**Evans Vs. Eaton**

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**Appeal No.** : 20 U.S. 356

**Appellant** : Evans

**Respondent** : Eaton

**Judgement** :

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U.S. Supreme Court Evans v. Eaton, 20 U.S. 7 Wheat. 356 356 (1822)

**Evans v. Eaton**

**20 U.S. (7 Wheat.) 356**

*ERROR TO THE CIRCUIT*

*COURT OF PENNSYLVANIA*

## SYLLABUS

A party cannot entitle himself to a patent for more than his own, invention, and if the patent be for the whole of a machine, he can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation.

If the same combination existed before in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery or some improved mode of operation to the old, the patent should be limited to such improvement, for if it includes the whole machine, it includes more than his invention, and therefore cannot be supported.

When the patent is for an improvement, the nature and extent of the improvement must be stated in the specification, and it is not sufficient that it be made out and shown at the trial or established by comparing the machine specified in the patent with former machines in use.

The former judgment of this Court in the same case, 16 U. S. 3 Wheat. 454, commented on, explained, and confirmed.

A person having an interest only in the question, and not in the event of the suit, is a competent witness.

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

This is the same case which was formerly before this Court and is reported at 16 U. S. 3 Wheat. 454, and by a reference to that report, the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause was now again brought before the Court upon a writ of error to the judgment of the circuit court, rendered upon the new trial had in pursuance of the mandate of this Court.

Upon the new trial, several exceptions were taken



by the counsel for the plaintiff Evans. The first was to the admission of one Frederick as a witness for the defendant, upon the ground of his interest in the suit. The witness, on his examination on the *voir dire,* denied that he had any interest in the cause or that he was bound to contribute to the expenses of it. He

said that he had not a Hopperboy in his mill at present, it being then in court, that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia, and that his Hopperboy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the court.

Another exception was to the refusal of the court to allow the deposition of one Shetter to be read in evidence by the plaintiff, which had been taken according to a prevalent practice of the state courts instead of being taken pursuant to the provisions of the act of Congress.

But the principal exceptions were to the charge by the circuit court in summing up the cause to the jury, which it is deemed necessary here to insert at large.

"MR. JUSTICE WASHINGTON. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be,"

"1. For the whole of the machine employed in the manufacture of flour, called the Hopperboy."

"2. For an improvement on the Hopperboy."

"The question is, is the plaintiff entitled to recover upon either of these claims? The question is stated

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thus singly because the defendant admits that he uses the very Hopperboy for which the patent is, in part, granted, and justifies himself by insisting"

"1st. That the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent, the Hopperboy, as patented."

"2d. That his patent for an improvement is bad because the nature and extent of the improvement is not stated in his specification, and if it had been, still the patent

comprehends the whole machine, and is therefore too broad."

"1st. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the description which the plaintiff has given of this machine in his specification, a model of which is now before you. Its parts are (1) an upright round shaft to revolve on a pivot in the floor; (2) a leader or upper arm; (3) an arm set with small inclining boards, called flights and sweepers; (4) cords from the leader to the arm to turn it; (5) a weight passing over a pulley, to keep the arm tight on the meal; (8) a log at the top of the shaft to turn it, which is operated upon by the water power of the mill."

"The flights are so arranged as to track the one below the other and to operate like ploughs, and at every revolution of the machine to give the meal two turns towards the center. The sweepers are to receive the meal from the elevator and to trail it round the circle for the flights to gather it to the center, and also to sweep the meal into the bolt. "

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"The use of this machine is stated to be to spread any granulated substance over a floor, to stir and expose it to the air, to dry and cool it, and to gather it to the bolt."

"The next inquiry under this head is when was this discovery made? Joseph Evans has sworn that in 1783, the plaintiff informed him that he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind sometime in July of that year. In 1784 he constructed a rough model of the Hopperboy, but having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn around the arm by hand. In 1785 he set up a Hopperboy in his mill resembling the model in court and the machine described in his specification. The evidence of Mr. Anderson strongly supports this witness, and indeed the discovery as early as 1784 or 1785 is scarcely controverted by the defendant."

"The defendant insists that a Hopperboy similar to the plaintiff's was discovered and in use many years anterior even to the year 1783, and relies upon the

testimony of the following witnesses: "

"Daniel Stouffer, who deposes that he first saw the Stouffer Hopperboy in his father's, Christian Stouffer's mill, in the year 1764. In the year 1775 or 1776 he erected a similar one in the mill of his brother Henry and another in Jacob Stouffer's mill in 1777, 1778, or 1779. "

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"Philip Frederick swears that in 1778 he saw a Stouffer Hopperboy in operation in Christian Stoutfer's mill, and in the year 1783 he saw one in Jacob Stouffer's mill and another in U. Charles' mill, and that it was always called Stouffer's machine."

"George Roup stated that in 1784 he erected one of these Hopperboys in the mill of one Braniwar, and that in 1782 Abraham Stouffer described to him a similar machine, which his father used in his mill."

"Christopher Stouffer, the son of Christian, has sworn, that his father, having enlarged his mill in the year 1780, erected a new Hopperboy of the description above mentioned, which is still in use in the same mill, now owned by Peter Stouffer."

"If these witnesses are believed by the jury, they establish the fact asserted by the defendant that the Stouffer Hopperboy was in use prior to the plaintiff's discovery."

"The next inquiry is into the parts, operation, and use of the Stouffer Hopperboy. This consists of an upright square shaft which passes lightly through a square mortice in an arm, underneath which are fixed slips of wood, called flights, and the arm is turned by a log on the upper end of it, which is moved by the power which moves the mills."

