

the passages on which they were to decide the sufficiency of the specification, was also for the jury, who were to say whether the words were or were not sufficient for carrying into practical effect the invention or discovery, which the patentee supposed he had made. It was further argued, that the meaning of the words depended upon evidence ; whereas, if the court were to pass upon the meaning of the paper, they must act upon the written paper alone, without evidence. But the court laid down the doctrine that in all cases the meaning of the specification is for the court ; and, although the question which goes to the jury is whether the directions in the specification are sufficient or not, it is necessary for the court to declare what the specification has said. This must be done, either by taking into view at the time the evidence which bears upon the meaning, where it is not controverted, or by leaving to the jury, as matters of fact, to pass upon that evidence, in order to ascertain the meaning of scientific words, or the surrounding circumstances on which the construction depends. In the one case, the construction is given absolutely ; in the other, it is given conditionally, because dependent upon facts to be found by the jury.¹

¹ Neilson v. Harford, Webs. Pat. Cas. 295, 349. Sir W. Follett argued as follows : “ I submit to your lordships that the whole question upon the validity of the specification, that is, on the meaning of the specification, and whether it can or cannot be carried into effect, is a question for the jury and not for the court, and that the jury are to put their construction upon the meaning of the words, and that the jury are to say whether the words are or not sufficient, and that it is for them to say, whether the specification does sufficiently show the mode of carrying the invention and discovery which the patentee supposed he had made, into practical effect. [Lord Abinger, C. B. : Why is the specification, which is a written instrument, more particularly to be considered by a jury, than any other instrument ? The meaning of scientific words must be matter of evidence.] [Alderson B. : The construction of it is surely for the court.] I do not know quite the extent to which it is supposed the authorities have gone in stating that certain papers are for the court. In many cases, undoubtedly, written papers are for the court, but I apprehend that is by no means a general doctrine of law ; but that written papers, which involve a question of fact like this, whether or not the party has sufficiently described the invention, that that written paper is for the jury

§ 401. The question whether the invention disclosed by the specification is a proper subject for a patent, is a question of

and not for the court, because it is for the jury to say, as a matter of fact, whether there be or not a sufficient description in that instrument to enable parties to carry it into effect. That I apprehend to be a question entirely for the jury. Certainly, the whole of this is a question of evidence, and a question of fact. It is a question of fact as relates to the paper; it is a question of fact as regards the evidence at the trial; it is not a question of law at all; and I do not know any rule which is to say that the court is to construe that specification, and to take it from the jury, because, supposing the fact to be that evidence was given at the trial on scientific matters, which evidence would aid the meaning or the construing of the instrument, your lordships can have no judicial notice of that at all. If it be a written paper for your lordships to decide upon, it must be without evidence. It is not that your lordships can come to a conclusion upon the meaning of the paper by looking at the evidence at the trial, but if it comes within the rule, that is a written paper which the court is to act upon, then it must act upon the written alone. I think I can show your lordships that in every single case in which any question has arisen, it has been submitted to the jury, not decided by the court. [Lord Abinger, C. B. : Not consistently with my recollections; I have always thought that the meaning of the specification was to be determined by the court. That meaning may be varied by the evidence of particular words. A man must gather as he goes along in order to construe the written instrument. It is quite new to me that it is not to be considered by the court.] [Alderson B. : Surely the court is to tell the jury what the specification has said. If the specification contains words of art, the court is to say — If you believe these words of art to mean so and so, the specification has said so and so; leaving the question of words of art to the jury. But if there are no words of art, what the specification has said is to be construed by the court. Then it is to be left to the jury, whether the specification having so said, it is or not a sufficient description of the invention according to their judgment.] I do not mean the validity of the specification as to questions in which you may direct nonsuits in point of law arising out of objections of a different kind, but that this question, whether or not the specification sufficiently describes the mode of carrying the invention into effect, that every thing relating to that is for the jury, and not for the court — the meaning of the passages in the specification, and every thing. I should submit to your lordships that the whole of it was for the jury, and not for the court. [Alderson, B. : That there are some things in the specification which are questions of fact is true, and there are some things in the specification which are questions of law; the construction is to be given by the court, but the intelligibility of it is for the jury.] That is

law, on which the court will instruct the jury. It may involve the finding of a variety of facts; but when the facts are all ascertained, it is purely a question of law, whether the invention or discovery is a patentable subject. This is a distinct and very different question from that of the novelty of the invention. The thing claimed as the subject of a patent may be entirely new, and yet it may not fall within that class of discoveries or inventions recognized by the patent law as the subjects of patents, and as such comprehended within the description of the statute. Thus, the subject-matter may turn out to be the application of an old or well-known thing, to a new purpose, constituting a new use only so far as the occasion is concerned; which the law decides is not the subject of a patent.¹ Or, on the other hand, the claim may be for the use of a known thing in a known manner, to produce effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public; which the law decides is a patentable subject.² In these and other cases, where the question arises, upon all the facts attending and surrounding the alleged invention, whether it is a patentable subject, it is for the court to settle that question. Of course, the novelty of the invention is a pre-requisite to the validity of the patent, and this is a question of fact; but the alleged invention being ascertained to be new, it is still to be determined whether it is that species of invention to which the law gives the protection of a patent.

all I am contending. [Lord Abinger, C. B. ; The intelligibility means with reference to words of science, or matters in it which persons may explain so as to satisfy the jury. You are discussing an abstract principle where it is not necessary; if you take an abstract principle, I must say the meaning of the specification is a matter of law, and that the judge must be informed, by evidence, of the facts, and then he must leave those facts to the jury, for them to find whether they be true or not.] See also Ante, note.

¹ *Losh v. Hague*, Webs. Pat. Cas. 202, 207; *Howe v. Abbott*, 2 Story's R.

² *Crane v. Price*, Webs. Pat. Cas. 408, 409.

§ 402. The question of infringement is, as has already been stated, a question whether the invention of the defendant is substantially the same thing as that of the plaintiff. The identity of two things is a matter of fact, depending upon evidence; and although it is to be determined under the guidance of those principles which determine what constitutes identity and diversity in the sense of the patent law, yet it is for the jury to determine, as matter of fact, under proper instructions, whether the two things are the same or different.¹

¹ *Boulton v. Bull*, 2 H. Bl. 4; *Whittemore v. Cutter*, 1 Gallis. 478; *Pennock v. Dialogue*, 4 Wash. 538; *Lowell v. Lewis*, 1 Mason, 191; *Phillips on Patents*, 131.

CHAPTER VI.

JURISDICTION OF CONGRESS AND THE FEDERAL COURTS.

§ 403. THE Constitution of the United States confers upon Congress power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." This power is general; there is no distinction which limits it to cases where the invention has not been known or used by the public. Accordingly, it is well settled, that Congress may pass general or special laws, in favor of inventors; and they may leave a particular inventor to the protection afforded by a general law, or they may specially exempt his case from the operation of a general law, by extending his exclusive right beyond the term fixed by such general law. This may be done after the invention has been in the possession of the public, as well as before; for when the exclusive privilege has once been secured, the grant does not imply an irrevocable contract with the public, that, at the expiration of the period, the invention shall become public property.¹

§ 404. Congress, therefore, has power to pass an act which will operate retrospectively to give a patent for an invention which is already in public use; but no act, it has been said, ought to be construed to operate retrospectively, unless such a construction is unavoidable.²

¹ *Evans v. Eaton*, 3 Wheaton, 545; S. C. *Peters* Circ. C. R. 322; *Evans v. Hettich*, 7 Wheat. 453; *Blanchard v. Sprague*, 2 Story's R. 164; S. C. 3 Sumner, 535; *Woodworth v. Hall*, 1 Woodb. & M. 248.

² *Blanchard v. Sprague*, *ut supra*. Letters-patent were granted to the

§ 405. The Act of Congress, of July 4, 1836, § 17, declares, "that all actions, suits, controversies, and cases arising under

plaintiff, Thomas Blanchard, on the 6th of September, 1819; and being deemed inoperative, by reason of defects in the specification, new letters-patent were granted on the 20th of January, 1820, for the space of fourteen years. Afterward, by Act of Congress, passed the 30th of June, 1834, the sole right was granted to the plaintiff, to make, use, and vend his invention for the term of fourteen years, from the 12th of January, 1834. This act not being thought to describe with sufficient accuracy the letters-patent, to which it was intended to refer, an additional act was passed on the 6th of February, 1839, renewing the act of the 30th of June, 1834, and correcting the date of the 12th of January, 1834, to the 20th of January, 1834. This last act was as follows: "*An Act to amend and carry into effect the intention of an Act entitled An Act to renew the Patent of Thomas Blanchard, approved June 30th, 1834.* Sec. 1. Be it enacted, &c., That the rights secured to Thomas Blanchard, a citizen of the United States, by letters-patent granted on the sixth of September, eighteen hundred and nineteen, and afterwards on a corrected specification on the twentieth day of January, Anno Domini eighteen hundred and twenty, be granted to the said Blanchard, his heirs and assigns, for the further term of fourteen years from the 20th of January, eighteen hundred and thirty-four, said invention so secured being described in said last-mentioned letters as an engine for turning or cutting irregular forms out of wood, iron, brass, or other material which can be cut by ordinary tools. Provided, that all rights and privileges heretofore sold or granted by said patentee to make, construct, use, or vend the said invention, and not forfeited by the purchasers or grantees, shall enure to and be enjoyed by such purchasers or grantees respectively, as fully and upon the same conditions during the period hereby granted as for the term that did exist when such sale or grant was made. Sec. 2. And be it further enacted, that any person who had *bonâ fide* erected or constructed any manufacture or machine for the purpose of putting said invention into use, in any of its modifications, or was so erecting or constructing any manufacture or machine for the purpose aforesaid, between the period of the expiration of the patent heretofore granted on the thirtieth day of June, one thousand eight hundred and thirty-four, shall have and enjoy the right of using said invention in any such manufacture or machine erected or erecting as aforesaid, in all respects as though this act had not passed. Provided, that no person shall be entitled to the right and privilege by this section granted, who has infringed the patent right and privilege heretofore granted, by actually using or vending said machine before the expiration of said patent, without grant or license from said patentee or his assignees, to use or vend the same."

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, by the Circuit courts of the United States, or any district court having

Upon this Act, Mr. Justice Story said, "Then it is suggested, that the grant of the patent by the Act of Congress of 1839, ch. 14, is not constitutional; for it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the supreme court in the case of the Patent of Oliver Evans. *Evans v. Eaton*, 3 Wheat. 454. For myself I never have entertained any doubt of the constitutional authority of Congress to make such a grant. The power is general to grant to inventors; and it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases, where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor. The only remaining objection is, that the act is unconstitutional, because it makes the use of a machine constructed and used before the time of the passage of the Act of 1834, ch. 213, and the grant of the patent under the act of 1839, ch. 14, unlawful, although it has been formerly decided, that under the Act of 1834, the plaintiff had no valid patent; and so the defendant, if he constructed and used the machine during that period, did lawful acts, and cannot now be retrospectively made a wrong-doer. If this were the true result of the language of the Act, it might require a good deal of consideration. But I do not understand, that the act gives the patentee any damages for the construction or use of the machine, except after the grant of patent under the Act of 1839, ch. 14. If the language of the act were ambiguous the court would give it this construction, so that it might not be deemed to create rights retrospectively, or to make men liable for damages for acts lawful at the time when they were done. The Act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority; and not only so, but it ought to be construed, not to operate retrospectively or *ex post facto*, unless that construction is unavoidable; for even, if a retrospective act is or may be constitutional, I think I may say, that, according to the theory of our jurisprudence, such an interpretation is never adopted without absolute necessity; and courts of justice always lean to a more benign construction. But in the present case there is no claim for any damages but such as have accrued to the patentee from a use of his machine since the grant of the patent under the Act of 1839, ch. 14.

the powers and jurisdiction of a circuit court, which courts shall have power, upon bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: Provided, however, that, from all judgments and decrees, from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.”¹

§ 406. The jurisdiction of the circuit courts of the United States embraces, therefore, all cases, both at law and in equity, arising under the patent laws, without regard to the citizenship of the parties or the amount in controversy; and it seems to be the better opinion, that this jurisdiction is exclusive, and that the state courts cannot entertain a suit for the infringement of a patent, or to declare a patent void.²

§ 407. When a case is sent to the Supreme Court of the United States, under the discretion conferred upon the court below by the seventeenth section of the Act of 1836, the whole case is to go up. The word “reasonable” in the statute applies to the “cases” rather than to the points of the cases.³

¹ See also the Act, Feb. 15, 1819, c. xix.

² 3 Kent's Com. 368; Story's Com. on the Constitution. The course of legislation on the subject of patents may be seen in the Appendix of this work.

³ Hogg v. Emerson, 6 Howard, 439, 478.

The court there said, “It may be very proper for the court below to examine those points separately and with care, and if most of them present

questions of common law only, and not of the construction of the patent acts, and others present questions under those acts, which seem very clearly settled or trifling in their character, not to grant the writ of error at all. It might, then, well be regarded as not 'reasonable' for such questions, in a controversy too small in amount to make the writ a matter of right to persons, if standing on an equal footing with other suitors. But, we think, from the particular words used rather than otherwise, that the act intended, if the court allowed the writ as 'reasonable' at all, it must be for the whole case, or, in other words, must bring up the whole for consideration."

APPENDIX.

A P P E N D I X .

LAWS OF THE UNITED STATES RELATING TO PATENTS AND THE PATENT OFFICE.

CONSTITUTION OF THE UNITED STATES.

ARTICLE 1st, SECTION 8th.

“The Congress shall have power, &c., to promote the progress of science and useful arts, by securing for limited times to Authors and Inventors the exclusive right to their respective writings and discoveries.” Also, to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.”

CHAP. VII. — AN ACT to promote the progress of useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the department of war, and the Attorney General of the United States, setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful, to and for the said Secretary of State, the Secretary for the department of war, and the Attorney General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing

Patents for useful discoveries, how applied for, and granted.
Repealed by the act of 21st Feb'y, 1793, chap. 11.
The Secretary of State, the Secretary of War, and the Attorney Gen'l, or any two of them, if they shall deem the invention, &c., useful and important, to cause letters patent to be issued.

Continuance
of a patent.

Attor'y Gen-
eral to certify
the conformi-
ty of the pa-
tent with this
act.

Patents to be
recorded.

Specification
in writing,
with a draft or
model thereof,
to be deliver'd
and filed in
the office of
the Secretary
of State.

Certified co-
pies, in what
cases to be ev-
idence.

the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her or their heirs, administrators or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters-patent shall be delivered to the Attorney General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and endorsed on the patent by the said Secretary at the time of granting the same.

SEC. 2. *And be it further enacted,* That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said Secretary, and certified copies thereof, shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege, shall come in question.

SEC. 3. *And be it further enacted,* That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

Copies of specification and models may be taken.

SEC. 4. *And be it further enacted,* That if any person or persons shall devise, make, construct, use, employ, or vend within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending, shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

Penalty for making, &c., any art, &c., for which a patent has been granted.

Damages to be assessed by a jury.

SEC. 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no

Patents surreptitiously obtained.

How to be repealed.

sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants, shall be recovered in due course of law.

In actions for penalty, patents to be deemed *prima facie* evidence of the first discovery; but special matter may be given in evidence; and to what effect.

SEC. 6. *And be it further enacted,* That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

Patent fees. SEC. 7. *And be it further enacted,* That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10, 1790.

CHAP. IX. — AN ACT to promote the progress of useful arts, and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State, to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner, or petitioners, his, her, or their heirs, administrators or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-general of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed: and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

Act of 1790,
chap. 7.

Letters pa-
tent, how and
by whom
made out.

Act of April
10, 1799, ch.
33, repealed.

To bear teste
by the Presi-
dent, and

be examined
by the Attor-
ney-general.

1800, ch. 25.

SEC. 2. *Provided always, and be it further enacted,* That any person, who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which have been patented,

The liberty
of using an
improvement
defined.

Changing the form or proportions of any machine, &c., not to be a discovery.

How to proceed to obtain letters-patent.

1800, ch. 25, sec. 2.

Specification.

Specification.

and shall have obtained a patent for such improvement, he shall not be at liberty to make, use or vend the original discovery, nor shall the first inventor be at liberty to use the improvement: And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.

SEC. 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe, that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall 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, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right, shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided, the Secretary shall deem such model to be necessary.

Inventors may assign their titles.

Record of assignment to be made in the office of the Secretary of State.

SEC. 4. *And be it further enacted,* That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to

right and responsibility, and so the assignee of assigns, to any degree.

SEC. 5. *And be it further enacted,* That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending, shall forfeit and pay to the patentee a sum, that shall be at least equal to three times the price, for which the patentee has usually sold or licensed to other persons, the use of the said invention; which may be recovered in an action on the case founded on this act, in the circuit court of the United States, or any other court having competent jurisdiction.

Forfeiture on using patented inventions without leave.

Three times the price to be the penalty.

How recovered.

SEC. 6. *Provided always, and be it further enacted,* That the defendant in such action shall be permitted to plead the general issue, and give this act and any special matter, of which notice in writing may have been given to the plaintiff, or his attorney, thirty days before trial, in evidence, tending to prove that the specification, filed by the plaintiff, does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made, for the purpose of deceiving the public, or that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person: in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

How defendants may give this act in evidence.

And judgment shall be given.

SEC. 7. *And be it further enacted,* That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party, claiming that right, shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

State rights to inventions, when to be deemed void.

SEC. 8. *And be it further enacted,* That the persons, whose applications for patents, were, at the time of pass-

How applications depending under for-

mer law shall be prosecuted under this act. ing this act, depending before the Secretary of State, Secretary at War, and Attorney-general, according to the act, passed the second session of the first Congress, 1790, ch. 7. intituled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

Proceedings to be had on interfering applications.

SEC. 9. *And be it further enacted,* That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them shall be final, as far as respects the granting of the patent: And if either of the applicants shall refuse or fail to chuse an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

And against persons surreptitiously obtaining patents.

SEC. 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the district court, where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose

Repeal of a patent illegally obtained.

complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

SEC. 11. *And be it further enacted*, That every inventor, before he presents his invention to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money, thus paid, shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office. *Provided, nevertheless*, That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person, obtaining such copy, shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the same, shall pay two dollars; of which payments, an account shall be rendered, annually to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

Inventor, before presenting petition, to pay \$30 into the treasury.

Copying fees.

SEC. 12. *And be it further enacted*, That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," be, and the same is hereby repealed. *Provided always*, That nothing, contained in this act, shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, and assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provided, such violations shall be committed after the passing of this act.

Act of April 10, 1790, ch. 7, repealed.

Proviso.

Approved February 21, 1793.

CHAP. LVIII. — An Act supplementary to the act, intituled "An Act to promote the progress of useful arts."

(Obsolete.)

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled

Suits, &c., had under cer-

tain act re-
vived.

Act of Feb.
21, 1793, ch.
11.

Act of April
10, 1790, ch.
7.

In what man-
ner.

bled, That all suits, actions, process and proceedings, heretofore had in any district court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been, when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process or proceedings, be, and are hereby intituled to proceed in such cases, as if no such repeal of the act aforesaid had taken place.

Provided always, That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding, as is used in other cases for compelling the appearance of a party.

Approved June 7, 1794.

(Repealed.)

CHAP. XXV. — AN ACT to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

Aliens hav-
ing resided 2
years within
the U. States,
entitled to the
benefit of the
former act.

Act of Feb.
21, 1793, ch.
11.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries and improvements, by the act, intituled "An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are extended and given to all aliens, who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed,

by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided, and directed in the case of citizens of the United States. *Provided always,* That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery which it shall afterwards appear had been known or used previous to such application for a patent shall be utterly void.

Oath to be taken by such resident, that the invention or discovery hath not been used.

SEC. 2. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery or improvement on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations and restrictions, as the same was held or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

The legal representatives of a deceased inventor may obtain a patent.

SEC. 3. *And be it further enacted,* That where any patent shall be or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators or assigns first obtained in writing, shall make, devise, use, or sell the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending, shall forfeit and pay to the said patentee, his executors, administrators or assigns, a sum equal to three times the actual damage sustained by such patentee.

Damages for breach of patent right.

tec, his executors, administrators or assigns, from or by reason of such offence, which sum shall and may be recovered, by action on the case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereof.

To be recovered by action on the case in the circuit court.

Repeal of part of the former act.

Act of Feb. 21, 1793, ch. 11.

SEC. 4. *And be it further enacted*, That the fifth section of the above-mentioned act, intituled "An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is repealed.

Approved April 17, 1800.

CHAP. XIX. — AN ACT to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents.

The circuit courts to have original cognisance in equity and at law, in controversies respecting the right to inventions and writings.

Act of Feb. 21, 1793, ch. 11.

Act of May 31, 1790, ch. 15.

Proviso.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the circuit courts of the United States shall have original cognisance, as well in equity as at law, of all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to authors or inventors, the exclusive right to their respective writings, inventions, and discoveries: and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided, however*, That from all judgments and decrees of any circuit courts, rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

Approved February 15, 1819.

CHAP. CLXII.—AN ACT concerning patents for useful inventions.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

Act of July 4, 1836, chap. 357.

List of expired patents to be annually reported to Congress.

SEC. 2. *And be it further enacted,* That application to Congress to prolong or renew the term of a patent, shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

Form of application to prolong or renew patent.

SEC. 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the

Patent to be invalid in case of inventor not having complied with the terms, &c. 1793, ch. 11.

Secretary of State, upon surrender, &c. to grant a new patent.

residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of

In case of the said act. And, in case of his death, or any assignment death, &c., by him made of the same patent, the like right shall vest right to vest, in executors, in his executors and administrators, or assignee or as- &c.

Proviso. signees: *Provided, however,* That such new patent, so granted, shall, in all respects, be liable to the same matters of objection and defence, as any original patent granted under the said first mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

Approved July 3, 1832.

CHAP. CCIII. — AN ACT concerning the issuing of patents to aliens, for useful discoveries and inventions.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended, in like manner, to every alien, who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act, and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six

The privileges granted to aliens extended.

Act of April 17, 1800, ch. 25.

Proviso.

months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13, 1832.

CHAP. CCCLVII. — AN ACT to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be established and attached to the Department of State an office to be denominated the Patent Office, the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said Commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

March 3, 1837,
ch. 43.

Commissioner of Patents to be appointed, and his duties.

August 29,
1842, ch. 263.

SEC. 2. *And be it further enacted,* That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the chief clerk of the Patent Office, who, in all cases during the necessary absence of the Commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers,

Chief clerk.

Examining
clerk, & other
officers.

machines, models, and all other things, belonging to the said office, and shall perform the duties of Commissioner during such vacancy. And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks, at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk, at one thousand dollars; a machinist, at twelve hundred and fifty dollars; and a messenger, at seven hundred dollars. And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be, granted.

