

introduce the patent under which counsel contends that its apparatus is made. Its contention here is that the patent is a puzzling one difficult to comprehend, and that an expert should have been called to show just what is the structure, mode of action, and result of the patented apparatus and also of defendant's; that in no other way could it be made to appear that there is such identity of structure and function as would sustain a finding of infringement.

We do not agree with defendant's counsel. We find nothing difficult, intricate, or puzzling about the specifications, the drawings, or the single claim, on which complainant relies. Possibly an expert, if allowed to talk long enough, might have made them seem puzzling by the use of a multitude of words, and the reading into the description of propositions emanating from the expert's own brain, unsuggested by anything in the specifications. Just what the structure is, how it works, and what results from its operation, is set forth in plain language in the patent; there is nothing improbable in the results which the inventor asserts, an assertion to which the Patent Office gave credit.

Moreover, the structure of the defendant is so nearly identical that the action of similar materials rotated in the tumbling barrels of both machines must, in the absence of proof to the contrary, be taken to be the same. Indeed, the spacing of the different sized pebbles in defendant's blueprint of its apparatus indicates that the action is the same. Defendant uses the tumbling barrel of the patent, but has two conical barrels and two outlets and a different method of feeding. Mere duplication will not avoid infringement, and it seems quite clear to us that defendant has appropriated the substantial features of the claim. And if there is not identity of elements operating to produce the same results, there is certainly such equivalency as to constitute infringement of a patent not confined to specific forms. Complainant is to be commended for not overloading such a simple case with expert testimony, and we think the decree should be affirmed, and that nothing further need be added to Judge Hazel's opinion. As to the statement that defendant's apparatus is built under some patent of its own, we cannot guess at what that patent is; it may only cover the "ideal spiral feed" referred to in defendant's circulars and which is a mere addition to the invention of Hardinge. If defendant intended to rely on this patent for protection, it should have put it in evidence.

Decree affirmed, with costs.

431. COLT'S PATENT FIREARMS MFG. CO. v. NEW YORK SPORTING GOODS CO., 190 Fed. 553, 111 C. C. A. 405 (1911, Second Circuit. Patent No. 580,924).

Before Lacombe, Coxe and Noyes, Circuit Judges.

Per Curiam. * * *

The other claim relied upon is:

"13. In a firearm, the combination with a frame and a barrel mounted on said frame, of a breech block or bolt carrier, comprising a breech-bolt and a forward semi-tubular extension to cover the barrel, and having an opening forward of the breech-bolt to permit the ejection of the shell."

In the opinion of a majority of the court it cannot be successfully contended that the Browning patent, No. 580,924, covers a generic invention. Automatic firearms, embodying the general principles of the Browning device, had long been known, and are shown and described in numerous prior patents heretofore referred to, notably the patent to Borchardt.

As time progressed defects were discovered, and, as usually happens in so promising a field, many skilled workers in the art entered upon the task of remedying these defects; the result being the compact and effective arm of the present day. Some of these men were inventors, others were skilled mechanics, and frequently the changes, even when made by men possessing the inventive faculty, required only the skill of the calling. The finished product of today, is to a large extent the evolution of successive improvements developed as experience demonstrated their necessity. Browning does not assume to be a pioneer. He distinctly says that his additions and changes are but improvements upon existing structures. It is not pretended that Browning was the first to construct an automatic recoil-operated firearm containing as essential elements the frame, the barrel, and the breech-slide. He has made certain definite and meritorious improvements upon this firearm, consisting, as the complainants' expert states, "in a definite structural and operative relation of these three elements to one another in the organization of the pistol."

It is manifest, therefore, that though he is entitled to the rewards of his contribution to the art, and to a reasonable range of equivalents, he is not entitled to the fruits of the labor of others who have endeavored to reach the same result by improvements along different lines. Other inventors have the same right as Browning to improve the combination of the frame, barrel, and breech-slide, and, if the result be accomplished by elements differing from his to the extent that they cannot be regarded as clear equivalents, these inventors cannot be held as infringers. In other words, the claim cannot be given a broad construction.

It must be confined strictly to the elements as shown and described. * * *

We are convinced that we must follow the familiar rule and interpret the claim in the light of the specification, conceding to Browning all that he has accomplished, but not permitting him to collect tribute from an independent inventor, who has made other improvements in an already crowded art. The three elements of the claim—the frame, the barrel and the breech-block—are not any frame, barrel, and breech-block, but Browning's frame, barrel, and breech-block, as described and shown in his specification and drawings. It is not enough that the defendant has these three elements, unless they are found in the environment and operating in the manner described by Browning. They cannot so operate and accomplish the result sought by him unless they have the characteristics and perform the functions pointed out in the patent. His combination will not operate unless its members are assembled as he directs. The frame and the barrel must be so constructed as to permit the "limited double movement" which is so clearly emphasized. Without this the combination is inoperative.

The barrel of the patent must have a longitudinal and also a vertical movement. The bolt-carrier comprises the bolt as an integral part thereof. In the defendant's pistol the barrel is not mounted on the frame, but is mounted on the bolt-carrier. It has no longitudinal or vertical movement, but is fixed against both. The "double limited movement" of the patent is therefore wholly absent. In the defendant's structure the breech-bolt is separate from the bolt-carrier; in the patented structure the carrier comprises the bolt as an integral part thereof.

Many other differences between the two structures could be pointed out, but sufficient has been said to indicate our views. It is enough that the defendant's pistol does not have one of the elements of the combination of the claim, namely, a barrel mounted on a frame. Neither does it have the "limited double movement" which is an essential ingredient of the combination of the claim.

The complainant advances the ingenious argument that the defendant's barrel is mounted upon the frame, because the breech bolt carrier, upon which it is actually mounted, is slidingly mounted on the frame. In support of this contention it is asserted that "the barrel is mounted upon the frame just as truly as a rider is mounted upon a horse, in spite of the use of a saddle."

Undoubtedly a rider is mounted upon a horse, even though he wears breeches and has a saddle under him; but the illustration, though specious, fails, we think, for lack of resemblance. We

might suggest another and, perhaps, a more relevant simile. Would it be accurate to assert that the locomotive engineer seated in his cab is mounted on the rails, because his engine is so mounted?

In the most favorable view for the complainants, which can be taken of the evidence, infringement of the thirteenth claim is involved in doubt.

It follows that the decree of the Circuit Court must be affirmed, with costs.

432. AMERICAN AIR CLEANING CO. v. GENERAL COMPRESSED AIR & VACUUM MACHINERY CO., 195 Fed. 744 (1912, Seventh Circuit. Patent No. 690,084).

Before Baker, Seaman and Kohlsaas, Circuit Judges.

Baker, J.: * * *

For the claims in suit to have any validity, in view of the statement of the nature and scope of the invention made in the specification and particularly in view of the prior art, the words "substantially as described" must be taken to limit the claims to a structure which will accomplish the stated objects of the invention in substantially the manner described in the specification. *State Bank v. Hillman's*, 180 Fed. 732, 736, 104 C. C. A. 98; *Pope Mfg. Co. v. Gormully & J. Mfg. Co.*, 144 U. S. 248, 253, 12 Sup. Ct. 641, 36 L. ed. 423; *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568, 18 Sup. Ct. 707, 42 L. ed. 1136; *Singer Mfg. Co. v. Cramer*, 192 U. S. 265, 284, 285, 24 Sup. Ct. 291, 48 L. ed. 437. So limited, the claims are not infringed. * * *

433. WOLFF TRUCK FRAME CO. v. AMERICAN STEEL FOUNDRIES, 195 Fed. 940 (1912, Seventh Circuit. Patent No. 569,044).

* * *

The case is thus stated by the trial judge: "The bill charges infringement of claims 2, 3, and 6 of patent No. 569,044, granted to J. S. Hardie on October 6, 1896, for a metallic car truck. The claims in suit read as follows, viz.:

"2. A car truck, comprising two truck-arches rigidly connected with each other, each truck-arch having a transverse opening, the upper portion of which is contracted, a truck-bolster fitted in the upper portion of said openings, and springs seated in the openings and below the truck-bolster and respectively bearing against the truck-bolster, substantially as described.

"3. A truck having two truck-arches, each formed with an opening, the upper portion of which is contracted, a truck-bolster having its ends respectively fitted within the upper portions of said openings, and means within the upper portions of said openings, and means within the openings and below the truck-

bolster by which the truck-bolster is held in place, substantially as described. * * *

"6. A truck having a truck-arch formed with an opening, the central portion of which is enlarged over the terminals, a spring-seat fitted within the contracted lower portion of the opening, springs rested on the spring-seat, and truck-bolster fitted within the upper contracted portion of the opening, and engaged by the springs, substantially as described.

* * *

"The application upon which the patent in suit was granted was filed January 25, 1896. Of the four original claims asked for, none claimed the contracted upper part or the enlarged central portion. Original claims, 1, 2, and 4 were rejected. Original claim 3, which covered principally the means for placing and holding the bolster in the contracted upper part, was allowed. Thereupon Hardie canceled original claims 1, 2, and 4, and added claims 2 to 9, inclusive, among which appear the claims in suit. Now for the first time appears a claim for the contracted upper end and the enlarged central portion of the opening. No new specification or drawings were filed, nor was the change in the claims sworn to. The drawings disclosed the contracted upper portion and the enlarged central portion of the opening, but no reference is made thereto in the specification."

* * *

Before Baker and Seaman, Circuit Judges, and Sanborn, District Judge.

Sanborn, District Judge (after stating the facts as above):

(1) The gist of the testimony so taken under objection is that Hardie's real invention was a truck adapted for use with any bolster then known, and particularly suited to that of the type of the Schaffer bolster, having column guides, but which cannot be inserted into the side-frames unless the opening is enlarged in the manner shown in the patent drawings. But as the purpose of this enlargement is not explained in the patent or file wrapper, and since the bolster shown in the patent needs no such enlargement (working just as well with a square opening), a situation results where the sole patentable novelty asserted resides in an element wholly without use or function, and which might just as well have been entirely omitted unless explained or aided by something outside the four corners of the patent itself. From this it will be seen how very important this testimony becomes. Without it the patent as now construed by appellees has no force or effect. It may well be called Hardie's reissue. Moreover, his story is most persuasive, almost pathetic. His car truck has been highly successful in the hands

of his assignee, as evidenced by its enormous sales. The picture of the poor but brilliant inventor being cheated out of his valuable discovery by the misapprehension of his solicitors is an appealing one, well calculated to influence any court. It was said upon the argument that this testimony was taken without a shadow of doubt of its admissibility; and it is undeniable that evidence to show the patentee's equities is very common in patent cases, while motions to strike out such evidence are correspondingly rare. Therefore the question of admissibility becomes a vital one upon which alone depends the validity of the patent.

The patent record in suit presents a case quite similar to that of a patent ambiguity in a contract, which, as Lord Bacon said, could not be "holpen by averment." The enlarged opening appears in the patent drawings, and is referred to in the amended claims, but without any explanation of its purpose, or any suggestion of usefulness or function. After reading all there is in the patent, the uncertainty still remains. When the file wrapper is examined, it is found that the enlargement of the opening is made part of the amended claims, but why this was done is just as uncertain as before. The ambiguity is emphasized, but the doubt is not dispelled. So we have an element shown in the drawings, and counted on in the claims, whose purpose is a mystery, entirely without any use or function. "A patent ambiguity is an uncertainty that arises at once on the reading of the contract. We do not have to wait until some other fact is brought to our knowledge before the uncertainty is apparent, but the doubt is suggested at once, and by the phrase itself." *Strong v. Waters*, 27 App. Div. 299, 50 N. Y. Supp. 257. A latent ambiguity, on the other hand, is one brought out by extrinsic evidence, where the words, in themselves clear, apply equally well to two different things. *Petrie v. Trustees*, 158 N. Y. 458, 53 N. E. 216. "Nothing is clearer than the general rule," said Judge Story, in *Peisch v. Dickson*, 1 Mason 9, Fed. Cas. No. 10,911, that "latent ambiguities may be removed by parol evidence, for they arise from proof of the facts aliunde; and, where the doubt is created by parol evidence, it is reasonable that it should be removed in the same manner. But patent ambiguities exist in the contract itself; and if the language be too doubtful for any settled construction, by the admission of parol evidence, you create, and do not merely construe, the contract."

(2) The question then arises whether the contract between the government and the patentee, expressed by the patent, must not be construed to exclude all reference to the enlarged opening. Hardie's alleged use of the Schaffer bolster as an element of his invention was all before he filed his application. He tried to

make it a part of his discovery, but through his solicitors' failure to comprehend was unable to do so. Thereupon he abandoned the only forms of bolsters which could possibly have any functional connection with his real invention, and substituted an ancient form which in and of itself absolutely excluded the only use, function, or novel result he was seeking to obtain. On this basis the patent was issued, the contract made. To allow the patentee now, by parol testimony, to make a wholly different contract, and obtain an entirely different grant, is utterly inadmissible. Even as against the government, the other party to the grant, this would be unauthorized by settled principle, and how much less should it be allowed against the public, in no way bound or concluded by such grant.

In *Osgood Dredge Co. v. Metropolitan Dredging Co.*, 75 Fed. 670, 673, 21 C. C. A. 491, defendant's declarations or admissions tending to show patentability were shown in evidence. "In that class of litigation in which the results can affect no interests except those of the parties to it, the court may well give weight to declarations of that nature; but with reference to a patent for an invention, which is of public concern, such declarations are of little consequence and neither the inventor nor the alleged infringer can be permitted to substitute his own acts or opinions for the judgment of the court. It is a thoroughly well-settled principle of patent law that in clear cases the court may, of its own motion, adjudge a patent invalid, even if its invalidity is not set up by the alleged infringer. Much more would it refuse to be controlled by evidence of this kind which the complainant thus brings to our attention."

"Were it important to inquire which of these two men would be most likely to produce a working machine having the necessary characteristics, there can be little doubt that Mr. Brush would be chosen. But such an inquiry seems irrelevant. The patent law cannot be administered along such lines as these. Patents are formal grants controlled by carefully drawn statutes and strict rules, and must be construed as other similar documents are construed. The court is not permitted to inquire what the patentee might have done or was capable of doing. The question is, What did he do? Conjecture and speculation are out of place in interpreting the claims of a patent." *Coxe, J.*, in *Edison Electric Light Co. v. E. G. Bernard Co.*, (C. C.) 88 Fed. 267, 275.

On the other hand, the evidence may properly show the prior art, the problem presented to the inventor, and all the surrounding circumstances, in order that the specifications and claims may be read in the light of the inventor's actual knowledge, and such information as the law imputes to him. *Field, C. J.*, in

Giant Powder Co. v. California Vigorit Powder Co., (C. C.) 4 Fed. 720, 727, 728. Thus, a broad claim, when applied to the disclosures of the prior art (presumed to be known to the inventor), must be limited accordingly. Rules of construction must be applied, to learn what the claim means. A latent ambiguity arises, and to explain it the court may put itself in the position of the inventor, and seek to know what he knew, and what the law required him to know. But this is quite a different thing from allowing him, by testimony showing what he tried to do, and how he unfortunately failed, to make a new contract, based on evidence never disclosed either to the Patent Office or the public, and which never saw the light until it became necessary for his assignee to broaden the contract, and include something which the patentee gave up, even though he gave it up through mistake of law.

Two cases were cited on the argument in support of the contention that the testimony of Hardie is admissible. These were *Ball & Socket Fastener Co. v. Kraetzer*, 150 U. S. 111, 14 Sup. Ct. 48, 37 L. ed. 1019, and *Steward v. American Lava Co.*, 215 U. S. 161, 30 Sup. Ct. 46, 54 L. ed. 139. In both these cases, however, the testimony was rather in the nature of an admission, made against interest, and was not self-serving in its character, as were the persuasive explanations of the patentee in this case. Technically speaking, Hardie had no interest, because he had assigned his patent; but his statements were not against his interest, he having none, but were in support of his assignee's attempt to broaden the scope of the public disclosure of his specifications and claims.

Disregarding this evidence, as we must, we have the case of an element not defined, vital to the validity of the patent as now construed by appellees, and which is utterly without function or use. Within the loosest construction of the statute requiring full, clear, concise description, the appellees' contention respecting the lawful scope of the patent in suit cannot be sustained. *Merrill v. Yeomans*, 94 U. S. 568, 24 L. ed. 235; *Bates v. Coc*, 98 U. S. 31, 25 L. ed. 68; *Incandescent Lamp Patent*, 159 U. S. 465, 16 Sup. Ct. 75, 40 L. ed. 221.

Within the rules of *Blease v. Garlington*, 92 U. S. 1, 23 L. ed. 521, and *Nelson v. United States*, 201 U. S. 92, 114, 26 Sup. Ct. 358, 50 L. ed. 673, settling the rule as to the return on appeal of inadmissible evidence taken below, defendant's counsel might have moved before hearing to strike out so much of Hardie's testimony as related to his conferences with his solicitors, and to his re-vention, or insisted on the hearing (as they did) upon the question. Whatever action might have been taken by the court either event, the evidence would nevertheless be

part of the record on appeal, even if struck out by the trial judge. Under the cases cited, and by the common practice, all evidence taken, whether struck out or not, is to go up on appeal.

The decree appealed from is reversed, with direction to dismiss the bill for want of equity.

433a.

[The patent is prima facie proof of invention, patentability and regularity in its issue. *Philadelphia, etc., R. Co., v. Stimpson*, 14 Pet. (U. S.) 448, 10 L. ed. 535; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Seymour v. Osborne*, 78 U. S. 516, 20 L. ed. 33; *Marsh v. Seymour*, 97 U. S. 348, 24 L. ed. 963; *Hunt Bros. v. Cassidy*, 53 Fed. 257, 3 C. C. A. 525.]

434. *ATLAS GLASS CO. v. SIMONDS MFG. CO.*, 102 Fed. 643, 42 C. C. A. 554.

The meaning of the words "patent" and "patented" as used in section 4887, is not difficult to ascertain. The word "patent," originally a qualifying adjective applied to the "open letters" by which a sovereign grants an estate or privilege, has come to mean, in connection with the so-called patent laws of the United States, as well as in common parlance, the exclusive privilege itself granted by the sovereign authority to an inventor with respect to his invention. What the nature and extent of the exclusive privilege thus granted by the constitution and laws of the United States may be depends upon the terms of the act of Congress providing for and regulating the same; and, when this section 4887 speaks of an invention which has been previously patented in a foreign country, it obviously means an invention with respect to which the inventor has received from the sovereign authority of such foreign country such exclusive privilege as its laws provide for or sanction.

435. *BUTTERWORTH v. HOE*, 112 U. S. 50, 28 L. ed. 656, 5 Sup. Ct. 25. [See Const., Art. I, sec. 8.]

The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved, that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more, when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of

law, necessary to be applied in the settlement of this class of public and private rights, have founded a special branch of technical jurisprudence.

[The following under this heading are brief extracts to complete the discussion.] :

436. **BATES v. COE**, 98 U. S. 31, 25 L. ed. 68.

Power to grant patents is conferred upon the commissioner; and when that power has been duly exercised, it is, of itself, when introduced in evidence in cases like the present, *prima facie* evidence that the patentee is the original and first inventor of that which is therein described as his invention. Proof may be introduced by the respondent to overcome that presumption but in the absence of such proof, the *prima facie* presumption is sufficient to enable the party instituting the suit to recover for the alleged violation of his rights.

437. **PALMER v. CORNING**, 156 U. S. 342, 39 L. ed. 445, 15 Sup. Ct. 381.

There is no doubt that the letters patent are *prima facie* evidence that the device was patentable. Still, we are always required, with this presumption in mind, to examine the question of invention *vel non* upon its merits in each particular case.

438. **W. W. WARE CO. v. ROSENBLATT**, 80 Fed. 540, 25 C. C. A. 625.

The presumption referred to is sometimes defined to mean that the patent itself is *prima facie* evidence of novelty and of invention, but that presumption is probably a mere rule of evidence, which casts the burden of proof upon the alleged infringer. This presumption cannot usurp the province of the court to declare what constitutes novelty. The court should give due consideration to the action of the patent office, but should not permit that action to control its deliberate judgment when it is manifest that there is no invention.

439. **ROGERS v. FITCH**, 81 Fed. 959, 27 C. C. A. 23.

In view of the fact that the examiners-in-chief seem not to have had the remotest conception of what the specifications showed, or of what Fulton claimed, the presumption in this case of patentability arising from the allowance of the application by the patent office is of no practical value.

440. **FAIRBANKS, ETC., CO. v. STICKNEY**, 123 Fed. 79, 59 C. C. A. 206.

The officials of the Patent Office, with the prior art before them so found, and granted a patent. This action on their part

creates a presumption of patentable novelty, which presumption can be overcome only by clear proof that they were mistaken, and that the combination lacks patentable novelty.

441. ELECTRICAL ACCUMULATOR CO. v. BRUSH ELECTRIC CO., 52 Fed. 130, 2 C. C. A. 682.

If letters patent were to be treated by courts in the critical and hostile spirit which a plea in abatement formerly encountered, the contention of the defendant would have technical importance; but courts do not construe letters patent for the purpose of their destruction.

442. THOMSON-HOUSTON ELECTRIC CO. v. WESTERN ELECTRIC CO., 72 Fed. 530, 19 C. C. A. 1.

In the construction of a patent, it is not the personal intent or understanding of the patentee, but the actual facts regarding the invention, that are material.

443. ROBERTS v. RYER, 91 U. S. 150, 23 L. ed. 267.

The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he has conceived the idea of the use or not.

444. GOSHEN SWEEPER CO. v. BISSELL CARPET SWEEPER CO., 72 Fed. 67, 19 C. C. A. 13.

He is entitled to this beneficial function of his invention, whether he then knew all its beneficial uses or not.

445. REECE BUTTON-HOLE MACH. CO. v. GLOBE BUTTON-HOLE MACH. CO., 61 Fed. 958, 10 C. C. A. 194.

The rule is clear that ordinarily a patentee who is first to make an invention is entitled to his claim for all the uses and all the advantages which belong to it, so far as the new application does not itself involve further invention.

446. MULLER v. LODGE, ETC., TOOL CO., 77 Fed. 621, 23 C. C. A. 357.

An inventor is entitled to all the uses of which his invention is capable, whether he then knew of all such uses or not. It is not necessary that he shall state all the beneficial results, effects, uses, or advantages of the mechanism which he has devised.

447. CANDA v. MICHIGAN, ETC., IRON CO., 124 Fed. 486, 61 C. C. A. 194.

If the patent gave reason to suppose that the inventor may probably have contemplated that his device was capable of

other uses, and made adequate provisions therefor, his invention should be regarded as covering them, whether he mentioned them or not, or whether he contemplated any other particular use or not.

448. WESTMORELAND SPECIALTY CO. v. HOGAN, 167 Fed. 327, 93 C. C. A. 31.

But the mere failure of a patentee to realize all the benefits and possibilities of his invention is not fatal. The after-discovery of unsuspected usefulness in a disclosed apparatus, far from detracting from its value, may serve to enhance it.

449. TEMPLE PUMP CO. v. GOSS PUMP, ETC., CO., 58 Fed. 196, 7 C. C. A. 174.

It is, of course, true that a mistaken description, or even misconception of the operation of a device which is itself fitly described and claimed, does not vitiate a patent.

450. WELLS v. CURTIS, 66 Fed. 318, 13 C. C. A. 494.

If the idea [of invention] was not present to his mind, but is an after-thought perceived from subsequent experience or scientific inspection or analysis, it is obvious that there was no invention in thus by accident, as it were, supplying the means of a function not contemplated.

451. PARSONS v. SEELYE, 100 Fed. 455, 40 C. C. A. 486.

A man may, under certain circumstances, be protected in building stronger than he knows. And in this sense it is broad enough to include the idea that, if the momentum element which was described, or at least illustrated by the drawings, becomes, in practical operation, a more potent and efficient element than was understood, still the patent should not be rendered invalid for that reason.

452. GENERAL ELECTRIC CO. v. BULLOCK, ETC., MFG. CO., 152 Fed. 427, 81 C. C. A. 569.

It does not follow that, because the patentee did not state all the advantages of his invention, he was ignorant of them. But if he was, yet if those advantages were really present, they might properly be taken into account in estimating the novelty and utility of the invention. In a number of opinions of this court it has been held that it is not necessary for the patentee to describe in detail all the beneficial functions which he claims

will result from his invention. It is enough if those functions are evident and obviously contribute to the success of the invention.

453. WESTINGHOUSE ELECTRIC, ETC., CO. v. STANLEY INSTRUMENT CO., 133 Fed. 167, 68 C. C. A. 523.

Possibly he valued no other two-phased alternating current motors, or he conceived that there were no others, so that naturally the practical application which he had in mind was limited accordingly. Nevertheless he is entitled to the advantage of the well-settled rule by virtue of which an inventor who has patented his invention is entitled to all the uses to which it may be applied of the class to which he himself practically applied it.

454. KUHLMAN ELECTRIC CO. v. GENERAL ELECTRIC CO., 147 Fed. 709, 78 C. C. A. 97.

The object that Dobrowolsky seemed to have chiefly in mind was to avoid the useless converting of energy into heat by the constant and rapid changing of poles of the transformer apparatus then in use. As things have turned out this has not proven the chief actual advantage. * * * Now though these advantages be different from the one chiefly in the patentee's mind, the invention will not on that account fail, if there be in the concept an actual advantage, and the structure embodying it evinces patentable invention; for a patentee is entitled, not only to what he specifically sees, but to what has been brought about by his invention, even though not at the time actually seen.

455. BATES MACH. CO. v. FORCE, ETC., CO., 149 Fed. 220, 79 C. C. A. 178.

It is true that a patentee is entitled to all the beneficial uses of his real invention, whether stated or not. But the fact that this patentee, while enumerating in his specification some 12 advantages resulting from his improved construction has not even hinted at or suggested any resulting capacity for vertical removal of the plunger, is very persuasive that this element, instead of being "the aim and purpose of the invention," of the patentee, is rather the discovery of his expert.

456. BALL & SOCKET FASTENER CO. v. EDGARTON MFG. CO., 96 Fed. 489, 37 C. C. A. 523.

The patentee did not show the court what were the real advantages and extent of his alleged improvement, and therefore the court was unable to find infringement in anything which did not respond precisely to the form and letter of the patent.

457. CLEVELAND FOUNDRY CO. v. DETROIT VAPOR STOVE CO., 131 Fed. 853, 68 C. C. A. 233.

But if the fact that his construction does effect the results, and they are beneficial, he is none the less entitled to the benefit of his invention though he may not have correctly understood the principles of its operation.

458. STILWELL-BIERCE, ETC., CO. v. EUFAULA COTTON OIL CO., 117 Fed. 410, 54 C. C. A. 584.

An inventor is not required to describe in full all the beneficial functions to be performed by his machine. If the thing accomplished is a necessary consequence of the improvement made and described, making it obvious that the inventor intended the thing accomplished, though not specifically pointed out, he is entitled to the benefit thereof in construing his patent.

459. BALL & SOCKET FASTENER CO. v. BALL GLOVE FASTENING CO., 58 Fed. 818, 7 C. C. A. 498.

It is true that by a practice which seems to have somewhat gained favor in the courts, and which appears to be preferred by some patent solicitors, a description is held sufficient, if from it, aided by the drawings, the model, and the other parts of the application, the invention can be fully ascertained. Rob. Pat. sec. 489, note 1. In other words, the position seems to be that what can be made certain by any reasonable amount of skill is of itself certain.

While, however, it is not necessary, for the present case, to consider how far a description is sufficient which gives only the details of the article claimed, without stating the pith of what the novelty consists of, or how far the invention extends, we are compelled to repeat that the absence of this, in the case at bar, alike in the specifications and in the proofs, in connection with the complicated history of this second claim, and the entire lack of explanation of the various steps taken in perfecting it, has added to the difficulty which the court has had in arriving at its conclusions. [Bill dismissed.]

460. SEWALL v. JONES, 91 U. S. 171, 23 L. ed. 275.

The principle is this: The omission to mention in the specification something which contributes only to the degree of benefit, providing the apparatus would work beneficially and be worth adopting without it, is not fatal, while the omission of what is known to be necessary to the enjoyment of the invention is fatal.

461. CROWN v. STANDARD, 136 Fed. 841, 69 C. C. A. 200.

The brevity and simplicity of his specification and claim do not detract from the merit and validity of his patent, and are a refreshing contrast to the verbosity of the patent in suit.

462. LYONS v. RUCKER, 106 Fed. 416, 45 C. C. A. 368.

A careful study of the great mass of words with which the draughtsman of the patent seems to have sought to magnify the invention, shows how extremely slight is the improvement upon which complainant relies.

463. HEMOLIN v. HARDWAY, 138 Fed. 54, 70 C. C. A. 480.

But it is well settled that when a patent contains a sufficient disclosure of the claimed invention, it will not be invalidated either by the failure of the patentee to state the causes which produce the operation, or by a mistaken statement as to the reasons therefor. The sufficiency of the disclosure and the novelty and utility of the result are the sufficient considerations for the grant.

464. CONSOLIDATED SAFETY VALVE CO. v. CROSBY, ETC., VALVE CO., 113 U. S. 157, 28 L. ed. 939, 5 Sup. Ct. 513.

The direction given in the patent is, that the flange or lip is to be separated from the valve seat by about one sixty-fourth of an inch for an ordinary spring, with less space for a strong spring and more space for a weak spring, to regulate the escape of the steam, as required. As matter of law, this description is sufficient within the rule laid down in *Wood v. Underhill*, 5 How. 1, and it is not shown to be insufficient, as a matter of fact.

465. COCHRANE v. BADISCHE, ETC., FABRIK, 111 U. S. 293, 28 L. ed. 433, 4 Sup. Ct. 455.

Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process.

466. EDISON ELECTRIC LIGHT CO. v. UNITED STATES ELECTRIC, ETC., CO., 52 Fed. 300, 3 C. C. A. 83.

It is immaterial that the philosophy of electrical heating of the pumps is better understood today than it was in 1879, so long as the requirements of the patent would not be complied with by one skilled in the art unless he did in fact so heat the filaments.

467. CEREALINE MFG. CO. v. BATES, 101 Fed. 272, 41 C. C. A. 341.

The statement of a process upon the part of a patentee, to be sustainable, must not only clearly distinguish the old from the new, so that the novelty claimed is obvious, but must point out the new steps so definitely, that one wishing to use that process for the production of the desired product, will have a clear chart before his eye.

468. MATHESON v. CAMPBELL, 78 Fed. 910, 24 C. C. A. 384.

The applicants for this patent were in Europe and their solicitor here evidently knew little, if anything, about the chemistry of azo products; and there is nothing in the record to suggest that the changes which the solicitor made were due to anything except his own ignorance, or that he had any intent to mislead or to conceal. It is not doubted that an applicant is bound by the acts of his solicitor, but this contention seems to go beyond this wholesome rule when it seeks to void a patent, upon the theory of a fraudulent concealment or fraudulent misrepresentation because, through the solicitor's ignorance, the specifications, when describing the process of manufacture, contain some immaterial error or omission, which could not mislead a person skilled in the art.

469. MAURER v. DICKERSON, 113 Fed. 870, 51 C. C. A. 494.

The suggestion that the description commencing with the words "in carrying out my process practically I proceed as follows," is only one specific example of the invention, is not to be accepted. * * * Undoubtedly the specification, as a whole, evinces that the invention is limited to the para product. * * * We cannot see that Matheson v. Campbell, 78 Fed. 910, 24 C. C. A. 384, decides anything favorable to the contention of this appellant. The facts there differed radically from the facts of this case. The patent Hinsberg unlike the patent involved in Matheson v. Campbell, is distinctly limited to one individual product, fully described and unmistakably identified.

470. THOMSON-HOUSTON ELECTRIC CO. v. WESTERN ELECTRIC CO., 72 Fed. 530, 19 C. C. A. 1.

To this mode of discussion section 4888 is pertinent. It requires that an application for a patent (not the claim) shall contain a written description of the supposed invention, and of the manner of constructing and using it, "in such full, clear, con-

cise and exact terms as to enable any person skilled in the art * * * to make and use the same;" and it follows that, in determining whether the invention described in one patent differs from that described in another, evidence may be heard—and, in a difficult case, manifestly ought to be heard—concerning the construction and actual operation of each. * * *

It may be conceded, as asserted, that the differences of operation could be brought about by mechanical changes so minute that the most expert telephonist in the world, taking an instrument at random out of the line could not tell by mere inspection of it whether it would be a Reis or a Blake in operation and result; but a mere hearing would be enough. * * * By way of further illustration, it is said that "there is a cabinet in the Agassiz Museum at Cambridge, containing a row of mounted skeletons, beginning at one end with a monkey and ending at the other with a Caucasian. The difference between the extremes is wide enough, but the two half-way chaps look like brothers. But they are not brothers. By neither man nor monkey has a live one of either kind ever been mistaken for the other, and in skeletons, with all the zeal of the Darwinians to find the missing link, they remain, to the experts, easily distinguishable, and can only be said to resemble. In the light of present knowledge, the Caucasian, as an invention, is not anticipated by the Simian.

471. CROWN CORK, ETC., CO. v. ALUMINUM STOPPER CO., 108 Fed. 845, 48 C. C. A. 72.

The object of the drawings filed in the Patent Office is attained if they clearly exhibit the principles involved, and, in a case like this, rigid adherence to the dimensions thus exhibited is not required or expected, and if an intelligent mechanic would so proportion the dimensions as to secure practical results, inutility is not demonstrated by experiments with material identical in form and proportion of parts with the drawings in the patent.

472. WESTERN TELEPHONE MFG. CO. v. AMERICAN ELECTRIC TELEPHONE CO., 131 Fed. 75, 65 C. C. A. 313.

But the drawings are not required to be working plans. They must be read in connection with the description and claims, and any inferences arising from omissions or inconsistencies in the drawings must yield to a legally sufficient specification.

And see further:

473. SCHREIBER, ETC., v. GRIMM, 72 Fed. 671, 19 C. C. A. 67.

474. ELGIN, ETC., CO. v. CREAMERY, ETC., MFG. CO., 80 Fed. 293, 25 C. C. A. 426.

475. DASHIELL v. GROSVENOR, 162 U. S. 425, 40 L. ed. 1025, 16 Sup. Ct. 805.

The very fact that a machine is patented is some evidence of its operativeness, as well as of its utility, and where a model is constructed after a design shown in a patent, which is not perfectly operative, but can be made so by a slight alteration, the inference is that there was an error in working out the drawings, and not that the patentee deliberately took out a patent for an inoperative device.

476. PACKARD v. LACING-STUD CO., 70 Fed. 66, 16 C. C. A. 639.

We are even further from an ability to determine that a mechanic of ordinary skill in the art could not take the patented machine in issue, and, with the aid of the specification, overcome the minor difficulty to which the appellant refers. The law does not require more than this. Persons possessed of the most brilliant conceptions are sometimes the poorest mechanics.

477. SCOTT v. FISHER, 145 Fed. 915, 76 C. C. A. 447.

It is frequently a characteristic of generic inventions that their first embodiments work imperfectly, and where the imperfections may be remedied, as in this case, by what amounts to a mere readjustment of relative sizes, such change does not affect the character of the underlying creative conception.

478. BATES v. COE, 98 U. S. 31, 25 L. ed. 68.

Cases arise not infrequently where the actual invention described in the specification is larger than the claims of the patent; and in such cases it is undoubtedly true that the patentees in a suit for infringement must be limited to what is specified in the claims annexed to the specification, but it is equally true that the claims of the patent, like other provisions in writing must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims; nor is it incorrect to say that due reference may be had to the specification, drawings and claims of a patent, in order to ascertain its true legal construction. * * * In construing patents it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings.

479. *EVANS v. EATON*, 7 Wheat (U. S.) 356, 5 L. ed. 472.

The specification then has two objects: one is to make known the manner of constructing the machine (if the invention is of a machine), so as to enable artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. * * * The other object of the specification is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention, which the party may otherwise innocently suppose not to be patented. It is therefore, for the purpose of warning an innocent purchaser or other persons using a machine, of his infringement of the patent; and at the same time taking from the inventor the means for practising upon the credulity, or the fears of other persons by pretending that his invention is more than what it really is, or different from its ostensible objects.

480. *HOWE MACH. CO. v. NATIONAL NEEDLE CO.*, 134 U. S. 388, 33 L. ed. 963, 10 Sup. Ct. 570.

The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.

481. *CONTINENTAL PAPER BAG CO. v. EASTERN PAPER BAG CO.*, 210 U. S. 405, 51 L. ed. 1122, 28 Sup. Ct. 748.

The invention, of course, must be described, and the mode of putting it to practical use, but the claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it.

482. *GENERAL FIRE, ETC., CO. v. MALLERS*, 110 Fed. 529, 49 C. C. A. 138.

We may go to the description to amplify a claim, but we cannot, out of the mere descriptive portion of the patent, wholly create a claim.

483. *CANDA v. MICHIGAN, ETC., IRON CO.*, 124 Fed. 486, 61 C. C. A. 194.

The claims cannot be broadened or be made to include things not therein included, but to know what is included we may resort to the specification for the purpose of interpreting the claim.

It is well settled that for such purpose, and especially when the claim refers to the specification for further description, it is proper to resort to the specification, if explanation is necessary.

484. **ROBINS, ETC., BELT CO. v. AMERICAN, ETC., MACH. CO.**, 145 Fed. 923, 76 C. C. A. 461.

If any doubt existed as to the meaning of the claim, or if it were susceptible of two interpretations, it would be both right and proper that reference should be made to the drawings and specifications, not for the purpose of changing or altering the claim, but to ascertain its true and proper interpretation.

485. **WHITE v. DUNBAR**, 119 U. S. 47, 30 L. ed. 303, 7 Sup. Ct. 72.

Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification so as to make it include something more than, or something different from, what its words express. The context may undoubtedly be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.

486. **SOEHNER v. FAVORITE STOVE, ETC., CO.**, 84 Fed. 182, 28 C. C. A. 317.

These are a few of the great number of cases in which the foregoing rule has been approved and applied. Of course, if the language of a claim, in the light of the specifications, does not show that the patentee has described a practical combination, there is an end of it, and the claim is nugatory.

487. **NATIONAL ENAMELING, ETC., CO. v. NEW ENGLAND ENAMELING CO.**, 151 Fed. 19, 80 C. C. A. 485.

The rule is fundamental, in the construction of patents, that the claim in the patent is the measure of the invention. The specification may be referred to to explain any ambiguity in the claim, but it cannot be referred to for the purpose of expanding or changing the claim.

488. **DURAND v. SCHULZE**, 61 Fed. 819, 10 C. C. A. 97.

In the apt words of Judge Dallas, in rendering the decree of the circuit court (60 Fed. 392), "the law prescribes that the claim must be taken as defining precisely what the invention covered by the patent is, and, hence, the true question is, not what the patentee might have claimed, but what he has claimed."

489. **LEWIS v. PENNSYLVANIA STEEL CO.**, 59 Fed. 129, 8 C. C. A. 41.

The patentee has disclosed only one particular construction operating in a defined way, and this construction he has claimed. It is idle to speculate whether or not he might have made a broader claim. The court is powerless to relieve him from the consequences of self-imposed limitations.

490. **DEY TIME REGISTER CO. v. SYRACUSE TIME RECORDER CO.**, 161 Fed. 111, 88 C. C. A. 275.

When a claim is explicit the courts cannot alter or enlarge it.

491. **HENDY v. GOLDEN STATE, ETC., IRON WORKS**, 127 U. S. 370, 32 L. ed. 207, 8 Sup. Ct. 1275.

[Claims specifically covered cylinders with chambers or depressions. Held, they could not be construed to cover plain cylinders.]

492. **ASHTON VALVE CO. v. COALE, ETC., VALVE CO.**, 52 Fed. 314, 3 C. C. A. 98.

In insisting now that the defendant has incorporated this vital feature in its safety-valve, the complainant seems to place itself precisely within the animadversion of the Supreme Court in the case of *Western Electric Mfg. Co. v. Ansonia Brass & Copper Co.*, 114 U. S. 447, 29 L. ed. 210, 5 Sup. Ct. 941, where it says, "It has been held by this court that the scope of letters patent should be limited to the invention covered by the claim; and, though the claim may be illustrated, it cannot be enlarged by the language of other parts of the specification."