"The arm, with the flights, operates as it turns upon the meal placed below it, and its use is in a degree to cool the meal and to conduct it to the bolt. It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars. They each consist of a shaft or log to turn it by the power of the mill, and an arm

with flights on the under side of it. They each operate on the mill below the arm to cool, dry, and conduct it to the bolt."

"In what do they differ? The plaintiff's shaft is round, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords which connect the extremities of the arm to those of the leader. The shaft of the Stouffer Hopperboy is square, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are, and consequently it does not, in the opinion of most of the witnesses, cool or prepare the flour for packing as well as the plaintiff's."

"The question of law now arises, which is are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the Hopperboy as the original inventor of it? I take the rule to be, and so it has been settled in this and in other courts, that if the two machines be substantially the same and operate in the same manner to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle, and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted because he cannot be considered as the original inventor of the machine. If the alleged inventor of a machine which differs from another previously patented merely in form and proportion,



but not in principle, is not entitled to a patent for an improvement, which he cannot be by the 2d section of the law, he certainly cannot in a like case claim a patent for the machine itself."

"The question for the jury, then, is are the two Hopperboys substantially the same in principle?, not whether the plaintiff's Hopperboy is preferable to the other. Because if that superiority amounts to an improvement, he is entitled to a patent only for an improvement, and not for the whole machine. In the latter case, the

patent would be too broad, and therefore void when the patent is single."

"If you are of opinion that the plaintiff is not the original inventor of the Hopperboy, he cannot obtain a verdict on that claim unless his is an excepted case. The 1st, 2d, 3d, and 6th sections of the general patent law conclusively support this opinion. But the judgment of the Supreme Court in this case is relied upon by the plaintiff's counsel to prove that this is an excepted case insomuch that the plaintiff is entitled to a verdict although you should be satisfied that he is not the original inventor of the Hopperboy. But we are perfectly satisfied that the interpretation put upon the last clause of the judgment by the plaintiff's counsel is incorrect, and that for the following reasons."

"1. The question of priority of invention was not before the Supreme Court, and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point. The error in the charge which



this part of the judgment was obviously intended to correct is stated by THE CHIEF JUSTICE in the following words: "

"The second error alleged in the charge is in directing the jury to find for the defendant if it should be of opinion that the Hopperboy 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, it is a grant for the Hopperboy itself, and not for an improvement on the Hopperboy."

"It contradicts what is [elsewhere] stated, where it is said that the plaintiff's claim is to the machine 'which he has invented,' &c.; Now if he did not invent the Hopperboy, he has no claim to it, and if so, could the court mean to say that he was nevertheless entitled to recover under that claim? Such a decision was certainly not called for by the terms of the 'act for the relief of Oliver Evans,' but would seem to be in direct violation of it. The act directs a patent to issue to Oliver

Evans not for his Hopperboy, elevator, &c.;, but 'for his invention, discovery, and improvement in the art, &c.;, and on the several machines which he has discovered, invented, and improved.' Now if the Hopperboy was not invented, &c.;, by O.E., this act, without which O.E. could not have obtained a patent, did not authorize the Secretary of State to grant him one for that machine, or if granted it is clear that it was

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improvidently done. If indeed the Supreme Court had been of opinion, that the fact of Oliver Evans' prior invention was decided, and could constitutionally have been decided by Congress, there might have been more difficulty in the case; but the argument of counsel, which pressed that point upon the Court, was distinctly repudiated. We conceive that the meaning of that part of the opinion is that this Court erred in stating to the jury that O. Evans was not entitled to recover, if the Hopperboy (that is the original Hopperboy) had been in use prior to the plaintiff's alleged discovery of it, because if the plaintiff was entitled to claim an improvement on the Hopperboy, which this Court had denied and which the Supreme Court affirmed, this Court was clearly wrong in saying to the jury that the plaintiff could not recover for his improvement, which in effect was said. Upon the whole, then, the court is of opinion that O. Evans is not entitled to a verdict in his favor as the inventor of the Hopperboy; if you should be of opinion that another Hopperboy, substantially the same as his in principle, as before explained, up to the point where any alteration or improvement exists in his Hopperboy, was invented and in use prior to the plaintiff's invention or discovery, however they may differ in mere form, proportions, and utility."

"2d. The plaintiff's next claim is to an improvement on a Hopperboy, which claim, we were of opinion in another case, has received the sanction of the Supreme Court. His counsel contend that his improvement is (1) on the original method of supplying the

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bolt by manual labor, (2) on his own Hopperboy, and (3) on some Hopperboy invented by some other person. Let this position be analyzed."

"1. It is said to be an improvement on the original method by manual labor. But it is obvious that if this be the invention, it is of an original machine, because wherever the patent law speaks of an improvement, it is on some art, machine or manufacture, &c.;, and not on manual labor which was applied to the various arts long before the invention of machinery to supply its place."

"2. An improvement on his own discovery."

"But where is the evidence of such invention? It is true that Joseph Evans has stated that the plaintiff constructed, in 1784, a rude model of a Hopperboy; but it was no substitute for manual labor, because without the cords or leading lines, the arm could not move, and it was therefore turned by hand. It was, in fact, in an incomplete state, in progress to its completion, but not given out or prepared to be given out to the world as a machine before 1785, when the cords to turn the arm were added."

"3. An improvement on a former machine."

"This is a fair subject for a patent, and the plaintiff has laid before you strong evidence to prove that his Hopperboy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is that the plaintiff's patent for an improvement is void because

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the nature and extent of his improvements are not stated in his specification."