Officers to
make oath
&c.

SEC. 3. *And be it further enacted,* That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the chief clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

A seal to be
provided.

SEC. 4. *And be it further enacted,* That the said Commissioner shall cause a seal to be made and provided for the said office, with such device, as the President of the United States shall approve; and copies of any records, books, papers, or drawings, belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant, under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings, could be evidence. And any person making application therefor may have certified

copies of the records, drawings, and other papers deposited in said office, on paying, for the written copies, the sum of ten cents for every page of one hundred words; and for copies of drawings, the reasonable expense of making the same.

SEC. 5. *And be it further enacted,* That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State, and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

SEC. 6. *And be it further enacted,* That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements on any art, machine, manufacture, or composition of matter not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer, and shall desire to obtain an exclusive property therein, may make application in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which

Patents to be signed by the Secretary of State and by the Commissioner.

Applications, how made.

Specification.

it appertains, or with which it is most nearly connected, to make, construct, compound and use the same ; and in 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 shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings ; or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter ; which descriptions and drawings, signed by the inventor, and attested by two witnesses, shall be filed in the Patent Office ; and he shall, moreover, furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath, or affirmation, that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent ; and that he does not know or believe that the same was ever before known or used ; and also of what country he is a citizen ; which oath or affirmation may be made before any person authorized by law to administer oaths.

Drawings, &c.

Models.

Oath or affirmation.

Examination of invention, to be made, and proceedings thereon, should it not be deemed new.

SEC. 7. *And be it further enacted,* That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery ; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country, prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale, with the applicant's consent or allowance, prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But when-

ever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office; a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant, the said sum of twenty dollars. But if the applicant, in such case shall persist in his claims for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid; and if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them

Proviso.

with such facts and evidence as they may deem necessary to a just decision ; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part ; and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application : *Provided, however, That,* before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars ; and each of said persons so appointed shall be entitled to receive, for his services, in each case, a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

Interfering applications.

SEC. 8. *And be it further enacted,* That whenever an application shall be made for a patent, which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be ; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act, and the like proceedings shall be had to determine which, or whether either, of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take

date from the time of filing of the specifications and drawings, not, however, exceeding six months prior to the actual issuing of the patent ; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office, until he shall furnish the model, and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SEC. 9. *And be it further enacted,* That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the Treasury of the United States, or into the Patent Office, or into any of the deposit banks, to the credit of the treasury, if he be a citizen in the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars ; if a subject of the King of Great Britain, the sum of five hundred dollars ; and all other persons the sum of three hundred dollars ; for which payment duplicate receipts shall be taken, one of which to be filed in the office of the treasurer. And the moneys received into the treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the patent fund.

Thirty dollars to be paid to the credit of the United States treasurer by a citizen, or, &c.

Five hundred dollars by a subject of G. Britain, and three hundred by other persons.

SEC. 10. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate ; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime ; and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

Inventors dying without taking a patent, their executors, &c., may, &c.

Assignment
of a patent,
and record
thereof.

SEC. 11. *And be it further enacted,* That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the Commissioner the sum of three dollars.

Caveat may
be entered.

SEC. 12. *And be it further enacted,* That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent Office a caveat setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right, till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person, within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice (by mail) to the person filing the caveat of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specification, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the

case of interfering applications. *Provided, however,* Proviso.
That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

SEC. 13. *And be it further enacted,* That whenever any patent, which has heretofore been granted, or which shall hereafter be granted, shall be inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent so reissued, together with the corrected description and specifications, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery, which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the commissioner shall certify, on the margin of such annexed description and specification, the Patents invalid from defective specifications may be surrendered, and new patents may be issued in certain cases.
Patentee may make additions to his patent.

time of its being annexed and recorded; and the same shall thereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

Courts may render judgment for a sum not exceeding three times the am't of actual damages.

SEC. 14. *And be it further enacted,* That whenever, in any action for damages [for] making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment of any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

Defendant may plead the general issue, &c.

SEC. 15. *And be it further enacted,* That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by the plaintiff, does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent, or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected,

for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; and whenever the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing and where the same had been used; in either of which cases, judgment shall be rendered for the defendant, with costs: *Provided,* Proviso.
however, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent believed himself to be the first inventor or discoverer of the thing patented, the same shall not be void on account of the invention or discovery, or any part thereof, having been before known or used in any foreign country; it not appearing that the same, or any substantial part thereof, had before been patented or described in any printed publication; *And provided,* Proviso.
also, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification or claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court to adjudge and award, as to costs as may appear to be just and equitable.

SEC. 16. *And be it further enacted,* That whenever there shall be two interfering patents, or whenever a patent or application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the

inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall, in any such case, be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act:

Proviso. *Provided, however,* That no such judgment or adjudication shall affect the rights of any person, except the parties to the action, and those deriving title from or under them subsequent to the rendition of such judgment.

Actions cognizable in circuit courts of the U. S., &c.

SEC. 17. *And be it further enacted,* 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, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: *Provided, however,* That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

Proviso.

Patents may be extended seven years in certain cases.

SEC. 18. *And be it further enacted,* That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the

applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years; and the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein: *Provided, however,* That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

Proviso.

Library of
Patent Office.

SEC. 19. *And be it further enacted,* That there shall be provided, for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

Models to be
classified and
arranged.

SEC. 20. *And be it further enacted,* That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics, and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

Former acts
repealed.

SEC. 21. *And be it further enacted,* That all acts and parts of acts heretofore passed on this subject be, and the same are hereby, repealed: *Provided, however,* That

Proviso.

all actions and processes in law or equity sued out prior to the passage of this act, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided, also,*

Proviso.

That all applications for petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof.

JAMES K. POLK,

Speaker of the House of Representatives.

W. R. KING,

President of the Senate, pro tempore.

Approved July 4, 1836.

ANDREW JACKSON.

CHAP. XLV. — AN ACT in addition to the act to promote the progress of science and useful arts.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation, or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim, and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing, which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with certificate of the oath; or such drawings may be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States to transmit, as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and

Patents issued, and assignments executed and recorded prior to 15th December, 1836, may be recorded anew, &c.

Measures to be taken to obtain patents, &c., to be recorded, &c.

Clerks of the judicial courts of U. States to transmit statements of authenticated copies of patents, &c., prior to 15th December, 1836, &c.

transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said Commissioner.

Certified copies of such record, &c., to be evidence in any judicial court of U. S., &c.

SEC. 2. *And be it further enacted,* That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be primâ facie evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

No patent, &c., issued, &c., prior to December 15, 1836, to be received in evidence in said courts, after 1st June next, unless recorded anew.

New patents to be issued for those lost or destroyed on or before December 15, 1836.

Proviso.

SEC. 3. *And be it further enacted,* That, whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon, that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided, however,* That before such patent shall be issued, the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and descriptions, with specifications of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent and copies of such drawings and descriptions, duly certified, shall be admissible

as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SEC. 4. *And be it further enacted,* That it shall be the duty of the Commissioner to procure a duplicate of such of the models destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided,* That a duplicate of such models may be obtained at a reasonable expense: *And provided, also,* That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and, also, to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said Commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

Duplicates of certain models to be procured.

Proviso.

Further proviso.

A temporary board of commissioners to be appointed; their duties.

SEC. 5. *And be it further enacted,* That, whenever a patent shall be returned for correction and reissue, under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued: *Provided, however,* That no patent made prior to the aforesaid fifteenth day of December, shall be corrected and reissued until a duplicate of the model and drawing of the thing, as origi-

Patents returned for correction, &c., under the 13th section of the act to which this is additional, &c.

Act of 1836, ch. 357. Proviso.

nally invented, verified by oath as shall be required by the Commissioner, shall be deposited in the Patent Office.

No addition
&c., to be
made to any
patent hereto-
fore granted
&c., until a
verified dupli-
cate model,
&c., is depos-
ited, &c.

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor, of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally invented, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office. And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawing, shall be subject to the judgment and decision of the Commissioners provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

Compensa-
tion for mod-
els, &c.

Patents here-
after to be is-
sued.

SEC. 6. *And be it further enacted,* That any patent hereafter to be issued, may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

Whenever
any patentee
shall, through
inadvertence,
&c., make his
specification
too broad, &c.
he, &c., may
make dis-
claimer, &c.

SEC. 7. *And be it further enacted,* That whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of

the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming, in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him, subsequent to the record thereof. But no such disclaimer shall effect 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 the same.

SEC. 8. *And be it further enacted,* That whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings, as are provided by law in the case of original applications for patents.

Applications for additions to newly discovered improvements to be made to existing patents, &c.

SEC. 9. *And be it further enacted,* (any thing in the fifteenth section of the act, to which this is additional, to the contrary notwithstanding,) That whenever, by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have 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 first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for

When, by mistake, &c., any patentee claims to be the original inventor of part of the thing patented, of which he was not, &c.

so much of the invention or discovery as shall be truly and bonâ fide his own: *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of a whole or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be bonâ fide his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer to all that part of the thing patented which was so claimed without right: *Provided, however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

Further proviso.

Agents to be appointed to receive and forward models, &c.

SEC. 10. *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents in not exceeding twenty of the principal cities or towns in the United States, as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients, and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

Two examining and one copying clerk to be appointed.

SEC. 11. *And be it further enacted*, That instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and, also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the

Temporary clerks may be employed.

records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

SEC. 12. *And be it further enacted,* That whenever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the Commissioner shall be a sufficient warrant to the Treasurer to pay back to such applicant two-thirds of the duty he shall have paid into the Treasury on account of such application.

Certificate of the Commissioner to be sufficient warrant to the Treasurer.

SEC. 13. *And be it further enacted,* That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

Affirmation may be substituted for an oath.

SEC. 14. *And be it further enacted,* That all moneys paid into the Treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act of which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and, also, for such other purposes as are or may be hereafter, specially provided for by law.

Moneys paid into the treasury for patents, &c., prior to passage of the act to which this is additional, to be carried to credit of patent fund created by said act; and said fund appropriated for salaries, &c.

And the Commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress, in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund. And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the

Commissioner authorized to draw upon the same, &c.; and lay before Congress annually a statement of expenditures, &c., and also, a list of patents, &c.

- patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public.

Approved March 3d, 1837.

CHAP. LXXXVIII. — AN ACT in addition to an "Act to promote the progress of the useful arts."

Act of July 4, 1836, chap. 357.

Act of Aug. 29, 1842, ch. 263.

Two assistant examiners to be appointed; how; their salaries.

Temporary clerks.

Proviso.

List of patents to be published.

Pay for use of rooms in City Hall.

Purchase of books.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.

SEC. 2. *And be it further enacted,* That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it: *Provided, however,* That instead of salary a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

SEC. 3. *And be it further enacted,* That the Commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office, and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the patent fund, to defray the expense of the same.

SEC. 4. *And be it further enacted,* That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SEC. 5. *And be it further enacted,* That the sum of one thousand dollars be appropriated from the patent fund, to be expended under the direction of the Commissioner, for the purchase of necessary books for the library of the Patent Office.

SEC. 6. *And be it further enacted,* That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided,* That the same shall not have been introduced into public and common use in the United States prior to the application for such patent: *And provided, also,* That in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters-patent.

No person to be debarred from receiving a patent, &c.

Proviso.

Proviso.

SEC. 7. *And be it further enacted,* That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use, has been for more than two years prior to such application for a patent.

Persons, &c., having purchased or constructed any newly invented machine, &c.

SEC. 8. *And be it further enacted,* That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyances of the whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyance shall, in future, be recorded without any charge whatever.

So much of 11th sec. act July 4, 1832, chap. 357, as requires payment for recording assignments, repealed.

SEC. 9. *And be it further enacted,* That a sum of money, not exceeding one thousand dollars, be, and the same is hereby, appropriated out of the patent fund, to be expended by the Commissioner of Patents in the collection of agricultural statistics, and for other agricultural purposes; for which the said Commissioner shall account in his next annual report.

Agricultural statistics, &c.

Provisions
16th sec. act
July 4, 1836,
chap. 357, ex-
tended.

SEC. 10. *And be it further enacted*, That the provisions of the sixteenth section of the before recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

Appeals.

SEC. 11. *And be it further enacted*, That in cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of

the machine or other thing for which a patent, in such case, is prayed for. And it shall be the duty of the said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided, however,* That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent which has been, or may hereafter be, granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

Proviso.

SEC. 12. *And be it further enacted,* That the Commissioner of Patents shall have power to make all such regulations in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is additional, as provides for a board of examiners, is hereby repealed.

Commissioner may make regulations respecting contested cases.

SEC. 13. *And be it further enacted,* That there be paid annually, out of the patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

Compensation of Chief Justice.

Approved March 3, 1839.

CHAP. CCLXIII. — AN ACT in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depository to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to said Treasurer by the Commissioner of Patents.

Act of July 4, 1836, chap. 357.

Act of Mar. 3, 1837, chap. 45.

Act of Mar. 3, 1839, chap. 37.

Treasurer authorized to pay back, out of the patent fund, certain money paid as fees.

Sec. 3, act of
Mar. 3, 1837,
chap. 43, ex-
tended to pat-
ents granted
prior to 15th
Dec'r, 1836,
though lost
subsequently.

Proviso.

Citizens, &c.,
may obtain a
patent; how.

Proviso.

SEC. 2. *And be it further enacted,* That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided, however,* The same shall not have been recorded anew under the provisions of said act.

SEC. 3. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted, or cast, or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceeding had, may grant a patent therefor, as in the case now of application for a patent: *Provided,* That the fee in such cases, which by the now existing laws would be required of the particular applicant, shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act, shall apply to applications under this section.

SEC. 4. *And be it further enacted,* That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, phenipotentiary, charge d'affaires, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which such applicant may be.

Oath may be taken before U. S. ministers, &c.

SEC. 5. *And be it further enacted,* That if any person or persons shall paint or print, or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold by him, for the sole making or selling which he hath not, or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same, or any word, stamp, or device of like import, on any unpatented article for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; one-half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

Penalty for infringing the rights of a patentee, &c., by marking.

How recoverable, &c.

SEC. 6. *And be it further enacted,* That all patentees and assignees of patents hereafter granted, are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended or offered for sale, the date of the patent; and if any person or persons, paten-

Patentees, &c., required to mark articles offered for sale.

Penalty for fees or assignees, shall neglect to do so, he, she, or they shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

Approved August 29, 1842.

CHAP. XLVII. — AN ACT to provide additional examiners in the Patent Office, and for other purposes.

May 28, 1848. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in the manner provided in the second section of the act entitled "An Act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars: *Provided,* That the power to extend patents, now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents; and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make a full report to said Commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said Commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years.

1836, ch. 357. Additional examiners in the Patent Office

Salaries.

Extension of patents.

SEC. 2. *And be it further enacted,* That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant or conveyance, of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the things patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

Fee for recording conveyances of patents.

SEC. 3. *And be it further enacted,* That there shall be appointed in manner aforesaid two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall be paid a salary of one thousand two hundred dollars per annum.

Two copying and recording clerks authorized.

SEC. 4. *And be it further enacted,* That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

Franking privilege of commissioner of Patents.

Approved May 27, 1848.

DECISIONS
OF THE
HON. JUDGE CRANCH,
IN CASES OF
APPEAL FROM THE COMMISSIONER OF PATENTS.

NOTE. — The following decisions of Judge Cranch, in cases of appeal from the Commissioner of Patents, are reprinted here for the convenience of the profession and of persons interested in applications at the Patent Office, but without intending to express any assent or dissent, with regard to the doctrines contained in them. The decisions were not received in season for a careful and deliberate examination, and are, therefore, not referred to in the body of this work.

G. T. C.

Boston, April 10th, 1849.

KEMPER'S CASE.

THE petition of John F. Kemper sets forth that he “has *invented* certain *improvements* in the manner of constructing vessels for the stowing and carrying ice; and also *an improvement in the manner of stowing the same*, and prays that letters-patent of the United States may be granted to him *therefor*, securing to him and his legal representatives an exclusive right in and to his said invention, agreeably to the provisions of the acts of Congress in that case made and provided; he having paid thirty dollars into the treasury of the United States, and otherwise complied with the requirements of the said acts.”

In his specification, after describing his vessel and the improvements in the same, and certain matters to be attended to in the stowing of the ice, he says :

“ I have discovered that, for the purpose of keeping ice for a great length of time, it is necessary, in stowing it, to place all the pieces edgewise, as, when placed flatwise, small openings are formed through it by the percolation of water or otherwise, and that the injurious effect goes on increasing and eventually producing a rapid destruction thereof: this I obviate, by carefully packing all the blocks edgewise, when, as experience has abundantly shown, no such effect is produced. This mode of stowing applies not only to vessels, but also to ice houses, and wherever ice is to be preserved.”

After stating what he disclaims and what he claims as his invention and improvements in constructing vessels for the transportation of ice, he says :

“ In the manner of stowing the ice, I claim the placing of the prepared blocks edgewise, in the manner and for the beneficial purpose herein set forth.”

No objection was made by the Commissioner of Patents to the grant of a patent for the novel construction of vessels for the transportation of ice as claimed by him ; but the Commissioner decided that the applicant was not entitled to receive a patent for the manner of stowing the ice by placing the blocks edgewise.

From this decision he has appealed, according to the provisions of the 11th section of the act of March 3, 1839, and the 7th section of the act of July 4, 1836 ; and has filed in the Patent Office his reasons of appeal, and paid the sum of twenty-five dollars to the credit of the patent fund.

By the 11th section of the act of March 3, 1839, ch. 88, (pamphlet edition,) the judge is to confine his revision to the points involved in the *reasons of appeal*, and the Commissioner of Patents is to lay before the judge the grounds of his decision touching the same points.

The applicant claims a patent for his vessel, and his manner of stowing ice in vessels and ice houses, as one invention, and pays thirty dollars as for one patent.

The Commissioner denies his right to a patent for his manner of stowing, but admits it for his improvement in the construction of his vessel.

The first and principal point involved in the reasons of appeal is, whether the thing for which the patent is claimed is the invention or discovery of a new and useful art, or of a new improvement on an art, within the meaning of the constitution and laws of the United States respecting patents.

The invention, if it be one, consists only in laying each block of ice on its narrowest side. Can that act be considered as a new thing invented or made? Was it never done before? If it has been done before, although the *beneficial effect* of so placing it, rather than on its broadest side, had not been discovered, it is not a new thing. The only thing new is the discovery of the beneficial effect, and that is the discovery of a thing which existed before; for if it is now true that ice so placed keeps longer than when differently placed, it was always true; and that it existed before is shown in the specification, where it is said that the effect was discovered by *experience*.

Much of the confusion of ideas upon this subject has arisen from the ambiguity of the words "*discover*" and "*discovery*," used in the constitution and the patent laws of the United States. In their primary and common sense they are not synonymous with "*invent*" and "*invention*."

Mr. Webster, in the last 8vo. edition of his dictionary, under word "*discover*," says: "discover differs from invent; the *discover* what *before existed*; the *invent* what did *not before exist*." And under the article "*invention*," he says: "invention differs from discovery." "Invention is applied to the contrivance and production of something that did not before exist. '*Discovery*' brings to light that which *existed before*, but which was not known."

A discovery, in this sense, is not the subject of a patent; and it will be found, by a careful perusal of the constitution and laws of the United States upon the subject of patents for useful arts, &c., that it is not there used in this sense, but always as synonymous with *invention*.

Thus the constitution, (in ch. 4, art. 1, sec. 8, clause 8,) among the enumerated powers given to Congress, says: "To promote the progress of science and useful arts, by securing for limited terms to authors and *inventors* the exclusive right to their respective writings and discoveries."

Here it is evident, that the "*discoveries*," the use of which is to be secured, are the discoveries of *inventors* only. The applicant must invent, contrive, or produce something that did not exist before. A man may *discover* (i. e. may disclose) his invention; and for that discovery or disclosure he will be entitled to the exclusive use of his *invention* for a limited time.

In the first act of Congress, "to promote the progress of useful

arts," passed April 10, 1790, the words *invention* and *discovery* are used synonymously throughout the whole act; and whether application was for a patent, for an invention, or a discovery, it must be founded upon an invention or discovery of an useful art, &c., (or improvement therein,) not before known or used. The discovery of a new art that will justify a patent under that act can be only the *invention* of a new art, and the discovery of a new improvement, the *invention* of a new improvement. In every case, therefore, the applicant must be the inventor, and by the constitution none but *inventors* could be entitled to the monopoly.

The next act was passed on the 21st of February, 1793, entitled "an act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose."

By the first section of this act, the applicant was to declare that he had *invented* (not discovered) a new and useful art, &c., or improvement, &c., and the patent was to give a short description of the said invention or *discovery*. Here "*discovery*" is intended to be synonymous with invention, for the claimant had alleged an *invention only*; and it is afterwards again in the same section called, the said invention or *discovery*. The second section says, that any person who shall have *discovered* an improvement and obtained a patent therefor, shall not be at liberty to use the "*original discovery*, nor shall the first inventor" (i. e. of the *original discovery* which he had alleged to be his *invention*) "be at liberty to use the improvement;" and the change of form or properties was not to be deemed a "*discovery*." By the third section, "every *inventor* was to swear or affirm that he believed that he was the true inventor or *discoverer* of the art, &c." and deliver a written description of his "*invention*, by which it may be distinguished from other *inventions*."

The fourth and fifth sections speak of *inventors* and *inventions*, without saying any thing of discoverers or discoveries. The sixth section, alluding to the same *invention*, calls it "his *discovery*," and speaks of *original discovery* and *supposed discovery*, and the discovery of another man, and all these expressions are used in reference to what had been patented as inventions. The tenth section speaks of the *true inventor or discoverer*, and the eleventh section provides that *every inventor* shall pay thirty dollars before he presents his petition.

The act of 17th of April, 1800, only extends the privileges of the

former act to aliens, and to the legal representatives of *inventors* and *discoverers*, &c., and gives treble damages for violation of patent rights.

The act of July 13, 1832, applies only to aliens.

The next act is that of July 4, 1836, entitled "an act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose."

The first section speaks of "issuing patents for new and useful *discoveries*, *inventions*, and *improvements* as part of the business of the Commissioner of Patents, whose office was therein created.

In the 5th section the words *invention* and *discovery* are used throughout as synonymous.

The 6th section, which declares for what a patent may issue, shows that the applicant must have "*discovered* or *invented*" some new art, &c., or improvement, and it is called "his discovery or invention thereof," and he is called the *inventor* or *discoverer*. It then says: "But before any inventor shall receive a patent for any such new *invention* or *discovery*, he shall deliver a written description of his *invention* or *discovery*." The descriptions and drawings are to be "signed by the *inventor*," and he is to furnish a model of "his *invention*," and he is to make oath "that he does verily believe that he is the original and first *inventor* or *discoverer* of the art, &c., or improvement, for which he solicits a patent; and that he does not know or believe that *the same* was ever before known or used."

