibid.*, 520.

29. The intent not to be guilty of piracy is not material, if much has been actually copied and the new work is a mere substitute. But if this be doubtful, the intent not to pilfer from another, colorably or otherwise, for the substantial parts of the new work, may be important. *Ibid.*, 524.

30. The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. *Story's Exrs. v. Holcombe*, 4 McLean, 309.—McLEAN, J.; Ohio, 1847.

31. The intention with which extracts from a work are made, has no bearing upon the question of violation. The inquiry is, what effect must the extracts have upon the original work. If they render it less valuable by superseding its use in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done. *Ibid.*, 310.

32. A book may in one part of it infringe the copyright of another book, and in other parts be no infringement; in such a case, the remedy will not be extended beyond the injury. *Ibid.*, 315.

33. In questions of infringement of copyright, the inquiry is not, whether the defendant has used the thoughts, conceptions, information, or discoveries promulgated by the original, but whether his composition may be considered a *new work* requiring invention, learning and judgment, or only a mere transcript of the whole or parts of the original, with merely colorable variations. *Stowe v. Thomas*, 2 Amer. Law Reg., 229.—GRIER, J.; Pa., 1853.

34. The abridgment of a work, for which a copyright has been secured, and which has been publicly circulated, is not an infringement of the statutory privilege; but such an abridgment would violate the right of the literary proprietor of a book of which the circulation had been private only. *Keene v. Wheatley*, 9 Amer. Law Reg., 82.—CADWALLADER, J.; Pa., 1860.

B. OF PATENTS.

1. General principles as to.

See also ACTIONS, B.; INVENTION, E.

1. The general law declares that the right to a patent belongs to him who is the first inventor, even before a patent is granted; therefore, any person, who, knowing that another is the first inventor, yet doubting whether that person will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril, and with the full knowledge of the law, that a subsequent patent may cut him out of the use of the machine thus erected; *a priori*, where the party constructing knew that the inventor had obtained a patent, though afterward declared invalid, but under a subsequent act :

Congress a valid patent was secured. *Evans v. Weiss*, 2 Wash., 345.—WASHINGTON, J.; Pa., 1809.

2. To constitute an infringement, the making must be with an intent to infringe the patent-right, and deprive the owner of the lawful rewards of his discovery. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. In an action for an infringement the first question for consideration is, whether the machines used by the defendant are substantially, *in their principles and mode of operation*, like the plaintiff's. If so it is an infringement to use them. *Odiorne v. Winkley*, 2 Gall., 53, 55.—STORY, J.; Mass., 1814.

4. Mere colorable differences, or slight improvements, cannot shake the right of an original inventor, or protect an infringer. *Ibid.*, 54.

5. It is not the duty of the attorney-general, as the law adviser of the Commissioner of Patents, or of the Secretary of State (now Interior) to determine what rights are conferred by patents granted, or what will amount to a violation of those rights. These are questions to be settled by the courts and juries. *Nourse's Case*, 1 Opin., 576.—WIRT, Atty. Gen.; 1822.

6. Whoever erects or uses a patented machine, does it at his peril. He takes upon himself all the chances of the patent being originally valid; or being afterward made so by a surrender and the grant of a new one. *Ames v. Howard*, 1 Sumn., 488.—STORY, J.; Mass., 1833.

7. The maker and seller of a patented article intended by the act (1793, § 5) is the principal, the person for whom, by whose direction, and on whose account the articles are made and sold—the person who receives the profits of

the sale. The workmen employed by him for stipulated wages have nothing to do with his rights, or with his invasion of the right of another. *Delano v. Scott*, Gilpin, 498.—HOPKINSON, J.; Pa., 1834.

8. The right secured to the inventor is founded on considerations of public policy, and is not to be destroyed by open infraction, or mere colorable improvements. *Smith v. Pearce*, 2 McLean, 178.—MCLEAN, J.; Ohio, 1840.

9. It is not necessary that two things should be identical in order to make one an infringement of the other. The true question is, are they substantially the same, though not in every minute particular. *Alden v. Dewey*, 1 Story, 339.—STORY, J.; Mass., 1840.

10. In an action for an infringement, it is no ground for a recovery that the process used by the defendant is not so good as that patented to the plaintiff. The question is, not which is best or most perfect; but whether the one mode or combination is an infringement of the rights secured by the other mode or combination. *Howe v. Abbott*, 2 Story, 194.—STORY, J.; Mass., 1842.

11. A mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent, nor can it shelter from the consequences of an infringement. The inquiry always is, whether the principle of the two machines is the same. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

12. Where witnesses differ as to the fact of infringement, the question should be submitted to a jury, either by an action at law, or an issue directed by the court. *Ibid.*, 262.

13. If the defendant construct and use a machine before the plaintiff ob-

tain his patent, such construction or use will not be protected, if the machine was copied from that of the plaintiff, unless he consented to such construction or use. *Hovey v. Stevens*, 1 Wood. & Min., 301.—WOODBURY, J.; Mass., 1846.

14. The question of infringement is one irrespective of *motive*. The defendant may have infringed without intending, or even knowing it; but he is not on that account the less the infringer. *Parker v. Hulme*, 7 West. Law Jour., 426.—KANE, J.; Pa., 1849.

15. If a machine, constructed as described in the patent, will accomplish the end practically and usefully in the way pointed out, the inventor is entitled to the protection granted by the government, and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the machine by superior skill in the mechanical arrangement and construction of the parts. *Parkhurst v. Kinsman*, 1 Blatchf., 497.—NELSON, J.; N. Y., 1849.

16. The inquiry as to infringement is whether the defendant has appropriated to his own use and for his own benefit the machine constructed and put in operation, or the thing invented by the patentees. This question is to be determined by reference to what was in existence at the time of the invention by the patentees. *Wilbur v. Beecher*, 2 Blatchf., 139.—NELSON, J.; N. Y., 1850.

17. As to the question of infringement the inquiry is, whether the defendants' machine involves some new idea in its construction not to be found in the plaintiff's, or whether the plan used by the defendants is in substance the same as the plaintiff's, the differences introduced being merely differences in things not material or important; in other words, whether the defendants'

plan is in substance and effect a colorable evasion of the plaintiff's rights, or is new and substantially a different thing. *McCormick v. Seymour*, 2 Blatchf., 245, 246.—NELSON, J.; N. Y., 1851.

18. If the defendants have taken the same plan and applied it to the same purpose, it is in substance the same thing, although they may have varied the mode of construction. It is then only a mechanical equivalent, which, however meritorious and creditable to the mechanic, is not invention. *Ibid.*, 248.

19. In examining a machine to ascertain whether or not it is an infringement of another, the similarity or dissimilarity of the mechanical construction is not necessarily conclusive or controlling. The structure may be very similar, but the principle, operation, and result, be very different; or the structure and appearance may be very different, and yet the principle be in reality the same. *Blanchard v. Beers*, 2 Blatchf., 416, 418.—NELSON, J.; Ct., 1852.

20. No person can appropriate the benefit of the new ideas which another has originated and put into practical use, because he may have been enabled, by superior mechanical skill, to embody them in a form different in appearance, or different in reality. Although he may not have preserved the exterior appearance of the previous machine, he may have appropriated the ideas which give to it all its value. *Ibid.*, 418.

21. Whenever a defendant sets up that he has substantially departed from an existing machine, so as to avoid the consequence of an infringement, he must show that his departure has been such as involves invention, and not mere mechanical skill. There must be mind and inventive genius involved in it, and

not the mere skill of the workman. *Ibid.*, 420.

22. In examining questions of identity and infringement, it is to be first ascertained wherein consists the substantial peculiarity which distinguishes the art or invention patented. Whoever adopts or appropriates such distinctive peculiarity or principle without license of the patentee, appropriates the invention, and infringes the patent, if the specification be correctly drawn. *Goodyear v. Day*, MS.—GRIER, J.; N. J., 1852.

23. It is no justification of the infringement of a renewed patent, that the infringer had stolen and used the invention with impunity before the patent was amended. § 7 of the act of 1839, gives no protection to those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. *Ibid.*

24. On a bill filed for an infringement of a patent, and for an injunction, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court will order the defendants to run such machines in the presence of some expert, and that the expert be allowed to bring into court specimens of the work produced by such machines. *Sloat v. Patten*, 24 Jour. Fr. Inst., 3d Ser., 23.—KANE, J.; Pa., 1852.

25. No person can take the benefit of a patentee's discovery for the production of a new manufacture, and by varying or improving the mode or process of its production, rob the patentee of his franchise. *Goodyear v. The Railroads*, 2 Wall., Jr., 361.—GRIER, J.; N. J., 1853.

26. Whether the defendant has constructed, used, or sold the thing pat-

ented to the plaintiffs, is a question of fact for the jury. *Winans v. Denmead*, 15 How., 338.—CURTIS, J.; Sup. Ct., 1853.

27. It is a familiar rule that to copy the principle or mode of operation described in a patent, is an infringement, although such copy should be totally unlike the original in form or proportions. *Ibid.*, 342.

28. A question of infringement is one of fact, which it is the province of a jury to decide. *Rich v. Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

29. The substitution and use of one power, as electricity, in the place of another, as hand power, does not make the machine different, or prevent its being an infringement. *Crehore v. Norton*, MS.—NELSON, J.; N. Y., 1853.

30. If a defendant, for a good consideration, covenants not to infringe a patent, he will be enjoined, by a court of equity, from further infringing, unless he shows some equitable reason why the performance of such agreement should not be enforced. *Sargent v. Larned*, 2 Curt., 344.—CURTIS, J.; Mass., 1855.

31. The question of infringement has reference to what the patentee *has claimed* in his patent, and not to what he *might have claimed*, if his specification had been more skilfully prepared. *Sickles v. Glou. Manuf. Co.*, 1 Fisher, 238.—GRIER, J.; N. J., 1856.

32. As to the question of infringement, it is a standing principle of law, that every person is entitled to the free use of whatever was known and used prior to the patent which attempts to appropriate it as a new discovery: and it is unimportant whether the character and capacities of machinery open to

general use are understood or not by the public at large, or had been used by many; it is sufficient to show the public had free means of access to it, and to employ it, and the law then presumes it was well known and in public use. *Smith v. Higgins*, MS.—BETTS, J.; N. Y., 1857.

33. If the thing used by a defendant corresponds substantially with that known and in use before the discovery of the patentee, or described in printed works, then his acts are no infringement of any right of a patentee; and if the thing used by the defendants and that patented to the plaintiff, are substantially alike, the question of infringement will still depend upon the further inquiry whether the patentee was the first and original discoverer of the patented invention. *Ibid.*

34. If the patentee be an original inventor of a machine or thing, he has the right to treat as infringers all who make a like invention, operating on the same principles, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement on the original and patented one. *McCormick v. Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

35. But if his invention be but an improvement on a known machine, he cannot treat another as an infringer who has improved the original machine by using a different form or combination, performing the same function. The inventor of a first improvement cannot invoke the doctrine of mechanical equivalents to suppress all other improvements which are not mere colorable invasions. *Ibid.*, 405.

36. The question of infringement is one for the jury. The true point is,

have the defendants used the invention of the plaintiff, or something substantially like it? Do the two structures operate upon the same principle? Are they substantially the same? *Bell v. Daniels*, 1 Fisher, 379.—LEAVITT, J.; Ohio, 1858.

37. An unpatented invention is not property, nor the subject of exclusive ownership, but is free to the use of all persons, in whatever way they may come to the knowledge of it. *Shreeve v. United States*, MS.—LORING, J.; Ct. Claims, 1859.

38. In determining questions of infringement, the jury are not to judge about similarities or differences by the names of things; but are to look to the machines, or their several devices or elements, in the light of what they do, or what office or function they perform, and how they perform it; and to find that a thing is substantially the same as another, if it perform substantially the same function or office, in the same way, to attain the same result; and that things are substantially different when they perform different duties, or in a different way, or produce a different result. *Cahoon v. Ring*, 1 Fisher, 419.—CLIFFORD, J.; Me., 1859.

39. For the same reason, they are not to judge about similarities or differences merely because things are apparently the same, or a different shape or form; but the true test of similarity or difference is the same in regard to shape or form as in regard to names; in both cases they are to look at the mode of operation, or the way the parts work, and at the result as well as the means by which the result is attained. *Ibid.*, 419.

40. The question of infringement of a patent is exclusively a question for the jury. *Judson v. Cope*, 1 Fisher, 625.—LEAVITT, J.; Ohio, 1860.

2. *What has been held to amount to.*

See also COMBINATION, B.; COMPOSITION OF MATTER, C.; DESIGN.

1. The using of a thing invented by another, and secured by patent, is an offence, and it makes no difference that the thing or machine was made or erected prior to the issuing of the patent. *Evans v. Weiss*, 2 Wash., 344.—WASHINGTON, J.; Pa., 1809.

2. The making of a machine fit for use, and with a design to use it for profit, is an infringement of a patent-right, for which an action will lie, even if there is no user and no actual damage. *Whittemore v. Cutter*, 1 Gall., 432, 433.—STORY, J.; Mass., 1813.

3. Though as a general rule a patent covers only the improvement precisely described, and is not violated unless the defendant make use of the precise thing described in the patent, yet if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation, for the purpose of evading the right of the patentee, this will be considered a fraud upon the law, and such slight variation be disregarded. *Davis v. Palmer*, 2 Brock., 309.—MARSHALL, Ch. J.; Va., 1827.

4. If the machine used by the defendants, in its structure and operation, is substantially the same with the plaintiff's invention as patented, though different somewhat in form and arrangement, it is an infringement of his patent. *Wyeth v. Stone*, 1 Story, 280.—STORY, J.; Mass., 1840.