493. **ELECTRIC SMELTING, ETC., CO. v. PITTSBURG REDUCTION CO.**, 125 Fed. 926, 60 C. C. A. 636.

Various other limitations upon the claims are urged by which the defendant seeks to avoid infringement. They are of the same general nature and proceed upon the initial fallacy, namely, that in a generic process patent every phenomenon observed during operation and every minute detail described must be read into the claims and that the least departure from the claims

as so construed avoids infringement. Neither position is tenable. In a patent like Bradley's the claims should be as broad as the invention and, even if unnecessary and unreasonable limitations are incorporated in the claims, the court should interpret them liberally and not permit a defendant to escape who reaches the same result by analogous means, though he may employ additional elements and improve mechanical appliances.

494. SCHREIBER, ETC., MFG. CO. v. ADAMS CO., 117 Fed. 830, 54 C. C. A. 128.

It may be that Farwell's invention would have entitled him to make a broader claim, * * * but his patent makes no such broad claim. It is in this respect like the patent under consideration in *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 24 L. ed. 344.

495. HARDER v. UNITED STATES PILING CO., 160 Fed. 463, 87 C. C. A. 447.

If in truth Harder understood the now stated objections, and was the first to conceive and embody a way of overcoming them, he carefully refrained from saying so. Now a patent is to be sustained not for what an inventor may have done in fact, but only for what he "particularly points out and distinctly claims" in his open letter.

496. BRAMMER v. SCHROEDER, 106 Fed. 918, 46 C. C. A. 41.

The general rule of the patent law is that one who invents and secures a patent for a machine or combination which first performs a useful function is thereby protected against all machines and combinations which perform the same function by equivalent mechanical devices; but one who merely makes and secures a patent for a slight improvement on an old device or combination, which performs the same function before as after the improvement, is protected against those only who use the very device or improvement he describes and claims, or mere colorable evasions of it. *Adams Electric Ry. Co. v. Lindell Ry. Co.*, 77 Fed. 432, 440, 23 C. C. A. 223, 231, 40 U. S. App. 498; *Stirrat v. Manufacturing Co.*, 61 Fed. 980, 981, 10 C. C. A. 216, 217, 27 U. S. App. 13, 42; *McCormick v. Talcott*, 20 How. 402, 405, 15 L. ed. 930; *Railway Co. v. Sayles* 97 U. S. 554, 556, 24 L. ed. 1053.

497. GROTH v. INTERNATIONAL POSTAL SUPPLY CO., 61 Fed. 284, 9 C. C. A. 507.

It is therefore insisted that the claims of the patent should have a liberal construction, and that the special devices described

in the specification "are not necessary constituents of the claims." *Morley, etc., Machine Co. v. Lancaster*, 129 U. S. 263, 32 L. ed. 715, 9 Sup. Ct. 299. This just principle is one that is well recognized, but another principle is, at the present stage of the patent law, of equal force, which is that the construction of the patent must be in conformity with the self-imposed limitations which are contained in the claims.

498. *DELEMATER v. HEATH*, 58 Fed. 414, 7 C. C. A. 279.

A mere reference in a claim to a letter on the drawing does not of itself limit the claim to the precise geometrical shape shown in the drawing (*Reed v. Chase*, 25 Fed. 100) even though the description of the drawing in the specification refers to the part thus lettered by an adjective appropriate to the form shown in the drawing, unless that particular form is pointed out in the specification, or was known by the state of the art to be the particular improvement the inventor claimed.

499. *UNION WATER METER CO v. DESPER*, 101 U. S. 332, 25 L. ed. 1024.

That the courts of this country cannot always indulge the same latitude which is exercised by English judges in determining what parts of a machine are or are not material. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. We can only decide whether any part omitted by an alleged infringer is supplied by some other device or instrumentality which is its equivalent.

500. *JONES v. DAVIS*, 138 Fed. 62, 70 C. C. A. 558.

The meaning of the claim is plain. It does not require, and therefore it is not open to, interpretation. It is so explicit that the courts cannot alter or enlarge it.

501. *TAYLOR v. SAWYER SPINDLE CO.*, 75 Fed. 301, 22 C. C. A. 203.

A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve whirl does not affect the validity of either one of the claims, which belong

to that class where reference may be made to the specifications to supply in a claim what it is plain, to anyone skilled in the art, is a necessary incident.

502. NATIONAL ENAMELING, ETC., CO. v. NEW ENGLAND ENAMELING CO., 151 Fed. 19, 80 C. C. A. 485.

The requirement of the patent law that a patentee shall claim in his patent the exact invention is not only to enable the public to use it after the term of the patent has expired, but is also for the purpose of enabling anyone to determine what the invention is, which is protected by the patent, and what processes which are not protected by the patent may be used in the same manufacture. A person who discovers a new and useful invention does not obtain a monopoly under the patent laws unless he claims his invention in his patent. Even if he describes his invention in the specifications, and then claims as his invention something he has not invented, his patent is good for nothing.

503. CORNING v. BURDEN, 15 How. (U. S.) 252, 14 L. ed. 683.

He cannot describe a machine which will perform a certain function and then claim the function itself, and all other machines that may be invented to perform the same function.

504. LANYON ZINC CO. v. BROWN, 129 Fed. 912, 64 C. C. A. 344.

It is an elementary rule that a patentee may claim the whole or a part of what he has invented. He is entitled to limit his claims to any extent that may seem desirable, but, having done so, his right to protection is also limited, since the claim actually made by the patentee is the measure of his right to relief.

505. AMERICAN WRITING MACH. CO. v. WAGNER TYPEWRITER CO., 151 Fed. 576, 81 C. C. A. 120.

The court is not permitted to reconstruct the claims of a patent, and the patentee is bound by the claims as he has written them.

506. NATIONAL ENAMELING, ETC., CO. v. NEW ENGLAND ENAMELING CO., 151 Fed. 19, 80 C. C. A. 485.

Courts lean toward reading into the claims of a patent such limitations as will save the real invention as disclosed by the specification and the prior state of the art. But when the claims are drawn in broad and nebulous terms with the apparent purpose of enabling the patentee to monopolize an important in-

dustry, the courts should be slow in attempting to sustain their validity by narrowing them beyond the boundaries which are clearly warranted by the specification.

507. DAY v. FAIR HAVEN, ETC., R. CO., 132 U. S. 93, 33 L. ed. 265, 10 Sup. Ct. 11.

It is true that elements of a combination not mentioned in a claim may sometimes be held included, in the light of other parts of the specification, which may be applicable, but here the claim is so broad that we are not justified in importing into it an element which would not operate to so enlarge its scope as to cover an invention in no manner indicated upon its face.

508. EVANS v. ROOD, 99 Fed. 990, 40 C. C. A. 209.

The invention being, then, in no sense a pioneer in the art, no unexpressed meaning can be read with the claim, and the patent must be limited to the specific device described therein.

509. WOLLENSAK v. REIHER, 115 U. S. 87, 29 L. ed. 355, 5 Sup. Ct. 1132.

But, having reference to the state of the art at the date of the alleged invention, and the claims of the patent, the patentee must be limited to the combination.

510. SESSIONS v. ROMADKA, 145 U. S. 29, 36 L. ed. 609, 12 Sup. Ct. 799.

In view of the fact that Taylor was a pioneer in his art of making a metallic trunk fastener, and invented a principle which has gone into almost universal use in this country, we think he is entitled to a liberal construction of his claim, and that the Romadka device, containing as it does all the elements of his combination should be held an infringement, though there are superficial dissimilarities in their construction.

511. CANDA v. MICHIGAN, ETC., IRON CO., 124 Fed. 486, 61 C. C. A. 194.

If, when thus explained, the specification answers the calls of the claim, there is no difficulty. But one may not read into a claim an element not contained in it when its meaning is once settled by construction.

512. PENFIELD v. POTTS, ETC., CO., 126 Fed. 475, 61 C. C. A. 371.

Neither can a feature of construction or an element covered by one claim be read into another in which it is not mentioned.

We know of no authority for reading into a claim features which have been omitted, although shown in the specifications, and none which would justify us in suffering such an enlargement of this claim for the purpose of increasing the damages justly recoverable for the infringement of the patented portions of the infringing machine. We may, beyond doubt, look to the specifications and drawings for the purpose of understanding the claims, or that we may see whether the device is useful or operative, and sometimes for the purpose of limiting a claim to the particular device described, but we may not enlarge a claim by including therein elements which are not claimed as such.

513. TYLER v. BOSTON, 74 U. S. 327, 19 L. ed. 93.

This term "equivalent," when speaking of machines, has a certain definite meaning, but when used with regard to the chemical action of such fluids as can be discovered only by experiment, it only means equally good.

514. PITTSBURG METER CO. v. PITTSBURG SUPPLY CO., 109 Fed. 644, 48 C. C. A. 580.

The court is not at liberty by construction to expand a claim beyond the fair meaning of its terms. As we have seen, this is a claim for a combination. Its terms are explicit and clear. It needs no interpretation. It speaks for itself. The court must take the claim as it finds it.

515. SANTA CLARA, ETC., LUMBER CO. v. PRESCOTT, 102 Fed. 501, 42 C. C. A. 477.

The object of the claim in a patent is to publish to the world the precise nature of the invention which the patentee seeks to protect. He cannot demand that there shall be imported into it an element which is not there distinctly stated or necessarily implied.

516. DELAMAR v. DELAMAR MIN. CO., 117 Fed. 240, 54 C. C. A. 272.

The invention claimed being only for improvements in well-known processes, and in no sense one of a pioneer character, the patentee must be held to a strict construction of his claims.

517. CHICAGO, ETC., R. CO. v. SAYLES, 97 U. S. 554, 24 L. ed. 1053.

Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the

patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use.

518. WOOLLENSAK v. SARGENT, 151 U. S. 221, 38 L. ed. 137, 14 Sup. Ct. 291.

And we do not regard ourselves as justified in importing into the claims elements that would operate to so enlarge its scope as to cover an invention not indicated upon its face.

519. UNITED STATES REPAIR, ETC., CO. v. ASSYRIAN ASPHALT CO., 100 Fed. 965, 41 C. C. A. 123.

It is not within the rightful power of the courts to enlarge or restrict the scope of patents which by mistake, were issued in terms too narrow or too broad to cover the invention, however manifest the fact and extent of the mistake may have shown to have been.

520. CONSOLIDATED FASTENER CO. v. LITTAUER, 84 Fed. 164, 28 C. C. A. 133.

We know of no principle of patent construction which, in such a case (the improvement being novel) would require the court to read into the claim the particular concrete form of improvement shown in the drawings and in the description of such drawings.

521. THOMSON-HOUSTON ELECTRIC CO. v. UNION RY. CO., 86 Fed. 636, 30 C. C. A. 313.

We do not entertain any doubt that there must be incorporated into these claims, by implication, means for maintaining the contact device and the conductor in their normal working relations.

522. ADAMS ELECTRIC RY. CO. v. LINDELL RY. CO., 77 Fed. 432, 23 C. C. A. 223.

The statute requires the inventor to particularly point out, and distinctly claim, the improvement or combination which he claims as his discovery. Rev. Stat. sec. 4888. The purpose of a claim in a patent is to notify the public of the extent of the monopoly secured to the inventor, and, while it is notice of his exclusive privileges, it is no less a notice, and a legal notice, upon which everyone has a right to rely, that he disclaims and dedicates to the public, any combination or improvement, apparent on the face of his specification, not a mere evasion of

his own, which he has not there pointed out and distinctly claimed as his discovery or invention. Everyone has the right to use every machine, combination, device and improvement not claimed by the patentee, without molestation from him. It would work great injustice to permit a patentee, after a combination or device which he did not claim has gone into general use, and years after his patent was granted, to read that combination or device into one of the claims of his patent, and to recover for its infringement of everyone who has used it on the faith of his solemn declaration that he did not claim it.

523. *CIMIOTTI UNHAIRING CO. v. AMERICAN FUR REF. CO.*, 198 U. S. 399, 49 L. ed. 1100, 25 Sup. Ct. 697.

In making his claim the inventor is at liberty to choose his own form of expression, and while the courts may construe the same, in view of the specifications and the state of the art, they may not add to or detract from the claim. And it is equally true, that, as the inventor is required to enumerate the elements of his claim, no one is an infringer of a combination claim unless he uses all the elements thereof.

524. *ANDERSON, ETC., MACH. WORKS v. POTTS*, 108 Fed. 379, 47 C. C. A. 409.

Clearly, however, it is not allowable, in that way [by reading in elements] to give identity to claims which in terms are intelligibly different.

525. *DECECO CO. v. GILCHRIST CO.*, 125 Fed. 293, 60 C. C. A. 207.

While, according to strict rules of law, two distinct claims for the same substantial matter, differing only in nonessentials, cannot both be sustained, yet out of regard to the frailty of human methods of expression, and the variety of views among different legal judicial tribunals as to the construction of instruments of the character of letters patent, and conceding also, the difficulty of always correctly defining what one's invention really is, the practice has become settled to allow the same substantial invention to be stated in different ways, very much as the same cause of action, or the same offense intended to be covered by indictment, are permitted to be propounded in different counts, with a general verdict on all of them.

526. *PANZL v. BATTLE ISLAND PAPER CO.*, 138 Fed. 48, 70 C. C. A. 474.

An inventor cannot "speculate on the equivalents of his claimed invention, and thereby oblige the public to resort to experiments in order to determine the scope of the claims of his patent."

527. *MILLER v. MAWHINNEY LAST CO.*, 105 Fed. 523, 44 C. C. A. 581.

A fatal defect in claim 2 arises out of the words "at or near." We have seen that there is nothing in the specification to limit the indefinite nature of these words. Consequently, there is not enough in the patent to meet the requirements of the statute, pointing out the method by which a successful last can be made in accordance with the claim, and no useful last without a holder was ever made until the respondent came into the field.

528. *GILL v. WELLS*, 89 U. S. 1, 22 L. ed. 699.

Four propositions were decided in that case [*Vance v. Campbell*, 1 Black (U. S.) 427, 17 L. ed. 530] * * * (1) That a patentee, in a suit for an infringement of an invention consisting of a combination of old ingredients, cannot in his proofs abandon a part of such combination and maintain his claim to the rest, for the reason that unless the patented combination is maintained, the whole of the invention falls. (2) That the patentee in such a suit cannot be allowed to prove that any part of the combination is immaterial or useless. (3) That the combination is an entirety, and that if one of the ingredients be given up the thing claimed disappears, which is an obvious truth, as the invention in such a case consists simply in the combination. (4) That the clause which provides that the suit shall not be defeated where the patentee claims more than he has invented, in case he shall disclaim such part, applies only when the part invented can be clearly distinguished from that improperly claimed, which shows that the clause cannot apply to a patent granted for an invention consisting of a combination of old ingredients.

529. *CARTER MACH. CO. v. HANES*, 78 Fed. 346, 24 C. C. A. 128.

His claim is for the combination in a tobacco flavoring machine of three parts. * * * His claim, then, is for an entirety. He can not abandon a part, and claim the rest. He must stand by his claim as he has made it. If more or less than the whole of his ingredients are used by another, such party is not an infringer, because he has not used the invention or discovery patented. *Shumacher v. Cornell*, 96 U. S. 549, 24 L. ed. 676. When a patent is for a combination only, none of the separate elements of which the combination is composed is included in the monopoly. *Rowell v. Lindsay*, 113 U. S. 97, 28 L. ed. 906, 5 Sup. Ct. 507. Or, as expressed by Mr. Justice Bradley in the *Corn Planter Patent (Brown v. Guild)*, 23 Wall. U. S. 181, 23 L. ed. 161.

"When a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device or part of the machine, this is an implied declaration, as conclu-

sive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new.”

530. NATIONAL, ETC., MACH. CO. v. HEDDEN, 148 U. S. 482, 37 L. ed. 30, 13 Sup. Ct. 680.

If a person has invented a combination of three elements, all of which are necessary to the operation of his device, he cannot by making a claim for two of them forestall another who has so combined these two elements that they perform the same function as the three elements.

531. CIMIOTTI UNHAIRING CO. v. AMERICAN, ETC., MACH. CO., 115 Fed. 498, 53 C. C. A. 230.

The argument that the claim is void for lack of novelty if construed to cover a stiff sectional brush, because such brushes were old, loses sight of the distinction, which we have endeavored to point out, that it is not the brush alone which gives patentability to the claim, but the novel motion of the brush. * * * It would be better to hold the patent invalid at the outset than to destroy it by the illiberal construction for which the appellant contends. Few patents can survive if such criticisms are allowed to prevail.

532. CARLTON v. BOKEE, 84 U. S. 463, 21 L. ed. 517.

Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that where a specification by ambiguity and a needless multiplication of nebulous claims is calculated to deceive and mislead the public, the patent is void.

533. HEAP v. TREMONT, ETC., MILLS, 82 Fed. 449, 27 C. C. A. 316.

While it is clear that a patentee is ordinarily entitled to all the uses and all the advantages which his invention develops so far as the new application does not involve additional invention, * * * * yet a function not known when the patent issues, and afterwards developed, cannot ordinarily be used to broaden the construction of a claim.

534. ELECTRIC, ETC., CO. v. BOSTON ELECTRIC CO., 139 U. S. 481, 35 L. ed. 250, 11 Sup. Ct. 586.

What he described in the specification of that patent and did not claim is presumed to have been old.

535. LYONS v. DRUCKER, 106 Fed. 416, 45 C. C. A. 368.

When a patentee has practically disclaimed other devices by stating in his specifications that they existed before his own was contrived, such other devices may fairly be considered to be part of the prior art, when he brings suit upon the patent issued to him, upon the representation made in such specifications.

536. FAY v. CORDESMAN, 109 U. S. 408, 27 L. ed. 979, 3 Sup. Ct. 236.

The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination either directly by the language of the claim or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination and the court can not declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.

537. ANDERSON, ETC., MACH. WORKS v. POTTS, 108 Fed. 379, 47 C. C. A. 409.

The very fact that the other elements mentioned in the specification, while expressly embraced in the other claims, were not mentioned in the sixth claim, demonstrates an intention to cover by that claim any and all forms of disintegrators in the construction of which that cylinder should be used.

538. KALAMAZOO, ETC., SUPPLY CO. v. DUFF MFG. CO., 113 Fed. 264, 51 C. C. A. 221.

It is manifestly just to a patient and meritorious inventor that the court should be careful not to regard with too much importance the mere mechanical resemblance in the parts of the combination, or the combination as a whole, to the neglect of the result, and the success and efficiency with which the object aimed at is accomplished.

539. HAY v. HEATH CYCLE CO., 71 Fed. 411, 18 C. C. A. 157.

When a combination is claimed, there arises an implied concession that the elements are old and not separately patentable.

540. **ADAMS v. BELLAIRE STAMPING CO.**, 141 U. S. 539, 35 L. ed. 849, 12 Sup. Ct. 66.

The court did not, therefore, err in refusing the instruction requested, that before the patent could be held invalid by reason of a prior patent it was not sufficient to find one of the elements in one patent, a second in another, and a third in another. If the patent were for a combination of new or old elements producing a new result such instruction might have been correct, but as it was merely a new aggregation of old elements, in which each element performed its old function and no new result was produced by their combination, the instruction was not applicable and was properly refused.

541. **BATES v. COE**, 98 U. S. 31, 25 L. ed. 68.

Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. In determining about similarities and differences, courts of justice are not governed merely by the names of things, but they look at the machines and their devices in the light of what they do or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result, and that devices are substantially different when they perform different duties in a substantially different way, or produce a substantially different result.

542. **CENTRAL FOUNDRY CO. v. COUGHLIN**, 141 Fed. 91, 72 C. C. A. 93.

An equivalent is defined as a thing which performs the same function, and performs that function in substantially the same manner, as the thing of which it is alleged to be an equivalent. But in the application of rules on the subject we must have in view the patent alleged to be infringed. If it is for a primary invention—one which performs a function never performed by an earlier invention—the patentee will have the right to treat as infringers those who make or use machines 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 of the original. But if the invention is a secondary invention, * * * that is, one which performs a function previously performed by earlier inventions, but which performs that function in a substantially different way from any which preceded it, an improvement on a known ma-

chine by a mere change of form or a new combination of parts, the patentee can not treat another as an infringer who has improved the original machine by the use of a different form or combination performing the same functions. The first inventor of improvements can not invoke the doctrine of equivalents and suppress all other improvements.

543. MACHINE CO. v. MURPHY, 97 U. S. 120, 24 L. ed. 935.

Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself, so that if two devices do the same work in substantially the same way and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.

544. LOURIE IMPLEMENT CO. v. LENHART, 130 Fed. 122, 64 C. C. A. 456.

One who claims and secures a patent for a new machine thereby necessarily claims and secures a patent for every mechanical equivalent for that device, because, within the meaning of the patent law, every mechanical equivalent of a device is the same thing as the device itself. A device which is constructed on the same principle, which has the same mode of operation, and which accomplishes the same result as another by the same means, or by equivalent mechanical means, is the same device, and a claim in a patent for one such device claims and secures the other.

545. KINLOCH TEL. CO. v. WESTERN ELECTRIC CO., 113 Fed. 652, 51 C. C. A. 362.

One who claims and secures a patent for a new machine or combination, thereby necessarily claims and secures a patent for every mechanical equivalent for that device or combination, because, within the meaning of the patent law, every mechanical equivalent of a device is the same thing as the device itself. Moreover, in determining what is a mechanical equivalent of a given device, where, as in the case at bar, form is not the essence of the invention, forms and names are of little significance. The similarities and differences of machines and combinations are to be determined by the offices or functions which they perform, by the principles on which they are constructed, and by the modes which are used in their operation. A device which is constructed on the same principle, which has the same mode of operation, and which accomplishes the same result as another by the same or by equivalent mechanical means, is the same device, and a claim in a patent of one such device claims and secures the other.

546. **BRYCE BROS. CO. v. NATIONAL GLASS CO.**, 116 Fed. 186, 53 C. C. A. 611.

The patents are not for methods, but for particular mechanisms. As such, like all machine patents, they are entitled to a fair construction, and to one that will fully secure to the inventor the monopoly of his real invention, any device or combination which accomplishes the same result, by substantially the same means, will be held an invasion of that monopoly. Care must be taken, however, in all cases, that we do not by an uncalled-for application of the doctrine of equivalents, practically give to the patentee a monopoly of the function of his mechanism. This, of course, we are not permitted to do, directly or indirectly.

547. **MILWAUKEE CARVING CO. v. BRUNSWICK-BALKE-COLLENDER CO.**, 126 Fed. 171, 61 C. C. A. 175.

The patent is granted for the combination, as "the particular means devised by the inventor by which that result is attained," and the patentee is entitled to protection against any use of the same combination of elements, combined in the same way, so that each element performs the same function, or against substantially the same use with deviations which are merely colorable. But each of these well-known elements remains open to the use of the subsequent inventor for a different combination for like results.

548. **WESTINGHOUSE AIR-BRAKE CO. v. NEW YORK AIR-BRAKE CO.** 63 Fed. 962, 11 C. C. A. 528.

The question of infringement is controlled by the principle restated in *Morley, etc., Mach. Co. v. Lancaster*, 129 U. S. 263, 32 L. ed. 715, 9 Sup. Ct. 299, and confirmed in subsequent and recent cases (*Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 38 L. ed. 121, 14 Sup. Ct. 310) and which makes these actual differences, which would be important in a subordinate patent, unessential when a patent for a pioneer invention is under examination. If such differences should be regarded by courts as essential, when the claims do not make the specific devices essential, patents for pioneer inventions would ordinarily have but little value.

549. **MURPHY MFG. CO. v. EXCELSIOR CAR-ROOF CO.**, 76 Fed. 965, 22 C. C. A. 658.

A patent to the original inventor of a machine or construction, which first performs a useful function, protects him against all machines and constructions that perform the same function by equivalent mechanical devices. But a patent to one who has

simply made a slight improvement on devices that perform the same function before as after the improvement is protected against those only which use the very improvement he describes and claims, or mere colorable evasions of it.

550. BUNDY MFG. CO. v. DETROIT TIME-REGISTER CO., 94 Fed. 524, 36 C. C. A. 375.

If his invention is one which has marked a decided step in the art, and has proven of value to the public, he will be entitled to the benefit of the rule of equivalents, though not in so liberal a degree as if his invention was of a primary character.

551. McSHERRY MFG. CO. v. DOWAGIAC MFG. CO., 101 Fed. 716, 41 C. C. A. 627.

The form he describes and claims is not of the essence of his invention, and the law allows a patentee any form which is the equivalent of that claim, unless he has expressly limited himself to the one claim he describes, or unless it is necessary to limit him to the specific form in order to save his patent from anticipation. Hoyt was not a pioneer. But his invention is clearly a meritorious one. In such case he is not cut off from a reasonable range of equivalents measured by the advance he has made over older machines.

552. BEACH v. HOBBS, 92 Fed. 146, 34 C. C. A. 248.

The range of equivalents depends upon the "extent and nature of the invention."

553. NATIONAL, ETC., CO. v. INTERCHANGEABLE, ETC., CO., 106 Fed. 693, 45 C. C. A. 544.

One who merely makes and secures a patent for a slight improvement on an old device or combination, which performs the same function before as after the improvement, is protected against those only who use the very device or improvement he describes or mere colorable evasions thereof. In other words, the term "mechanical equivalent," when applied to the interpretation of a pioneer patent, has a broad and generous signification, while its meaning is very narrow and limited when it conditions the construction of a patent for a slight and almost immaterial improvement.

* * *

The doctrine of mechanical equivalents conditions the construction of all these patents, and in determining questions concerning them, the breadth of the signification of the term is proportioned in each case to the character of the advance or inven-

tion evidenced by the patent under consideration, and is so interpreted by the courts as to protect the inventor against piracy and the public against unauthorized monopoly.

554. *RICH v. BALDWIN, ETC.*, 133 Fed. 920, 66 C. C. A. 464.

As we have several times had occasion to say, and what is indeed well established in patent law, the term "equivalent" has a variable meaning, and is measured by the character of the invention to which it is applied.

555. *BENBOW-BRAMMER MFG. CO. v. STRAUS*, 166 Fed. 114, 92 C. C. A. 98.

We are dealing, not with a great invention, but with a meritorious one which has made a distinct advance in the art in question. We think the claims should be given an interpretation liberal enough to protect the inventor from the use of machines which differ only in non-essential changes which any skilled mechanic would know enough to make.

556. *AMERICAN ROLL-PAPER CO. v. WESTON*, 59 Fed. 147, 8 C. C. A. 56.

[The substitution of a weight to perform the same function as a spring, held an equivalent.]

557. *McKAY, ETC., CO. v. DIZER*, 61 Fed. 102, 9 C. C. A. 382.

There can be no question that a spring rocker is a perfectly familiar way of obtaining a tipping or oscillating motion, as well as a pivot or hinge, and that one is a well known equivalent for the other.

558. *DIAMOND, ETC., IRON CO. v. GOLDIE*, 84 Fed. 972, 28 C. C. A. 589.

The defendant's rotary machine has the same anvil die, and its cutters are arranged to operate with relation thereto in exactly the same way as on the reciprocating machine. They must be classed in the same category.

559. *AMERICAN CRAYON CO. v. SEXTON*, 139 Fed. 564, 71 C. C. A. 548.

We think it must be conceded that the movement of a machine irrespective of the mechanism which causes it can not be patented. * * * The claim must be restricted to the mechanism which causes the movement, subject, of course, to the rule of equivalents, which operates liberally in favor of the grantee where the patent is primary in nature, making a distinct advance in the progress of the art; and this patent, in our opinion,

is of that character. When we examine the mechanism we find in the appellant's machine described in the patent a rocking or tilting device, and in the appellee's a lifting and dropping device. The appliances are essentially different. They do different things in distinct ways. The one rocks or tilts the mold plates, the other alternately lifts and drops them. * * * But are we justified in holding that these two essentially distinct devices are equivalents, simply because the ultimate result * * * is the same? We think not, for that would be construing the claim so as to cover the movement alone and not the mechanism producing it. It would be virtually giving a patent for the result, regardless of how reached.

560. *KINLOCH TEL. CO. v. WESTERN ELECTRIC CO.*, 113 Fed. 659, 51 C. C. A. 369.

An attempt is made to escape from this conclusion under the rule that, if the element substituted for the one withdrawn has been discovered since the date of the patent, it cannot be said to be its mechanical equivalent. *Gould v. Rees*, 15 Wall. (U. S.) 187, 21 L. ed. 39. * * * But it is too plain for argument or serious consideration that there was neither discovery nor invention in perceiving and applying to the device of complainant the fact that an insoluble metal secured by wax on other fusible material was the mechanical equivalent of, performed the same function and worked the same result as, the fusible plug of *White*, and could be effectually used as its substitute. The shot and the wax were not, therefore, newly discovered elements, but constituted a mere mechanical substitute for the element which *White* described and claimed.

561. *LEPPER v. RANDALL*, 113 Fed. 627, 51 C. C. A. 337.

The learned judge who decided the case below had no doubt "that the defendant's straps and buckles are an equivalent of the complainant's cords and hooks," and in this we agree with him; but he held that the complainants were not entitled to invoke the doctrine of equivalency, and this ruling we think was erroneous. By the changes in phraseology which were made pending the application nothing can fairly be said to have been surrendered or disallowed which the third claim as finally approved plainly included. That claim, as broadly expressed, is for "lacing devices," and it is not to be implied that either the patent office on the one side or the applicant on the other contemplated any limitation of it which would admit of its evasion by means so palpably colorable as the substitution of straps for cords and buckles for hooks. * * * In no case is a patentee to be de-

nied protection commensurate with the scope of his actual and distinctly described and claimed invention by excluding him from the benefit of the doctrine of equivalents. That doctrine therefore, should have been applied in this case, for it is plainly obvious that the departures made by the defendant from the patent in suit, are merely formal, "and of such character as to suggest that they are studied evasions of these described in the claim in issue."

562. UNITED STATES PEG-WOOD, ETC., CO. v. STURTEVANT CO., 125 Fed. 382, 60 C. C. A. 248.

Among cases which run to the other extreme, where the range of equivalents is held to be very narrow, are *Masten v. Hunt*, 51 Fed. 216, 55 Fed. 78, 5 C. C. A. 42; *Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. 818, 7 C. C. A. 498; *Ball & Socket Fastener Co. v. C. A. Edgerton Mfg. Co.*, 96 Fed. 489, 37 C. C. A. 523; and *Millard v. Chase*, 108 Fed. 399, 47 C. C. A. 429. In some of this class the nature of the invention prohibited everything except the narrowest range of equivalents, it being a practical rule that the range is proportionate to the extent of the invention; but some are within the expressions in the *Reece Case*, at pages 961 and 962, to the effect that words and phrases which might have been omitted may be so introduced as to leave the courts no option except to regard them as limitations.

563. LAMBERT, ETC., ENGINE CO. v. LIDGERWOOD MFG. CO., 154 Fed. 372, 83 C. C. A. 350.

Where three separate elements, each performing an individual function, are supplanted by a single element which itself performs the functions of all three, it is quite clear that the three-fold capacity of the single element is not the equivalent of the three single elements.

564. BUNDY MFG. CO. v. DETROIT TIME-REGISTER CO., 94 Fed. 524, 36 C. C. A. 375.

Bundy prints by pressing his record strip against the type, while defendant prints by pressing the type down upon the recording strip. That the printing is done by a blow delivered by Bundy's "hammer," and by pressure only in the device of defendant, is not material. Both methods of printing were well known and one is the full equivalent of the other.

* * *

Neither was it invention to cause the printing to be done by pressing the type down upon the paper strip instead of pressing the paper strip against the type. The one was the plain

equivalent of the other. *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 61 Fed. 958, 10 C. C. A. 194. That defendant's impression mechanism is not in the form or shape of a hammer, is of no consequence, unless the form itself is of the essence of the invention.

565. *BOSTON, ETC., R. CO. v. BEMIS CAR-BOX CO.*, 80 Fed. 287, 25 C. C. A. 420.

If it be conceded, however, that the appellant does not use the "tapered sleeve," nor the flange projecting out from the side of the wheel, in precisely the forms described in the appellee's patent, the case becomes a question of equivalents. We have discussed this general question so fully in *Long v. Manufacturing Co.*, 75 Fed. 835, 21 C. C. A. 533, in *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 61 Fed. 958, 10 C. C. A. 194 (an extreme case one way), and in *Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. 818, 7 C. C. A. 498, (an extreme case the other way), that we do not deem it necessary to go over it here. The patent at bar lies between the two cases last cited; and it clearly is not shut out from the expression of the supreme court, cited by us in *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, at page 962, 61 Fed., and page 198, 10 C. C. A. 194, that "the range of equivalents depends upon the extent and the nature of the invention." This invention did not relate to a matter of mere simplicity of form, or of mere convenience, or to cheapening the cost. It involved a new and useful function, although, perhaps, in view of what the record shows of the art, in a limited field of operation. It is therefore entitled to some aid from the doctrine of equivalents; and we can not conceive of any case where it could be so entitled unless it is in the present one, where the departures are only in matters of form, and of such character as to suggest that they are studied evasions of those described in the claim in issue.

566. *HUBBELL v. UNITED STATES*, 179 U. S. 77, 45 L. ed. 95, 21 Sup. Ct. 24.

Whether the examiners were right or wrong in so holding we are not to inquire, as the claimant did not appeal, but amended his claim and accepted a grant thereof, thereby putting himself within the range of the authorities which hold that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers.

In order to get his patent, he was compelled to accept one with a narrower claim than that contained in his original application; and it is well settled that the claim as allowed must be read and interpreted with reference to the rejected claim and to the prior state of the art, and can not be so construed as to cover either what was rejected by the patent office or disclosed by prior devices.

567. *ROEMER v. PEDDIE*, 132 U. S. 313, 33 L. ed. 382, 10 Sup. Ct. 98.

This court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he can not, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it.

568. *AMERICAN STOVE CO. v. CLEVELAND FOUNDRY CO.*, 158 Fed. 978, 86 C. C. A. 182.

The applicant had a long struggle in securing his patent and was constrained to trim away, modify, and otherwise define his specifications and claims to meet the references made by the office, until they were brought within very narrow limits before his patent would be allowed. He must be deemed to have surrendered and disclaimed what he conceded, and to have imposed such definitions upon the language of the patent as he attributed to it in order to secure the grant.

569. *CLOUGH v. GILBERT, ETC., MFG. CO.*, 106 U. S. 166, 27 L. ed. 134, 1 Sup. Ct. 188; and 106 U. S. 178, 27 L. ed. 138, 1 Sup. Ct. 198.

[In the first of these cases the invention was for an improvement in gas burners. It was held that the prior cited burner might be made to furnish a supplementary supply of gas if used in the way for which it was not designed and for which it had not been shown to have been used.]

“The structure was not designed for the same purpose as Clough’s; no person looking at it or using it would understand that it was to be used in the way Clough’s is used, and it is not shown to have been really used and operated in that way.”

[The patent was, therefore, held valid and the second claim infringed, the court saying in applying the doctrine of equivalents:]

“But Clough was the first person who applied a valve regulation of any kind to the combination to which he applied it, and the first person who made such combination, and he is entitled, under decisions heretofore made by this court, to hold as in-

fringements all valve regulations, applied to such a combination, which perform the same office in substantially the same way as, and were known equivalents for, his form of valve regulation.”

[In the second case suit was brought against Clough by the owners of the Barker patent, one of the defendants in the previous case, for an improvement in gas burners.]

“It has been held by this court, in the other suit between the same parties, that a gas-burner made according to the description in the Barker patent infringes both of the claims of the Clough patent; the claim for the method of supplying the additional gas, and the claim for the application of a valve arrangement to regulate the supply. But, the point of the invention and patent of Barker is, that the surrounding shell or tube is so arranged that the screwing of such shell up or down causes it to act as a valve, on the outside of the pillar, to close or open the holes. As a consequence, the interior tubular valve of Clough is dispensed with, the burner is made in two pieces instead of three, is less expensive to make and, moreover, in regulating the supply of gas, the shell alone revolves and not the burner with it, as in Clough’s burner, and so the flame always remains in one position. We think, from the evidence, that these modifications were new and useful, and sufficient in character to sustain a patent. The burner, in the form presented by Barker, appears to have superseded the burner in the form patented by Clough and, after Barker had introduced his burner into use Clough commenced making, for market, burners in the same form patented by Barker.”

[To the same effect amongst many cases see, for example, *Shepard v. Carrigan*, 116 U. S. 593, 29 L. ed. 723, 6 Sup. Ct. 493; *Sutter v. Robinson*, 119 U. S. 530, 30 L. ed. 492, 7 Sup. Ct. 376; *Corbin, etc., Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 37 L. ed. 989, 14 Sup. Ct. 28; *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S. 609, 51 L. ed. 645, 27 Sup. Ct. 307; *Brush Electric Co. v. Western Electric Co.*, 76 Fed. 761, 22 C. C. A. 543; *Kelly v. Clow*, 89 Fed. 297, 32 C. C. A. 205; *Campbell, etc., Mfg. Co. v. Duplex Printing Press Co.*, 101 Fed. 282, 41 C. C. A. 351; *Royer v. Coupe*, 146 U. S. 524, 36 L. ed. 1073, 13 Sup. Ct. 166; *Carnegie Steel Co. v. Brislin*, 124 Fed. 213, 59 C. C. A. 651.]

570. IRONCLAD STEEL CO. v. DAIRYMAN'S, ETC., MFG. CO., 143 Fed. 512, 74 C. C. A. 372.

The applicant acquiesced in the rejection, and amended his claim by adding the interlocking means. Thus it was conceded, and the complainant is precluded from asserting the contrary, that, except for the interlocking means, there was no novelty in the invention claimed.

- 571. NATIONAL CONDUIT, ETC., CO. v. ROEVLING'S SONS CO.,** 158 Fed. 99, 85 C. C. A. 567.

In the case of a meritorious invention a reasonable liberality in applying the doctrine of equivalents is not unusual, and patentees are not always held closely to the precise form stated in the claim when the same functions are found in a structure of a somewhat different form. But the history of this patent during its passage through the patent office precludes any construction of the claim which will eliminate the qualifying word "spirally wound."

- 572. AMERICAN STOVE CO. v. CLEVELAND FOUNDRY CO.,** 158 Fed. 978, 86 C. C. A. 182.

It is a corollary of this proposition, that if the applicant successfully defends his position and secures the assent thereto of those in the office having charge of the application, and the patent issues notwithstanding the objection which had at one time been urged, the patent is not subject to diminution on that account.

- 573. UNITED STATES PEG-WOOD, ETC., CO. v. STURTEVANT CO.,** 125 Fed. 382, 60 C. C. A. 248.

In order that the proceedings in the patent office should positively operate as a waiver or estoppel, they must relate to the pith and marrow of the alleged improvement, and be understandingly and deliberately assented to.

- 574. BUNDY MFG. CO. v. DETROIT TIME-REGISTER CO.,** 94 Fed. 524, 36 C. C. A. 375.

To be estopped by the action of the patent office, the patentee must be shown to have surrendered something which he now claims in order to obtain that which was allowed.

- 575. COBURN, ETC., MFG. CO. v. CHANDLER,** 97 Fed. 333, 38 C. C. A. 201.

The effect of *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, as shown at the foot of page 969 of 61 Fed. and page 205 of 10 C. C. A., is to hold that such proceedings are of no effect when no direct issue of novelty or invention was involved, or when the amendments made by the applicant came in only incidentally, or in reference to an incidental matter. The case at bar, however, is clearly not excluded by the rule thus given.

576. REGENT MFG. CO. v. PENN, ETC., MFG. CO., 121 Fed. 80, 57 C. C. A. 334.

So the applicants never acquiesced in the examiner's action; the examiner did not require the amendment as a condition precedent to the allowance of claims narrower than originally made; and the appellate tribunal allowed the claims after examining the device in the spirit that giveth life.

