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Evans Vs. Eaton

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Decided On : 1818

Appeal No. : 16 U.S. 454

Appellant : Evans

Respondent : Eaton

Judgement :

Evans v. Eaton - 16 U.S. 454 (1818)
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Evans v. Eaton

16 U.S. (3 Wheat.) 454

ERROR TO THE CIRCUIT COURT FOR

THE DISTRICT OF PENNSYLVANIA

SYLLABUS

Under the sixth section of the patent law of 1793, ch. 156, the defendant pleaded the general issue and gave notice that he would prove at the trial that the machine for the use of which, without license, the suit was brought had been used previous

to the alleged invention of the plaintiff in several places which were specified in the notice, or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." The defendant having given evidence as to some of the places specified, offered evidence as to others not specified. *Held,* that this evidence was admissible. But the powers of the court in such a case are sufficient to prevent and will be exercised to prevent the patentee from being injured by surprise.

Testimony on the part of the plaintiff that the persons of whose prior use of the machine the defendant had given evidence had paid the plaintiff for licenses to use the machine since his patent ought not to be absolutely rejected, though entitled to very little weight.

Quaere whether, under the general patent law, improvements on different machines can be comprehended in the same patent so as to give a right to the exclusive use of several machines separately as well as a right to the exclusive use of those machines in combination.

However this may be, the Act of 21 January, 1808, ch. 117, "for the relief of Oliver Evans," authorizes the issuing to him of a patent for his invention, discovery, and improvements in the art of manufacturing flour and in the several machines applicable to that purpose.

Quaere whether Congress can constitutionally decide the fact that a particular individual is an author or inventor of a certain writing or invention so as to preclude judicial inquiry into the originality of the authorship or invention.

Be this as it may, the act for the relief of Oliver Evans does not decide that fact, but leaves the question of invention and improvement open to investigation under the general patent law.

Under the sixth section of the patent law, ch. 156, if the thing secured by patent had been in use, or had been described in a public work anterior to the supposed discovery, the patent is void, whether the patentee had a knowledge of this previous use or description or not.

Oliver Evans may claim under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour and meals and in the several machines which be has invented, and in his improvement on machines previously discovered. But where his claim is for an improvement on a machine, he must show the extent of his improvement so that a person understanding the subject may comprehend distinctly in what it consists.

The act for the relief of O.E. is engrafted on the general patent law, so as to give him a right to sue in the circuit court for an infringement of his patent rights, although the defendant may be a citizen of the same state with himself.

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This was an action brought by the plaintiff in error against the defendant in error for an alleged infringement of the plaintiff's patent right to the use of his improved hopper boy, one of the several machines discovered, invented, improved, and applied by him to the art of manufacturing flour and meal, which patent was granted on 22 January, 1808. The defendant pleaded the general issue, and gave the notice hereafter stated. The verdict was rendered, and judgment given thereupon for the defendant in the court below, on which the cause was brought, by writ of error, to this Court.

At the trial in the court below, the plaintiff gave in evidence the several acts of Congress entitled respectively "An act to promote the progress of useful arts," and

"to repeal the acts heretofore made for that purpose and to extend the privilege of obtaining patents for useful discoveries and inventions

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to certain persons therein mentioned and to enlarge and define penalties for violating the rights of patentees,"

and "An act for the relief of Oliver Evans," the said Oliver's petition to the Secretary of State, for a patent, and the patent thereupon granted

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to the said Oliver, dated 22 January, 1808, and further gave in evidence

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that an agent for the plaintiff wrote a note to the defendant, in answer to which he called on the

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agent at Chambersburg at the house of Jacob Snyder on 9 August, 1813; there were a number

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of millers present; the defendant then told the agent that he had got Mr. Evans' Book, a plate in

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the Millwright's Guide, and if the agent would take $40, the defendant would give it him; the

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defendant said that his hopper boy was taken from a plate in Mr. Evan's book; he said he would give no more, alleging that the $100 the agent asked was too much; that the stream on which his mill was was a small head of Conogocheage. The agent then declared that if the defendant would not pay him by Monday morning, he would commence a suit in the circuit court.

The plaintiff further gave in evidence that another agent for the plaintiff was in the defendant's mill on 2 November, 1814, and saw a hopper boy there on the principles and construction of the plaintiff's hopper boy. This witness had heard that a

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right was obtained under Pennsylvania, but did not known of any rights under Pennsylvania sold by the plaintiff, and did not know that it was erected in any mill after the patent under Pennsylvania. The defendant's

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hopper boy had an upright shaft, with a leading arm, in the first place, and a large arm inserted

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with flights, and leading lines, and sweepers; a little board, for the purpose of sweeping the meal in the

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bolting hoppers and spreading it over the floor; a balance weight, to cause the arms to play up and down lightly over the meal. The leading arms were about 5

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feet long, and seemed to be in proportion, the arm about 14 and the length of the sweep about 9 inches.