"The patent is for an improved Hopperboy, as described in the specification, which is referred to, and made part of the patent. Now does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention, the machine,

the peculiar properties or principles of it, *viz.,* the spreading, turning, and gathering the meal, and the rising and lowering of its arm, by its motion to accommodate itself to the meal under it. But does this description designate the improvement or in what it consists? Where shall we find the original Hopperboy described either as to its construction, operation, or use or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is that the specification communicates no information whatever upon any of these parts. This being so, the law as to ordinary cases is clear that the plaintiff cannot recover for an improvement. The 1st section of the general patent law speaks of an improvement as an invention, and directs the patent to issue for this said invention. The 3d section requires the applicant to swear or affirm that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent, and further that he shall deliver a written description of his invention in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use

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the same, &c.; That it is necessary to the validity of a patent that the specification should describe in what the improvement consists is decided by MR. JUSTICE STORY in the cases referred to in the appendix to 3 Wheat. and in the cases of *Bombon v. Bule, Boville v. Poor, McFarlane v. Price, Harmer v. Playne,* and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against an unintentional infringement of the patent during its continuance and to enable an artist to make the improvement by a reference to some known and certain authority to be found among the records of the office of the Secretary of State after the patent has run out. But it is contended by the plaintiff's counsel that the law would be unreasonable to require, and that it does not require this to be done, unless the improvement is upon a patented machine, a description of which can be obtained by a reference to the records of the Secretary of State's office; that it might often be impossible for the patentee to discover and consequently to describe the parts of a machine in use perhaps only

in some obscure part of the world. The answer to this is that an improvement necessarily implies an original, and unless the patentee is acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement."

"If he knows nothing of an original, then his invention is an original, or nothing, and the subsequent appearance of an original to defeat his patent is one of the risks which every patentee is exposed to under

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our law. As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases, the improvement must be described, but with this difference -- that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine and then to state in what the improvements or such original consists, whereas in the latter case it would be necessary to describe the original machine and also the improvement. The reason for this distinction is too obvious to need explanation."

"If the general law upon this subject has been correctly stated, the next question is is this an excepted case? It is contended by the plaintiff that it is so, 1st, in virtue of the act for the relief of O.E., and 2d, by the decision of the Supreme Court."

"1. Under the private act. That declares that the patent is to be granted in the manner and form prescribed by the general patent law. What constitutes the manner and form in which a patent is granted by the law? The obvious answer is the petition -- the patent, with the signature of the President and the seal of the United States affixed to it -- the oath or affirmation -- the specification, or description of the invention, as required by the 3d section -- the drawings and models, if required. Will it be contended that a patent would be granted in the manner and form prescribed by this law if there were no description whatever of the invention? And if it would not, which is taken for granted, where is the difference between the total absence of a specification and one which has no

reference

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at all to the invention for which the patent is granted?"

"This is not the case of an imperfect or obscure description, but of one which relates exclusively to the whole machine, whereas the invention for which the patent is granted is for an improvement."

"2. The opinion of the Supreme Court, which states"

"that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists."

"But how is it to be shown? The court has not pointed out the manner, and we therefore think the only fair implication is that it must be shown as the statute of the United States and the general principles of law require -- *i.e.* by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff's counsel contend it may, then it may be fairly asked *cui bono?* which sort of a showing would then be, so far as it would be productive of any useful purpose? As to the defendant, the evidence comes too late to save him from the consequences of an error innocently committed. As to the public at large with a view to caution, during the continuance of the patent, and to information of the nature of the improvement after its termination, the evidence given in this cause must be evanescent and totally useless."

"We feel perfectly convinced that the meaning of the Supreme Court as to this point is again misunderstood by the plaintiff's counsel, not only for the reasons above mentioned, but because the extent and

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construction of the plaintiff's patent, and not the validity of it, in relation to any one of the machines, were the questions before that Court, and none others (in

reference to the charge) were argued at the bar or reasoned upon by THE CHIEF JUSTICE, in delivering the opinion."

"Upon the whole, we are of opinion, that the plaintiff is not entitled to a verdict for the alleged infringement of his patent, for an improvement of the Hopperboy."

Whereupon a verdict and judgment thereon were rendered for the defendant in the circuit court, and the cause was again brought by writ of error to this Court.

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MR. JUSTICE STORY delivered the opinion of the Court.

This is the same case which was formerly before

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this Court and is reported in 16 U. S. 3 Wheat. 454, and by a reference to that report, the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause now comes before us upon a writ of error to the judgment of the circuit court rendered upon the new trial had in pursuance of the mandate of this Court.

Upon the new trial several exceptions were taken by the counsel for the plaintiff. The first was to the admission of a Mr. Frederick as a witness for the defendant. It is to be observed that the sole controversy between the parties at the new trial was whether the plaintiff was entitled to recover for an alleged breach of his patent by the defendant in using the improved Hopperboy. Frederick, in his examination on the *voir dire,* denied that he had any interest in the cause or that he was bound to contribute to the expenses of it. He said he had not a Hopperboy in his mill at present, it being then in court, that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia, and that his Hopperboy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting chest. Upon this evidence the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the court. It does not

appear from this examination whether the Hopperboy used by Frederick was that improved by the plaintiff or not, but assuming it was, we are of opinion that the witness was

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rightly admitted. It is perfectly clear, that a person having an interest only in the question, and not in the event of the suit, is a competent witness; and in general the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him. If nothing had been in controversy in this case as to the validity of the patent itself, and the general issue only had been pleaded, the present objection would have fallen within the general rule. But the special notice in this case asserts matter which, if true and found specially by the jury, might authorize the court to adjudge the patent void, and it is supposed that this constitutes such an interest in Frederick in the event of the cause that he is thereby rendered incompetent. But in this respect Frederick stands in the same situation as every other person in the community. If the patent is declared void, the invention may be used by the whole community, and all persons may be said to have an interest in making it public property. But this results from a general principle of law that a party can take nothing by a void patent, and so far as such an interest goes, we think it is to the credit, and not to the competency, of the witness. It is clear that the verdict in this case, if given for Evans, would not be evidence in a suit against Frederick, but Frederick would be entitled to contest every step in the cause in the same manner as if no such suit had existed. *Non constat* that Frederick himself will ever be sued by the plaintiff, or that if