577. HILLBORN v. HALE MFG. CO., 69 Fed. 958, 16 C. C. A. 569.

It may well be [in view of *Royer v. Coupe*, 146 U. S. 524, 36 L. ed. 1073, 13 Sup. Ct. 166; *Knapp v. Morss*, 150 U. S. 224, 37 L. ed. 1061, 14 Sup. Ct. 81; *Corbin, etc., Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 37 L. ed. 989, 14 Sup. Ct. 28, and *Morgan Envelope Co. v. Albany, etc., Paper Co.*, 152 U. S. 425, 38 L. ed. 500, 14 Sup. Ct. 627, cited] that a patentee can not be permitted to hold under his patent anything that he has clearly renounced and excluded from his inventions during the prosecution of his application. But surely it has never been held that mere changes of phraseology to suit the views of the examiner, and to distinguish the claims made from those contained in prior applications, to which reference has been made, can be held to defeat the patent, when granted. What is forbidden is the attempt, after a patent has been procured surrendering or disavowing substantial claims or devices to recover such renounced and abandoned claims by demanding a broad construction of those allowed.

578. KINNEAR MFG. CO. v. WILSON, 142 Fed. 970, 74 C. C. A. 232.

It is quite unimportant that various claims in both applications were rejected, and the rejection acquiesced in by Kinnear, so long as the office finally granted the claim which is now in controversy. There is no question here of the construction of the claim, and no attempt to broaden it or to narrow it.

579. THOMAS v. ROCKER SPRING CO., 77 Fed. 420, 23 C. C. A. 211.

We now come to the novel question presented in this case. It is argued and the circuit court held, that because the applicants after the rejection of the claims, and after inserting the required limitations in the specifications, protested that the examiner was wrong in rejecting the claims, and advised him that they proposed to insist on a construction of claims as amended to cover the same ground as the rejected claims, the ruling of the patent office is not to be given the same effect as it would otherwise have. It seems to be contended that an applicant can qualify or minimize the effect of his acquiescence in the rejection of a

claim by stating to the patent office that it is not an acquiescence, and that he expects to insist upon his right to cover the same ground as the rejected claim covered, under other and amended claims. We are clearly of opinion that he can not thus destroy the effect of a patent office ruling.

580. *JEWELL FILTER CO. v. JACKSON*, 140 Fed. 340, 72 C. C. A. 304.

It is undoubtedly true that, when there are two claims in a patent for two distinct improvements invented to accomplish different results, as in the case of the invention of the rocking sole upon the brake shoe and of the separate device for the suspension of the shoe from the truck, the words "substantially as specified" mean substantially as specified relative to the subject-matter of the claim, and do not necessarily import the description or claim of either improvement into the claim for the other. *Lake Shore, etc., R. Co. v. National Car-Brake Shoe Co.*, 110 U. S. 229, 28 L. ed. 129, 4 Sup. Ct. 33; *Page Woven Wire Fence Co. v. Land* (C. C.) 49 Fed. 936, 942. But these words ordinarily refer back to and point out elements in the combination claimed which have substantially the construction and operation described in the specification. *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 42 L. ed. 1136, 18 Sup. Ct. 707; *Singer Mfg. Co. v. Cramer*, 192 U. S. 265, 48 L. ed. 437, 24 Sup. Ct. 291.

Cases may be found in which an element described in the specification which is essential to the operation, in the way portrayed in the specification, of a combination or device claimed, has been read into the claim from the specification. *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 18 Sup. Ct. 707, 42 L. ed. 1136; *Wellman v. Midland Steel Co.* (C. C.) 106 Fed. 221, 223. The converse of this proposition, that elements or devices described in the specification which are not essential to the operation of a combination claimed in the way portrayed in the specification, may not be imported into the claim, is equally well established. *Paul Boynton Co. v. Morris Chute Co.*, 87 Fed. 225, 30 C. C. A. 617; *General Electric Co. v. International Specialty Co.*, 126 Fed. 755, 61 C. C. A. 329, 333; *Walker on Patents*, p. 171, § 182; *Temple Pump Co. v. Gross Pump, etc., Mfg. Co.*, (C. C.) 30 Fed. 440, 442. Nor are decisions wanting which have limited the general language of a claim to an element or device, its construction, and operation as set forth in the specification. *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, 30 L. ed. 303; *Vance v. Campbell*, 1 Black (U. S.) 427, 17 L. ed. 168; *Stirrat v. Excelsior Mfg. Co.*, 61 Fed. 980, 984, 10 C. C. A. 216; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 445, 23 C. C. A. 223.

581. AMERICAN CAN CO. v. HICKMOTT, ETC., CANNING CO., 142 Fed. 141, 73 C. C. A. 359.

But those words [substantially as specified] refer to the whole claim, and import nothing into it not already there, either to narrow it, so as to escape anticipation, or to broaden it, so as to establish infringement. The words mean "substantially as specified in regard to the combination which is the subject of the claim."

582. DRAPER CO. v. AMERICAN LOOM CO., 161 Fed. 728, 88 C. C. A. 588.

These words [substantially as described] are sometimes used to limit a claim and sometimes to enlarge its operation, but seldom to practically defeat what was the real invention of the patentee.

583. BRESNAHAN v. TRIPP, ETC., CO., 72 Fed. 920, 19 C. C. A. 237.

It is rare that these words ["substantially as described"] aid the courts in construing patents, if ever they do. In view of the fact that the statutes require an inventor seeking a patent to give in his application a "written description" of his invention, the words in question are usually implied when not expressed. They can not enlarge a patent for a narrow invention, and that they cannot narrow a claim justly broad is sufficiently illustrated.

584. HOBBS v. BEACH, 180 U. S. 383, 45 L. ed. 586, 21 Sup. Ct. 409.

Without determining what particular meaning, if any, should be given to these words ["substantially as described or set forth"] we are of opinion that they are not to be construed as limiting the patentee to the exact mechanism described; but that he is still entitled to the benefit of the doctrine of equivalents.

585. WESTINGHOUSE, ETC., MFG. CO. v. STANLEY INSTRUMENT CO., 133 Fed. 167, 68 C. C. A. 523.

The words "as set forth" in the claims may grammatically refer to anything which precedes them. Therefore, in view of the just and liberal rules of construction stated in *Reece Button-Hole Co. v. Globe Button-Hole Co.*, 61 Fed. 958, 10 C. C. A. 194, they should not be held as restrictive, or as limiting anything in the claims, so as to render ineffectual any part of the conception involved in the portion of the specification which we have quoted.

585a.

[That the words "substantially as described" and "substantially as set forth," etc., refer to the specification and tend to make the claims specific, in some cases restrict the claim to the description of the parts recited in the claim, and in some cases

serve to save a claim by limiting it; see, for example, *Seymour v. Osborne*, 78 U. S. 516, 20 L. ed. 33; *Railroad v. DuBois*, 79 U. S. 47, 20 L. ed. 265; *Brown v. Guild*, 90 U. S. 181, 23 L. ed. 161; *Brown v. Davis*, 116 U. S. 237, 29 L. ed. 659, 6 Sup. Ct. 379; *Pope Mfg. Co. v. Gormully, etc., Mfg. Co.*, 144 U. S. 248, 36 L. ed. 423, 12 Sup. Ct. 641; *Fox v. Perkins*, 52 Fed. 205, 3 C. C. A. 32; *Westinghouse v. Edison Electric Light Co.*, 63 Fed. 588, 11 C. C. A. 342; *Boyden Power-Brake Co. v. Westinghouse Air-Brake Co.*, 70 Fed. 816, 17 C. C. A. 430; *Davis v. Parkman*, 71 Fed. 961, 18 C. C. A. 398; *Campbell v. Richardson*, 76 Fed. 976, 22 C. C. A. 669; *Boynton Co. v. Morris Chute Co.*, 87 Fed. 225, 30 C. C. A. 617; *Brill v. St. Louis Car Co.*, 90 Fed. 666, 33 C. C. A. 213; *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 93 Fed. 958, 36 C. C. A. 24; *General Electric Co. v. International Specialty Co.*, 126 Fed. 755, 61 C. C. A. 329; *Boyer v. Keller Tool Co.*, 127 Fed. 130, 62 C. C. A. 244; *Sanders v. Hancock*, 128 Fed. 424, 63 C. C. A. 166; *Lackawanna Iron, etc., Co. v. Davis-Colby Ore, etc., Co.*, 131 Fed. 68, 65 C. C. A. 306.]

586. *SINGER MACH. CO. v. CRAMER*, 192 U. S. 265, 48 L. ed. 437, 24 Sup.

On referring to the specification we find it there expressly declared that the invention consisted "in the construction and combination of parts hereinafter fully described and claimed, reference being had to accompanying drawings." Nowhere, either expressly or by reasonable inference, is it asserted that simply the best or a preferable construction of the whole or any part of the combination is what is described.

587. *HATCH STORAGE BATTERY CO. v. ELECTRIC STORAGE BATTERY CO.*, 100 Fed. 975, 41 C. C. A. 133.

We are not permitted, in litigations of this character, to give any word a particular interpretation when it is fairly capable of another one which will enable the patent to cover the actual invention.

588. *ANTHONY CO. v. GENNERT*, 108 Fed. 396, 47 C. C. A. 426.

To ignore the express functional limitation of the claim, viz.: "whereby they are enabled to fold back into the case side by side," would be to create a new claim; not interpret the one granted.

589. *IRONCLAD MFG. CO. v. DAIRYMAN'S MFG. CO.*, 143 Fed. 512, 74 C. C. A. 372.

The specification states that they are "preferably" of the same area, and that they are "preferably" to overlap completely,

in order to eliminate any limitation that might be implied if these terms had not been used, and thus to save the claim from being so narrowed that a can otherwise like that described would not be covered by its terms.

590. AMERICAN SULPHITE PULP CO. v. HOWLAND FALLS PULP CO.,
80 Fed. 395, 25 C. C. A. 500.

The evidence demonstrates—and quite likely Russell understood—that some cement mixtures, commercially speaking, were more desirable than others; and the word “cement,” used in the claims, must be understood, when considered in connection with the statutory description, as referring generally to cementitious mixtures having the qualities which he describes.

591. AMERICAN CAN CO. v. HICKMOTT, ETC., CANNING CO., 142 Fed.
141, 73 C. C. A. 359.

Of course, an inventor can not by the mere use of the word “means,” in reference to the accomplishment of a designated function in a combination claim, appropriate any and all kinds of mechanism or devices which may perform the specified function, or any other mechanism or device than that which is described in the patent, or which is its equivalent. Reference must be had to the specifications to ascertain the means which are made an element of the claim and are protected by the patent.

592. UNION MATCH CO. v. DIAMOND MATCH CO., 162 Fed. 148, 89 C.
C. A. 172.

While the claims of the patent specify the physical elements of the combinations, they do not specify the means whereby those elements perform their intended functions, but call for “means” generally for performing them. By this is not meant, as claimed by defendant’s learned counsel, all possible means for accomplishing the result. Such comprehensiveness of claim would not be patentable. * * * The claims in question by direct terms refer to the specification for the means by which the function, purpose, or object of the invention is to be accomplished and to that we must look for them.

593. JEFFREY MFG. CO. v. INDEPENDENT ELECTRIC CO., 83 Fed. 191,
27 C. C. A. 512.

A broad construction, such as is now insisted upon, which would include all cutting devices relied upon as holders, would make his claim void for anticipation. In view of the history of devices intended to perform the same function, performed by his holder, his patent can only be saved by confining him to the specific form he has described and claimed.

594. **STEARNS v. RUSSELL**, 85 Fed. 218, 29 C. C. A. 121.

To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty, is contrary to a well-settled rule of the patent law.

595. **STIRRAT v. EXCELSIOR MFG. CO.**, 61 Fed. 980, 10 C. C. A. 216.

If therefore, the claims of this patent warranted a construction broad enough to cover the device of the appellee, we should have no hesitation in holding it void for want of novelty.

595a.

[The danger of attempting to broaden a claim by construction is pointed out in a series of cases which indicate that if the claims be so broadened the patentee must submit also to the risk of anticipation. That is, the patentees' were between two extremes. If the claims were construed to charge the defendants with infringement then the claims would be void for want of patentable novelty. If so construed as to avoid infringement then the defendants would not infringe. For example, *Sutter v. Robinson*, 119 U. S. 530, 30 L. ed. 492, 7 Sup. Ct. 376; *Pope Mfg. Co. v. Gormully, etc., Mfg. Co.*, 144 U. S. 248, 36 L. ed 423, 12 Sup. Ct. 641; *Gates Iron Works v. Fraser*, 55 Fed. 409, 5 C. C. A. 154.]

596. **MULLER v. LODGE, ETC., TOOL CO.**, 77 Fed. 621, 23 C. C. A. 357.

If his invention is of a broad and meritorious character, such as to work a decided advance in the art, it will require something more than the use of reference letters in his claims to limit him to the exact form of device he has described.

597. **AMERICAN TOBACCO CO. v. STREAT**, 83 Fed. 700, 28 C. C. A. 18.

The apron referred to in the second, third and fourth claims is the rolling apron, A, indicated by the letter "A" in the drawings accompanying the patent, and is an essential part of each claim, as well as the vital part of the patent itself.

598. **M'CORMICK, ETC., MACH. CO. v. AULTMAN, ETC., CO.**, 69 Fed. 371, 16 C. C. A. 259.

Certainly neither of these cases establishes a hard and fast rule that where a patentee claims the combination of certain elements shown in his patent, describing them by reference letters in the drawings, he thereby deprives himself of the benefit of the liberal doctrine of equivalents applicable to pioneer patents, if otherwise he is entitled to its application.

599. ROSS-MOYER MFG. CO. v. RANDALL, 104 Fed. 355, 43 C. C. A. 578.

The use of letters in describing a patented device has been the subject of consideration in a number of cases in the Supreme Court as well as in this court. Sometimes the letters have been held to limit the inventor to the very device thus designated; in other cases the mere use of letters has not been held to deprive the inventor of a liberal application of the doctrine of mechanical equivalents. An analysis of the cases will show that the conclusion reached depends upon the character of the improvement under consideration. If the invention is of a pioneer character, highly meritorious in conception and usefulness, the mere use of letters has been held not to limit the inventor to the exact form of device shown, but he is entitled to a broader construction of his patent, in view of the advance which he has made in the art. However, if the field of invention is limited, and an improvement of a narrow character has been made, just sufficient to cross the line which divides mechanical improvement from patentable invention, the inventor will be allowed the specific description shown and no more. In other words, he will be held to have invented just what his claim shows to have been the specific subject-matter of his improvement. Without stopping to analyze the case we think the following citations establish the rule just stated.

600. STIRRATT v. EXCELSIOR MFG. CO., 61 Fed. 980, 10 C. C. A. 216.

The claims and specifications of every patent must be read and construed in the light of a full knowledge of the state of the art when the patent was issued. A patent to the original inventor of a machine which first performs a useful function protects him against all machines that perform the same function by equivalent mechanical devices, but a patent to one who has simply made a slight improvement on a device that performed the same function before as after the improvement, is protected only against those who use the very improvement he describes and claims, or mere colorable evasions of it.

600a.

[When an inventor applies for a patent he is subject to the presumption of law that he has before him all prior patents, prior uses, prior publications and prior knowledge. *Duer v. Corbin, etc., Lock Co.*, 149 U. S. 216, 37 L. ed. 707, 13 Sup. Ct. 850.

The prior state of the art is always important as bearing upon the construction of a patent and the question of infringement even in cases where the prior art may not anticipate the invention. *Deering v. Winona Harvester Works*, 155 U. S. 286, 39 L.

ed. 153, 15 Sup. Ct. 118. That is to say in the average case the claim for the invention must be drawn in the light of the prior art; and the claim of a patent must be construed in the light of the prior art.]

601. THOMSON-HOUSTON ELECTRIC CO. v. HOOSICK R. CO., 82 Fed. 461, 27 C. C. A. 419.

It would be waste of time to dwell upon the verbal differences in these claims. The change in phraseology import nothing of substance into their respective combinations. They describe the same things in different language, and the draftsman seems to have expended great ingenuity in cataloguing a group of synonyms.

602. MATHESON v. CAMPBELL, 78 Fed. 910, 24 C. C. A. 284.

In other words, having himself experimented only with three or four bodies out of a group of hundreds, he proposes to set himself in the pathway of future experimenters with any or all of the other bodies, and, as the result of each new experiment is disclosed, will fire away at it, calculating to "hit it if it is a deer, and miss it if it is a cow." That this is precisely what is contended for is manifest from the statement, prominently set forth in appellee's brief.

603. CARLTON v. BOKEE, 84 U. S. 463, 21 L. ed. 517.

One void claim, however, does not vitiate the entire patent if made by mistake or inadvertence and without any wilful default or intent to defraud or mislead the public.

604. THOMSON-HOUSTON ELECTRIC CO. v. ELMIRA, ETC., R. CO., 71 Fed. 396, 18 C. C. A. 145.

While two or more inventions residing in the same combination or structure may be covered by a corresponding number of claims in a single patent, the law does not require them all to be claimed in the same patent, and the invention may, at the option of the patentee, be secured by different patents. It is quite immaterial that both inventions originate at the same time and from a single conception.

605. ANDERSON v. COLLINS, 122 Fed. 451, 58 C. C. A. 669.

Even where each of several applications which subsequently ripen into patents to the same inventor discloses all the inven-

tions claimed in all the applications, and they are all pending at the same time, no one of the applications or patents can be used to anticipate any of the claims of the others which it does not itself claim and secure.

606. *IDE v. TRORLICHT, ETC., CARPET CO.*, 115 Fed. 137, 53 C. C. A. 341.

Where each of several applications which subsequently ripen into patents to the same inventor, describes an entire machine and the inventions claimed in all of the applications, but no one of the applications claims any invention claimed in any of the others, and they are all pending at the same time, the respective dates of the applications and of the patents, and the dates when the applications were filed are immaterial, and the applications and the patents can not be used to anticipate each other.

607. *DAYTON FAN, ETC., CO. v. WESTINGHOUSE, ETC., MFG. CO.*, 118 Fed. 562, 55 C. C. A. 390.

We have no disposition to depart from the rules in respect to the identity of patents and the method of determining it, here adverted to, which we deem sound and reasonable; but it would be a misapplication of them, and contrary to their spirit and purpose, to say that independent inventions may not be the proper subjects of independent patents, even though they may relate to the same subject-matter, and one may dominate the other in the same field.

* * *

Since, therefore, the invention of the specific means covered by these claims for the special means and the generic invention were for independent inventions, and neither had been given to the public, it was competent for the inventor to take out a patent for each; and we do not perceive that in such case it would be material that the taking out of the one patent was prior to that of the other.

* * *

And no valid reason exists why the patentee of an invention may not enjoy the privilege of a stranger in thereafter obtaining a patent for an independent invention made by him, although it relate to the matter of his former patent, and was described but not claimed, therein, provided he has not dedicated such independent invention to the public.

608. *WESTERN ELECTRIC CO. v. WILLIAMS-ABBOTT ELECTRIC CO.*, 108 Fed. 952, 48 C. C. A. 159.

The truth is that the kernel of the invention was taken out of this and made the subject of another application. Having dis-

claimed it, the patentee can not now claim that invention to be within the scope of the patent here in suit.

609. HILLARD v. FISHER, ETC., CO., 159 Fed. 439, 86 C. C. A. 469.

The feature which gives validity to the patent in suit was expressly carved out of No. 554,874 and reserved for patenting in No. 580,281. The specification expressly says so. * * * The patent is thus clearly within the protection of the rule followed by this court in Thomson-Houston Electric Co. v. Elmira Elec. R. Co., 71 Fed. 396, 404, 18 C. C. A. 145.

610. PALMER, ETC., TIRE CO. v. LOZIER, 90 Fed. 732, 33 C. C. A. 255.

The rule rests upon the broad and obvious ground that, if the second patent is for an invention, that was necessary to the use of the invention first patented, it cannot be sustained. * * * Undoubtedly, as pointed out in Miller v. Mfg. Co., supra, if the second patent is for a distinct and separate invention, or, to put the matter in another way, has not been made integral with another invention already patented, so as to be fairly necessary to its use, it should be sustained if the other requisite conditions exist.

* * *

One can not lawfully have two patents for one invention. When once the invention has been used, as the consideration of a grant, its value for that purpose is spent, and there is nothing in it on which a second grant can be supported. And this rule holds good though the scope of the patents may be different. One can not extract an essential element of his invention from a former patent, without which the former patent would not have been granted and make it the subject of a subsequent patent.

611. PALMER v. BROWN, 92 Fed. 925, 35 C. C. A. 86.

The conception of a mechanism capable merely of producing motion in a predetermined form, and the conception of this mechanism combined with other elements, in a machine producing work theretofore done only by hand, are distinct. Had the "movement" been in the prior art, we think that Palmer's claims to the protection by letters-patent of his quilting machine would be well founded. As he has produced not only a quilting machine, but a part of that machine which may be used in other machines, we see no reason why, by properly seeking protection for all that he has invented, he should be deprived of the protection of letters-patent for that which he regards as his chief invention.

Are the two patents for the same invention? Looking first to the letters-patent themselves, and comparing their claims we are unable to say that the combination claimed in the earlier is identical with that claimed in the later, since the later specifically claims elements not enumerated in the earlier. As the claims are not coextensive, the fact that a given element is common to both may be of little consequence. * * * The test of identity afforded by a comparison of the claims of the two patents, however, is not conclusive. We must be satisfied further that there are substantial differences, not merely varying descriptions of one invention, or descriptions of a single invention in different applications to use.

612. WESTERN ELECTRIC CO. v. WILLIAMS-ABBOTT, 108 Fed. 952, 48 C. C. A. 159.

By the general rule of patent law, a patent for the specific device would cover all known equivalents, the range of which would be more or less broad according to the scope of the invention. Such equivalents represent in legal contemplation, the same invention. One can not divide an integral invention, or have two patents for the same thing.

613. JAMES v. CAMPBELL, 104 U. S. 356, 26 L. ed. 786.

It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior patent to himself, any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well, because he might get a patent for an invention before patented to a third person in this country, if he could show that he was the first and original inventor, and if he should have an interference declared.

614. OTIS ELEVATOR CO. v. PORTLAND CO., 127 Fed. 557, 62 C. C. A. 339.

The complainant relies upon the disclaimer of the earlier patent: "I do not here claim any of the features also shown and claimed in my application and serial Nos. 157,771, 158,462 and 216,962." Though reference is here made to the application for the patent in suit, it is evident that a patentee can not thus withdraw the invention which actually is embodied in the structure claimed. He can not patent the structure, and by disclaimer withdraw the invention which makes the structure patentable.

* * *

The patentee can not subsequently start afresh and say: "I have now another machine, which is exactly like the old one

in the use of the generic idea. I desire a patent upon it, but I do not claim the feature in which the machine of my new application differs from the old, but I claim what is exactly the same as is in the old. I claim that machine again, and all others containing the same invention." Yet this is substantially the case before us.

615. CROWN CORK, ETC., CO. v. STANDARD STOPPER CO., 136 Fed. 841, 69 C. C. A. 200.

Where two patents are issued on the same day by the patent office, and there is no other evidence of seniority between them than such as appears from their several numbers, the earlier in number must be regarded the senior and the earlier in publication.

* * *

If, however, the invention of the later patent is patented by the earlier one, the earlier must, of course, invalidate the later, for there can not be two valid patents for the same invention, and the later patent is therefore void.

616. THOMSON-HOUSTON ELECTRIC CO. v. WESTERN ELECTRIC CO., 158 Fed. 813, 86 C. C. A. 73.

The matter sought to be covered by the later patent is inseparably involved in the matter embraced in the earlier patent, and, therefore, the claims in controversy are void.

617. WARREN BROS. CO. v. CITY OF OWOSSO, 166 Fed. 309, 92 C. C. A. 227.

The presumption that he believed himself to be the inventor of the pavement for which he was given a patent must be our starting point in determining whether his patent is defeated by anticipation. That somebody had, in fact, made the same composition before he did, does not necessarily defeat his patent. In one sense he would not be the first inventor in such case. But in the sense of the patent statute, he is the first inventor who, by his own thought makes an article or material and first perfects and adapts his discovery to actual use, although someone may have previously made a similar article without putting it to practical use or given his discovery to the public in any way.

618. NATIONAL CASH REGISTER CO. v. AMERICAN CASH REGISTER CO., 53 Fed. 367, 3 C. C. A. 559.

The result which he achieved was a distinct and single one, which had not, by any means, been previously attained. He

entered upon a barren territory in the domain of invention, and was the first to occupy and appropriate it. He was a pioneer.

619. WESTERN ELECTRIC CO. v. ROBERTSON, 142 Fed. 471, 73 C. C. A. 587.

A primary invention is "one which performs a function never performed by any earlier invention." A secondary invention is one which performs a function previously performed, but in a substantially different way. Walker on Pat. Secs. 353, 359. This word (pioneer) although used somewhat loosely, is commonly understood to denote a patent covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what had gone before.

620. WESTINGHOUSE, ETC., MFG. CO. v. STANLEY INSTRUMENT CO., 133 Fed. 167, 68 C. C. A. 523.

Where the originator has boldly struck out into a practical application, and stated it, though only in general terms, he has, for the most part, made his conception clear even though the mechanical details have not been expressed or thought out.

621. SCOTT v. FISHER, ETC., MACH. CO., 145 Fed. 915, 76 C. C. A. 447.

It may, therefore, fairly be said that he fulfilled the requirements of a generic invention, in that he devised a machine which performed the function of looping on a ribbed fabric, a function never performed thereon by any earlier machine, and thereby produced a result never before produced, namely, a ribbed fabric capable of being fleeced, and that in doing this he exercised invention of a high order.

622. SMITH v. GOODYEAR, ETC., CO., 93 U. S. 486, 23 L. ed. 952.

We do not say, the single fact that a device has gone into general use and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and, when the other facts in the case leave the question in doubt, it is sufficient to turn the scale.

623. TOPLIFF v. TOPLIFF, 145 U. S. 156, 36 L. ed. 658, 12 Sup. Ct. 825.

While the question of patentable novelty in this device is by no means free from doubt, we are inclined, in view of the extensive use to which these springs have been put by manufacturers of wagons, to resolve that doubt in favor of the patentees.

624. *MAGOWAN v. NEW YORK, ETC., CO.*, 141 U. S. 332, 35 L. ed. 781, 12 Sup. Ct. 71.

It is remarked by Judge Nixon in his opinion, as a fact not to be overlooked and having much weight, that the Gately packing went at once into such extensive public use as almost to supersede all packings made under other methods; and that that fact was pregnant evidence of its novelty, value, and usefulness. (Smith v. Goodyear, etc., Co., 93 U. S. 486, 23 L. ed. 952; Loom Co. v. Higgins, 105 U. S. 580, 26 L. ed. 1177.) It may also be added, that the evidence shows that the Gately packing was put upon the market at a price from 15 to 20 percent. higher than the old packings, although it cost 10 percent. less to produce it.

625. *KALAMAZOO RY. SUPPLY CO. v. DUFF MFG. CO.*, 113 Fed. 264, 51 C. C. A. 221.

The fact that the complainant's device was at once successful, and that, to a large extent, it practically displaced all lifting jacks in previous use, must be regarded as a circumstance of decided significance. Such circumstance clearly discloses the meritoriousness of the device or invention. And it is well settled that, when the question of patentable novelty is fairly open to doubt, the practical success of the device, with the fact that it displaced similar devices in previous use, is sufficient to turn the scale in favor of the invention.

626. *WESTINGHOUSE, ETC., MFG. CO. v. UNION CARBIDE CO.*, 117 Fed. 495, 55 C. C. A. 230.

If there is any doubt upon the question of patentability, the practical and commercial results of the improvement must resolve such doubts in its favor.

* * *

It is at most merely the use of an old device for a new and analogous purpose, without the necessity of any adaptation in order to discharge the old function in the new device. Its confessed commercial success, therefore, cannot be accepted as evidence of invention.

627. *DOWAGIAC MFG. CO. v. MINNESOTA MOLINE PLOW CO.*, 118 Fed. 136, 55 C. C. A. 86.

The testimony shows that the public by large purchases appreciated Hoyt's device; and while this fact is not controlling, it is entitled to consideration, when commercial success is not shown to be due to other causes.

628. BRUNSWICK-BALKE-COLLENDER CO. v. THUM, 111 Fed. 904, 50 C. C. A. 61.

Within three years after the issuance of the patent, 90 per cent. of the existing bowling alleys have had the new style, or Reisky, returnways. In the face of this evidence, we cannot hold that this improvement is devoid of patentable invention.

629. CROWN CORK, ETC., CO. v. STANDARD STOPPER CO., 136 Fed. 841, 69 C. C. A. 200.

It is urged that the great commercial success which has attended the introduction of the patented cap is persuasive that it supplied a want long felt, and which previous inventors had not been able to meet, and is therefore evidence of its patentable novelty. Such an argument is always legitimate, but in this case has not the usual force, first, because the caps put upon the market seem to have been made according to the earlier Painter patent; * * * and, secondly, because the success is largely attributable to the machine used for fastening the caps on the bottles, and which enables it to be done with great rapidity and efficiency.

630. KENNEY v. BENT, 97 Fed. 337, 38 C. C. A. 205.

From aught that appears, it may have come from his superior construction, or the other claims of the patent, and especially from the fact that he omitted all adjusting devices.

631. GLOBE-WERNICKE v. MACEY CO., 119 Fed. 696, 56 C. C. A. 304.

The fact * * * that these bookcases have gone into extensive use is due, as we think, to the elegant workmanship employed in their manufacture, and the convenience of having the sections separable, aided by the energy with which, as the bill states, they were pressed upon the market.

632. NEW YORK BELTING, ETC., CO. v. SIERER, 158 Fed. 819, 86 C. C. A. 79.

A large part of the success of the complainant's tiles is undoubtedly due to their thickness and the secret composition of which they are made.

633. BALL & SOCKET FASTENER CO., v. EDGARTON MFG. CO., 96 Fed. 489, 37 C. C. A. 523.

The device was known for over 12 years before this bill was filed; and yet during the whole of that period it never has been put to practical use. If the case had been otherwise, the prac-

tical result might have enabled us to give the patent the support which might have come therefrom.

634. **CAMPBELL, ETC., MFG. CO. v. DUPLEX PRINTING-PRESS CO.**, 101 Fed. 282, 41 C. C. A. 351.

The Stonemetz patent did not go into use at all. These facts would not of themselves establish that the inventions were not novel and useful, but such circumstances, unexplained, give additional ground for the belief that no very substantial improvement of the art was made.

635. **IDEAL STOPPER CO. v. CROWN CORK, ETC., CO.**, 131 Fed. 244, 65 C. C. A. 436.

Commercial success is not an infallible standard by which to test the merit of an invention. Such success is often due to mere business ability in manufacturing, exploiting, and advertising; but given a large demand for a particular thing, a market already created, and in an invention which it is free to use, the fact that it is not used strongly demonstrates its inadequacy.

636. **DRAPER CO. v. AMERICAN LOOM CO.**, 161 Fed. 728, 88 C. C. A. 588.

It is urged on us that the complainant made no commercial use of the patented device; but, utility and patentability being otherwise established, we are not required to investigate the excuse given by complainant for nonuser.

637. **LEWIS, ETC., MACH. CO. v. PREMIUM MFG. CO.**, 163 Fed. 950, 90 C. C. A. 310.

It is objected that no machine, conforming to the specification of the first patent, was ever used or placed upon the market. * * * During the life of his monopoly, a patentee is under no obligation to use or place upon the market a device or machine embodying his invention.

638. **OSGOOD DREDGE CO. v. METROPOLITAN DREDGING CO.**, 75 Fed. 670, 21 C. C. A. 491.

The complainant has pressed upon us advertisements and other public declarations of the respondent maintaining the patentability of dredgers of the general character of the one in issue. In that class of litigation in which results can affect no interests except those of the parties to it, the court may well give weight to declarations of that nature; but with reference to a patent for an invention, which is of public concern such declarations are of little consequence, and neither the inventor nor the alleged infringer can be permitted to substitute his own acts or opinions for the judgment of the court.

639. CLEVELAND FOUNDRY CO. v. KAUFFMAN, 135 Fed. 360, 68 C. C. A. 658.

The learned judge said: "The case is a close one. We have not arrived at our conclusion without hesitation, and there are grounds for strongly urging a different one." But we think that the doubt which he seems to have entertained should have been resolved in support of the patent.

640. CONSOLIDATED, ETC., TIRE CO. v. DIAMOND RUBBER CO., 162 Fed. 892, 89 C. C. A. 582.

Another volume of 500 pages has been added to the library which has accumulated during the last ten years through the efforts of many defendants who seem determined to use what they, in effect, assert to be a useless device. The indomitable persistency with which these people have fought for the right to use the Grant tire is more persuasive evidence of its merits than the opinions of experts.

641. NATIONAL, ETC., CO. v. INTERCHANGEABLE, ETC., CO., 106 Fed. 693, 45 C. C. A. 544.

The fact that his combination had not suggested itself to any mechanic skilled in the art during 12 years of diligent search and effort for improvement; the facility and rapidity with which it took the place of old devices and went into immediate and extensive use as soon as it was disclosed—all these facts converge upon the mind with compelling force to prove that the striking and effective improvement he made was the production, not of the skill of the mechanic, but of the intuitive genius of the inventor.

642. GENERAL ELECTRIC CO. v. WAGNER ELECTRIC MFG. CO., 130 Fed. 772, 66 C. C. A. 82.

We have been unable to find in the prior art any single device, or any sufficiently definite suggestions derivable from the various devices, which sustain the contention of defendants that the patented improvement is merely the result of mechanical skill. The reasons for the conclusion that the patented device involved invention sufficiently appear from a comparison of its construction, adapted to attain the objects stated in the specification and the practical results thereby secured, with the impracticability or insufficiency of the devices of the prior art. The failure of defendants to avail themselves of said earlier devices or improve them, and their bodily appropriation of the patented construction, is most persuasive upon the question of invention.

643. *MOTT IRON WORKS v. STANDARD, ETC., MFG. CO.*, 159 Fed. 135, 86 C. C. A. 325.

Indeed its inventive character is evidenced by the alleged anticipatory uses in the respondent's works. The combined use of a pneumatic hammer with a sieve was some years before there tried and abandoned. The evidence of exact practice is not such as to establish an anticipatory use, for it is contradictory as to how the hammer was applied, but the highly significant fact is that, even with the thought of a possible combination of pneumatic hammer and sieve suggested to men skilled in that art, they were not able to mechanically place the two in successful operative relation. But Arrott did just what they failed to do. He contributed to an important industry a device, labor-saving, effective, and which, in relieving to a degree labor under fierce heat conditions, rose to the plane of the humane. And it was these results which the respondent failed to secure that made Arrott's work invention, and theirs a fruitless and abandoned experiment.

644. *SCHENCK v. SINGER MFG. CO.*, 77 Fed. 841, 23 C. C. A. 494.

In view of the prior state of the art thus exhibited, it seems now to have been a very simple thing to do what was done by the patentees. It was only necessary for them to take the Levitt frame, change the location of the brace, perhaps enlarge the diameter of its arms, remove the metallic loop, and insert in the cross brace the short shaft shown in the patent to Brill. But the record in this case affords extrinsic evidence of a most convincing kind that what was done by the patentees was not an obvious thing, and that the change of organization was not one which the skilled mechanics of the particular art could have suggested and introduced without the exercise of inventive faculty. This evidence is supplied, not only by the many patents for improvements, which fell short of producing the simple, compact, less expensive, and more effective bearings of the patent, but by the sterility, during 20 years, of the great army of mechanics employed by the various sewing machine manufacturers. The complainant itself, from 1865 to 1879, used the overhung stud, and for several years of that period its machines contained cross-braces readily adaptable to the office of the patented brace. It employed a vast number of skilled workmen. Yet to none of them did the suggestion occur which is embodied in the new organization of the patentees. The simple change made by the patentees has proved so valuable that the complainant has adopted it in more than 9,000,000 sewing machines. The sewing machine company whose president is the defendant in this suit has also adopted it. No one can examine the bear-

ings of the patent, even cursorily, and compare them with those previously in use, without recognizing the meritorious improvements which they embody. We agree with the court below that these improvements were invention, and not merely the exercise of mechanical skill and adaptation.

645. HOBBS MFG. CO. v. GOODING, 111 Fed. 403, 49 C. C. A. 414.

It aided to make a successful machine; and the fact that Cushman failed to accomplish that result notwithstanding his ingenuity, weighs strongly in favor of the patentability of the complainant's box form, simple as it is.

646. LOOM CO. v. HIGGINS, 105 U. S. 580, 26 L. ed. 1177.

If Davis was the inventor of the wire motion applied to these looms, why did he not apply for a patent for it? He was already a patentee of a different and inferior apparatus. He knew all about the method of going about to get a patent. He belonged to a profession which is generally alive to the advantages of a patent right. On the hypothesis of his being the real inventor his conduct is inexplicable.

647. AUSTIN MFG. CO. v. AMERICAN WELLWORKS, 121 Fed. 76, 57 C. C. A. 330.

The defendant furnishes strong evidence of its utility by persistent adoption of means for like purpose.

648. SANDERS v. HANCOCK, 63 C. C. A. 166, 128 Fed. 424.

And, having regard to the presumption of validity arising from the grant, the success which it has attained, the non-existence of any anticipation, and the adoption of it by the defendant in his business, with express notice of the patent, and with a view to profit by it, we think we should hold the combination of claim 2 to be valid.

649. CLARK v. WILSON, 30 Fed. 372.

As at the time he obtained this patent he had been engaged for over 25 years in the manufacture and sale of rolling metallic shutters, and it was open to him to adopt the joint of the prior art, his adoption of the joint of the patent is quite persuasive evidence of its merit. That the changes of form were not an obvious thing, but involved invention, is shown by the fact that for a period of 40 years since the earlier invention in metallic shutters no one seems to have conceived of the practicability of the improvement.

650. HILLARD v. FISHER, ETC., CO., 159 Fed. 439, 86 C. C. A. 469.

It is difficult to imagine an instance where a patent should be defeated on this ground [want of utility] at the instigation of one who is himself persistently using the very thing which he denounces as useless.

651. CLOUGH v. GILBERT, ETC., MFG. CO., 106 U. S. 178, 27 L. ed. 138, 1 Sup. Ct. 198.

We think, from the evidence, that these modifications were new and useful, and sufficient in character to sustain a patent. The burner in the form patented by Barker appears to have superseded the burner in the form patented by Clough, and, after Barker had introduced his burner into use, Clough commenced making for market burners in the same form.

652. FARRIES MFG. CO. v. BROWN, ETC., CO., 121 Fed. 547, 57 C. C. A. 609.

The advance seems simple enough. One wonders why, pending its adoption, twelve years went by. But the same wonder accompanies every step forward in the useful arts. The eye that sees a thing already embodied in mechanical form gives little credit to the eye that first saw it in imagination. But the difference is just the difference between what is common observation and what constitutes an act of creation. The one is the eye of inventive genius; the other of a looker-on after the fact. Considering the utility of the new knot, and the unavailing efforts prior to the patent in suit, to reach some correction of the existing defects, and the length of time those efforts went on, we are convinced that the patent under consideration evinces something more than mere mechanical skill. (Patent No. 328,452, for Check-Row Wire.)

653. EDISON v. AMERICAN MUTOSCOPE CO., 114 Fed. 926, 52 C. C. A. 546.

Undoubtedly Mr. Edison, by utilizing this film and perfecting the first apparatus for using it, met all the conditions necessary for commercial success. This, however, did not entitle him, under the patent laws, to a monopoly of all camera apparatus capable of utilizing a film. Nor did it entitle him to a monopoly of all apparatus employing a single camera.

654. PARK, ETC., CO. v. HARTMAN, 153 Fed. 24, 82 C. C. A. 158.

But one who makes or vends an article which is made by a secret process or private formula cannot appeal to the protection of any statute creating a monopoly in his product. * * *

The process or the formula is valuable only so long as he keeps it secret. The public is free to discover it if it can by fair and honest means, and, when discovered, anyone has the right to use it. *Chadwick v. Covell*, 151 Mass. 190, 23 N. E. 1068, 6 L. R. A. 839, 21 Am. St. 442; *Tabor v. Hoffman*, 118 N. Y. 30, 23 N. E. 12, 16 Am. St. 740; *Peabody v. Norfolk*, 98 Mass. 452, 96 Am. Dec. 664; *Vulcan Detinning Co. v. American Can Co.*, 67 N. J. Eq. 243, 58 Atl. 290.