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And the defendant, having previously given the plaintiff written notice that upon the trial of the

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cause, the defendant would give in evidence under the general issue the following special matter, to-wit:

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"1st. That the improved hopper boy, for which, *inter alia,* the plaintiff in his declaration alleges he

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has obtained a patent, was not originally discovered by the patentee, but had been in use anterior to the supposed discovery of the patentee, in sundry places, to-wit, at the mill of George Fry and Jehu Hollingsworth in Dauphin County, Pennsylvania, at Christian Stauffer's mill in Warwick Township, Lancaster County, State of Pennsylvania, at Jacob Stauffer's mill in the same county, at Richard Downing's mill in Chester County, Pennsylvania; at Buffington's mill on the Brandywine; at Daniel Huston's mill in Lancaster County, Pennsylvania; at Henry Stauffer's mill in York County, Pennsylvania, and at Dihl's mill in the same county, or at some of the said places, and also at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere

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in the United States."

"2d. That the patent given to the plaintiff, as he alleges in his declaration, is more extensive than his discovery or invention, for that certain parts of the machine in said patent, called an improved hopper boy, and which the plaintiff claims as his invention and discovery, to-wit, the upright shaft, arms, and flights, and sweeps, or some of them, and those parts by which the meal is spread, turned and gathered at one operation, and also several other parts, were not originally invented and discovered by him, but were in use prior to his said supposed invention or discovery, to-wit, at the places above mentioned, or some of them."

"3d. That the said patent is also more extensive than the plaintiff's invention or discovery, for that the application of the power that moves the mill or other principal machine to the hopper boy is not an original invention or discovery of the plaintiff, but was in use anterior to his said supposed invention or discovery, to-wit, at the places above mentioned, or some of them."

"4th. That the said patent is void, because it purports to give him an exclusive property in an improvement in the art of manufacturing meal, by means of a certain machine, termed an improved hopper boy, of which the said plaintiff is not the original inventor or discoverer; parts of the machine in the description thereof referred to by the patent, having been in use anterior to the plaintiff's said supposed discovery, to-wit, at the places above mentioned, or some of them, and the said patent and description therein referred to contains no statement, specification, or description

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by which those parts, so used as aforesaid, may be distinguished from those of which the said plaintiff may have been the inventor, or discoverer, protesting at the same time that he has not been the inventor or discoverer of any of the parts of the said machine."

"5th. That the improved elevator, described in the declaration or referred to therein, was not originally discovered by the plaintiff, but was anterior to his said supposed discovery or invention, described in certain public works, or books, to-wit, in Shaw's Travels; in the first volume of the Universal History; in the first volume of Mormer's Husbandry; in Ferguson's Mechanics; in Bossuet's Histoire des Mathematiques; in Wolf's Cours des Mathematiques; in Desagulier's Experimental Philosophy, and in Proney's Architecture Hydraulique, or some of them."

"6th. That the said patent is more extensive than the invention or discovery of the plaintiff because certain parts of the machine called an improved elevator were, anterior to the plaintiff's said supposed invention or discovery, described in certain public works, or books, to-wit, the works or books above mentioned, or some of them, and that the said patent is void because it neither contains or refers to any specification or description by which the parts so before described in the said public works, may be distinguished from those parts of which the plaintiff may be the inventor, or discoverer, protesting, at the same time, that he has not been the inventor or discoverer of any of the parts of the said machine"

gave in evidence the existence of hopper boys prior to the plaintiff's alleged discovery at sundry mills in the State of Pennsylvania,

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mentioned in the said notice, and further offered to give in evidence the existence of hopper boys prior to the plaintiff's alleged discovery, at sundry other mills in the State of Pennsylvania not mentioned in the said notice, and the counsel for the plaintiff objected to the admission of any evidence of the existence of hopper boys in the said mills not mentioned in the said notice. But the court decided that such evidence was competent and legal. To which decision the counsel for the plaintiff excepted. The plaintiff, after the above evidence had been laid before the jury, offered further to give in evidence, that certain of the persons mentioned in the defendant's notice, as having hopper boys in their mills, and also certain of the persons not mentioned in the said notice, but of whom it had been shown by the defendant that they had hopper boys in their mills had, since the plaintiff's patent, paid the plaintiff for license to use his improved hopper boy in the said mills respectively. But the counsel for the defendant objected to such evidence as incompetent and illegal, and the court refused to permit the same to be laid before the jury. To which decision the plaintiff's counsel excepted.