5. And where a patent embraces divers distinct and independent inventions

or machines, but each auxiliary or conducive to the accomplishment of the same common or general end, if one of such inventions or machines is wrongfully used, it is a violation of the patent. *Ibid.*, 291, 292.

6. Making, using, or selling a patented machine, is an infringement. *Brooks v. Bicknell*, 3 McLean, 262.—MCLEAN, J.; Ohio, 1843.

7. No prior use of a defective patent can authorize the use of the invention after the emanation of an amended patent, under § 3 of the act of 1832, or § 13 of the act of 1836, which made no material change in the law. *Stimpson v. West Ches. R. R. Co.*, 4 How., 402.—MCLEAN, J.; Sup. Ct., 1845.

8. Any person using an invention protected by a renewed patent, subsequent to the date of the act of 1836 (July 4), is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Ibid.*, 403.

9. It is an infringement of a patent-right to make the thing patented, even though the person actually making was employed by others to do the work. *Bryce v. Dorr*, 3 McLean, 583.—MCLEAN, J.; Mich., 1845.

10. Where a patent embraces several machines, the wrongful use of either separate machine is a violation of the patent, *pro tanto*. *Emerson v. Hogg*, 2 Blatchf., 8.—BETTS, J.; N. Y., 1845.

11. If a machine, as made by a defendant, was not an infraction of the plaintiff's patent, the alteration of it by a third party will not make the defendant liable. But if the machine as made by the defendant was intended by him to operate in such a way as to violate the plaintiff's patent, and has in fact so operated, he is guilty of an infringement,

notwithstanding the ingenuity with which he may have sought to disguise his wrong. *Knight v. Gavit*, Mir. Pat. Off., 133.—KANE, J.; Pa., 1846.

12. To infringe a patent-right, it is not necessary that the thing patented should be adopted in every particular; if the patent is adopted substantially by the defendants, they are guilty of an infringement. *Root v. Ball*, 4 McLean, 180.—McLEAN, J.; Ohio, 1846.

13. If a defendant has arranged his machinery on the same principle as claimed by the plaintiff, he is guilty of infringement. It is not essential that it should be exactly similar in form, but it must work on the same principle. *Parker v. Haworth*, 4 McLean, 373.—McLEAN, J.; Ill., 1848.

14. The plaintiff's invention and patent was for a squeezer, so called, for converting puddlers' balls into blooms, and rolled the balls between reciprocating tables or plates, or between a revolving cylinder and a stationary curved segmental trough with stationary flanges. The defendant's machine compressed the ball between a rotating cam and two small rotating cylinders beneath it; *Held*, that plaintiff's patent was for a new process, mode, or method of converting puddlers' balls into blooms by continuous pressure and rotation between converging surfaces, and that the defendant's machine was an infringement upon it, if it converted such balls into blooms by continuous pressure and rotation between converging surfaces, although its mechanical construction and action might be different. *Burden v. Corning*, MS.—CONKLING, J.; N. Y., 1850.

15. If a person uses the invention of a patentee, he infringes whatever he may add to it, or with whatever new

invention he connects it. *Brooks v. Fiske*, MS.—SPRAGUE, J.; Mass., 1851.

16. Where a patentee of an improvement in cultivators, claimed "the arrangement of the teeth in two rows, in combination with a pair of wheels having their treads in a line midway between the points of the two rows of teeth, substantially as described," and the specification described the teeth as seven in number, arranged in two straight rows, three in one row and four in another, the points of the three being in front of the line of the wheels, and the points of the four behind such line, and the tread of the wheels being placed midway between the rows of the teeth to resist any tendency of either row of teeth to cut too deep, and the tread of the wheels between them acting as a fulcrum, so as to relieve the team of any strain arising from either row of the teeth running too low or too shallow, and by which arrangement also the use of guiding handles, or of four wheels, could be dispensed with; and the defendant's machine used but two wheels, and no guiding handles, and had also seven teeth, three in front of the wheels and four behind, but the middle tooth of the forward three was moved forward of the others, and the two middle teeth of the back row were placed behind the others, so that the two rows were not straight, and the axle of the wheels was thrown forward, so that the tread of the wheels was not midway between the rows of the teeth, by which strain on the team was further reduced; *Held*, that the defendant's machine was an infringement upon the plaintiff's, as it used the principle and substance of plaintiff's invention, and was not even an improvement, as it was only the re-

sult of practical experience in the use of plaintiff's machine, and involved no invention. *Tracey v. Torrey*, 2 Blatchf., 277, 278.—NELSON, J.; N. Y., 1851.

17. In an action for an infringement of the same patent, referred to last above, where the defendant's machine was like that of Torrey, except that the middle tooth of the forward three was set back, so that two teeth were forward of the wheels and five were back, *Held*, that defendant's machine was an infringement. *Chamberlin v. Ganson*, 2 Blatchf., 279 (note).—NELSON, J.; N. Y., 1851.

18. If a machine is capable of performing several functions, as Blanchard's machine for turning irregular forms, and a person construct a machine to perform but one of such functions, as the turning of wagon spokes, it is an infringement. *Blanchard v. Beers*, 2 Blatchf., 415.—NELSON, J.; Ct., 1852.

19. The sure test, and the one the jury should be guided by in all cases, is, whether or not the defendant's machine (whatever may be its form or mechanical construction), has incorporated within it the principle, or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff's machine. If it does, then, no matter what may be its mechanical construction, or its form, it is an infringement. *Ibid.*, 416.

20. The plaintiff's patent was for the curing of caoutchouc or india-rubber by subjecting it to the action of a high degree of artificial heat. The defendants set up the defence that the rubber made by them was made by a process in which *steam* and not *heat* was the chief agent; *Held*, that the plaintiff claimed the vulcanization of rubber and sulphur by artificial heat, however produced,

and that the use of steam in the place of heated air was an infringement of his patent. *Goodyear v. The Railroad*, 2 Wall., Jr., 358, 361, 362.—GRIER, J.; N. J., 1853.

21. In an action for infringement upon Wells' patent for making hat bodies, the defendants in their machine divided the tunnel or chamber into which the fibres of the fur were thrown, and used a perforated cone of wire gauze, of larger openings than Wells', and put a finer one of grass cloth over it, and used a metallic picker instead of the hair brush to throw the fibres of the fur into the chamber, and also, instead of immersing the bat formed on the cone into warm water to harden it so that it could be removed, discharged jets of steam upon the bat during the process of formation; *Held*, on an application for an injunction, that the machine of the defendants, and their process of making the hat body, was substantially like that of the complainants, the assignees of Wells, and that they were entitled to an injunction. *St. John v. Prentiss*, MS.—NELSON, J.; N. Y., 1853.

22. To constitute an infringement, the thing used by the defendant must be such as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree; but it must be the same in kind. *Winans v. Denmead*, 15 How., 344.—CURTIS, J.; Sup. Ct., 1853.

23. Where a patent was granted for constructing the body of a railroad car in the form of the frustum of a cone, and the claim was for making it in such

form whereby certain specified advantages were secured, and a new and useful result produced, and the defendants constructed the body of their car *octagonal*, the effect of which was, however, the same as when made circular, as described in the plaintiff's patent; *Held*, that it was an infringement upon plaintiff's patent, and that the plaintiff's patent, though describing only the form of a frustum of a cone, embraced every such variation of form as substantially embodied his mode of operation, and thereby attained the same result. *Ibid.*, 341-344.

24. Where a particular geometrical form is alone capable of embodying a patentee's invention, if the form is not used the invention is not copied, and there is no infringement; otherwise, where that form may be the best, but other forms may and do embody the invention. *Ibid.*, 343.

25. An infringement takes place whenever a party avails himself of the invention of a patentee, without such a variation as will constitute a new discovery. *Rich v. Lippincott*, 2 Fisher, 5.—GRIER, J.; Pa., 1853.

26. An infringement consists in constructing a machine, or making a compound substantially in the same mode as that for which the patent has been obtained. *Allen v. Hunter*, 6 McLean, 311.—McLEAN, J.; Ohio, 1855.

27. An unsubstantial or colorable alteration in a machine or a compound, as where they are formed on the same principle, though varied in form; or where the ingredients are the same, but combined in a different mode, or there is a substitute of one ingredient, having the same qualities and producing the same result, is an infringement. *Ibid.*, 313.

28. A change of form merely, or of

mechanical structure, which produces no new or materially improved result, is not the subject of a patent, and is an infringement of a patent. *Sargent v. Larned*, 2 Curt., 349.—CURTIS, J.; Mass., 1855.

29. Mere formal changes will not evade a patent. *Sickles v. Borden*, 3 Blatchf., 541.—NELSON, J.; N. Y., 1856.

30. According to the patent law, if the machine complained of involves substantial identity with the one patented, it cannot be upheld. *Ibid.*, 541.

31. If the invention of a patentee is a machine, it will be infringed by a machine which incorporates in its structure and operation the substance of the invention; that is, by an arrangement which performs the same service or produces the same effect in the same way, or substantially so. *Ibid.*, 541.

32. The identity that is to be looked to, in an action of infringement, respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode adopted by the defendant shows that the principle admits of the same application in a variety of forms, or by a variety of apparatus, such mode is a piracy of the invention. *Wintermute v. Reddington*, 1 Fisher, 251.—WILSON, J.; Ohio, 1856.

33. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law, or rule of practice or science, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. *Ibid.*, 251.

34. If a machine is constructed so as to conform in *all* respects to the description in a patent, except as to one particular, or as to one motion and effect, yet is so constructed and *intended*

as to obtain that motion or effect in the usage of the machine, by the action or wearing of the parts, and it is so obtained, it is a violation of the patent, a piracy of the principle. If the *principle* is worth any thing, no mere evasion should be countenanced. Perfect identity is not required to demonstrate an infringement of principle. *Page v. Ferry*, 1 Fisher, 311.—WILKINS, J.; Mich., 1857.

35. If a licensee use the thing patented beyond the limits of the license or grant, or in a way not authorized thereby, then there is a violation of the rights secured to the patentee. *Judson & Goodyear v. Union Rub. Co.*, 4 Blatchf., 65, 66.—INGERSOLL, J.; N. Y., 1857.

36. It is an infringement, if the defendants use the means secured by the plaintiff's patent, although they may have used another device, not patented to the plaintiff. *Waterbury Brass Co. v. N. Y. & B. Brass Co.*, 3 Fisher, 52.—INGERSOLL, J.; N. Y., 1858.

37. To constitute an infringement, it is not necessary that the defendant's machine should be exactly like the plaintiff's, but it is an infringement if his device is substantially like that of the plaintiff's. *Ibid.*

38. It is none the less an infringement of a patent, because something is added to the means patented, even though the object or result to be secured by such other means in connection, is better accomplished. *Imlay v. Nor. & Worc. R. R. Co.*, 4 Blatchf., 235.—INGERSOLL, J.; Ct., 1858.

39. Where a patent for improvements in the manner of supporting the bodies of railroad cars, &c., was for the use and application of two cylinder plates, one male and the other female, one within the other, the upper one slightly convex in its lower surface, so that it rested

only on the centre of the bed-plate, which could thus turn and vibrate under the top plate, and one of such plates attached to the truck and the other to the car, whereby the truck and carriage were combined; and the defendants used to connect their carriages the ordinary king bolt, and side bearings, near the side of the carriage, and also two cylindrical plates, male and female, one within the other, and which were called *guard collars* for the king bolt; *Held*, that the use and application of the two cylinder plates one within the other, as used and applied by the defendants, was in violation of the rights secured by the patent, and even though the inner one should not actually press upon the outer one. *Ibid.*, 237.

40. In order to constitute an infringement, it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye, or in point of fact. If they embody the ideas of the patentee, and the machinery of the defendant operates by such adoption and appropriation, then, though the arrangement may be apparently different, in reality and in judgment of law, an infringement exists. *Smith v. Higgins*, 1 Fisher, 541.—NELSON, J.; N. Y., 1856.

41. If a defendant uses that which belongs to another, he is responsible, although he may have added something of his own. It is an infringement, whatever else he may use. *Johnson v. Root*, 1 Fisher, 359.—SPRAGUE, J.; Mass., 1858.

42. In the absence of any explanation or suggestion to the contrary, it will be inferred that the use of machinery constructed according to the specification of a patent is without the license or consent of the patentee; and such use will make a *prima facie* case

of infringement. *Chaffee v. Bos. Bell. Co.*, 22 How., 222.—CLIFFORD, J.; Sup. Ct., 1859.

43. It is an infringement if a person has used a patentee's improvements or devices substantially the same, in which the same principles are brought into requisition, or in other words, which are alike in their principle of operation. *Coleman v. Liesor*, MS.—LEAVITT, J.; Ohio, 1859.

44. To constitute an infringement, the thing used must be so near that set forth in the patent as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. *Whipple v. Middlesex Co.*, MS.—SPRAGUE, J.; Mass., 1859.

45. An improvement on a machine gives no right to use the original, but the use of such original machine is an infringement, although with the improvements the machine may be much more useful than it would be without them. *Howe v. Morton*; 13 Mo. Law Rep., 71-72.—SPRAGUE, J.; Mass., 1860.

3. What has been held not to amount to.

1. The making of a patented machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement on the patentee's rights. *Whittemore v. Cutter*, 1 Gall., 432.—STORY, J.; Mass., 1813.

2. The levy and sale, under an execution, of the *materials* of patented articles, as the materials of machines for cutting brad-nails, is not such a sale under the patent acts as makes the sheriff liable to an infringement of the patent-right. To constitute such an in-

fringement, the sale must be not of the materials of a machine, either separate or combined, but of a complete machine with the right, express or implied, of using the same in the manner secured by the patent. It must be a tortious sale, not for the purpose of merely depriving the owner of the materials, but of the use and benefit of his patent. *Sawin v. Guild*, 1 Gall., 487.—STORY, J.; Mass., 1813.