In the 7th section, wherever the word *discovery* or *discoverer* is coupled with invention or inventor, it is evident that it means the discovery or discoverer of something *new* — something that did not exist before — and, therefore, equivalent to *invention* and *inventor*. In the latter part of the section it speaks of the "science to which the alleged *invention* appertains;" and of the part or parts of the *invention* which he (the Commissioner) considers as not entitled to be patented.

The 8th section speaks of the right of "*an original and true inventor*" to a patent for his invention, and says nothing of a *discovery* or *discoverer*.

The 12th section speaks only of invention, not discovery; yet it is evidently applicable to the former sections, which use the words "*invention* or *discovery*."

The 13th section provides that where a patent shall be "invalid by reason of the patentee claiming in his specification, as his own

invention, more than he had a right to claim as *new*," the Commissioner "may cause a new patent to be issued to the said *inventor* for the same invention," &c. The same section afterwards speaks of a "description and specification of any new improvement of the original *invention* or *discovery* which shall have been *invented* or *discovered* by him" (the patentee) "subsequent to the date of his patent.

The 15th section specifies the special matter which may be given in evidence by the defendant under the general issue, among which is evidence tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his *invention* or *discovery*, or that the patentee was not the original and first *inventor* or *discoverer* of the thing patented, or of a substantial and material part thereof claimed *as new*; or that he had surreptitiously or unjustly obtained the patent for that which was, in fact, *invented* or *discovered* by another. It also speaks of "the invention or discovery for which the patent issued." It speaks also of the first *inventor*, without adding *discoverer*, and of the *invention*, without adding *discovery*.

The 16th section speaks of the *inventions* patented, and generally of inventions, without adding *discoveries*.

The 19th section speaks of injunctions to prevent the violation of the rights of any *inventor*, but says nothing of any discoverer, showing that the word *inventor* included all such discoverers as were contemplated by the legislature as within the protection of the *patent* laws.

The 18th section provides "that whenever the patentee of an *invention* or *discovery* shall desire to extend his patent beyond the term of its limitation, he may make application," &c., and shall "furnish a statement of the ascertained value of the invention;" and having failed to obtain from the use and sale of *his invention* a reasonable remuneration, &c., he may have the term extended. Here it is evident that the word *invention* was understood as equivalent to "*invention and discovery*," mentioned in the beginning of the section; and shows that the discovery contemplated was the discovery of something *new*, i. e. that did not exist before, and was used as synonymous with the word *invention*.

The remaining sections of the act do not use the words *invention* or *discovery*.

The act of March 3, 1839, (pamphlet, ch. 88, p. 74,) section 7,

says that every person who shall have constructed any "newly *invented* machine, manufacture or composition of matter, prior to the application by the *inventor or discoverer* for a patent, shall be held to possess the right to use," &c., "the specific machine," &c., "so made," &c., "without liability therefor to the *inventor* or any other person interested in such *invention* ; and no patent shall be held to be invalid by reason of such use," &c., "except on proof of abandonment of such invention to the public," &c.

There is nothing further in this act tending to explain the meaning of the word "discovery," as used in the constitution and laws of the United States respecting patents for useful arts.

Upon consideration of the constitution and laws of the United States upon this subject, therefore I think I may safely say that the claimant in this case can build no argument upon the supposed difference between a discovery and an invention, for no discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not exist before ; or, in other words, to an *invention*.

The patent claimed is for "*the placing of the prepared blocks edgewise,*" for the purpose set forth in the specification.

The placing of the blocks of ice edgewise is not the contrivance or production of any thing which did not exist before. It is not an invention. It is not a discovery, because everybody knew before that blocks of ice might be placed upon their narrowest side ; and it is asserted by the Commissioner in the grounds of his decision, and not denied in argument, that blocks of ice have been so placed, whether by accident or design is immaterial — the placing is not new. It is not an invention.

The discovery of a new effect of that which existed before is not the subject of a patent. Blocks of ice have been placed on edge before the alleged discovery by the claimant. If they were so placed with intent to retard their dissolution, I presume the claimant would at once abandon his claim. But the intent can be no ground of a patent. The claimant may be the first who placed blocks of ice on edge *with that intent*, but this cannot justify a patent for doing that which was often done without that intent.

In truth, the whole merit of the claimant is the discovery of a fact which existed long before, viz: that ice placed edgewise kept longer than when placed flatwise. This is a mere naked *discovery*, for which a patent cannot be granted. There is no invention — nothing contrived or produced — which did not exist before.

It is, however, contended that, although the discovery, merely as such, is not patentable, and although blocks of ice may have been often placed edgewise, yet "it will not be pretended that, in vessels or in ice houses, ice had ever been stowed away upon the *system* adopted by Mr. Kemper." By "*system*," I suppose, must here be meant intent or purpose, for the placing the ice on edge cannot, of itself, form a system. A system, as defined by Dr. Johnson, is "any complexure or combination of many things acting together; a scheme which reduces many things to regular dependence or coöperation; a scheme which unites many things in order."

The patent, in the present case, is not asked for a system, but for the exclusive right to place blocks of ice on their narrowest side. The claim, therefore, obtains no support by calling it a *system*, nor by calling it a "*plan*," as in the reasons of appeal, where it is asked, "Is the proposed plan unquestionably old." What the writer meant by the word *plan* is not very obvious; but I presume he intended to refer to the placing of the ice *edgewise, with the intent* that it should thereby keep longer than if otherwise placed. He probably meant to include the *intent* with the *act*; but, as before observed, if the thing done be not new, the intent cannot entitle it to a patent.

It is admitted, in argument in behalf of the appellant, "that a discovery, taken abstractedly, is not patentable;" but it is contended "that, if the thing discovered be practically applied to produce a new and useful effect, the manner of attaining the end is patentable." Now, let us apply this rule or doctrine to the present case. The thing discovered is the beneficial *effect* of the position of the ice — not the position itself. How is this effect, which is the thing discovered, applied by the appellant to produce a new and useful effect? And what is the new effect thus to be produced by the effect discovered? Whatever it may be, it must be produced by means that are new, by some *invention*, some contrivance, or production of something that did not before exist. The beneficial effect of the position of the ice is the retardation of its dissolution. No new and further effect is proposed. That retardation is the ultimate effect contemplated. No new means are intended to be used which can be the subject of a patent. A new effect from old means will not justify a patent from those old means. This case is, therefore, not within the rule or doctrine thus advanced to supply it.

The patent to Mr. Tudor for filling the interstices between the blocks of ice with some non-conducting substance is cited as a precedent for the present application. No judicial decision is produced affirming the validity of that patent, and it seems to me to rest upon very doubtful ground; but it is to be presumed that the commissioner who issued it was satisfied that the means used were a new invention.

Mr. Dolland's patent for an improvement is also referred to; but there the means used were decided to be, as to him, a new invention, although Dr. Hall had, forty years before, constructed two telescopes upon *the same principle*, but had not pursued the matter and brought it into public use. That case has no analogy to the present.

In the reasons of appeal, it is suggested that patents for *processes* or modes of *procedure*, in preserving animal and vegetable substances by means extremely simple, have been granted in England and in this country; but as they are not particularly brought to my notice, I cannot say how far they may be considered as precedents to justify the present application. I presume that, in all of them, something new was invented; something more than the discovery of a fact or a principle, and the application of such fact or principle to some useful purpose by old means, or by means not newly invented.

It is also suggested, in the reasons of appeal, that "the Commissioner is *bound* to issue a patent for the thing claimed, if, on examination, it shall not appear to him that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described, &c., as stated in the 7th section of the act of July 4, 1836; and that the *discovery* in question is not placed in either of the conditions that would justify the refusing of a patent under the law.

But the 7th section refers to the 6th, by which it appears that a patent is to be issued only to a person who has discovered or invented some *new* and useful art, &c., or some new and useful improvement on any art, &c.

The Commissioner, therefore, is to decide, in the first place, whether the invention is new, and whether it is the proper subject of a patent; he is bound to refuse it, although it may not be liable to the particular objections specified in the 7th section.

It is also said, in the reasons of appeal, that the professed rule of the office is, "that where the question is at all doubtful, the patent should be granted."

This rule, I suppose, must have been adopted when the applicant had no remedy if the Commissioner rejected his claim, and the decision of the Commissioner was affirmed by the board of examiners under the 7th and 16th sections of the act of July 4, 1836; which last mentioned section gave the applicant a remedy, by bill in equity, only in case the patent was refused on the ground that it would interfere with an unexpired patent previously granted. In all other cases of refusal, the applicant had no remedy; whereas, if the patent should be granted, its validity might be, at all times, questioned in the courts of law. It was reasonable, therefore, to adopt such a rule.

But now, by the 10th section of the act of March 3, if the patent be refused for any cause, either by the Commissioner or the judge, the applicant may still establish his right to a patent by a bill in equity.

The reason of the rule, therefore, fails, and I should not think myself bound by it, if I thought this to be a case of doubt, which I do not.

Every patent is a monopoly; and nothing can justify it but the natural right of property which a man has in the products of his own labor and ingenuity. With this exception, it is in derogation of common right; and it should be strictly confined to the case excepted. Upon the whole, therefore, I am of opinion, and so decide, that the decision of the Commissioner of Patents, that the applicant, John F. Kemper, was not entitled to receive a patent for the manner of stowing ice, by placing the blocks edgewise, was correct, and the same is hereby confirmed.

And I hereby certify the same to the said Commissioner of Patents. And I do further certify that, having received an appeal and the petition herewith enclosed of John F. Kemper, and the original papers named in the letter from the Commissioner of Patents of the 13th of February, 1841, herewith also enclosed, I ordered notice to be given, as appears in my order of the 17th of February, 1841, also herewith enclosed, which was returned to me on the 18th of February, 1841, with service acknowledged. I further certify that the parties appeared before me at my chambers, on Monday, the 8th of March, 1841, when, by consent, the hearing

was postponed to Monday, the 15th of March, when the applicant, by Dr. Thomas P. Jones, his attorney, presented his written answer to the grounds of the Commissioner's decision, (which written answer is also herewith enclosed,) when the hearing was further postponed, by consent, to Wednesday the 17th instant, and on that day further postponed until Friday, the 19th instant, when the parties attended, and the Commissioner filed his reply to the argument of Dr. Jones, which is also herewith enclosed, and the case was then submitted without further argument.

All which papers are herewith transmitted to the Commissioner of Patents this 22d day of May, 1841. W. CRANCH.

GEORGE W. HILDRETH, appellant, }
 vs. } Appeal from the decision of
 GEORGE HEATH, appellee. } the Commissioner of Patents.

On the 29th of April, 1840, George Heath filed in the Patent Office his application for a patent for his invention of an improved canal lock gate.

The Commissioner being of opinion that the patent thus applied for would interfere with an unexpired patent granted to George W. Hildreth, on the 19th of March, 1840, gave notice thereof to the parties, and, upon a hearing before him, decided, that George Heath was the original and first inventor, and entitled to a patent therefor.

From this decision Mr. Hildreth has appealed, and the question is now submitted to me by the parties upon written argument.

The Commissioner has furnished a certificate in writing of his opinion and decision ; and Mr. Hildreth has filed his reasons of appeal, with the written argument of his counsel.

The reasons for appeal thus filed are eight in number, but may be reduced to three.

1. Because Mr. Heath was not the first inventor, in the meaning of the patent law, inasmuch as his invention was never reduced to practice, but was the mere speculation of a philosopher or mechanic.

2. Because he never filed a *caveat* pursuant to the 12th section of the Act of July 4, 1836.

3. Because he has forfeited his claim to the invention by his delay in applying for a patent.

1. Upon the first point the very ingenious argument of Mr. Hildreth's counsel is founded upon a *dictum* of Mr. JUSTICE STORY, in the case of *Bedford v. Hunt, et. al.*, 1 *Mason*, 304, that "the first inventor who has put the invention in practice, and he only, is entitled to a patent;" and that *dictum* was perhaps founded on the words in the 6th section of the Act of February 21, 1793, viz: "or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery by the patentee," &c., from which an inference seems to be drawn that the defence — *that the matter was not originally discovered by the patentee* — would not avail the defendant, unless he show also that it had been in use by the prior discoverer.

But the words "*but had been in use*" seem to have been carefully excluded from the 15th section of the act of 1836, which, like the 6th section of the act of 1793, states the matters which may be given in evidence under the general issue in an action for infringing the plaintiff's patent.

By thus excluding these words the defence, "that the patentee was not the original and first inventor or discoverer of the thing patented," is complete, without showing that the first inventor had put his invention in practice.

None of the patent laws have ever required that the invention should be in use, or reduced to actual practice, before the issuing of the patent, otherwise than by a model, drawings and specification containing a written description of the invention, and of the manner of making, constructing, and using the same, in such full, clear and exact terms as to enable any person skilled in the art to which it appertains, to make, construct and use the same. In England it is understood that, if the thing is in use before the issuing of the patent, it is void; and our act of March 3, 1839, section 7, in order to meet such an objection, provides that the use of the thing, even by leave of the inventor, for two years before his application for a patent, shall not invalidate it; *a fortiori* the use of by a third person or subsequent inventor, after the first invention and before the issuing of the patent to the first inventor, without his consent, will not, under our patent laws, be a bar to the issuing of it.

Mr. JUSTICE STORY, in the case of *Bedford v. Hunt*, was not considering the question whether the patent *should be issued*, but whether it should be invalidated by prior use. He has not said that,

under any circumstances, an invention must be in use before a patent for it can be obtained, and his dictum is wholly inapplicable to the question whether the Commissioner of Patents should issue a patent.

If a patent should be issued to Mr. Heath, its validity would be still a question open to the courts; and is one which can be conclusively settled by the courts only.

By the 7th section of the act of 1836, the Commissioner is bound to issue a patent in the case, and under the circumstances there stated. He has in such a case no discretion; and the present is such a case.

By that section it is enacted "that, on the filing of any such application, description and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made an examination of the alleged new invention or discovery, and if, on such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented, or described in any printed publication in this or any foreign country; or had been in public use or on sale, with the applicant's consent or allowance, prior to the application, if the Commissioner shall deem it sufficiently useful and important, it shall be his *duty* to issue a patent therefor.

It appears by the proceedings before the Commissioner that Mr. Heath regularly filed his application, description and specification, and paid the duty; that the Commissioner made the examination, and that upon such examination it did *not* appear to him that the same had been invented or discovered by any other person, or had been patented or described in any printed publication in this or any foreign country, prior to the alleged invention or discovery thereof by the applicant; or that it had been in public use or on sale, with the applicant's consent or allowance, prior to his application.

The Commissioner was, therefore, *primâ facie* bound to issue the patent to Mr. Heath.

At first view it may seem doubtful from the words of that section, whether a patent issued to the second inventor, before the application of the first inventor, would not be a bar to the issuing of a subsequent patent to the first inventor. But upon comparing the words of that section with those of the 6th, 8th, and 15th sections

of the same act, it is evident that the patent, which would bar the issuing of a patent to the applicant, must be a patent issued prior to his *invention*, and not merely prior to his *application*.

Having complied with all the requisites of the 7th section, what is to prevent the applicant from obtaining his patent. It is alleged that he was not the first inventor, because he had not reduced his invention to practice. But that objection is answered by showing that there is no law which requires an inventor to put his invention in practice or use, before obtaining his patent; and it is perfectly immaterial to him whether the subsequent inventor had put it in practice or not. That fact cannot effect the right of the first inventor. If Congress had intended that a patent to the second inventor should be a bar to a patent to the first inventor, they would not have given jurisdiction to the Commissioner to decide the question of priority between them, and to grant a patent to the first inventor in cases of interference, as they have done by the eighth section of the act.

Neither that section, nor any other section of that, or any other act, makes the right of the patentee, or of the applicant, depend upon the fact of the invention being reduced to actual practice, except in the case of an *alien patentee* failing and neglecting, "for the space of eighteen months *from the date of the patent*, to put and continue *on sale to the public*, on reasonable terms, the invention or discovery for which the patent issued." From this exception, an inference may be drawn, that a *citizen patentee* cannot lose his right by *non user*, unless it amount to evidence of an abandonment of the patent; and the question of an abandonment of a patent is a question for the jury on a trial at law.

If the invention be the mere speculation of a philosopher or mechanic in his closet, and he takes no step towards obtaining a patent, but keeps his invention secret, and another person, who is also an original but subsequent inventor of the same thing, obtain a patent for it and bring it into use, it has been held, both in England and in this country, that the patentee, in a suit at law, is to be considered as the first inventor. But it has happened in such case, as in many others, that elementary writers, and subsequent tribunals, have laid down the doctrine in broader terms than the cases upon which it was founded will warrant.

Thus SMITH, in his *Epitome of the Patent Laws*, (p. 11,) says: "It sometimes happens that two men severally discover the same

thing, each by his own unassisted exertions; when this happens, the first who communicates it to the public is deemed the first inventor, and entitled to the patent;" and he cites *Boulton v. Bull*, 2 *H. Be.*, 487; *Forsyth v. Riviere*, *Chitty, Prerog. of the Crown*, 182, *n.*; *Lewis v. Marling*, 10 *B. & C.*, 22; *Wood v. Zimmer*, *Holt, N. P. C.* 98; *Edgebury v. Stephens*, 2 *Salk.* 47. And Mr. Justice Story, in the case before cited, says: "The first inventor who has put the invention in practice, and *he only*, is entitled to a patent."

The doctrine thus broadly laid down is not supported to that extent by the cases cited, and it would be unjust, if it were, for it makes no exception of the *bonâ fide* first inventor who is "using reasonable diligence in adapting and perfecting" his invention, and whose right is saved by the spirit, if not the letter, of the fifteenth section of the act of 1836, which makes it a good defence to an action for infringing the patent, that the plaintiff had "unjustly obtained the patent for that which was *in fact* invented and discovered by another who was using reasonable diligence in adapting or perfecting the same."

If such a case had been presented to the mind of Mr. Justice Story, there can hardly be a doubt that he would have excepted it from the broad terms of the doctrine as laid by him in the case of *Bedford v. Hunt*.

Such, from the evidence and admissions of counsel, was the case of Mr. Heath. He was using reasonable diligence in adapting and perfecting his invention; and it appears by testimony adduced by Mr. Hildreth that in the winter of 1839, before he obtained his patent, Mr. Heath exhibited to the witness, Alfred Barrett, who had in his possession a model of Mr. Hildreth's paddle-gate, his, the said George Heath's, model of his gate, and claimed to be the inventor thereof; it is probable, therefore, that Mr. Hildreth had notice of Mr. Heath's claim before he obtained his patent.

The doctrine as stated by Mr. Smith and by Mr. Justice Story seems to have originated in *Dolland's* case, cited by Buller, J., in the case of *Boulton v. Bull*. *Dolland* had a patent for an improvement in make object-glasses for telescopes. It was objected that he was not the inventor, "but that Dr. Hall had made the same discovery before him. But it was holden, that as Dr. Hall had confined it to his closet, and the public was not made acquainted with it, *Dolland* was to be considered as the inventor."

The case of *Dolland* is not reported; and all that we know of it

is what was said by Buller, J., in the case of *Boulton v. Bell*. 2 H. Be., 463 - '4 ; and upon that foundation is probably built the broad doctrine that the first of the two original inventors who communicate the invention to the public is entitled to the patent, although the other invented the thing first.

Between *simultaneous* inventions, this may be just, because neither can claim priority, but it cannot be just that the prior inventor, who is maturing his invention, and preparing to make application for a patent in a reasonable time, should be defeated by a subsequent inventor who first obtains a patent. This is not the doctrine of Dolland's case, which was only that an inventor *who confines his invention to his closet*, and does not communicate it to the public, and takes no steps towards obtaining a patent until a subsequent original inventor has obtained his patent, thereby forfeits and abandons his claim to priority of invention. But the question of forfeiture or abandonment is for the jury, upon a trial at law. The first inventor is *primâ facie* entitled to a patent, and the Commissioner, as before observed, is bound to issue it under the 7th section of the act of 1836, if certain facts should not appear to the Commissioner as therein specified ; which specification of facts does not include *delay* or *abandonment* ; so that the question of delay or abandonment is not, by that section, submitted to the jurisdiction of the Commissioner.

I do not consider the expression " reduced to practice " as importing the bringing the invention into use. When applied to an invention, it generally means the reducing it into such form that it may be used, so as not to be a mere theory. If a machine be invented and described in such a manner that it may be made and used, and especially if a model be made, the invention may be said to be reduced to practice. In the present case, it is admitted in argument (and such is the evidence) that Mr. Heath, in the summer of 1836, actually made a lock gate according to his specification. It was, indeed, a small one, a model only, but the size is of no importance. The thing was done ; the invention was reduced to practice ; and it was demonstrated thereby that the invention was practicable.

I am, therefore, and for the reasons before stated, of opinion that where the invention is not of a mere philosophical speculation, abstraction, or theory, but of something corporeal, something to be *manufactured*, the applicant need not show that he has reduced his invention to practice otherwise than by filing his specification and

furnishing drawings and a model, as required by the statute, where the nature of the case admits of drawings or of a representation by a model. These having been thus filed and furnished by Mr. Heath, and it being admitted that he, in point of time, was the *first* inventor of the thing patented, he is entitled to a patent therefor notwithstanding the patent granted to Mr. Hildreth, unless he has lost his right by not filing a *caveat*, or by delay in applying for his patent.

2. The second reason of appeal is, that Mr. Heath never filed a *caveat*, pursuant to the 12th section of the act of July 4, 1836.

That section was introduced for the benefit of the inventor, but was not necessary to the preservation of his right. It only enables him to have notice of any interfering application.

Godson (Law of Patents, 146) says: "Of its nature and effect much misconception has arisen. It does not create any right, but is simply a request to be *favoured* with information." Again, he says: "Upon the whole, therefore, the entering of a *caveat* is nothing more than giving information that there is an invention nearly completed, and requesting that, if any other person should apply for a patent for the same thing, the preference may be given to him who entered it, which request is complied with by the *courtesy*, of the crown, upon its being satisfied of its reasonableness by the attorney-general, or the opinion of the lord chancellor; and when the patent is granted, it is to be judged of as if no *caveat* had been entered."

But this *caveat* gives no notice to the world, or even to the interfering applicant. It is notice to the Commissioner only; and is locked up in the secret and confidential archives of the office. It would not in any manner have strengthened the title of Mr. Heath; nor does the omission of it impair that title, or aid that of Mr. Hildreth.

This reason of appeal, therefore, as well as the first, must be overruled.