The court below charged the jury that the patent contained no grant of a right to the several machines, but was confined to the improvement in the art of manufacturing flour by means of those machines, and that the plaintiff's claim must therefore be confined to the right granted, such as it was. That it had been contended that the schedule was part of the patent, and contained a claim to the invention of the peculiar properties and principles of the hopper boy, as

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well as other machines. But the court was of opinion that the schedule is to be considered as part of the patent so far as it is descriptive of the machines, but not further, and even if this claim had been contained in the body of the patent, it would have conferred no right which was not granted by that instrument.

The court further proceeded to instruct the jury that the law authorized the president to grant a patent for the exclusive right to make, construct, use, and vend to be used any new and useful art, machine, manufacture, or composition of matter or any new and useful improvement in any art, machine &c.;, not known or used before the application. As to what constitutes an improvement, it is declared that it must be in the principle of the machine, and that a mere change in the form or proportions of any machine shall not be deemed a discovery. Previously to obtaining the patent, the applicant is required to swear or affirm that he verily believes that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent, and he must also deliver a written description of his invention, and of the manner of using it, so clearly and exactly, as to distinguish the same from all other things before known, and to enable others skilled in the art to construct and use the same. That from this short analysis of the law, the following rules might be deduced.

1st. That a patent may be for a new and useful art, but it must be practical, it must be applicable and referable to something by which it may be proved to be useful; a mere abstract principle cannot be appropriated by patent.

2d. The discovery must not only be useful, but new; it must not have been

known or used before in any part of the world. It was contended by the plaintiff's counsel that the title of the patentee cannot be impeached unless it be shown that he knew of a prior discovery of the same art, machine, &c.;, and that true and original are synonymous terms in the intention of the legislature. But as it was not pretended that those terms meant the same thing in common parlance, neither was it the intention of the legislature to use them as such. The first section of the law, referring to the allegations of the application for a patent, speaks of the discovery as something "not known or used before the application," and in the 6th section it is declared that the defendant may give in evidence that the thing secured by patent, was not originally discovered by the patentee, but has been in use, had been described in some public work anterior to the supposed discovery.

3d. If the discovery be of an improvement only, it must be an improvement in the principles of a machine, art, or manufacture, before known or used; if only in the form or proportion, it has not the merit of a discovery which can entitle the party to a patent.

4th. The grant can only be for the discovery as recited and described in the patent and specification. If the grantee is not the original discoverer of the art, machine, &c.;, for which the grant is made, the whole is void. Consequently, if the patent be for the whole of the machine, and the discovery were of an improvement, the patent is void.

5th. A machine or an improvement may be new and the proper subject of a patent though the parts of it were before known and in use. The combination, therefore, of old machines to produce a new

and useful result is a discovery for which a patent may be granted.

The above principles would apply to most of the questions that had been discussed. It was strongly insisted upon by the defendant's counsel that this patent is broader than the discovery, the evidence proving that in relation to the hopper boy for the using of which this suit is brought, the plaintiff can pretend to no discovery beyond that of an improvement in a machine known and used before the alleged discovery of the plaintiff. This argument proceeded upon the supposition that the plaintiff had obtained a patent for the hopper boy, which was entirely a mistake. The patent was "for an improvement in the art of manufacturing flour," by means of a hopper boy and four other machines described in the specification, and not for either of the machines so combined and used. That the plaintiff is the original discoverer of this improvement, was contested by no person, and therefore it could not with truth be alleged that the patent is broader than the discovery, or that the plaintiff could not support an action on this patent against any person who should use the whole discovery.

But could he recover against a person who had made or used one of the machines, which in part constitute the discovery? The plaintiff insisted that he could, because, having a right to the whole, he is necessarily entitled to the parts of which that whole is composed. Would it be seriously contended that a person might acquire a right to the exclusive use of a machine, because when used in combination with others, a new and useful result is produced which he could not have acquired independent of that combination?

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If he could, then if A. were proved to be the original inventor of the hopper boy; B. of the elevator, and so on, as to the other machines, and either had obtained patents for their respective discoveries, or chose to abandon them to the public, the plaintiff, although it was obvious he could not have obtained separate patents for those machines, might nevertheless deprive the original inventors, in the first instance, and the public, in the latter, of their acknowledged right to use those discoveries, by obtaining a patent for an improvement consisting in a combination of those machines to produce a new result.