3. If an invention is an improvement in the *principle* of a machine for which a patent has been granted, it is not a violation of the patent. *Park v. Little*, 3 Wash., 198.—WASHINGTON, J.; Pa., 1813.

4. A contract to purchase articles manufactured in violation of a patent is not of itself an infringement of such patent. *Keplinger v. De Young*, 10 Wheat., 365.—WASHINGTON, J.; Sup. Ct., 1825.

5. The exclusive grant in a patent is the construction and use of the thing patented. The patent law protects the thing patented, and not the product. The right of an assignee of a patent right for a particular district, is not infringed upon by the sale within such district of the products of the same patent-right, manufactured by a party holding an interest in the same patent in another district. *Boyd v. Brown*, 3 McLean, 296, 297.—MCLEAN, J.; Ohio, 1843.

6. Whether if the manufacturer in the second district was actually engaged in selling such articles within the district held by the other, it would not be a violation of the right of such other person; *query*. *Ibid.*, 296.

7. The sale of the thing manufactured, or the product of a patented machine, is not a violation of the exclusive right to use, construct, or sell the machine.

Boyd v. McAlpine, 3 McLean, 429.—McLEAN, J.; Ohio, 1844.

8. A purchaser, for his own account, of articles manufactured by a patented machine, though purchased with a full knowledge that they were manufactured in violation of the patent, cannot be enjoined, or held liable in any other way.

Anon., 3 West. Law Jour., 144.—N. Y., 1845.

9. A purchase from the defendants of a patented article by an agent of the patentee, and for the purpose of entrapping the defendant, is not such a sale as will render them liable. *Sparkman v. Higgins*, 2 Blatchf., 30, 31.—BETTS, J.; N. Y., 1846.

10. If a machine, as made by the defendant, was not an infraction of the plaintiff's patent, the alteration of it by a third party will not make the defendant liable. But if the machine, as made by the defendant, was intended by him to operate in such a way as to violate the plaintiff's patent, and has in fact so operated, he is a party to the infringement, notwithstanding the ingenuity with which he may have sought to disguise his wrong. *Knight v. Gavit*, Mir. Pat. Off., 133.—KANE, J.; Pa., 1846.

11. If the machine used by the defendant differs materially from that described in the patent, there is not an infringement. *Aiken v. Bemis*, 3 Wood. & Min., 353.—WOODBURY, J.; Mass., 1847.

12. Where a patentee claimed a hammer in a saw-set, of wrought-iron faced with steel, alleging that he found upon experiment that all steel hammers were much more liable to break, and wrought-iron ones more durable, and therefore confined his specification to wrought-iron ones with steel points, *Held*, in an action for infringement against a person

using a hammer wholly of steel, that it was matter of doubt whether the use of an inferior material for the hammer, when the patent covered only a superior one, was a violation of the patent. If the patentee covers the material of which a part of his machine is made, he endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. Had nothing been said about materials it would have been different. *Ibid.*, 350, 354.

13. Where A and B agreed with C to purchase of the latter all of a certain article, lead pipe, which he should make, A and B agreeing to furnish the lead and pay C a given price for manufacturing, and C used in such manufacture a machine patented to plaintiff's assignor, *Held*, in an action for infringement against A, B, and C, that if A and B had no connection with the manufacture, except to furnish the lead and pay a given price, that they were not liable for infringement. *Tatham v. Le Roy*, MS.—NELSON, J.; So. N. Y., 1849.

14. But if the agreement was only colorable, and entered into for the purpose of securing the profits of the business without assuming the responsibility for the use of the invention, then they would be liable. Aiding and assisting a person in carrying on such a business and in operating the machinery will implicate the parties so engaged. *Ibid.*

15. One machine or manufacture is not a violation of another, within the purview of the patent system, unless it is substantially the same. It need not be identical, but it must be similar in the principle, or mode of operation. *Smith v. Downing*, 1 Fisher, 83.—WOODBURY, J.; Mass., 1850.

16. When their results differ favorably and considerably, it is considered that there must be an improvement, or this could not happen. So when the mode of operation is unlike in material respects, the author is not guilty of any mechanical piracy. *Ibid.*

17. A sale of a patented article, to an agent of the patentee, employed to make the purchase, by him and on his account, is not, *per se*, an infringement of his patent. *Byam v. Bullard*, 1 Curt., 102.—CURTIS, J.; Mass., 1852.

18. Such a sale, however, accompanied by other circumstances, may warrant a jury in finding an infringement. *Ibid.*, 102.

19. The means specified in a patent to produce a result or effect, and nothing more, are patented, or secured, and there is no infringement, unless the defendant uses substantially the same means as those described by the patentee. *Amer. Pin Co. v. Oakville Co.*, 3 Blatchf., 192; 3 A. L. R., 137.—INGERSOLL, J.; Ct., 1854; NELSON, J., concurring.

20. Where a vessel was built and rigged in France, and had in use gaffs which had been patented in the United States, *Held*, as the gaffs were placed on the vessel when she was built, and as part of her original equipment, in a foreign country, by persons not within the jurisdiction of our patent laws, that such use was not within the application of our patent laws, but was excepted therefrom. *Brown v. Duchesne*, 2 Curt., 375–377.—CURTIS, J.; Mass., 1855. [Affirmed *post* 22.]

21. The right of property and exclusive use which a patentee has in his invention, is derived from the acts of Congress, and cannot extend beyond the limits to which the law itself is confined.

The use of his invention outside of the jurisdiction of the United States, is not an infringement of his rights, and he has no claim to any compensation for the profit or advantage the party may derive from its use. *Brown v. Duchesne*, 19 How., 195.—TANEY, Ch. J.; Sup. Ct., 1856.

22. The exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering our ports; and the use on such vessel of an improvement patented in this country, is not an infringement of the rights of the American patentee, provided it was placed upon such vessel in a foreign port, and authorized by the laws of the country to which she belongs. *Ibid.*, 198.

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

24. If the defendant's machine, in its original structure, was in fact and in truth no infringement, no piracy on the plaintiff's machine, and was not intended to be so, neither accident nor usage, as the natural wear of the material of which composed, could make it so. Mind must be associated with matter, in the commission of the trespass. It is the intention which gives the guilty hue to the act. *Ibid.*, 312.

25. Where, therefore, in a patent for improvements in portable circular-saw mills, the patent covered merely a com-

bination of the use of rollers, or their equivalents, for guiding the circular saw, with a saw which had *free end play*, so as not in any case to have an end bearing against a shoulder in its ordinary revolutions, *Held*, that if the defendant's machine was originally constructed and *designed* with the *saw tight to the shaft*, so as to operate *without* end play, and by its usage, and by the wear of the metal of which the shaft was made, such free action or end play was undesignedly produced, that such free end play would not amount to an infringement of the plaintiff's patent. *Ib.*, 312.

26. There is no violation of the rights of a patentee, under the laws of the United States, giving to him an exclusive right to use the thing patented, provided the use of the thing patented by a third person is under a license or grant from the patentee, and such person covenanting to do certain things on his part, in consideration of such license. *Judson & Goodyear v. Union I. R. Co.*, 4 Blatchf., 66.—INGERSOLL, J.; N. Y., 1857.

27. If an invention be but an improvement on a known machine, the inventor cannot treat another as an infringer, who has improved the original machine by using a different form or combination, performing the same function. *McCormick v. Talcott*, 20 How., 405.—GRIER, J.; Sup. Ct., 1857.

28. The inventor of a first improvement, cannot invoke the doctrine of mechanical equivalents to suppress all other improvements, which are not mere colorable invasions of the first. *Ibid.*, 405.

29. The use of a patented invention, as a matter of business, and the product of which is thrown into market for the purpose of being sold, cannot be called

experimental, but is such a use as will make the party liable. *Poppenheusen v. N. Y. G. P. Comb Co.*, 2 Fisher, 72.—INGERSOLL, J.; N. Y., 1858.

30. Where two machines produce the same result, but the means used by each to effect or produce such result are different, the two machines are not alike in principle, and the one is not an infringement upon the other. *Burr v. Cowperthwaite*, 4 Blatchf., 172.—INGERSOLL, J.; Ct., 1858.

31. A patent for making bonnet frames is not infringed by making simply the crown of a bonnet, without the tip. A bonnet frame includes both the crown and tip. *Kidd v. Spence*, MS.—INGERSOLL, J.; N. Y., 1859.

4. *Actions for, and Defences in.*

See ACTIONS, B. 1, 3; EQUITY, B. 1; DEFENCES.

6. *Evidence as to, and by whom determined.*

See EVIDENCE, H. 3.

C. OF TRADE-MARKS.

See also EQUITY, C.

1. The making and sale of medicines, under the name of medicines prepared and sold by the plaintiff, and selling them as and for those of the plaintiff, is a fraud upon the plaintiff, and an injury to his rights, for which the law will presume damage. *Thomson v. Winchester*, 19 Pick., 216.—SHAW, Ch., J.; Mass., 1837.

2. And the plaintiff, such a case being proved, will be entitled to recover nominal damage, at least, and more, if he shows he has sustained it. *Ibid.*, 216.

3. The fact that others have imitated the trade-mark and labels of the plain-

tiff, rather aggravates than excuses a violation, unless done with the consent or acquiescence of the plaintiff. *Taylor v. Carpenter*, 3 Story, 464.—STORY, J.; Mass., 1844.

4. A person has no right, and will not be allowed to use the names, letters, marks, or symbols, of another, to palm off upon buyers the article he is selling as the manufactures of such other person. *Coats v. Holbrook*, 2 Sand., Ch., 594.—SANDFORD, V. Chan., N. Y., 1845.

5. It makes no matter that the imitated article is as good as the original. *Ibid.*, 595.

6. The court will hold any imitation of a trade-mark colorable, which requires a careful inspection to distinguish its marks and appearance from those of the manufacture imitated. *Partridge v. Menck*, 2 Sand. Ch., 625.—SANDFORD, V. Chan., N. Y., 1846.

7. But it will not interfere, where ordinary attention will enable a purchaser to discriminate. It does not suffice to show that persons incapable of reading the labels might be deceived. It must appear that the ordinary mass of purchasers, paying that attention which such persons usually do, would probably be deceived. *Ibid.*, 625.

8. There can be no harm done to the owner of a trade-mark, of which he has a right to complain, unless his label or trade-mark be appropriated without change, or unless it is simulated in such a manner as probably to mislead his customers or patrons, inducing them to suppose that in purchasing the article marked they are purchasing that manufactured or sold by such owner. *Partridge v. Menck*, How. App. Cas. 559, 560.—WRIGHT, J.; N. Y., 1848.

9 One who affixes to his own goods

an imitation of an original trade-mark by which those of another are distinguished and known, commits a fraud upon the public, and upon the true owner of the trade-mark. *Amoskeag Manuf. Co. v. Spear*, 2 Sand., S. C., 605, 606.—DUEB, J.; N. Y., 1849.

10. In the case of the owner there is a fraud coupled with damage, which may be such as not to admit of compensation in damages, and which may be irreparable. *Ibid.*, 606.

11. In all cases where a trade-mark is imitated, the essence of the wrong consists in the sale of the goods of one manufacturer or vender, as those of another; and it is only when this false representation is directly or indirectly made, and only to the extent in which it is made, that a party can have a title to relief. *Ibid.*, 607.

12. The imitation of an original trade-mark need not be exact or perfect. It may be limited or partial. It may embrace variations that a comparison would instantly disclose, yet a resemblance may exist that was designed to mislead the public, and the effect may have been produced. *Ibid.*, 607.

13. It is not necessary, to render the imitation of a trade-mark culpable, that it should contain any forgery of the name of the owner of the original mark. Though the name of the proprietor is omitted, and that of the imitator substituted, if the peculiar device is copied, and so copied as to manifest a design of misleading the public, the omission or variation will be disregarded and an injunction issue. *Ibid.*, 608.

14. Under § 2 of the act of 1845, (New York) making it penal to sell any merchandise having on it any forged or counterfeited label or trade-mark, the vender cannot recover the price of the

goods sold, provided he knew that the labels or trade-marks were forged or counterfeited. *Rudderow v. Huntington*, 3 Sand., S. C., 256.—SANDFORD, J.; N. Y., 1849.

15. But where the vender had no knowledge that the labels or trade-marks were forged or fraudulent, and there was no warranty by him, nor any representation to such effect, he is entitled to recover. *Ibid.*, 256.

16. The original crime or fraud in the preparation of the counterfeit trade-marks does not attach itself to the goods in the hands of an owner ignorant of the offence, and fasten upon him the penalty of a wrong of which he is innocent. *Ibid.*, 256.

17. Where goods were sold by an auctioneer, as being a particular article, but they proved to be spurious, and the label to be counterfeit, but there was no proof that the auctioneer knew them to be counterfeit, and there were no representations as to their genuineness, nor any warranty, *Held*, that it was no defence to an action on a note given for such purchase that such goods were counterfeits. *Ibid.*, 256.

18. If a person has adopted the same mark which is well known and approved of, and which will cause his article to be taken for another in the market, it is an injury which the law will redress. *Coffeen v. Brunton*, 4 McLean, 519.—MCLEAN, J.; Ind., 1849.

19. In commercial dealings the utmost good faith should be observed, and no one is permitted to go into the market with a deception of this character, so as to profit by the ingenuity, good faith, or established reputation of another. *Ibid.*, 519.

20. Where a right is invaded by a fraudulent act, as by the wrongful use

of another's trade-mark, nominal damages are recoverable, though no specific injury is proved. *Ibid.*, 520.