655. PROVIDENCE RUBBER CO. v. GOODYEAR, 76 U. S. 788, 19 L. ed 566.

A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old, and the product new. In that event, the latter and not the former, would be patentable. Both may be new or both may be old. In the former case both would be patentable; in the latter neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither or both, according to the fact of novelty, or the opposite. The patentability or the issuing of a patent as to one, in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute.

656. UNITED STATES EX REL. STEINMETZ v. ALLEN, 192 U. S. 543, 48 L. ed. 555, 24 Sup. Ct. 416.

Can it be said that a process and an apparatus are inevitably so independent as never to be "connected in their design and operation?" They may be completely independent. * * * But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such cases the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it.

657. HOFF v. IRONCLAD MFG. CO., 139 U. S. 326, 35 L. ed. 179, 11 Sup. Ct. 580.

It may be true that Reynolds conceived the idea of his hod from an examination of the Hoff device; but he is none the less entitled to claim that the Hoff patent had been anticipated by prior devices, especially when such prior devices appear to show a complete anticipation of his own.

658. *DEERING v. WINONA HARVESTER WORKS*, 155 U. S. 286, 39 L. ed. 153, 15 Sup. Ct. 118.

Oral testimony, unsupported by patents or exhibits, tending to show prior use of a device regularly patented is, in the nature of the case, open to grave suspicion.

659. *CANTRELL v. WALLICK*, 117 U. S. 689, 29 L. ed. 1017, 6 Sup. Ct. 970.

The burden of proof is upon the defendants to establish this defense. For the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty.

660. *KIRCHBERGER v. AMERICAN, ETC., BURNER CO.*, 128 Fed. 599, 64 C. C. A. 107.

We conclude, however, that inasmuch as defendants' contention is based on the claim that the Buller or other devices of the prior art were capable of practical successful operation when made of lava or steatite, the burden was upon the defendants to prove this fact as part of their *prima facie* case.

661. *McMICHAEL, ETC., MFG. CO. v. RUTH*, 128 Fed. 706, 63 C. C. A. 304.

It is perhaps possible for an expert, having the patent in suit before him, to build up the structure covered by these claims, by selecting and deftly adapting appliances theretofore known, "yet it would still be true that neither the same combination in its entirety nor the same mode of operation" had previously been described or in any manner exemplified.

662. *AMERICAN ROLL-PAPER CO. v. WESTON*, 59 Fed. 147, 8 C. C. A. 56.

We are fully sensible of the just criticisms which were made upon this class of testimony by the supreme court in the case of *Washburn & Moen Manuf'g Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 Sup. Ct. 443, and many times repeated by that and other courts in dealing with such cases; but it is impossible to resist this mass of testimony, coming as it does from witnesses who are unimpeached, and, possibly with one exception, wholly disinterested.

663. *FARMERS' MFG. Co. v. SPRUKS MFG. CO.*, 127 Fed. 691, 62 C. C. A. 447.

Considering this patent as an alleged limiting or anticipating document, what would a person skilled in the art of barrel making produce from inspecting the drawings of the patent and

following it? Nothing but a tight, unventilated barrel, with a cylindrical center and cones at the ends. For nearly 30 years it had been on the public record without producing any effect on the art or trade of barrel making. It cannot be said that a patent for a device which fails to accomplish the desired end is an anticipation of one which successfully accomplishes it.

664. COLUMBUS CHAIN CO v. STANDARD CHAIN CO., 148 Fed. 622, 78 C. C. A. 394.

The burden was on appellant to establish that he invented his device prior to December 27, 1894, and that beyond a reasonable doubt. It is well settled that, if a defendant seeks to invalidate the patent in suit by showing by oral testimony, prior invention, the proof must be clear, satisfactory, and beyond reasonable doubt. [Barbed Wire Patent, 143 U. S. 275, 36 L. ed. 154, 12 Sup. Ct. 443, 450; American Roll-Paper Co. v. Weston, 59 Fed. 147, 8 C. C. A. 56.] It is also the law that, if a plaintiff seeks to maintain the patent in suit by showing by oral testimony invention prior to a patent which anticipates it and would otherwise invalidate it, the proof must be of the same character.

665. WESTINGHOUSE, ETC., MFG. CO. v. NEW ENGLAND GRANITE CO., 110 Fed. 753, 49 C. C. A. 151.

Giving to Deprez's theorem all the value to which it is entitled, its application by Tesla to the production of a new, original and most beneficial practical result by new and described means and the use of polyphase alternating currents—in brief, by the polyphase system—and the apparatus of Tesla was an invention of a very high order. The defense of non-patentability was elaborated in the record in the most painstaking manner, and with abundant reference to statements and theories of scientists who preceded Tesla, and who were trying to discover the laws of a mysterious natural force, the utilization of which is still far from complete development. Each was prospecting in a mine not thoroughly explored, and dimly lighted, and each produced something of value; but the attempt to minimize Tesla's invention of the method of successfully using electricity for very important purposes by means theretofore thought to be impracticable rested upon a very inadequate foundation.

666. EDISON v. AMERICAN MUTOSCOPE CO., 114 Fed. 926, 52 C. C. A. 546.

We are not satisfied that the apparatus is inoperative, but incline to the opinion that the alleged defects are merely in de-

tails of construction, which would be readily obviated by the skilled mechanic. The presumption arising from the grant of the United States patent must prevail in the absence of proof to overthrow it.

667. LINCOLN IRON WORKS v. McWHIRTER CO., 142 Fed. 967, 74 C. C. A. 229.

[The essential point of the patent was fastening together two tables. It was asserted that Gilmour had obtained a conception from Brown. The court held that this was not proof but that Brown had communicated to Gilmour only knowledge which was accessible to all who might have chosen to familiarize themselves with the prior art.]

668. WESTINGHOUSE AIR-BRAKE CO. v. CHRISTENSEN ENGINEERING CO., 128 Fed. 437, 63 C. C. A. 179.

It may be assumed that Boyden of 1883 and Holleman were mere paper patents not capable of successful practical operation. But this does not defeat their relevancy as limitations upon the scope of the patent in suit, provided they sufficiently embody the elements and disclose the principle of operation of said patent.

669. WESTINGHOUSE AIR-BRAKE CO. v. GREAT NORTHERN R. CO., 88 Fed. 258, 31 C. C. A. 525.

Prophetical suggestions in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements, * * * and the result which was then reached is not shaken by merely a single sentence in the English patent.

670. DRAPER CO. v. AMERICAN LOOM CO., 161 Fed. 728, 88 C. C. A. 588.

Of course where mechanical improvements have moved so fast as they have in the last half century, great caution is required in investigating alleged anticipations which date back nearly the whole of that period; and, so far as they did not go into use, so there was no practical exhibition of them, it is often difficult to determine whether they disclosed such full, clear and exact terms as are necessary to anticipate.

671. DEERING v. WINONA HARVESTER WORKS, 155 U. S. 286, 39 L. ed. 153, 15 Sup. Ct. 118.

These devices, though not claimed to fully anticipate the Olin patent in suit, are important in their bearing upon the construction of this patent and upon the alleged infringement by the defendants.

672. NATIONAL, ETC., CO. v. SWIFT, 104 Fed. 87, 43 C. C. A. 421.

The contention that these prior patents must be treated as failures—as mere paper patents of no practical value—is untenable. “The very fact” of the grant of a patent for the process described “is some evidence of its operativeness, as well as of its utility,” when introduced by way of anticipation.

673. VAN EPPS v. UNITED BOX, ETC., CO., 143 Fed. 869, 75 C. C. A. 77.

In these circumstances, the rule frequently invoked in the case of mere paper patents may with much greater force be applied to these machines, which, even though they may have worked imperfectly, were confessedly capable of a limited, successful, practical operation. Where such patents, or the machines constructed under them, embody the principle covered by a later patent, the mere fact that they are not capable of successful practical working because of objections as to the minor matters of detail in construction will not deprive them of their effect as defenses where they sufficiently disclose the invention claimed in the later patent.

674. SANDERS v. HANCOCK, 128 Fed. 424, 63 C. C. A. 166.

We have no doubt that Hardy had no knowledge of any of these former patents, for they had not been much extended in use or public notice; but the consequence of their existence no less affects his claim of novelty than if he had known all about them, notwithstanding their obscurity.

675. CANDA v. MICHIGAN, ETC., IRON CO., 124 Fed. 486, 61 C. C. A. 194.

Nor can we think that the existence in the Patent Office of something which might merely supply a hint, but was not specifically described or claimed as intended to be covered by a patent, ought to be held as an anticipation of an otherwise valid invention. Inventors are not precluded by the embryonic and shapeless ideas found in former patents, any more than they are by such undeveloped matter existing elsewhere.

676. *KIRCHBERGER v. AMERICAN, ETC., BURNER CO.*, 128 Fed. 599, 64 C. C. A. 107.

Said Bullier patent does not anticipate the patent in suit because: (1) The defendants have failed to show that it is capable of successful practical operation, or that the objections thereto were such as could be obviated without the exercise of the faculty of invention. * * * (2) Because, being a foreign publication, it does not contain a substantial representation of the patent improvement in such clear and exact terms as to enable a person skilled in the art to construct and practice the invention. * * * (3) It appears that it does not operate upon the theory or in the manner covered by the invention in suit.

677. *CARNEGIE STEEL CO. v. CAMBRIA IRON CO.*, 185 U. S. 403, 46 L. ed. 968, 22 Sup. Ct. 698.

A process patent, such as that of Jones, is not anticipated by mechanism which might, with slight alterations have been adapted to carry out that process, unless, at least, such use of it would have occurred to one whose duty it was to make practical use of the mechanism described. In other words, a process patent can only be anticipated by a similar process. A mechanical patent is anticipated by a prior device of like construction and capable of performing the same function but it is otherwise with a process patent. The mere possession of an instrument or piece of mechanism contains no suggestion whatever of all the possible processes to which it may be adapted. (*New Process Fermentation Co. v. Maus*, 122 U. S. 413, 30 L. ed. 1193, 7 Sup. Ct. 1304.) If the mere fact that a prior device might be made effective for the carrying on a particular process were sufficient to anticipate such process, the absurd result would follow that, if the process consisted merely of manipulation, it would be anticipated by the mere possession of a pair of hands.

* * *

Some of the expressions taken by themselves, seem to foreshadow the Jones idea; but there was nothing in any of these discussions that filled the requirement of the law (Rev. Stat. sec. 4886) of a description in a publication sufficient to anticipate the patent.

678. *ELECTRIC ACCUMULATOR CO. v. BRUSH ELECTRIC CO.*, 52 Fed. 130, 2 C. C. A. 682.

It, therefore, serves no useful purpose to strive to show that the Brush patent was anticipated because some pre-existing scientist has described a battery which corresponds with the general phraseology of the claims, provided their language

should be so construed as to include the class of batteries which has been mentioned, a construction which is forbidden by the history of the invention and by a disinterested examination of the patent.

678a. **WICKELMAN v. DICK CO.**, 88 Fed. 264, 31 C. C. A. 530.

The case is one for the application of the doctrine, well settled in the law of patents, that novelty is not negated by a prior accidental production of the same thing, when the operator does not recognize the means by which the accidental result is accomplished and no knowledge of them or of the method of its employment is derived from it by any one.

678b. **BROWN v. GUILD**, 90 U. S. 181, 23 L. ed. 161.

If, upon the whole of the evidence, it appears that the alleged prior invention or discovery was only an experiment and was never perfected or brought into actual use, but was abandoned and never revived by the alleged inventor, the mere fact of having unsuccessfully applied for a patent therefor cannot take the case out of the category of unsuccessful experiments.

679. **MILLER v. EAGLE MFG. CO.**, 151 U. S. 186, 38 L. ed. 121, 114 Sup. Ct. 310.

That which infringes if later, anticipates if earlier.
[And many other cases.]

PART X.

AMENDING, CORRECTING, REPEALING, EXTENDING PATENTS.

Statutes and Rules of Practice—Reissue—Must Be for Same Invention Which Should Have Been Covered by Original—When Claims May Be Broader Than in Original Patent—Error Arising from Inadvertence, Accident or Mistake, and Force of Grant by Commissioner of Patents—Reinstating Cancelled or Rejected Claims—Requirement of Reasonable Diligence—“Intervening Rights”—Effect of Surrender of Original Patent—General Rules and Illustrations—Certificate of Correction—Disclaimers—Repeal by Government—Extension.

STATUTES.

(Reissue of defective patents.)

Sec. 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced

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

(Disclaimer.)

Sec. 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

(Suit for infringement where specification is too broad.)

Sec. 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part hereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But

no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See Secs. 973, 4917.]

(Costs not recoverable in certain suits for infringement of patent unless disclaimer entered, etc.)

Sec. 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought. [See §§ 4917, 4922.]

RULES OF PRACTICE.

Rule 35 practically repeats Rev. Stat. § 4915, as modified by § 4895.

(Abstract of title. Assent of assignees.)

86. The petition for a reissue must be accompanied by an order for a certified copy of the abstract of title to be placed in the file, giving the names of all assignees owning any undivided interest in the patent. In case the application be made by the inventor it must be accompanied by the written assent of such assignees.

(Prerequisites—Oath of applicant for reissue.)

87. Applicants for reissue, in addition to the requirements of Rule 46, must also file with their petitions a statement on oath as follows:

- (1) That applicant verily believes the original patent to be inoperative or invalid, and the reason why.
- (2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.
- (3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly specifying the part or parts so alleged to have been improperly claimed as new.
- (4) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

- (5) That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant.

(New matter.)

88. New matter shall not be allowed to be introduced into the reissue specification, nor in the case of a machine shall the model or drawings be amended except each by the other.

(Division of reissue of application.)

89. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of Rule 50. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

(Re-examination of reissue claims.)

90. An original claim, if reproduced in the reissue, specification, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications.

91. The application for a reissue must be accompanied by the original patent and an offer to surrender the same, or, if the original be lost, by an affidavit to that effect, and a certified copy of the patent. If a reissue be refused, the original patent will be returned to applicant upon his request.

(Matter to be claimed only in a reissue.)

92. Matter shown and described in an unexpired patent, and which might have been lawfully claimed therein, but which was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident, or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent.

680. MILLER v. BRIDGEPORT BRASS CO., 104 U. S. 350, 26 L. ed. 783 (1881).* * *

We think, however, that the court below was clearly right in holding that the invention specified in the second claim of the reissued patent (which is the one in question here) is not the same invention which was described and claimed in the original patent. The latter was for a double dome without a chimney, the peculiarity of the supposed invention being the use of the double dome as a means of dispensing with the chimney. The reissue is for a single dome with a chimney. It is not only obviously a different thing, but it is the very thing which the patentee professed to avoid and dispense with.

But there is another grave objection to the validity of the reissued patent in this case. It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretense; or if not a pretense, the mistake was so obvious as to be instantly discernible on opening the letters-patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately.

These afterthoughts, developed by the subsequent course of improvement, and intended, by an expansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion. The pretense in this case that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for human credence. He simply appealed from the judgment of the office in 1860 to its judgment in 1876, from the commissioner and examiners of that date, to the commissioner and examiners of this: and upon a matter that was obvious on the first inspection of the patent. If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in returning to the Patent Office, and says "I omitted this," or "my solicitor did not understand that," his application may be entertained, and, on a proper showing, correction may be made. But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal

effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or reissue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.

The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused. It was first contained in the act of July 3, 1832, c. 357, and the law was adopted in view of suggestions made in several judgments of this court. But it was carefully confined to cases where the patent was invalid or inoperative by reason of a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention and where such failure was due to inadvertence, accident, or mistake, without any fraudulent or deceptive intention. This being shown, a new patent, with a correct specification, was authorized to be issued for the same invention. The act of July 4, 1836, c. 45, enlarged the power to grant reissues by adding an additional ground for reissue; namely, that the patentee had inadvertently claimed in his specification, as his own invention, more than he had a right to claim as new. And, with that addition, the law has continued substantially the same to the present time. The fifty-third section of the act of 1870, c. 230, which was the law on this subject when the reissue in the present case was granted, is in the following words: "Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee." It will be observed that whilst the law authorizes a reissue when the patentee has claimed too much, so as to enable him to contract his claim, it

does not, in terms, authorize a reissue to enable him to expand his claim. The great object of the law of reissues seems to have been to enable a patentee to make the description of his invention more clear, plain, and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. The third section of the act of 1793, c. 11, required an applicant for a patent "to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and 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. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings." This careful and elaborate requirement was substantially repeated in the sixth section of the act of 1836, with this addition: "And shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery." Although it had been customary to append a claim to most specifications, this was the first statutory requirement on the subject. It was introduced into the law several years subsequently to the creation of reissues; and it was in the thirteenth section of this act of 1836 that provision was made for a reissue to correct a claim which was too broad in the original. Now, in view of the fact that a reissue was authorized for the correction of mistakes in the specification before a formal claim was required to be made, and of the further fact that when such formal claim was required express power was given to grant a reissue for the purpose of making a claim more narrow than it was in the original, without any mention of a reissue for the purpose of making a claim broader than it was in the original, it is natural to conclude that the reissue of a patent for the latter purpose was not in the mind of Congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the Patent Office know the fact, that the constant struggle between the office and applicants for patents has reference to the claim. The patentee seeks the broadest claim he can get. The office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose

of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them.

Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real bona fide mistake, inadvertently committed; such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct. Reissues for the enlargement of claims should be the exception and not the rule. And when, if a claim is too narrow—that is, if it does not contain all that the patentee is entitled to—the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive claim. The granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights, and sleeps upon them, justly loses them.

The correction of a patent by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the claim. And hence a reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to reissues made for the purpose of enlarging the scope of the

patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the reissue, it is competent for the courts to decide whether the delay was unreasonable, and whether the reissue was therefore contrary to law and void.

We think that the delay in this case was altogether unreasonable, and that the patent could not lawfully be reissued for the purpose of enlarging the claim and extending the scope of the patent.

Decree affirmed.

681. JAMES v. CAMPBELL, 104 U. S. 356, 26 L. ed. 786 (1881).* * *

Perhaps we have gone more minutely into the evidence relating to the progressive improvements in this instrument than was necessary to show that the claim of the patent was not more restricted than it should have been. The court ought not to be called upon to explore the entire history of an art in order to ascertain what a patentee might have included in his patent had he been so disposed. If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time, and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent. When a patent fully and clearly, without ambiguity or obscurity, describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim so as to make it embrace an invention not described and specified in the original. It is difficult to express the law on this subject more aptly and forcibly than in the words of Mr. Justice Grier, in the case of *Burr v. Duryee*, 1 Wall. (U. S.) 531, where, in delivering the unanimous opinion of the court, he says: "The surrender of valid patents, and the granting of re-issued patents thereon, with expanded or equivocal claims, where the original was clearly neither 'inoperative nor invalid,' and whose specification is neither 'defective or insufficient,' is a great abuse of the privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive and, therefore, more 'available' for the suppression of all other inventions." Of course, if, by actual inad-

vertence, accident or mistake, innocently committed, the claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy application for its correction, before adverse rights have accrued, may be granted, as we have explained in the recent case of *Miller v. Brass Co.* But where it is apparent on the face of the patent, or by contemporary records, that no such inadvertence, accident or mistake, as claimed in a reissue of it, could have occurred, an expansion of the claim cannot be allowed or sustained.

By these extracts from the specification, and the summary of claims, it appears perfectly obvious that the patentee has embraced in the reissued patent several matters of supposed invention different from and additional to the invention which formed the subject of the original patent. And it is principally, if not wholly, these new and additional claims which the appellant James, as postmaster of New York, is charged with infringing.

In the first place, a new form of the canceling device is set forth and claimed, different from that described in the original patent, to-wit: a canceling type or die attached directly to the cross-bar, without any tube or pipe surrounding and holding the same. This is not contemplated or hinted at in the original patent. The latter does suggest, it is true, that "The cork, rubber or other elastic material may extend upward to the cross-bar, and there be connected to the same by a screw or pin-bolt, if desired:" but this suggestion had reference to a type inclosed, at the same time, by a surrounding cylinder, which formed the distinctive feature of the invention. The context shows that nothing more was intended by the suggestion than the extension of the type upward through the cylinder and fastening it in a particular way. The thought seems to have occurred to the patentee that it might be an advantage, under some circumstances, in addition to fastening the type in the cylinder by compression, to extend it through the cylinder and fasten it to the bar to secure it from any danger of falling out of the cylinder by becoming loose. Not a hint was given that the cylinder could be dispensed with. This was an afterthought. The cylinder was clearly and distinctly set forth as a necessary constituent of the device, and an essential element in the combination of which the blotting device consisted.

The bearing which this new feature in the reissued patent has on the case is evinced by the fact that one of the devices used for several years in the postoffice which is complained of as an infringement of the patent, was a naked blotter made of cork, directly attached to the cross-bar, without any inclosing cylinder to support it: also by the fact that the other device used in the postoffice during the defendant's term of office consisted of an iron blotter directly

attached to the side of the postmarking stamp without any inclosing cylinder.

In our judgment this addition to the patent was no part of the original invention, and could not lawfully be embraced in the re-issue, and that the claim for it is, therefore, void. It is true that this particular feature is not made the subject of a distinct claim. But it is described as part of the invention, and would, probably, be included in the general and sweeping terms employed in the claims that are made. Regarded as not being a part of the original invention, those claims cannot stand if they are construed to include it; if they are construed so as not to include it, then the use of this form of device by the defendant cannot be adjudged an infringement of the patent.

Another new matter, forming no part of the original invention, but expressly disclaimed in the original patent, is the making of the blotter of cast iron, steel or other suitable material. The original specification, in various forms of expression, excludes such materials. The words "wood, cork, rubber or any similar material" have this intention, as shown by the context. A claimed advantage is that "The said cork, rubber or other elastic substance, as aforesaid, will render the said stamp capable of an easy and rapid use; for there being a yielding of the same when the blow is given, the operator will not tire as soon by a constant or continued use of the same as though it were of solid metal. The said blotter or type can be more easily repaired or replaced by a new one, at less expense than if made of solid metal." This language amounts to an express disclaimer of solid metal. The merit claimed for the invention was that the elastic materials proposed to be used for the blotter, and the use of which the patent throughout supposes possible by the support received from the surrounding cylinder were far superior to solid metal and other solid and inelastic substances. How, after this, it could be supposed that the use of solid metal as a material for the type-blotter was included in the invention, and that a claim for it was omitted through inadvertence and mistake, it is difficult to understand. Besides, as already seen, and will be again adverted to, the use of steel or other material that would answer the purpose had already been described and claimed in Norton's patent of 1862. We think that any claim in the re-issued patent which can be fairly construed to embrace a blotter made of metal is void, and that the use of such a blotter by the defendant did not afford the patentee or the complainant any just ground of complaint.

In connection with this branch of the subject, it is observable that the patentee has added two new diagrams to his drawings for the purpose of exhibiting and illustrating this new ground of

claim. This fact, though not decisive, is strongly corroborative of the conclusion we have reached on the subject.

The third addition in the reissued patent to the invention described in the original is, that of the process of stamping letters with a postmark and canceling the postage-stamp, at one and the same blow or operation of the instrument, in the manner and by the means described and set forth. Leaving out of view the history of the art prior to the invention claimed by the patentee, what possible pretense can there be for contending that the general process was part of the invention which formed the subject of the original patent? Suppose it be true that Norton was the first inventor of this process, was that process the invention which he sought to secure in the original patent? A patent for a process and a patent for an implement or a machine are very different things. *Powder Co. v. Powder Works*, 98 U. S. 126. Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized rubber patent. But a process, and a machine for applying the process, are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and canceling a postage stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp constructed for performing that process. The claim of the process in the present case, however, is not so broad as this. It is for the process or act of stamping letters with a postmark and canceling the postage-stamp at one and the same blow or operation of the instrument, in the manner and by the means described and set forth. Perhaps this claim amounts to no more than a claim to the exclusive use of the patented instrument or device. If it is anything more, it is for a different invention from that described in the original patent. If it is not for anything more, the question is brought back to the instrument or device itself which forms the subject of the patent and which has been already considered.

The last claim, to-wit: "The employment and combination of a post-marking device with a postage-stamp canceling device, both being operated by one and the same handle for the postmarking of letters, envelopes or packets, and for the cancellation of the postage-stamps thereon with indelible or other ink, in the manner substantially as herein described and set forth," may admit of two constructions. It may either amount to claim for a combination of any kind of device for stamping and blotting, or for a combination of the particular devices described in the patent. Inasmuch as these specified devices, as we have already shown, embrace new devices not described in the original patent, the

claim is too broad in either of its aspects to be advanced in a re-issue of that patent, unless the patentee was really the inventor of the general combination of such devices in a double stamp, and was entitled to add a claim therefor to such reissue. We have seen that his original patent was for a specific blotting device, and for the combination of such specific device with a post-stamping device in the same instrument. Could he, in a reissue of the patent, lawfully make the broad claim of the combination of any and all devices for blotting and post-stamping at one and the same time in one and the same instrument? This would be, it is true, only adding a new claim to his patent, but greatly enlarging its scope and making it to embrace every kind of double stamp that can be conceived. Did he forget to insert this claim in his original patent? Was it admitted through accident or mistake? When we examine his original application, the change it underwent, the careful exclusions as well as inclusions which it contained, and the particularity of the specific combination which he did claim, could he, after the lapse of more than a year (if we take the date of his first application for a reissue as the time for consideration), be allowed to return to the Patent Office and pretend that he had inadvertently omitted the principal claim of the whole thing? If he was, or pretended to be, really the inventor of the entire double stamp, did not the patent, on its face, show that the invention was not secured to him, that it contained no such claim? And was not this omission obvious on inspection? The truth is, that when he made his original application, and got his original patent, all the documents show demonstrably that he did not intend it to embrace any such broad invention. That was not the invention he sought to secure. Having obtained a patent for his specific device and combination, if he afterwards wished to claim the general combination, and had not already abandoned it by taking a narrower patent, he was bound to make a new application for that purpose. Patentees avoid doing this when they can, and seek to embrace additional matters in a reissue, in order to supersede and get possession of the rights which the public, by lapse of time or other cause, have acquired in the meantime. It is for this very reason that the law does not allow them to take a reissue for anything but the same invention described and claimed in the original patent.

But these broad claims in the reissued patent, if construed according to the latitude in which they are expressed, are void by reason of embracing inventions which had been patented both in England and in this country prior to the patentee's application for the original patent.

It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in

a prior one granted to himself, any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well; because he might get a patent for an invention before patented to a third person in this country, if he could show that he was the first and original inventor, and if he should have an interference declared.

Now, a mere inspection of the patents referred to above will show that after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a postmark and canceling stamp at the same time; nor for the general combination of a post-stamper and blotter in one instrument; nor for the combination of a post-stamper and blotter connected by a cross-bar; for all these things, in one or other specific form, were exhibited in these prior patents.

Any such claim, therefore, in the reissued patent of 1870 must be inoperative and void, as well because the thing claimed was anticipated in former patents as because it would be for a different invention from that contained and described in the original patent. We may, therefore, dismiss from consideration the third and fourth claims of the reissued patent. If they are to be construed as being broader and claiming more than the original patent, they are void; if it be construed as claiming nothing more, they are simply redundant, because the first and second claims embrace all that was in the original, and more.

The case, then, upon the patent, is narrowed down to the claim of the specific device of the blotter as described and claimed in the original patent; and the combination thereof with the postmarking device in one instrument by means of the cross-bar. This being the case, it will be pertinent next to inquire whether the defendant used that device or combination. If he did not, it is unnecessary to pursue the subject further.

As we have already seen, the canceling stamp or device, described in the patent, consisted of a cylinder, corresponding in length to the postmarking device, and containing a type of wood, cork, rubber or other elastic material slightly projecting therefrom. It does not appear that this device was ever used by the defendant. The stamp used by him until January, 1876, had a blotter of cork, it is true; but it was not the specific device described in the patent, and to which the patent was restricted. The cork was not inclosed in a cylinder as demanded by the patent. It was a naked piece of cork directly attached to the cross-bar by a common wood screw, passing through a hole in the cross-bar, and driven into the cork, firmly holding it to the bar. This device, of course, was different from that which was patented. The only other stamp used by the defendant had a steel

blotter, connecte. . with the postmarker by a solid metallic plate or mass of metal, and having no cylinder. Neither of these devices infringed the complainant's patent, construed as we consider it must be in order to have any validity at all.

The decree of the Circuit Court is reversed and the cause remanded, with directions to dismiss the bill of complaint.

682. TOPLIFF v. TOPLIFF, 145 U. S. 156, 36 L. ed. 658, 12 Sup. Ct . 825.

* * * Statement by Mr. Justice Brown.

This was a bill in equity for the infringement of three patents, namely: (1) Patent No. 108,085, issued October 11, 1870, to John B. Augur, for an improvement in gearing for wagons; (2) patent No. 123,937, issued February 20, 1872, to Cyrus W. Saladee, for an improvement in carriage springs, and mode of attachment; (3) patent No. 122,079, issued December 19, 1871, to John A. Topliff and George H. Ely, for an improvement in connecting carriage springs, reissued March 28, 1876 (No. 7,017).

The patent to Augur consisted in a mode of equalizing the pressure upon two carriage springs by "connecting together by a rigid rod the two pivoted links upon the clips employed on the hind axle, so that, when the weight is upon one spring, both springs, by reason of the connecting rod, shall be caused to work together, thus preventing the roll." The effect of this device is such that, if a heavy weight is thrown upon one spring, as, for instance, by a person getting into a buggy at one side, the pressure is borne equally by both springs. The claims alleged to be infringed were the following:

"(1) The herein-described method of equalizing the action of springs of vehicles and distributing the weight of the load.

"(2) The combination of the pivoted links with a rod connecting the same, the rod compelling both links to move in unison, as and for the purpose described."

The reissued patent to Topliff and Ely, as stated by the patentees, "relates to side half-elliptic spring vehicles, and has for its object suspending the front and rear ends of the springs directly to the rear axle and front bolster of the running gear by means of two separate connecting rods, the outer ends of which have formed upon them, as a part of the same, and at right angles with the rod, short arms, between which the ends of the springs, respectively, are secured and operated, the connecting rod receiving the rear ends of the springs, being hinged to the rear axle, while the rod receiving the front ends of the springs is, in like manner, connected to the front bolster in such manner that the vibration of the springs will impart a corresponding rotation to the connecting rods front and back, and so that the depression of either spring will, by the rotary action imparted to

the connecting rod, compel a corresponding depression of the other, and thus compel both springs to vibrate together, and move in unison one with the other, equalizing their action and the weight imposed upon them, as well as to prevent side motion to the body of the vehicle."

There were but two claims to this patent, which read as follows:

"(1) The combination of two connecting rods located at the front and rear ends of a wagon body, and arranged to turn in their bearings, with a pair of half-elliptic springs, whereby the springs are caused to yield in unison with each other, substantially as and for the purpose set forth.

"(2) The combination of the connecting rods, BB', provided with arms at their ends, with the half elliptic springs, AA', substantially as and for the purpose set forth." * * *

Mr. Justice Brown, after stating the facts in the foregoing language, delivered the opinion of the court.

As the court below failed to pass upon the Saladee patent in its decree, and as neither party has assigned this omission as error, it is unnecessary to take it into consideration upon this appeal. There are really but two questions involved in this case: (1) The validity of the Augur patent, in view of the state of the art; (2) the validity of the Topliff and Ely reissue. * * *

While it is possible that the Stringfellow and Surles patent might, by a slight modification, be made to perform the function of equalizing the springs which it was the object of the Augur patent to secure, that was evidently not in the mind of the patentees, and the patent is inoperative for that purpose. Their device evidently approached very near the idea of an equalizer; but this idea did not apparently dawn upon them, nor was there anything in their patent which would have suggested it to a mechanic of ordinary intelligence, unless he were examining it for that purpose. It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.

2. The Topliff and Ely patent is claimed to be fully anticipated by the Augur device. In their specification the patentees admit that the connecting rods, placed at right angles across the front and rear of the running gear of vehicles, and hinged to the front bolster and rear axle, are an old device. The better to illustrate the distinction between their own invention and all others pertaining to the use of connecting rods, they cite several

patents, among which is that of Augur, of which they state as follows: * * *

“The radical difference of our invention from each and all the cases above cited is—First, in the construction of the connecting rod, [which is in reality precisely the same as that employed by Augur]; and, secondly, in suspending both ends of the springs upon separate connecting rods, and thus allow both ends of the springs to act freely and in harmony with their vibrating motion, to which is added the other important advantage, viz., that arrangement of connecting rods admits of their application to side spring vehicles of the ordinary kind now in use as readily as to those built expressly for the purpose—an advantage not attained by any other previously-known combination of connecting rods with the springs or bodies of vehicles.” * * *

If this patent differed from the other merely in duplicating the rod and applying it to the front bolster as well as to the rear axle, it is conceded that it would not, under the cases of *Dunbar v. Myers*, 94 U. S. 187, 195, and *Slawson v. Railroad Co.*, 107 U. S. 649, 653, 2 Sup. Ct. 663, involve invention.

But there is a further distinction between the two devices which ought not to be overlooked. Under the Augur patent, the front ends of the springs are supported upon standards rising from the bolster, and the rear ends upon the links of the connecting rod, rising perpendicularly above the rear axle. In other words, the links are turned upward, instead of down. This arrangement would evidently be inoperative if the springs were hung at both ends upon links, so placed, since the body of the vehicle would fall down at once upon the axles. In the *Topliff and Ely* patent, to obviate this, and to enable the device to be applied at both ends of the springs, the links are turned horizontally, or somewhat dependent, so that the springs can rest upon them at both ends, and thus secure a more perfect equalization. Trifling as this deviation seems to be, it renders it possible to adapt the Augur device to any side spring wagon of ordinary construction.

While the question of patentable novelty in this device is by no means free from doubt, we are inclined, in view of the extensive use to which these springs have been put by manufacturers of wagons, to resolve that doubt in favor of the patentees, and sustain the patent.

3. With regard to the reissue of this patent, the record shows that on April 9, 1872—within four months from the date of the original patent—a reissue was granted, in which the specification was largely reframed, the drawings changed in form, though apparently not in substance, but the claim was changed only by providing that the connecting rods should be “secured

directly to the hind axle and front bolster," instead of "to the front and rear axles," as provided in the claim of the original patent. The claim of the original and first reissue are as follows:

Original.

"The arms, CCC'C', arranged upon separate rock rods, BB', secured directly to the front and rear axles, to cause both ends of each spring to yield simultaneously and in unison with each other, and also to be laterally braced by said rock rods, as described."

First Reissue.

"The arms CCC'C', arranged upon separate connecting rods, BB', secured directly to the hind axle and front bolster, to cause both ends of the side springs to yield simultaneously and in unison with each other, in the manner shown and described."

The original claim was, in the particular above mentioned, a clear mistake, since affixing the connecting rod and springs to the front axle would render it impossible to be turned, and, in addition to this, the original drawing shows it affixed to the bolster. The correction of a mistake so clear, made within so short time after the issue of the original patent, was undoubtedly within the power of the commissioner, as defined by Rev. Stat., § 4916. The lateral bracing by the rock rods mentioned in the claim of the original patent was a merely incidental function to the operation of the rock rod in securing the axle to the spring, and their omission can not be considered an enlargement of the claim.

The second reissue was applied for a little more than a month after the first was granted, although the patent was not granted upon this application until March 28, 1876—nearly four years after the application was filed. No change from the first reissue was made in the drawings or specification in this reissue, but the claim was divided and changed so as to read as follows:

"(1) The combination of two connecting rods located at the front and rear ends of a wagon body, and arranged to turn in their bearings, with a pair of half-elliptic springs, whereby the springs are caused to yield in unison with each other, substantially as and for the purpose set forth.

"(2) The combination of the connecting rods, BB', provided with arms at their ends, with the half-elliptic springs, AA', substantially as and for the purpose set forth."

The first claim of this reissue is not insisted upon in this case, so that the question of its validity need not now be considered. The second claim is to some extent a change of the claim of the first reissue. It omits the requirement that the connecting rod

shall be secured directly to the axle and bolster, so as to cause both ends of the side springs to yield simultaneously, and introduces the half-elliptic springs, AA', as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, and, in view of the fact that the reissue was applied for as soon as the mistake was discovered, and before any rights in favor of third parties could be reasonably expected to have attached, or had in fact attached, we think this reissue is not open to the objections which have proved fatal to so many since the case of *Miller v. Brass Co.*, 104 U. S. 350, was decided.

It is a mistake to suppose that that case was intended to settle the principle that, under no circumstances, would a reissue containing a broader claim than the original be supported. We have no desire to modify in any respect the views expressed in that and subsequent cases with regard to the validity of reissues. There is no doubt, as was said by this court in *Powder Co. v. Powder Works*, 98 U. S. 126, 137, 138, that a reissue can only be granted for the same invention which formed the subject for the original patent, of which it is a reissue, since, as was said by the court in that case, the express words of the act are "a new patent for the same invention." "The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must be the same. * * * This prohibition is general, relating to all patents; and by 'new matter' we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others, after its issue."

In the case of *Miller v. Brass Co.*, 104 U. S. 350, a reissue with expanded claims was applied for 15 years after the original patent was granted. It was held to be manifest upon the face of the patent that the suggestion of inadvertence and mistake was a mere pretense, or, if not a pretense, that the mistake was so obvious as to be instantly discernible on the opening of the patent; and the right to have it corrected was abandoned and lost by unreasonable delay. "The only mistake suggested," said Mr. Justice Bradley, "is that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and, if any correction was desired, it should have been applied for immediately." It was intimated in that case (page 352), although the facts did not call for

an adjudication upon the point, that, "if two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim." It was further said that the section of the Revised Statutes does not in terms authorize a reissue to enable a patentee to expand his claim, and that it was natural to conclude that the reissue of a patent for such purposes was not in the mind of congress when it passed the laws in question. "At all events," said the court, (page 354) "we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made when it clearly appears that an actual mistake has inadvertently been made. * * * Now, whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of the opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real, bona fide mistake, inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. * * * The granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void."

So, in the case of *Johnson v. Railroad Co.*, 105 U. S. 539, the patent was issued in 1857, and at the expiration of the original term of 14 years an extension of 7 years was granted, and a reissue was applied for after a lapse of 15 years, and it was held, upon the authority of *Miller v. Brass Co.*, that, if the patentee had the right to a reissue if applied for in a reasonable time, he had lost it by his unreasonable delay. Said the court, speaking by Mr. Justice Woods: "He has rested supinely until the use of the fish plate joint has become universal, and then, after a lapse of fifteen years, has attempted by a reissue to extend his patent to cover it. We think it is perfectly clear that the original patent could not be fairly construed to embrace the device used by the appellee, which appellants insist is covered by their reissue. If the reissued patent covers it, it is broader than the original, and is, therefore, void."

In the case of *Mahn v. Harwood*, 112 U. S. 354, 5 Sup. Ct. 174, and 6 Sup. Ct. 451, a patent reissued nearly four years after the date of the original patent was held to be invalid as to the

new claims, upon the ground of unreasonable delay in applying for it; the only object of the reissue being to enlarge the claims. Nothing was changed but to multiply the claims and make them broader, and this was done, not for the benefit of the original patentee, but for that of his assignee. "It was not intended then," said Mr. Justice Bradley, referring to *Miller v. Brass Co.*, "and is not now, to question the conclusiveness, in suits for infringements of patents, of the decisions of the commissioner on questions of fact necessary to be decided before issuing such patents, except as the statute gives specific defenses in that regard." He repeated substantially what had been said in *Miller v. Brass Co.*—that "a patent for an invention can not lawfully be issued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for a reissue is made within a reasonably short period after the original patent was granted. The granting of such reissues after the lapse of long periods of time is an abuse of power, and is founded on a total misconception of the law." It was held that, while lapses of time might be of small consequence where the original claim was too broad, and the patentee sought to restrict it, there were substantial reasons why the claim could not be enlarged unless the patentee used due diligence to ascertain his mistake. "The rights of the public here intervene, which are totally inconsistent with such tardy reissues; and the great opportunity and temptation to commit fraud after any considerable lapse of time, when the circumstances of the original application have passed out of mind, and the monopoly has proved to be of great value, make it imperative on the courts, as a dictate of justice and public policy, to hold the patentees strictly to the rule of reasonable diligence in making applications for this kind of reissues." It was further held that, while it was for the commissioner of patents to determine the question of inadvertence, accident, or mistake, the question of reasonable time was one which the court could determine as one of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception.