The court further charged the jury that it was not quite clear that this action could be maintained, although it was proved beyond all controversy that the plaintiff was the original inventor of this machine. The patent was the foundation of the action, and the gist of the action was the violation of a right which that instrument had conferred. But the exclusive right of the hopper boy was not granted by this patent, although this particular machine constitutes a part of the improvement of which the plaintiff is the original inventor, and it is for this improvement and this only that the grant is made. If the grant then was not of this particular machine, could it be sufficient for the plaintiff to prove in this action that he was the original inventor of it?

Again, could the plaintiff have obtained a separate patent for the hopper boy, in case he were the original inventor of it, without first swearing or affirming, that he was the true inventor of that machine? Certainly not. Has the plaintiff then taken or could he have taken such an oath in this case? Most assuredly he could not,

because the prescribed form of the oath

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is that he is the inventor of the art, machine, or manufacture for which he solicits a patent. But since the patent which he solicited was not for the hopper boy, but for an improvement in the manufacture of flour, he might with safety have taken the oath prescribed by law, although he knew at the time that he was not the true inventor of the hopper boy, and thus it would happen that he could indirectly obtain the benefit of a patent right to the particular machine, which he could not directly have obtained, without doing what it must be admitted in this case he had not done.

But this was not all. If the law had provided for fair and original discoverers a remedy when their rights are invaded by others, it had likewise provided corresponding protection to others, where he has not the merit. What judgment could the district court have rendered on a *scire facias* to repeal this patent if it had appeared that the plaintiff was not the true and original inventor of the hopper boy? Certainly not that which the law has prescribed, *viz.,* the repeal of the patent, because it would be monstrous to vacate the whole patent, for an invention of which the patentee was the acknowledged inventor, because he was not the inventor of one of the constituent parts of the invention for which no grant is made. But the court would have no alternative but to give such a judgment, or, in effect, to dismiss the *scire facias,* and if the latter, then the plaintiff would have beneficially the exclusive right to a machine, which could not be impeached in the way prescribed by law, although it should be demonstrated that he was not either the true or the original inventor of it. And

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supposing the jury should be of opinion, and so find, that the plaintiff was not the original inventor of this machine, would not the court be prevented from declaring the patent void, under the provisions of the 6th section of the law, for the reason assigned why the district court could not render judgment upon a *scire facias?*

Indeed it might well be doubted whether the defense now made by the defendant could be supported at all in this action (if this action could be maintained), inasmuch as the defendant cannot allege, in the words of the 6th section, that the thing secured by patent was not originally discovered by the patentee, since, in point of fact, the thing patented was originally discovered by the patentee, although the hopper boy may not have been so discovered. But if this defense could not be made, did not that circumstance afford a strong argument against this action? If the plaintiff was not the inventor of the parts, he had no right to complain that they were used by others, if not in a way to infringe his right to their combined effect. If he was the original inventor of the parts which constitute the whole discovery, or any of them, he might have obtained a separate patent for each machine of which he was the original inventor.

Upon the whole, although the court gave no positive opinion upon this question, it stated that it was not to be concluded that this action could be supported even if it were proved that the plaintiff was the original inventor of the hopper boy. But if an action would lie upon this patent for the violation of the plaintiff's right to the hopper boy, still the plaintiff could not recover if it had been shown to the satisfaction of the

jury that he was not the original discoverer of that machine.

It appeared by the testimony of the defendant's witnesses that Stauffer's hopper boy was in use many years before the alleged discovery of the plaintiff; that the two machines differed from each other very little in form, in principle, or in effect. They were both worked by the same power which works the mill, and they both stir, mix, cool, dry, and conduct the flour to the bolting chest. Whether the flights and sweepers in the plaintiff's hopper boy were preferable to the slips attached to the under part of the arm in Stauffer's, or whether, upon the whole, the former is a more perfect agent in the manufacture of flour than the latter were questions which the court would not undertake to decide, because, unless the plaintiff was the original inventor of the hopper boy, although he had obtained a separate patent for

it, he could not recover in this action, however useful the improvement might be which he had made in that machine. If the plaintiff had obtained a patent for his hopper boy, it would have been void, provided the jury should be of opinion, upon the evidence, that his discovery did not extend to the whole machine, but merely to an improvement on the principle of an old one, and if this should be their opinion in the present case, the plaintiff could not recover.

It had been contended by the plaintiff's counsel that the defendant, having offered to take a license from the plaintiff if he would consent to reduce the price of it to $40, he was not at liberty to deny that the plaintiff is the original inventor of this machine.