21. The adoption of the same trade-mark as the plaintiff's, or of one so like it as to deceive the public, is actionable. Mere colorable alterations will not protect the defendant. *Davis v. Kendall*, 2 R. I., 569.—GREENE, Ch. J.; R. I., 1853.

22. But if the defendant state on his label or trade-mark that the article which he sells is made by himself, although he calls it by the same name as the plaintiff, he will not be liable. *Ibid.*, 569.

23. And though the defendant without fraud use the trade-mark of the plaintiff, he is still liable; if the right be violated, it matters not whether it be by fraud or mistake. *Ibid.*, 570.

24. The question is, whether the defendant's label is liable to deceive the public and to lead them to suppose they are purchasing an article manufactured by the plaintiff, instead of the defendant. *Ibid.*, 579.

25. The wrong for which remedies for violation of trade-marks are given, consists in misrepresenting to the public, by the use of that trade-mark, goods or wares of another person as having been manufactured by the true proprietor of that mark, and thereby depriving him, to a greater or less extent, of the benefit of the good-will of his establishment, and the reputation of his articles. *Stokes v. Landgraff*; 17 Barb., S. C., 609.—STRONG, J.; N. Y., 1853.

26. If the article sold under the forgery of a trade-mark is inferior to that made by the true owner, he is injured in reputation; and if it be of a similar quality and kind, its sale goes so far to diminish the sale of his own article, and thus works a pecuniary damage. *Le-*

moine v. Gaulton, 2 E. D. Smith, 348.—DALY, J.; N. Y., 1854.

27. The wrong and injury consists in the sale of the article falsely purporting and declared to be his manufacture; and it makes no difference whether that object was effected by counterfeiting the trade-mark which he uses at present, or one that he formerly used. *Ibid.*, 348.

28. Where a party was a manufacturer of steel pens, which he put up in boxes for sale, such boxes bearing particular numbers or labels which indicated the character of the article, and another removed from the inferior pens the number appropriate to them, and placed upon them the label of a superior kind, such acts are a fraud upon the public and the true owner, for which he may have an action. *Gillott v. Kettle*, 3 Duer, 626, 627.—BOSWORTH, J.; N. Y., 1854.

29. In the imitation of trade-marks, the essence of the wrong consists in the sale of the goods of the manufacturer or vender as those of another; and it is only to the extent in which such a false representation is made that a party can have a title to relief. *Samuel v. Berger*, 24 Barb., S. C., 164.—DAVIES, J.; N. Y., 1856.

30. The mere fact that names used on a trade-mark are fictitious will not authorize the use of it by strangers. *Stewart v. Smithson*, 1 Hilton, 121.—BRADY, J.; N. Y., 1856.

31. The question to be determined is, whether the mark used by the party claiming the protection of the court is owned by him, without regard to its form, which such party has a right to design according to his judgment or his fancy. *Ibid.*, 121.

32. To render a person liable for false representations by the use of false signs

or trade-marks, the sign or mark must be false in fact, and be so known to the party using it, and have been used with *the intention to deceive*, and be of such a character as would mislead a person using ordinary caution. *Peterson v. Humphrey*, 4 Abb. Pr., 395, 396.—MITCHELL, J.; N. Y., 1857.

33. An imitation of a trade-mark, with partial differences such as the public would not observe, does the party entitled thereto the same harm as an entire counterfeit. *Clark v. Clark*, 25 Barb., S. C., 79.—MITCHELL, J.; N. Y., 1857.

34. Though the wholesale buyer who is most familiar with the marks may not be misled, if the small retailer or consumer is, the injury is the same in law, and differs only in degree. *Ibid.*, 79.

35. If a defendant has adopted a device or name so differing from that adopted by the plaintiff as in nowise to deceive the public or do injury to the plaintiff, then he is not liable. *Burnett v. Phalon*, 12 Mo. Law Rep., 221.—PIERREPONT, J.; N. Y., 1859.

36. When one intentionally closely imitates the trade-mark of another, as using the word "cocoine" instead of "cocoaine," the law presumes it to have been done for the purpose of inducing the public to believe that the article is that of him whose trade-mark is imitated, and for the purpose of supplanting him in the good-will of his trade and business. *Ibid.*, 223.

37. In an action for the infringement of a trade-mark, the plaintiff is not entitled to recover, as a part of his damages caused by the infringement, the costs of obtaining an injunction in the case. *Burnett v. Phalon*, 12 Abb. Pr., 189; 21 How., Pr., 102.—MONCRIEF, J.; N. Y., 1861.

INJUNCTIONS.

A.	IN RESPECT TO COPYRIGHTS.....	377
B.	IN RESPECT TO PATENTS.	
	1. <i>General Principles applicable to all kinds of.....</i>	379
	2. <i>Preliminary or Provisional</i>	
	<i>a.</i> Allowance or Refusal of.....	381
	<i>b.</i> Right to, from exclusive Possession or former Recoveries; Character of such exclusive Possession....	388
	<i>c.</i> Security in place of, or on granting	396
	<i>d.</i> Practice on Motions for.....	998
	<i>e.</i> Continuance or Dissolution of.....	401
	3. <i>Final or Perpetual.....</i>	404
	4. <i>Violation of.....</i>	407
C.	IN RESPECT TO TRADE-MARKS.....	409

A. IN RESPECT TO COPYRIGHTS.

As to when injunctions will issue to prevent publication of letters and manuscripts, see **LETTERS and MANUSCRIPTS.**

See also, **EQUITY, A.**

1. If the author of a book has not a copyright secured according to law, he is not entitled to an injunction to restrain the publishing and vending of the work by another. He can have no remedy of any kind. *Ewer v. Cox*, 4 Wash., 490, 491.—WASHINGTON, J.; Pa., 1824.

2. If it is doubtful whether or not there has been an infringement, an injunction will not be granted in the first instance; but the parties will be sent to a trial at law. *Blunt v. Patten*, 2 Paine, 403, 404.—THOMPSON, J.; N. Y., 1828.

3. If there appears a reasonable doubt as to the plaintiff's right, or the validity of his title, an injunction will be refused, and he will be required to try his title at law. *Miller v. McElroy*, 1 Amer. Law Reg., 205.—HOPKINSON, J.; Pa., 1839.

4. It is no objection to an injunction to restrain the infringement of a copy-

right, that if it goes to part of the work it may render the other part, which is original, wholly without value, or injuriously diminish its value. *Emerson v. Davies*, 3 Story, 796.—STORY, J.; Mass., 1845.

5. If a person chooses, in any work, to mix with his own literary matter which belongs to another, he will be restrained from publishing that which does not belong to him; and if the parts cannot be separated, and by that means the injunction prevents the publication of his own matter, he has only himself to blame. *Ibid.*, 796.

6. Before granting an injunction on a charge of an infringement of a copyright, the court will generally refer the matter to a master, with instructions to report the extent of the infringement, if any, that the court may act in the case. *Story's Exrs. v. Derby*, 4 McLean, 160, 161.—CURIAM, Ohio, 1846.

7. A court of equity can restrain a future violation of a copyright, as well as require an account for a past one; and such remedy is often better than damages, which alone can be had at law. *Pierpont v. Fowle*, 2 Wood. & Min., 35.—WOODBURY, J.; Mass., 1846.

8. In respect to copyrights, the course has been so liberal as to enjoin, if an equitable or clear title exists; and if the title be free from doubt, the court will always enjoin. *Ibid.*, 39.

9. Though small in value, an imitation or appropriation of another's invention or copyright may be actionable, and the subject of an injunction, perhaps, if easily separated from the rest. But where the appropriation is small, and pervades the whole work, and no permanent injunction can issue without destroying the whole, such a remedy would be disproportionate, unsuited to

the case, and therefore unjust. *Webb v. Powers*, 2 Wood. & Min., 521, 523.—WOODBURY, J.; Mass., 1847.

10. The damages sustained may be obtained in a suit at law, without destroying the whole work, and such would be the most equitable relief. *Ibid.*, 523.

11. But where a violation is clear, and the part copied can readily be separated, an injunction issues against such part. Where a party wilfully mixes the property of another with his own with a bad motive, he may be required at times to lose the whole. *Ibid.*, 521, 522.

12. An injunction in copyright cases chiefly runs against the specific parts copied. It is usually issued to work substantial justice between the parties, rather than destroy the whole book of the defendant for a small infringement, if otherwise it is novel and unexceptionable, and useful to the community. *Ibid.*, 523.

13. Whether the purchase and sale by the plaintiffs of the defendant's book, and the delay of plaintiffs to prosecute, should bar an application for an injunction; *query*. *Ibid.*, 523.

14. Where, on a motion for an injunction to restrain the alleged violation of a copyright, the evidence is conflicting, and not full enough to enable the court to determine on which side the truth lies, a decision on the injunction will be suspended, and an issue at law directed, and the defendants ordered to keep an account of their sales, and report to the court. *Jollie v. Jaques*, 1 Blatchf., 626.—NELSON, J.; N. Y., 1850.

15. There may be cases in which an equitable title in a copyright is sufficient to entitle its possessor to protection by injunction. *Little v. Gould*, 2 Blatchf., 181.—CONKLING, J.; N. Y., 1851.

16. Where, under an agreement between the plaintiffs and certain officers of the state designated by law for that purpose, and the reporter of the Court of Appeals, it was stipulated that, upon the terms mentioned therein, the plaintiff should have the exclusive right to the publication of the decisions of the said Court of Appeals prepared by said reporter, for a period of five years, and the defendants during that time published and sold such decisions, *Held*, that the plaintiffs, though not the assignees of the entire privilege or copyright, had a perfect title to the beneficial interest therein during the stipulated term of five years, and that it was such a title as the court was bound to take cognizance of. *Ibid.*, 181, 183.

17. Where, however, such reporter, after his removal from the said position of reporter, prepared a volume of the decisions of said court, on his own account, and in his individual or private capacity, such volume containing, however, some decisions that came into his hands while he held the official position of reporter—and sold the same to the defendants, who published the same, *Held*, on a bill filed by the plaintiffs for an injunction, and claiming title to such volume, by virtue of the agreement referred to in the case last above named, that the plaintiffs could not be considered as the legal owners of the volume, for the purposes of the contract under the copyright laws, and that they were not entitled to an injunction to prevent its publication and sale. Whatever obligation may arise under such contract as to such volume, is founded on the failure of the reporter to furnish the manuscripts to the plaintiff. *Little v. Hall*, 18 How., 172.—MCLEAN, J. Sup. Ct., 1855.

18. Where, on a motion for an injunction to restrain the alleged violation of a copyright, it appeared that neither the title-page nor a volume of the printed book had been deposited until more than two years after the work had been published, *Held*, that the plaintiff was not entitled to an injunction, as he had no valid copyright. *Struve v. Schwedler*, 4 Blatchf., 24.—NELSON, J.; N. Y., 1857.

19. Where a person claimed to have secured his copyright in June, 1856, but before that time had assisted in the preparation for publishing of a volume, and in the selection of matter therefor, which he afterward insisted was included in his copyright, but at such time made no claim to copyright on his part, and subsequently was also employed by the publisher of the first work, at a stipulated price, to reduce for another work the drawings which were the subject of the assumed copyright, *Held*, that such person would not be permitted to stop the sale of the work, even if he had a valid copyright therein. By aiding in the publication, he agreed to it, and by assenting that the work might be published, he agreed that it might be sold. *Heine v. Appletons*, 4 Blatchf., 128.—INGERSOLL, J.; N. Y., 1857.

20. On a motion for an injunction for the infringement of a copyright, a reference will not be made to a master to examine the map or book of the complainant, and also that of the defendant, and report the facts, with his opinion on the question of the infringement of right. Such motions must be disposed of on the moving papers of the complainants and the affidavits on the part of the defendants in opposition thereto. *Smith v. Johnson*, 4 Blatchf., 252.—INGERSOLL, J.; N. Y., 1858.

B. IN RESPECT TO PATENTS.

1. *General Principles applicable to all kinds of.*

1. A judge of the court in vacation can allow a writ of injunction in those cases only where it may be granted by the Supreme or a Circuit Court. *Livingston v. Van Ingen*, 1 Paine, 47.—LIVINGSTON, J.; N. Y., 1811.

2. Where, therefore, a suit was commenced on the equity side of the Circuit Court for the infringement of a patent, and praying for an injunction, and the parties were residents of the same state, *Held*, that the court had no jurisdiction of the case, as under the judiciary act the court could take jurisdiction only as between citizens of different states, and the act of 1800 conferred jurisdiction in patent cases only in actions at law, and that the injunction must be refused. *Ibid.*, 48, 54.

3. In the exercise of its jurisdiction, in all cases of granting injunctions to prevent the violation of patent-rights, the court is to proceed according to the course and principles of courts of equity in such cases. *Sullivan v. Redfield*, 1 Paine, 448.—THOMPSON, J.; N. Y., 1825.

4. The jurisdiction exercised by a court of equity in granting an injunction is in aid of the common law, and should not be asserted when the right is doubtful. The court in granting the injunction acts upon the assumption that the right has been infringed, or that little or no doubt exists on that point. *Thomas v. Weeks*, 2 Paine, 97.—THOMPSON, J.; N. Y., 1827.

5. A bill will lie for an injunction, if the patent-right has been established, or

is admitted, upon well grounded proof of an apprehended intention of the defendant to violate the patent-right. A bill, *quia timet*, is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 Story, 752.—STORY, J.; Mass., 1845.

6. Bills for injunctions are usually brought after the title to a patent has been established, and the expectation is that the only questions agitated will be the amount to be accounted for, and the restrictions for the future. *Orr v. Merrill*, 1 Wood. & Min., 378.—WOODBURY, J.; Me., 1846.

