

Grant Vs. Raymond

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Appellant : Grant

Respondent : Raymond

Judgement :

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Grant v. Raymond

31 U.S. (6 Pet.) 218

ON CERTIFICATE OF DIVISION IN OPINION IN THE CIRCUIT COURT

OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

SYLLABUS

Action for damages for an infringement of a patent right granted to the plaintiff in 1825. The patent recited that a former patent had been issued in 1821, to the same person for the same improvement "which had been cancelled owing to the

defective specification on which the same was granted." The exclusive privilege given by the patent on which the suit was brought is to continue fourteen years from the day on which the original was issued. On the trial, the defendants objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel the first letters patent, or to inquire into and decide upon the causes for so doing, or to grant the second patent for the same invention with an amended specification for the unexpired, portion of the term of fourteen years which had been granted by the first patent. The Circuit Court of the Southern District of New York decided, in conformity with its former decisions, that such surrender might be made when the defect arose from inadvertence or mistake and without any fraud or misconduct on the part of the patentee, and that the Secretary of State had authority to accept such surrender and cancel the record of the patent and to issue a new patent for the unexpired part of the fourteen years granted under the first patent.

By the court:

"It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the circuit court, and have considered it as settled. We would not willingly disregard the settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied it is required by justice and good faith."

To promote the progress of useful arts is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power

"To promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries"

is among those expressly given to Congress. It is the reward stipulated for advantages derived by the public for the exertions of individuals, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this

purpose ought to be construed in the spirit in which they have been made and to execute the contract fairly on the part of the United States, where the full benefit has been received if this can be done without transcending the intentions of the statutes or countenancing acts which are fraudulent or may prove mischievous.

If a mistake should be committed in the Department of State, no one would say it ought not be corrected. All would admit that a new patent, correcting the error and which would secure to the patentee the benefits which the law intended to secure, ought to be issued, and yet the law does not, in terms, authorize a new patent even in such a case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose if the mistake has been innocently committed by the inventor himself?

The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor

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devoted to those discoveries by the exclusive right to make up and sell the things discovered for a limited time. That which gives complete effect to this object and intention by employing the same means for the correction of inadvertent error which are directed in the first instance cannot be a departure from the spirit and character of the act.

Quaere what would be the effect of a second patent, issued after an innocent mistake in the specification, on those who, skilled in the art for which it was granted, perceiving the variance between the specifications and the machine, had constructed, sold, and used the machine. This question is not before the Court, and is not involved in the opinion given in the case. The defense, when true in fact, may be sufficient in law notwithstanding the validity of the new patent.

The Defendant in the circuit court, in his plea, assigned the particular defect supposed to exist in the specification and then proceeded to answer in the very

words of the act

"that it does not contain a written description of the plaintiff's invention and improvement, and manner of using it, in such full, clear, and exact terms, as to distinguish the same from all other things before known, so as to enable any person skilled in the art to make and use the same."

The plea alleged in the words of the act that the prerequisites to issuing a patent had not been complied with. The plaintiffs denied the facts

alleged in the plea, and on this issue was joined. At the trial, the counsel for the defendants, after the evidence was closed, asked the court to instruct the jury that if they should be of opinion that the defendants had maintained and proved the facts alleged in their plea, they must find for the defendants. The court refused this instruction, and instructed the jury that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design or for the purpose of deceiving the public. By the Court: "The instruction was erroneous, and the judgment of the circuit court ought to be reversed."

This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained and if such verdict would have supported a judgment in their favor, although the defect in the specification might not have arisen from design and for the purpose of deceiving the public. That such is the law the Court is entirely satisfied. The third section of the act requires, as preliminary, to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed and is the foundation of the power to issue a patent. The necessary consequences of the ministerial character in which the Secretary acts is that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, the Court would come to this conclusion, but it is understood to be settled.

Courts did not perhaps at first distinguish clearly between a defense which would authorize a verdict and judgment in favor of a defendant in an action for the violation of a patent, leaving the plaintiff free to use his patent and to bring other suits for its infringement, and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. The distinction is now well settled.

If the party is content with defending himself, he may either plead specially or plead the general issue and give the notice required by the sixth section of any

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special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defense is complete. He is entitled to the verdict of the jury, and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity with the sixth section. If he depends on evidence

"tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect,"

it may avail him so far as it respects himself, but will not justify a judgment declaring the patent void unless "such concealment or addition shall fully appear to have been made for the purpose of deceiving the public," which purpose must be found by the jury to justify a judgment of vacatur.

The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner so far as respects his defense, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in the sixth section.

On inspecting the record, it appeared that on the trial of the cause in the circuit court, the counsel for the defendants had excepted to the decisions of the court on various matters which had been presented for the consideration of the court, and that a bill of exceptions had been sealed by the court on their motion.