3. The statute does not limit any time in which the inventor must apply for a patent; nor does it declare a forfeiture by reason of any delay. The delay, therefore, seems to be unimportant, unless it amounts to evidence of abandonment of the claim. It is not one of the specified grounds for which the Commissioner is, by the 7th section of the act of 1836, authorized to refuse to grant the patent; and it seems to be a matter within the peculiar province of the jury upon a trial at law, in any action which either of the patentees may institute against the other. If there be any limit of the time of applica-

tion, it must be a reasonable limit, and that is proper matter for the consideration of a jury ; and I am very much inclined to the opinion, that any matter of defence which it is the peculiar province of a jury to decide, and which is not by the 7th section of the act of 1836, made a ground for the refusal of a patent by the Commissioner, should be left by him to be decided by the jury in a subsequent action at law.

In *Morris v. Huntingdon*, 1 Paine 354, Mr. JUSTICE THOMPSON said : “ No man is to be permitted to lie by *for years* and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public before taking out a patent, *that ought not to prejudice him* ; but it should always be a question *submitted* to the jury, what was the intent of the delay of the patent, and whether the *allowing* the invention to be used without a patent, should not be considered an abandonment, or present of it to the public ? ”

In *Pennock & Sellers v. Dialogue*, 2 Peters 16, Mr. JUSTICE STORY, in delivering the opinion of the court, says : “ It has not been, and indeed cannot be, denied, that an inventor may abandon his invention and surrender or dedicate it to the public.” “ The question which generally arises at trials is a question of fact, rather than of law, whether the acts of acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment, or dedication of the invention to the public.” The point decided by the court in that case, was “ that the first inventor cannot acquire a good title to a patent, if he *suffers* the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent.” But it is believed that it has not yet been decided that the right of the first inventor has been lost merely by lapse of time between the invention and application for the patent, unless there has been some intermediate use by the applicant, or by his consent ; and especially where he was *bondâ fide* taking measures to improve or perfect his invention, and to prepare for applying for the patent ; which, from the evidence, appears to have been the case of Mr. Heath.

If, therefore, the question of abandonment be cognizable by the Commissioner, there is, in my opinion, no evidence to support it ; and this reason of appeal must also be overruled.

It is, therefore, upon the whole case, my opinion, and I do so decide and adjudge, that the decision of the Commissioner of Patents in this cause be, and it is hereby, affirmed.

Certified by me, this 15th of October, 1841. W. CRANCH.

DISTRICT OF COLUMBIA, *to wit* :

I, William Cranch, Chief Justice of the District of Columbia, certify to the Commissioner of Patents, that, upon the appeal of George W. Hildreth from the decision of the Commissioner of Patents, upon the application of George Heath for a patent for hydraulic gates for canal locks, &c., on the 4th of September, 1841, I ordered notice to be given to the parties to appear before me on the last Monday of September, 1841, for the hearing of the said appeal; at which time the said George W. Hildreth appeared by Thomas P. Jones, Esq., and the said George Heath by Mr. Fitzgerald, and submitted the case to my consideration upon the evidence and the reasons of appeal, and the argument of the counsel of Mr. Hildreth, and the grounds of the decision of the said Commissioner, fully set forth in writing: all which being duly heard and considered, I have decided, and do hereby decide and adjudge, that the decision of the said Commissioner of Patents — that the said George Heath is the original and first inventor of the matter for which he has applied for a patent, and is entitled, as such, to receive the patent for which he has applied — be, and the same is hereby, affirmed.

Given under my hand, this 15th of October, 1841.

W. CRANCH.

I herewith return all the papers.

W. CRANCH.

JOHN ARNOLD, appellant, <i>vs.</i> GEO. G. BISHOP, & JOHN AKIN, appellees.	}	Appeal from the decision of the Commissioner of Patents.
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On the 19th of September, 1840, John Arnold made application for a patent for his invention of a “new and useful manner for forming the web of felt cloth and web for other purposes,” and in October following complied with the other requisites of the act of the 4th July, 1836. A caveat, however, had been entered by George G. Bishop and John Akin, who claimed to be joint inventors with the said John Arnold of the same machine; and on the 20th of March, 1841, the said Bishop and Akin made application by petition for a patent for the same invention in the name of the said Bishop, Akin, and John Arnold, averring it to be the joint invention of the three.

The Commissioner, on the 30th of March, 1841, decided them to be interfering claims, and notice was given to the parties by the Commissioner that he would hear them on the second Monday in May, 1841, and they respectively took the depositions of several witnesses.

On the 16th of June, 1841, the Commissioner decided that it was to be considered a joint invention, and that neither of the parties can claim the whole, and rejected the applications of all the applicants. From this decision, Mr. Arnold has appealed, and the reasons stated are in effect: That the Commissioner has considered and acted upon evidence not competent according to the general rules of law, and upon testimony not taken according to the regulations prescribed and promulgated by himself; and that, independent of the evidence thus objected to, there is not sufficient to establish the fact of *joint* invention. And Mr. Arnold's attorney asks leave to be further heard if his objections to the evidence should be overruled.

The evidence objected to consists of—

1. John Akin's *ex parte* affidavit in support of the same joint claim.

3. Letters from Mr. Rowley to the Commissioner of Patents, dated respectively March 15, May 2, and June 9, 1841.

4. George G. Bishop's letters to the Commissioner of 7th of May and 12th June, 1841.

5. Mr. Rowley's deposition.

One of the objections to the deposition of Mr. Rowley is, that the Commissioner of Deeds, before whom the deposition was taken, has not certified upon the deposition, according to the 5th rule, that it was sealed up by him; and there is no evidence that it was *in fact* sealed up by him.

By the act of March 3, 1839, § 12, it is enacted, "That the Commissioner of Patents shall have power to make all such regulations, in respect to the taking of evidence to be used in *contested* cases before him, as may be just and reasonable."

Under this authority, the Commissioner made out and promulgated the following rules:

RULES FOR TAKING AND TRANSMITTING EVIDENCE, &c., TO THE
COMMISSIONER OF PATENTS.

PATENT OFFICE,

1st. That all statements, declarations, evidence, &c., shall be in

writing, setting forth, minutely and particularly, the point or points at issue, and shall be verified by oath or affirmation.

2d. That all statements, declarations, proofs, and evidence, shall be filed in the Patent Office, by the parties respectively, before the day of hearing.

3d. That, before the deposition of a witness or witnesses be taken by either party, notice should be given to the opposite party of the time and place when and where such deposition or depositions will be taken ; so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or witnesses. And such notice shall, *with proof of service of the same*, be attached to the deposition or depositions, whether the party cross-examine or not ; and such notice shall be given in sufficient time for the appearance of the opposite party, and for the transmission of the evidence to the Patent Office before the day of hearing.

4th. That no evidence, statement, or declaration, touching the matter at issue, will be *considered* upon the said day of hearing, which shall not have been taken and filed in compliance with these rules : *Provided*, That if either party shall be unable, from good and sufficient reasons, to procure the testimony of a witness or witnesses, within the above stipulated time, then it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied with statements of the cause of such inability, which last mentioned notice to the Commissioner shall be received by him _____ days previous to the day of hearing aforesaid, viz. : the _____ day of _____ next.

5th. That all evidence, &c., shall be sealed up and addressed to the Commissioner of Patents, by the persons before whom it shall be taken, and so certified thereon.

The first of these rules is evidently intended to apply to the initiatory proceedings in applications for patents, and to uncontested cases, where the Commissioner may consider all the circumstances which may come to his knowledge. The other rules, viz. : the 2d, 3d, 4th, and 5th, are applicable to contested cases, where parties are to be heard ; and in such cases, inasmuch as each party is bound by the rules, each party is also entitled to the benefit of them. The 4th rule says : " That no evidence, statement, or declaration, touching the matter at *issue*, will be considered upon the said day of hearing which shall not have been taken and filed in compliance with

these rules." This is a restraint imposed upon the Commissioner himself as much as if the very words of the rule had been contained in the statute; for the rules, made in conformity with the law, while they remain unabrogated, are as binding as the law itself. The rule is an assurance, an engagement, by the Commissioner, that he will not, at the hearing, *consider* any evidence not taken and filed in compliance with these rules; one of which was that the person taking the deposition should certify thereon that it was sealed up by him. This is not an immaterial form. It is a security that the deposition has not been altered after it left the hands of the magistrate before whom the deposition was taken. In the rules which the Commissioner has promulgated, he has not reserved any right to dispense with them, in particular cases, at his pleasure. After a deposition has been taken while the rules were in force, his dispensation cannot affect that deposition. A revocation of the rules can affect only subsequent proceedings. After a contest has arisen, the parties have a right to insist not only that the evidence should be taken agreeably to the rules prescribed by the Commissioner, but that it should be evidence competent in law. It is one of the rules in law, that no man can be a witness in his own cause, unless made competent by statute, or by being called upon by the opposing party to answer upon oath, as in cases of equity and admiralty jurisdiction, &c.

If the witness is interested he is excluded, however small the amount of interest may be.

Objection was made to the taking of the deposition of Mr. Rowley, at the time of taking it, because of his interest, and because the notice was too short; because the magistrate was not named before whom the deposition was taken, and because the time was so late that Mr. Arnold would not have time to take countervailing testimony.

The interest of Mr. Rowley in the patent right is the same, whether the patent should be granted to Mr. Arnold alone, or jointly to the three applicants; for his only interest is as a member of the company to whom all the applicants have bound themselves to convey the patent right when obtained. If the covenants do not cover the claim for a patent, then Mr. Rowley is not interested at all. If they do cover it, then it is immaterial to him which of the claimants obtains the patent.

The objection to the shortness of the notice is answered by the

fact that Mr. Arnold did appear at the time and place, and cross-examined the witness. The lateness of the time is no cause for rejecting the deposition; but it might, perhaps, have been good ground for an application to the Commissioner of Patents to allow further time for taking other testimony which he might deem important in the cause.

But the objection that the magistrate, before whom the deposition was taken, did not certify thereon that it was sealed up by him, is sufficient ground for excluding that deposition from the consideration of the Commissioner of Patents.

This evidence, then, being excluded, there remains only, on the part of Messrs. Bishop and Akin, the deposition of Mr. Lownsberry.

This deposition is admitted to have been taken and transmitted according to the rules; but it is said that it shows Mr. Lownsberry to be so interested as to be an incompetent witness. In that respect, however, he stands on the same ground with Mr. Rowley, and the same answer is applicable to him.

It appears by his deposition that the idea of crossing the wool diagonally was suggested by Mr. Bishop and Mr. McLean, or one of them, before Arnold was applied to, or had any connection with the company in which Lownsberry, Bishop, and McLean was concerned; that, upon the recommendation of Mr. Moulton, Bishop, as agent of the company, applied to Arnold to make the necessary machinery, who undertook the work, and was to have one-fifth of the concern; that he made a machine for crossing the wool at right angles, and obtained a patent for it in 1829 or 1830, which was afterwards improved by him and Bishop, who obtained a patent for the improvement in their name; that Bishop frequently, from 1828 to 1837, urged the building of a machine to cross the wool diagonally, to which Mr. Lownsberry was opposed. The machine, however, was built in 1837, by Arnold and Akin, *for the company*, who paid them for building it. It has always been in possession of the company, and owned by them; that the machine is the same spoken of by Alonzo C. Arnold in his deposition, and the model of which was sent to the Patent Office by Bishop, in March, 1841.

That one objection to adopting the diagonal machine was, that it would interfere with a patent machine then in operation at Catskill; but the right-angled machine did not interfere, and made a better article.

That the claim of Bishop and Akin is made for the benefit of the company, and that whether the patent be taken out in the joint names of Bishop, Akin, and Arnold, or of Arnold alone, the benefit of it is to be assigned and transferred to the company under certain covenants, entered into by all of them, to the company; and copies of these covenants are filed with the papers in this cause.

He does not know who invented the machine built by Arnold in 1837, but it is the same mode which had been agitated by Bishop, and occasionally by Arnold during their connection in business. That Akin suggested alterations while the machine in 1837 was putting up, and after it was up, to make it go better; that he did the greater part of the work; cannot explain the alterations, nor the difficulties to be overcome, *but it did not operate at all*. It seems to me that there is enough in this deposition to show that Mr. Arnold was not the sole inventor of the principle of crossing the wool diagonally, or of the machine for reducing that principle to practice; and, if not the sole inventor, he is not entitled to a patent.

There is no claim before me upon this appeal but that of Mr. Arnold. Bishop and Akin have not appealed from the decision of the Commissioner rejecting their joint claim.

It appears by Lownsberry's deposition that the principle or mode of crossing the wool diagonally was suggested and contemplated by Bishop and McLean before Arnold was employed by them to reduce their ideas to practice. The machine did not constitute the whole invention. The next material part of the invention was the principle, i. e., the diagonal motion, which was to distinguish this machine from all other felting machines; and it is the vibratory and rotary motions which produce the diagonal crossing of the wool, which Mr. Arnold claims as his invention, and for which he asks a patent. The man who reduces to practice the theory of another who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine. Arnold would not have made the machine unless informed by Bishop of the discovery which he had made of the effect of the diagonal crossing of the wool. The invention consisted both of the discovery of the principle and the reduction of it to practice. Neither Bishop nor Arnold, therefore, could be considered as sole inventor. It appears also by the deposition of Henry Lamb, taken by Mr. Arnold, that the machine, when first put up, "*would not go*;" that Akin went up to remedy

the defect, and that the witness afterwards saw it in operation in the fall of 1837, or spring of 1838; and that he never heard Arnold claim the patent right until within a year.

I see nothing in the deposition of Alonzo C. Arnold inconsistent with the facts stated by Mr. Lownsberry in his deposition; but if there were, Alonzo C. Arnold seems, by his own showing, to be interested by the promise of his father, to give him a share in the patent if it should be obtained; for, although afterward, in answer to the leading question, he said the agreement was *abandoned*, yet it is evidence that in the preceding part of his deposition, he thought it depended upon his generosity whether he should have an interest in the patent when obtained. If this interest, however, was not sufficiently certain to exclude his testimony, it cannot fail to have some effect upon his credibility.

But he states that the machine was put in operation in 1837, and his father never spoke with him about getting the patent, now applied for, until the summer of 1840, and after his father had ceased to be a member of the Union manufactory, who claim the benefit of the patent under the agreement before mentioned, if it should be obtained by either or all of the claimants. It may be inferred from this, that so long as he remained a member of the company he did not claim a sole right, or any right to the invention. Another strong argument that he did not claim to be the inventor during those three years, results from his suffering the machine to be set up and used during that period, without taking any steps to secure a patent, when, by the terms of the acts of 1836 and 1839, the use of the machine, with his consent, for two years prior to his application is a bar to his claim.

That fact, indeed, seems to be a bar to all their claims, and to put an end to this controversy; for, if a patent should now be granted to any of them, and an action should be brought by the patentee for a violation of the patent right, it seems that the defendant might defend himself under the 15th section of the act of 1836, and the 7th section of the act of 1839, by showing that the machine had been in public use, with the consent of the patentee, for more than two years prior to the application for the patent.

It is suggested in the reasons of appeal, that if the decision of the Commissioner is sustained, there does not appear to be any possible mode of determining this question; and that it is only by granting the patent to Arnold, that the rights of the individuals

interested, and of the public, can be determined according to the intention of the acts of Congress for the promotion of the useful arts.

But upon comparing the 16th section of the act of 1836 with the 10th section of the act of 1839, it will appear that, "in all cases where patents are refused, for any reason whatever, either by the Commissioner of Patents, or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner," the "applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had," "may adjudge that such applicant is entitled, according to the principles and provisions of the act of 1836, to have and receive a patent, for his invention, as specified in his claim;" "and such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent on his filing a copy of the adjudication, and otherwise complying with the requisitions of that act.

The reservation of a right to a further hearing on the part of Mr. Arnold's attorney, was confined to the case of my admitting the evidence which he objected to; and, as I have rejected that evidence, any further hearing is unnecessary.

Upon the whole, then, after rejecting the evidence, I am of opinion that Mr. Arnold has not supported his claim as sole inventor; and that if he had, he has lost his right to a patent, by suffering the machine to be in use for more than two years before his application for a patent; and that, therefore, and upon both grounds, the decision of the Commissioner of Patents, rejecting his claim, ought to be, and it is hereby affirmed.

W. CRANCH.

October 29, 1841.

Subsequent to this decision of the honorable judge, he transmitted a second opinion to the office, in the following words:

JOHN ARNOLD, appellant, vs. GEORGE G. BISHOP and JOHN AKIN, appellees.	}	Appeal from the decision of the Commissioner of Patents.
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After I had sent my opinion in this case to the Commissioner of Patents, on the 30th of October last, I was satisfied that I had mis-

apprehended the attorney of Mr. Arnold, in supposing that, in case I should sustain his objections to the testimony and evidence on the part of the appellees, he would not desire to be further heard, I therefore determined to hear his further argument, on the 20th instant, at my chambers, of which I gave notice to the attorneys of the parties, and they attended, viz: Doctor Jones on the part of the appellant, and Mr. Morfit on the part of the appellees. Mr. Fitzgerald also attended on behalf of the Patent Office, to give any explanations, &c., which might be required. Doctor Jones then presented his further argument, in writing, in which he contended that this claim of Mr. Arnold for a patent is not included in the covenant to the Union Manufacturing Company, of which Mr. Lownsberry is a member; and, therefore, that the interest of Mr. Lownsberry "cannot be the same whether the patent should be granted to Arnold or to the three applicants."

I cannot, however, perceive how that consequence should follow. It is only by introducing the assignments and covenants by Mr. Arnold to the Union Manufacturing Company, and by showing that these covenants cover this claim, that Mr. Lownsberry is supposed to be interested.

If those covenants do not cover this claim, then Mr. Lownsberry is not interested; and if they do, then, as all the applicants are bound by similar covenants, it is not material to him which prevails.

The only question for me to decide is that which is suggested by the reasons of appeal, viz: whether Mr. Arnold was the sole inventor of the machine.

To that question it is wholly immaterial whether it be an entirely new machine, or an improvement upon an old one.

Upon a careful review of the depositions of Alonzo C. Arnold, Mr. Waters, and Mr. Lamb, taken on the part of the appellant, and of that of Mr. Lownsberry, on the part of the appellee, I am still of opinion that Mr. Arnold has not supported his claim as sole inventor.

But it is suggested that there is no law which authorizes the Commissioner of Patents to withhold the grant of a patent, in the case in question, that is, where the applicant is not the sole inventor; that it is not one of the grounds, stated in the 7th section of the act of 1836, which would justify the Commissioner in refusing the patent; and that the only one of these grounds which can be sup-

posed to apply to this case is, its appearing to the Commissioner that the same thing had been invented or discovered by some other person *prior* to the alleged invention or discovery by the applicant.

But by the sixth section of the same act, the applicant must be the *inventor*. One of the three joint inventors cannot with propriety be called *the* inventor; and if he applies for the patent, the Commissioner is bound to refuse it. This seems to be admitted in the reasons of appeal, where it is said that Arnold, who has sworn that he was the original and first inventor, cannot, without admitting that he has been guilty of perjury, acknowledge that Bishop and Akin were joint inventors with him; and that, upon their own showing, a patent cannot be granted to Bishop and Akin without the concurrence of Arnold.

Here, then, is the authority of the Commissioner to withhold a patent from an applicant who is not the sole inventor.

In my former opinion in this case, I stated as one of the grounds for affirming the decision of the Commissioner of Patents rejecting the claim of Mr. Arnold, that he had lost his right, if he had any, by suffering the machine to be in use for more than two years before his application for a patent. I should have said "public use," which are the words of the statute. But, upon reflection, I doubt whether I can decide upon any other matter than that which arises upon the *reasons* of appeal. The words of the act of 1839, section eleven, which confer the jurisdiction upon the judge, after allowing the applicant a right to appeal, by giving notice thereof to the Commissioner, filing his reasons of appeal, and paying into the office twenty-five dollars to the credit of the patent fund, are: "and it shall be the duty of the said chief justice, on petition, to hear and determine all such appeals, and to *revise* such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing; whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, *touching all the points involved in the reasons of appeal* TO WHICH THE REVISION SHALL BE CONFINED," i. e., the revision by the judge shall be confined to *the points involved in the reasons of appeal*. He is to "hear and de-

termine such appeals," but he is to revise the decision of the Commissioner only in respect to the points involved in the reasons of appeal. If the Commissioner did not err in *those* points, his decision upon those points must be affirmed, although the judge should be of opinion, upon the evidence and the merits of the whole case, that the patent ought to have been granted ; so, if the judge should reverse the decision of the Commissioner upon those points, *it would seem* that the patent must issue, although the judge should be of opinion that upon the whole case, as it appears in evidence before him, the patent ought not to issue. I say this would *seem* to be the effect of such a decision ; because the effect of such a decision upon the further proceedings of the Commissioner would depend upon the question, whether the reasons of appeal thus affirmed, by the judge, involved the merits of the case. If they did not, the Commissioner might well say : it is true, I erred in those points, but my objections to the issuing of the patent still exist untouched by the decision of the judge. The words of the act are, that the judge's decision "*shall govern the further proceedings of the Commissioner in such case.*" This must apply only to so much of the case as is involved in the reasons of appeal ; and the appeal itself can be considered only as an appeal to so much of the decision of the Commissioner as is effected by such reasons. If, therefore, after the judge shall have decided in favor of the applicant upon the points involved in his reasons of appeal, other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, it would seem that the Commissioner might properly still reject it.

Whether such new rejection would be subject to appeal, is a question which may be left, as well as the effect of the judgment of the judge in regard to the subsequent proceedings of the Commissioner, to future decision, as cases may arise requiring a decision upon those points. For these reasons, I doubt very much, whether it was competent for me to decide in this case, that Mr. Arnold has lost his right to a patent by suffering the machine to be in public use for more than two years before his application for a patent. So much, therefore, of my former opinion in this case may be considered as *extra judicial and as withdrawn*. This renders it unnecessary to answer the very ingenious argument of Mr. Arnold's attorney upon that point ; which argument, however, has not in any degree diminished my confidence in the correctness of the opinion which I have thus withdrawn. This withdrawal does not in any manner affect the judgment which I cer-

tified on the 29th of October, 1841, inasmuch as I am still of opinion that Mr. Arnold has not supported his claim as the sole inventor of the machine for which he claims a patent.

The judgment, therefore, rendered by me, and certified on the 29th of October last, must stand as my final decision in the case.

W. CRANCH.

November 25, 1841.

Judgment in the Case.