7. Injunctions being prohibited in the courts of the United States (by § 5 ch. 22, of the act of 1793, 1 Stat. at Large), without notice first to the opposing party, it follows that all of them must be regarded as special, rather than some of them as common or matter of course, and therefore when resisted under such notice, whether the hearing comes on before or after an answer, no injunction can be granted unless special and sufficient cause is clearly shown. *Perry v. Parker*, 1 Wood. & Min., 281.—WOODBURY, J.; Mass., 1846.

8. An injunction cannot properly issue in a patent case, except on a bill of complaint regularly filed. *Morse v. O'Reilly*, MS.—CATRON, J., at Chambers; D. C., 1849.

9. An injunction cannot issue out of a state court to restrain a defendant from infringing a patent; such courts have no jurisdiction over the subject matter. *Dudley v. Mayhew*, 3 Coms., 19.—STRONG, J.; N. Y., 1849.

10. Proceedings to restrain the unlawful use of a machine are instituted against the owner or party concerned in the infringement, who is personally liable for the violation, and may be brought in the district where he lives,

or is found at the time of serving the writ, even though the machine is in another district. But where it might become necessary to proceed directly against the machine itself, as in cases of controversy, or fraudulent contrivance to evade an injunction, the proceedings should be instituted in the district in which the machine is located. *Wilson v. Sherman*, 1 Blatchf., 541.—NELSON, J.; N. Y., 1850.

11. The stringent directions in the act of 1836 as to injunctions, copied from the act of 1819, seem to be designed to remove all doubts as to the authority of the courts of the United States to employ that process in patent cases to the same extent it is used in courts of general jurisdiction. *Nevins v. Johnson*, 3 Blatchf., 81.—BETTS, J.; N. Y., 1853.

12. If a defendant for a good consideration covenants not to infringe a patent, he will be enjoined by a court of equity from further infringing, unless he shows some equitable reason why the performance of such agreement should not be enforced. *Sargent v. Larned*, 2 Curt., 344.—CURTIS, J.; Mass., 1855.

13. A bill for an injunction should be filed in the state where the defendant resides. An injunction will not issue out of a court in a state different from that where such defendant resides and carries on his business, on the ground that they would be beyond the process of the injunction, and the issuing of it would be inoperative and useless. *Goodyear v. Chaffee*, 3 Blatchf., 270.—NELSON, J.; N. Y., 1855.

14. A writ of injunction ought to contain a concise description of the particular acts or things in respect to which the party is enjoined, so that there may

be no misapprehension on the subject, in order to warrant an attachment for its violation. *Whipple v. Hutchinson*, 4 Blatchf., 192.—NELSON, J.; N. Y., 1858.

15. Where the writ of injunction referred to the complaint for the description of the thing enjoined, such description may be sufficient, so far as the defendant, who has been already served with the complaint, is concerned, but as to all other persons it would not be sufficient. *Ibid.*, 192.

16. The writ of injunction is a remedial writ, in the nature of a prohibition—to prevent the commission of injuries in future, not to redress injuries that are past. It acts as a remedy against a threatened wrong by preventing the commission of such wrong. *Poppenheusen v. N. Y. G. P. Comb Co.*, 4 Blatchf., 187.—INGERSOLL, J.; N. Y., 1858.

17. It is not necessary before such a writ to prevent a wrong, issue, that the wrong should have been actually committed. When the rights of a party have been established, and an infringement of such rights is threatened, or where they have been infringed, and the party has good reason to believe they will continue to be infringed, an injunction will issue. *Ibid.*, 187.

18. The remedy by injunction, though necessary in certain cases to do complete justice, is nevertheless one which should always be cautiously granted, especially where demanded before decree on final hearing on the merits. *Goodyear v. Dunbar*, 1 Fisher, 474.—GRIER, J.; N. J., 1861.

19. If the defendant shows a belief that he has a just defence, and is not a wilful pirate of the plaintiff's invention, it should be a case of evident mistake

of law or fact, or both, in his defence, which will justify the court in using their *festinum remedium*. *Ibid.*, 474.

2. Preliminary or Provisional.

a. Allowance and Refusal of.

See also INJUNCTIONS, B. 2. d.

1. Where it appeared that the thing patented was the result of the suggestion of another, *Held*, that it threw so much doubt upon the patentee's right as the first and sole inventor, as to render it improper to grant an injunction until his right has been tried at law. *Thomas v. Weeks*, 2 Paine, 102.—THOMSON, J.; N. Y., 1827.

2. A court of equity will not interfere in behalf of a patentee, either to grant an injunction, or to give him any relief in respect to an alleged violation of his patent, if, after having obtained his patent, he has surrendered or dedicated it to the public, or acquiesced, for a long period, in the public use thereof without objection, as his own conduct may be considered as having led to such use or application, or acts of the defendants. *Wyeth v. Stone*, 1 Story, 282, 284.—STORY, J.; Mass., 1840.

3. The granting of an injunction is a matter resting in the sound discretion of the Court. *Ibid.*, 295.

4. In awarding an injunction, a very delicate and highly responsible power is used, which ought not to be exerted where there is reasonable doubt as to the existence of any fact on which the application is founded. *Cooper v. Matthews*, 8 Law Rep., 415.—BALDWIN, J.; Pa., 1842.

5. In asking an injunction, the plaintiff seeks either to interrupt the course

of the common law, or to ask for some relief he cannot have at law; he must consequently state and make out a case for equitable relief on such facts as bring his case within the jurisdiction of the courts of equity, and proper for its exercise. *Ibid.*, 416.

6. There should be a certainty as to all the material facts, for doubt and uncertainty are fatal to a motion to grant an injunction, though it is good cause for continuing it on a motion to dissolve, the burden of proof being on the plaintiff in one case, and on the defendant in the other. *Ibid.*, 416.

7. An injunction will be granted only when the plaintiff has used due diligence in asserting his rights. If he acquiesces, or is inactive while the danger exists, or the mischief is done, it negatives the necessity of action in equity, unless the inaction is accounted for. *Ibid.* 417.

8. The inquiry is not whether the plaintiff had notice of the violation of his right by the defendant, but whether his improvement has come into public use during his inaction, or a state of things of which he might have had notice by the use of due diligence, or where the law of equity deems negligence to be the same as notice. *Ibid.*, 418.

9. A court of equity frequently refuses an injunction where it acknowledges a right, when the conduct of the party had led to a state of things which occasions the application, and therefore will refuse or dissolve an injunction, without saying in whom the right is. *Ibid.*, 419.

10. An injunction will not be granted to restrain a party who has been in possession any length of time claiming by a title adverse, till the right is first set-

tled by law. An injunction is a proper remedy to protect a possession until it appears to be against right, but is never used to disturb a possession under claim and color of right. *Ibid.*, 419.

11. The rule on which courts of equity act by an injunction in the first instance, is to leave the parties in the same position it finds them when the application for relief is made, by protecting the plaintiff in the same possession which he had before enjoyed, and when the possession of the defendant had been unmolested, leaving the right of possession to be settled at law. *Ibid.*, 419.

12. No cases come before a court of equity in which a greater degree of diligence is required than applications for injunctions; their nature and effect are such as to produce the most irreparable injury when improvidently granted. *Ibid.*, 419.

13. Equity acts on different principles in protecting the possession of the plaintiff, or declining to disturb the defendant; it leaves the right of the parties as they stand at law. *Ibid.*, 420.

14. The refusal of an injunction to a plaintiff does not impair his right or remedy at law. Nor does the granting of an injunction interfere with the defendant contesting, at law, the right of the plaintiff to the same extent as if equity had not interfered. *Ibid.*, 420.

15. Courts of equity exercise this part of their jurisdiction, granting injunctions with great caution, always declining it in a doubtful case, and one not brought forward by a party who was vigilant, and not clearly within the established rules and principles of equity jurisprudence. *Ibid.*, 421.

16. In most cases a court will not enjoin, until the complainant has established his right at law. But where the

injury would be irreparable, an injunction will issue. *Brooks v. Bicknell*, 3 McLean, 262.—McLEAN, J.; Ohio, 1843.

17. For a reference to and examination of many of the cases in reference to granting injunctions, see *Orr v. Littlefield*, 1 Wood. & Min., 13.—WOODBURY, J.; N. H., 1845.

18. It is within the sound discretion of the court whether to issue an injunction or refuse it; or if issued, to dissolve or retain it. *Ibid.*, 19.

19. The rule is well settled, that in cases of infringement involving points to be decided by the testimony of experts, and as to which there is a great diversity of opinion, an injunction will not be decreed unless the right is clear, or has been established by an action at law. *Brooks v. Bicknell*, 4 McLean, 72.—McLEAN, J.; Ohio, 1845.

20. A patentee will not be deemed to have acquiesced in the use of his invention, so as to deprive him of the right to an injunction, &c., because he first proceeded against only the more palpable and obvious violations of his patent, or because he has not brought suit against all infringing upon it. *Van Hook v. Pendleton*, 1 Blatchf., 191.—NELSON, BETTS, JJ.; N. Y., 1846.

21. *Semble*, that a workman on a machine, though not interested in it, is liable to be restrained in order to prevent evasions. *Woodworth v. Hall*, 1 Wood. & Min., 252.—WOODBURY, J.; Mass., 1846.

22. So if a person does not himself perform the work, but procures another to do it for his advantage, on a machine owned by himself, he can still be restrained, and is estopped from denying *qui facit per alium, facit per se*; or if he hire one to work on such a machine. *Ibid.*, 252.

23. An injunction will not be granted against a person restraining him from using a machine, unless it is shown that he actually used it, or received profit from it. *Ibid.*, 253.

24. Slight and unimportant alterations in a machine—alterations which the description of the invention would naturally, if not necessarily, suggest without the aid of much ingenuity or skill, will not be sufficient to prevent the issuing of an injunction to restrain the use of such a machine. *Gibson v. Harris*, 1 Blatchf., 170, 172.—NELSON, J.; N. Y., 1846.

25. An injunction will be granted as well against an agent, who merely sells the article which infringes a patent, as against the manufacturer, as both are joint trespassers, and they may be sued jointly. *Buck v. Cobb & Hermance*, 9 Law Rep., 547.—CONKLING, J.; N. Y., 1846.

26. Where an inventor had manufactured and put on sale his invention for some time before his application for a patent, and had also sold large quantities of the article invented, an ornamental button, in packages marked as imported from Paris, thereby affording an implication that he was not the original inventor, *Held*, in an action for infringement, and the novelty of the invention being denied, that he was not entitled to a provisional injunction, until his right should have been established at law. *Booth v. Garelly*, 1 Blatchf., 250.—NELSON, J.; N. Y., 1847.

27. Where one person runs a machine which others own, and which machine is a violation of a patent, an injunction will issue against all for the violation. *Woodworth v. Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

28. If an injunction has been issued against a person, restraining him from the use of an alleged invention, which injunction remains in full force, and the grounds of which are in no way overturned, the use of such alleged invention will not be permitted by third persons, claiming from such person, but they will also be enjoined. *Ibid.*, 133.

29. An injunction is never issued in hostility to what seem to be the legal rights of parties, but in aid and protection of them. And whenever a trial is had, showing that the rights at law are with the party enjoined, the injunction, as a matter of course, will be dissolved. *Woodworth v. Rogers*, 3 Wood. & Min., 150.—WOODBURY, J.; Mass., 1847.

30. Where a bill was filed for an injunction, to restrain the running of a machine in violation of the plaintiff's rights, and the defendants justified under a license, which the complainant alleged had been abandoned, but there was no issue of abandonment made in the pleadings, *Held*, that no evidence of abandonment could be received, and therefore an injunction could not issue. *Wilson v. Stolley*, 4 McLean, 276.—MCLEAN, J.; Ohio, 1847.

31. The grant of a patent by the patent office, is not of itself, or in virtue of § 7 of the act of 1836, a bar to an interlocutory injunction, in favor of a person claiming to be a prior patentee of the same thing; and particularly as such person had no notice to appear and be heard at the patent office, and the court being satisfied on a hearing before it that the last granted patent was an interference with the one previously granted. *Wilson v. Barnum*, 1 Wall, Jr., 349, 350.—KANE, J.; Pa., 1849.

32. Where the court is itself satis-

fied that the defendants are infringing the plaintiff's right, although the majority of experts, called as witnesses, were of the opinion that there was no infringement, it is its duty to grant an injunction to restrain such infringement. *Ibid.*, 351, 352.

33. An injunction will be granted against a licensee to restrain him from the use of a machine, in violation of the conditions of his license, if applied for during the time of such violation. *Wilson v. Sherman*, 1 Blatchf., 540.—NELSON, J.; N. Y., 1850.

34. But where it appears that the violation has been under a misapprehension of his rights, and he has discontinued the violation, an injunction will not be granted. *Ibid.*, 540.

35. An injunction will be granted in favor of the holder of the legal title of a patent, against the holder of an equitable interest therein, if it appear that the holder of the legal title was a purchaser for a valuable consideration, and without notice of the equitable interest; and the burden of proof lies on him impeaching the legal title. *Gibson v. Cook*, 2 Blatchf., 145, 151.—NELSON, J.; N. Y., 1850.

36. The chief object of issuing writs of injunction before the final hearing of a cause, is to prevent irreparable mischief; not to give the complainant the means of coercing a compromise from the injury the defendants may suffer from being restrained. *Parker v. Sears*, 1 Fisher, 101.—GRIER, J.; Pa., 1850.

37. The issuing of an interlocutory injunction is always a matter of discretion with the court, and depends upon the peculiar circumstances of each case. *Ibid.*, 102.

38. No interlocutory injunction should issue, unless the complainant's title, and

the defendant's infringement are admitted, or are so palpable and clear that the court can entertain no doubt on the subject. *Parker v. Sears*, 1 Fisher, 96.