In speaking of the case of *Miller v. Brass Co.*, Mr. Justice Bradley observed: "We suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case."

In the large number of cases which have come up to this court since that of *Mahn v. Harwood* was decided, in which re-

issues have been held to be invalid, it will be found that the opinion of the court was put upon the ground either that the patentee had been guilty of inexcusable laches—usually of from 4 to 16 years—or that circumstances had occurred since the granting of the original patent which made the reissue operate harshly or unjustly to the defendant in the case.

Thus, in *Mathews v. Machine Co.*, 105 U. S. 54, there was a delay of 14 years; in *Bantz v. Frantz*, 105 U. S. 160, a delay of 14 years and 6 months; in *Wing v. Anthony*, 106 U. S. 142, 1 Sup. Ct. 93, of over 5 years; in *Moffitt v. Rogers*, 106 U. S. 423, of 2 years and 7 months; in *Gage v. Herring*, 107 U. S. 640, 2 Sup. Ct. 819, of 14 years; in *Clements v. Odorless Apparatus Co.*, 109 U. S. 641, 3 Sup. Ct. 525, of nearly 5 years; in *McMurray v. Malloy*, 111 U. S. 97, 4 Sup. Ct. 375, of 9 years; in *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, of 5 years. In *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 87, 8 Sup. Ct. 38, there was a delay of 1 year and 8 months, but it appeared that the improvements not covered by the original patent had been brought into use by others than the patentee before the reissue was applied for. In *Coon v. Wilson*, 113 U. S. 268, 5 Sup. Ct. 537, a reissue was applied for only a little over three months after the original patent was granted; but the patentee waited until the defendants produced their device, and then applied for such enlarged claims as to embrace this device, which was not covered by the claim of the original patent, and it was apparent from a comparison of the two patents that the application for a reissue was made merely to enlarge the scope of the original. In *Wollensak v. Reiher*, 115 U. S. 96, 5 Sup. Ct. 1137, there was a delay of more than five years, Mr. Justice Matthews observing that “the settled rule of decision is that, if it appears, in cases where the claim is merely expanded, that the delay has been for two years or more, it is adjudged to invalidate the reissue, unless the delay is accounted for and excused by special circumstances, which show it to have been not unreasonable.” In the very latest case decided by this court, viz., *Electric Gas-Lighting Co. v. Boston Electric Co.*, 139 U. S. 481, 11 Sup. Ct. 586, there was a delay of 8½ years, and the sole object of the reissue was to expand the claims. In *Newton v. Furst & B. Co.*, 119 U. S. 373, 7 Sup. Ct. 369, there was a delay of more than 13 years, and the defendant had begun in the meantime to make machines of the pattern complained of. In *Ives v. Sargent*, 119 U. S. 652, 7 Sup. Ct. 436, there was a delay of 3 years, and in the meantime the patent was infringed by a construction manufactured and sold without infringing the patent as originally granted. In *Worden v. Searls*, 121 U. S. 14, 7 Sup. Ct. 814, there was a delay of 6 years; and in *Mathews v. Manufacturing Co.*, 124 U. S. 347, 8 Sup. Ct. 639, one of 7 years.

From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.

Second. That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

Third. That this court will not review the decision of the commissioner upon the question of inadvertence, accident, or mistake, unless the matter is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all, such cases, a question of law for the court.

To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy; and, in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake, and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they

have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation. The evidence in this case shows that plaintiffs were conceded by manufacturers a monopoly of this invention; that defendant was the only one who had infringed their patents; and that he did not begin to manufacture the infringing device until 1882—six years after the second reissue was granted. In view of this and the fact that the second reissue was applied for within 5 months from the time the original patent was granted, and within 37 days after the first reissue, and that it covers no more than the actual invention of the patentee, so far as the same is an improvement upon the Augur patent, we think it should be upheld.

683. *IN RE HERAULT*, 29 App. Cas. D. C. 42, 127 O. G. 3217 (1907).
Shepard, J.:

This is an appeal from the decision of the Commissioner of Patents rejecting an application for the reissue of a patent.

The applicant is a citizen of the Republic of France, and a skilled metallurgist. Having invented a new electrical process for obtaining soft metals, consisting of substances which tend to combine with carbon, through the avoidance of the introduction of carbon from the electrode used therein, and a furnace to carry out said process, the applicant obtained a patent therefor in France. Being then in one of the provincial towns, the inventor instructed an attorney in Paris to secure patents for his invention in other countries. Pursuant thereto an application containing the description of the French patent was filed in the United States patent office. The patent issued in due course with the following single claim:

“5. In an electric furnace, the combination of a crucible adapted to carry a bath of molten material, two electrodes supported above it and connected in series, a conductor in position to effect contact with material contained in the crucible, and a voltmeter in shunt between one of said electrodes and said conductor, said conductor consisting of a rod passing through the refractory material of the crucible and projecting outside and inside of the same whereby the portion of the rod which is melted is replaced by molten material which fills up the space and thus insures good conductivity.”

Having discovered that his process was not protected by the patent so obtained, the inventor, something more than two years after his patent issued, filed the present application for reissue, presenting five claims, the fifth one of which is the claim above set out as contained in the patent. The other four claims are the following:

"1. In the manufacture of soft metals such as chromium, manganese or iron by means of an electric furnace, the method which consists in playing two separate arcs in series through an insulating layer of slag between the metal on the one hand, and the two carbon electrodes on the other hand.

"2. In the manufacture of metals having a strong affinity for carbon, such as chromium, manganese, iron or the like, by means of an electric furnace with carbon electrodes, the method which consists in submitting the charge to the heat of electric arcs between the electrodes and the metal itself, and regulating the arcs so as to avoid contact of the electrodes with the metal.

"3. In the manufacture of metals having a strong affinity for carbon, such as chromium, manganese, iron or the like, by means of an electric furnace with carbon electrodes, the method which consists in passing the current from one electrode into and through the metal, thence through another electrode, and regulating the position of each electrode separately, so as to avoid contact thereof with the metal.

"4. In the manufacture of metals having a strong affinity for carbon, such as chromium, manganese, iron, or the like, by means of an electric furnace with carbon electrodes, the method which consists in maintaining a layer of non-conducting slag between the end of an electrode and the molten metal, so as to avoid the combining of the carbon of the electrode with the metal."

In the affidavit accompanying the application the applicant said,

"that the letters-patent are inoperative for the reason that the specification thereof is defective and insufficient, and that such defect or insufficiency consists particularly in the failure of the claim to describe applicant's real invention; and deponent further says that the error which renders such patent so inoperative arose from inadvertence, accident or mistake, and not in fraudulent or deceptive intention on the part of the deponent."

Under the French system a patent is construed to cover whatever of novelty is described in the specification. The affidavit recites that the applicant was ignorant of the difference between the French patent law and that of the United States, and believed that being the first to disclose the real invention his patent would secure to him whatever was new in the same as described. That visiting the United States and discussing his patent with his present New York attorneys, he learned for the first time of the practical inoperativeness of his patent, and was advised that he might apply for reissue to correct the insufficiency. That he was familiar with the state of the industry in the United States; and that to the best of his knowledge and belief his real invention as now claimed has not been in use therein up to the

present time. This statement in respect of his previous knowledge and belief as to the protection of his patent, and of the advice given him by his American counsel, was supported by the affidavit of one of them.

It is apparent that the patent as issued is of little or no practical value; and there is no question but that the process is both novel and valuable. This is shown in recent publications, by writers of established standing in Europe and America, to which our attention has been called. These show also that the process has been largely applied by the inventor and his licensees, or assignees. The statement of the invention in the specifications of the French and American patents contains a particular description of the process from which any one skilled in the art could utilize the invention. They also describe the apparatus of the claim of the latter patent, as used in the process. The process is first described, and then it is said: "such is the principle of the invention which is carried out," in the apparatus immediately after described.

So thoroughly was the process described that the description was copied verbatim in the reissue application. In view of the established skill and learning of the applicant, in the art, and from all the facts and circumstances disclosed, we think it apparent that he considered the process as the real or main invention, and that his failure to make specific claims therefor was due to inadvertence, accident, or mistake. It is unnecessary to discuss the facts as to diligence in applying for the reissue, as that has been conceded by the tribunals of the office. It is sufficient to say that the applicant acted without unnecessary delay; and there was no intervening claim.

The grounds of the Primary Examiner's decision are stated, as follows:

"Claims 1 to 4 inclusive are for a process of making metals in an electric furnace, in which the apparatus may differ widely from the specific structure covered by claim 5. The process of these claims was fully disclosed in the original specifications. No anticipatory references are known for these method claims, and it is generally conceded, in the art to which this application relates, that the present applicant is the inventor of the process claimed. The sole ground for rejection from which the appeal is taken is that the method of making metals is a different invention from the furnace which forms the subject-matter of the original claim, and that neither the patent nor the correspondence in the case contains a suggestion that the process of claims 1 to 4 was a part of applicant's invention."

As indicated above, we can not agree that the description of the patent contains no suggestion that the process of claims 1 to

4' was a part of applicant's invention. If, as declared, "the process of these claims was fully disclosed in the original specification," and was novel, they would either have been allowed if set out along with the claim made, or a divisional application required under Rule 41, as then in force. Having disclosed the process, the failure to claim was either intentional, or the result of inadvertence, accident or mistake for which § 4916 Revised Statutes furnishes a remedy.

The Examiners-in-Chief in affirming that decision on appeal, did so on the ground that a reissue can only be granted for the same issue as the original patent, and say:

"The only thing claimed in the original patent was the furnace itself. While the applicant, being a foreigner, may have been mistaken as to the scope of his patent when granted, he was not acting without the advice of competent counsel. It is hardly to be believed that they applied for and took out a patent for the furnace when they intended to apply for a patent for the process."

The question is, however, was this omission to make claims covering the novel process disclosed in the application, the result of inadvertence, mistake or accident. Applicants usually act through solicitors or attorneys, and their inadvertence, accidents and mistakes, if such in fact, are remediable under the statute permitting the reissue, when it is clear that there is no fraudulent or deceptive intent, or attempt to destroy an intervening right. (In *re Briede*, 123 O. G., 322, 27 App. Cas. D. C. 298, 301.)

The Commissioner, who in turn affirmed the decision of the Examiners-in-Chief, stated the grounds of his decision as follows:

"These claims have been refused on the ground that they cover a different invention from that of the patent.

"It is contended by appellant that a reissue may be granted for subject-matter which was intended to be claimed in the original patent. The intention to claim the process is alleged to be shown in the present case by the fact that the process covered by claims 1, 2, 3 and 4 is described in the patent. It is stated that the applicant, being a foreigner, was of the impression that the description in a patent determined its scope, and that, therefore, the patent as granted covered the process described. Having discovered that the patent did not cover the process described, patentee now comes asking for a reissued patent with claims to the process.

"The question of whether there was an intention to claim the process in the original patent does not appear to have any material bearing on the present case. It is clear that the claim of the

patent was for a machine, and it is well established that a patent for a machine will not sustain a reissue for a process."

Assuming, then, that the invention of the process was fully described in the original application; that it was the original intention of the applicant to secure protection for his entire invention through a patent; and that the failure to do so through specific claims was the result of inadvertence, accident, or mistake; is it true that the patent limited in claim to a machine will not sustain a reissue for the process? The Commissioner's conclusion that it will not, is rested upon the cases of *James v. Campbell*, 21 O. G. 67, 104 U. S. 356, 26 L. ed. 786; *Heald v. Rice*, 21 O. G. 215, 104 U. S. 737, 26 L. ed. 910; and several others referring to them. We do not understand those decisions as establishing such an invariable rule. In *James v. Campbell* the patent, held void on all points involved, was a second reissue in 1870 of a patent granted in 1863. The invention was declared to be a very narrow one, and the two claims of the original patent were for specific machines. The application for the last reissue made many changes in the specifications, materially enlarging them and the apparatus claims, and adding a new claim for the process. The court expressly declared that an inspection of former patents showed that the process could not be lawfully patented because anticipated. In regard to this process it was also said:

"Leaving out of view the history of the art prior to the invention claimed by the patentee, what possible pretense can there be for contending that the general process was part of the invention which formed the subject of the original patent? Suppose it to be true that Norton was the first inventor of this process, was that process the invention which he sought to secure in the original patent? A patent for a process and a patent for an implement or a machine are very different things. (*Powder Co. v. Powder Works*, Vol. 15 O. G. 289, 98 U. S. 126, 25 L. ed 77.) Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized-rubber patent. But a process, and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and canceling a postage-stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp for performing the process. The claim of the process in the present case, however, is not so broad as this. It is for the process or act of stamping letters with a postmark and cancelling the postage-stamp at one and the same blow or oper-

ation of the instrument, in the manner and by the means described and set forth. Perhaps this claim amounts to no more than a claim to the exclusive use of the patented instrument or device. If it is anything more, it is for a different instrument from that described in the original patent. If it is not for anything more, the question is brought back to the instrument or device itself which forms the subject of the patent, and which has been already considered."

In *Heald v. Rice*, the application for the reissued patent contained material changes in the description. These having been stated, the court said:

"It appears, then, from the reading of the two specifications, that the invention described in the first is for the return-flue boiler; while that described in the second abandoning the claim for the boiler itself, is for a particular mode of using it, with straw as a fuel, by means of an attachment to the furnace-door for that purpose. It might well be that Rice was entitled to patents for both, separately, or to one for both inventions. But it is too plain for argument that they are perfectly distinct. A patent, consequently, for one can not lawfully be surrendered as the basis for a reissue for the other. They are as essentially diverse as a patent for a process and a compound, as in the case of *Powder Co. v. Powder Works*, 15 O. G. 289, 98 U. S. 126, 25 L. ed. 77, where the reissue patent was avoided, although the original application claimed the invention both of the process and the compound. The case comes directly within the principle held in *James v. Campbell*, that a patent for a machine can not be reissued for the purpose of operating that class of machines; because if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention."

It is to be observed that in *James v. Campbell* the court did not say that a process, and a machine for applying the process, are always distinct and different, but "generally distinct and different."

A rule of the patent office has long provided that two or more independent inventions can not be claimed in one application; and in conformity with the doctrine thought to have been established in the foregoing cases, a specific provision was added thereto, that:

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications."

(Rule 41 recently amended by striking out the above quoted). The question has recently been re-examined by the Supreme Court of the United States, and the power to make a hard and

fast rule of the kind denied. (*Steinmetz v. Allen*, 192 U. S. 543, 24 Sup. Ct. 416.) It was said that inventions may be so connected or related, as to constitute substantially one invention.

"They may be completely independent. (*Cochrane v. Deener*, 94 U. S. 780.) But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such case the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it. There is an illustration in the Telephone Cases, 43 O. G. 377, 126 U. S. 1."

Stating the claim in that case as referring to the art described, as well as the means of making it useful, the opinion was quoted from as follows:

"Other inventors may compete with him for the ways of giving effect to the discovery, but the new art he has found will belong to him during the life of his patent. * * * The patent for the art does not necessarily involve a patent for the particular means employed for using it. Indeed, the mention of any means, in the specification or descriptive portion of the patent, is only necessary to show that the art can be used; for it is only the useful arts—arts which may be used to an advantage—that can be made the subject of a patent."

Of *James v. Campbell*, the court said that—

"was a case of reissued patent, and by express provision of the statute as to reissued patents no new matter can be introduced in them. In other words, the reissue is to perfect, not to enlarge the invention. Whether the principle of the case applies to related as well as independent inventions is not clear from its language."

After quoting several passages from the opinion in that case, the following language was used:

"The case, however, indicates what embarrassment and peril of rights may be caused by a hard and fixed rule regarding the separation of related inventions."

Whatever the doctrine of those earlier cases, a more liberal rule has since prevailed in respect of the right of reissue. (*Eames v. Andrews*, 39 O. G. 1319, 122 U. S. 40, 59; *Topliff v. Topliff*, 59 O. G. 1257, 145 U. S. 156, 171, 36 L. ed. 658; *Hobbs v. Beach*, 94 O. G. 2357, 180 U. S. 383, 394, 45 L. ed. 586.)

In *Eames v. Andrews* the court said:

"If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, and thus cause the patent to include an invention not within the original, the rights of the public are

not thereby narrowed, and the case is within the remedy intended by the statute."

Topliff v. Topliff, supra, is a leading and most instructive case on this point. After reviewing very many of the former decisions, beginning with *Powder Co. v. Powder Works*, 15 O. G. 289, 98 U. S. 126, it was said by Mr. Justice Brown, who delivered the opinion:

"From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications."

After stating these to be, first, that it shall be for the same invention as the original patent, and that diligence must be exercised, and is ordinarily determined by the lapse of two years, he proceeded to say:

"To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."

The doctrine of that case was applied by this court in the recent case of *in re Briede*, 123 O. G. 322, 27 App. D. C. 298, 302,

306. In this case as in that, no new matter was contained in the specification, and the applicant applied promptly for reissue. The statement of the invention in the original application, followed without change in the reissue application, shows that the process and the apparatus are connected in their design and operation, and are so related as to entitle the applicant to claims for both within the rule declared in *Steinmetz v. Allen*, supra. In the language of that case, the process is "the dominant thing." Consequently, as was said in the case of *in re Briede*, supra:

"Had the claim in controversy been submitted while the application for the original patent was pending, we can not believe that it would have been refused as not being for the same invention as that described and shown. Rather, we think, the Office approached its consideration with the idea that it was an unwarranted attempt to obtain a broadened claim by means of a reissue, and with the mistaken idea that such a reissue was not permissible. The construction placed upon the patent statutes by the courts is favorable toward inventors having meritorious inventions, and they do not put upon them harsh or technical interpretations. They do not look with favor upon the refinements of division which lead to many patents being issued for various improvements incorporated in a single device. They are inclined to resolve all doubts to as whether more than one invention is embraced in one patent in favor of the patentee."

Whatever of doubt there may be whether the reissue in this case is for the same invention described in the original patent, and under all the circumstances allowable, should, we think, following the ordinary practice of the patent office, be resolved in favor of the inventor of a meritorious invention, especially when it is now too late to file an independent application for a patent for the same. No absolute right of property is conferred by the grant of the patent. The patentee is merely put in position to assert his prima facie right in case of infringement, and have the same adjudicated in a course where extrinsic evidence, if important, may be heard; and not confined, as is this court, to a review of the decisions of the patent office upon the record as made up therein. (*In re Thompson*, 26 App. D. C. 426, 429; *Seymour v. Osborne*, 11 Wall. 516, 544; *Parker & Whipple Co. v. Yale Clock Co.*, 41 O. G. 811, 123 U. S. 87, 98.)

Our conclusion is that there was error in refusing the reissue application, and the decision must be reversed. It is so ordered, and that this decision be certified to the Commissioner of Patents. Reversed.

684. *McCORMICK HARVESTING MACH. CO. v. AULTMAN*, 169 U. S. 606, 42 L. ed. 875 (1898).* * *

Mr. Justice Brown delivered the opinion of the court.

The validity of the claims in question depends upon the view taken of the action of the examiner in rejecting them when incorporated in an application for a reissue of the patent, upon the ground that the claims were wanting in patentable novelty, as evidenced by prior patents cited by him. No appeal was taken from this decision, and the matter lay in abeyance for nearly two years before the plaintiff corporation, which had in the meantime become the owner of the patent, abandoned the application for a reissue and requested and obtained from the patent office the return of the original patent.

It has been settled by repeated decisions of this court that when a patent has received the signature of the Secretary of the Interior, countersigned by the Commissioner of Patents, and has had affixed to it the seal of the patent office, it has passed beyond the control and jurisdiction of that office, and is not subject to be revoked or canceled by the president, or any other officer of the government. (*United States v. Schurz*, 102 U. S. 378; *United States v. Am. Bell Telephone Co.*, 45 O. G. 1311, 128 U. S. 315, 363.) It has become the property of the patentee, and as such is entitled to the same legal protection as other property. (*Seymour v. Osborne*, 11 Wall. 516; *Cammeyer v. Newton*, 11 O. G. 287, 94 U. S. 225; *United States v. Palmer*, 128 U. S. 262, 271, citing *James v. Campbell*, 21 O. G. 337, 104 U. S. 356.)

The only authority competent to set a patent aside, or to annul it, or to correct it for any reason whatever, is vested in the courts of the United States, and not in the Department which issued the patent. (*Moore v. Robbins*, 96 U. S. 530, 533; *United States v. Am. Bell Telephone Co.*, 45 O. G. 1311, 128 U. S. 315, 364; *Michigan Land and Lumber Co. v. Rust*, 168 U. S. 589, 593.) And in this respect a patent for an invention stands in the same position and is subject to the same limitations as a patent for a grant of lands. The power to issue either one of these patents comes from Congress and is vested in the same department. In the case of a patent for lands it has been held that when one has obtained a patent from the government he can not be called upon to answer in regard to that patent before the officers of the Land Department, and that the only way his title can be impeached is by suit in equity. (*United States v. Stone*, 2 Wall. 525, 535; *Iron Silver Mining Co. v. Campbell*, 135 U. S. 286; *Noble v. Union River Logging Co.*, 147 U. S. 165.) But a suit may be maintained by the United States to set aside a patent for lands improperly issued by the government on the ground of mistake, or fraud; but only in the case where the government has a direct interest, or is under

obligation respecting the relief invoked. (United States v. Mo., K. & T. R. R. Co., 141 U. S. 358.)

While a patent for a grant of lands is absolutely free from the future control of the officers of the Land Department after it has once issued, and jurisdiction over the matter can not again be obtained, this is subject to a single qualification in the case of a patent for an invention where the patentee, his legal representatives or assigns, find the original patent inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new (provided the error has arisen through inadvertence, accident or mistake, and without fraudulent or deceptive intention.) In such case a reissue will be granted by the Commissioner upon the surrender of the patent, but such surrender takes effect only upon the issue of the amended patent. This provision is embodied in Revised Statutes, § 4916, which also declares that—
“the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications, * * * but no new matter shall be introduced into the specifications.”

The plain purpose of this section is to give the patentee an opportunity to make valid and operative that which was before invalid and inoperative; invalid, because it claimed as new that which had been previously invented or used by the public; inoperative, because the specification was defective or insufficient. New matter can not be introduced, nor can the scope of the invention be enlarged. All that the applicant can do is to so amend his patent as to enable him to receive some practical and beneficial result from his actual invention, of which he has been deprived by defects or omissions in the original patent. The object of a patentee applying for a reissue is not to reopen the question of the validity of the original patent but to rectify any error which may have been found to have arisen from his inadvertence or mistake. But until the amended patent shall have been issued the original stands precisely as if a reissue had never been applied for (Allen v. Culp, 79 O. G. 1523, 166 U. S. 501, 505), and must be returned to the owner upon demand. The fact that the rules of the patent office require that the original patent should be placed in its custody for the purpose of surrendering it upon the issue of an amended patent gives that department no right to the possession of it upon the rejection of the application for a reissue. If the patentee abandoned his application for a reissue, he is entitled to a return of his original patent precisely as it stood when such application was made, and the patent office has

no greater authority to mutilate it by rejecting any of its claims than it has to cancel the entire patent.

In *Peck v. Collins*, 19 O. G. 1137, 103 U. S. 660, an application for reissue made under the laws in force in 1866 was held to absolutely extinguish the original patent. Subsequent to that time the law of 1870, of which Revised Statutes, § 4916, forms a part, was passed. Mr. Justice Bradley, in discussing the clause in that section which declares that the surrender "shall take effect upon the issue of the amended patent," said:

"What may be the effect of this provision in cases where a reissue is refused it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a reissue is refused on some formal or other ground which does not affect the original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue."

This same question was considered but not decided in *Eby v. King*, 71 O. G. 1454, 158 U. S. 366; and in *Allen v. Culp*, 79 O. G. 1523, 166 U. S. 501, 505, it was held that if the original application for a reissue be rejected the original patent stands precisely as though a reissue had never been applied for; but the effect of the refusal of the reissue upon some ground equally affecting the original patent was not considered.

In neither of these cases was this court called upon to decide the question which has been certified, and the expression of opinion in *Peck v. Collins*, relied upon by the defendants, must be considered merely a dictum, and lacking the force of a judicial determination.

In the case under consideration the Examiner acted upon the application as if it were a new proceeding, and dealt with it as the evidence before him seemed to warrant, but his action in rejecting some of the claims which had been repeated from the original patent did not affect that patent. It is true that it was within his power to reject any claims contained in the application for a reissue which he judged to be invalid, whether contained in the original patent or not. It is also true that the reasons given for the rejection of such claims might apply equally to the same claims contained in the original patent; but with respect to such claims he was *functus officio*. His opinion thereon was but his personal opinion, and however persuasive it might be, did not oust the jurisdiction of any court to which the owner might apply for an adjudication of his rights, and as the Examiner had no authority to affect the claims of the original patent, no appeal was necessary from his decision.

Had the original patent been procured by fraud or deception it would have been the duty of the Commissioner of Patents to have had the matter referred to the Attorney-General with the recommendation that a suit be instituted to cancel the patent; but to attempt to cancel a patent upon an application for reissue when the first patent is considered invalid by the Examiner would be to deprive the applicant of his property without due process of law, and would be in fact an invasion of the judicial branch of the government by the executive.

Our conclusion upon the whole case is that, upon the issue of the original patent, the Patent Office had no power to revoke, cancel or annul it. It had lost jurisdiction over it, and did not regain such jurisdiction by the application for a reissue. Upon application being made for such reissue the Patent Office was authorized to deal with all its claims, the originals as well as those inserted first in the application, and might declare them to be invalid, but such action would not affect the claims of the original patent, which remained in full force, if the application for a reissue were rejected or abandoned.

The validity of the claims, so far as their merits are concerned, has been sustained by the Circuit Court of Appeals, and, as the original patent must stand precisely as though a reissue had never been applied for, the question certified to this Court must be answered in the negative.

685. CHICAGO RY. EQUIPMENT CO. v. PERRY SIDE BEARING CO.,
170 Fed. 968 (1909, C. C. Illinois. Reissue patent No. 11,611,
affirmed on reissue question 101 C. C. A. 433, 178 Fed. 449).

Kohlsaat, J.: * * *

It will be observed that 23 months intervened the grant of letters patent in No. 533,763 and the application for a reissue thereof. The record discloses no question of intervening rights, nor of equitable estoppel, the presence of which seems to have generally been deemed a matter to be considered, especially with reference to laches, although it was held in *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, 30 L. ed. 303, that:

“The existence of intervening rights adds nothing to the illegality of a reissue which has been expanded to cover more than the original patent sought to cover. That is deduced from general principles of law as applied to the statutes authorizing reissues and affecting the rights of the government and the public.”

It seems to have been with some reluctance that the courts have construed the reissue statute so as to permit the enlargement of claims. Rev. Stat. § 4916 (U. S. Comp. St. 1901, p. 3393), provides for a reissue of a new patent for the same in-

vention (1) whenever any patent is inoperative or invalid by reason of a defective or insufficient specification; (2) or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

In *Miller v. Brass Co.*, 104 U. S. 350, 26 L. ed. 783, the court, reasoning from the history of the statute, says:

“It is natural to conclude that the reissue for the latter purpose [making a claim broader] was not in the mind of Congress when it passed the law in question.”

Discussing the subject further, the court says:

“But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims.”

In *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. ed. 658, the court reviewed *Miller v. Brass Co.*, and said:

“It is a mistake to suppose that that case was intended to settle the principle that under no circumstances would a reissue containing a broader claim than the original be supported. We have no desire to modify in any respect the views expressed in that and subsequent cases with regard to the validity of reissues.”

In *Freeman v. Asmus*, 145 U. S. 226, 12 Sup. Ct. 939, 36 L. ed. 685, it was sought by reissue—

“To construe the first claim so as to cover any kind of a blast furnace with a closed breast, having a slag discharge-opening cooled in any way, or to any extent, by water. There is nothing in the original specification which indicates that any such claim was intended to be made in the original patent. On the contrary, the whole purport of that specification shows that it was intended to claim only a slag discharge-piece or cinder-block constructed and attached in a specific manner.”

The court held that the reissue was not for the same invention as the original patent, and that:

“There is nothing inconsistent with the foregoing views in our decision in *Topliff v. Topliff*.”

From these and other decisions, it seems clear that the burden of showing mistake is upon the applicant in all cases involving the broadening of a claim, and must be plainly established. There is a line of cases holding that the grant of the reissue patent constitutes a *prima facie* presumption of its validity. *Walker on Patents* (4th Ed.) § 492; *Clark v. Wooster*, 119 U. S. 326, 7 Sup. Ct. 217, 30 L. ed. 392; *Whitcomb v. Coal Co.* (C. C.) 47 Fed. 655.

In *Topliff v. Topliff* it is said that the court will not review the decision of the Commissioner as to inadvertence, accident, or mistake, "unless the matter is manifest from the record." This language is repeated in substance in *Hobbs v. Beach*, 180 U. S. 395, 21 Sup. Ct. 409, 45 L. ed. 586, and may be deemed to express the final conclusion of the Supreme Court in the subject; so that, notwithstanding the burden which is cast upon the complainant to maintain his allegation of accident and mistake in this cause, the defendants must take the onus of showing that the facts of record do not sustain the presumption arising from the grant—which is no greater than that arising from any grant of a patent. * * *

It can hardly be claimed that the original patent was not a complete device. It was operative, just as completely as that of the reissue patent. For all that Wands was seeking, it was in itself a finished side-bearing arrangement. Later he thought he could just as well claim the resilient centering device and make it apply to every anti-friction side bearing which is centered by a spring. Undoubtedly he made the mistake of not claiming the larger invention, if it be such, in his first application; but this is not the mistake the statute and the courts have in mind. In *Campbell v. James*, 104 U. S. 356, 26 L. ed. 786:

"When a patent fully and clearly, without ambiguity or obscurity, describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim, so as to make it embrace an invention not described and specified in the original."

Approving the language of Justice Grier in *Burr v. Duryee*, 1 Wall. 531, 17 L. ed. 650, in which the court says:

"The surrender of valid patents and the granting of reissued patents thereon, with expanded or equivocal claims, when the original was clearly neither inoperative nor invalid, and which specification is neither defective nor insufficient, is a great abuse of the privilege granted by the statute and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other invention."

In *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 42, 14 Sup. Ct. 30, 37 L. ed. 989, it appears that the reissue was made, among other things, to cover a device containing one element, a mortise, not claimed in the original and surrendered patent. The court says this "clearly operated to broaden and

expand the original claim," and holds the reissue unwarranted. Says the court:

"It is settled by the authorities that, to warrant new and broader claims in a reissue, such claims must not be merely suggested or indicated in the original specification, drawings, or models; but it must further appear from the original patent that they constitute parts or portions of the inventions which were intended or sought to be covered or secured by such original patent."

In *Hobbs v. Beach*, 180 U. S. 394, 21 Sup. Ct. 414, 45 L. ed. 586, the reissue patent was attacked upon the ground that the original patent was neither inoperative nor invalid by reason of any defective or insufficient specification. The reissue had been applied for only a few weeks after the original issue, and, as the court says, "was issued merely to correct, as it would seem, an obvious error in one of the drawings." The court holds that:

"To justify a reissue it is not necessary that the patent should be wholly inoperative or invalid. It is sufficient if it fail to secure to the patentee all of that which he has invented and claimed."

In *Huber v. Nelson*, 148 U. S. 270, 13 Sup. Ct. 603, 37 L. ed. 447, the court held the reissue invalid because it left out one of the elements of the original claim, to wit, a flushing chamber. Says the court:

"We think that, on all the facts of this case, no one of the claims of the reissue can be construed as valid in leaving out the flushing chamber as an element of the combination, inasmuch as every claim of the original patent contained it."

It was further held in this case:

"That the failure to claim the particular combination not claimed in the original patent, but claimed in the reissue, was not due to any such inadvertence or mistake as would authorize the claiming of it in the reissue, and that the failure to claim such combination originally occurred under such circumstances and was accompanied with such full knowledge of all material facts as to amount to an abandonment of that particular combination to the public."

This was reviewed and approved in *Olin v. Timken*, 155 U. S. 141, 15 Sup. Ct. 49, 39 L. ed. 100.

An examination of the foregoing cases, and a large number of other cases decided by the Supreme Court, and by the various Courts of Appeal and Circuit Courts, leads plainly to the conclusion so well stated by Judge Coxe in *Carpenter Straw Sewing Machine Co. v. Searle*, 52 Fed. 809, 814, and approved by the Court of Appeals in 60 Fed. 82, 8 C. C. A. 476, viz.:

"That unless the court can find that the invention of the reissue is described as the invention in the original, and that the patentee intended to secure it as his invention in the original, the reissue is invalid. It is not for the same invention." * * *

It seems incredible that a man of sufficient intelligence to invent the device of the original patent could fail to discover at once that his patent did not purport to secure to him a monopoly of the combination of movable anti-friction side bearing for railway cars of every kind with centering springs. Under the circumstances, the delay of 23 months seems wholly unaccounted for.

In *Ives v. Sargent*, 119 U. S. 661, 7 Sup. Ct. 436, 30 L. ed. 544, Mr. Justice Matthews quotes with approval the language of the court in *Wollensak v. Reiber*, 115 U. S. 96, 99, 5 Sup. Ct. 1137, 1139, 29 L. ed. 350, as follows, viz.:

"It follows from this that if, at the date of the issue of the original patent, the patentee had been conscious of the nature and extent of his invention, an inspection of the patent, when issued, and an examination of its terms, made with that reasonable degree of care which is habitual to and expected of men in the management of their own interests in the ordinary affairs of life, would have immediately informed him that the patent had failed fully to cover the area of his invention; and this must be deemed to be notice to him of the fact, for the law imputes knowledge when opportunity and interest, combined with reasonable care, would necessarily impart it."

He also cites and approves the following language in *Mahn v. Harwood*, 112 U. S. 354, 5 Sup. Ct. 174, 28 L. ed. 665, viz.:

"If a patentee had not claimed as much as he is entitled to claim, he is bound to discover the fact in a reasonable time, or he loses all his right to a reissue; and if the Commissioner of Patents, after the lapse of such reasonable time, undertakes to grant a reissue for the purpose of correcting the supposed mistake, he exceeds his power and acts under a mistaken view of the law. The court, seeing this, has a right, and it is its duty, to declare the reissue *pro tanto* void in any suit founded upon it."

In the same case it is held that the time fixed by law with regard to public use, two years, might be deemed to be such a delay as to defeat the reissue. Here something less than two years had elapsed; but it is not the rule that two years must intervene. The circumstances of each case must control. *Freeman v. Asmus*, 145 U. S. 226, 12 Sup. Ct. 939, 36 L. ed. 685. Under the facts of this case, even though an arbitrary period of two years had not intervened, yet there was unpardonable delay. It would seem to constitute practically indisputable evidence of what otherwise appears to be the fact; i. e., that Wands had

no intention of claiming the spring broadly, with any movable anti-friction side bearing, as an invention at the time of filing his application. * * *

It is apparent that the claims of the reissue patent here in suit are broader than the specification. This latter limits the invention to movable roller anti-friction bearings. Claims 4 and 5 in terms, and claim 6 in effect, cover any movable anti-friction device. It is held in *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, 30 L. ed. 303, that the specification cannot be resorted to for the purpose of changing the claim and making it different from what it is. Nor can a patentee, who had claimed either more or less than was necessary, in a suit for infringement be relieved from the consequences. *McClain v. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. ed. 800. Our own Court of Appeals, in *Anderson Foundry & Machine Co. v. Potts*, 108 Fed. 379, 47 C. C. A. 409, has said:

“The true rule seems to be stated in *McCarty v. Railroad Co.*, 160 U. S. 110, 116, 16 Sup. Ct. 240, 40 L. ed. 358; * * * ‘It is not permissible to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement.’”

So these claims must stand the ordeal of the prior art in this proceeding just as they read, independently of the specifications and of the other claims of the patent. *Wilson v. McCormick Harvester Mach. Co.*, 92 Fed. 167, 34 C. C. A. 280; *Penfield v. Potts & Co.*, 126 Fed. 475, 61 C. C. A. 371. * * *

Counsel for complainant has devoted much of his argument to the contention that defendant Henry D. Laughlin is personally responsible for the acts of the Perry Side Bearing Company. This is charged in the bill and not denied by the answer. There seems to be no doubt that Laughlin owned all but a nominal amount of the stock and directed the acts of the corporation. This is established by his admissions in his answer and testimony, and his express assertions that he had personal control of the company. He makes no effort to deny that he was behind the acts of the company, and, indeed, in his letter to complainant of November 14, 1904, says that he holds himself responsible for the acts of the Perry Side Bearing Company. Although the answer contains a general denial that Laughlin acted in any way but as a corporate officer, there seems to be abundant ground for his joinder with defendant company in this suit. *Saxleher v. Eisner*, 147 Fed. 189, 77 C. C. A. 417; *Whiting Safety Catch Co. v. Western Wheeled Scraper Co. et al.* (C. C.) 148 Fed. 396. * * *

686. SIMPLEX RAILWAY APPLIANCE CO. v. PRESSED STEEL CAR CO., 189 Fed. 71, 110 C. C. A. 634 (1911).

Before Lacombe, Coxe and Ward, Circuit Judges.

Coxe, Circuit Judge:

The patentee, Carl E. Bauer, states in his specification that his object is to improve upon and remedy the defects of the form of bolster shown in patent No. 565,481, issued to W. H. Marshall, August 11, 1896. * * * The specification contains a statement that, though the best results are obtained by keeping the tension member straight, if the construction be varied by bending the tension member and keeping the compression member straight it will still be within the spirit of the invention.

The Circuit Court, however, permitted a disclaimer to that part of the specification, so that the patent is now limited to a bolster having a straight tension member and a compression member with its end bent at a point approximately over the place of support. That the court was entirely justified in permitting a disclaimer is, we think, clearly established by the authorities. The effect of the disclaimer was not to broaden the claim, but to limit it to the construction, described and shown, of a straight tension member and a bent compression member. Until this disclaimer was allowed it was possible to contend for a construction of claim 6 broad enough to include a structure described in the language disclaimed, viz., a straight compression member and a bent tension member. That this was a proper case for a disclaimer and that the language disclaimed is no longer a part of the specification, are propositions which are sustained by the following authorities: *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34, and cases cited in *Accumulator Co. v. Julien Co.* (C. C.) 38 Fed. 117, 133-136.

In *Carnegie Co. v. Cambria Co.*, 185 U. S. 403, at page 436, 22 Sup. Ct. 698, at page 711, 46 L. ed. 968, the court say:

"Had the purpose of the disclaimer been to reform or alter the description of the invention, or convert the claim from one thing into something else, it might have been objectionable, as patents can only be amended for mistakes of this kind by a reissue. But the disclaimer in this case appears to have been made to obviate an ambiguity in the specification, and with no idea of obtaining the benefit of a reissue. If the clauses had the effect of broadening the patent the disclaimer removes the objection. If they did not, the disclaimer could do no harm, and cannot be made the subject of criticism."

The sole effect of the present disclaimer is to limit the sixth claim to a structure embodying Bauer's actual invention and strictly within its terms. The statement eliminated by the disclaimer was unnecessary and was not advisedly inserted, but

there is nothing of which to predicate a fraudulent intent. The statement is gone and to that extent the atmosphere is cleared. * * *

687. UNITED STATES v. AMERICAN BELL TEL. CO. ET AL., 167 U. S. 224, 42 L. ed. 144 (1897). * * *

Mr. Justice Brewer, after stating the facts in the foregoing language, delivered the opinion of the court.