The record proceeded to state that the cause afterwards came on for argument on a motion for a new trial, when the opinions of the two judges of the circuit court were opposed upon questions, presented for the decision of the court excepted to on the trial, as stated in the bill of exceptions:

"That upon the questions thus occurring before the court, the opinions of the said two judges were opposed, and upon request of the counsel for the plaintiffs, the points upon which the disagreement happened were stated under the direction of the judges and certified under the seal of the court to the Supreme Court."

Mr. Webster stated that a question preliminary to the argument of the case was presented for the decision of the Court. It was whether the Court would entertain the case as it came up from the circuit court on a division in that court on a motion

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for a new trial. This Court had exercised its right to decide in cases where the opinions of the judges of the circuit court on questions of law had been opposed, when a motion for a new trial was before the court.

MR. JUSTICE STORY. In the cases referred to, the division of the court took place on the trial of the cause before the jury, as well as on the motion for a new trial.

MR. CHIEF JUSTICE MARSHALL suggested that the case might be brought on if the parties would agree that it should stand as if a judgment had been given by the circuit court on the exceptions. The case, he said, could not be heard on a difference in opinion of the judges of the court on a motion for a new trial.

The counsel for the plaintiffs and defendants having agreed that the case should stand as suggested by THE CHIEF JUSTICE, and an agreement in writing to that effect having been filed, the Court made the following order.

"It is now here by the Court considered and ordered that this cause shall now be heard and decided as on a writ of error brought after verdict and judgment in the circuit court on the exceptions which were taken in that court; that the cause shall now proceed as if judgment had been actually entered in the circuit court for the plaintiffs there, and that the certificate in the case shall be taken, regarded, and treated as a writ of error sued out by the defendants below on the judgment of the circuit court, and that the question shall be, as in other cases, whether the said judgment ought to be reversed or affirmed, but that this Court will reserve its opinion and judgment in this cause till the defendants in the court below shall have sued out a writ of error in this cause to the said circuit court and filed a return thereto, with a bill of exceptions in this cause in the usual form, signed by the court below, in this Court."

The case came on for argument, after the defendants had sued out a writ of error on a judgment entered in the circuit

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court for the plaintiffs in conformity with the suggestion and order of this Court. The case was as follows:

The action was brought to recover damages for an alleged infringement of a patent right, and came on for trial in the circuit court in November, 1828, when a verdict was rendered for the plaintiffs for \$3,266.66.

The plaintiffs gave in evidence a patent from the United States in the following terms, the same being the patent declared upon:

"Whereas Joseph Grant, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the mode of manufacturing hat bodies by the combination of motions, *viz.*, the rotatory and revolving motion, with the vibrating or transverse motion, which forms the two hat bodies by machinery, and crosses the wool from one extremity of the hat bodies to the other at one operation, called Grant's improved winding machine for setting up hat bodies -- his former patent for the same invention, dated 11 August, 1821, having been

cancelled owing to the defective specification on which the same was granted -- which improvement he states had not been known or used before his application -- hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the Treasury of the United States the sum of \$30, delivered a receipt for the same, 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."

"These are, therefore, to grant, according to law, to the said Joseph Grant, his heirs, administrators or assigns, for the term of fourteen years, from 11 August, 1821, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the words of the said Joseph Grant himself in the schedule hereunto annexed, and is made a part of these presents."

"In testimony whereof I have caused these letters to be made patent and the seal of the United States to be hereunto affixed. Given under my hand, at the City of Washington, this 28

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April, in the year of our Lord 1825, and of the independence of the United States of America the forty-ninth."

"[L.S.] J. Q. ADAMS"

"By the President. H. CLAY, Secretary of State"

"City of Washington, to-wit: I do hereby certify that the foregoing letters patent were delivered to me on 23 April in the year of our Lord 1825, to be examined; that I have examined the same and find them conformable to law, and I do hereby return the same to the Secretary of State within fifteen days from the date aforesaid, to-wit, on this 28th April in the year aforesaid."

"WILLIAM WIRT, Attorney General of the U.S."

The schedule referred to in these letters patent and making part of the same contained a description in the words of the said Joseph Grant himself, of his improvement in the mode of manufacturing hat bodies by the combination of motions, *viz.*, the rotary or revolving motion, with the vibrating or transverse motion, which forms the two hat bodies by machinery and crosses the wool from one extremity of the hat bodies to the other at one operation, called Grant's improved winding machine for setting up hat bodies, his former patent for the same invention dated on 11 August, A.D. 1821, having been cancelled owing to the defective specification on which the same was granted.

The schedule, which contained a full description of the invention and of the mode of using it, was also given in evidence.