DISTRICT OF COLUMBIA, *to wit* :

JOHN ARNOLD, appellant, <i>vs.</i> GEO. G. BISHOP and JOHN AKIN, appellees.	}	Upon appeal from the Commissioner of Patents, rejecting the application of John Arnold for a patent for his invention of "a new and useful machine for forming the web of felt cloth, and web for other purposes."
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I, William Cranch, chief justice of the District of Columbia, certify to the honorable the Commissioner of Patents, that on the 4th Monday of October, 1841, the day appointed by me therefor, the parties appeared before me, namely : the said John Arnold, by his attorney, Dr. Thomas P. Jones, and the said appellees, by Mr. Morfit, and submitted the said case to my consideration, upon the petition of the said John Arnold and the statement of the reasons of appeal, and upon the original papers and evidence in the case, and the grounds of the Commissioner's decision therein fully set forth in writing, touching all the points involved in the reasons of appeal ; and that the same having been duly considered,

I do decide and adjudge, that the decision of the said Commissioner of Patents, rejecting the application of the said John Arnold for a patent for the invention aforesaid, be, and the same is hereby, affirmed ; and I herewith return all the papers in the cause.

W. CRANCH.

WASHINGTON, *October 29, 1841.*

AT CHAMBERS, *Nov. 21, 1842.*

RALPH POMEROY, appellant, }
ALEX. CONNISON, appellee, }

Alexander Connison applied for a Patent.

The Commissioner of Patents being of opinion that the patent applied for would, if granted, interfere with a prior unexpired patent to Ralph Pomeroy, granted on the 24th of January, 1841, gave him notice thereof, under the 8th section of the act of July 4, 1836, chap. 357, vol. 8, p. 549, and he appeared before the Commissioner of Patents and contested the right of Mr. Connison, who claimed to be the first inventor. The Commissioner, on the 25th of July, 1842, decided "that a patent ought to issue to Alexander Connison, as the first original inventor, and that the same be accordingly issued, unless an appeal be entered within ten days."

From this decision Mr. Pomeroy appealed, and filed his reasons of appeal.

The Commissioner has laid before the Judge the grounds of his decision in writing, with the original papers, and the evidence in the cause.

The first question is, has the Judge jurisdiction upon this appeal from the decision of the Commissioner, not *rejecting* but *granting* the application?

In no other case under the patent laws can an appeal be taken from the decision of the Commissioner, unless the application for a patent has been rejected by him.

In no other case can an appeal be taken to the granting of a patent; and the reason for giving an appeal from the rejection of an application for a patent, and not giving an appeal from the granting of a patent, is, that the applicant whose application is rejected has no remedy. He cannot go into a court of law or of equity to obtain a patent; nor can he maintain any action for the use of his invention. But if the Commissioner should grant a patent erroneously, its validity may be tried; and any person interested may defeat it by a suit at law or in equity.

The general object of giving an appeal under the patent laws, therefore, is to correct the error of the Commissioner in *refusing* to grant the patent applied for. His error in *granting* a patent is corrected by the ordinary tribunals of the country; and there was no need of a special tribunal for that purpose.

This general object seems to me to govern all the provisions of the laws upon this subject, and ought to be taken into consideration in their construction.

Thus in the 7th section of the act of July 4, 1836, "if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may on appeal, and upon request in writing, have the decision of a board of examiners," &c., who may reverse the decision of the Commissioner. And by the 16th section, the remedy given by bill in equity is confined to the case of two interfering patents, and to the *refusal* of the board of examiners to grant a patent. The provisions of this section are, by the 10th section of the act of 1839, extended to all cases where patents are *refused*, for any reason whatever, by the Commissioner of Patents or by the Judge, &c.

The proceedings before the Commissioner and before the Judge by appeals are all *initiatory* — all relating to the question, whether a patent shall issue; they cannot effect a patent already issued. Such are the provisions of the act of 1836, sections 5, 6, 7, 8, 9, 10, 11, 12, and 16, and of the act of 1839, sections 10 and 11.

There is no section or clause of either of the acts which gives a *patentee* a right of appeal from the decision of the Commissioner granting a patent to another person, unless that right be given by the 8th section of the act of 1836.

By that section it is enacted "That whenever an application shall be made for a patent, which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice *thereof to such applicant*, or patentee, as the case may be; and if *either* shall be dissatisfied with the decision of the Commissioner, on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for."

The power and jurisdiction given by the patent laws to the board of examiners and to the judge are special and limited, and must be construed and exercised strictly. The judge can only decide such questions, and render such judgment as he is expressly authorized by the statutes to decide and render. In the case stated in the 8th sec-

tion of the act of 1836 the judge is only "to determine which or whether either of the applicants is entitled to receive a patent as *prayed for*." He can only act in a case where there are *contending applicants* for a patent, and those applicants must have "*prayed for*" a patent. A *patentee* is not an *applicant*. He has already obtained all he asked for. If his patent can be supported at law, he has nothing to fear. The grant of a subsequent patent erroneously to another cannot affect the validity of his patent. The judge is to determine which or whether either of the applicants is entitled "to receive" a patent. It would be absurd to say that a *patentee* is entitled to *receive* the patent after he has already received it.

It is true that the 8th section, after speaking of *applicants* and *patentees*, says, if *either* shall be dissatisfied, he may appeal. The word "*either*" may be satisfied by applying it to the words "*such applicants*;" i. e. "*either*" of "*such applicants*." And that such was the understanding of the legislature seems probable, from the fact that they have only authorized the judge to determine between contending applicants, and not between an applicant and a patentee; for when they come to say what the judge is to do upon the appeal, we find it is "to determine which or whether *either of the applicants* is entitled to *receive* a patent as *prayed for*." The word "*either*" in the former parts of the clause is here explained to mean either of the applicants. It cannot be contended that the judge is to decide whether a patentee is entitled to receive a patent which he has already received, and which he still has in his possession.

This construction of this section is corroborated by the reference to it in the 11th section, which gives a right to file a *caveat*; and where it is said, that "if in the opinion of the Commissioner the specifications of claim interfere with each other, like proceedings may be had in all respects as are provided in the case of interfering *applications*," (i. e., in the 8th section.)

The 16th section seems to give the remedy in a case of interfering patents, which this will be if the Commissioner shall issue a patent to Mr. Connison. It also provides for the case where a patent is *refused* by the board of examiners, on the ground that it would interfere with an unexpired patent; and the provisions of this section are extended by the 10th section of the act of 1839, to all cases of *refusal* by the Commissioner or the Judge.

When the patent has issued, the jurisdiction of the Commissioner is exhausted. He has no further control over it, except in the case

provided for in the 13th section of the act of 1836, where the patent is inoperative or invalid by reason of a defective or insufficient description. An adjudication upon it by the Commissioner or the Judge has no effect upon a patent already granted, and is entirely inoperative as to the rights of the parties, unless the decision be *against the applicant*, against whom it would be conclusive, unless an appeal were given by the statute. He could apply to no other tribunal. But as to the *patentee*, a decision against *him* would be a *brutum fulmen*; and if the second patentee should do any act under his patent to the supposed injury of the first patentee, *he* would have a right of action, and might maintain the validity of his patent in the same manner and to the same effect as if the second patent had not issued. When the Commissioner inquires as to the relative priority of invention between the applicant and the patentee, it is only for the purpose of setting aside the patent already granted, over which he has no control. The decision of the Commissioner does not affect the patentee if his patent is valid, and if it is invalid, he has no right to complain.

There was no necessity, therefore, that the patentee should have a right to appeal from the decision of the Commissioner, which could have no effect upon his rights. This is a sufficient reason why the legislature should not give him a right to appeal in such a case. He has already abundant means of redress, both at law and in equity, if his patent is valid, and should be violated; and this accounts for the restraining the action of the Judge to the case of contending applicants.

An appeal is given to a disappointed applicant, because otherwise the decision of the Commissioner would be conclusive against him. It is not given to the patentee, because the decision of the Commissioner is not only conclusive as to him, but does not in any manner affect his legal or equitable rights; and if the patent should be issued to Mr. Connison by the Commissioner, the act of 1836, section 16, expressly gives him a remedy in equity where he may have the benefit of the oath of the second patentee, in addition to all legal evidence taken according to the rules of a court of equity, which has power and jurisdiction to act effectually in the case, and to adjudge either of the patents to be void; or, if he does not like the remedy by bill in equity, he may bring an action at law for a violation of his patent; in which case, its validity may be tried and decided. In either of these cases, his remedy is full and conclusive, whereas

if he were to have an appeal, he would not thereby have any conclusive or effectual remedy, for, if upon such appeal he should prevail in reversing the decision of the Commissioner, the reversing decision would not be final and conclusive upon Mr. Connison. He would still have his remedy upon a bill in equity, under the same 16th section.

I am, therefore, of opinion that the legislature designedly limited the authority of the judge to the decision of the question, "which or whether either of the applicants is entitled to receive a patent as prayed for;" and that as, in this case, there is only one applicant, I have no jurisdiction in it under the 8th section of the act of 1836.

The only other case of appeal provided for in the statutes, is where the application for a patent is rejected; and as the application of Mr. Connison was not rejected, but sustained, I have no jurisdiction of the appeal of Mr. Pomeroy, who is not an *applicant*.

Believing that I have no jurisdiction in this case, and that Mr. Pomeroy has all his rights and remedies reserved to him by the statutes upon this subject, I shall return the papers to the Patent Office with a certificate of the substance of this opinion.

W. CRANCH.

NOVEMBER 22, 1842.

BENJAMIN M. SMITH, appellant	} Appeal from Commissioner of
vs.	
FLICKENGER and KRIM, appellees.	

Mr. Smith was an applicant for a patent for a machine for separating garlic from wheat.

The Commissioner being of opinion that it would interfere with a patent already granted to Flickenger & Krim, gave notice thereof to the applicant and patentees, as required by the act of Congress of the 4th of July, 1836, ch. 357, sec. 8, and assigned the 19th of December, 1842, for hearing the parties upon the question of priority of invention. Upon that day it appeared that the depositions on the part of the applicant, Mr. Smith, were taken and transmitted in due form, according to the regulations which the Commissioner

of Patents had (by virtue of the 12th sec. of the act of Congress of the 3d of March, 1839,) made "in respect to the taking of evidence to be used in contested cases before him." The depositions on the part of the patentees, Flickenger & Krim, were correctly taken, but not transmitted in the form required by these regulations, and, therefore, according to the Commissioner's 4th rule, could not be *considered* by him upon the day assigned for hearings touching the matter at issue. But as it appeared to the Commissioner that the facts stated in the depositions thus informally transmitted would, but for that informality, clearly show that the applicant was not the first and original inventor, he postponed the hearing to the 27th of February, 1843; of which he gave to Mr. Smith the following notice:

"PATENT OFFICE, *December 20, 1842.*

"The day of hearing in the matter of interference between your claims and those of Messrs. Flickenger & Krim has been postponed to the 27th of February, 1843, the evidence on their part being informal in the manner of transmission to the Commissioner of Patents. The case is open for the reception of further evidence taken and transmitted according to the rules in the enclosed circular.

"Respectfully, yours,

"H. L. ELLSWORTH."

The circular referred to is as follows:

"PATENT OFFICE.

"Rules for taking and transmitting evidence, &c., to the Commissioner of Patents.

"1st. That all statements, declarations, evidence, &c., shall be in writing, setting forth minutely and particularly the point or points at issue; and shall be verified by oath or affirmation.

"2d. That all statements, declarations, proofs, and evidence shall be filed in the Patent Office by the parties, respectively, before the day of hearing.

"3d. That before the deposition of a witness or witnesses be taken by either party, notice shall be given to the opposite party of the time and place when and where such deposition or deposi-

tions will be taken, so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or witnesses. And such notice shall, *with proof of service of the same*, be attached to the deposition or depositions, whether the party cross-examine or not; and such notice shall be given in sufficient time for the appearance of the opposite party, and for the transmission of the evidence to the Patent Office before the day of hearing.

“4th. That no evidence, statement, or declaration touching the matter at issue will be *considered* upon the said day of hearing which shall not have been taken and filed in compliance with these rules: Provided, that if either party shall be unable, from good and sufficient reasons, to procure the testimony of a witness or witnesses within the above stipulated time, then it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied with statements of the cause of such inability, which last mentioned notice to the Commissioner shall be received by him ——— days previous to the day of hearing aforesaid, viz: the ——— day of ——— next.

“5th. That all evidence, &c., shall be sealed up and transmitted to the Commissioner of Patents by the persons before whom it shall be taken, and so certified thereon.

“—————,
“ *Commissioner of Patents.*”

At the hearing on the 27th of February, 1843, the depositions on the part of the patentees, Flickenger & Krim, having been regularly taken and transmitted, they were considered with the other evidence in the case by the Commissioner, who thereupon made the following decision :

“ In the matter of interference between the claims of Benj'n M. Smith, of Massillon, Stark county, Ohio, and Messrs. Daniel Flickenger and Sebastian Krim, of Hanover, York county, Pennsylvania, for an alleged improvement in separating garlic from wheat by means of elastic rollers, &c.

PATENT OFFICE,
Feb. 28, 1843.

“ This case came up for hearing on the 27th instant, and on examination of the evidence on the part of Messrs. Flickenger and

Krim, it appears that he invented and constructed a machine for separating garlic from wheat, by passing the grain between elastic rollers, in the year 1835. On the part of Benj'n M. Smith, it appears that he first invented a similar machine in the year 1837. The testimony on both sides being duly taken and transmitted to this office, it is hereby decided that Messrs. Flickenger and Krim are the first and original inventors of the said improvement, and, as such, entitled to their patent.

“ H. L. ELLSWORTH.”

From this decision Mr. Smith has appealed, and filed his reasons of appeal, with a petition that it may be heard and determined.

Those reasons of appeal are —

1st. That the Commissioner could not lawfully postpone the hearing of the case from the 19th of December, 1842, to the 27th of February, 1843, on account of any thing appearing in the depositions which had been informally transmitted; because, by the 4th of the rules which he had made in respect to the taking of evidence to be used in contested cases before him, he had precluded himself from *considering* any “evidence, statement, or declaration,” “upon the day of hearing, which shall not have been taken and filed in compliance with these rules,” unless in the case provided for in that rule, which case is not applicable to these patentees.

The applicant contends that it was his *right* to have the case decided on the 19th of December, 1842, (the day assigned for the hearing,) upon such legal and competent evidence as was *then* before the Commissioner, who had no authority to postpone the hearing without the consent of the applicant, upon any ground appearing in the depositions informally transmitted.

2. The second reason of appeal is, “that the appellees did not give a sufficient time for the appearance of the opposite party to cross-examine the witness, as required by the rules for taking evidence; and therefore the deposition taken by the appellees on the 23d of February, 1843, is not legal, and should not have been entertained in deciding the case; for the appellant would have been required to travel 400 miles in three days to appear at the time appointed for taking the evidence, which is obviously impossible.”

These are all the reasons of appeal alleged by the appellant, and

to these the "revision" is expressly required to be "confined," and the appellant says, at the close of his first reasons of appeal, that he has foreborne to go into the *merits* "of the two claims at this time, because he considered his right to a patent, under the rules as fully substantiated, and prefers deciding the validity of the former patent before a jury."

The grounds of the Commissioner's decision, which he is required by the 11th section of the act of March 3d, 1839, fully to set forth in writing, are to be confined to the points involved in the reasons of appeal.

As to the first reason of appeal — the postponement of the hearing — he says that, "upon examination of the papers, the affidavits clearly showed that Mr. Smith was not the first and original inventor." That "the affidavits to show this were duly taken, but not duly transmitted." That this fact was presented "to his consideration by the examiner, and that having a due regard to the public interest, he postponed the case to a future day, giving both parties the opportunity to procure further testimony, if they thought proper," of which he gave notice to Mr. Smith by the letter produced by him with his reasons of appeal. That "no motion of the opposite party was filed for postponement," and "that he adopted that course to further the ends of justice."

As to the second reason of appeal, that sufficient time was not given to Mr. Smith, the appellant, to be present at the taking of the deposition on the 23d of February, 1843.

The Commissioner says that "this objection did not arise at the time of trial, and should have then been made; but Mr. Smith was anxious to hasten rather than postpone the case, for any cause."

The question arising upon the first reason of appeal is, whether the Commissioner was bound to hear and decide on the merits of the case upon the evidence which was regularly taken and transmitted to him, and which, according to his rule for taking and transmitting evidence, he could, on the 19th of December, 1842, have *considered* upon the hearing of the matter at issue, or whether he had a right to postpone the hearing, to enable the patentees to cure an informality in the transmission of their evidence, if he should deem such a postponement necessary to further the ends of justice; giving, at the same time, to both parties, an opportunity to procure further testimony.

The argument of the appellant rests upon the construction of the

fourth of the five rules made by the Commissioner "in respect to the taking of evidence to be used in contested cases before him," which rules were made by virtue of the power given him in the 12th section of the act of March 3d, 1839.

The 4th rule is in these words :

"4th. That no evidence, statement or declaration, touching the matter at issue, shall be *considered* upon the said day of hearing, which shall not have been taken and filed in compliance with the rule : provided, that if either party shall be unable, from good and sufficient reason, to procure the testimony of a witness or witnesses within the above stipulated time, then it shall be the *duty* of said party to give notice of the same to the Commissioner of Patents, accompanied with statements of the cause of such inability ; which last mentioned notice to the Commissioner shall be *received* by him ten days previous to the day of hearing aforesaid, viz : the day of next."

It is contended by the counsel of the appellant, not only that the Commissioner cannot consider the deposition, informally transmitted, as evidence upon the hearing of the matter in issue, but that he cannot look into it for any purpose, and therefore there was no cause whatever for postponing the hearing ; and that, for that reason, the decision of the Commissioner upon the merits of the case ought to be reversed.

But the prohibition contained in the rule is not to the Commissioner's *looking into* the deposition thus informally transmitted, or to his reading it and ascertaining its contents ; but to his *considering* it on the day of hearing, as evidence touching the matter at issue.

The Commissioner does not *consider* it, upon the day of hearing, as evidence touching the matter at issue, and in that respect complied with his own rule.

The proviso in the 4th rule is applicable only to the case where the party is unable to procure the testimony "in sufficient time for the appearance of the opposite party, and for the transmission of the evidence to the Patent Office before the day of hearing, in which case it shall be the duty of said party to give notice of the same to the Commissioner of Patents." But the rule does not say what the Commissioner shall do in consequence of such notice — whether he shall receive the testimony, although taken without reasonable notice, or whether he shall postpone the hearing — so that if the patentees

had given such notice to the Commissioner he would have still been as much without power to postpone the hearing as he was on the 19th of December, 1842.

The notice therefore would have availed them nothing.

There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing the hearing of a cause, if, in his opinion, the justice of the case should require it, and especially for the correcting of an irregularity in matters of form. To deny him this power, would be to stifle justice in her own forms.

2. As to the 2d reason of appeal, viz : that sufficient time was not given to Mr. Smith to be present at the taking of the deposition, taken on the 23d of February, 1843, it is a sufficient answer to say, that the objection was not made at the hearing ; but it appears also that the notice was served on Mr. Smith, personally, on the 11th of February, at Massillon, in Stark county, in Ohio, to take the depositions of witnesses at Manhime, in York county, in Pennsylvania, on the 23d of February — eleven days — which seems to be a reasonable time, even if the distance was 400 miles, as suggested in the reasons of appeal.

Upon the whole, therefore, I am of opinion that in this case the alleged reasons of appeal are not sufficient to sustain it, and that the decision of the Commissioner of Patents, as to all the points involved in the said reasons, must be affirmed. W. CRANCH.

March 25, 1843.

BENJAMIN M. SMITH, appellant, } Upon appeal from the decision
 vs. } of the Commissioner of Pa-
 FLICKENGER and KRIM, appellees, } tents.

I, William Cranch, chief justice of the District of Columbia, certify to the Hon. H. L. Ellsworth, Commissioner of Patents, that I have considered the reasons of appeal filed by the applicant in this cause, and the grounds of the decision of the said Commissioner upon the points involved in the said reasons, and have heard and considered the argument of the attorney of the applicants.

Whereupon I do decide and adjudge that the said decision of the said Commissioner of Patents, upon the points involved in the said reasons of appeal, be, and the same is hereby, affirmed.

And I herewith return all the papers in the cause, together with the reasons of my opinion. W. CRANCH.

WASHINGTON, D. C., *March 27, 1843.*

JOHN COCHRANE, appellant, vs. HENRY WATERMAN, appellee.	}	Appeal by John Cochrane from the decision of the Commissioner of Patents, refusing to grant him a patent for a machine for steering vessels, styled "the spring tiller self-compensating steering machine."
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By the 11th section of the act of the 3d March, 1839, ch. 88, the reversion of the decision of the Commissioner is to be "confined to the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal."

Mr. Cochrane in his specification says: "The nature of my invention consists in applying the endless screw or worm working in cogs on the periphery of a quadrant, to the moving or holding of the rudder; and, also, in the application of springs to compensate for the action of the sea on the rudder."

The Commissioner refused to grant the patent, because as to the first supposed improvement, namely: the application of the endless screw to the cogs on the periphery of a quadrant, it was not the *invention* of an improvement; and as the second improvement, namely: the springs on the tiller, it would interfere with a patent already granted to Henry Waterman.

The reasons of appeal from the decision are, in substance — first, that the application of the endless screw, &c., is an invention of an improvement on the *machinery* of steering vessels, within the meaning of the sixth section of the act of the 4th of July, 1836, ch. 375; and, secondly, that he was the first inventor of the spring-tiller; and, therefore, the patent ought not to have been granted to Waterman, and ought now to be granted to him, Cochrane.

The Commissioner, in stating his reasons for his decision, contends that the substitution of a known mechanical equivalent is not an invention within the patent law; and I think he is right. In some machines the moving power is communicated by a band. If I were to substitute a pinion for the band, I do not think it could be considered as an invention for which I could obtain a *patent*.

A.

Upon the first point, therefore, the decision of the Commissioner is affirmed.

The second question is, whether Mr. Cochrane was the first inventor of the spring-tiller, according to the evidence before the Commissioner?

Upon this point it is necessary to ascertain what the evidence was.

1. James Cochrane testifies in his deposition, taken on the 15th of March, 1844, at Baltimore, "that he knows that the compensating *principle* in the steering machine was invented by John Cochrane, the claimant, by the application of steel springs to the rudder, prior to the 19th day of October, 1835." He "heard him describe their position on the rudder and explain their use, which was to ease off the action of the sea on the rudder, previous to the said 19th of October, 1835."

The endless screw and wheel is a common mechanical power, applicable to an indefinite number of machines, and the mere application of it to a machine, to which it had never before been applied, would not be an *invention*, although it might make the machine better than it would have been without it. There may be innumerable cases in which that mechanical power may be used with great effect; but it does not follow that the person using it is thereby entitled to a patent. The fact that it enables the helmsman to hold and stay the rudder with more ease, results from the nature of the power, and is a property belonging to it wherever used; for the power of the helmsman is applied slowly at the long end of the lever against the power of the rudder, which works at the short end. This property is not now for the first time discovered. The application of it to the steering of vessels seems to be no more entitled to a patent, than if it had been applied to a kitchen-jack for roasting. It seems to me to be an ordinary power applied to an ordinary purpose, and that the application of it is not an invention within the meaning of the patent law.