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sued, any recovery can be had against him, even if the plaintiff's patent should not be avoided in this suit. It therefore rests in remote contingencies whether Frederick will under any circumstances have an interest in the event of this suit, and the law adjudges the party incompetent only when he has a certain, and not a contingent

interest. It has been the inclination of courts of law in modern times generally to lean against exceptions to testimony. This is a case which may be considered somewhat anomalous, and we think it safest to admit the testimony, leaving its credibility to the jury.

Another exception was to the refusal of the court to allow a deposition to be read by the plaintiff which had been taken according to a prevalent practice of the state courts. It is not pretended that the deposition was admissible according to the positive rules of law or the rules of the circuit court, and it is not now produced so that we can see what were the circumstances under which it was taken. No practice, however convenient, can give validity to depositions which are not taken according to law or the rules of the circuit court unless the parties expressly waive the objection or by previous consent agree to have them taken and made evidence. This objection therefore may at once be dismissed.

The principal arguments, however, at the bar have been urged against the charge given by the circuit court in summing up the cause to the jury. The charge is spread *in extenso* upon the record, a practice which is unnecessary and inconvenient and may give rise to minute criticisms and observations

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upon points incidentally introduced for purposes of argument or illustration, and by no means essential to the merits of the cause. In causes of this nature, we think the substance only of the charge is to be examined, and if it appears upon the whole that the law was justly expounded to the jury, general expressions which may need and would receive qualification if they were the direct point in judgment are to be understood in such restricted sense.

It has been already stated that the whole controversy at the trial turned upon the use of the plaintiff's Hopperboy, and no other of the inventions included in his patent was asserted or supposed to be pirated by the defendant.

The plaintiff, with a view to the maintenance of his suit, contended that his patent, so far as respected the Hopperboy, had a double aspect. 1. That it was to be as a

patent for the whole of the improved Hopperboy -- that is of the whole machine as his own invention. 2. That if not susceptible of this construction, it was for an improvement upon the Hopperboy, and he was entitled to recover against the defendant for using his improvement. The defendant admitted that he used the improved Hopperboy, and put his defense upon two grounds: 1. that if the patent was for the whole machine, *i.e.* the improved Hopperboy, the plaintiff was not the inventor of the improved Hopperboy so patented; 2. that if the patent was for an improvement only upon the Hopperboy, the specification did not describe the nature and extent of the improvement,

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and if it did, still the patent comprehended the whole machine, and was broader than the invention. To the examination of these points and summing up the evidence the attention of the circuit court was exclusively directed, and the question is whether the charge in respect to the matters of law involved in these points was erroneous to the injury of the plaintiff.

We will consider the points in the same order in which they were reviewed by the circuit court. Was the patent of the plaintiff, so far as respects his improved Hopperboy, a patent for the whole machine as his own invention? It is not disputed that the specification does contain a good and sufficient description of the improved Hopperboy and of the manner of constructing it, and if there had been any dispute on this subject, it would have been matter of fact for the jury, and not of law for the decision of the court. The plaintiff, in his specification, after describing his Hopperboy, its structure, and use, sums up his invention as follows:

"I claim as my invention the peculiar properties or principles which this machine possesses in the spreading, turning, and gathering the meal at one operation and the rising and lowering of its arms by its motion to accommodate itself to any quantity of meal it has to operate upon."

From this manner of stating his invention, without any other qualification, it is apparent that it is just such a claim as would be made use of by the plaintiff if the

whole machine was substantially in its structure and combinations new. The plaintiff does not state

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it to be a specific improvement upon an existing machine, confining his claim to that improvement, but as an invention substantially original. In short, he claims the machine as substantially new in its properties and principles, that is to say in the *modus operandi.* If this be true, and this has been the construction strongly and earnestly pressed upon this Court by the plaintiff's counsel in the argument at the present term, what are the legal principles that flow from this doctrine?

The Patent act of 21 February, 1793, ch. 11, upon which the validity of our patents generally depends, authorizes a patent to the inventor for his invention or improvement in any new and useful art, machine, manufacture, or composition of matter not known or used before the application. It also gives to any inventor of an improvement in the principle of any machine, or in the process of any composition of matter which has been patented, an exclusive right to a patent for his improvement, but he is not to be at liberty to use the original discovery, nor is the first inventor at liberty to use the improvement. It also declares that simply changing the form or the proportion of any machine or composition of matter in any degree shall not be deemed a discovery. It further provides that on any trial for a violation of the patent, the party may give in evidence, having given due notice thereof, any special matter tending to prove that the plaintiff's specification does not contain the whole truth relative to his discovery, or contains more than is necessary to produce the effect (where the addition or concealment shall appear to have been to

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deceive the public), or that the thing secured by the 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 person's invention, and provides that in either of these

cases, judgment shall be rendered for the plaintiff with costs, and the patent shall be declared void. It further requires that every inventor, before he can receive a patent, shall swear or affirm to the truth of his invention,

"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 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 several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions."