This is a suit by the United States to set aside a patent for an invention as wrongfully issued. It is, we believe, the first case in this court in which upon proofs such an application has been presented. The right of the United States to maintain such a suit was affirmed in *U. S. v. American Bell Tel. Co.*, 128 U. S. 315, 9 Sup. Ct. 90. The question now is whether upon the facts disclosed in this record the relief prayed for ought to be awarded. It becomes, therefore, a matter of moment to determine under what circumstances and upon what conditions the United States are entitled to have a patent, issued in due course of law, set aside and canceled.

Many cases have come to this court in which patents for lands have been sought to be set aside, and the rules controlling such suits have been frequently considered. Such decisions will naturally throw light upon the question here presented, though before adverting to them it may be well to note the difference between patents for land and patents for inventions. While the same term is used, the same grantor is in each, and, although each vests in the patentee certain rights, yet they are not in all things alike. The patent for land is a conveyance to an individual of that which is the absolute property of the government, and to which, but for the conveyance, the individual would have no right or title. It is a transfer of tangible property; of property in existence before the right is conveyed; of property which the government has the full right to dispose of as it sees fit, and may retain to itself or convey to one individual or another; and it creates a title which lasts for all time. On the other hand, the patent for an invention is not a conveyance of something which the government owns. It does not convey that which, but for the conveyance, the government could use and dispose of as it sees fit, and to which no one save the government has any right or title except for the conveyance. But for the patent the thing patented is open to the use of any one. Were it not for this patent, any one would have the right to manufacture and use the Berliner transmitter. It was not something which belonged to the government before Berliner invented it. It was open to the manufacture and use of any one, and any one who knew how could contrive, manufacture, and use the instrument. It conveyed to Berliner, so far as respects rights in the instru-

ment itself, nothing that he did not have theretofore. The only effect of it was to restrain others from manufacturing and using that which he invented. After his invention he could have kept the discovery secret to himself. He need not have disclosed it to any one. But in order to induce him to make that invention public, to give all a share in the benefits resulting from such an invention, congress, by its legislation made in pursuance of the constitution, has guaranteed to him an exclusive right to it for a limited time; and the purpose of the patent is to protect him in this monopoly, not to give him a use which, save for the patent, he did not have before, but only to separate to him an exclusive use. The government parted with nothing by the patent. It lost no property. Its possessions were not diminished. The patentee, so far as a personal use is concerned, received nothing which he did not have without the patent, and the monopoly which he did receive was only for a few years. So the government may well insist that it has higher rights in a suit to set aside a patent for land than it has in a suit to set aside a patent for an invention. There are weightier reasons why the government should not be permanently deprived of its property, through fraudulent representations or other wrongful means, than there are for questioning the validity of a temporary monopoly or depriving an individual of the exclusive use for a limited time of that whose actual use he claims to have made possible, and which, after such time, will be open and free to all. Bearing in mind this distinction, let us inquire upon what conditions the government may maintain a suit to set aside a patent for land.

These suits may be conveniently grouped in three classes: First, where the government being the only party interested, the patent is charged to have been obtained by fraud in representations or conduct; second, where the land by appropriate reservation is not subject to patent, but is, nevertheless, erroneously patented; third, where the land, though subject to patent in the ordinary administration of the land office, is patented to the wrong person either through fraud or by reason of mistake or inadvertence. In the first class are the following cases: *U. S. v. Hughes*, 11 How. 552; *U. S. v. Throckmorton*, 98 U. S. 61; *U. S. v. Atherton*, 102 U. S. 372; *Moffat v. U. S.*, 112 U. S. 24, 5 Sup. Ct. 10; *U. S. v. Minor*, 114 U. S. 233, 5 Sup. Ct. 836; *Maxwell Land-Grant Case*, 121 U. S. 325, 7 Sup. Ct. 1015; *Colorado Coal & Iron Co. v. U. S.*, 123 U. S. 307, 8 Sup. Ct. 131; *U. S. v. San Jacinto Tin Co.*, 125 U. S. 273, 8 Sup. Ct. 850; *U. S. v. Iron Silver Min. Co.*, 128 U. S. 673, 9 Sup. Ct. 195; *U. S. v. Hancock*, 133 U. S. 193, 10 Sup. Ct. 264; *U. S. v. Trinidad Coal & Coking Co.*, 137 U. S. 160, 11 Sup. Ct. 57; *U. S. v. Budd*, 144 U. S. 154, 12

Sup. Ct. 575; *San Pedro & Canon del Agua Co. v. U. S.*, 146 U. S. 120, 13 Sup. Ct. 94. In the second are these: *U. S. v. Stone*, 2 Wall. 525; *Leavenworth, etc., R. Co. v. U. S.*, 92 U. S. 733; *McLaughlin v. U. S.*, 107 U. S. 526, 2 Sup. Ct. 802; *Western Pac. R. Co. v. U. S.*, 108 U. S. 510, 2 Sup. Ct. 802; *Mullan v. U. S.*, 118 U. S. 271, 6 Sup. Ct. 1041. And in the third the following: *Hughes v. U. S.*, 4 Wall. 232; *U. S. v. Beebe*, 127 U. S. 338, 8 Sup. Ct. 1083; *U. S. v. Marshall Silver Min. Co.*, 129 U. S. 579, 9 Sup. Ct. 343; *U. S. v. Missouri, K. & T. Ry. Co.*, 141 U. S. 358, 12 Sup. Ct. 13; *U. S. v. Southern Pac. R. Co.*, 146 U. S. 570, 13 Sup. Ct. 152.

The second and third classes are not paralleled in this case, for it is not claimed that there was no invention, or that the patent issued to the wrong party. The decisions in those classes need not be considered. The first class comprises all cases in which the land, though subject to patent and therefore within the jurisdiction of the land department, was charged to have been patented in consequence of fraudulent representations or conduct on the part of the patentee. The representations may have been as to the matter of right or the matter of quantity. The patentee may have been entitled to no land, or to less, or a different tract than that patented. In any event, fraud was the basis of the relief sought, and as fraud, actual or constructive, in the issue of the patent, is the burden of this suit, we will quote from the opinions in some of these cases. In the *Maxwell Land-Grant Case*, Mr. Justice Miller, delivering the opinion of the court, said (page 381, 121 U. S., and page 1029, 7 Sup. Ct.):

“We take the general doctrine to be that when in a court of equity it is proposed to set aside, to annul, or to correct a written instrument for fraud or mistake in the execution of the instrument itself, the testimony on which this is done must be clear, unequivocal, and convincing, and that it cannot be done upon a bare preponderance of evidence which leaves the issue in doubt. If the proposition, as thus laid down in the cases cited, is sound in regard to the ordinary contracts of private individuals, how much more should it be observed where the attempt is to annul the grants, the patents, and other solemn evidences of title emanating from the government of the United States under its official seal. In this class of cases, the respect due to a patent, the presumption that all the preceding steps required by the law had been observed before its issue, the immense importance and necessity of the stability of titles dependent upon these official instruments, demand that the effort to set them aside, to annul them, or to correct mistakes in them should only be successful when the allegations on which this is attempted are clearly stated and fully sustained by proof. It is not to be admitted

that the titles by which so much property in this country and so many rights are held, purporting to emanate from the authoritative action of the officers of the government, and, as in this case, under the seal and signature of the president of the United States himself, shall be dependent upon the hazard of successful resistance to the whims and caprices of every person who chooses to attack them in a court of justice; but it should be well understood that only that class of evidence which commands respect, and that amount of it which produces conviction, shall make such an attempt successful."

In *Colorado Coal & Iron Co. v. U. S.*, Mr. Justice Matthews, after quoting part of the foregoing, adds (page 317, 123 U. S., and page 135, 8 Sup. Ct.):

"It thus appears that the title of the defendants rests upon the strongest presumptions of fact, which, although they may be rebutted, nevertheless can be overthrown only by full proofs to the contrary, clear, convincing, and unambiguous. The burden of producing these proofs, and establishing the conclusion to which they are directed, rests upon the government. Neither is it relieved of this obligation by the negative nature of the proposition it is bound to establish. It is, indeed, sometimes said that a negative is incapable of proof, but this is not a maxim of the law. In the language of an eminent text writer: 'When the negative ceases to be a simple one—when it is qualified by time, place, or circumstance—much of this objection is removed; and proof of a negative may very reasonably be required when the qualifying circumstances are the direct matter in issue, or the affirmative is either probable in itself, or supported by a presumption, or peculiar means of proof are in the hands of the party asserting the negative.'"

Then, after quotations from many authorities, the learned justice closes the discussion with these words from 1 Greenl. Ev. § 80:

"So, where the negative allegation involves a charge of criminal neglect of duty, whether official or otherwise; or fraud; or the wrongful violation of actual lawful possession of property—the party making the allegation must prove it; for in these cases the presumption of law, which is always in favor of innocence and quiet possession, is in favor of the party charged."

In *U. S. v. Marshall Min. Co.*, Mr. Justice Miller again refers to this matter, saying (page 589, 129 U. S., and page 346, 9 Sup. Ct.):

"The dignity and character of a patent from the United States is such that the holder of it cannot be called upon to prove that everything has been done that is usual in the proceedings had in the land department before its issue, nor can

he be called upon to explain every irregularity, or even impropriety, in the process by which the patent is procured.”

With these declarations of the law controlling such cases, we proceed to consider that which, according to the brief of counsel for the government, is the principal matter in this case. We quote their words:

“The delay in the office is the great fact in the case. It determined the bringing of the suit, stands in the forefront of the bill, was the principal question argued in both courts below, and occupies the chief space in the decisions rendered. It is not set up as laches, nor as a ground of forfeiture under any provision of the law or rule of the patent office, but as a course of conduct in the nature of fraud on the public.”

What was the delay in this case? The application by Berliner was made on June 4, 1877, he having filed a caveat on April 14, 1877. In 1878, and prior to October 23d, the telephone company purchased Berliner's invention, and on November 17, 1891, a patent was issued to the telephone company, as assignee of Berliner. The application was, therefore, pending in the department 14 years, during 13 of which the invention was the property of the telephone company. The effect of this, it is said, is to prolong for all practical purposes the telephone monopoly during the lifetime of this patent; and in this way: On March 7, 1876, patent No. 174,465 was issued to Alexander Graham Bell, in which patent, as alleged in the bill and admitted in the answer, were described and claimed “a method of and apparatus for transmitting sound by means of an undulatory current of electricity.” This was the original telephone patent. And it signified that Bell invented the telephone. That patent has expired, and all the monopoly which attaches to it alone has ceased, and the right to use that invention has become public property. But while he invented the telephone, the apparatus he devised was inefficient for public uses. Berliner invented something by which, taken in connection with Edison's and Blake's inventions, Bell's undulatory current could be made practically available for carrying on conversation at long distances. In other words, the telephone, as we use it—that which has become such an important factor in the commercial and social life of today—does not embody simply the invention of Bell, but also those of Edison, Blake, and Berliner. So that while the public has today, by reason of the expiration of the Bell patent, the right to use as it pleases his invention, such right is a barren one, and the telephone monopoly is practically extended to the termination of the Berliner patent; and this extension of the time of the monopoly has been accomplished by means of the delay in the

issue of the Berliner patent—the long pendency of the application in the patent office. * * *

Certain rules of procedure have been prescribed by the commissioner of patents, and a certain routine of practice has become established in that department. Now, all these matters of statutory enactments, rules of procedure, and routine of practice are things over which an applicant has no control. When he has once filed his application, complying with the statutory requirements, then the patent office takes possession of the matter. It determines when and how it will act, and the applicant can only ask and wait.

And why should he be called upon to do more? He comes before the tribunal which the government has established and presents his application. Why should the validity of the grant which that tribunal finally makes depend in any degree upon the number of times he has repeated his application? The true rule is that if application has been made, and the applicant has once called for action, he cannot be deprived of any benefits which flow from the ultimate action of the tribunal, although that tribunal may unnecessarily, negligently, or even wantonly, if that supposition were admissible, delay its judgment. If the public is interested in prompt action, if the government, which represents the public, thinks that more speed on the part of any of its tribunals is essential, it is the government which is called upon to act, and the applicant may with propriety wait until either the tribunal has acted, or until the government, having regard for the public interest, has interfered to compel action. Accepting the statement of counsel as to the facts to be correct in all its fullness, consider what would have been the ruling of a court if an application had been made to it based upon those facts. Suppose the applicant had presented its petition for a mandamus to compel prompt action on the part of the patent officials, and said: "I have applied for and am entitled to a patent. It will be issued after a while without any judicial compulsion. I can make large profits if the patent office will be dilatory, and yet I ask a mandamus to compel its immediate action"—would not the ruling have been: "By your own showing you are entitled to no relief; you have no cause of complaint. It is the government, representing the public, which alone can complain." And if it could obtain no assistance by a suit in advance, can it be punished indirectly by being deprived of that which was finally awarded to it?

Much is said in the briefs and in the arguments about the practical continuance of the telephone monopoly. It is well to understand exactly what is meant thereby. No one questions that the Bell patent has expired, and that all of his invention is

free to the use of the public. It is not denied that Berliner's invention is something independent and distinct from the Bell invention. It is the combination of these inventions with those of Blake and Edison which make the instrument in commercial use, and because this is the most serviceable it is the one that the public insists upon having. But each invention has independent rights. It loses nothing because when united with another it results in an instrument more valuable than either alone will give. Suppose that at the expiration of this Berliner patent some new invention shall be made by which, in connection with those already free to the public, an instrument can be manufactured far surpassing in utility that used today, and the Bell Company shall purchase that invention, the public, which always insists on having the best and most serviceable, will undoubtedly take the new instrument, and in that way it may happen that what is called the "telephone monopoly" is practically still further continued. But surely that does not abridge the legal rights of any one. The inventor of the latest addition is entitled to full protection, and if the telephone company buys that invention it is entitled to all the rights which the inventor had. All that the patent law requires is that when a patent expires the invention covered by that patent shall be free to every one, and not that the public has the right to the use of any other invention, the patent for which has not expired, and which adds to the utility and advantage of the instrument made as the result of the combined inventions.

Counsel seem to argue that one who has made an invention, and thereupon applies for a patent therefor, occupies, as it were, the position of a quasi trustee for the public; that he is under a sort of moral obligation to see that the public acquires the right to the free use of that invention as soon as is conveniently possible. We dissent entirely from the thought thus urged. The inventor is one who has discovered something of value. It is his absolute property. He may withhold the knowledge of it from the public, and he may insist upon all the advantages and benefits which the statute promises to him who discloses to the public his invention. He does not make the law. He does not determine the measure of his rights. The legislative body, representing the people, has declared what the public will give for the free use of that invention. He cannot be heard in the courts to say that it is of such value that he is entitled to a larger and longer monopoly; that he is not fully compensated for the great benefit which his invention has bestowed by the pecuniary receipts during 17 years. No representative of the public is at liberty to negotiate with him for a new and independent contract as to the terms and conditions upon which he will give up his

invention. He must come under the dominion of the statute, and take that which the public has proffered its willingness to give. As the lawmaking power has prescribed what the public will give, specified the terms and conditions of purchase, indicated the time and methods of determining the right of compensation, he on his part has an absolute legal right to avail himself of all the provisions thus made. It is not, of course, doubted that the courts in construing the patent as all other statutes, must have regard to the spirit as well as the letter. That sim-

What are the evidences of wrong in this matter of delay? It may have been caused either by the negligent or wrongful action of the officers of the department, and without any connivance, assistance, or concurrence on the part of the applicant, or it may have been brought about by the applicant, either through its corruption of the public officers or through other misconduct on its part. If the fault is wholly that of the department, the applicant ought not to suffer therefor. While, on the other hand, if its conduct has been wrongful, it may and ought to suffer. There is no presumption against the applicant. If a tribunal charged with official action delays such action, whatever of presumption surrounds the delay attaches to the tribunal, and no evidence of wrong being given, the presumption would be that the delay was at the instance of the tribunal, and not caused by the applicant. The government, therefore, in order to make out its case, must affirmatively show that the delay has been caused in some way by the conduct of the applicant, and before its patent can be set aside the government must, in accordance with the rules laid down in respect to land patents, establish that fact clearly. It may not rest on mere inferences, mere suggestions, but must prove the wrong in such a manner as to satisfy the judgment before it can destroy that which its own agents have created. We reiterate what was said by Mr. Justice Miller for the court in the Maxwell Land Grant Case, that a suit between individuals to set aside an instrument for fraud can only be sustained when the testimony in respect to the fraud is clear, unequivocal, and convincing, and cannot be done upon a bare preponderance of evidence which leaves the issue in doubt, and that, if this be the settled rule in respect to suits between individuals, it is much more so when the government attempts to set aside its solemn patent. And we may here again repeat that if this is true when the suit is to set aside a patent for land, which conveys for all time the title, a fortiori, it must be true when the suit is one to set aside a patent for an invention, which only grants a temporary right.

What evidence has the government produced? We premise by saying that there is not a scintilla of testimony as to any cor-

ruption of the officers of the department by the defendants, or any attempt at such corruption. Counsel do not put the finger on a single fact tending to show that any money was ever paid to any official of the patent office, or that any undue influence was ever attempted to be exerted upon or improper suggestion made to any one. So far as the record discloses, there never was an intimation made to a single official that he could profit in any way by a moment's delay. All thought of wrong in this respect may, therefore, be put aside. If there was no corruption on the part of the defendants, what did they do that calls for condemnation? * * *

This presents the burden of the case on the part of the government. It amounts to only this: The defendant company was not active, but passive. If millions were to be added to its profit by active effort it would have been importunate, and have secured this patent long before it did. As millions came to it by reason of its being passive, it ought to suffer for its omission to be importunate. It must keep coming before the commissioner, like the widow before the unjust judge in the parable, until it compels the declaration, "though I fear not God nor regard man, yet because this widow troubleth me, I will avenge her, lest by her continual coming she weary me." But is this the rule to measure the conduct of those who apply for official action? What is the amount of the importunity which will afford protection to the grant finally obtained? How frequent must the demand be? It is easy to say that the applications of this defendant, coming only at the interval of months and years, were, taken with the replies of the patent office, mere "perfunctory exchanges of compliments," but this does not change the fact that action was asked and repeatedly asked; that no request was made for delay; no intimation that it was desired or would be acceptable. * * *

But is the applicant to be condemned because, having once made an urgent request for action and pointed out reasons therefor, it was not continually repeating that request, because it did not see that such request was placed on the files of this particular application, or, as intimated in the words of counsel, nailed on the doors of the patent office?

It is, of course, easy to say that these applications, these suggestions and requests, meant nothing; that they were a mere blind. But something more than assertion of counsel is necessary to destroy their significance, or to establish collusion between the applicant and the officials of the department. But the case does not stand upon the fact that the formal communications from the solicitor in charge of this application were few in number. While in every one in which the matter was re-

ferred to there was a request for action, it also appears from the testimony of Messrs. Freeman, Lyons, and Kintner, who were the examiners in charge during the major portion of the time in dispute, that the representatives of the Bell Company were urgent in pushing the Berliner application. * * *

Another matter referred to by counsel is what they call the "tacit understanding." The facts are these: One Daniel Drawbaugh claimed to have invented the telephone prior to Bell. He assigned his invention to the People's Telephone Company, between whom and the defendant company a heated and protracted litigation arose. Now, it is said that there was an agreement, or, at least, a tacit understanding, between the officials of the patent office, the People's Company, and the defendant company that the proceedings in the patent office in respect to the Berliner application should wait the determination of the litigation between the two telephone companies. It is insisted that the officials had no right to enter into such an agreement; that it was unlawful in its character. Assuming that this is so, still the fact appears that the proposition therefor came from the representatives of the Drawbaugh interest, that it was deemed by the officers of the patent office to be for the best interests of all, and that it was simply assented to by the defendant. Nowhere does it appear that the defendant urged, or even suggested, the propriety of such a delay. For the present we do not consider the wisdom or the rightfulness of the course pursued. All that we desire to notice is that it was not at the instance of the defendant.

It is further said that, even if there were at first any excuse for such "tacit understanding," and the patent office properly delayed action on this application until after the litigation between Drawbaugh and Bell had ended, a judgment therein was rendered in the circuit court in 1884; and that then the office should have proceeded promptly, and that there was no excuse for waiting until the decision of the appeal by this court in 1888; and, least of all, for any delay after that final decision by this court.

Summing up their argument on this branch of the case, counsel say:

"The review of the history of the Berliner application, which we have now completed, shows that in its treatment of it the office proceeded upon two unlawful assumptions.

"The first was that an applicant, whose application is ready for issue except for a possible threatened interference, must wait until the antagonizing application is either found allowable and ready for the interference, or finally ejected from the office, no

matter how long that may be. This assumption governed the action of the examiners from 1882 to the issue of the patent.

* * *

“The second assumption was that the judicial determination of the question of Drawbaugh’s invention, in the suit between the owners of the applications, was not enough to warrant action by the office. Examiner Kintner took the ground, in conversation with Mr. Swan—never on the record—that the decision of the circuit court was not enough for him; that the case might be appealed, and he would act only on the decision of the supreme court. But when that came it received no more consideration than had been given to that of the circuit court.”

Were it conceded that these two assumptions were “false assumptions,” as counsel call them, what are they but errors of judgment on the part of the patent officials as to the course of procedure; and can it be possible that an applicant for a right who has under the statute no choice of tribunals or course of procedure, but is compelled to apply to one tribunal which has exclusive jurisdiction in the matter, and must abide by its rulings as to procedure, can be held to have forfeited his right simply because of errors of judgment by such tribunal as to the procedure? The statement of the question seems to us to carry its own answer. It is true counsel follow this declaration of the errors on the part of the office in the matter of procedure with the further statement:

“The guilty party is the Bell Company. It had a full and perfect inside view of the whole situation from the beginning. Its attorneys were wiser in these things than the commissioners or the examiners. They shrewdly availed themselves of every unauthorized usage, mistaken assumption, ignorant misconception, or supposed obstacle, by means of which the issue of the patent could be delayed without apparent responsibility on their part. In view of the duty which vested upon the company to speed the application, that was fraud, not less but more reprehensible because it was not of the common and gross kind, but so refined and acute that its garb of professed innocence has deceived even the court of appeals.”

The difficulty with this charge of wrong is that it is not proved. It assumes the existence of a knowledge which no one had; of an intention which is not shown. It treats every written communication from the solicitor in charge of the application, calling for action, as a pretense, and all the oral and urgent appeals for promptness as in fact mere invitations to delay. It not only rejects the testimony which is given, both oral and written, as false, but asks that it be held to prove just the reverse.

Indeed, the case which the counsel present to us may be summed up in these words: The application for this patent was duly filed. The patent office after the filing had full jurisdiction over the procedure; the applicant had no control over its action. We have been unable to offer a syllable of testimony tending to show that the applicant ever in any way corrupted, or attempted to corrupt, any of the officials of the department. We have been unable to show that any delay or postponement was made at the instance or on the suggestion of the applicant. Every communication that it made during those years carried with it a request for action, yet because the delay has resulted in enlarged profits to the applicant, and the fact that it would so result ought to have been known to it, it must be assumed that in some way it did cause the delay, and, having so caused the delay, ought to suffer therefor. There is seldom presented a case in which there is such an absolute and total failure of proof of wrong.

The defendant company might safely have left the case here, but it has not been content to rest the controversy with the failure on the part of the government to show any wrong. It has not been content to accept the Scotch verdict of "not proven." It has called as witnesses the examiners who were in charge of this application, and taken their testimony as to what did in fact take place, and as to how and why the long delay occurred. Whatever judgment may be pronounced upon the wisdom of the course pursued by these officials, or the sufficiency of the reasons given by them therefor, there is no ground for controverting that they acted in good faith. The case is not one of arbitrary, peremptory postponements and delay.

They supposed they were acting in compliance with the rules of the patent office, and out of proper regard for the rights of conflicting interests. No just estimate can be placed upon the propriety of their conduct without taking into consideration the whole subject of telephonic inventions and litigation. As heretofore stated, and as is well known, Bell claimed to be the pioneer in this matter of telephonic communication. His claim was disputed, and out of that dispute came the most important, the most protracted, litigation which has arisen under the patent system in this country. For years this litigation was pending in the trial courts, subsequently brought to this court, and finally decided in 1888. So great was this litigation, so immense the volume of testimony, and so important the rights involved, that it is the only case in the history of this court to which an entire volume of our Reports is devoted. 126 U. S., 8 Sup. Ct. The argument was protracted through weeks, and the case was held under consideration for a year, and finally decided by a closely-divided court. Is it strange that, when the primary right was

being so vigorously contested, and was so much a matter of doubt, when (as appears from the testimony in this case) the judgment of the law department of the government was adverse to the claims of Bell, and to the validity of the patent which he had obtained—is it strange, we ask, in view of these facts, that the disposition of the apparently minor matter should be held in abeyance in the patent office until a final decision of the primary right?

Neither can any just estimate be placed upon their conduct without taking into account the volume of business, and the pressure on account thereof, in the patent office. Beyond the fact, which is a matter of common knowledge, that thousands of applications are filed and thousands of patents granted each year, the record discloses something as to the multitude of applications for patents for telephones and telephonic devices which were pending during these years. Mr. Townsend, who was an examiner up to November 15, 1880, while unable to state the number of applications, was able to say that he had examined over 120 that went to patent. This it will be remembered was in the early days of telephonic investigation and invention. It appears also from a communication made by the commissioner of patents to the secretary of the interior, on December 13, 1892, advising against this suit, that at that time a gentleman, who is called in the letter the "relator," had pending in the patent office 152 applications for patents on telephones and telephone systems. These facts may be only side lights, but they show that the examiners and other officials in the patent office had something else to do besides considering this application.

Of course, it is easy to say that the patent office could have disposed of this application more promptly than it did; that it ought to have done so; and that, in view of the termination of the great litigation favorable to the claims of Bell, its delay has resulted in large pecuniary benefits to the defendants. But a wisdom born after the event is the cheapest of all wisdom. Anybody could have discovered America after 1492. The question is not whether a better judgment on the part of the patent officials would have disposed of this application long before it was, is not, indeed, whether there was any error of judgment, but whether they acted wrongfully, and their action was induced by or at the instance of the defendants.

One thing more deserves notice. The argument of the counsel for the government proceeds all along on the assumption of the superior knowledge of the representatives of the defendant company; that they saw the end from the beginning; that they knew that their client had an invention which was patentable, and that they would ultimately obtain a patent therefor, and also

that Bell was and would finally be adjudged the primary inventor of the telephone; and that, possessed of all of this knowledge, they planned the delay in securing the Berliner patent in order that thereby they might extend to the termination of its life the telephone monopoly. But what an assumption this is, and how illy justified by the facts! The very process and termination of the Bell-Drawbaugh litigation demonstrates the doubtfulness of the question there in issue, and is absolute evidence that there was up to the close of that litigation an uncertainty as to the result. Equally uncertain was the outcome of the Berliner application. Indeed, there is an uncertainty as to every application. No one can foretell what will be the judgment of the patent office upon the questions of novelty and utility. And in respect to this Berliner application, the matters which are subsequently to be considered attest that there was more than ordinary doubt as to the outcome. On account of those matters, it is earnestly contended that there was no merit in the application, and that it ought to have been denied. Further than that, they knew that the officials of the patent office were subject to change—as in fact they were changed during the pendency of these proceedings—and, even if they had any direct intimations from the first examiner or the first commissioner, there was no certainty that a subsequent examiner and subsequent commissioner would entertain the same views. If the Bell-Drawbaugh litigation had terminated the other way, and a different opinion on the part of a single member of this court would have changed this result, or if when the time came the commissioner of the patent office had decided against the Berliner application, and his decision been sustained on appeal to the supreme court of the District of Columbia, then all this brilliant scheme of realizing millions would have vanished into thin air. If they were possessed of the wisdom which the government attributes to them, the representatives of the Bell Company must have realized that the certainty which attends a final decision and the issue of a patent was something worth striving for, and not lightly to be ignored. And if this underlying assumption has so little foundation, what shall be said of an inference and an imputation unsupported by evidence and based upon that assumption?

Our conclusions on this branch of the case are: First, That before the government is entitled to a decree canceling a patent for an invention on the ground that it has been fraudulently and wrongfully obtained, it must, as in the case of a like suit to set aside a patent for land, establish the fraud and the wrong by testimony which is clear, convincing, and satisfactory. Second, That congress has established a department, with officials selected by the government, to whom all application for patents

must be made; has prescribed the terms and conditions of such applications, and intrusted the entire management of affairs of the department to those officials; that when an applicant for a patent complies with the terms and conditions prescribed, and files his application with the officers of the department, he must abide their action, and cannot be held to suffer or lose rights by reason of any delay on the part of those officials, whether reasonable or unreasonable, unless such delay has been brought about through his corruption of the officials, or through his inducement, or at his instance. Proof that they were in fault, that they acted unwisely, unreasonably, and even that they were culpably dilatory, casts no blame on him and abridges none of his rights. Third, The evidence in this case does not in the least degree tend to show any corruption by the applicant of any of the officials of the department, or any undue or improper influence exerted or attempted to be exerted by it upon them, and, on the other hand, does affirmatively show that it urged promptness on the part of the officials of the department, and that the delay was the result of the actions of those officials. And, fourth, if the circumstances do not make it clear that this delay on the part of the officials was wholly justified, they do show that it was not wholly unwarranted, and that there were reasons for the action of such officials which at least deserve consideration and cannot be condemned as trivial.

The three remaining grounds of relief asserted by the government may be considered together. Defendants contend that as the last two, although urged in the circuit court, were not presented to the court of appeals (referring for this fact to the opinion of the latter court, and also a notice which was contained in the brief of counsel for the government), we are precluded from noticing them, citing as authority *Bell v. Bruen*, 1 How. 169; *Alviso v. U. S.*, 8 Wall. 337; *National Bank v. Com.*, 9 Wall. 353; *Rogers v. Ritter*, 12 Wall. 317; *Klein v. Russell*, 19 Wall. 433; *Supervisors v. Lackawana Co.*, 93 U. S. 619; *Wilson v. McNamee*, 102 U. S. 572; *Wood v. Weimar*, 104 U. S. 786; *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825; *McGahan v. Bank*, 156 U. S. 218, 15 Sup. Ct. 347; and *Carr v. Fife*, 156 U. S. 494, 15 Sup. Ct. 427—in which cases, with more or less particularity, the proposition is announced that this court will not consider questions not presented to and passed upon by the lower court. We deem it unnecessary to determine how far that rule is applicable in this case, for the reasons which compel us to deny relief on the first of these grounds are, when applied to the facts developed by the testimony, equally potent as to the others. That ground, as stated, is “that a patent issued November 2, 1880, upon a division of the original application, cov-

ers the same invention as that covered by the patent in suit, and exhausted the power of the commissioner as to that invention." The patent of 1880 is for a receiver; that of 1891 for a transmitter. It is claimed that the two instruments are alike in form and alike in function, save as they are operated at different ends of the telephone wire. The transmitter can be placed at the other end of the wire, and then becomes a receiver, and so vice versa. Popularly speaking, it may be said that the transmitter takes the varying sounds of the human voice, and passes them on to the telephone wire, to be borne along thereon by the undulatory electric current until they reach the receiver, which takes and passes them to the human ear. In a sense the receiver is also a transmitter, for it passes the sounds from the wire to the ear. We agree with the court of appeals that it is unnecessary to determine whether there are two separate inventions in the transmitter and the receiver, or whether the patent of 1891 is for an invention which was covered by the patent of 1880. The judgment of the patent office, the tribunal established by congress to determine such questions, was adverse to the contention of the government, and such judgment cannot be reviewed in this suit.

Suits may be maintained by the government in its own courts to set aside one of its patents, not only when it has a proprietary and pecuniary interest in the result, but also when it is necessary in order to enable it to discharge its obligations to the public, and sometimes when the purpose and effect are simply to enforce the rights of an individual. In the former cases it has all the privileges and rights of a sovereign. The statutes of limitation do not run against it. The laches of its own officials does not debar its right. *Van Brocklin v. Tennessee*, 117 U. S. 151, 6 Sup. Ct. 670; *U. S. v. Nashville, C. & St. L. Ry. Co.*, 118 U. S. 120, 6 Sup. Ct. 1006; *U. S. v. Insley*, 130 U. S. 263, 9 Sup. Ct. 485. But when it has no proprietary or pecuniary result in the setting aside of the patent; is not seeking to discharge its obligations to the public; when it has brought the suit simply to help an individual, making itself, as it were, the instrument by which the right of that individual against the patentee can be established—then it becomes subject to the rules governing like suits between private litigants. As said in *U. S. v. Beebe*, 127 U. S. 338, 347, 8 Sup. Ct. 1083, 1088:

"We are of the opinion that when the government is a mere formal complainant in a suit, not for the purpose of asserting any public right or protecting any public interest, title, or property, but merely to form a conduit through which one private person can conduct litigation against another private person, a court of equity will not be restrained from administering the

equities existing between the real parties by any exemption of the government designed for the protection of the rights of the United States alone. The mere use of its name in a suit for the benefit of a private suitor cannot extend its immunity as a sovereign government to said private suitor, whereby he can avoid and escape the scrutiny of a court of equity into the matters pleaded against him by the other party, nor stop the court from examining into and deciding the case according to the principles governing courts of equity in like cases between private litigants." See, also, *U. S. v. Des Moines, etc., Ry. Co.*, 142 U. S. 510, 12 Sup. Ct. 308; *Curtner v. U. S.*, 149 U. S. 662, 13 Sup. Ct. 985, 1041.

Now, in the case at bar the United States has no proprietary or pecuniary interest. The result, if favorable to it, would put no money in its treasury or property in its possession. It has a standing in court either in the discharge of its obligation to protect the public against a monopoly it has wrongfully created, or simply because it owes a duty to other patentees to secure to them the full enjoyment of the rights which it has conferred by its patents to them. Perhaps both of these objects were in view. In so far as the latter was and is the purpose of this suit, it brings it within the rule laid down in *U. S. v. Beebe*, supra. Doubtless the removal from the public of the burden of a monopoly charged to have been wrongfully created was also one of the objects, and perhaps the principal object. *U. S. v. American Bell Tel. Co.*, 159 U. S. 548, 16 Sup. Ct. 69. To what extent this may relieve the government as suitor from all the rules governing the suits of private individuals need not be specifically determined here.

One of the familiar rules of equity, reinforced by statute (section 723, Rev. St.), is that "suits in equity shall not be sustained in either of the courts of the United States in any case where a plain, adequate, and complete remedy may be had at law." The objection to the validity of this patent on the ground that it was already covered by the patent of 1880 is a defense which, under the statutes (section 4920, Rev. St.) is open to every individual charged by the patentee with infringement, whether the proceeding against him be an action at law or a suit in equity. The government, therefore, if seeking simply to protect the right of an individual, ought not to be permitted to maintain a suit in equity to cancel that against which the individual has a perfect legal defense available in any action brought by or against him. The query is pressed whether the same rule would not also apply when the government is only seeking to protect the public at large, for the public is but the aggregation of all the individuals, and, if each of them has a perfect defense to the pat-

ent, so all together have. Again, and as an illustration, perhaps, of the extent of the rule referred to, it has often been held that while one having the title to and possession of a tract of land can maintain a suit in equity to cancel a deed or other instrument which is a cloud upon the title, such suit cannot be sustained if the deed or instrument is void upon its face, its invalidity resting upon matters of record, and not affected by any lapse of time or statute of limitations. In other words, the deed or instrument is not considered a cloud if it can never be used to destroy his title or disturb his possession. The objection to this patent on the ground stated is an objection resting upon matters of record—of record in the patent office—not dependent on oral testimony nor subject to change, and in no way affected by lapse of time. Within the scope of this specific application of the general rule, it would seem that equity has no jurisdiction either at the suit of the government or of an individual to formally cancel that which by record and unfailing evidence is, as claimed, absolutely void.

But, further, congress has established the patent office, and thereby created a tribunal to pass upon all questions of novelty and utility. It has given to that office exclusive jurisdiction in the first instance, and has specifically provided under what circumstances its decisions may be reviewed, either collaterally or by appeal. As said in *Butterworth v. Hoe*, 112 U. S. 50, 67, 5 Sup. Ct. 25, 34: "That it was intended that the commissioner of patents, in issuing or withholding patents, in reissues, interferences, and extensions, should exercise quasi judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed."

§§ 4911-4914, Rev. Stat., grant appeals in certain cases to the Supreme Court of the District of Columbia. It is true those sections do not authorize appeals on behalf of the government, but the failure so to do may be evidence that congress thought the government ought not to interfere, and because it believed it had made ample provision for securing the rights of all without the intervention of the government. § 4915, Rev. Stat., authorizes a suit in equity on behalf of an applicant for a patent whose application has been refused. *Morgan v. Daniels*, 153 U. S. 120, 14 Sup. Ct. 772, presented a controversy under that section, and in the opinion, on page 124, 153 U. S., and page 773, 14 Sup. Ct., we said: "It is a controversy between two individuals over a question of fact which has once been settled by a special tribunal, intrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that the decision of the patent office was a finality upon every matter of fact."

It is true that all these sections refer to proceedings between individuals, but the government is as much bound by the laws of congress as an individual, and when congress has created a tribunal to which it has given exclusive determination in the first instance of certain questions of fact, and has specifically provided under what circumstances that determination may be reviewed by the courts, the argument is a forcible one that such determination should be held conclusive upon the government, subject to the same limitations as apply in suits between individuals.

There is nothing in *U. S. v. Bell Tel. Co.*, 128 U. S. 315, 9 Sup. Ct. 90, and *U. S. v. American Bell Tel. Co.*, 159 U. S. 548, 16 Sup. Ct. 69, to conflict with the views above expressed. In the former case the question presented was whether the government could maintain a bill to set aside a patent for an invention on the ground of fraud in its issue, and among the objections urged was the fact that congress had, in § 4920, Rev. Stat., made specific provision for certain defenses in suits by an infringer. It was held that the government could maintain such a bill, and that these special statutory provisions did not defeat its right, the court summing up the discussion in these words (page 373, 128 U. S., and page 99, 9 Sup. Ct.):

“The argument need not be further extended. There is nothing in these provisions expressing an intention of limiting the power of the government of the United States to get rid of a patent obtained from it by fraud and deceit. And although the legislature may have given to private individuals a more limited form of relief, by way of defense to an action by the patentee, we think the argument that this was intended to supersede the affirmative relief to which the United States is entitled, to obtain a cancellation or vacation of an instrument obtained from it by fraud, an instrument which affects the whole public, whose protection from such a fraud is eminently the duty of the United States, is not sound.”

In the latter case, which is the one now before us, there was decided a motion to dismiss for want of jurisdiction in this court of an appeal from the decision of the court of appeals, and it was adjudged that this court had jurisdiction. It is true, at the close of the opinion is found this general statement as to the power to maintain such a suit (page 555, 159 U. S., and page 72, 16 Sup. Ct.):

“In *U. S. v. American Bell Tel. Co.*, supra, it was decided that where a patent for a grant of any kind issued by the United States has been obtained by fraud, by mistake, or by accident, a suit by the United States against the patentee is the proper remedy for relief, and that in this country, where there is no kingly prerogative, but where patents for land and inventions are issued

by the authority of the government, and by officers appointed for that purpose, who may have been imposed upon by fraud or deceit, or may have erred as to their power, or made mistakes in the instrument itself, the appropriate remedy is by proceedings by the United States against the patentee."

But, while there was thus rightfully affirmed the power of the government to proceed by suit in equity against one who had wrongfully obtained a patent for land or for an invention, there was no attempt to define the character of the fraud, or deceit, or mistake, or the extent of the error as to power which must be established before a decree could be entered canceling the patent. It was not affirmed that proof of any fraud, or deceit, or the existence of any error on the part of the officers as to the extent of their power, or that any mistake in the instrument, was sufficient to justify a decree of cancellation. Least of all was it intended to be affirmed that the courts of the United States, sitting as courts of equity, could entertain jurisdiction of a suit by the United States to set aside a patent for an invention on the mere ground of error of judgment on the part of the patent officials. That would be an attempt on the part of the courts in collateral attack to exercise an appellate jurisdiction over the decisions of the patent office, although no appellate jurisdiction has been by the statutes conferred. We are of opinion, therefore, that the question, as stated, is not open for consideration in this case. We see no error in the decision of the court of appeals, and its decree, dismissing the bill, is affirmed.