—GRIER, J.; Pa., 1850.

39. Where, however, the answers or affidavits are equivocal and evasive, or disclose a state of facts which show that the conclusions drawn from them are clearly erroneous, and founded on a mistake of law; as when an infringement is denied and a model admitted, which shows a palpable infringement, and it is evident that the denial is made under a gross mistake of the true construction of the patent; or where the originality of the invention is denied in general terms, and infringement is admitted, and the patent has been fully established at law, and it is evident that the denial of its validity is but a matter of obstinate opinion or mistake of law, an injunction will issue, as such cases are exceptions to the general rule. *Ibid.*, 96.

40. The object of granting a preliminary injunction is simply to keep the parties in *statu quo* until the legal rights can be ascertained. One material question always is, whether the defendants are responsible. *Day v. Boston Belting Co.*, 6 Mo. Law Rep., 330, 331.—SPRAGUE, J.; Mass., 1853.

41. The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction articles are manufactured which are an infringement of a patent, and the agents who conduct the business of selling such articles, are responsible for such infringement, and may be restrained by injunction. *Goodyear & Union Rubber Co. v. Phelps*, 3 Blatchf., 93.—NELSON, J.; N. Y., 1853.

42. One tenant in common has as good

right to use and license others to use a thing patented, as another tenant in common. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract between them. None such existing, one tenant in common cannot enjoin the other from such use or sale. *Chum v. Brewer*, 2 Curt., 524.—CURTIS, J.; Mass.; 1855.

43. A court of equity upon a bill filed by a legal owner of a patent cannot enjoin the equitable owner from using it. *Ibid.*, 523, 524.

44. In acting on applications for temporary injunctions to restrain the infringement of letters patent, there is much latitude of discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for making or refusing the order. *Forbush v. Bradford*, 11 Mo. Law Rep., 471.—CURTIS, J.; Mass., 1856.

45. The state of the litigation, where the plaintiff's title is denied, the nature of the improvement, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or disallowing the motion, must all be considered in determining whether it should be allowed or refused; and if at all, whether absolutely or upon some and what conditions. *Ibid.*, 471.

46. Where the defendants were only using in their own business a certain number of the patented invention, looms for weaving, and were not making and selling, the court ordered an injunction, unless the defendants should within a certain number of days give a bond to keep an account of the cloth made on each of the looms, and file the

same under oath once in three months, and to pay the amount of any final decree in the cause. *Ibid.*, 472, 473.

47. If a defendant has been making and selling a thing patented for more than two years before the application for a patent by the patentee, an injunction will not issue to restrain him from doing that which he was accustomed to do at the time of the granting of the patent. *Gebberd v. Bagot*, MS.—INGERSOLL, J.; N. Y., 1857.

48. Where by granting an injunction there is more danger of producing an irreparable injury to the defendant than preventing it on the part of the complainant, it should not be granted. *Ibid.*

49. Every man who stands upon a patent has a *prima facie* title, which upon a preliminary question will not be pronounced good for nothing. *Cong. Rub. Co. v. Amer. Elas. Cloth Co.*, MS.—GRIER, J.; Pa., 1857.

50. Where on a motion for a preliminary injunction, the defendants claimed to act under a patent regularly issued from the Patent Office, *Held*, that the court would not on such a motion decide against such a patent, and grant the injunction prayed for. *Ibid.*

51. It is not a sufficient reason against granting an injunction that its issue will put the defendant to considerable expense, that he is not making any profits by its use, that he is willing to pay for its use when it shall have been legally established, and that he is able to respond in any damages which may be recovered against him. *Sickles v. Mitchell*, 3 Blatchf., 552.—INGERSOLL, J.; N. Y., 1857.

52. A defendant cannot insist upon having the privilege of using a patented invention for the reason that he is able to pay any damages which may be

awarded against him at the end of a protracted litigation. *Ibid.*, 552.

53. Where the plaintiff's invention was in use upon one of a line of ocean steamers, and it was claimed that the issuing of an injunction to restrain its further use would be a great public calamity, and that it would be impossible to remove the invention without an enormous expense and a consumption of several months of time, *Held*, that these were not sufficient reasons for refusing an injunction, and that for such results the defendant had no one to blame but himself. *Ibid.*, 551-2.

54. Where the defendants set up that they were manufacturing the thing claimed to be an infringement of the plaintiff's patent, under and by virtue of another patent, and it appeared that they had been so manufacturing such article for a number of years with the knowledge of the plaintiffs, and without suits or molestation from them, *Held*, that the right to an injunction was not so clear of reasonable doubt as to warrant its issue. *North v. Jones*, 4 Blatchf., 73.—INGERSOLL, J.; N. Y., 1857.

55. Where on a motion for an injunction the only question raised was as to the fact of infringement, as to which the affidavits were contradictory, and the defendants denied that their machine was intended to, or did perform, the functions of the plaintiff's, and for which a patent had been obtained, though a slight change would give to the defendants' machine the benefit of the patentee's arrangement, the court denied the motion, but with liberty to renew it upon further evidence. *Singer v. Wooster*, MS.—NELSON, J.; N. Y., 1857.

56. An injunction will not be granted to restrain the use of a patented inven-

tion after the patent has expired. *Im-lay v. Nor. & Wor. R. R.*, 4 Blatchf., 237.—INGERSOLL, J.; Ct., 1858.

57. An interlocutory injunction will not be granted when the defendant has letters patent for the same invention, as the plaintiff's, which are *prima facie* valid. *Sargent v. Carter*, 11 Mo. Law Rep., 652.—CURTIS, J.; Mass., 1858.

58. To authorize an injunction it is not necessary that *all* the grants of right in the plaintiff's patent should have been infringed. All that is required is that some of them should have been. *Potter v. Holland*, 4 Blatchf., 251.—INGERSOLL, J.; Ct., 1858.

59. Under the practice and decisions of the seventh circuit an injunction will be refused in a patent case, if upon the facts presented there is a fair doubt whether the defendant has infringed. *Dodge v. Vard*, 2 Fisher, 117.—LEAVITT, J.; Ohio, 1860.

60. Upon a motion for a preliminary injunction, the defendant justified his acts under an outstanding adverse patent, which however was alleged to have been irregularly issued, *Held*, that the court would not ignore the rights of parties under such instrument, because there may have been some irregularity in its issue, and assume it to be a nullity. *Mitchell v. Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

61. The granting or refusal of an injunction in a patent case rests in the sound discretion of the court. A rash or indiscreet exercise of such power may be very oppressive, as of no use to the complainant and ruinous to the defendant. *Sanders v. Logan*, 2 Fisher, 170.—GRIER, J.; Pa., 1861.

62. As a remedy it should be administered only for prevention and protection. Where it is not necessary for

these purposes, it is merely vindictive, injuring one party without benefit to the other. *Ibid.*, 170.

63. The issue of an injunction to stop a mill or a manufactory, locomotive or steam-engine, because in their construction some patented device or machine has been used, would be an act of *more than doubtful discretion*. *Ibid.*, 170.

64. Stopping the mill or engine might *inflict irreparable injury*, but could not benefit the inventor. *Ibid.*, 170.

65. Where the injury done to the patentee, by the use of his invention, exists not in using his invention, but in using it without paying compensation therefor, it being his interest that his invention should be used by all, provided he is paid the price of a license; and the measure of "actual damage" is a sum certain—the value of a license—and neither protection nor prevention is sought or required, but only compensation, the jurisdiction of a chancellor is not required, and an injunction is not the proper remedy; the issue of it would be an abuse of power. *Ib.*, 170.

66. An injunction is never granted vindictively, but only when it is necessary to protect the rights of the complainant. *Livingston v. Jones*, 2 Fisher, 210.—GRIER, J.; Pa., 1861.

67. Where a patentee has fixed a license fee as the consideration for the use of his invention, and suffers no other wrong for such use than the detention of his fee, an injunction would do him no good. *Ibid.*, 210.

68. Where a defendant is acting under apparent legal authority, *prima facie* good—as under a patent granted by the proper authorities—a preliminary injunction will not issue against him at the suit of an older patentee, claiming that his patent covers the same process.

The defendant, by virtue of his patent, has a *prima facie* legal right to manufacture under it. *Goodyear v. Dunbar*, 1 Fisher, 473.—GRIER, J.; N. J., 1861.

69. Wherever a defendant presents, by answer or otherwise, a case which shows a *bona fide* issue in fact or law, or a *prima facie* right to continue his manufacture, founded on a decree of the Patent Office, and a consequent public grant, the court will rarely give a preliminary injunction. This kind of process being, in fact, an execution before judgment, is to be used cautiously. *Ibid.*, 474.

70. Where an alleged infringement of a patented invention consists in the use of some improvement in expensive machinery, which has been adopted in good faith by a defendant, and where the profit of the patentee consists, not in the monopoly of selling his machine, but in the price of licenses given to others to use it, it being the interest of the patentee that all persons should use his improvement, provided they pay him for a license; and the injury being, not in their using his invention, but in their not paying him for using it; this court sitting in chancery, though it does not necessarily in such capacity act as auxiliary to a court of law, but may render a final decree on a patent, will not, before a right is established at law, grant a preliminary injunction, except in a clear case, since it might ruin the defendant without doing any corresponding benefit to the patentee, and since the main object of an injunction can be obtained by making the defendant keep an account until the right is decided at law. *Batten v. Silliman*, 3 Wall, Jr.—GRIER, J.; Pa., 1861.

71. This case, distinguished from the case of a medicine where the patentee's

profit consists in a monopoly of sale, and the defendant has been at little or no expense, while his competition might be highly injurious to the complainant. An injunction might (the medicine not being a "quack" medicine) be granted in the latter case, when it would be refused in the former. *Ibid.*

72. The fact that, as between themselves, parties are connected together as the stockholders, managers, and servants of an incorporated company, will not exempt them from being enjoined, or being liable to an action for infringement. *Poppenhausen v. Falke*, 4 Blatchf., 494.—SHIPMAN, J.; N.Y., 1861.

b. Right to, from exclusive Possession or former Recoveries; Character of such exclusive Possession.

1. If the bill states an exclusive possession of the invention or discovery, for which the plaintiff has obtained a patent, an injunction is granted, though the court may feel doubts as to the validity of the patent. *Isaacs v. Cooper*, 4 Wash., 260.—WASHINGTON, J.; Pa., 1821.

2. But where the patent is modern, and objections are made to the specification, or to the validity of the patent, the court will not, from its own notions of the matter in dispute, act on the presumed validity or invalidity of the patent, and will not grant an injunction until the plaintiff has established the validity of his patent at law. *Ibid.*, 260.

3. The rule in the English Court of Chancery, as to granting injunctions—and there are no American decisions at variance therewith—is, that where a patent has been granted, and there has been an exclusive possession of some

duration under it, the court will interpose its injunction without putting the party previously to establish the validity of his patent at law. *Sullivan v. Redfield*, 1 Paine, 449.—THOMPSON, J.; N. Y., 1825.

4. Where the patent is recent, and, upon an application for an injunction, it is endeavored to be shown, in opposition thereto, that there is no good specification, or, otherwise, that the patent ought not to be granted, the court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will give him the benefit of an injunction. *Ibid.*, 449.

5. In *Hill v. Thompson* (3 Meriv. 622), in which Lord Eldon adopted the rule before referred to, the patentee had had his patent-right in operation for about eighteen months; but this was considered too short a period to justify a continuance of the injunction. *Ibid.*, 452.

6. If the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit, and if the plaintiff has been in possession of it by having used it or sold it, in part or in whole, the court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try his right. *Ogle v. Ege*, 4 Wash., 584.—WASHINGTON, J.; Pa., 1826.

7. Where a patent was granted in 1818, and was on its face free from all exception, and six years thereafter the patentee sold the right for Pennsylvania for \$700, and bill was filed in 1826

for an injunction to restrain an infringement, *Held*, that the injunction would be retained until the invalidity of the patent, or the want of title in the plaintiff, should be established by law. *Ibid.*, 585.

8. Where there has been an exclusive possession for some considerable time, of a patent-right, the court will sometimes, on the ground of possession, grant an injunction, without requiring the party previously to establish the validity of the patent at law. *Thomas v. Weeks*, 2 Paine, 97.—THOMPSON, J.; N. Y., 1827.

9. But where the patent is recent, and any real doubts are entertained of its validity, the court will require that it be established at law before it will grant the patentee the benefit of an injunction. These principles are well settled in this country, and are founded on the soundest rules of justice and equity. *Ibid.*, 97.

10. The sale of an invention, and its use by the inventor and his vendors, is sufficient evidence of an exclusive possession by claim and color of title, so that equity will protect in the continued enjoyment, whatever doubts may exist as to the validity of the patent. *Cooper v. Matthews*, 8 Law Rep., O. S., 419.—BALDWIN, J.; Pa., 1842.

11. The doctrine laid down by Lord Eldon in *Hill v. Thompson*, 3 Meriv. R. 622, as to granting injunctions in patent cases, stated in *Sullivan v. Redfield* (*ante*, 3 and 4), is the true doctrine, and is indispensable to the repose of titles, and the security of patentees. *Washburn v. Gould*, 3 Story, 170.—STORY, J.; Mass., 1840.

12. In motions for an injunction, the fact that the plaintiffs have for some considerable time enjoyed their rights,

is important, and cannot be disregarded. *Brooks v. Bicknell*, 3 McLean, 263.—McLEAN, J.; Ohio, 1843.

13. Where there had been possession for some considerable length of time under a patent—the patent having been extended—and a judgment in an action at law had been recovered against another defendant for the use of a machine substantially the same as that used by the defendant in the action, *Held*, that after the lapse of so much time, the affidavit of a single witness that the patentee was not the first inventor, would not outweigh the oath of the patentee, and the general presumption arising from the grant of the letters patent.