From this enumeration of the provisions of the act it is clear that the party cannot entitled himself to a patent for more than his own invention, and if his patent includes things before known or before in use as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before

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in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery or some improved mode of operation to the old, the patent should be limited to such improvement, for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported. This is the view of the law on this point which was taken by the circuit court. That court went into a full examination of the testimony, and also of the structure of Evans' Hopperboy, and Stouffer's Hopperboy, and left it to the jury to decide whether, up to a certain point, the two machines were or were not the same in principle. If they were the same in principle and merely differed in form and proportion, then it was declared that the plaintiff was not entitled to recover, or, to use the language of the court, if the jury was of opinion that the plaintiff was not

the inventor of the Hopperboy, he was not entitled to recover unless his was a case excepted from the general operation of the act. We perceive no reason to be dissatisfied with this part of the charge; it left the fact open for the jury and instructed it correctly as to the law. And the verdict of the jury negatived the right of the plaintiff as the inventor of the whole machine.

The next inquiry before the circuit court was whether the plaintiff's case was excepted from the general operation of the act. Upon that it is unnecessary to say more than that the point was expressly decided by this Court in the negative upon the former writ of error. And we think the opinion of this Court delivered on that occasion is correctly understood

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and expounded by the circuit court. It could never have been intended by this Court to declare, in direct opposition to the very terms of the patent act, that a party was entitled to recover although he should be proved not to have been the inventor of the machine patented, or that he should be entitled to recover notwithstanding the machine patented was in use prior to his alleged discovery. There is undoubtedly a slight error in drawing up the judgment of the court upon the former writ of error, but it is immediately corrected by an attentive perusal of the opinion itself. And we do not think that it can be better stated or explained than in the manner in which the circuit court has expounded it.

We are then led to the examination of the other point of view in which the plaintiff's counsel have attempted to maintain this patent. That is, by considering it not as a patent for the whole of the machine or improved Hopperboy, but as an improvement of the Hopperboy. Considered under this aspect, the point presents itself which was urged by the defendant's counsel, *viz.,* that if it be a patent for an improvement, it is void because the nature and extent of the improvement is not stated in the specification. The circuit court went into an elaborate examination of the law applicable to this point and into a construction of the terms of the patent itself, and came to the conclusion that no distinct improvement was specified in the patent, that such specification was necessary in a patent for an improvement, and

that for this defect the plaintiff was not entitled to recover, supposing his patent to be for an improvement

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only of an existing machine. It may be justly doubted whether this point at all arises in the cause, for the very terms of the patent, as they have been already considered and as they have been construed at the bar by the plaintiff's counsel at the present argument, seem almost conclusively to establish that the patent is for the whole machine -- that is, for the whole of the improved Hopperboy, and not for a mere improvement upon the old Hopperboy. But waiving this point, can the doctrine asserted at the bar be maintained, that no specification of an improvement is necessary in the patent, and that it is sufficient if it be made out and shown at the trial, or may be established by comparing the machine specified in the patent with former machines in use? That there is no specification of any distinct improvement in the present patent is not denied; that the patent is good without it is the subject of inquiry. Let this be decided by reference to the patent act.

The third section of the patent act requires, as has been already stated, that the party

"shall deliver a written description of his invention 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, &c.;, to make, compound, and use the same."

The specification, then, has two objects -- one is to make known the manner of constructing the machine (if the invention is of a machine) so as to enable artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration

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of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not is not material to the present inquiry. The other object of the specification is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is therefore for the purpose of warning an innocent purchaser or other person using a machine of his infringement of the patent, and at the same time of taking from the inventor the means of practicing upon the credulity or the fears of other persons by pretending that his invention is more than what it really is or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. Nothing can be more direct than the very words of the act. The specification must describe the invention "in such full, clear, and distinct terms as to distinguish the same from all other things before known." How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is nor state in what it consists nor how far the invention extends? Which describes the machine fully and accurately, as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification



is indispensable. We do not say that the party is bound to describe the old machine, but we are of opinion that he ought to describe what his own improvement is, and to limit his patent to such improvement. For another purpose, indeed, with the view of enabling artisans to construct the machine, it may become necessary for him to state so much of the old machine as will make his specification of the structure intelligible. But the law is sufficiently complied with in relation to the other point by distinguishing in full, clear, and exact terms the nature and extent of his improvement only.

We do not consider that the opinion of the circuit court differs in any material respect from this exposition of the patent act on this point, and if the plaintiff's patent is to be considered as a patent for an improvement upon an existing Hopperboy, it is defective in not specifying that improvement, and therefore the plaintiff ought not to recover.

Upon the whole, it is the opinion of the majority of the Court that the judgment of the circuit court ought to be

*Affirmed with costs.*

MR. JUSTICE LIVINGSTON dissented.

At this late period, when the patentee is in his grave and his patent has expired a natural death, we are called on to say whether his patent ever had a legal existence, and it may seem not very important to the representatives of the patentee what may be the decision of this Court. But understanding that many other actions are pending for a violation of this part of the patent right, and that infractions have taken place for which actions may yet be commenced, and believing

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that the decision we are about to make will have a very extensive, if not a disastrous bearing on many other patents for improvements and will in fact amount to a repeal of many of them, I have though proper to assign my reasons for dissenting from the opinion just delivered.

In doing this, my remarks will be confined principally to the charge of the court so far as it applies to the claim of Evans for an improvement on a Hopperboy.

I was much struck with the argument of the plaintiff's counsel in favor of the patent's being for an original invention, and not for an improvement; nor would it in my opinion be a forced construction to regard it as a patent for a combination of machines to produce certain results and not for any of the machines nor the different parts of which the whole is composed.

But considering it as a patent for an improvement on a Hopperboy, in which light it had been regarded as well by the circuit as by this Court when this cause was here before, I proceed to examine the charge so far as it relates to this part of the subject.