2. Richard Cochrane in his deposition, taken at Newark, New Jersey, March 16th, 1844, says: "That the *invention was made* in the year 1835, but cannot now recollect any fact by which to ascertain in his own mind the exact date." That part of his deposition, in which he says that "he distinctly remembers that the inventor, John Cochrane, said, years ago, that it was on the 7th of February, at 10 o'clock at night," is not competent evidence in this cause.

The deponent further testifies that he "was present when *the invention was made*, and recollects that it was at night." He further testifies that, "in the month of October, 1835, he had a conversation with Captain Scott, of the brig Planter, of Baltimore, Maryland, on the *principle* on which steering machines *should* act, for the purpose of ascertaining whether the springs were as important in steering as the said John Cochrane supposed; but that he, deponent, is certain that this invention was in existence before said conversation with Captain Scott." He further testifies that "the model deposited at Washington is the same in *substance* or *principle* as when first *invented* by John Cochrane." The letter of Captain Bunker, of the 15th of February, 1843, a copy of which was enclosed in Mr. John Cochrane's letter of the 22d of March, 1844, to the Commissioner of Patents, is not evidence in this cause; and, if it were, it does not give any information as to the priority of invention of the spring-tiller.

All the evidence in favor of the appellant upon that point is contained in the depositions of James and Richard Cochrane, and they do not carry back the date of the invention to any certain time prior to the 19th of October, 1835. The only evidence of Henry Waterman's priority of invention of the spring-tiller is contained in the deposition of Stephen Waterman, who testifies that in *April* or *May*, 1835, he had a conversation with his brother Henry, in relation to the application of springs to the head of the rudder, and again in July, 1839 — "that, at both of said interviews, said Henry Waterman described to deponent his said invention, the same as the one patented to him in Washington." That in February, 1843, the deponent being about to go to Washington, Henry Waterman furnished him with a model of his invention. That, being in New York, they called to see Mr. Cochrane's model, and Henry Waterman showed his own model. That the deponent asked Mr. Halstead, who had charge of Mr. Cochrane's model, how long it had been invented? and the deponent thinks he stated in reply, seven or eight years. The deponent annexes to his deposition an original letter from himself to his brother Henry; but it is of no importance.

This deposition appears to have been taken in the presence of Mr. Cochrane, and carries back the date of Waterman's invention of the spring-tiller to April or May, 1835, whereas the date of Mr. Cochrane's invention is not carried back with any degree of certainty beyond the 19th of October, 1835. The Commissioner of Patents,

therefore, was bound, as the case appeared in evidence before him, to refuse to grant a patent to Mr. Cochrane.

Mr. Cochrane, in stating the reasons of his appeal, has alleged that Mr. Waterman obtained his patent *surreptitiously*. There is no evidence to support this charge. The reasons of appeal are extended at great length, and for the most part are founded upon the assumption of facts, of which there was no competent evidence before the Commissioner.

1. There is no evidence that either of the applicants for the patent had reduced the invention of the spring-tiller to practice. The letter of Captain Bunker is not admissible evidence.

2. There is no evidence of the protest of W. W. Kingsley mentioned in the reasons of appeal.

3. There is no evidence that in the interview between the Watermans and Halstead, in New York, in 1843, Henry Waterman said that he invented the spring-tiller "*four or five years ago*," nor that he had never tried it! Nor that Mr. Halstead informed them "that this machine was then on board of two ships, namely: the Alabama and the Vicksburg, and was in operation about six months, and so far appeared to answer well. Nor that "Mr. Cochrane had been at great expense in maturing the invention and in reducing it to practice, and had it in actual operation." Nor that Mr. Waterman had bestowed no labor and gone to no expense upon the invention.

4. There is no evidence that Mr. Waterman claimed to have invented this application of springs, in 1838 or 1839.

5. There is no evidence that Stephen Waterman protested "that if Ellsworth should take back the patent they would enter suit for damages against him."

6. There is no evidence that Richard Cochrane had the books of the brig Planter examined to ascertain the date of the conversation with Captain Scott.

7. What Mr. John Cochrane says, in his reasons of appeal, he told his brother Richard, is not evidence.

8. There is no evidence that James Cochrane stated as a reason for fixing the date of the invention before the 19th October, 1835, that on that day he left Baltimore to reside in Richmond.

9. There is no evidence that Stephen Waterman stated in evidence that Cochrane's "machines were in operation."

10. There is no evidence that Henry Waterman was intentionally assisted by the Patent Office in disregarding the caveat, as insinuated

in the reasons of appeal. Nor is there any evidence that the evidence of one of Mr. Cochrane's witnesses was mutilated, nor that any important evidence was suppressed, nor that a portion of the evidence was passed over without notice, as charged in the reasons of appeal.

All those reasons of appeal, therefore, which were founded on supposed facts, of which there was no evidence, must be disregarded.

The fact that the patent to Mr. Waterman was granted while Mr. Cochrane's *caveat* was pending and in force, does not of itself vacate that patent, nor authorize the Commissioner to grant to Mr. Cochrane a patent unless he should establish his priority of invention.

The Commissioner could act only upon the evidence before him ; and I can act only upon the same evidence.

If Mr. Cochrane had other evidence, and did not produce it; it was his own fault, or misfortune ; but perhaps he may yet file a bill in equity under the 16th section of the act of Congress of the 4th of July, 1836, and establish his priority and obtain a patent upon consideration of the reasons of appeal, and the reasons of the Commissioner of Patents, for his decision. I am of opinion that the decision is correct, and ought to be affirmed.

W. CRANCH.

November 6, 1844.

DISTRICT OF COLUMBIA, *to wit* :

I, William Cranch, Chief Justice of the District Court of the United States for the District of Columbia, certify to the honorable the Commissioner of Patents, that having caused due notice to be given to the parties interested in the application of John Cochrane for a patent for steering vessels, and of his appeal from the decision of the said Commissioner refusing to grant the said patent, I have considered the reasons of the said appeal filed by the said John Cochrane and the grounds of the decision of the said Commissioner, upon the points involved in the said reasons of appeal. Whereupon I do, this 7th day of November, 1844, decide and adjudge that the said decision of the said Commissioner of Patents, upon the points involved in the said reasons of appeal, be, and the same is hereby confirmed ; and I herewith return all papers in the cause.

W. CRANCH.

SOLOMON C. WARNER,

vs.

CHARLES GOODYEAR.

Appeal from the decision of the Commissioner of Patents refusing a patent to Solomon C. Warner, for combining with the metallic calender rollers an elastic endless apron and a stretching frame, for manufacturing corrugated or shirred India rubber goods.

The only material point "involved in the reasons of appeal," and to which my revision must be limited is, whether Solomon C. Warner was the first inventor of that combination, (which is the same combination for which Charles Goodyear obtained a patent on the 9th of March, 1844, upon a specification dated July, 24, 1843; more than fifteen months before the application of Solomon C. Warner;) for if he was not the first inventor, it is immaterial to this cause who was.

Upon this point the Commissioner of Patents has decided that he was not the first inventor; and upon his appeal from that decision the question is now brought before me, and must be decided according to the evidence produced before the Commissioner, and now laid before me.

That a patentable improvement in the manufacture of corrugated or shirred India rubber goods by machinery has been invented, is admitted by both parties; and, in order to ascertain who was the inventor, it seems to be necessary, first, to ascertain in what this patentable improvement consists.

It does not consist in the whole machine nor in any particular part of it; for neither the whole nor any part of it is new. The invention consists only of a new combination of some known mechanical principles or powers. The calenders, the rollers, the endless apron and the stretching frame are all old instruments, and, as such, cannot be patented; but when a certain particular combination of them produces a new and useful *effect* in the manufacture, that combination becomes the lawful subject of a patent.

Warner's specification says, that what he claims as new is the combining with the metallic calender rollers an elastic endless apron and a stretching frame. Goodyear's specification is in the same words, omitting the word *metallic*.

The question then is, was Solomon C. Warner the first inventor of that combination?

A vast deal of testimony has been taken ; much of it is immaterial. The counsel for the claimant objects to some of Mr. Goodyear's witnesses as incompetent, by reason of their interest. But there is an agreement, signed by the counsel of the parties, dated January 9, 1846, "that all testimony taken before ——— Gardiner, Esq., United States commissioner, and ——— Metcalf, Esq., United States commissioner, up to and during the 9th of January, 1846, shall be heard and considered by the Commissioner of Patents, whether the same be filed before the twelfth day of January instant, or not, rights reserved as to all other testimony taken after this date." All the testimony to which the objection relates was taken before those commissioners, or one of them, and before or during the 9th of January, 1846. This agreement seems to me to be a waiver of the objection to the competency of the witnesses, whose testimony is thus agreed to be heard and considered. The objection, however, may go to their credit, and have its due weight.

The principal evidence in favor of the claim of Mr. Solomon C. Warner is the inference drawn from the fact that he made the machine which contains the combination for which he desires to obtain a patent.

This is *primâ facie* evidence that he was the first inventor of that combination. This inference, however, is rebutted by the facts that in making that machine he was working in his trade as a machinist, in the employment and for the benefit of Mr. Goodyear, for wages ; that he did not claim to be the inventor of that combination for a long time after his supposed invention, but stood by and saw Mr. Goodyear apply for and obtain a patent for it without objection, and did not apply for a patent for it as his own invention until the 4th of November, 1844, more than 18 months after his supposed invention, and nearly six months after Goodyear had obtained his patent for the same invention, and not till Norton and Lawrence had agreed to secure him against all costs and expenses to be incurred in procuring the patent.

These facts seem to me to rebut the inference drawn from the fact that Mr. Warner was the fabricator of the machine which contains the combination.

The greater part of the testimony produced by him is to prove the fact that he built the machine.

The presumption, from the fact that Warner made the machine

for Goodyear, at his request, for his benefit, and at his expense, is that it was made according to his directions ; and the burden of proof is then on Warner, to show that the machine was not made according to his directions.

By a careful examination of the testimony, I am satisfied that in the fall of 1842 Mr. Charles Goodyear made several experiments, combining the principle of the calenders, the stretching frame, and the elastic apron passing through the calenders, with the cloth intended to be corrugated ; and ascertained that a machine combining those principles, if properly made, would effect the object he has in view, viz. : the shirring of India rubber goods by machinery.

This combination, the effect of which Mr. Goodyear had thus ascertained, was reduced to practice by the machine built by Solomon C. Warner, at the request or by the order, and at the expense of Mr. Goodyear, so that it was, in fact, Mr. Goodyear, and not Mr. Warner, who reduced the invention to practice.

Whether the apron should be an endless or a straight apron does not affect the principle ; the object was to have an elastic matter pass through the calenders, with the cloth intended to be corrugated. The one may do the work better than the other, but either of them effects the object intended.

Mr. Goodyear's discovery or invention was in the year 1842. Mr. Warner claims only from the spring of 1843.

Without deciding, therefore, the question, whether or not Mr. Solomon C. Warner received his instructions from Mr. Goodyear or from Mr. Emory Rider, or from any one else, I am of opinion, from the evidence, that Mr. Solomon C. Warner was not the first inventor of the combination for which he seeks to obtain a patent.

W. CRANCH.

July 17th, 1846.

JOSEPH P. HAZARD } In case of rejection of an application for an
and } improvement in the manufacture of shoes
HENRY R. GREEN. } and brogans.

I, William Cranch, Chief Justice of the District Court of the United States for the District of Columbia, hereby certify, that on the 15th day of May, in the year 1847, according to notice, I proceeded to hear the appeal of Joseph P. Hazard and Henry R. Green

from the decision of the Commissioner of Patents, rejecting their application for an improvement in the manufacture of shoes; and having heard and considered the same, and the appellant's reasons of appeal, and the grounds of the Commissioner's decision, filed in the office, —

I am of opinion, and do determine, that the appellants are not entitled to the patent for which they have applied, and that the decision of the Commissioner rejecting their application therefor be, and the same is hereby, confirmed.

Given under my hand this 15th of May, 1847.

W. CRANCH.

To the HON. EDMUND BURKE,
Commissioner of Patents.

WILLIAM CUNDELL, appellant, }
vs. }
ZIBA PARKHURST, appellee. }

Upon appeal by William Cundell from the decision of the Commissioner of Patents, awarding priority of invention to Ziba Parkhurst, of the *zigzag* or pointed guard to be applied to burring machines; —

I, William Cranch, Chief Justice of the district court of the United States for the District of Columbia, certify to the Hon. Edmund Burke, Commissioner of Patents, that on the 24th of May, 1847, according to notice duly given, the parties aforesaid appeared before me, viz. : the said William Cundell, by Mr. Keller, his attorney, and Mr. Ziba Parkhurst, by George Gifford, Esq., his attorney; Mr. Fitzgerald of the Patent Office was also present; and the said appeal was heard upon the decision of the said Commissioner of Patents, and the reasons of appeal filed in the office, with the grounds of said decision fully set forth in writing touching all the points involved in the reasons of appeal, and the same being fully argued, heard, and considered, I do adjudge that the said decision of the said Commissioner of Patents be, and it is hereby affirmed, and I do determine that the said Ziba Parkhurst is entitled "to receive a patent as prayed for."

I return herewith all the papers. May 24, 1847.

W. CRANCH.

May 28, 1847.

Opinion of the Judge.

WILLIAM CUNDELL, }
 vs. }
 ZIBA PARKHURST. }

Appeal from the decision of the Commissioner of Patents refusing a patent to William Cundell, because it interferes with an application by Parkhurst, the prior inventor of the same improvement of a machine for cleaning sheep's wool from burrs, &c. The commissioner having decided that Parkhurst was the first inventor of the improvement.

The Commissioner's decision is as follows :

"The invention in dispute between the parties is the application of the zigzag or pointed guard to the burring machine. The testimony of James C. Johnson proves that the said Parkhurst showed the guard in question as early as the spring of 1845 ; and none of the witnesses testify to its invention by the said Cundell earlier than the summer of the same year. Priority of invention is therefore decided in favor of *Ziba Parkhurst*. This view of the case renders the decisions of the interlocutory questions which have been raised in taking the testimony wholly unnecessary. February 2, 1847."

From this decision Mr. Cundell has appealed and assigned his reasons of appeal as follows :

"Although the witness referred to does testify that Ziba Parkhurst described to him the improvement in question in the spring of 1845, and at a time anterior to the alleged invention of William Cundell, yet, it will appear from the testimony on both sides that this witness erred in his statement of the time at which this communication was made to him, for it is clearly proved, by the testimony, that this improvement was made in consequence of the imperfect working of the *original* machine, and to remedy a defect which was discovered after *this* machine was put in operation, and the whole of the testimony shows that *this* machine was not put in operation until the month of July, 1845, subsequent to the time at which the witness testifies the said improvement was described to him by Parkhurst ; they therefore submit that the improvement *which was the result of, and suggested by the defective working of a machine*, could not have been described before the said machine was constructed and put in operation ; and that, *therefore*, the Commissioner of Patents erred in giving

credence to the statement by a witness of a date, which *all* the circumstances of the case, established by the testimony adduced on both sides, clearly shows was the result of error."

By the act of March 3, 1839, section 11th, the Commissioner of Patents is to "lay before the judge all the original papers and evidence in the case, together with the grounds of his decision fully set forth in writing touching all the points involved by the reasons of appeal, to which the revision shall be confined."

The only point involved in the reasons of appeal is the date of the conversation between Ziba Parkhurst and Joseph C. Johnson, in which the former showed the latter a drawing similar to exhibit D, of a machine called a stripper or guard, to be applied to burring machines. Mr. Johnson thinks it was the latter part of the spring of 1845, but says he cannot name dates. He fixes the date, however, by recollection of another fact, to wit: that in May, 1845, Ziba Parkhurst went out to Erie county, Pennsylvania, and Ohio, and bought some fifty or sixty thousand pounds of wool, and drew upon Johnson's house for it, who sold it on commission for him, and that that is his reason for knowing the time; and that he saw the machine before Ziba left for Erie county, Pennsylvania.

This witness, who is a merchant, appears to have testified fairly and impartially. No attempt is made to discredit him, unless by showing that he has mistaken the date of the conversation. This is attempted to be done by proving facts supposed to be inconsistent with the testimony of this witness.

None of the other witnesses carry the invention farther back than a few weeks after Stephen R. Parkhurst first departed for England, which appears to have been about the first of August, 1845; but they speak of the time when the *invention* was *first applied to a machine in operation*, not to the time of the invention itself, which necessarily precedes it. There is, therefore, no irreconcilable discrepancy between Mr. Johnson and the witnesses as to the time.

But it is said by Mr. Cundell's counsel that the defects of the machine, at No. 60 Vesey street, led Ziba to suggest the improvement, and that the machine was not put into operation in Vesey street until the 18th of July, 1845. But I have not found any evidence that it was the defect in the working of that particular machine that suggested the improvement. Other burring machines had been before in use, to which the new stripper might be an improvement, and the defects of which might have suggested the improvement.

Other circumstances have been given in evidence tending to throw some doubts as to the time of the invention, but none which, in my opinion, outweigh the positive testimony of Mr. Johnson.

I am, therefore, of opinion that Ziba Parkhurst has established his priority of invention of the zigzag guard to the burring-machine, and is entitled to a patent therefor; and that the decision of the Commissioner of Patents be affirmed.

W. CRANCH.

May 27, 1847.

DISTRICT OF COLUMBIA, *to wit* :

ALONZO D. PERRY, appellant,

vs.

SAMUEL C. CORNELL, appellee.

} Upon appeal from the Commissioner of Patents, awarding priority of invention to Samuel G. Cornell, of his invention of an improvement in the machine for the manufacture of lead pipes.

I, William Cranch, chief justice of the district court of the United States for the District of Columbia, certify to the Hon. Edmund Burke, Commissioner of Patents, that on the 21st day of June, 1847, according to notice duly given, the parties appeared before me, namely: the said Alonzo D. Perry, by Mr. Keller, his attorney, and the said Samuel G. Cornell, by Mr. Stoughton, his counsel; Mr. Fitzgerald, of the Patent Office, being also present; and the said appeal was heard before me at my chambers in the City Hall, in Washington, D. C., and argued by counsel on the 21st, 22d, 23d and 24th of June aforesaid, upon the decision of the said Commissioner of Patents, and the reasons of appeal filed in the office, with the grounds of the said decision fully set forth in writing, touching all the points involved in the reasons of appeal, and the evidence produced before the said Commissioner; and the same being fully heard, argued, and considered, I do, this 7th day of July, 1847, adjudge and determine that the said decision of the said Commissioner of Patents, awarding priority of invention to the said Samuel G. Cornell, be, and the same is hereby affirmed, and that he "is entitled to receive a patent, as prayed for."

W. CRANCH.

I return all the papers.

W. C.

A. D. PERRY, appellant,
 vs.
 S. G. CORNELL, appellee. } Appeal from Commissioner of Patents.

The first reason of appeal is, that the *evidence* does not show Cornell to be the first to conceive the idea of a machine such as he now claims.

The question, therefore, is, what is the evidence ?

The counsel for Mr. Perry offered to the Commissioner of Patents the depositions of Robert J. Craig, and twenty other witnesses, taken without notice to this applicant, Samuel G. Cornell. These depositions, therefore, cannot be used against him, unless he has waived his right to notice, and agreed to admit them to be read in evidence before the Commissioner of Patents. It is suggested that the notice given by Mr. Cornell's counsel to the other parties litigant, to produce these depositions to a Commissioner for inspection and examination by his counsel, and the offer by Mr. Perry to have the witnesses again before the Commissioner, to be cross-examined by Mr. Cornell's counsel, and his refusal to cross-examine them when produced, was equivalent to a waiver of notice.

I am not, however, of that opinion. Mr. Cornell had a right to be present at the direct examination in chief. But it is said that the Commissioner of Patents has received these depositions in evidence ; and, as he decided in favor of Cornell, he cannot appeal upon that ground. But the Commissioner, in his judgment, says it is unnecessary to decide the question raised in reference to the admissibility of the evidence, as its rejection would not vary the result. It is plain, therefore, that he did not decide that question. There is no evidence that Mr. Cornell, or his counsel, has ever agreed to admit these depositions as evidence against him. They must, therefore, be rejected.

Mr. Keller, the agent of the defeated applicant, objects to my hearing any argument by an officer or counsel of the Patent Office. Heretofore it has been usual for some officer of the Patent Office to attend the hearings before the judge, upon appeals from the judgment of the Commissioner, and no objection to that course has been taken, until this time. The officer who attends is not considered as counsel for the Commissioner, or for the office ; and I should think he could not with propriety be considered as an advocate of either of the parties litigant. I have hitherto considered him as attending for

the purpose of explaining the decision of the Commissioner, and not as arguing the cause of either of the litigants. He can only appear as an officer of the department; as such I shall always be willing to avail myself of his assistance in the investigation of the truth.

W. CRANCH.

Opinion given Tuesday morning, June 23, 1847.

A. D. PERRY, appellant,	}	Appeal from the decision of the Commissioner of Patents, awarding priority of invention to Samuel G. Cornell of an improvement in the machine for making lead pipe.
<i>vs.</i>		
S. G. CORNELL, appellee.		

There were four conflicting applications for a patent for the improvement —

1st. By John Robertson, on the 9th of September, 1846.

2d. By Alonzo D. Perry, on the 6th of October, 1846.

3d. By Stephen Parks, Jr., on the 12th of November, 1846, and

4th. By Samuel G. Cornell, on the 21st of December, 1846.

Before the application of Samuel G. Cornell, and while the litigation was going on between the other three applicants, the depositions of twenty-one witnesses had been taken on the part of those applicants, respectively, and, of course, without notice to Mr. Cornell, who had not then made his application. These depositions were returned to the Commissioner of Patents, and objected to by Mr. Cornell's counsel for want of notice.

The Commissioner, without deciding upon the question of the admissibility of the evidence as to Mr. Cornell, awarded to him the priority of invention, saying, "the decision of the question raised in reference to the admissibility of testimony is unnecessary to decide; its rejection would not vary the result; the testimony is therefore received, and priority of invention awarded to Samuel G. Cornell." (March 24, 1847.)

From this decision Mr. Perry has appealed, and his reasons of appeal are in effect —

1st. That the evidence does not show that Mr. Cornell was the first to conceive the idea of a machine such as he now claims, but that the plan proved to have been so conceived is essentially different and mechanically inferior to the one claimed and now awarded to him by the Commissioner.

2d. That the evidence on which the decision in favor of Mr. Cornell is based is contradictory and insufficient to establish his claim even to the conception of the idea of the principle or mode of operation of the machine now sought to be patented, but, on the contrary, shows that the plan said to have been conceived was entirely different; and

3d. That if he did conceive the idea of the principle or mode of operation of a machine substantially similar to the one now claimed, and did describe to the witness such a machine prior to the date of the invention claimed by the applicant, Perry, yet it was merely an intellectual invention, based in theory, and not an invention in the meaning of the law.