Mr. Justice Harlan dissented.

Mr. Justice Gray and Mr. Justice Brown were not present at the argument, and took no part in the decision.

688. RUSSELL v. DODGE, 93 U. S. 460, 23 L. ed. 973.

A reissue could only be granted for the same invention embraced by the original patent, the specification could not be substantially changed, either by addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention.

689. McMURRAY v. MALLORY, 111 U. S. 97, 28 L. ed. 365, 4 Sup. Ct. 375.

It is plain that the claims mentioned include many soldering devices not covered by the original patent. The claims are, therefore, void. *Gill v. Wells*, 22 Wall. 1; *The Wood Paper Patent*, 23 Id. 566; *Powder Co. v. Powder Works*, 98 U. S. 126; *Ball v. Langles*, 102 Id. 128; *Miller v. Brass Co.*, 104 Id. 350; *James v. Campbell*, Id. 356; *Heald v. Rice*, Id. 737; *Johnson v. R. R. Co.*, 105 Id. 539; *Bantz v. Frantz*, Id. 160; *Wing v. Anthony*, 106 U. S., 142. [Bill dismissed.]

690. *HARTSHORN v. SAGINAW BARREL CO.*, 119 U. S. 664, 30 L. ed. 539, 7 Sup. Ct. 421.

The alterations, it is said in argument, had the effect only of giving a more full, complete, and accurate description of the same mechanism; but, in point of fact, the alterations changed the shape of the specification in such a way as to admit the new and enlarged claim in a manner in which it could not have been made upon the original description.

691. *WHITE v. DUNBAR*, 119 U. S. 47, 30 L. ed. 303, 7 Sup. Ct. 72.

The original patent is not susceptible of the broad construction which the appellees would give to it, and that the reissued patent is a material expansion and enlargement of it. As such expansion appears to be the only object of the reissue, and as the application for the reissue was not made until nearly five years after the original was granted, the case comes within the ruling of *Miller v. Brass Co.*, 104 U. S. 350.

692. *FLOWER v. DETROIT*, 127 U. S. 563, 32 L. ed. 175, 8 Sup. Ct. 1291.

What was suggested in the original specification, drawings, or patent office model is not to be considered as a part of the invention intended to have been covered by the original patent, unless it can be seen from a comparison of the two patents that the invention which the original patent was intended to cover embraced the things thus suggested or indicated in the original specification, drawings, or patent office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent.

693. *HUBER v. NELSON MFG. CO.*, 148 U. S. 270, 37 L. ed. 447, 13 Sup. Ct. 603.

We think that, on all the facts of this case, no one of the claims of the reissue can be construed as valid in leaving out the flushing chamber as an element of the combination, inasmuch as every claim of the original patent contained it. *Prouty v. Ruggles*, 41 U. S. 16 Pet. 336, 341; *Brooks v. Fiske*, 56 U. S. 15 How. 212, 219; *Burr v. Duryee*, 68 U. S. 1 Wall. 531; *Reckendorfer v. Faber*, 92 U. S. 347; *Fuller v. Yentzer*, 94 U. S. 288; *Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554; *Union Water Meter Co. v. Desper*, 101 U. S. 332.

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Every one of the elements which is made a part of the several combinations claimed in the original patent is thereby made material to such combinations. *Eames v. Godfrey*, 68 U. S. 1 Wall,

78; *Burr v. Duryee*, 68 U. S. 1 Wall. 531; *Case v. Brown*, 69 U. S. 2 Wall. 320; *Gould v. Rees*, 82 U. S. 15 Wall. 187; *Gill v. Wells*, 89 U. S. 22 Wall. 1; *Fuller v. Yentzer*, 94 U. S. 288; *Giant Powder Co. v. California Powder Works*, 98 U. S. 126; *Leggett v. Avery*, 101 U. S. 256; *James v. Campbell*, 104 U. S. 356; *Coon v. Wilson*, 113 U. S. 268; *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 87; *Electric Gas Lighting Co. v. Boston Electric Co.*, 139 U. S. 481; *Topliff v. Topliff*, 145 U. S. 156.

694. *HOUGHTON v. WHITIN MACH. WORKS*, 153 Fed. 740, 83 C. C. A. 84.

The somewhat recent case of *Topliff v. Topliff*, 145 U. S. 56, 36 L. ed 658, * * * stated that the power to reissue may be exercised when the patent is inoperative, because the claims were narrower than the actual invention, provided the error arose from inadvertence or mistake. The right, however, is subject to certain limitations, and among them that the reissue shall be for the same invention, as it appears from the specification and claims, and that there must be reasonable diligence in moving. It is also stated as something to be regarded as settled by the Supreme Court that the court will not review the decision of the Commissioner of Patents upon the question of inadvertence, accident, or mistake, unless the matter is manifest from the record. * * * The application was made in a little over four months, which ordinarily would be accepted as not an unreasonable time, provided public rights had not intervened. * * * The specification of the original patent, when read in connection with the cuts, manifestly shows that the patentee intended a broader invention than that stated in his claims.

695. *SEYMOUR v. OSBORNE*, 78 U. S. 516, 20 L. ed. 33.

Where the commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the circuit court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent.

696. *EBY v. KING*, 158 U. S. 366, 39 L. ed. 1018, 15 Sup. Ct. 927.

We think it a serious question whether the commissioner of patents had any jurisdiction, under Rev. Stat., § 4916, to consider the application upon the bare statement that the patentee desired to surrender his patent and obtain a reissue. The commis-

sioner is authorized to reissue patents in certain specified cases, and if the petition makes no pretense of setting forth facts entitling the patentee to a reissue, it is exceedingly doubtful whether he obtains any jurisdiction to act at all [and see No. 708].

697. *BEACH v. HOBBS*, 92 Fed. 146, 34 C. C. A. 248.

If by reason of any inadvertence or mistake in the drawings or specification a patent is rendered in part inoperative, and the patentee promptly applies for a reissue, and no substantial rights are affected, or fraudulent intent charged, we think the commissioner has the right, under § 4916 of the Revised Statutes, to cause a new patent to issue, and that, under such circumstances, his decision is conclusive. We know of no authority in conflict with this proposition.

698. *GOODYEAR DENTAL, ETC., CO. v. DAVIS*, 102 U. S. 222, 26 L. ed. 149.

Indeed, we have heretofore expressed doubts whether reissued letters-patent can be sustained in any case where they contain claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters-patent.

699. *CROWN CORK, ETC., CO. v. ALUMINUM STOPPER CO.*, 108 Fed. 845, 48 C. C. A. 72.

In this class of cases there should not be applied a stricter rule of diligence than that applied by statute in case of public use before application for the patent, even if so strict a limitation as that is applicable.

700. *MILLOY ELEC. CO. v. THOMSON-HOUSTON ELEC. CO.*, 148 Fed. 843, 78 C. C. A. 533.

The original patent was granted April 11, 1893. The application for the reissue was filed Sept. 28, 1900. In the meantime, as the record shows, various persons had been acting upon the supposed invalidity of the patent, * * * and on July 22, 1897, the patent was declared invalid by the Circuit Court of Appeals for the Second Circuit. * * * As early as 1895, the attention of the patentee was directly challenged to the specifications of the patent, and they were elaborately canvassed. If any error had been committed in the language employed or in claiming more than was new, it was as discoverable then as it ever became, unless, indeed, a patentee has the right to await the result which the courts may reach after prolonged litigation and examination of the subject. * * * We can not think that a patentee

may thus experiment with his patent. On the contrary we think that, when the grounds are disclosed for thinking there may be an error or mistake, he is bound in duty to the public to correct it by obtaining a reissue or to adhere to his original patent; and, if he declines to correct it, he should be deemed to be standing upon it as the measure of his right.

701. TORRENT, ETC., LUMBER CO. v. RODGERS, 112 U. S. 659, 28 L. ed. 842, 5 Sup. Ct. 501.

The reissue was not applied for until nearly five years after the date of the original patent and not until another inventor had made a substantial advance in the art to which the original patent belonged, which the assignee of the original invention, it may be fairly inferred, desired to include in the monopoly of his patent and that he sought to accomplish this by its reissue. The first claim of the reissued patent was, therefore, void. This conclusion is sustained by many decisions of this court, some of which may be found in the following cases: *Gill v. Wells*, 22 Wall. 1; *The Wood Paper Patent*, 23 Wall., 566; *Powder Co. v. Powder Works*, 98 U. S. 126; *Ball v. Langles*, 102 U. S. 128; *James v. Campbell*, 104 U. S. 356; *Heald v. Rice*, 104 U. S. 737; *Miller v. Brass Co.*, 104 U. S. 350; *Johnson v. R. R. Co.*, 105 U. S. 539; *Bantz v. Frantz*, 105 U. S. 160; *Wing v. Anthony*, 106 U. S. 142. Especial attention is called to three decisions of this court which are peculiarly opposite. *Clements v. Odorless Excavating, etc., Co.*, 109 U. S. 641; *McMurray v. Mallory* (ante 365 [111 U. S. 97]) and *Mahn v. Harwood* (ante 665 [112 U. S. 354]), decided at the present term.

702. WOLLENSAK v. SARGENT, 151 U. S. 221, 38 L. ed. 137, 14 Sup. Ct. 291.

It is declared to be settled that while no invariable rule can be laid down, * * * a delay of two years by analogy to the law of public use, before an application for a patent, should be construed equally favorably to the public.

703. ALLEN v. CULP, 166 U. S. 501, 41 L. ed. 1093, 17 Sup. Ct. 644.

It is true that in making his surrender the patentee declares that his patent is inoperative and invalid; but this is not necessarily so for all purposes, but for the purpose for which he desires to have it reissued. Such a patent might be inoperative and invalid as against certain persons who had pirated the underlying principle of the patent, and avoided infringing the exact language of the claims, and yet be perfectly valid as against others, who were making machines clearly covered by their language.

When a patent is thus surrendered, there can be no doubt that it continues to be a valid patent until it is reissued, when it becomes inoperative; but if a reissue be refused, it is entirely clear that the surrender never takes effect, and the patent stands as if no application had ever been made for a reissue. Whether, if the reissue be void, the patentee may fall back on his original patent, has never yet been decided by this court, although the question was raised in *Eby v. King*, 158 U. S. 366; but as the original patent in that case was also held to be void, it did not become necessary to express an opinion upon the question. But if the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for, unless at least the reissue be refused upon some ground equally affecting the original patent.

704. *McCORMICK HARVESTING MACH. CO. v. AULTMAN*, 169 U. S. 606, 42 L. ed. 875, 18 Sup. Ct. 443.

The fact that the rules of the patent office require that the original patent should be placed in its custody for the purpose of surrendering it upon the issue of an amended patent gives that department no right to the possession of it upon the rejection of the application for a reissue. If the patentee abandoned his application for a reissue, he is entitled to a return of his original patent precisely as it stood when such application was made, and the patent office has no greater authority to mutilate it by rejecting any of its claims than it has to cancel the entire patent.

705. *COFFIELD v. FLETCHER MFG. CO.*, 167 Fed. 321, 93 C. C. A. 25.

When the patentee came to ask for a reissue, he was confronted with certain conditions on which only could the reissue be permitted. One was that the specifications of his patent, as it stood, were inoperative. He was obliged to aver and prove that they were so. * * * If this was true, the patentee had been exploiting a patent which, though it might have contained the germ of an invention, was practically useless to the public, for a patent which does not disclose a way to work or use the invention does not constitute the expected consideration for the grant. Having averred in a solemn manner, and to induce the granting a reissue, that the fact was as just stated, he was estopped from claiming otherwise. * * * *Moffitt v. Garr*, 1 Black. 273, 17 L. ed. 207; *Reedy v. Scott*, 23 Wall. 352, 23 L. ed. 109; *Peck v. Collins*, 103 U. S. 660, 26 L. ed. 512; *Gage v. Herring*, 107 U. S. 640, 2 Sup. Ct. 819, 27 L. ed. 601; *Coon v. Wilson*, 113 U. S. 268, 5 Sup. Ct. 537, 28 L. ed. 963; *Eby v. King*, 158 U.

S. 366, 15 Sup. Ct. 972, 39 L. ed. 1018; *Allen v. Culp*, 166 U. S. 501, 17 Sup. Ct. 644, 41 L. ed. 1093; *McCormick Machine Co. v. Aultman*, 169 U. S. 606, 18 Sup. Ct. 443, 42 L. ed. 875.

706. DOBSON v. LEES, 137 U. S. 258, 34 L. ed. 652, 11 Sup. Ct. 71.

A reissue is an amendment, and can not be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. Rev. Stat., § 4916. Hence the reissue can not be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the patent office, which narrow the scope of the invention as at first described and claimed, are instances of such omission. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S. 624; *Shepard v. Carrigan*, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342, 379, and cases cited.

707. FREEMAN v. ASMUS, 145 U. S. 226, 36 L. ed. 685, 12 Sup. Ct. 939.

There have been numerous decisions in this court which require that the present reissue be held invalid, although it was applied for within less than a year after the granting of the original patent. Those cases are *Mahn v. Harwood*, 112 U. S. 354; *Coon v. Wilson*, 113 U. S. 268; *Ives v. Sargent*, 119 U. S. 652; *Parker & W. Co. v. Yale Clock Co.*, 123 U. S. 87; *Matthews v. Ironclad Mfg. Co.*, 124 U. S. 347; *Hoskin v. Fisher*, 125 U. S. 217; *Flower v. Detroit*, 127 U. S. 563; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342; *Electric Gas Lighting Co. v. Boston Electric Co.*, 139 U. S. 481.

708. EBY v. KING, 158 U. S. 366, 39 L. ed. 1018, 15 Sup. Ct. 972.

Had the plaintiff, in his reissue, confined himself to the correction of an error so manifest, we should have found little difficulty in sustaining it; but in his application, which was made four years after the original patent, he makes no claim that his patent "was inoperative or invalid, by reason of a defective or insufficient specification," or by reason of his having claimed "more than he had a right to claim as new," or that any error had arisen, "by inadvertence, accident, or mistake," without which the commissioner has no right to grant a reissue but simply prays that he may be allowed to surrender his original patent, and that "letters-patent may be reissued to him for the same invention, upon the annexed amended specification." He makes

no reference at all to the obvious mistakes in his first claim, and although the point is not distinctly made in the briefs, we think it a serious question, whether the Commissioner of Patents had any jurisdiction under Rev. Stat., 4916, to consider the application upon the bare statement that the patentee desired to surrender his patent and obtain a reissue.

709. McMURRAY v. MALLORY, 111 U. S. 97, 28 L. ed. 365, 4 Sup. Ct. 375.

It is not competent for the patentee or his assignees, by merely disclaiming all the changes made in the reissued patent, to revive and restore the original patent. This could be done only, if it could be done at all, by surrender of the reissued patent and the grant of another reissue.

710. YALE LOCK MFG. CO. v. SARGENT, 117 U. S. 536, 29 L. ed. 954, 6 Sup. Ct. 934.

“That case [*Gage v. Herring*, 107 U. S. 640], holds that the invalidity of a new claim in a reissue does not impair the validity of a claim in it which is only a repetition and separate statement of a claim in the original patent. It also holds that a reissued patent is within the letter and spirit of the provisions of §§ 4917 and 4922; and that where a defendant has infringed such a restated valid claim of a reissue, the plaintiff, on filing a disclaimer of the new and invalid claims of the reissue, may have a decree, without costs, for the infringement of such valid claim, where there has been no unreasonable delay in entering the disclaimer.”

711. ELECTRIC GAS LIGHTING CO. v. BOSTON ELECTRIC CO., 139 U. S. 481, 35 L. ed. 250, 11 Sup. Ct. 586.

Nor was the application for the reissue made because Tirrell in the original had claimed as his invention more than he had a right to claim as new, for his oath declares that the defect consists in the “omission of claims.”

Moreover, the unexplained delay in applying for the reissue must be regarded as fatal to its claims. *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 355; *Clements v. Odorless E. A. Co.*, 109 U. S. 641, 649; *Mahn v. Harwood*, 112 U. S. 354, 363; *Wolensak v. Reiher*, 115 U. S. 96, 100; *Ives v. Sargent*, 119 U. S. 652, 662; *Hoskin v. Fisher*, 125 U. S. 217.

Nor was there any inadvertence, accident or mistake such as would authorize a reissue with new claims. *Clements v. Odorless E. A. Co.*, 109 U. S. 641, 649; *Mahn v. Harwood*, 112 U. S. 354, 359; *Coon v. Wilson*, 113 U. S. 268, 277; *Newton v. Furst & B. Co.*, 119 U. S. 373, 385; *Worden v. Searls*, 121 U. S. 14, 24; *Matthews v. Ironclad Mfg. Co.*, 124 U. S. 347.

712. GILL v. WELLS, 89 U. S. 1, 22 L. ed. 699.

Equivalents are, doubtless, allowed to a patentee or owner of the patent to shut out infringements, but the Patent Act furnishes no support to the theory that the patentee may surrender a patent for an invention consisting of a combination of old ingredients, and amend the descriptive parts of the specification by striking out the entire description of one of the ingredients of the combination and inserting in lieu thereof a full description of several other devices without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever showing the reason why the change was made.

713. McNEELEY v. WILLIAMES, 96 Fed. 978, 37 C. C. A. 641.

On the assumption that it was incumbent on him to disclaim, if his omission to do so was the result of unreasonable neglect or delay, the complainants were not entitled to recover anything, while, if there was no such neglect or delay, they were entitled to recover damages but no costs. No disclaimer was necessary to the recovery either of damages or of costs unless Williames in those three claims or one or more of them included something to which he was not entitled.

714. HAILES v. ALBANY STOVE CO., 123 U. S. 582, 31 L. ed. 284, 8 Sup. Ct. 262.

A disclaimer is usually and properly employed for the surrender of a separate claim in a patent, or some other distinct and separable matter, which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms, but certainly it can not be used to change the character of the invention. And if it required an amended specification or supplemental description to make an altered claim intelligible or relevant, whilst it may possibly present a case for a surrender and reissue, it is clearly not adapted to a disclaimer. A man can not, by merely filing a paper drawn up by his solicitor, make to himself a new patent, or one for a different invention from that which he has described in his specification.

715. LAMB KNIT GOODS CO. v. LAMB GLOVE, ETC., CO., 120 Fed. 267, 56 C. C. A. 547.

If the patent, when construed upon what stands, "within its four corners," claims more than the actual invention, the patentee must disclaim the excess in order to save that to which he is really entitled.

716. GAGE v. HERRING, 107 U. S. 640, 27 L. ed. 601, 2 Sup. Ct. 819.

Considering that the question of the validity of the new claim in the reissue is a question of law upon the face of the patent, and that its validity has been sanctioned by the Commissioner of Patents in granting the reissue, and upheld by the circuit court, there has been no unreasonable delay in entering a disclaimer; for the plaintiffs were not bound to disclaim until after a judgment of this court upon the question.

717. DUNBAR v. MEYERS, 94 U. S. 187, 24 L. ed. 34.

Matters properly disclaimed cease to be a part of the invention and it follows that the construction of the patent must be the same as it would be if such matters had never been included in the description of the invention or the claim of the specification.

718. UNITED STATES v. AMERICAN BELL TEL. CO., 167 U. S. 224, 42 L. ed. 144, 17 Sup. Ct. 809.

The government, therefore, if seeking simply to protect the right of an individual, ought not to be permitted to maintain a suit in equity to cancel that against which the individual has a perfect legal defense available in any action brought by or against him.

719.

[§§ 4924 to 4928 relating to *extension* of patents—that is, giving a new term after the expiration of the term of the grant—are now obsolete. A patent may be extended only by special act of Congress.]

PART XI.

TITLE—GRANT, INHERITANCE, ASSIGNMENT.

Legal and Equitable—By Occupancy—By Assignment, Grant or Conveyance—By Creditor's Bill—By Bankruptcy—By Succession or Inheritance.

STATUTES.

720. ASSIGNMENTS OF PATENTS.

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

If any such assignment, grant or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance.

721. WHAT PROPERTY VESTS IN ASSIGNEE.

§ 5046. All property conveyed by the bankrupt in fraud of his creditors; all rights in equity, choses in action, patent-rights, and copyrights; all debts due him, or any person for his use, and all liens and securities therefor; and all his rights of action for property or estate, real or personal, and for any cause of action which he had against any person arising from contract or from the unlawful taking or detention, or injury to the property of the bankrupt; and all his rights of redeeming such property or estate; together with the like right, title, power, and authority to sell, manage, dispose of, sue for, and recover or defend the

same, as the bankrupt might have had if no assignment had been made, shall, in virtue of the adjudication of bankruptcy and the appointment of his assignee, but subject to the exceptions stated in the preceding section, be at once vested in [in] such assignee.

722. ACT OF JULY 1, 1898.

§ 70. Title to Property. The trustee of the estate of a bankrupt, upon his appointment and qualification, and his successor or successors, if he shall have one or more, upon his or their appointment and qualification, shall in turn be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, except in so far as it is to property which is exempt, to all (1) documents relating to his property, (2) interests in patents, patent rights, copyrights, and trademarks.

RULES OF PRACTICE.

723. ASSIGNABILITY OF PATENTS.

195. Every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under the patent to the whole or any specified part of the United States.

723a. IN WHOM MAY BE VESTED.

196. Interest in patents may be vested in assignees, in grantees of exclusive sectional rights, in mortgagees, and in licensees.

724. ASSIGNEES.

(1) An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed and duly signed.

725. GRANTEES.

(2) A grantee acquires by the granting the exclusive right, under the patent, to make, use, and vend, and to grant to others the right to make, use, and vend, the thing patented within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed and be duly signed.

726. MORTGAGES.

(3) A mortgage must be written or printed and be duly signed.

727. LICENSES.

(4) A licensee takes an interest less than or different from either of the others. A license may be oral, written, or printed, and if written or printed, must be duly signed.

728. RECORDING.

197. An assignment, grant, or conveyance of a patent will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice unless recorded in the patent office within three months from the date thereof.

729. ACKNOWLEDGMENT.

If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, or conveyance.

730. RECORDING.

198. No instrument will be recorded which is not in the English language and which does not, in the judgment of the commissioner, amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates. Such instrument should identify the patent by date and number; or, if the invention be unpatented, the name of the inventor, the serial number, and date of the application should be stated.

731. CONDITIONAL ASSIGNMENTS.

199. Assignments which are made conditional on the performance of certain stipulations, as the payment of money if recorded in the office, are regarded as absolute assignments until canceled with the written consent of both parties or by the decree of a competent court. The office has no means for determining whether such conditions have been fulfilled.

732. DATE OF RECORD.

200. In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the pat-

ent office at a date not later than the day on which the final fee is paid. (See Rule 26.) The date of the record is the date of the receipt of the assignment at the office.

733. RECEIPT, RECORDING, AND RETURN OF ASSIGNMENTS.

201. The receipt of assignments is generally acknowledged by the office. They are recorded in regular order as promptly as possible, and then transmitted to the persons entitled to them. (For form of assignment, see Appendix, Forms 38-43.)

734. GAYLER ET AL. v. WILDER, 10 Howard (U. S.) 477, 13 L. ed. 504 (1850). * * *

Three objections have been taken to the instructions given by the circuit court at the trial, and neither of them is, perhaps, entirely free from difficulty. The first question arises upon the assignment of Fitzgerald to Enos Wilder. The assignment was made and recorded in the patent office before the patent issued. It afterwards issued to Fitzgerald. And the plaintiffs in error insist that this assignment did not convey to Wilder the legal right to the monopoly subsequently conferred by the patent, and that the plaintiff, who claims under him, can not therefore maintain this action.

The inventor of a new and useful improvement certainly has no exclusive right to it, until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. Fitzgerald possessed this inchoate right at the time of the assignment. The discovery had been made, and the specification prepared to obtain a patent. And it appears by the language of the assignment, that it was intended to operate upon the perfect legal title which Fitzgerald then had a lawful right to obtain, as well as upon the imperfect and inchoate interest which he actually possessed. The assignment requests that the patent may issue to the assignee. And there would seem to be no sound reason for defeating the intention of the parties by restraining the assignment to the latter interest, and compelling them to execute another transfer, unless the act of congress makes it necessary. The court think it does not. The act of 1836 declares that every patent shall be assignable in law, and that the assignment must be in writing, and recorded within the time specified. But the thing to be assigned is not the mere parchment on which the grant is written. It is the

monopoly which the grant confers; the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the provisions of the act of congress.

And we are the less disposed to give it a different construction, because no purpose of justice would be answered by it, and the one we now give was the received construction of the act of 1793 (1 Stats. at Large, 318) in several of the circuits; and there is no material difference in this respect between the two acts. As long ago as 1825, it was held by Mr. Justice Story, that in a case of this kind an action could not be maintained in the name of the patentee, but must be brought by the assignee. (4 Mason 115). We understand the same rule has prevailed in other circuits; and if it were now changed, it might produce much injustice to assignees who have relied on such assignments, and defeat pending suits brought upon the faith of long-established judicial practice and judicial decision. Fitzgerald sets up no claim against the assignment, and to require another to complete the transfer would be mere form. We do not think the act of congress requires it; but that, when the patent issued to him, the legal right to the monopoly and property it created was, by operation of the assignment then on record, vested in Enos Wilder.

The next question is upon the agreement between the defendant in error and Herring. Is this instrument an assignment to Herring for the State or city of New York, upon which he might have sued in his own name? If it is, then this action cannot be maintained by the defendant in error.

Now, the monopoly granted to the patentee is for one entire thing; it is the exclusive right of making, using, and vending to others to be used, the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights, therefore, which may be exercised under it cannot be regulated by the rules of the common law. It is created by the act of congress; and no rights can be acquired in it unless authorized by statute, and in the manner the statute prescribes.

By the eleventh section of the act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint owners of the whole interest secured by the patent,

according to the respective proportions which the assignment creates.

By the fourteenth section, the patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assignment the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself, as well as others. And any assignment short of this is a mere license. For it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place. Unquestionably, a contract for the purchase of any portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. This is the view taken of the subject in the case of *Blanchard v. Eldridge*, 1 Wall. Jr., 337, and we think it the true one.

Applying these principles to the case before us, the action was properly brought by the plaintiff below, and could not have been maintained by Herring.

The agreement is singularly confused and complicated. It purports to grant to Herring the exclusive right to make and vend the Salamander safe in the city, county, and State of New York; and Herring agrees to pay to the defendant in error a cent a pound for every pound the safes might weigh, to be paid monthly. But at the same time it reserves to Wilder the right to set up a manufactory or works for making these safes in the State of New York, provided it is not within fifty miles of the city, and to sell them in the State of New York, paying to Herring a cent a pound on each safe so sold within the State. It is evident that this agreement is not an assignment of an undivided interest in the whole patent, nor the assignment of an exclusive right to the entire monopoly in the State or city of New York. It is therefore to be regarded as a license only, and under the act of congress does not enable Herring to main-

tain an action for an infringement of the patent right. The defendant in error continues the legal owner of the monopoly created by the patent. * * *

735. **LITTLEFIELD v. PERRY**, 21 Wall. (U. S.) 205, 22 L. ed. 577.

Opinion by Waite, C. J.: * * *

We are met at the outset of this case with a question of jurisdiction. All the parties, plaintiff as well as defendant, are citizens of the State of New York. The power of the Circuit Court, therefore, to entertain the cause, if it exists at all, must be found in the jurisdiction conferred by the patent laws.

The suit is in equity against a patentee by one who claims to be his assignee, to restrain him from infringing upon rights under his patent, which are alleged to have been assigned. The Circuit Court has jurisdiction of all suits arising under the patent laws, and has power, upon a bill in equity filed by a party aggrieved, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of any right secured by patent. Every patent, or any interest therein, is by statute made assignable by an instrument in writing, and the patentee or his assignee may, in like manner, grant and convey an exclusive right under his patent throughout any specified part of the United States. All such assignments must be recorded in the Patent Office within three months from the time of their execution. This power of assignment has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or undivided part thereof within and throughout a certain specified portion of the United States. One holding such an assignment is an assignee within the meaning of the statute, and may prosecute in the Circuit Court any action that may be necessary for the protection of his rights under the patent.

The title of the complainant in this case grows out of what is termed in the answers "a grant and supplementary agreement," executed in "two parts," between Littlefield, the patentee, and Treadwell & Perry. The "grant" is one of the parts, and the "supplementary agreement" the other. The grant, taken by itself, contains, in most unmistakable language, an absolute conveyance by the patentee of his patent and inventions described, and all improvements thereon, within and throughout the States of New York and Connecticut, and an agreement by the assignees to pay a royalty on all patented articles sold, with a clause of forfeiture in case of non-payment or neglect, after due notice, to make and sell the patented articles to the extent of a reasonable demand therefor. This grant was duly recorded in the Patent Office six days after its execution.

The supplementary agreement was never recorded. It contained, among other things, a stipulation to the effect that nothing in the assignment should give to Treadwell & Perry the right to use or apply the principle of the patent to furnaces erected in cellars or basements of houses for the purpose of heating several rooms, it being the intention of the patentee to reserve that to himself. It also contained certain other stipulations between the parties intended for the protection of their respective rights and the regulation of their conduct under the assignment. The defendants now contend that by reason of this reservation, and these several stipulations, the title of Treadwell & Perry, under the grant, has been reduced from that of assignees to mere licenses.

Undoubtedly, for the purpose of ascertaining the intention of the parties in making their contract, the two instruments, executed as they were at the same time, and each referring to the other, are to be construed together. If, when so construed, they shall be found to convey to the assignees the title to the patent and inventions and grant a license back from the assignees to the patentee of the right to use the patent and its principle in the manufacture of the designated furnaces, the Circuit Court had jurisdiction of the cause.

When the "grant" was placed on record, Treadwell & Perry became the apparent owners of the entire patent and inventions throughout the specified territory. Neither the agreement to account and pay the royalty nor the clause of forfeiture for non-performance contained in that instrument reduced them to the position of licensees. The agreement to account and pay formed part of the consideration of the assignment, and was in effect an agreement to pay at a future time a sum to be determined by the number of articles made and sold. For the non-payment or other non-performance a forfeiture might be enforced as for condition broken, but until it was enforced the title granted remained in the assignees.

The supplementary agreement contained a provision that Littlefield should sue infringers "in his own name or otherwise," and also defend all suits against Treadwell & Perry for alleged infringements of other patents by the use of his, and this it is alleged is evidence of the intention of the parties to make the grant effective only as a license. It needs only a slight examination of that clause in the contract, however, to become satisfied that it was intended only as a provision for placing on Littlefield the costs and expenses of all such litigation, as well as all damages for infringements growing out of the use of the inventions by the assignees. The suits were to be prosecuted in his name, or otherwise, as circumstances should

require, and he was to be at all the costs and expense of maintaining his patents. That is the extent of the provision.

Upon the argument, the reservation of the right to use the principle of the patent and inventions in the manufacture of furnaces seemed to be relied upon with more confidence as establishing this claim on the part of the defendants. All agree that the intention of the parties, when ascertained by an examination of both the instruments, must govern in this action where only the parties themselves are interested. There are no intervening innocent third persons. Jagger, the partner of Littlefield, who is codefendant with him, is charged with full notice of the rights of Treadwell & Perry, and others claiming under them.

It is a significant fact that the agreement was executed in two parts. Ordinarily the whole of such a contract is embodied in a single instrument. Another important fact is, that only one of the parts is recorded, and that the one which, taken by itself, places the title in Treadwell & Perry. The record is intended for the benefit of the public. Bona fide purchasers look to it for their protection. The record of the grant alone, therefore, furnishes the strongest evidence of the intention of the parties to give effect to the two instruments as an assignment. It is true that in the recorded part reference is made to the other, but the manner of the reference is not such as to indicate that the unrecorded part contained anything to defeat the title granted by that which was recorded. The language is, "in consideration of one dollar, and of the agreements herein contained on the part of the parties of the second part, and of the agreements contained in a certain agreement this day executed between the parties hereto, and bearing even date herewith, hath, and by these presents doth, assign," etc. And again: "It is expressly understood and agreed between the said parties that in case said party of the first part shall well and faithfully keep and perform all the agreements herein, and in the aforesaid agreement bearing even date herewith contained, and said parties of the second part shall, etc., neglect, etc., that this assignment and transfer shall thereafter be void and of no effect," etc. This is undoubtedly sufficient to charge purchasers with notice of the execution of the supplementary agreement, and possibly of its provisions, but it falls far short of indicating an intention of the parties, by anything contained in the unrecorded instrument, to limit or defeat the assignment made in consideration of it. The most that can be inferred from such language is, that the parties had stipulated between themselves, not as to the legal effect of the recorded instrument, but as to their obligations or equitable rights under it. We think, therefore,

that Treadwell & Perry were the assignees of Littlefield within the meaning of the patent laws, and that they and those claiming under them may sue in the Circuit Courts to prevent an infringement upon their rights.

But even if they are not technically assignees, we think this action is, nevertheless, maintainable. They certainly had the exclusive right to the use of the patent for certain purposes within their territory. They thus held a right under the patent. The claim is that this right has been infringed. To determine the suit, therefore, it is necessary to inquire whether there has been an infringement, and that involves a construction of the patents. The act of Congress provides "that all actions, suits, controversies, and cases arising under any law of the United States granting or confirming to inventors the exclusive right to their inventions or discoveries shall be originally cognizable, as well in equity as at law, in the Circuit Courts," etc. An action which raises a question of infringement is an action arising "under the law," and one who has the right to sue for the infringement may sue in the Circuit Court. Such a suit may involve the construction of a contract as well as the patent, but that will not oust the court of its jurisdiction. If the patent is involved it carries with it the whole case.

A mere licensee cannot sue strangers who infringe. In such case redress is obtained through or in the name of the patentee or his assignee. Here, however, the patentee is the infringer, and as he cannot sue himself, the licensee is powerless so far as the courts of the United States are concerned, unless he can sue in his own name. A court of equity looks to substance rather than form. When it has jurisdiction of parties it grants the appropriate relief without regard to whether they come as plaintiff or defendant. In this case the person who should have protected the plaintiff against all infringements has become himself the infringer. He held the legal title to his patent in trust for his licensees. He has been faithless to his trust, and courts of equity are always open for the redress of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the patent laws, and of that suit the Circuit Court has jurisdiction.

It is next asserted that the complainant has not by his proof shown himself to be the assignee of Treadwell & Perry. They, on the 25th of March, 1862, assigned all their interest to George W. Sterling. He became dissatisfied with his purchase, and, by agreement of parties, the sale was cancelled, he giving effect to the cancellation by executing a reassignment to Treadwell & Perry, bearing date June 2d, 1862. Under date of April 7th, 1862, Treadwell & Perry executed another assignment to one

Dickey. Both the reassignment from Sterling and the assignment to Dickey were left at the Patent Office for record on the 26th June, 1862, and on the 2d July Dickey assigned to Mary J. Perry, in whose name the suit was commenced.

It is now claimed that this proof shows title in Treadwell & Perry, inasmuch as Sterling reassigned to them after they had assigned to Dickey. Mrs. Perry was the wife of John S. Perry, one of the firm, and he is now a party to the suit, having upon her death succeeded to all her rights, as trustee under her will. Treadwell, the other member of the firm, has been several times in the progress of the cause examined as a witness, and has testified that Dickey became the owner of the patents under a transfer to which he consented. It is clear, therefore, that Mrs. Perry at the commencement of the action was in equity, if not in law, the owner of whatever had been assigned by Littlefield, and that if Treadwell & Perry had the legal title, they held it in trust for her, and will be estopped by a decree in her favor from setting up as against Littlefield any beneficial interest under it. At an earlier stage of the proceedings it might have been proper to make Treadwell a party, but upon the case as it now stands no possible harm can result to the defendants from a decree against them in his absence.

This brings us to a consideration of the merits of the case.

On the 15th April, 1851, a patent was issued to Littlefield for a certain improvement in cooking-stoves, and on the 30th December, 1852, he filed in the Patent Office his application for another improvement in stoves, devised "for the purpose of economizing and burning the gases generated by the combustion of anthracite coals." On the 5th April, 1853, he executed the grant and supplementary agreement already referred to. In the grant, after reciting that he held a patent bearing date April 15th, 1851, "for a coal-burner so constructed as to produce combustion of the inflammable gases of anthracite coals," and that he had "made application to the Patent Office at Washington for letters patent securing to him a certain improvement in the invention so as aforesaid patented to him," and that such application was then pending, he proceeded to assign all the right, title, and interest which he then had, or might thereafter have, "in or to the aforesaid inventions, improvement, and patent, or the patent or patents that may be granted for said inventions or any improvement therein, and on any extension or extensions thereof within and throughout the district, etc., for and during the term for which the aforesaid letters-patent were granted, and the terms for which any patent for the aforesaid improvement or any improvement or improvements thereof may be granted," etc. The application of December 30th, 1852, was

rejected at the Patent Office, and finally withdrawn by Littlefield on the 22d day of July, 1853, he at the same time filing another application for "a new and useful improvement in stoves," so devised as "to burn the gaseous or more inflammable elements of the coal in contact with its more refractory portions, and thus secure a complete combustion of them both." Upon this application a patent was issued January 20th, 1854. All the patents outstanding, and the subject of this controversy, are admitted to be reissues of this or improvements upon it. Littlefield and his codefendant do not deny that they have used the patents issued after January, 1854, and if the title to them passed under the assignment of April, 1853, it is admitted that such use is an infringement and that the complainant is entitled to a decree. The simple question, then, presented for our consideration is as to the effect to be given to this assignment.

It is well settled that a recorded assignment of a perfected invention, made before a patent has issued, carries with it the patent when issued (*Gayler v. Wilder*, 10 How. 477) and that reissues are not patents for new inventions, but amendments of old patents. If a reissue is obtained with the consent of an assignee, it inures at once to his benefit; if without, he has his election to accept or reject it.

The parties have themselves agreed that the invention of 1852 is an improvement upon the patent of 1851. In the grant the patent is described as being "for a coal-burner, so constructed as to produce combustion of the inflammable gases of anthracite coal," and the application as being for an improvement upon the patent. It is true that the application is not referred to by its date, but there can be no doubt as to its identity, because the language adopted to describe the patent is not that of the claim in the patent itself, but of the application of 1852. Besides, the application is said to be then pending, and it is not pretended that Littlefield had any other on file in the Patent Office at that date. This relieves us from an examination of the specifications in the patent and application, for the purpose of ascertaining whether in point of fact the one was an improvement upon the other. Littlefield having agreed that it was, and having induced Treadwell & Perry to purchase by reason of this agreement, cannot now deny it.

It is clear, also, that the idea which Littlefield had in mind, and which he was endeavoring by his devices to make practically useful, was greater economy in the use of the inflammable gases of coal to produce combustion. It is not important in this suit that the patent, which had then been obtained, was not in fact suited for that purpose. It is sufficient that it was intended to be so. The subsequent devices, better adapted to the

end to be accomplished, may therefore properly be regarded as improvements upon the original invention. They produce a stove doing the same thing which the first was intended to do, but doing it better. This is the proper office of an improvement.

The assignment in this case, by its express terms, covers all improvements in the original patent or the invention described in the application of 1852. It carried with it the legal title to the existing patent. If one had been issued upon the application, that, too, would have inured to the benefit of the assignee, because in that case it would have been the assignment of a perfected invention. Without considering whether the invention upon which the patent of 1854 issued was not, in fact, the same to all intents and purposes as that of 1852, it is sufficient for the purposes of this case that it was an improvement upon it, or perhaps more properly, that invention perfected. An assignment of an imperfect invention, with all improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results. The assignment in this case being such a one, the assignees became in equity the owners of the patent granted upon the perfected invention; that is to say, of the patent of 1854. Littlefield took the legal title in trust for them, and should convey. Courts of equity in proper cases consider that as done which should be. If there exists an obligation to convey at once, such courts will oftentimes proceed as if it had actually been made. * * *

736. SIMPSON v. WILSON, 4 How. (U. S.) 712, 11 L. ed. 1171.

Nelson J., delivered the opinion of the court. * * *

The questions in this case come up on the certificate of a division of opinion in the court below. The judgment of this court in the previous case of *Wilson v. Rousseau et al.*, 4 How. 646, upon the second question certified in that case, disposes of the first question certified here, and is answered accordingly.