Woodworth v. Sherman, 3 Story, 171, 172.—STORY, J.; Mass., 1844.

14. The obtaining a verdict by a patentee in a suit at law against a person infringing his patent, is sufficient cause for granting an injunction till the hearing, against another infringer. *Orr v. Badger*, 7 Law Rep., 468.—SPRAGUE, J.; Mass., 1844.

15. It is not enough that a party has taken out a patent, and thus obtained a public grant; he must furnish further evidence of a probable right, something stronger than the mere issue, as an *exercise and use* of his right. Such use and exercise for some years, without its being disturbed, strengthens the probability that his patent is good, and renders it so likely, as alone often to justify the issue of an injunction in aid of it. *Orr v. Littlefield*, 1 Wood. & Min., 15, 16.—WOODBURY, J.; N. H., 1845.

16. The time to be regarded for such use is what has elapsed since the original issue. *Ibid.*, 16.

17. The court will not refuse an injunction on account of the shortness of time after the grant, however brief, if

long enough to permit articles or machines to be constructed by the patentee, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. *Ibid.*, 17.

18. Another kind of evidence, besides the issue of the patent itself, and long use and possession under it, so as to render it probable the patent is good, and justify an injunction, is the fact that if the patent has been disputed, the patentee has prosecuted for a violation of his rights, and has recovered. And it makes no difference that the judgments have been given on verdicts and defaults under agreements, if rendered without collusion or fraud. *Ibid.*, 17, 18.

19. Where a complainant has made out not merely a grant of the patent, but possession, and use, and sale under it for some time, undisturbed, and also a recovery, the courts have invariably held that such a strong color of title shall not be deprived of the benefit of an injunction till a full trial on the merits counteracts or annuls it. *Ibid.*, 19, 20.

20. Long possession and use under one patent, and recoveries upon it, will not inure in favor of another patent, as to which an injunction is asked, even though the two patents are very useful and necessary for each other, unless there is some connection in law between them, or one is auxiliary to or a part of the other. *Hovey v. Stevens*, 1 Wood. & Min., 295, 296.—WOODBURY, J.; Mass., 1846.

21. An injunction, when asked before the trial and resisted, is never to issue as a matter of course till the trial. There must, in order to obtain it in advance, be proof not only of a patent but also of some length of use under

it, or some considerable sales under it, or some recovery establishing the validity of the patent, so as to impart to it weight or strength, as valid beyond the mere issue of it. *Ibid.*, 303.

22. Where possession for some years has existed, or there have been numerous sales or recoveries, the court will not refuse an injunction, or dissolve it, on a denial of the validity of the patent by a defendant, either through affidavits, or an answer, or other pleadings. *Ibid.*, 304, 305.

23. If none of these fortifying circumstances exist, courts will not only refuse an injunction, but will dissolve one previously allowed, if the validity of the patent is denied or brought into doubt. *Ibid.*, 304.

24. Where plaintiffs have endeavored to obtain the verdict of a jury as to their patent—there having been two trials at law, at which the juries had disagreed—and have by reason of such suits lost opportunity of selling rights in their patent, and half of the term of the patent had expired, and the defendants were undoubted infringers, *Held*, that an injunction would issue, as the patent itself must be held *prima facie* evidence of all the plaintiffs claimed under it. *Buck v. Hermance*, 9 Law Rep., 547.—CONKLING, J.; N. Y., 1846.

25. Where there has been a possession for some years under a patent, and also numerous recoveries for infringements of it, and sales have been extensive, an injunction will issue. *Woodworth v. Hall*, 1 Wood. & Min., 253.—WOODBURY, J.; Mass., 1846.

26. Recoveries under an original patent are evidence after the issue of new letters with a new specification, to strengthen the title of the plaintiff so as to obtain an injunction. *Ibid.*, 257.

27. On a motion for a provisional injunction, where a patent has been frequently made the subject of legal actions, and decisions have been made in the Circuit and in the Supreme Court, in which the originality of the invention, and the validity of the patent have been examined and confirmed, the patent will be considered as established. *Van Hook v. Pendleton*, 1 Blatchf., 191.—NELSON, BETTS, JJ.; N. Y., 1846.

28. Though a plaintiff by repeated recoveries on his patent, and long possession under it, may be entitled to a temporary injunction against those infringing, yet, if the defendants deny the validity of the plaintiff's invention, the injunction, if granted, will only be until the validity of the patent can be determined by a trial at law, and will be dissolved if such suit is not brought before the next term of the court. *Woodworth v. Edwards*, 3 Wood. & Min., 133.—WOODBURY, J.; Mass., 1847.

29. The rendition of a verdict in a patent case in favor of a plaintiff is not conclusive upon the right of such party to an injunction. *Many v. Sizer*, 1 Fisher, 43.—WOODBURY, SPRAGUE, JJ.; Mass., 1849.

30. Where the plaintiff's machine has been in use for a long time, and the right to its enjoyment has been established by the judicial tribunals, if the court is satisfied that the defendant's machine is substantially identical with it, the court is bound to grant an injunction, and the defendants cannot give security for the damages that may be found against them on a trial at law. *Gibson v. Van Dressar*, 1 Blatchf., 536.—NELSON, J.; N. Y., 1850.

31. Where a bill was filed for an infringement of a patent, and an injunc-

tion was prayed and the originality of the invention was denied, and many affidavits read in support of such denial, and it also appeared that there had been three trials at law upon the question, in which there had been a verdict in favor of each party, plaintiff and defendant, and a divided jury on the other trial, *Held*, that the question of originality could not be considered as settled, and therefore the court suspended decision on the motion for an injunction, and directed an account to be kept by the defendants, and that an issue should be made up and presented for trial before a jury on the question of originality and infringement. *Allen v. Sprague*, 1 Blatchf., 567, 568.—NELSON, J.; N. Y., 1850.

32. An injunction will be refused if the verdicts establishing the complainant's title have been obtained on such inconsistent and contradictory claims, or have left the plaintiff's title in such a doubtful shape that the court cannot say with certainty what is, and what is not an infringement of the patent. *Parker v. Sears*, 1 Fisher, 97.—GRIER, J.; Pa., 1850.

33. An injunction will also be refused where possession is very vaguely stated in the bill, and is met and avoided by allegations and proof of a more peaceable and exclusive possession by the defendants. *Ibid.*, 97.

34. On a motion for an injunction, based upon prior adjudications in favor of his patent, the defendant may show that the title was not fairly in controversy in the cases which professed to try it—or that some material fact was then unknown, or some opposite argument overlooked—and the court, if satisfied that such was in truth the case, would not hold itself concluded by the

former adjudications. *Parker v. Brant*, 1 Fisher, 61.—KANE, J.; Pa., 1850.

35. But the considerations which would justify a judge in renewing the discussion of a patentee's title after solemn hearing and judgment at law, should be such as, if presented to his view after a trial at law, would have induced him to set aside the verdict. *Ibid.*, 61.

36. Where the evidence shows that the defendants are infringing some of the claims of a patent, and the plaintiff has had a verdict at law upon his patent sustaining such claims, an injunction will be granted before final hearing, although it may be a question whether another claim in the same patent, the novelty of which is disputed, is valid. *Colt v. Young*, 2 Blatchf., 472, 474.—NELSON, J.; N. Y., 1852.

37. When a patent has been granted and there has been an exclusive possession of some duration under it, the court will enjoin, without putting the party previously to establish his right at law. *Foster v. Moore*, 1 Curt., 286.—CURTIS, J.; Mass., 1852.

38. It is not possible, however, to fix any precise number of years during which exclusive possession must have continued. *Ibid.*, 286.

39. And the acquiescence of the public is entitled to more or less weight, according to the degree of the utility of the machine, and the number of persons whose trade or business are affected by it. *Ibid.*, 286.

40. An exclusive possession of about eight years, under a patent for a useful machine, which affects the trade and business of large numbers of persons, and many of which machines had been constructed and put in operation in different states, is sufficient to justify

granting an injunction, before requiring the plaintiff to bring an action at law. *Ibid.*, 286, 287.

41. Upon a motion for a preliminary injunction, a verdict in favor of the plaintiffs in another action, but against different defendants, sustaining the originality of their invention, though not conclusive, is entitled to great consideration, and if the machine used by the defendants is substantially like that of the plaintiff, an injunction will issue. *St. John v. Prentiss*, MS.—NELSON, J.; N. Y., 1853.

42. Although on a motion for an injunction, it appears that on a trial at law as to the question of infringement there had been a verdict in favor of the plaintiff, the court is not bound to adopt the verdict of the jury, so found, but will examine the whole case, including the evidence given before the jury, and will grant or withhold the injunction, according to its own judgment therein. *Sickles v. Youngs*, 3 Blatchf., 297.—NELSON, J.; N. Y., 1855.

43. In this case, notwithstanding the verdict of the jury in favor of the plaintiff, the court decided that the defendant did not infringe, and refused the injunction. *Ibid.*, 303.

44. If a patentee has established his title under his original letters patent, he is entitled to a temporary injunction under an extension of such letters patent, without a further trial at law. *Clum v. Brewer*, 2 Curt., 517, 518.—CURTIS, J.; Mass., 1855.

45. Though, strictly speaking, there can be no possession of an exclusive right to an invention before the date of the patent—because the patent grants that right, yet, under our patent laws, the inventor may make and sell his invention for two years before his patent,

and the public may acquiesce in his claim during such period, and such acquiescence may be entitled to weight, in considering his right to a temporary injunction. *Sargent v. Seagrave*, 2 Curt., 555.—CURTIS, J.; F. L., 1855.

46. To make a *prima facie* title, without a judgment at law, the patentee must have had such an exclusive possession, as with his claim and the acquiescence of the public lays a reasonable foundation for the presumption of the validity of his patent. *Ibid.*, 556.

47. An unsuccessful attempt to interrupt a possession strengthens the presumption which arises from it. *Ibid.*, 556.

48. It is not possible to fix any term of years during which the exclusive possession must have continued. Each case must depend upon its own circumstances, *i. e.*, the extent of the use or sales by the patentee, the degree of the utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right, and the completeness of the acquiescence under it. *Ibid.*, 557.

49. Where sufficient possession is established, a doubt concerning the validity of the patent will not necessarily prevent an injunction. The court will look to the particular circumstances of the case, to see what degree of inconvenience will be occasioned to either party by granting or withholding the injunction, and whether the defendant has voluntarily placed himself in the position to be subject to that inconvenience. *Ibid.*, 557, 558.

50. As respects the effect of a verdict upon a motion for a temporary injunction, a verdict and judgment, where

there is a bill of exceptions and a writ of error sued out, cannot be distinguished from a verdict where there is a motion for a new trial. Either may be disregarded by the judge, if his conscience is satisfied, though ordinarily neither should be. *Day v. Hartshorn*, 3 Fisher, 32, 36.—PITMAN, J.; R. I., 1855. [Stated as the opinion of CURTIS, J.]

51. A verdict at law, or finding in case of a feigned issue, is never conclusive upon a judge sitting in equity, on an application for an injunction. *Ibid.* 34. [Stated as the opinion of NELSON, J.]

52. The obtaining a verdict in favor of a plaintiff on a trial at law, is not necessarily conclusive as to the right of such party to have an injunction against the defendant. On a motion for an injunction, the judgment of the judge upon the law and the evidence must determine his action, and not the judgment of the jury. *Ibid.* 32.

53. Where the plaintiff's title has been finally established at law, he is entitled to an injunction, whatever may be the effect upon the defendants as to stopping their works, and throwing their employees out of employment. *Forbush v. Bradford*, 11 Mo. Law Rep., 472.—CURTIS, J.; Mass., 1856.

54. But where litigation is not in fact terminated, but a bill of exceptions has been taken upon a trial, resulting in favor of the plaintiff, and the result may be adverse to the plaintiff's title, it is necessary for the court to contemplate that as a possible result, and look at the consequences, in that event, of allowing or refusing the injunction. *Ibid.*, 472.

55. Where a patent has not been established by a trial at law, nor its use been acquiesced in by the public, to authorize the issue of a provisional in-

junction, the right of the plaintiff must be clear and free from doubt, and the violation on the part of the defendant must be equally clear. *North v. Jones*, 4 Blatchf., 72.—INGERSOLL, J.; N. Y., 1857.

56. In order to justify the issuing of an injunction to restrain the infringement of a patent, it is not necessary that the validity of the patent should have been established in a trial at law; the chief use of it having been so established is to show, where the defendant denies the invention of the patentee, or claims that the invention was known and used more than two years before the date of the application, that there is no foundation for such denial or claim. *Sickles v. Mitchell*, 3 Blatchf., 552.—INGERSOLL, J.; N. Y., 1857.

57. Where the patent has been in use a number of years, and there is no denial of the invention of the patentee, nor any proof that it had been used for more than two years before the application for a patent, an injunction will be granted without such trial. *Ibid.*, 552.

58. Where upon a trial in a former suit between the plaintiff and another defendant it had been determined that the invention used by the defendant in that suit was an infringement of the plaintiff's patent, although such use was under a patent, and the thing used by the defendant in the present suit was admitted to be the same as that used by the defendant in such other suit, *Held*, that the former adjudication as to the question of infringement was conclusive, and that an injunction would issue to restrain such use. *Ibid.*

59. Where a patentee had failed to sustain his patent in actions at law brought under both the original patent and its reissue, and the patent had not

been acquiesced in by the public, but the right of the patentee was contested by different persons, *Held*, that under such circumstances an injunction would not issue before a trial at law; but the defendants were required to be ready for trial at the next term, or that injunction should then issue. *Serrell v. Collins*, 4 Blatchf., 62.—INGERSOLL, J.; N. Y., 1857.