The court, after stating in what particulars the plaintiff's counsel contended that his improvement consists, which is unnecessary to repeat here, proceeds:

"The plaintiff has laid before you strong evidence to prove that his Hopperboy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been

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raised by the defendant's counsel remains to be considered, which is that the plaintiff's patent for an improvement is void because the nature and extent of his improvement is not stated in the specification."

"The patent is for an improved Hopperboy, as described in the specification, which is referred to and made part of the patent. How does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention the peculiar properties or principles of the machine, *viz.,* the spreading, turning, and gathering the meal and the raising and lowering of its arms by its motion to accommodate itself to the meal under it. But does this description designate the improvement or in what it consists? Where shall we find the original Hopperboy described, either as to its construction, operation, or use or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such originals stated? The undoubted truth is that the specification communicates no information whatever upon any of these points."

After some further reasoning on the subject and showing that the plaintiff's case is not excepted from the general rule of law by the act which was passed for his relief, the court declares that for this imperfection or omission in the specification,

the "plaintiff is not entitled to recover for an alleged infringement of his patent for the improvement on the Hopperboy." This was equivalent to saying that for this defect in the specification, the patent for the improved Hopperboy was void, and

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of course that no action at all, whatever might be the state of the evidence, could be maintained for the use of it. It left nothing as it regarded the improved Hopperboy for the jury to decide. Such is the charge, and it is delivered in terms too plain to be misunderstood.

The objections to it are now to be considered. In doing this, it will be shown

1st. That the specification is not defective, and that although it does not discriminate in what particulars the machine in question does differ from other Hopperboys in use, yet if from the whole of the description, taken together, the machine is specified so minutely and so accurately as to be directly and easily distinguished from all other Hopperboys antecedently known, everything has been done which the law requires, and the patent is good.

2d. That if the specification be vicious in the points mentioned, the patent ought not to be considered as absolutely void, but it is enough, and the public interest is sufficiently guarded, if care be taken that it shall not be extended to create a monopoly in any other machine, which may or may not be mentioned in the patent, which was previously known or in use. And

3d. That if a patent must be set aside for such defect in the specification, it should be left to the jury, on the evidence before it, to decide whether the improvement patented be not set forth with all necessary precision.

1. I have said the specification is not defective.

In determining this question, it would seem but

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natural and just that the validity of a patent granted under a particular act of Congress should be tested by the terms there used and by the decisions of our own courts so far as they are of authority, and that we should be extremely cautious in adopting the rules which have been introduced into other countries and under laws not in every respect like our own, however respectable the tribunals may be which may have prescribed those rules, and this the more especially as most of the decisions in England which are generally cited and seem to have been implicitly followed in this country are of a date long subsequent to the Revolution, and many of them posterior to the passage of the patent laws in this country, and which could not therefore have been in the contemplation of Congress at the time. Besides, there is somewhat of hardship in constantly applying to a patentee in this country adjudications made on a British act of Parliament very unlike our own, and with which decisions he has no means of becoming acquainted until long after a knowledge of them can be of any service. Already have we extended to patents for improvements on old machines several recent decisions in England, although it was long doubted in that country and as late as the year 1776, whether by the act of the 21 James I, c. 3, there could be a patent for an addition only. When the English courts decided in favor of such patents, they also made rules for their construction as cases arose, there being no direct provisions in the statute on the subject. As we have provided by law not only for the security of inventions entirely new, but also for the

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protection of those who may discover any new and useful improvement on any art, machine, &c.;, not known or used before, and have prescribed the terms on which patents under it may be obtained, it would seem, if all those terms are complied with and the invention be really new and useful, that no court can have a right to add any other terms or to require of a patentee anything more than what the law has enjoined on him. Let us now try the patent before us by this rule: the Act of the 21 February, 1793, c. 11, after stating in what cases letters patent for inventions may issue, and how they are to be obtained, requires, *inter alia,* that the inventor, before he receives his patent, shall take a certain oath and shall deliver a written

description of his invention and of the manner of using 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 and use the same. And in the case of a 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 is to accompany the whole with drawings and written references, where the nature of the case admits of it, and a model of his machine, if required by the Secretary of State, is also to be delivered.

In the present case, the patent is for an improved Hopperboy, a particular description of which and its uses will be found in 3 Wheat. 16 U. S. 466 . It is

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not pretended that this machine, if made in conformity with the description given by Mr. Evans, could not in fact be distinguished from everything else before known, when brought into comparison with it, nor that a skillful person, from its description, would not be able to make one like it, which would seem to satisfy every requisition of the law. But the defendant's counsel say this is not enough. It should not only in its organization and aggregate be different from everything else, but every respect in which it differs in its construction or operation from other machines should be minutely stated in the specification -- or in other words that other machines heretofore used for similar purposes should be either described or referred to therein and the differences between the patented machines and those in former use be carefully designated.

The answer to this is that the law does not require it -- that it is impracticable and would be of no use.

We have seen already that the law prescribes no precise form of specification, which would have been impracticable, and imposes no obligation to describe in any particular mode the machine in question. Not a word is said as to showing in

what particulars the improvement patented differs from all other machines for the same purpose then in use. If on the whole description taken together the machine of the plaintiff can be distinguished from other machines when compared with his, the words and the objects of the law are satisfied. The law appears to have nothing else in view in requiring a specification than the instruction

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of the public -- that is, to guard them against a violation of the patented improvement and to enable them, when the letters patent expire, from the specification filed to make a machine similar to the one which had been patented. The only inquiry therefore ought to be whether this obvious intention of the legislature has been answered by the particular specification which may be the subject of litigation, and if enough appears either to prevent a person from encroaching on the right of the patentee or to enable a skillful person to make a machine which shall not only resemble the one patented, but produce the like effect; more ought not to be required. Whether these ends be attained by a particular description of every part of the improved machine or by describing in what respect it differs from other machines can make no difference. The information to the public is as valuable and intelligible, if not more so, in the former case than in the latter. If it be, taken altogether, an improved machine for the purpose of producing certain results, and so described that it may be distinguished from other machines, and that others may be made on the same model, it is a literal compliance with all that the law requires.