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This argument had no weight in it, not merely because the offer was rejected by the plaintiff's agent, and was therefore as if it had not been made, but because the law prevents the plaintiff from recovering if it appear on the trial that he was not the original inventor. If the offer amounted to an acknowledgment that the plaintiff was the original inventor (and further it could not go), this might be used as evidence of that fact, but it would not entitle the plaintiff to a verdict if the fact proved to be otherwise.

The plaintiff's counsel had also strongly insisted that under the equity of the tenth section of the law, the defense set up in this case ought not to be allowed after three years from the date of the patent. This argument might, perhaps, with some propriety be addressed to the legislature, but was improperly urged to the court. The law had declared that in an action of this kind, the defendant may plead the general issue, and give in evidence that the plaintiff was not the original inventor of the machine for which the patent was granted. The legislature has not thought proper to limit this defense in any manner, and the court could not do it.

But what seemed to be conclusive of this point was that the argument would tend to defeat altogether the provision of the sixth section, which authorizes this defense to be made, for if it could not be set up after three years from the date of

the patent, it would be in the power of the patentee to avoid it altogether by forbearing to bring suits until after the expiration of that period. And thus, although the law has carefully

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provided two modes of vacating a patent improvidently granted, the patentee, though not the original inventor, and however surreptitiously he may have obtained his patent, may secure his title to the exclusive use of another's invention, if he can for three years avoid an inquiry into the validity of his title.

The last point was that Stauffer's invention was abandoned, and consequently might be appropriated by the plaintiff. But if Stauffer was the original inventor of the hopper boy, and chose not to take a patent for it, it became public property by his abandonment; nor could any other person obtain a patent for it, because no other person would be the original inventor.

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MR. CHIEF JUSTICE MARSHALL delivered the opinion of the Court.

In this case, exceptions were taken in the circuit court by the counsel for the plaintiff in error,

1st. To the opinion of the court in admitting testimony offered by the defendant in that court.

2d. To its opinion in rejecting testimony offered by the plaintiff in that court.

3d. To the charge delivered by the judge to the jury.

Under the 6th section of the act for the promotion of useful arts and to repeal the act heretofore made for that purpose, the defendant pleaded the general issue, and gave notice that he would prove at the trial that the improved hopper boy, for the use of which, without license, this suit was instituted, had been used previous to the alleged invention of the said Evans, in several places (which were specified

in the notice), or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." Having given evidence as to some of the places specified in the notice, the defendant offered evidence as to some other places not specified. This evidence was objected to by the plaintiff, but admitted by the court, to which admission the plaintiff's counsel excepted.

The 6th section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading when it allows him to give in

evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed, from an unfair use of this privilege. Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act which may have some influence on this point. It has been already observed, that the notice is substituted for a special plea; it is further to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence on a special plea the prior use of the machine at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

But there is still another view of this subject, which deserves to be considered. The section which directs this notice, also directs that if the special matter stated in the section be proved, "judgment shall be rendered for the defendant, with costs, and

the patent shall be declared void." The notice might be intended not only for the information of the plaintiff,

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but for the purpose of spreading on the record the cause for which the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the court are sufficient to prevent, and will undoubtedly be so exercised as to prevent the patentee from being injured by the surprise.

This testimony having been admitted, the plaintiff offered to prove that the persons of whose prior use of the improved hopper boy the defendant had given testimony had paid the plaintiff for licenses to use his improved hopper boy in their mills since his patent. This testimony was rejected by the court on the motion of the defendant, and to this opinion of the court also the plaintiff excepted.

The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is therefore in such a case as this deemed more safe to permit it to go to the jury, subject, as all testimony is, to the animadversion of the court, than entirely to exclude it.

We come next to consider the charge delivered to the jury.

The errors alleged in this charge may be considered under two heads:

1st. In construing the patent to be solely for the general result produced by the combination of all the machinery, and not for the several improved machines, as well as for the general result.

2d. That the jury must find for the defendant, if they

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should be of opinion, that the hopper boy was in use prior to the invention of the improvement thereon by Oliver Evans.

The construction of the patent must certainly depend on the words of the instrument. But where, as in this case, the words are ambiguous, these may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. But before we proceed to this investigation, it may not be improper to notice the extent of the authority under which this grant was issued.