The Commissioner has laid before me "the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal," to which my revision must be confined as provided in the 11th section of the act of March 3d, 1839, c. 88, (pamphlet edition, pp. 75 and 76.)

The grounds of the decision of the Commissioner, as set forth in writing, are in substance —

"That it is proved by the testimony of Wm. Frost, confirmed by that of Benjamin Peck, that the said Cornell invented *the machine in dispute* as early as the summer of 1843; and there is no testimony that tends to show that either of the other parties invented it until a considerable time afterwards."

That "it appears by the testimony of Frost that Cornell described the machine to him fully, so that he perfectly understood it; that he repeatedly made draughts representing it in so clear a manner that the said Frost was able to make draughts and estimates of its cost, and absolutely did make both with the assistance of Cornell."

That "Cornell made the invention as clearly understood as if the machine had been built and in operation." "It appears, therefore, that Cornell had done all that an inventor, as such, could do, and nothing remained to complete the machine, but the labor of the mechanic, which cannot be confounded with invention." "The daily number of inventions daily patented have never been reduced to practice."

In the grounds of his decision, the Commissioner controverts the *dictum* found in some of the books, that "he who first reduces an

invention to practice, is the first inventor :” a *dictum* which, he says, “ although often quoted and reiterated, was not applicable to, nor borne out by, the case in which it was first pronounced, nor by any of the cases in which it has subsequently been repeated ; and which, in the broad terms in which it is announced, is not, and never has been, the law. If by reduction to practice is meant *rendering a principle practicable or useful in a new way*, and clearly pointed out the manner in which it may be thus made useful, so that any competent mechanic can avail himself of it, then, and in that sense, an invention must be reduced to practice ;” but “ neither the statutes, nor the decisions of the courts, require that a machine should be *built and used as a part of the invention*, and before the party can be considered an inventor ; but that the sense, above alluded to, is the sense in which the courts have used the phrase *reduction to practice* ;” and the only sense which will reconcile the “ decisions, and make them conform to the statutes regulating patent rights.”

The other two applicants, Mr. Robertson and Mr. Parks, have not appealed ; so that the contest is now between Mr. Perry and Mr. Cornell only.

It is admitted that a great and valuable improvement has been made in the old machine for making lead pipes ; and the principal, if not the only point involved in the reasons of appeal is the question — “ Which, or whether either of these two applicants is entitled to receive the patent prayed for ;” and this is to be decided by the *evidence* produced before the Commissioner. The 21 depositions taken in the conflict between Robertson, Perry, and Parks, being taken without notice to Cornell, are not evidence against him, and, therefore, cannot be considered by the judge upon the appeal. The only evidence which he can consider is that which is contained in the depositions of Wm. Frost and Benjamin Peck, and in the cross-examination of Mr. Cornell himself by the counsel of Mr. Perry.

The question then is — whether the machine described by Mr. Cornell to those two witnesses is substantially the same as that for which he asks a patent.

The improvement consists in the great diminution of the friction of the machine, by which the same effect is produced by a power much less than that which was necessary to work the old machine.

As the question is merely of priority of invention, it is not neces-

sary to describe the particular alterations of the old machine which constitute the improvement.

It is, however, necessary to examine the testimony, to see whether the improvement which Mr. Cornell described to the witnesses is substantially the same as that for which he now claims a patent.

It appears by the deposition of Mr. William Frost, the principal witness, and who seems to have testified fairly and intelligently, that Mr. Cornell, in June or July, 1843, described to the witness a plan for a machine for making lead pipe, different from any machine for that purpose then in use; and that he intended to use a hollow ram, with an aperture in the bottom coming out at the side of the ram; that he intended to place a die on the top of the ram, then to have a mandril to pass through the top of the cylinder long enough to pass through the interior of the die, leaving a space between the mandril and the die for the lead to pass through, when the ram was forced upward against the lead, making the pipe from that portion of the lead which was first acted upon by the top of the ram being pressed against it; his object being, as he stated it, to avoid the immense friction that was produced by driving so large a mass of lead before the ram, out through the aperture, as used in many other machines then in use. That he (Mr. Cornell) exhibited to the witness a sketch or drawing of his plan; and the witness then prepared and produced a drawing of Cornell's plan, as he then drew and described it, which is annexed to his deposition, and marked A.

That, about a fortnight afterward, the witness had a further conversation with Mr. Cornell in relation to his said plan for a pipe machine in Mr. Cornell's office, in New York; that he then stated to the witness and described the manner in which he intended to construct a pipe machine for the purpose of passing the lead pipe through the interior of the ram, and for using a movable mandril in connection with the hollow ram, and for forming the pipe at the point on which the ram pressed against the lead; that Mr. Cornell made a sketch of such machine, a copy of which this witness has made, thinking it might be called for, and to explain the arrangement which he then described. Mr. Cornell said he intended to make such a machine. The counsel for Mr. Perry objected to the introduction of the copy of Mr. Cornell's sketch, unless the loss of the original should first be proved. After the proof of the loss of

the original, the witness produced and filed his copy, which is annexed to the deposition and marked B.

It further appears, by the testimony of the witness, William Frost, that the sketch or drawing B differs from the sketch or drawing A, in having two cross-heads and two rods to connect them together; also an upper movable mandril, which was connected to the upper cross-head and kept in its proper position by means of a stand or frame which was secured to the lead cylinder, the lower cross being secured to the ram rising from the hydraulic cylinder. The upper mandril or ram, he stated, might be hollow or solid, for the purpose of holding either the short mandril or die; that these drawings do not exhibit the nuts, bolts, or screws, or the manner in which the different parts are guided or secured to each other, but merely the arrangement of the raiser dies and mandrils to each other, and as he designed to place them for the purpose of manufacturing lead or other pipes; that the leading essential feature of these two planes, which distinguishes them from machines previously known for the purpose of making lead pipe, is the hollow ram, and the die placed on the top of it, and the forming of the pipe on the head of that ram from the point where it presses against the lead, and the passing of the pipe, when so formed, through the interior of the ram; that the second plan drawn and described to this witness contained this essential feature or difference, with the addition of the parts which are before described; that, from the drawings and descriptions so made by Mr. Cornell to this witness, he could have made and constructed machines for making pipe upon those plans.

That the drawing, marked exhibit B, shows the relations of the rams to each other, of the die, of the short mandril, of the cross-heads, and the rods which connect them together, as also the lead cylinder, the cast iron stand or frame, the hydraulic cylinder, and a portion of the ram rising therefrom; as also the columns for connecting the hydraulic and lead cylinder together. It also shows the upper hollow ram, as also the lower hollow ram, with the apertures through the same. It does not describe the manner in which the different parts are secured to each other, but simply the arrangement described by Mr. Cornell in New York.

This witness says he is not aware that Mr. Cornell ever built a machine with the improvements which he described to the witness.

He further testified that Mr. Cornell, at different times, showed

him at least half a dozen drawings like exhibit B on separate and distinct pieces of paper, also two in Connecticut and two in Brooklyn, also two like exhibit A, one of them on board of the steamboat "Croton," in June or July, 1843, and the other at his factory, in Glenville, Connecticut.

That, in the fall of 1844, he made, at the request of Mr. Cornell, an estimate of the cost of such a machine as that described in the exhibit B.

The witness, Benjamin Peck, testified that, in June, 1843, before Mr. Cornell had applied for a patent for his invention of an improvement in the machine for the manufacture of lead pipe, he communicated to this witness his plan for the construction thereof; that he stated that the die was to be attached to the end of the ram. The ram to be hollow, the pipe to form at the end of the ram, and pass down through the hollow ram; that the object was to prevent friction. The core was to pass through the cylinder, the end of it to be inserted in the die, the die and mandril to move together; that the mandril forms the inside of the pipe. It is sometimes called the core. The pipe is formed over the mandril or core. The hollow ram and the movable mandril were to move together by force of an hydraulic press; that Mr. Frost was present at this communication.

This witness states that the machine for which Mr. Cornell seeks a patent, contains, among other things, the lead cylinder, the ram, the die, the core, rod or mandril.

That the construction of this machine differs from that of the old machine, which was worked by Parks; in this the die is placed at the head of the ram, in the old one at the top of the cylinder. In this the pipe forms at the head of the ram, in the old one at the top of the cylinder. That the advantage of this over the old one is, that in the old one the whole body of lead from the bottom to the top of the cylinder was required to move in a body, in order to form the pipe at the top of the cylinder; whereas in this improvement the main body of the lead is not required to move, because the pipe forms at the head of the ram immediately after the pressure is put on, and passes out through the ram.

That about two months ago, (November, 1846,) Mr. Cornell showed this witness a pencil sketch of his improvement, saying that that was his plan for the machine for which he was about to get a patent, and to have a model made of it. That sketch did not *show*

the *hollow* ram. That when Mr. Cornell showed to this witness that sketch, he said that was a sketch of his invention which he had before disclosed to this witness, and that there was a die at the head of the ram, and that the ram was hollow; that on the sketch he saw he could not say whether the ram was hollow or not. He thinks there was no hydraulic sketch on that sketch. There was a lead cylinder and a mandril core or ram. The end of the core or mandril extended out of the top of the cylinder, and down to the head of the ram, or near to it. This witness was sure there was a representation of a ram; one end of the ram was placed near the cylinder, the other below. He thinks that no part of the ram, as represented in the sketch, entered the lead cylinder. That the ram of the lead cylinder, as represented in the sketch, was a round piece of iron. This witness only saw the sketch for a few minutes, and handed it back to Mr. Cornell. Being asked, in cross-examination, to describe the frame work of the machine as it appeared on the said sketch, he says there was a mark across the top which he supposed represented a piece, and one straight line down each side. The core was in the centre of the cylinder; one end projected at the top, and came down near the bottom of the cylinder. There was a piece across the top. He does not recollect seeing the die. He does not know by whom the sketch was made. This, he says, was a rough, and to all appearances an imperfect sketch. Mr. Cornell, the appellee, having been affirmed and examined as to the loss of the two original drawings or sketches, of which the witness, Mr. Frost, testified that the exhibits A and B are copies made by him, was cross-examined by the counsel of Mr. Perry, at large, as if he, Mr. Cornell, were a competent witness in chief — thereby making the answer of Mr. Cornell evidence for himself.

Upon that cross-examination he stated that he has a distinct recollection of making a sketch, and has no doubt it was at the time referred to by Mr. Frost. Thinks it was made on foolscap paper, with a lead pencil, but it might have been with ink. It was made in the office at his works, (in Connecticut;) presumes it was at the time Mr. Frost speaks of. They have had many conversations on the subject. He showed the drawings to Mr. Peck, and he thinks to Mr. Parks, who was at work for him. He affirms positively that he showed them to Mr. Peck and Mr. Frost. He does not wish to identify any particular drawings. He made a number at different times, and had frequent conversations with Mr. Peck and Mr. Frost on the

subject. He is not certain whether he mentioned it first to Mr. Frost or Mr. Peck. The first to Mr. Peck was, no doubt, in his works in Connecticut, in June, 1843. He cannot recollect which the first time he mentioned it to Mr. Frost, but it was in either June or July, 1843. He thinks it was early in June. He has none of his drawings at present. The first drawing was showing the appearance of a lead cylinder; the ram at the mouth of the cylinder, which ram should be hollow; a die to be placed in the head of the ram, and the pipe should form at the head of the ram as the ram rose, by any power that might be applied to it, and pass out through the bottom of the ram. The mandril or core, to form the calibre of the pipe, should come from the head of the cylinder.

From comparing this evidence with Mr. Cornell's specification, it will be seen that the invention therein described is substantially, if not exactly, that for which he now claims a patent. That it is a great improvement is admitted, and the only question is, who is entitled to the priority of invention? There being no evidence that any other person invented it, Mr. Cornell must be adjudged to be the first inventor.

But it is said that Mr. Cornell is not entitled to a patent, because he has never reduced the invention to practice. But reducing to practice, differs from bringing into use. There is no law requiring the applicant to reduce his invention to actual use before he can obtain a patent. On the contrary, the use of the invention before obtaining the patent is one of the reasons for refusing it. An inventor has reduced his invention to practice when he has so described it upon paper, with such drawings or model as to enable any person, *skilled in the art*, to make and use the same. He must show that it is practicable, and the manner in which it may be used. But it is not necessary that he should do this until he has perfected his invention and is ready to apply for a patent. He may have conceived the idea years ago, but is not obliged to furnish drawings or model until he makes his application. In the present case, the specification and drawings and model have been filed, showing the invention to be practicable, and the manner in which it can be used.

It is suggested that Mr. Cornell has not used "reasonable diligence in adjusting and perfecting" his invention; having done nothing from the spring of 1843 to the winter of 1846, and therefore, under the equity of the fifteenth section of the patent law of 1836, has lost the benefit of his priority of invention. That clause of the section is

only applicable to the case of a patent surreptitiously or unjustly obtained while the first inventor was using reasonable diligence in adapting and perfecting his invention; not to the case of conflicting applicants before any patent is granted. It is one of the pleas which the defendant, who is sued for a supposed violation of the surreptitious patent, may plead; and if pleaded, it may be necessary for the defendant to show, *in order to vacate the patent*, that he was using reasonable diligence, &c., when the patent was obtained. But before a patent is granted to any one for the invention, there is no law that requires the first inventor to disclose his invention within any limited time before application for a patent; and there is no limitation unless the lapse of time be sufficient to show an abandonment of the invention, which is a question for the jury and not for the Commissioner. Nor does the priority of application for a patent decide the priority of invention.

It should be borne in mind, that the cases cited from the books are all cases at law or in equity, in actions for violations of patents already granted. The proceedings before the Commissioner of Patents are initiatory. The question is, "whether the patent shall be granted," not "whether it shall be vacated;" and a patent may be granted or refused upon less evidence than would be required to sustain or amend it.

Upon all the points made in this case, I refer to the opinion in the case of the appeal of *Hildreth v. Heath*, filed in the Patent Office, on the 15th of October, 1841.

Upon consideration of the whole case, I am of opinion that Samuel G. Cornell is the first inventor of the improvement in the machine for making lead-pipe, as claimed in his specification, and that the decision of the Commissioner of Patents, awarding the priority of invention to the said Samuel G. Cornell, be, and the same is hereby, affirmed; and that he is "entitled to receive a patent as prayed for."

W. CRANCH.

July 7, 1847.

DISTRICT OF COLUMBIA, *to wit* :

WILLIAM ATKINSON, appellant,
vs.
 WILLIAM BOARDMAN, Jr., appellee. }

Your appeal from the decision of the Commissioner of Patents, "that William Boardman, Jr., is the first inventor of the improvements to the portable steam-pump, which are the subject-matters in controversy" between the said parties, which decision bears date on the 17th of May, 1847 :

I, William Cranch, Chief Justice of the District Court of the United States for the District of Columbia, certify to the honorable the Commissioner of Patents, that, on the second Monday in October, 1847, according to notice duly given, the parties aforesaid appeared before me, namely: the said William Atkinson by his counsel, Charles M. Keller, and the said William Boardman, Jr., by his counsel, Z. C. Robbins — when the said counsel agreed to submit their respective arguments in writing, which was done on Thursday, the 14th of the said month, to which day the hearing of the said appeal was by consent adjourned; and the said appeal being then fully heard and considered by me upon all points involved by reason of appeal, and the grounds of your decision filed in the office, I do hereby affirm the same, and adjudge that the said William Boardman, Jr., is the inventor of the improvements to the portable steam-pump, which are the subject-matters in this controversy.

W. CRANCH.

October 21, 1847.

This decision is sustained by the following opinions :

WILLIAM ATKINSON, appellant,
vs.
 WILLIAM BOARDMAN, Jr., appellee. }

This is an appeal from the decision of the Commissioner of Patents, in a case of conflicting applications for certain improvements in the construction of steam-pumps.

It appears by the files in the Patent Office, that, on the 4th of December, 1843, William Boardman, Jr., filed his application for his invention "of a new and improved portable steam-pumping engine,

for relieving stranded vessels and for other purposes," which application was rejected by the then Commissioner of Patents, on the 20th of February, 1844. It does not appear upon what grounds that application was rejected; but it is suggested that the matter as then presented was not patentable, but that certain improvements have been since invented and made by which the matter has become patentable, and the Commissioner has decided that the applicant, William Boardman, Jr., is entitled to a patent. It is unnecessary to ascertain what these improvements were, as this is a case of conflicting applications for a patent for the same thing. The question is not, now, who invented the matter upon which the first application of Mr. Boardman was founded, but who is the inventor of the improvements which have made the matter patentable. That such improvements have been made is admitted by both parties, and by the Commissioner.

I do not find any evidence that Mr. Atkinson, after the rejection of Mr. Boardman's first application, on the 20th of February, 1844, invented any patentable improvement upon the pump. It appears by all the evidence that Mr. Boardman *constructed* the pump and all the improvements. In the absence of all evidence to the contrary, the presumption, therefore, is that he was also the *inventor*, and the burden of proof is thrown upon Mr. Atkinson to show, not merely that he first suggested to Mr. Boardman the abstract idea of a steam-pump, (for steam-pumps had been in common use for many years,) but that he invented the improvements which entitle it to a patent. To rebut this inference Mr. Atkinson produces the deposition of *Josiah L. Hale*, who says: "Not long after the loss of the ship *Sheffield*, in November or December, 1843, I met Mr. Atkinson and Mr. Boardman in the Merchants' Exchange, and knowing that some alienation of feeling existed between them, and being anxious that they should be friends, I said to Mr. Boardman, 'why don't you and Mr. Atkinson settle your difficulties?' or words equivalent. He, Boardman, made a reply, having reference to a little paragraph, which had, about that time, appeared in one of the papers, respecting the pump in question," (meaning, no doubt, the paragraph which appeared in the *Journal of Commerce* of the 25th of November, 1843, which gave to Mr. Atkinson the whole credit of the invention of the pump.) "He, Boardman, spoke with some warmth, but respectfully. The deponent replied, '*I had always supposed Mr. Atkinson was the inventor.*' He, Boardman said, '*he was— I again*

say, *he was*' — he, Boardman, used these words, or words equally strong. I, deponent, replied, 'so I always supposed.' After these strong expressions, Mr. Boardman said 'that it was the *combination* which made the steam-pump.' Always supposing that Mr. Atkinson was the inventor, I feel certain I could never have conveyed any other idea to any person that he was not the inventor."

Taking the whole testimony of Mr. Josiah L. Hale, altogether, it seems strange that Mr. Boardman, while expressing indignation at the paragraph which gave to Mr. Atkinson the whole credit for the invention of the pump, should have admitted that he was the *inventor*, in the technical sense of the word. He might have admitted "that Mr. Atkinson suggested the idea of *having* a steam-pump," as testified by Mr. Flanders; and yet he (Boardman) might be the inventor of the peculiar combination of mechanical principles which entitled it to a patent. Mr. Hale says that Boardman told him, "that it was the *combination* which made the steam-pump." There is no evidence that that *combination* was suggested to him by Mr. Atkinson.

I do not perceive in the testimony, any further evidence in support of Mr. Atkinson's claim to be the inventor of any of the patentable improvements in the portable steam-pump.

I have not considered the declarations of the parties in their own favor, in the absence of each other, as competent evidence in this cause for any purpose but to ascertain when and what they have respectively claimed to have invented.

There is no evidence that Mr. Boardman was in the employment and pay of Mr. Atkinson at the time of the supposed invention, or at the time of the construction of the improvements which render it a patentable invention, or at any previous time. On the contrary, it appears in the testimony of Mr. Currier, that before his first application for a patent, in December, 1843, Mr. Boardman built four of these pumps for the board of underwriters, who paid him for the construction thereof; and that this was done without the interference or agency, but with the knowledge of Mr. Boardman.

There does not appear to be any evidence that Mr. Atkinson, either before or after the rejection of Mr. Boardman's application for a patent for the pump, gave Mr. Boardman any instructions in relation to the particular combination of mechanical principles, which is understood to be the ground of his present application for

a patent; nor any model or drawings by which to construct the pump, nor does there appear to be any evidence that he paid Boardman or any other person for constructing it; or that the underwriters had any authority from Mr. Atkinson to use these pumps, which had been built for them by Mr. Boardman.

The deposition of Mr. *Josiah L. Hale*, was taken in New York ten days after Mr. Boardman's, senior, deposition had been taken, in Nashville, New Hampshire, and may have been taken with a view to rebut it. Mr. *Boardman, senior*, testified that between the spring of 1841, and the fall of 1842, Mr. Atkinson told him that William (his son) had invented a steam-pump at his, Atkinson's request, and that he had requested William to turn his attention to getting up a steam-pump, a portable pump, to be used about wrecked vessels. That Atkinson asked him if he had seen the model of the pump invented by William. He, this witness, replied, that it was shown to him by Currier. That in none of the conversations which he had with Mr. Atkinson did he ever pretend or intimate that he was the inventor of the pump, or of any part of it, but, on the contrary, had always stated, that William, his son, was the inventor. That in September, 1842, Mr. Hale, speaking of William Boardman, junior, said, he had recently invented a steam-pump, which they thought highly of, and he should use his influence to have the insurance companies adopt it, and to have one built, and that he intended William should make money out of it.

Mrs. Boardman, mother of the appellee, says, that in the summer of 1842, Mr. Atkinson, speaking of her son, William, told her that he had been inventing a new pump—a steam-pump, to raise ships from the ocean, that he thought William would do something great with it, that he would assist him. That in the next season, Mr. Atkinson was again at their house in Nashville. He said William was getting along finely with his pump, and expressed his opinion that it would be very valuable to him. That in neither of these conversations did Mr. Atkinson intimate that he had invented any part of the said pump. That he expressed himself as grateful for favors he had received from her husband, and was glad to have some opportunity to make a return by assisting her son.

Mr. Jeremiah J. Dickinson says that some time between June and September, 1842, he was present at the exhibition of a steam-pump in Pearl street, at the request of Mr. Atkinson. That two or three

of the board of underwriters were there, and he thinks Mr. Boardman was there also; he understood from Mr. Atkinson that Mr. Boardman was the inventor of the pump; that Mr. Atkinson was to find the funds, and that they were to be partners in the concern; and that he always thought they were partners until one or two years ago, when he learned there had been some misunderstanding between them.

Horace Prior testifies that he received from Mr. Boardman compensation for the use of the room in which the pump was exhibited.

Mr. Orlando Bennett proves the publication of the offensive paragraph, which seems to have caused the misunderstanding between Boardman and Atkinson, by attributing the whole invention to Mr. Atkinson. This paragraph, a copy of which is annexed to Mr. Bennett's deposition, appeared in the Journal of Commerce of the 25th of November, 1843. This seems to have excited Mr. Boardman, and on the 4th of December following he filed his petition for a patent.