The second question certified involves the point, whether or not the assignment of an exclusive right to make and use, and to vend to others, planing machines, within a given territory only, authorizes the assignee to vend elsewhere, out of the said territory, the plank, boards, and other materials, the product of said machines.

The court have no doubt but that it does; and that the restriction in the assignment is to be construed as applying solely to the using of the machine. There is no restriction, as to place, of the sale of the product. * * *

737. *WATERMAN v. MACKENZIE*, 138 U. S. 252, 34 L. ed. 923, 11 Sup. Ct. 334 (1891).

[This case strictly falls under the next heading, but its broad definitions make it advisable to place it here.] * * *

Mr. Justice Gray, after stating the facts as above, delivered the opinion of the court.

Every patent issued under the laws of the United States for an invention or discovery contains "a grant to the patentee, his heirs and assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the territories thereof." (Rev. St. § 4884.) The monopoly thus granted is one entire thing, and cannot be divided into parts, except as authorized by those laws. The patentee or his assigns may, by instrument in writing, assign, grant, and convey, either (1) the whole patent, comprising the exclusive right to make, use, and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States. *Id.* § 4898. A transfer of either of these three kinds of interests is an assignment, properly speaking, and vests in the assignee a title in so much of the patent itself, with a right to sue infringers. In the second case, jointly with the assignor. In the first and third cases, in the name of the assignee alone. Any assignment or transfer, short of one of these, is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for an infringement. *Id.* § 4919; *Gayler v. Wilder*, 10 How. 477, 494, 495; *Moore v. Marsh*, 7 Wall. 515. In equity, as at law, when the transfer amounts to a license only, the title remains in the owner of the patent; and suit must be brought in his name, and never in the name of the licensee alone unless that is necessary to prevent an absolute failure of justice, as where the patentee is the infringer, and cannot sue himself. Any rights of the licensee must be enforced through or in the name of the owner of the patent, and perhaps, if necessary to protect the rights of all parties, joining the licensee with him as a plaintiff. Rev. Stat., § 4921; *Littlefield v. Perry*, 21 Wall. 205, 223; *Paper Bag Cases*, 105 U. S. 766, 771; *Birdsell v. Shaliol*, 112 U. S. 485-487, 5 Sup. Ct. Rep. 244; and see *Renard v. Livinstein*, 2 Hem. & M. 628. Whether a transfer of a particular right or interest under a patent is an assignment or a license does not depend upon the name by which it calls itself, but upon the legal effect of its provisions. For instance, a grant of an exclusive right to make use, and vend two patented machines within a certain district is an assignment, and gives the grantee the right to sue in his own name for an infringement within the

district, because the right, although limited to making, using, and vending two machines, excludes all other persons, even the patentee, from making, using, or vending like machines within the district. *Wilson v. Rousseau*, 4 How. 646, 686. On the other hand, the grant of an exclusive right under the patent within a certain district, which does not include the right to make, and the right to use, and the right to sell, is not a grant of a title in the whole patent-right within the district, and is therefore only a license. Such, for instance, is a grant of "the full and exclusive right to make and vend" within a certain district, reserving to the grantor the right to make within the district, to be sold outside of it. *Gayler v. Wilder*, above cited. So is a grant of "the exclusive right to make and use," but not to sell, patented machines within a certain district. *Mitchell v. Hawley*, 16 Wall. 544. So is an instrument granting "the sole right and privilege of manufacturing and selling" patented articles, and not expressly authorizing their use, because, though this might carry by implication the right to use articles made under the patent by the licensee, it certainly would not authorize him to use such articles made by others. *Hayward v. Andrews*, 106 U. S. 672, 1 Sup. Ct. Rep. 544. See, also, *Oliver v. Chemical Works*, 109 U. S. 75, 3 Sup. Ct. Rep. 61. An assignment of the entire patent, or of an undivided part thereof, or of the exclusive right under the patent for a limited territory, may be either absolute or by way of mortgage, and liable to be defeated by non-performance of a condition subsequent, as clearly appears in the provision of the statute, that "an assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice, unless it is recorded in the patent office within three months from the date thereof." (Rev. St. § 4898.) Before proceeding to consider the nature and effect of the various instruments given in evidence at the hearing in the circuit court, it is fit to observe that (as was assumed in the argument for the plaintiff) by the law of the state of New York, where all the instruments were made and all the parties to them resided, husband and wife are authorized to make conveyances and contracts of and concerning personal property to and with each other, in the same manner and to the same effect as if they were strangers. *Armitage v. Mace*, 96 N. Y. 538; *Adams v. Adams*, 91 N. Y. 381.

By the deed of assignment of February 13, 1884, the plaintiff assigned to Mrs. Waterman the entire patent right. That assignment vested in her the whole title in the patent, and the exclusive right to sue, either at law or in equity, for its subsequent infringement.

The next instrument in order of date is the "license agreement" between them of November 20, 1884, by which she granted to him "the sole and exclusive right and license to manufacture and sell fountain pen-holders containing the said patented improvement throughout the United States." This did not include the right to use such pen-holders, at least if manufactured by third persons, and was therefore a mere license, and not an assignment of any title, and did not give the licensee the right to sue alone, at law or in equity, for an infringement of the patent. *Gayler v. Wilder, Paper Bag Cases*, and *Hayward v. Andrews*, above cited. The plaintiff not having amended his bill, pursuant to the leave granted by the circuit court, by joining the licensor as a plaintiff, this point requires no further notice. Nor is it doubted that the circuit court rightly held that, if the plaintiff was entitled to recover only for infringements occurring between February 12 and November 25, 1884, his remedy was at law. *Root v. Railway Co.*, 105 U. S. 189.

The remaining question in the case, distinctly presented by the plea, and adjudged by the circuit court, is of the effect of the deed of November 25, 1884, by which Mrs. Waterman assigned to the firm of Asa L. Shipman's Sons all her right, title, and interest in the invention and the patent, with an express provision that the assignment should be null and void if she and her husband, or either of them, should pay at maturity a certain promissory note of the same date made by them, and payable to the grantees. This instrument, being a conveyance made to secure the payment of a debt, upon condition that it should be avoided by the subsequent payment of that debt at a time fixed, was a mortgage, in apt terms, and in legal effect. *Conard v. Insurance Co.*, 1 Pet. 386, 446, 447. On the same day, the mortgagees assigned by deed to Asa L. Shipman all their title under the mortgage, and the promissory note thereby secured. Both assignments were recorded in the patent office within three months after their date, and the title thereby acquired by Shipman was outstanding in him at the time of the subsequent assignment of the patent right by Mrs. Waterman to the plaintiff, and of the filing of this bill. This last assignment was therefore subject to the mortgage, though not in terms so expressed. By a mortgage of personal property, differing in this respect from a pledge, it is not merely the possession or a special property that passes; but, both at law and in equity, the whole title is transferred to the mortgagee, as security for the debt, subject only to be defeated by performance of the condition, or by redemption on bill in equity within a reasonable time, and the right of possession, when there is no express stipulation to the contrary, goes with the right of property. *Story, Bailm.*

§ 287; 2 Story, Eq. Jur. §§ 1030, 1031; *Conard v. Insurance Co.*, 1 Pet. 386, 441; *Casey v. Cavaroc*, 96 U. S. 467, 477; *Boise v. Knox*, 10 Metc. (Mass.) 40, 43; *Brackett v. Bullard*, 12 Metc. (Mass.) 308, 310. A mortgage of real estate has gradually partly by the adoption of rules of equity in courts of common law, and partly by express provisions of statute, come to be more and more considered as a mere security for the debt, creating a lien or incumbrance only, and leaving the title in the mortgagor, subject to alienation, levy on execution, dower, and other incidents of a legal estate; but the rules upon the subject vary in different states, and a mortgage is everywhere considered as passing the title in the land, so far as may be necessary for the protection of the mortgagee, and to give him the full benefit of his security. *Stelle v. Carroll*, 12 Pet. 201; *Van Ness v. Hyatt*, 13 Pet. 294; *Hutchins v. King*, 1 Wall. 53, 58; *Brobst v. Brock*, 10 Wall. 519, 529, 530. After the mortgagee has taken possession, the mortgagor has no power to lease, and the mortgagee is entitled to have, and is bound to account for, the accruing rents and profits, damages against trespassers, timber cut on the premises, and growing crops. *Keech v. Hall*, 1 Doug. 21; *Turner v. Coal Co.*, 5 Exch. 932; *Dawson v. Johnson*, 1 Fost. & F. 656; *Fairclough v. Marshall*, 4 Exch. Div. 37, 47, 49; *Scruggs v. Railroad Co.*, 108 U. S. 368, 375, 2 Sup. Ct. Rep. 780; *Teal v. Walker*, 111 U. S. 242, 4 Sup. Ct. Rep. 420; *Hutchins v. King*, above cited; *Gore v. Jenness*, 19 Me. 53; *Bagnall v. Villar*, 12 Ch. Div. 812. Even against a mortgagor in possession, the mortgagee may obtain an injunction or damages for such cutting of timber as tends to impair the value of the mortgage security, or as is not allowed by good husbandry or by express or implied license from the mortgagee. *Robinson v. Litton*, 3 Atk. 209, 210; *Farrant v. Lovel*, Id. 723; *Hampton v. Hodges*, 8 Ves. 105; *Humphreys v. Harrison*, 1 Jac. & W. 581; *King v. Smith*, 2 Hare, 239; *Kountze v. Hotel Co.*, 107 U. S. 378, 395, 2 Sup. Ct. Rep. 911; *Verner v. Betz*, 46 N. J. Eq. 256, 267, 268; *Page v. Robinson*, 10 Cush. 99; *Searle v. Sawyer*, 127 Mass. 491; *Waterman v. Matteson*, 4 R. I. 539. A mortgagee of a leasehold or other personal property has the like right to an injunction to stay waste by the mortgagor. *Farrant v. Lovel*, above cited; *Brown v. Stewart*, 1 Md. Ch. 87; *Parsons v. Hughes*, 12 Md. 1. The right of action against a stranger for an injury to goods mortgaged, generally, though not always, depends upon the right of possession. When the right of possession is in the mortgagor, he is usually the proper party to sue. *Sellick v. Smith*, 11 Moore, C. P. 459, 475; *Brierly v. Kendall*, 17 Q. B. 937; *Luse v. Jones*, 39 N. J. Law, 707; *Copp v. Williams*, 135 Mass. 401. But even a mortgagee out of possession may sometimes maintain

an action for an injury to his interest. *Gooding v. Shea*, 103 Mass. 360; *Manning v. Monaghan*, 23 N. Y. 539, and 28 N. Y. 585; *Woodside v. Adams*, 40 N. J. Law, 417, 421, 422. And when the right of possession, as well as the general right of property, is in the mortgage, the suit must be brought by the mortgagee, and not by the mortgagor or any one claiming under a subsequent conveyance from him. *Conard v. Insurance Co.*, 1 Pet. 386; *Wood v. Weimar*, 104 U. S. 786; *Clapp v. Campbell*, 124 Mass. 50; *Watson v. Macquire*, 5 C. B. 836, 844. When it is provided by statute that a mortgage of personal property shall not be valid against third persons, unless the mortgage is recorded, a recording of the mortgage is a substitute for, and (unless in case of actual fraud) equivalent to, a delivery of possession, and makes the title and the possession of the mortgagee good against all the world. *Aldrich v. Aetna Co.*, 8 Wall. 491, 497; *Robinson v. Elliott*, 22 Wall. 513, 521; *Bullock v. Williams*, 16 Pick. 33; *Coles v. Clark*, 3 Cush. 399, 401. A patent right is incorporeal property, not susceptible of actual delivery or possession; and the recording of a mortgage thereof in the patent office, in accordance with the act of congress, is equivalent to a delivery of possession, and makes the title of the mortgagee complete towards all other persons, as well as against the mortgagor. The right conferred by letters patent for an invention is limited to a term of years, and a large part of its value consists in the profits derived from royalties and license fees. In analogy to the rules governing mortgages of lands and of chattels, and with even stronger reason, the assignee of a patent by a mortgage duly recorded, whose security is constantly wasting by the lapse of time, must be held (unless otherwise provided in the mortgage) entitled to grant licenses, to receive license fees and royalties, and to have an account of profits or an award of damages against infringers. There can be no doubt that he is "the party interested, either as patentee, assignee, or grantee," and as such entitled to maintain an action at law to recover damages for an infringement; and it cannot have been the intention of congress that a suit in equity against an infringer to obtain an injunction and an account of profits, in which the court is authorized to award damages, when necessary to fully compensate the plaintiff, and has the same power to treble the damages as in an action at law, should not be brought by the same person. Rev. St. §§ 4919, 4921; *Root v. Railway Co.*, 105 U. S. 189, 212. The necessary conclusion appears to us to be that Shipman, being the present owner of the whole title in the patent under a mortgage duly executed and recorded, was the person, and the only person, entitled to maintain such a bill as this; and that the plea, therefore, was rightly adjudged good.

In the light of our legislation and decisions, no weight can be given to the case of *Van Gelder v. Society*, 44 Ch. Div. 374, in which, upon pleadings and facts similar to those now before us, the mortgagor of a patent was treated as a mortgagor in possession, and was allowed to maintain a suit for infringement, under the provisions of the English Judicature Act of 1873 and Patent Act of 1883. St. 36 and 37 Vict. c. 66, § 25; 46 and 47 Vict. c. 57, §§ 23, 46, 87. Whether in a suit brought by the mortgagee, the court, at the suggestion of the mortgagor, or of the mortgagee, or of the defendants, might, in its discretion, and for the purpose of preventing multiplicity of suits or miscarriage of justice, permit or order the mortgagor to be joined, either as a plaintiff or as a defendant, need not be considered, because no such question is presented by this record. Decree affirmed.

Mr. Justice Brown, not having been a member of the court when this case was argued, took no part in its decision.

738. *WATERMAN v. SHIPMAN*, 55 Fed. 982, 5 C. C. A. 371 (1893).

Before Wallace and Shipman, Circuit Judges.

Wallace, Circuit Judge: * * *

This is a bill in equity, alleging the infringement of two patents for fountain pens—No. 293,545, dated February 12, 1884, and No. 303,735, dated November 4, 1884—each granted to Lewis E. Waterman, as inventor. The defendants were originally Asa L. Shipman (who died before final hearing, and whose executor has been substituted) and James D. Shipman and Edward L. Shipman, his sons, who were copartners by the firm name of Asa L. Shipman's Sons. The questions which have been principally litigated are those in respect of the title to the patents; it being insisted for the defendants that the title at the time of the commencement of the suit was in Asa L. Shipman, and consequently that the complainant could not maintain the bill. The facts bearing upon this branch of the case are these: Prior to November 20, 1884, the title to the patents had been assigned by the complainant to Sarah E. Waterman, his wife, and on November 20, 1884, she granted to him an exclusive license to manufacture and sell the patented improvements throughout the United States. By the terms of the license he agreed to make full returns on the first day of every month of all fountain pens containing the patented improvements, manufactured by him, and to pay to her the sum of 25 cents as a license fee for every pen so manufactured on or before the 5th day of every month, for the pens manufactured during the preceding months. The license provided that "upon a failure of the licensee to make returns after thirty days, or to make payment of the license

fees after ninety days from the time when such returns and payments are due, then the said Sarah E. may terminate this license by serving a written notice upon the said licensee; but that will not discharge him from any liability for any license fees due when such notice was given." November 25, 1884, Mrs. Waterman executed to Asa L. Shipman's Sons a mortgage of the two patents as collateral security for the payment of a note of \$6,500 made by her and the complainant, payable in three years. By this instrument, Mrs. Waterman assigned to the mortgagees all her right, title, and interest in the inventions and the patents upon the express condition that the assignment should be null and void if she and her husband, or either of them, should pay the note at maturity. It contained also a recital that the interest conveyed was free from all incumbrances except a license to this complainant to manufacture and sell pens under both patents. The mortgage was duly recorded in the patent office December 29, 1884; and from the time of its execution until November 25, 1887, the complainant continued to manufacture and sell the patented improvements, making returns to Mrs. Waterman, and paying royalties to her, under his license, until the 16th day of April, 1886, when she executed to him an assignment of all her right, title, and interest in the patents. The note given to secure the mortgage became due November 28, 1887, and was not paid, and shortly thereafter Asa L. Shipman granted to the firm of Asa L. Shipman's Sons an exclusive license to manufacture and sell the patented pens. He also brought suit upon the note in the supreme court of the state of New York, and on the 22d day of December, 1887, duly obtained judgment thereon against the complainant and Mrs. Waterman for the full amount, with interest. After the execution of the license to the firm of Asa L. Shipman's Sons, and about April 1, 1888, they began to manufacture and sell as the patented pens an article identical with those which the complainant had made and sold under his license. They were manufacturing these pens when the present bill was filed, and continued to do so until May 10, 1888. The judgment obtained against the complainant and his wife not having been paid, supplementary proceedings, pursuant to the Code of Civil Procedure of the state of New York, were instituted, which resulted in the appointment of a receiver, who on the 10th day of April, 1888, duly qualified, and became vested, under the provisions of the Code, with all the property, legal and equitable, belonging to the complainant. On January 9, 1888, Asa L. Shipman sent the complainant a letter giving him notice "that the license given you by Mrs. Waterman is revoked, and suit will be brought against you for infringement of said patents." On April 26, 1888, he sent the com-

plainant another letter, stating "that, in addition to the notice already handed to you, the license agreement executed by Sarah E. Waterman to you, dated November 18th, 1884, is hereby revoked, on account of your failure to make due returns thereunder on the first day of January, 1888, and also on February 1st, 1888, and also for your failure to pay the royalties under said agreement which became due to me on December 5th, 1887; also, on January 5th, 1888."

On April 27, 1888, the complainant made a tender to the attorney of Asa L. Shipman of the full amount of the judgment obtained upon the note, together with the costs of the suit; but this tender did not include anything for the fees of the receiver in the supplementary proceedings. On the 5th day of May the present suit was brought. The circuit court dismissed the bill, without a written opinion, apparently upon the ground that the legal title to the patent was in Asa L. Shipman at the time of the commencement of the suit.

It is entirely clear, upon the authority of *Waterman v. Mackenzie*, 138 U. S. 252, 11 Sup. Ct. Rep. 334, that by virtue of the mortgage the whole title to the patents at the time of the execution of the instrument became vested in the mortgagees, subject only to be defeated by performance of the condition or by redemption of the bill in equity within a reasonable time, and that the right of possession to the incorporeal property was in legal effect delivered to the mortgagees at the time of the recording of the mortgage in the patent office. We do not consider it necessary to determine whether a tender of the mortgage debt, made after the day of payment, entitled the complainant, as the assignee of the mortgagor, to a reconveyance of the patents. Nor do we deem it necessary to determine whether the tender made by him April 27th was a sufficient one, or whether it should have included a sum sufficient to cover the fees of the receiver in the supplementary proceedings. We regard it as entirely immaterial, for the purposes of the present suit, whether the legal title to the patents was or was not in the complainant at the time of the commencement of the suit. The mortgage of Asa L. Shipman was subject to the license which had previously been granted to the complainant, and could in no manner operate to restrict or curtail the exclusive right of the complainant to make and sell the patented improvements, so long as the license should remain unrevoked. The recital in the mortgage of the existence of this license was notice of all its terms and conditions. It is familiar doctrine that a purchaser will have constructive notice of everything appearing in any part of the deed or instrument constituting the title purchased, which is of such a nature that, if brought directly to his

knowledge, it would amount to actual notice; for the right of a purchaser can in no case go beyond his own title, and whatever appears on the face of the title papers forms an integral part of the title itself. Such notice, therefore, is of the most conclusive nature, and is insusceptible of being explained away or rebutted.

The bill of complaint alleges that the license granted to the complainant was in full force at the time of the commencement of the suit. This averment is not denied by the answer; and the answer makes no issue setting up the invalidity of the license, or any revocation by reason of failure to make returns, or pay royalties, or for any other reason. There is evidence in the record, however, which has been referred to, of letters sent by Asa L. Shipman to the complainant—one of the date of January 9, 1887, and one of the date of April 26, 1888—giving notice of the revocation of the license. Under the issues made by the pleadings, we ought not to notice this evidence. It is proper, however, to say that the letter of January 9th did not assign any reasons for revoking the license, and the letter of April 26, 1888, assigned grounds for revoking it which do not appear to have been correct in fact. The complainant was not in default for failure to make returns on the 1st day of January, 1888, or on the 1st day of February, 1888, or for not paying royalties on the 5th of December, 1887, or on January 5, 1888. He did not manufacture at all in the months of December or January, and, if any royalties became due on December 5th or on January 5th, the fact does not appear.

Even if it were open to the defendants, under their answer, to assert that at the time when the suit was commenced the complainant's interest in the patent had vested in the receiver in supplementary proceedings, the contention would be untenable. The license was not assignable. No license is assignable by the licensee to another unless it contains words which show that it was intended to be assigned. *Factory v. Corning*, 14 How. 193; *Rubber Co. v. Goodyear*, 9 Wall, 788; *Adams v. Howard*, 23 Blatchf. 27, 22 Red. Rep. 656; *Baldwin v. Sibley*, 1 Cliff. 150. The present license contained no such words, and was purely a personal license to the complainant. Consequently the receiver could not acquire it.

If the owner of the legal title to the patent had not been made a party to the suit, undoubtedly the bill by the complainant could not be sustained against the other defendants. A mere licensee cannot sue strangers who infringe. In such a case redress is obtained through or in the name of the owner of the patent. But there is no reason or authority for the proposition that a licensee who has the exclusive right to manufacture and

sell a patented article cannot maintain a suit in equity against the owner of the patent, if the latter is guilty of an infringement by making or selling himself, to redress the wrong occasioned thereby, or that such a suit does not arise under the patent laws of the United States. The case of *Littlefield v. Perry*, 21 Wall. 205, 223, is a direct authority in favor of the right of the licensee to maintain such an action. In that case the supreme court said:

“A court of equity looks to substance, rather than form. When it has jurisdiction of the parties, it grants the appropriate relief, without regard to whether they come as plaintiff or defendant. In this case the person who should have protected the defendant against all infringements has become himself the infringer. He held the legal title to the patent in trust for his licensees. He has been faithless to his trust, and courts of equity are always open for the redress of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the patent laws; and of that suit the circuit court has jurisdiction.”

If the licensees' rights have been infringed by the owner, and third persons confederating with the owner, there is no reason why all the infringers should not be joined as defendants. *Perry v. Littlefield*, 17 Blatchf. 272, 285. In such a case it is quite immaterial to the other defendants whether the owner, when made a party to the suit, is a complainant or a defendant. It suffices, so far as they are concerned, that all the parties are present who have any interest in the controversy, and that decree will definitely determine their rights as between themselves and the owner of the patent, as well as between themselves and the complainant.

The bill in this case alleges a combination between the defendants to deprive the complainant of the benefits and advantages of his license; and the evidence shows that the license granted by Asa L. Shipman to his sons, the other defendants, was granted by him, and procured by them, for the paramount purpose of preventing the complainant from enjoying the monopoly conferred by his license. The defendants, therefore, are joint infringers. We conclude that **there is no impediment**, arising from the fact that the complainant is merely a licensee, to preclude him from obtaining the relief sought by his bill.

The proof of infringement of the patents is very meager, and we find no evidence in the record that the pens made by the defendants infringe any of the claims of either patent, except the first claim of patent No. 307,735. Undoubtedly the defendants, in manufacturing their pens, intended to copy the pens made by the complainant; but the record does not show whether the

pens made by the complainant embodied any of the inventions of the other claims.

To sustain the defense of want of novelty the defendants have set up in their answer, and offered in evidence, a large number of patents prior in date to those of the complainant. In the absence of any expert testimony to explain these patents, or indicate what they contain tending to negative the novelty of the complainant's patents, we do not feel called upon to examine them. There may be cases in which the character of the invention has so little complexity that such expert testimony is not necessary to aid the court in understanding whether one patent, or several patents considered together, describe the devices or combination of devices which are the subject-matter of a subsequent patent; but this is not one of them.

The defendants also introduced in evidence a pamphlet entitled "An Exposé of the Assumptions and Business Methods of a Dealer and Reputed Inventor," consisting of some 25 printed pages, published in 1886. This pamphlet was prepared and published by a rival pen manufacturer apparently for the purpose of discrediting the inventions of the complainant, and his personal character and business methods. The author was called as a witness for the defendants, and asked this question: "Does this pamphlet, so far as it refers to the patents which you have studied, correctly express your views respecting the same?" The witness answered: "In so far as it goes, I suppose it does. It was so intended." The pamphlet was then offered in evidence, and made an exhibit in the cause, against the objections of the complainant. The statements contained in this pamphlet are relied upon by the defendants as evidence upon the issue of novelty. We decline to consider anything contained in it as competent evidence upon this issue. The counsel for the complainant was justified in refusing, as he did, to cross-examine the witness in regard to its contents. The greater part of it was scandalous matter, entirely irrelevant to the present controversy; and he was under no obligation to undertake to read and analyze its contents to see whether it contained anything bearing upon the issue worthy of a cross-examination.

As to the defense resting upon the prior invention of Fisher, it suffices to say that no such defense is set up in the answer; and, if all that is asserted in respect to the defense is true, only the third claim of patent No. 307,735 would be defeated by it.

We conclude that the complainant is entitled to a decree for an accounting and an injunction. The decree of the circuit court is reversed, with costs, and the cause remanded to that court with directions to enter a decree for the complainant in conformity with this opinion.

739. CITY OF NEW YORK v. AMERICAN CABLE RY. CO., 60 Fed. 1016, 9 C. C. A. 336 (1894).

Before Wallace, Lacombe and Shipman, Circuit Judges.

Wallace, Circuit Judge: * * *

The complainant's title to the letters patent in suit depends upon the authenticity of the mesne assignments under which it claims. No evidence was introduced tending to prove the execution of the assignments from the patentee to Horton, from Horton to the Cable Railway Construction Company, and from the Cable Railway Construction Company to the complainant, except duly-certified copies of the patent office record of three instruments which purport to be such assignments. The objection that the instruments were not sufficiently proved was taken in due season, and was insisted upon at the hearing in the circuit court. We are of opinion that the objection was valid, and consequently that the complainant was not entitled to a decree.

The assignment of a patent is not a public document, but is merely a private writing. There is no statutory provision requiring it to be recorded in the patent office. Section 4898 of the Revised Statutes permits this to be done for the protection of the assignee against a subsequent bona fide purchaser or mortgagee. The section does not make the recorded instrument evidence, does not require the assignment to be executed in the presence of any public officer, or to be acknowledged or authenticated in any way before recording, and does not provide or contemplate that it shall remain subsequently in the custody of the office. It devolves upon the patent office merely the clerical duty of recording any instrument which purports to be the assignment of a patent. We are aware of no principle which gives to such a record the effect of primary evidence, or of prima facie proof of the execution or the genuineness of the original document. To give it such effect would enable parties to manufacture evidence for themselves.

Section 892 of the Revised Statutes does not touch the point. That section provides that written or printed copies of any records, books, papers, or drawings belonging to the patent office shall be in evidence in all cases wherein the originals could be evidence. The original assignment does not belong to the patent office. The section makes a copy evidence of the same class as the original record, but has no application when the original record is not competent. The early cases of *Brooks v. Jenkins*, 3 McLean, 432, Fed. Cas. No. 1,953, and *Parker v. Harworth*, 4 McLean 370, Fed. Cas. No. 10,738, in which it was held that a certified copy of the patent office record of an assignment of a patent is prima facie evidence of the genuineness of the

instrument, were decided at first instance, and apparently without much consideration. The rule of these cases has been accepted without discussion in the later cases of *Lee v. Blandy*, 1 Bond 361, Fed. Cas. No. 8,182; *Dederick v. Agricultural Co.*, 26 Fed. 763; *National Folding Box & Paper Co. v. American Paper Pail & Box Co.*, 55 Fed. 488. It is not improbable that these decisions were influenced by the technical nature of the objection in the particular cases. But the rule opens the door to fraud, as any stranger can put an assignment upon record; and it imposes upon a defendant who honestly doubts whether a party who claims title to a patent is the owner, the burden which ought to rest upon his adversary. Our conclusions are supported by the opinion of the circuit court of appeals in *Paine v. Trask*, 5 C. C. A. 497, 56 Fed. 233, where the question was considered with care, although its decision was unnecessary to the judgment.

We have not considered the point argued by the appellants that the bill should have been dismissed because no proof was given of the complainant's incorporation. The assignment of errors does not present the question. Although, upon the proofs in the circuit court, the complainant was not entitled to a decree, it would have been a proper exercise of discretion on the part of the court, in view of the reliance which the complainant had doubtless placed upon the adjudications which have been referred to, to permit the complainant to reopen the proofs, and the cause to be reheard. In reversing the decree and directing the dismissal of the complainant's bill, we do so without prejudice to the granting by the circuit court of such an application, if seasonably made by the complainant.

The decree is reversed, with instructions to the circuit court to proceed in conformity with this opinion.

740. *STANDARD ELEVATOR CO. v. CRANE ELEVATOR CO.*, 76 Fed. 767, 22 C. C. A. 549 (1896).

Before Woods, Showalter and Bunn, Judges.

Showalter, J.: * * *

The third error alleged by appellants concerns the title of appellees to the patent numbered 328,614. The title comes to them by divers assignments. Copies of the record in the Patent Office of such assignments were put in evidence, and no other proof of the original instruments or the signatures thereto was made. It is the want of such additional proof, rather than the incompetency, for any purpose, of the copies from the record in the Patent Office, which appellants insist on. Section 4898 of the Revised Statutes of the United States is in words following:

"Sec. 4898. Every patent or any interest therein shall be

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

Section 892 is in words following:

"Sec. 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof."

Section 4898 does not require that any instrument in the chain of title to a patent shall be recorded; but all such assignments may be recorded. The sense, the essential significance and intent of this section, is that the record or official copy of any assignment shall give to any person interested the prima facie assurance that an original assignment was made in terms as shown in the record; that such instrument was subscribed as shown; that it was delivered; that the signature thereto is the genuine signature of the assignor, and that such assignor had an assignable interest according to the purport of the instrument. These are the inferences, the prima facie inferences, which any person interested is authorized, and authorized by law—that is to say, by the section itself—to draw. The laws of thought are not suspended when the inquiry arises in a court of justice. The self-same inferences spring up prima facie when a litigant in a patent case, being called on to prove that A assigned to B, produces a writing purporting to show on its face an assignment from A to B, which is proven to be a copy of a record in the Patent Office. The record of assignments in the Patent Office is a record "belonging to the Patent Office" within the literal terms of section 892; but in the absence of that section and on the general principles of evidence a paper purporting to be a copy of a record in the Patent Office could be proven to be such copy by the sworn testimony of the person who made it or of a person who had compared it with the original record in the Patent Office. The view here stated as to the prima facie probative force of a copy from the record of an assignment in the Patent Office has been substantially taken in many reported decisions. (Brooks et al. v. Jenkins et al., 3 McLean 432; Parker v. Haworth, 4 McLean 370; Lee v. Blandy, 1 Bond 361; Died-

rich v. Agricultural Company, 26 Fed. 763; National Folding Box & Paper Co. v. American Paper Pail & Box Co., 55 Fed. 488.)

The same theory as to the probative force of records made by authority of law in the case of alienations of other property is recognized with more or less definiteness in the following cases: *Sudlow v. Warshing*, 108 New York 522; *Chamberlin v. Bradley*, 101 Mass. 188; *Ward v. Fuller*, 15 Pickering 185; *Lane v. Bommelmann*, 17 Ill. 95; *Seeley v. Wells*, 53 Ill. 120; *People v. Lee*, 112 Ill. 113; *Sucker v. The People*, 117 Ill. App. 136; *Sampson v. Noble*, 14 La. An. 347; *Evanston v. Gunn*, 99 U. S. 660; *Merchants' Navigation Company v. Amsden*, 25 Ill. App. 307.

Said the Supreme Court of Massachusetts, speaking of the probative force of a copy of a deed from the public registry of deeds, in *Chamberlin v. Bradley*, *supra*:

"Between natural persons the production of a copy is evidence of the execution of the deed by the person whose deed it purports to be; of its delivery; of its due acknowledgment; and, interest assigned on the face of the instrument or that the grantor This involves the presumption or inference of fact, first, that the seal was the seal of the grantor; second, that it was affixed by him or by his authority; third, that he signed his name or authorized it to be signed by him or in his presence; fourth, that it was the grantor who made the acknowledgment; fifth, that the certificate of the magistrate is genuine; and sixth, that the grantor was seized of the land which the deed purports to convey."

It is not here meant that a plaintiff in ejectment could make out a *prima facie* case by putting in evidence a copy from the record of the last deed in his chain of title. The presumption that the assignor of a patent, for instance, was vested with the interest assigned on the face of the instrument or that the grantor in a land conveyance was seized of the estate transferred on the face of the deed, in the absence of other proof tracing *prima facie* the title of such assignor to the original source or to a source which was common to the contending litigants, would, doubtless, be sufficiently rebutted, in the case of a patent by the adverse user, in the case of land by the adverse possession.

In *Merchants' Navigation Co. v. Amsden*, 25 Ill. App. 307, and in *Sampson v. Noble*, 14 La. An. 347, records in the collector's office were used as *prima facie* proof to show the ownership of a vessel. In a case where the litigant against whom the copy is offered was himself the assignee in the assignment to be proved, and may, for that reason, be assumed to have the custody of the original, an objection that no notice was given to him to produce the original will be good, but such objection

must specify the want of notice as its ground. On the other hand, if a litigant should offer a copy from the Patent Office to prove an assignment wherein he himself is assignee and presumptively in possession of the original an objection specifically on the ground that he should produce or show the loss of or account for the original would likewise be good. (*Draper v. Hatfield*, 124 Mass. 53; *Stockwell v. Siloway*, 105 Mass. 517; *Samuels v. Borrowscale*, 104 Mass. 207; *Blanchard v. Young*, 11 Cush. 345; *Palmer v. Stevens*, 11 Cush. 147; *McNichols v. Wilson*, 42 Iowa 385.)

The record in the case at bar shows the following note of the objection made when the copy from the Patent Office of the first in the chain of assignments was introduced in evidence before the Commissioner:

“Counsel for defendants objects to the introduction of the said paper as an exhibit for its admission in evidence, on the ground that the original of which it is certified to be a copy, so far as the purposes of the suits which defendants’ counsel represents, is immaterial, indefinite, incompetent, and not proven.”

This objection in terms is that the record in the Patent Office is “immaterial, indefinite, incompetent, and not proven.” “The original of which” the paper put in evidence was “certified to be a copy” is the record in the Patent Office, not the original writing of assignment. The meaning of the objection is that the record in the Patent Office is “immaterial,” etc. This objection was repeated, or, rather, referred to in connection with each succeeding assignment in the chain of title, as the copy from the Patent Office was put in evidence. There was no call for any original writing of assignment; nor was any objection made on the ground that any original writing of assignment was not produced or its loss accounted for. The matter was not brought in any way to the attention of the circuit judge; nor is it asserted as error that any copy from the Patent Office was admitted over the objection that the original writing was not produced or its loss accounted for. The only question presented by the record is the prima facie probative force of the Patent Office record of an assignment.

In *Mayor of New York et al. v. The American Cable Railway Co.*, 60 Fed. 16, the Federal Court of Appeals at New York, following an obiter dictum by the Federal Court of Appeals at Boston in *Paine v. Trask*, 65 O. G. 298, 56 Fed. 233, decided that under the sections above quoted from the Revised Statutes of the United States a certified copy from the records in the Patent Office would not prima facie prove the assignment without a further showing as to the execution of the original instrument. It is argued by the learned writer of the opinion that the statute

does not require an assignment to be recorded, that the original is not left in the custody of the Patent Office, and that no certificate of acknowledgment or proof of execution is required by the statute to be made in connection with such instrument; but the line of reasoning upon which the courts have developed the rule already stated does not involve any one of the conditions named.

The statute makes it the duty of the Commissioner of Patents to record assignments, meaning assignments that are genuine. He has no authority to record a spurious instrument. A spurious assignment recorded in the Patent Office would not be in law a record of that office. The record of an assignment is in law tantamount to a finding or certificate by the Commissioner that the original is genuine. It matters not that the Commissioner may act on the mere assumption that whatever paper of this kind is presented for record is genuine. He is a public officer charged by law with the duty of recording only such as are genuine. The law attaches to his act in making the record the prima facie presumption that the instrument copied upon his record-book is entitled to record—that is to say, is genuine. The argument that a spurious assignment may be mistakenly put upon the record might be urged against the policy of the statute, but not against the obvious sense of it. Such an argument might also be urged against the ordinary statutes for recording deeds, for it would be no more difficult to secure the recording of an instrument with a spurious certificate of acknowledgment than an instrument with no acknowledgment at all, but with a spurious signature. All such enactments proceed upon the assumed integrity of men on the average, as civil institutions in general in this country assume a fair degree of integrity and intelligence in the average man. This court cannot accede to the view announced in *Mayor of New York et al. v. American Cable Railway Company*, supra. The rule as understood and acted upon prior to that decision is considered by this court to be law. For fifty-two years (*Brooks et al. v. Jenkins et al.*, supra, was decided in 1844) that rule has prevailed. As pointed out by Judge Coxe in *National Folding Box & Paper Co. v. American Paper Pail & Box Co.*, supra, a holding that the Patent Office record of an assignment shall have no force as prima facie proof of the original writing would often entail great and useless expense, if not an entire defeat of the rights of the complainant, in a patent case. A spurious or counterfeit assignment put of record in the Patent Office would be easily and certainly detected by any person interested in the inquiry, especially in the case of any patent of real value. The possible gain from such a rascality would not be worth the risk.

The complainant in a patent suit is ordinarily making actual use of the patent. What may be called his "possession" of the patent property is usually open and notorious. It is no hardship upon an infringer who, claiming no right in himself, proposes to dispute the showing of the patent office on the matter of title to require from him such proof as might at least raise a fair presumption that the original of some assignment shown of record in the chain of title is spurious.

In accordance with the prevailing opinion of the judges on this hearing the adjudication appealed from is affirmed in all respects, except as to the sixth claim of Patent No. 328,614, and as to that claim the decree is reversed, with the direction that the order of reference be to that extent vacated and the bill to that extent dismissed for want of equity, and the cause is remanded to the circuit court. * * *

Coming to the merits of the appeal, the third specification of error presents the question whether the complainants had proved title to Patent No. 328,614. The proof made consisted in certified copies of the record in the patent office of assignments purporting to have been made by Reynolds, the patentee, to the Crane Brothers Manufacturing Company, and by that company to the Crane Elevator Company, and by the last-named company to James H. Raymond, trustee. For the purpose of showing that the alleged assignments had been recorded in the Patent office, as provided in § 4898 of the Revised Statutes, the copies were admissible in evidence over the objection of incompetence and irrelevancy; but that they constituted no proof of the execution or genuineness of the original instruments seems clear both on principle and authority. It has been so declared in well-considered cases by the Courts of Appeals in both the first and second circuits. (*Paine v. Trask*, 65 O. G. 298, 5 C. C. A. 497, 5 U. S. App. 283; *City of New York v. Am. Cable Ry. Co.*, 67 O. G. 1334, 9 C. C. A. 336) and even if those decisions were doubtful this court ought not now to assert a different rule. But it is to be observed in this instance that the assignments of which copies were put in evidence, were in the possession of the complainants or their trustee, and, that being so, even under the rule in respect to office copies of conveyances of real estate under the registry laws, the production of the originals or an excuse for the failure was necessary. As the rule is stated in *Ward v. Fuller*, 15 Pick. 185, 187, cited in *Chamberlain v. Bradley*, 101 Mass. 188—
"where the party relying upon a deed of conveyance is the grantee, or person who is entitled to the possession of it, he must produce the original, or lay a foundation, in the usual manner, for the production of secondary evidence." * * *