If the different parts of the machine and their combination or connection be accurately described or intelligibly set forth, why should it not be supported although no reference be made to other machines dissimilar in construction and which, although applied for the same purpose, are inferior in the beneficial results produced by them. To the objection that it does not precisely appear in

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what the patent Hopperboy differs from those antecedently in use, the answer is, and it ought to be conclusive, that the patentee does not mean to abridge or restrain the public from using those or any other machines, so that they differ from the one described by him and that any mechanic, on having his specification before him, can avoid an interference with his invention. To confine our examination to the only Hopperboy which was produced on this trial, and which was called Stouffer's Hopperboy, and of which a model has been exhibited to the court, together with a model of Evans' improved Hopperboy, can a doubt be entertained for an instant that they are very dissimilar and that any mechanic would not in a moment point out the distinctions between them -- either from the specification or the model -- or that he would not be able to make a Stouffer Hopperboy, or the improved Hopperboy of Evans, as he might be directed; and in like manner he would be able, when brought together, to discriminate between any other Hopperboy and that of Evans, provided they were different, so that those who were desirous of having a Hopperboy, on an old construction, and of not interfering with the rights of Mr. Evans, would labor under no difficulty whatever. But inasmuch as Evans himself has not discriminated or exhibited in his specification all the points of difference between his and other Hopperboys, it is supposed that his patent is for some Hopperboy already in use, as well as for his improvement thereon. The very terms of his specification precluded every supposition of that kind. If there



were a thousand of those machines on different constructions in use before the date of his patent, he leaves to the public the undisturbed enjoyment of them. He meddles not nor does he pretend to interfere with any of them until they make or use one constructed, in all its parts, upon his model. That form and that form alone he claims as his invention or improvement. It would not have been difficult even from British authorities to show that this specification was sufficient, but I prefer recurring to our own law as the only proper criterion of the validity or invalidity of the specification in question. My opinion is that it has all the certainty which is required by law.

Such a specification as is required by the circuit court is not only not prescribed by law, but to me it appears to be one extremely difficult, if not impracticable.

If the inventor of an improved Hopperboy is to discriminate in his specification between his improvements and any particular Hopperboy which may be produced on that trial, and is to be nonsuited for not having done so; however correct and distinguishing it may be in every other respect, he must do the like as to all other Hopperboys, and if he must describe any, he must describe all others with which he may be acquainted, and after all someone may be introduced at the trial of which he had never heard or which he had never seen, and inasmuch as he had not stated in what respects it was improved by his machine, although this would immediately be seen on inspection, he must not

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only fail of recovering damages for a manifest violation of his right, but must have his patent declared void by the court without a trial by jury and be deprived of the fruits of a most valuable improvement, not because he was not the *bona fide* inventor -- not because he had not described his improvement with sufficient certainty, according to the act of Congress -- but because something more was required of him of which he had no means of information. The only Hopperboy which made its appearance on this trial except the plaintiff's was that known by the name of the Stouffer Hopperboy, but *non constat* that there may not have been a hundred different kinds in use, and some entirely unknown to the plaintiff. If he could have described them all, which would not have been an easy task, and stated in what particulars his Hopperboy differed from them all, his specification would have extended to an immoderate length, and after all have been less intelligible and satisfactory than a full description, such as is given here, of all the parts of which his consisted and of the manner in which they are put together. There may be cases in which an improvement may be so simple as to describe it at once by reference to the thing or machine improved, as in the case of an improvement of this kind on a common watch. But even in the case of a watch, if the improvement pervades the whole machine, it would be a compliance with the terms of the law if the patentee described every part of his improved watch, with its

principle, without discriminating particularly in what respect his different wheels, &c.;, varied from all other watches

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then in use. Many patents have been obtained for improvements on stoves, locks, &c.;, but has it ever been required of the patentee in such cases not only to describe in what manner his stove or lock is constructed and the benefits resulting from such construction, but to point out every particular in which they differ from those already in use? This, to say the least, would be a work of great labor and of little or no use to the public, who would be at liberty to use a stove or lock of any construction not interfering with the one described in the specification of the patentee.

A few observations will show that such a description as the defendant's counsel contend for would be of no greater use than the one which Mr. Evans has adopted. After all the pains to discriminate had been taken, the question would still recur how is the improved Hopperboy to be constructed? and if, from the specification, that could not be ascertained, then and then only ought it to be pronounced defective. But if from the description the improved Hopperboy could be made by a skillful mechanic, then the public is informed, not only of what has been patented, but of what still remains common as before, and if an action be brought for a violation of the patented right, and it should appear that the Hopperboy used is not of such construction, the plaintiff must fail in his suit. It cannot be said, with any justice that if the discrimination be not made, the patent includes not only the improvement, but the old machine on which the improvement is engrafted.

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The old machine still remains public property; may be used by everyone; nor can any person be considered as infringing on the patent right until he adds to the machine already in use the improvements of the patentee, or in other words until he makes a machine resembling in all its parts the one which is described in the

specification.

2d. But if the specification be defective in the points which have been mentioned, is the patent therefore necessarily void? This is a question of vital importance to every patentee.

I am aware that it has been said in England that the patent must not be more extensive than the invention; therefore, if the invention consists in an improvement only and the patent is for the whole machine, it is void. But I am not aware that it has ever been decided there that when a patent is for an "improved machine" and is taken out only for the machine thus improved, and not for the machine as before used, that such patent is void.