The authority of the executive to make this grant is derived from the general patent law and from the act for the relief of Oliver Evans. On the general patent law alone, a doubt might well arise whether improvements on different machines could regularly be comprehended in the same patent so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination. And if such a patent would be irregular, it would certainly furnish an argument of no inconsiderable weight against the construction. But the "act for the relief of Oliver Evans" entirely removes this doubt. That act authorizes the Secretary of State to issue a patent granting to the said Oliver Evans the full and exclusive right in his invention, discovery, and improvements in the art of manufacturing flour and in the several machines

which he has invented, discovered, improved, and applied to that purpose.

Of the authority, then, to make this patent coextensive with the construction for which the plaintiff's counsel contends there can be no doubt.

The next object of inquiry is the intention of the parties so far as it may be collected from sources to which it is allowable to resort.

The parties are the government, acting by its agents, and Oliver Evans.

The intention of the government may be collected from the "act for the relief of Oliver Evans." That act not only confers the authority to issue the grant, but expresses the intention of the legislature respecting its extent. It may fairly be inferred from it that the legislature intended the patent to include both the general result, and the particular improved machines, if such should be the wish of the applicant. That the executive officer intended to make the patent coextensive with the application of Oliver Evans, and with the special act, is to be inferred from the reference to both in the patent itself. If, therefore, it shall be satisfactorily shown from his application to have been the intention of Oliver Evans to obtain a patent including both objects, that must be presumed to have been also the intention of the grantor.

The first evidence of the intention of Oliver Evans is furnished by the act for his relief. The fair presumption is that it conforms to his wishes -- at least that it does not transcend them.

The second is his petition to the Secretary of State,

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which speaks of his having discovered certain useful improvements, and prays a patent for them, "agreeably to the act of Congress, entitled, an act for the relief of Oliver Evans." This application is for a patent coextensive with the act.

This intention is further manifested by his specification. It is not to be denied that a part of this specification would indicate an intention to consider the combined operation of all his machinery as a single improvement, for which he solicited a patent. But the whole taken together, will not admit of this exposition. The several machines are described with that distinctness which would be used by a person intending to obtain a patent for each. In his number 4 which contains the specification of the drill, he asserts his claim, in terms, to the principles, and to all the machines he had specified, and adds

"they may all be united and combined in one flour mill, to produce my improvement in the art of manufacturing flour complete, or they may be used separately for any

of the purposes specified and allotted to them, or to produce my improvement in part, according to the circumstances of the case."

Being entitled by law to a patent for all and each of his discoveries; considering himself, as he avers in his specification and affirmation, as the inventor of each of these improvements; understanding, as he declares he did, that they might be used together so as to produce his improvement complete, or separately, so as to produce it in part; nothing can be more improbable than that Oliver Evans intended to obtain a patent solely for their combined operation. His affirmation,

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which is annexed to his specification, confirms this reasoning. To the declaration that he is the inventor of these improvements, he adds, "for which he solicits a patent."

With this conviction of the intention with which it was framed, the instrument is to be examined.

The patent begins with a recital that Oliver Evans had alleged himself to be the inventor of a new and useful improvement in the art of manufacturing flour, &c.;, by the means of several machines, for a description of which reference is made to his specification.

It will not be denied that if the allegation of Oliver Evans was necessarily to be understood as conforming to this recital, if our knowledge of it was to be derived entirely from this source, the fair construction would be that his application was singly for the exclusive right to that improvement which was produced by the combined operation of his machinery. But in construing these terms, the court is not confined to their most obvious import. The allegation made by Oliver Evans, and here intended to be recited, is in his petition to the Secretary of State. That petition is embodied in and becomes a part of the patent. It explains itself and controls the words of reference to it. His allegation is not "that he has invented a new and useful improvement," but that he has discovered certain useful improvements. The words used by the Department of State in reciting this

allegation must then be expounded by the allegation itself, which is made a part of the patent.

The recital proceeds "which improvement has not been known," &c.; These words refer clearly to

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the improvement first mentioned and alleged in the petition of Oliver Evans, and are of course to be controlled in like manner with the antecedent words, by that petition. This part of the recital is concluded by adding that Oliver Evans has affirmed that he does verily believe himself to be the true inventor or discoverer of the said improvement.

But the affirmation of Oliver Evans, like his petition, is embodied in the grant, and must of course expound the recital of it. That affirmation is that he does verily believe himself to be the true and original inventor of the improvements contained in his specification.

In every instance, then, in which the word improvement is used in the singular number throughout the part of recital of this patent, it is used in reference to a paper contained in the body of the patent, which corrects the term and shows it to be inaccurate.