William Fletcher testifies that William Boardman, Jun., employed him to make the patterns for the pump, and paid him for making them. Mr. Boardman showed him a sketch which gave him the idea so that he could commence. He never had any communication with Mr. Atkinson, and did not know him till the day of taking his deposition. This witness made a casting of the pump pattern. Mr. Boardman made an alteration in the angle of the discharge nozzle. About the 1st of June, 1842, he took to Mr. Boardman a boiler for the purpose of trying the model, which was then complete. The boiler was of iron. The pumps were cast in Browning's foundery.

Cyrus Currier, of the firm of Davis, Currier & Co., machinists at Newark, New Jersey, testifies that they made four of these steam-pumps for Mr. Boardman, and were paid for them by the New York underwriters; Mr. Boardman having attested to the accuracy of the accounts. That he directed the building of them, and drafted them. The order for the first pump was given about the middle of March, and completed the middle of May, 1843.

Mr. Atkinson was never in the shop during the building of these pumps, to the knowledge of this witness, and gave no instructions about the building of them. He, Mr. Atkinson, has been in the shop since they removed. He came and said he wanted an engine

built with a pump attached to it. He gave no drawings, but asked this witness's opinion as to the size, &c.; thinks he asked if Mr. Boardman's patterns were there; he was answered "no," they were in New York. He then asked the witness if he could build him a pump, the same as they had built for Boardman; thinks it was in the fall of 1841, that Boardman first told him he contemplated building a pump for wrecking purposes. Thinks it was in the middle of the fall. He first saw the model of the steam-pump completed in the spring or summer of 1842. He saw Mr. Atkinson at the place where he saw the model. Mr. Atkinson did not, at that time, claim to be the inventor of the pump, or say any thing to lead this witness to think that he was the inventor, nor did he say or do any thing which gave this witness to understand that he did not recognize Mr. Boardman, at that time, as the inventor. Mr. Atkinson said nothing about it. Mr. Boardman showed him the whole and explained it to him.

Mr. Julius Von Schmidt, a machinist in Washington, D. C., testified that he was applied to, to make a model for Mr. Atkinson "a year ago last winter." (His deposition was taken in 1847.) Mr. Atkinson showed him a model and drawing in Doctor Jones's, and wished him to make him such a model, which he did with some small variation; saw the same model in the Patent Office about three months ago. The name of William Boardman, junior, was upon it. He made a sketch of it at Dr. Jones's office. He has seen at the Patent Office, the model he made for Mr. Atkinson. Mr. Atkinson did not give him any idea of the principle or construction of the pump before he took him to Dr. Jones's office. He called the model at Dr. Jones's office *his* model. He did not examine the drawing particularly; he only took a glance at it. Dr. Jones held it in his hands, and took it away immediately and told him he could sketch better from the model. Upon a careful consideration and comparison of the evidence on both sides, I am of opinion that the preponderance is greatly in favor of William Boardman, jun., as the inventor of the improvements in the steam-pump, for which he has now applied for a patent, and I do therefore affirm the decision of the honorable the Commissioner of Patents in this cause.

W. CRANCH.

October 21, 1847.

DISTRICT OF COLUMBIA, *to wit* :

Edwin Janney, appellant from the refusal of the Commissioner of Patents to rehear his application for a patent after it had been twice rejected by the late Commissioner, Mr. Ellsworth.

I, William Cranch, Chief Justice of the District Court of the United States for the District of Columbia, certify to the Hon. Edmund Burke, Commissioner of Patents, that on the 13th of December, 1847, according to notice given, the said Edwin Janney appeared before me, and was fully heard by his counsel, Mr. J. J. Greenough, in support of his appeal; Mr. Fitzgerald, an examining clerk in the Patent Office being also present and heard in explanation of the grounds of the Commissioner's decision.

Whereupon, inasmuch as the decision of the Commissioner, from which the appeal is taken, neither affirms or denies the right of the applicant to the patent (which he claims) upon the merits of his supposed invention, it is not such a decision as is the subject of appeal under the act of July 4, 1836, "to promote the progress of useful arts," &c., or the act of March 3, 1839, in addition to that act, and that therefore I have not jurisdiction of this appeal, which is therefore hereby dismissed.

W. CRANCH.

December 14, 1847.

(The above decision is sustained by the following reasons :)

December 13, 1847. — EDWIN JANNEY, Appeal.

This is an appeal from the decision of the Commissioner of Patents in the following words, contained in a letter from him to Mr. Janney, dated

PATENT OFFICE, *Oct. 28th, 1847.*

"SIR, — It appears by the records of this office that your application for letters-patent for alleged improvement in machinery for sawing staves was examined and rejected, for reasons assigned on the 3d of August, 1843. That on the 7th of September following, the case was reconsidered, and the decision was again revised and affirmed. All these actions took place under the administration of the late Commissioner Ellsworth.

“ Under these circumstances, the decision heretofore made cannot be disturbed, and your application must stand rejected.

“ Respectfully yours,

“ EDMUND BURKE.

“ EDWARD JANNEY, Esq.

“ *Care of J. J. Greenough, Washington, D. C.*

The last application for the patent was made on the 27th of October, 1847, some small amendment having been made in the specification, not affecting the merits of the claim, so that it was, in effect, an application to the present Commissioner to revise and revoke the two decisions made by Mr. Ellsworth, the former Commissioner. His refusal so to revise and revoke these decisions is not a ground of appeal under the acts of 1836 and 1839. The act of 1839 gives the right of appeal to the Judge only in cases where an appeal was, by the previous act, allowed from the decision of the Commissioner to a board of examiners, and then only when a patent was refused. In the present case he has not refused a patent. He decides only that he will not examine the merits of the claim, which has been twice rejected, after a full examination of his predecessor in office. This refusal was not a ground for appeal to examiners under the 7th section of the act of 1836, and therefore is not a ground of appeal to the judge.

Having no jurisdiction of such an appeal, it is not for me to say whether the refusal, under the circumstances of the case, was right or wrong. There is no limitation of time as to the appeal; and I do not perceive any reason why Mr. Janney may not now appeal from the decision of Mr. Ellsworth, and have the merits of his invention decided. I understand the merits of both applications are alike. Having no jurisdiction of this appeal, I suppose it must be considered as dismissed.

W. CRANCH.

December 13, 1847.

ALEXANDER BAIN, appellant,

vs.

SAM'L. F. B. MORSE, appellee.

} Upon appeal by Alexander Bain, from the decision of the Hon. Commissioner of Patents, rejecting his application for a patent for certain improvements in communicating intelligence by electro-chemical telegraphs.

I, William Cranch, Chief Justice of the District Court of the United States for the District of Columbia, certify to the Honorable the Commissioner of Patents, that on the first Monday of February, 1849, according to notice duly given, the parties aforesaid appeared before me; to wit., the said Alexander Bain by the Hon. R. M. Gillet, his counsel; and the said Samuel F. B. Morse, by Amos Kendall and Alexander H. Lawrence, Esquires, his counsel, and the said appeal was heard upon the decision of the said Commissioner of Patents, and the reasons of appeal filed in the office, with the grounds of the said decision, fully set forth in writing, touching all the points involved by the reasons of appeal; and the same, being fully argued, heard and considered, I do decide and adjudge, that the decision of the said Commissioner of Patents, "that the said Samuel F. B. Morse is the first and original inventor of the alleged improvement in Telegraphs, and as such, is entitled to receive a patent therefor," be, and the same is hereby reversed and annulled—inasmuch as the question of priority of invention does not necessarily arise in the case; as the claims of the two parties do not, in my opinion, interfere in regard to any matter (described in their respective specifications) which is now patentable. And I do further decide and adjudge that the said Samuel F. B. Morse is entitled, under the seventh section of the Act of 1836, to a patent for the combination which he has invented,—claimed and described in his specification, drawings, and model; and that the said Alexander Bain is entitled, under the same section, to a patent for the combination which he has invented, claimed, and described in his specifications, drawings, and model; provided the said Morse and Bain shall have, respectively, complied with all the requisites of the law to entitle them to their respective patents.

I deem it unnecessary therefore, to decide any other points involved by the reasons of appeal.

I herewith return all the papers, and add the reasons of my decision, which may be filed in the case.

W. CRANCH.

Washington, D. C., March 12, 1849.

The Commissioner, upon hearing, decided that Mr. Bain's claim interfered with Mr. Morse's; and that Mr. Morse was the first inventor, and rejected the claim of Mr. Bain. From this decision Mr. Bain has appealed.

It is contended by the counsel of Mr. Morse, that the judge upon appeal has no jurisdiction of the question of interference. That an appeal is given only upon the question of *priority of invention*; and that upon the question of interference, the decision of the Commissioner is conclusive.

Whether it be thus conclusive, then, is the first question to be decided.

By the act of 1836, ch. 357, § 7, it is enacted, that "if the specification and claim shall not have been so modified as *in the opinion of the Commissioner*, shall entitle the applicant to a patent, he may, on an appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three, &c.; and on examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part; and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application."

This section is applicable to cases where there is no conflicting applicant, and shows that the legislature, by saying, "*if in the opinion of the Commissioner*," &c., did not intend to make that opinion conclusive. On the contrary, it provides "that the board shall be furnished with a certificate in writing, of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented; and that the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting," &c. All these provisions were evidently intended to enable the board of examiners to revise the opinion and decision of the Commissioner, and show that his opinion was not to be conclusive.

By the 8th section of the same act, (1836,) it is enacted, "That

whenever an application shall be made for a patent which, *in the opinion of the Commissioner*, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice *thereof* to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of *priority* of right or invention on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine *which*, or whether either of the applicants is entitled to receive a patent as prayed for."

The question of priority of right or invention necessarily implies *interference*. The Commissioner, before he could decide the question of priority, must have decided that of interference; for without interference there can be no question of priority. Before I can have jurisdiction of the question of priority, I must be satisfied that there is an interference; and I must decide the question of jurisdiction as well as any other question which arises in the cause.

The opinion of the Commissioner, [mentioned in the 8th section, that interference exists,] only justifies him in *giving notice thereof* to the other applicant, and appointing a day to hear the parties upon that question. He decides it only *pro hac vice*; and for that purpose only. Upon that hearing he is to decide; and from that decision, if either shall be dissatisfied with it, on the question of priority, including that of interference, he may appeal; and upon such appeal as I understand the law, the judge, in case of real interference, may "determine which, or whether either of the applicants is entitled to receive a patent as prayed for." The scope thus given to the judge, is broad enough to include the question of interference, as well as that of priority, if it should arise.

By the Act of 1839, ch. 88, § 11, it is enacted "That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents, to a board of examiners provided for in the 7th section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the District Court of the United States for the District of Columbia by giving notice thereof to the Commissioner, and filing in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing; and also paying into the

Patent Office, to the credit of the patent fund, the sum of twenty-five dollars.

“And it shall be the duty of the said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions, in a summary way, on the evidence adduced before such a Commissioner, at such early and convenient time as he may appoint; first notifying the Commissioner of the time and place of hearing; whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as the said judge shall prescribe.

“The Commissioner shall also lay before the said Judge all the original papers and evidence in the case, together *with the grounds of his decision*, fully set forth in writing, *touching all the points involved by the reasons of appeal*; to which the revision shall be confined.”

One of the reasons of appeal in this case, is, ‘That there is no real and substantial interference between the two applications.

The question of interference, therefore, is involved by the reasons of appeal, and must be decided by the judge. By limiting the jurisdiction of the judge, to the points involved by the reasons of appeal, the legislature has affirmed it to that extent.

The interference mentioned in the 8th section of the Act of 1836, must be an interference in respect to patentable matters; and the claims of the applicants must be limited to the matters specifically set forth, as their respective inventions; and what is not thus claimed, may, for the purpose of this preliminary inquiry, be considered as disclaimed.

The question then is, does Mr. Bain claim a patent for any matter now patentable, for which Mr. Morse claims a patent?

To answer this question, it is necessary to ascertain for what patentable matter Mr. Morse now claims a patent.

In his specification, filed Jan. 20, 1848, he says:

“What I claim, as my own invention and improvement, is the use of a single circuit of conductors *for the marking of my Telegraphic signs already patented*, for numerals, letters, words and sentences, by means of the decomposing, coloring or bleaching effects of electricity acting upon any known salts that leave a mark as the result of the said decomposition, upon paper, cloth, metal, or other convenient and known markable material. I also claim the invention of the machinery as herein described, for the purpose of applying the decomposing, coloring, or bleaching effects of electricity acting upon known salts as herein before described.”

The Commissioner in his written decision in this case, says:—
“Such use of a single circuit [i. e. to produce marks upon chemically prepared paper] is not the point at issue; *nor is this claimed by either party*. Said Morse claims using a single circuit of conductors, for a certain purpose, or in a certain way; viz., to mark his telegraphic signs; and also claims the machinery by which he accomplishes this purpose. Said Bain does not specifically mention in his claim, using a single circuit, though this must be considered as an essential part of his invention and claim, and is necessarily involved in the final clause of his claim, to wit: “So that in either case these form the *received communication*, substantially in the manner and with the effects described and shown.”

The Commissioner proceeds—The third clause of the claim of said Bain with which the true claims of said Morse interfere, is as follows, to wit:

“Third.—The application of any suitable chemically prepared paper, without regard to the chemical ingredients used for such a purpose, to receive and record signs forming such communications, such signs being made by the pulsations of an electric current or currents, transmitted from a distant station, said current operating directly, and without the intervention of any secondary current or mechanical contrivance, through a suitable metal marking style that is in continuous contact with the receiving paper, thereby making marks thereon, which marks correspond with the groups of perforations in the paper *composing* the transmitted communication; or may be given by the pulsations from the spring 45 and block 46, so that in either case these form the received communication substantially in the manner, and with the effects described and shown; including any merely practical variations, analogous and equivalent in the means employed and the effects produced thereby.”

The Commissioner, in his written decision, says:

“The invention, it will be seen by reference to the specifications of the parties respectively, does not consist in the use of the electric current to make marks upon chemically prepared paper; nor making marks through a single line of conductors; nor could a claim to either of these devices have been entertained as patentable, as they have been long known.”

Again—It is said by the counsel of Mr. Morse, “it is admitted that neither could patent the *battery*, the *circuit*, the prepared paper, or the marking by the electro-chemical process— it was only a *new*

combination of the several parts so as to produce a new result, or an old result in a better manner, that either could patent."

Again — The Commissioner, in his "*reasons of decision*" says — "it is true, as Mr. Bain asserts, that no one can monopolize the use of air, fire, or water, but it is equally true that any one can monopolize the use of air, fire, or water upon certain principles of operation which he may have invented or discovered, and this is precisely what the respective claimants, in this case demanded as their rights, and gave rise to the interference, viz: each claimed the right to use and exclude others from using, galvanic power to mark certain signs [which signs have been already patented by said Morse] upon chemically prepared paper through a single circuit of conductors.

"*A single circuit of conductors*, consisting either wholly of wire, or in part of wire and part of earth, for telegraphic purposes *was not new*. The signs or signals to be marked *were not new*; — the same having been before patented by said Morse; — and *chemically prepared paper*, for receiving telegraphic signs by galvanism, *was not new*; the same having been patented in England, in 1838, by Mr. E. Davy. Moreover, the *use of a single telegraphic circuit*, for marking the aforesaid signs upon paper, *was not new*, the same having been before patented by said Morse.

"Neither party claimed any one, or any two of the above elemental features. *The invention of each was made up of the three combined*; and the advantages claimed to have been discovered by each, in these combined operations, were identical."

If then, these matters are not now patentable in themselves there is nothing patentable in Mr. Morse's claim, left to be interfered with, except his claim of a patent for his invention of the machinery described in his specification, or for his combination of machinery and materials, as described therein. The claim of each applicant, therefore, is reduced to the claim *for the combination of machinery and materials* which he has invented, and does not include any of the matters claimed in his specification which are not now patentable.

These combinations seem to me to be far from identical. Mr. Bain includes in his combination the use of the perforated paper for *composing* the communication; and of the style which passes the electric current through the perforated paper; and the machinery for transmitting the same communication to several different places at the same time. It is said that the style is not new; — but he makes it an ingredient in his combination — and in that respect, his combi-

nation differs from that of Mr. Morse, and it is a very important item in connection with the perforated paper. He includes, in his combination, new patentable matter with old matter, not patentable, and thereby makes a new patentable combination. This new matter thus introduced into the new combination is admitted to be patentable in itself without combination with the old unpatentable matter, and indeed it seems to be a great improvement in the transmission of telegraphic information.

But it is said that Mr. Bain is only authorized to obtain a separate patent for each of those inventions, and cannot claim a patent for his new combination of the old and new together. If, however, his new combination of old materials be patentable [which must be admitted, or it would not interfere with Mr. Morse's claim] it seems to be not the less patentable, because it includes the new matter in connection with the old. The old matter may not, in itself, be patentable, but joined to the new matter, a combination may be formed which may be patented. He is not obliged to take separate patents for each new patentable matter. He does not now ask for them; he may be willing to ask only for a limited use of those new matters, *to wit, in combination*; and not for an exclusive use of them for every purpose to which they may be applicable.

Mr. Godson (in p. 63,) says — “a combination or arrangement of old materials, when, in consequence thereof a new effect is produced, may be the subject of a patent. This effect may consist either in the production of a new article, or in making an old one in a better manner, or at a cheaper rate.” “This manufacture may be made of different substances mingled together; or of different machines formed into one; or of the arrangement of many old combinations.” “Each distinct part of the manufacture may have been in common use, and every principle upon which it is founded may have been long known, and yet the manufacture may be the proper subject for a patent. It is not for those parts and principles, but for the new and useful compound, or thing thus produced by combination, that the grant is made; it is for combining and using things before known, with something then invented, so as to produce an effect which was never before attained.”

The counsel of Mr. Morse, in argument, said:

“It is obvious, and is admitted by our adversaries, that Morse's instrument is a very different thing, in its *form* and *structure* from Bain's.” But *form* and *structure* are very important matters in

machinery ; and if they enable the operator to do the work in a better manner, or with more ease, or less expense, or in less time, it is no interference ; but is an improvement for which the inventor may have a patent.

When the application is for a patent for a combination of machinery and materials, form and structure become *substance* ; they are of the essence of the invention ; and an admission that Morse's instrument is a very different thing, in its form and structure, from Bain's, is an admission of a fact which is *primâ facie* evidence at least, that there is no interference between the two, and throws the burden of proof on the other side.

There was no evidence laid before the Commissioner of Patents upon the question of interference ; so that he must have adjudged the interference upon a comparison of the two specifications ; possibly without considering that the only patent which either could obtain, would be a patent for his own combination — all the materials, of which Mr. Morse's combination consists, being old and not now patentable.

The question is not now, whether the claims of Mr. Bain and Mr. Morse interfere as to matters not now patentable ; but whether they interfere as to matters *now patentable* ; and the only matter now patentable, in Mr. Morse's specification, is his own combination of machinery and materials. That combination constitutes his machine ; and his machine is admitted to be a very different thing, in its form and structure from Mr. Bain's. Form and structure constitute the identity of machinery. The combination consists in *form* and *structure* ; and the patent if issued, will, I presume, be issued for the *form* and *structure* of the instrument.

It being admitted that the form and structure of Mr. Bain's instrument is very different from Morse's, there can be no interference in that respect, and if form and structure constitute the identity of machinery there is no interference in the two instruments ; and if the instruments are the combinations, or the result of the combinations, for which patents are now claimed, there is no interference in the two instruments in regard to any matter now patentable.

But it is not necessary to rely alone upon the admission of Mr. Morse's counsel to show that there is a great difference between the machinery used by the contending applicants to effect the object ; that is, the rapid transmission of intelligence by the power of the electric current. Any one who will compare the two specifications and drawings and models, will at once perceive that difference.

A patentable improvement is not an interference.

The Commissioner in his written decision, says : " It appears from the records of the office, that the application by said Alexander Bain, subject of Great Britain, was made April 18, 1848, and upon examination of his claims, it was found that the before-mentioned claim could be *admitted to patent*, no invention of a like character, appearing in the public records of the office ; nor in any printed publication. Prior, however, to the final issue of the case, the secret archives were consulted ; and it was found that an application, filed by Samuel F. B. Morse, January 20, 1848, had been there deposited, in compliance with provisions of law, which presented claims conflicting with those, before mentioned, set up by said Bain."

This shows that but for the supposed interfering claim of Mr. Morse, Mr. Bain was entitled to his patent ; and if there be no interference in respect to patentable matter, he is still entitled to a patent for his own combination.

But the counsel for Mr. Morse say : " There is an interference — that Bain's third claim palpably covers the whole of Morse's first claim ; and, if granted, Bain could do all that Morse claims an exclusive right to do ; he could write Morse's characters precisely as Morse does ; and that therein consists the interference."

But the only matter now patentable, and claimed in Mr. Morse's specification, is *his peculiar combination of materials and machinery as therein described*. All the materials, used in that combination, are old ; and he will not, under this patent, be entitled to the exclusive use of any of them separately, or in any other combination than that which he has described in his specification. There cannot be a patent for a *principle* ; nor for the application of a principle ; nor for an effect. Two persons may use the same principle and produce the same effect *by different means*, without interference or infringement, and each would be entitled to a patent for his own invention. — *Godson*, 63, 68, 74.

So, in the present case, although the power used by both applicants is the same, and the subject the same, yet, as the effect is produced by means which appear to me so different as to prevent an interference, *the question of priority of invention does not arise*. It is, therefore, not a case under the 8th section of the act of 1836, but under the 7th section of the same act. So that each of the applicants may have a patent for the combination which he has invented and claimed and described in his specification — provided he shall have complied with all the requisites of the law to entitle him to a patent.

If this were a doubtful question, I should think it my duty to render the same judgment, so as to give Mr. Bain the same right to have the validity of his patent tested by the ordinary tribunals of the country, which Mr. Morse would enjoy as to his patent; and finally, to obtain the judgment of the Supreme Court of the United States upon it. For if the Commissioner and the Judge should reject Mr. Bain's application for a patent, the decision would be final and conclusive against him, unless he could obtain relief by a bill in equity under the 16th section of the act of 1836, and the 10th section of the act of 1839; which, it is said, is doubtful.

I am, therefore, of opinion, and so decide :

That there is no interference in the claims of these applicants, in relation to any matter (contained in their respective specifications) *now patentable*; and, therefore, that Samuel F. B. Morse is entitled to a patent for the combination which he has invented, claimed, and described in his specification, drawings, and model. And that Alexander Bain is entitled to a patent for the combination which he has invented, claimed, and described in his specification, drawings and model; provided they shall respectively, have complied with all the requisites of the law, to entitle them to their respective patents.

I deem it unnecessary, therefore, to decide upon any other points involved by the reasons of appeal.

W. CRANCH.

WASHINGTON, D. C. *March 12, 1849.*

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