But whatever may have been some of the late decisions in that country, I prefer and think it the better course to consider this question also under our own act, which in this respect is different from the English statute and will therefore afford us more light and be a safer guide than either that statute or the judgment on it. In what part, then, of our act, may it be asked, is an authority given to the federal courts to declare a patent void for a defective specification, however innocently made, and which in its consequences can injure no one? I state the question in this way not because I think it necessary to show that if injurious consequences

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might flow from an imperfect specification, a patent must necessarily be declared void, but because I think it must be admitted that there is no evidence whatever in this cause to induce anyone to believe that Mr. Evans either intended to take or that he did receive a patent for anything beyond his invention, which was the Hopperboy in the improved condition in which he describes it.

To declare a patent for a highly useful improvement absolutely void merely for a defective specification, if this be one, is a very high penalty and should not be lightly inflicted unless rendered absolutely necessary by law, the more especially as without recurring to so harsh a measure, a court and jury will always be able to confine a remedy on the patent to violations of the improvement actually secured,

and if the patentee should be so foolish or ill advised as to attempt to bring within its reach the machine in its unimproved state, or any other machine before common, he would do it not only with no prospect of success, but with the certainty of a defeat, attended with a very heavy expense. As long, therefore, as he could maintain no action but for his improvement, it is not perceived why he should be visited with so heavy a denunciation as the forfeiture of his improvement merely because, by some construction of his specification, which might after all be a mistaken one, he had included in his invention something of ever so trifling a nature which was already known. But if such be the law and such the frail tenure on which these rights are held, however hard it may apply in particular cases, it must have its course.

But

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I cannot think it our duty or that we have any right to pronounce a patent void on this account, but that this important office is exclusively confided to a jury. Whether we have this right or not will now be examined.

If such summary authority were intended to have been conferred on the federal courts, the patent law ought to have been and would have been explicit. This is so far from being the case that in the patent law, a provision, but of a different kind, is inserted on this very subject which is not the case in the statute of James. It was foreseen that it must sometimes happen, either from the imperfection of language or the ignorance of a patentee, that defective specifications would be made; it was also foreseen that an imperfect specification might be made from design, and with a view of deceiving the public. We accordingly find it provided by law that among other matters which the defendant may rely on in an action for infringing a patent right is

"that the specification filed 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 must fully appear to have been made for the

purpose of deceiving the public."

If judgment is rendered for the defendant on this ground, the patent is to be declared void. This section applies as well to patents for an improvement on an existing machine as for an invention entirely new, and was intended to protect the patent in either case against an avoidance for an imperfect and innocent specification of the invention patented. If, therefore, the defect which is alleged

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really exist in the specification of the patented improvement, the court is not authorized, on its mere inspection, to declare it imperfect and the patent on that account void. Both questions are clearly questions of fact, and are so treated by the legislature. The party has a right to insist with the jury not only that his specification is perfect, but that if it be otherwise, no deception was intended on the public, and on either ground it may find a verdict in his favor. So if, on the allegation that the thing secured by patent was not originally discovered by the patentee, a verdict passes against the plaintiff, he loses his patent. In like manner, in this case, if it had appeared that the "improved Hopperboy," which was the thing secured by patent, had not been originally discovered by Mr. Evans, and a verdict had passed against him on that ground, there would have been an end of his patent. From the tenth section, also, an argument may be drawn against the right of a court to declare a patent void on mere inspection for redundancy or deficiency in a specification. This section provides a mode of proceeding before the district court where there may be reason to believe a patent was obtained surreptitiously or upon false suggestions, and if on such proceeding it shall appear that the patentee was not the true inventor, judgment shall be rendered by such court for a repeal of the patent. This is the only case in which a power is conferred on a court to vacate a patent without the intervention of a jury. If a proceeding of this kind had been instituted before the proper tribunal against Mr. Evans, the court would

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have examined witnesses and have formed its opinion on their testimony, and it is not clear that even in this case a jury might not have been called in.

This section has been taken notice of to show that it could never have been the intention of the legislature that a patent should be avoided on any account whatever on the opinion of the court alone, without some examination other than that of the specification, whatever might be its excess or poverty of description. If it had been intended to vest so important a power in the court, it would not have been left to mere implication, but would have been conferred in terms admitting of no doubt. My opinion, therefore, on this part of the charge is that the court erred in taking upon itself to pronounce the patent void, even if the specification had been defective or imperfect in not particularly describing what the improvements of the patentee were, this being a power expressly delegated to a jury, which, under all the circumstances of the case, is to decide both questions of fact -- that is, whether the specification be deficient or superfluous and the intention with which it was made so. I repeat once more that whatever may have been the decisions in England, which are not admitted to be contrary to the view which has here been taken of the subject, they are not of authority, and are upon an act so very different in its structure from our own as to afford little or no useful information on the subject. One great and important difference in the two laws is that the statute of James I has not prescribed a mode in which a patent for a vicious specification is to be set aside.

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The patent is granted on condition that a specification be enrolled.

I give no opinion on the questions which arise from the admission of certain witnesses who were supposed to be disqualified on the score of being interested, for if the patent for the Hopperboy be void for a defect in its specification, and that question is not to be referred to the jury, and such I understand to be the opinion of four of the judges, it is very unimportant whether any error was committed in this respect by the court before which the cause was tried, as a verdict must ever be rendered against the representatives of the patentee on this ground, whatever

may be the state of the evidence.

MR. JUSTICE JOHNSON and MR. JUSTICE DUVALL also dissented.

Judgment affirmed with costs.