The patent, still by way of recital, proceeds to add

"and agreeably to the act of Congress, entitled 'An act for the relief of Oliver Evans,' which authorizes the Secretary of State to secure to him by patent the exclusive right to the use of such improvement in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose; he has paid into the Treasury, &c.;, and presented a petition to the Secretary of State signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose. "

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To what do the words "said improvement" relate? The answer which has been given at the bar is entirely correct. To the improvement mentioned in the statute and in the petition, to both of which direct reference is made. But in the statute and in the petition, the word used is "improvements," in the plural. The patent therefore obviously affixed to the word "improvement," in the singular, the same sense in which the plural is employed, both in the statute and in the petition. We are compelled from the whole context so to construe the word in every place in which it is used in the recital, because it is constantly employed with express reference to the act of Congress, or to some document embodied in the patent, in each of which the plural is used.

When, then, the words "said improvement" are used as a term of grant, they refer to the words of the recital, which have been already noticed, and must be construed in the same sense. This construction is rendered the more necessary by the subsequent words, which refer for a description of the improvement to the schedule. It also derives some weight from the words "according to law," which are annexed to the words of grant. These words can refer only to the general patent law and to the "act for the relief of Oliver Evans." These acts, taken together, seem to require that the patent should conform to the specification, affirmation, and petition of the applicant.

It would seem as if the claim of Oliver Evans was rested at the circuit court on the principle that a grant for an improvement, by the combined operation

of all the machinery, necessarily included a right to the distinct operation of each part, inasmuch as the whole comprehends all its parts. After very properly rejecting this idea, the judge appears to have considered the Department of State, and the patentee, as having proceeded upon it in making out this patent. He supposed the intention to be, to convey the exclusive right in the parts as well as in the whole, by a grant of the whole; but as the means used are in law incompetent to produce the effect, he construed the grant according to his opinion of its legal operation.

There is great reason in this view of the case, and this Court has not discarded it without hesitation. But as to the grant, with the various documents which form a part of it, would be contradictory to itself, as these apparent contradictions are all reconciled by considering the word "improvement" to be in the plural instead of the singular number, as it is apparent that this construction gives to the grant its full effect, and that the opposite construction would essentially defeat it, this Court has, after much consideration and doubt, determined to adopt it, as the sound exposition of the instrument.

The second error alleged in the charge is in directing the jury to find for the defendant if they should be of opinion that the hopper boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements

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it is a grant for the hopper boy itself, and not for an improvement on the hopper boy.

The counsel for the plaintiff contends that this part of the charge is erroneous because, by the "act for the relief of Oliver Evans," Congress has itself decided that he is the inventor of the machines for which he solicited a patent, and has left that point open to judicial inquiry.

This Court is not of that opinion. Without inquiring whether Congress, in the exercise of its power "to secure for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries" may decide the fact that an individual is an author or inventor, the court can never presume Congress to have decided that question in a general act, the words of which do not render such construction unavoidable. The words of this act do not require this construction. They do not grant to Oliver Evans the exclusive right to use certain specified machines, but the exclusive right to use his invention, discovery, and improvements, leaving the question of invention and improvement open to

investigation, under the general patent law.

The plaintiff has also contended that it is not necessary for the patentee to show himself to be the first inventor or discoverer. That the law is satisfied by his having invented a machine, although it may have been previously discovered by some other person.

Without a critical inquiry into the accuracy with which the term invention or discovery may be applied to any other than the first inventor, the Court

considers this question as completely decided by the 6th section of the general patent act. That declares that if the thing 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, judgment shall be rendered for the defendant and the patent declared void.

Admitting the words "originally discovered" to be explained or limited by the subsequent words, still if the thing had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void. It may be that the patentee had no knowledge of this previous use or previous description; still his patent is void; the law supposes he may have known it, and the charge of the judge, which must be taken as applicable to the testimony, goes no further than the law.

The real inquiry is does the patent of Oliver Evans comprehend more than he has discovered? If it is for the whole hopper boy, the jury has found that this machine was in previous use. If it embraces only his improvement, then the verdict must be set aside.

The difficulties which embarrass this inquiry are not less than those which were involved in the first point. Ambiguities are still to be explained, and contradictions to be reconciled.

The patent itself, construed without reference to the schedule and other documents to which it refers, and which are incorporated in it, would be a grant of a single improvement; but construed with those

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documents, it has been determined to be a grant of the several improvements which he has made in the machines enumerated in his specification. But the grant is confined to improvements. There is no expression in it which extends to the whole of any one of the machines which are enumerated in his specification or petition. The difficulty grows out of the complexity and ambiguity of the specification and petition. His schedule states his first principle to be the operation of his machinery on the meal from its being ground until it is bolted. He adds "this principle I apply by various machines, which I have invented, constructed, and adapted to the purposes hereafter specified,"

His second principle is the application of the power that moves the mill to his machinery.