60. Where a trial at law has been had, resulting in a verdict in favor of the patentee, in which the right to the thing patented has been established to the satisfaction of the court, and the infringement made clear, such trial is sufficient without any other proof to authorize a court to grant an injunction to prevent any future violation of right. *Poppenheusen v. N. Y. G. P. Comb Co.*, 4 Blatchf., 187.—INGERSOLL, J.; N. Y., 1858.

61. Where a patentee has had quiet enjoyment under his patent for a considerable time, and has had verdicts in his favor in suits at law, the judgments in which were obtained without collusion, though the validity of the patents was not contested; and the novelty of his invention is strongly sustained by affidavits of competent persons, his patent will be considered valid and he will be entitled to a preliminary injunction against a defendant using substantially the thing patented to him. *Potter v. Holland*, 4 Blatchf., 250.—INGERSOLL, J.; Ct., 1858.

62. On a bill filed for an injunction within three months after issuing of the patent, the defendants denying that the patentee was the inventor of the thing claimed by him, and also denying infringement, *Held*, that there was no proof of such a public acquiescence of the exclusive right of the patentee, as

to justify the assumption that his claim was well founded, and there being also some doubt as to the sufficiency of the specification of the patent, the injunction was refused, and the parties sent to an action at law. *Muscan Hair Co. v. Amer. Hair Manuf. Co.*, 4 Blatchf., 178.—HALL, J.; N. Y., 1858.

63. Where there has been no adjudication as to the validity of a patent under which a party claims, such party must show that he has had exclusive possession and enjoyment for some time before a preliminary injunction will be granted in his favor. *Mitchell v. Barclay*, MS.—SHIPMAN, J.; N. Y., 1860.

64. The possession and enjoyment of a patent, which will justify a court in granting a preliminary injunction, previous to a trial at law establishing the validity of the patent, must be something more than the mere holding of the parchment, or muniment of title, or experimenting with the patented article. If it is a machine or tool it must be brought into use—if a process, it must be put in execution—if a composition of matter or patented article, it must be put on sale. This is the true doctrine both in England and in this country. *Ibid.*

65. The bare holding of a patent and an infringement alone constitute no complete ground of relief, at least by preliminary injunction. *Ibid.*

66. Relief by injunction is never granted as a matter of course, nor on merely filing a bill and producing a patent. The patent itself, though in a certain sense *prima facie* evidence of the validity of the grant, is never sufficiently strong *per se* to warrant relief by injunction. *Toppan v. National Bank Note Co.*, 4 Blatchf., 511.—SHIPMAN, J.; N. Y., 1861.

PRELIMINARY. SECURITY ON GRANTING, OR IN PLACE OF.

67. In order to obtain such relief the title of the patentee must always be strengthened by exclusive possession for some period of time, or by an adjudication in which the validity of the patent has been sustained. *Ibid.*, 511.

68. The principle that exclusive possession for a time strengthens the title of a patentee, is founded on the idea that as it is a claim of right adverse to the public, and the public acquiesce in that claim, such acquiescence raises a presumption that the claim is good. *Ibid.*, 512.

69. But the use must have been a *public* use, under an avowed claim of right to a patent otherwise; there is no exclusive possession as *against* the public, and no claim in which the public can acquiesce. A secret use, away from the eye of the public, sweeps away the ground of exclusive possession and acquiescence of the public. *Ibid.*, 512.

c. Security on Granting, or in Place of.

1. If an injunction will lead to serious injury in suspending the works of the defendant, the court may require security of the complainant, to indemnify for such loss, if the patent is avoided, or can make an order to expedite a final hearing and decision. *Orr v. Littlefield*, 1 Wood. & Min., 20.—WOODBURY, J.; N. H., 1845.

2. Where an injunction had been granted against a person for an infringement of a patent, and while such proceedings were being taken, a third party, with full knowledge of all the circumstances connected with such injunction, became the assignee of all the rights and interests of the person first enjoined, *Held*, that such assignee stood in the light of the other's substitute, and

that he could not be allowed, by giving security and keeping an account, to continue the business till final hearing, but that an injunction would issue against him. *Parkhurst v. Kinsman*, 2 Blatchf., 81, 82.—BETTS, J.; N. Y., 1848.

3. Where an application was made for an injunction to restrain the use of certain telegraph instruments, in use upon an extended line of telegraph, *Held*, that if any prudential proceedings were necessary, that the working of the line should not be stopped (as that might seriously and wrongfully injure the defendants), but that security should be required to indemnify the plaintiff, in case the suit should ultimately result in his favor. *Morse v. O'Reilly*, MS.—CATRON, J., at Chambers; D. C., 1849.

4. Where the judges of the court differed as to the question of infringement, and the jury had failed to agree, the court directed an injunction already granted to be dissolved, upon the defendant giving proper security to keep an account; or, on failure so to do, ordered it to remain, upon the plaintiff giving proper security. *Wilson v. Barnum*, 1 Wall., Jr., 354, 355.—GRIER, KANE, JJ.; Pa., 1849.

5. Where a patent has been in use a long time, and the right to its enjoyment has been established by the judicial tribunals, and it is evident that the defendant is infringing upon it, he will not be permitted to give security for the damages that may be found against him, but he will be enjoined. *Gibson v. Van Dresar*, 1 Blatchf., 536.—NELSON, J.; N. Y., 1850.

6. Where an infringement is clear, and the right to an injunction manifest, an injunction will not be stayed on the

defendants, giving security, and rendering a periodical account of their sales, even though the defendant is a person of pecuniary responsibility. *Tracy v. Torrey*, 2 Blatchf., 279.—NELSON, J.; N. Y., 1851.

7. When a bill was filed for an injunction, founded on long possession, and an allegation of infringement by the defendant's machine, but it appeared that the defendant had only constructed one machine for his own use, and it was not suggested that he was about to construct any other machine, the court required the defendant to keep an account, and file a bond with sufficient sureties to pay such sums as should finally be decreed against him, or that injunction should issue. *Foster v. Moore*, 1 Curt., 293.—CURTIS, J.; Mass., 1852.

8. If the plaintiff is made secure of receiving all the profits, which may arise from the use of the machine until a final hearing, he is sufficiently protected in case the infringement is proved. *Ibid.*, 293.

9. Where a plaintiff, upon bill filed, asked a preliminary injunction against the defendants, restraining the use of plaintiff's machine, and the defendants justified their use under certain agreements of the patentee, but omitted to show that they had performed, on their part, the conditions of such agreements, the court granted a modified injunction, that the defendants should be enjoined from using the machines, unless within a certain number of days, they gave security to keep and render an account of the profits arising from the use of the machines, and to pay over the same according to the order of the court. *Day v. Hartshorn*, MS.—PREMAN, J.; R. I., 1853.

10. Where a defendant was a *bona*

fide purchaser of an invention, without notice that it was claimed to be an infringement of another patent, prior in time to the patent which had been granted for the invention so purchased, and his invention was constructed in conformity with the patent granted for it, and it appeared that a peremptory injunction, if granted, would have the effect to close the business of the defendants, the court, although the defendant did not contest the validity of the plaintiff's patent, or the title of the plaintiff as assignee, and its validity had been sustained by verdicts and judgments in two suits, withheld the injunction on condition that the defendant should give bonds in \$5,000 to abide the final decision of the case. *U. S. Annunciator & Bell Tel. Co. v. Sanderson*, 3 Blatchf., 187.—BETTS, J.; N. Y., 1854.

11. Upon applications for injunctions there is much latitude of discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties, as conditions for making or refusing the order. *Forbush v. Bradford*, 11 Mo. Law Rep., 471.—CURTIS, J.; Mass., 1856.

12. Where the defendants were *using*, but not making, certain looms having a patented improvement, and an injunction would stop their whole business, *Held*, that they might be allowed to give security to keep and render an account. *Ibid.*, 472.

13. It is common, in case of a bill filed for an infringement, and motion made for a preliminary injunction, where the question of infringement is not manifest, and enjoining the defendant would produce serious hardship and inconvenience of his business, to withhold the injunction on the defendants, keeping

an account or giving security for damages accruing. *Tatham v. Lowber*, 4 Blatchf. C. C., 87.—NELSON, J.; N. Y., 1857.

14. Where a defendant was manufacturing under a patent, which was claimed to be an infringement of another and an older patent, the court refused to grant a preliminary injunction, but ordered the defendant to keep an account of all that he manufactured and sold. *Goodyear v. Dunbar*, 1 Fisher, 474.—GRIER, J.; N. J., 1861.

d. Practice on Motions for.

1. The practice of the court in equity upon motions for an injunction, is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and is verified by affidavit. *Isaacs v. Cooper*, 4 Wash., 260.—WASHINGTON, J.; Pa., 1821.

2. If the bill states an exclusive possession of the invention for which the plaintiff has obtained a patent, an injunction is granted, although the court may feel doubts as to the validity of the patent. *Ibid.*, 260.

3. But if the defects in the patent or specification are so glaring that the court can entertain no doubt as to that point, the court will not restrain the defendant from using a machine, or other thing which he may have constructed, until a decision at law can be had. *Ibid.*, 260.

4. Where a patent was for an *improvement* on the horizontal wheel for gaining power to propel boats, but the specification did not state the nature of the original invention upon which it was an improvement, nor whether it had been patented, or give any information respecting it, an injunction was refused. as the nature of the im-

provement was altogether unintelligible. *Ibid.*, 261.

5. In an application for an injunction made by a patentee to restrain the infringement of a patent, it should appear by the bill, or by affidavit, that the complainant believes himself to be the original inventor of what he claims under his patent, and the bill must be sworn to. The oath taken by the patentee of originality of invention at the time of his application for a patent, is not sufficient. The question is, not whether the plaintiff believed himself to be the first inventor at the time he applied for a patent, but whether he believes it at the time he asks for the relief sought. *Sullivan v. Redfield*, 1 Paine, 445, 446.—THOMPSON, J.; N. Y., 1825.

6. It is not a matter of course to grant an injunction upon the mere exhibition of the patent, and an allegation that it has been infringed. The patent may be, upon a trial at law, *prima facie* evidence of right, but in order to warrant an interference by injunction, there ought to be but little if any doubt in the minds of the court as to the validity of the patent, especially where the case rests entirely upon the complainant's own showing, without any opposing testimony. *Ibid.*, 447.

7. Upon a motion for an injunction, the plaintiff should subjoin to his bill a special affidavit to the truth of the allegations therein, and that he was the original and first inventor, as he believed, of the thing patented, and that the same had not been in use or described anterior to his invention. *Rogers v. Abbott*, 4 Wash., 514.—WASHINGTON J.; Pa., 1825.

8. On a motion for an injunction, the plaintiff must rest on the case stated in the bill, though he may, by affidavits,

state any matters which it sets forth with more particularity, and a reference to collateral matters which explain, or which tend to support and strengthen it; he may also, in the same way, contradict any statements made by the defendant in his affidavit, and either party may take and read the affidavits of other persons. *Cooper v. Matthews*, 8 Law Rep., 415.—BALDWIN, J.; Pa., 1842.

9. No affidavit of the defendant—and his answer in this stage of the case is to be considered only an affidavit—unsupported by other testimony, is to be considered as evidence to overthrow any averment in the bill. *Ibid.*, 415.

10. If there appears, from the affidavits of the parties or witnesses, such a repugnancy in point of fact as makes it necessary to decide on the relative truth of their conflicting statements, or the credibility of the affirmants, no prudent judge will undertake so dangerous an inquiry in the first stage of the cause. *Ibid.*, 415.

11. If the bill or affidavits state any facts not denied by the defendant, or if the plaintiff, in his counter affidavits, does not deny the statements of the defendant, such facts are assumed as a safe basis for a decision of the motion, though they may be open to inquiry at a subsequent state of the case. *Ibid.*, 416.

12. On a motion for an injunction, the exhibition of models on which their parties construct their respective machines, will not suffice to turn the scale either way, without an examination into the detail of the construction, combination, and operation of all their parts, by competent mechanics. *Ibid.*, 417.

13. The loss of a patent issued under the act of 1793, and which is required to be recorded, is no excuse for delay in

applying for an injunction for its infringement; a copy would be as full evidence of the patentee's right, as the original, or as a new patent issued under the act of 1837. *Ibid.*, 418.

14. On a motion for an injunction, if the complainants have called in their bill for the defendants to answer, and they have filed such answer, though voluntarily and before the entry of any rule to answer, it seems that such answer will be treated as an answer, and not merely as an affidavit. *Brooks v. Bicknell*, 3 McLean, 254.—MCLEAN, J.; Ohio, 1843.

15. From § 5, ch. 22, of the act of 1793, and the 55th rule in equity, it seems a hearing of both parties is contemplated on an application for an injunction. *Ibid.*, 254, 255.

16. And affidavits may be read, on the part of the plaintiff, in support of the bill, and in contradiction of the answer. *Ibid.*, 255.

17. Where the answer is responsive to the bill and under oath, and denies the infringement, something more than the evidence of a single witness must be produced to overcome it, and justify an injunction. *Woodworth v. Hall*, 1 Wood. & Min., 252.—WOODBURY, J.; Mass., 1846.

18. Where a bill was filed asking for an injunction against the use of a patent but lately issued, and the answer denied the use of it, and also the originality of the invention, and such answer was also supported by several affidavits, the injunction was refused until the trial of an issue at law to determine such matters. *Hovey v. Stevens*, 1 Wood. & Min., 292, 305.—WOODBURY, J.; Mass., 1846.

19. On an application for a preliminary injunction for an infringement of a pat-