The application of these principles, he says, to manufacturing flour, is what he claims as his invention or improvement in the art.

He asserts himself to be the inventor of the machines and claims the application of these principles, to the improvement of the process of manufacturing flour, and other purposes, as his invention and improvement in the art.

The schedule next proceeds to describe the different machines as improved, so as to include in the description the whole machine, without distinguishing his improvement from the machine as it existed previous thereto, and in his fourth number he says,

"I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them. "

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If the opinion of the court were to be formed on the schedule alone, it would be difficult to deny that the application of Oliver Evans extended to all the machines it describes. But the schedule is to be considered in connection with the other documents incorporated in the patent.

The affirmation which is annexed to it avers that he is the inventor not of the machines, but of the improvements herein above specified.

In his petition, he states himself to have discovered certain useful improvements, applicable to the art of manufacturing flour, and prays a patent for same -- that is, for his improvements, agreeably to the act of Congress, entitled, "an act for the relief of Oliver Evans." After stating the principles as in his schedule, he adds, "the machinery consists of an improved elevator, an improved conveyor, an improved hopper boy, an improved drill, and an improved kiln dryer."

Although in his specification he claims a right to the whole machine, in his petition he only asks a patent for the improvements in the machine. The distinction between a machine and an improvement one a machine or an improved machine is too clear for them to be confounded with each other.

The act of Congress agreeably to which Evans petitions for a patent authorizes the Secretary of State to issue one for his improvements in the art of manufacturing flour, "and in the several machines which he has invented, discovered, improved, and applied to that purpose."

In conformity with this act, this schedule, and this petition, the Secretary of State issues his patent, which, in its terms, embraces only improvements. Taking the whole together, the Court is of opinion that the patent is to be constructed as a grant of the general result of the whole machinery and of the improvement in each machine. Great doubt existed whether the words of the grant, which are expressed to be for an improvement to improvements only, should be understood as purporting to be a patent only for improvements, or should be so far controlled by

the specification and petition as to be considered as a grant for the machine as improved, or in the words of the schedule and petition, for "an improved elevator, an improved conveyor, an improved hopper boy, an improved drill, and an improved kiln dryer." The majority of the Court came at length to the opinion that there is no substantial difference, as they are used in this grant, whether the words grant a patent for an improvement on a machine or a patent for an improved machine, since the machine itself, without the improvement, would not be an improved machine. Although I did not concur in this opinion, I can perceive no inconvenience from the construction.

It is, then, the opinion of this Court that Oliver Evans may claim, under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered.

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In all cases where his claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.

Some doubts have been entertained respecting the jurisdiction of the courts of the United States, as both the plaintiff and defendant are citizens of the same state. The 5th section of the act to promote the progress of useful arts, which gives to every patentee a right to sue in a circuit court of the United States in case his rights be violated, is repealed by the 3d section of the Act of 1800, ch. 179, which gives the action in the circuit court of the United States where a patent is granted "pursuant" to that act or to the act for the promotion of useful arts. This patent, it has been said, is granted not in pursuance of either of those acts, but in pursuance of the act "for the relief of Oliver Evans." But this Court is of opinion that the act for the relief of Oliver Evans is engrafted on the general act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the Court is therefore sustained.

As the charge delivered in the circuit court to the jury differs in some respects from this opinion, the judgment rendered in the court is reversed and annulled and the cause remanded to the circuit court with directions to award a *venire facias de novo* and to proceed therein according to law.

Judgment reversed.

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JUDGMENT. This cause came on to be heard on the transcript of the record of the Circuit Court for the District of Pennsylvania, and was urged by counsel. On consideration whereof this Court is of opinion that there is error in the proceedings of the said circuit court in this, that the said court rejected testimony which ought to have been admitted, and also in this, that in the charge delivered to the jury, the opinion is expressed that the patent on which this suit was instituted conveyed to Oliver Evans only an exclusive right to his improvement in manufacturing flour and meal produced by the general combination of all his machinery, and not to his improvement in the several machines applied to that purpose, and also that the said Oliver Evans was not entitled to recover if the hopper boy in his declaration mentioned had been in use previous to his alleged discovery. Therefore it is considered by this Court that the judgment of the circuit court be reversed and annulled and that the cause be remanded to the said circuit court with directions to award a *venire facias de novo.*

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