The counsel for the plaintiffs also produced and read in evidence a certificate of the Secretary of State, duly authenticated under his hand and official seal, and certain papers thereto annexed, in the words and figures following:

"To all to whom these presents shall come, greeting: "

"I certify that the annexed is a true copy of the record of cancellation of a patent granted to Joseph Grant on 11 August, 1821, and cancelled on 28 April, A.D. 1825; also that the annexed is a true copy of the petition praying for the cancellation and the issuing of another patent for the same invention."

"In testimony whereof, I, Henry Clay, Secretary of State of the United States, have hereunto subscribed my name and

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caused the seal of the Department of State to be affixed. Done at the City of Washington this 19 May, A.D. 1828, and of the independence of the United States of America the fifty-second."

"[L.S.] H. CLAY"

This patent was returned to the Patent Office, the seal broken, and now stands cancelled owing to the defective specification on which it was issued, and another patent granted with a corrected specification, and for 28 April, 1825, bearing date with the first, and for the same invention.

"The petition of Joseph Grant, of Providence, in the County of Providence, and State of Rhode Island, hatter, a citizen of the United States of America, respectfully represents that your petitioner has invented a new and useful improvement in the mode of manufacturing hat bodies by the combination of motions, *viz.*, the rotatory or revolving motion with the vibrating or traverse motion, which forms the two hat bodies by machinery and crosses the wool from one extremity of the hat bodies to the other at one operation, called 'Grant's improved winding machine for setting up hat bodies,' according to the specification, explanations, and drawings, herewith presented, which the subscriber prays may be taken as a part of his petition -- an improvement not used or known before his application, the advantages of which your petitioner is desirous of securing to himself and his legal representatives."

"Your petitioner would further state that he has heretofore, *viz.*, on 11 August, A.D. 1821, obtained letters patent from the President of the United States for his said improvement, but, owing to a defective specification on which the same were granted, he prays that the said patent may be cancelled and a new and correct one granted embracing the same improvements, so far as the same are set forth in the accompanying specification, drawing, and explanations. Your petitioner therefore prays that letters patent of the United States may be issued granting to your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used his said improvement according to the specification and drawings hereto annexed, agreeably to the act of Congress in such case made and provided, your petitioner having paid \$30

into the Treasury of the United States and complied with other provisions of the said act. As in duty bound, will ever pray."

"JOSEPH GRANT"

"To the Hon. Henry Clay, Secretary of State of the United States of America."

"Providence, April 20, 1825."

"As the assignee of David Curtis who was the assignee of Joseph Grant of one moiety of the original patent, I unite in the prayer of the above petitioner that the original patent may be cancelled and a new one granted to the said Joseph Grant as above set forth."

"SOLOMON TOWNSEND"

"To the Hon. Henry Clay, Secretary of State of the United States of America."

"Providence, April 20, 1825."

"The counsel for the defendant objected that the Secretary of State had no power by law to accept a surrender of and to cancel said letters patent or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years, which had been granted by the first patent."

The court decided that such surrender might be made when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee, and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent in manner aforesaid. To which decision the counsel for the defendant excepted.

The fourth plea, filed on the part of the defendant, after reciting the specification annexed to the patent of the plaintiffs, averred as follows:

"And the defendants aver that said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention, but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely in said specification no proportions, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specifications or drawings, but the same is wholly omitted, and in other particulars said specification

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and drawings are altogether defective. And the defendants aver that said specification, annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid and manner of using it in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same, and that for the cause aforesaid, said letters patent are void. All which the defendants are ready to verify; wherefore they pray judgment if the said Joseph Grant and Solomon Townsend ought to have or maintain their aforesaid action against them, and for their costs."

To which plea the following replication was filed:

"And as to the said plea of the said Eliakim Raymond and Henry Raymond, by them fourthly above pleaded, the said Joseph Grant and Solomon Townsend say that, by reason of anything in the said last mentioned plea alleged, they ought not to be barred from having and maintaining their aforesaid action thereof against them, the said Eliakim Raymond and Henry Raymond, because they say that the specification mentioned in the said last mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant, as his invention, and because they say further that neither the said specification nor the drawings thereto annexed is defective in any of the particulars in that behalf alleged in the said last mentioned plea, and this they, the said Joseph Grant and

Solomon Townsend, pray may be inquired of by the country, and the said Eliakim Raymond and Henry Raymond do the like, &c.;"

The counsel for the defendants on the said trial introduced sundry witnesses to prove the allegations traversed in the said fourth plea, and insisted that they had proved the same and that the said specification of the said Joseph Grant did not describe the improvement which he claimed to have invented in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a 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,

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and they requested the court to charge the jury that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants, which instructions the court refused to give, but instructed the jury that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design and for the purpose of deceiving the public, to which opinion the counsel for the defendants also excepted.

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

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This action was brought by Grant and Townsend against E. and H. Raymond, to recover damages for an infringement of their right under a patent granted to the plaintiff Joseph Grant in April 1825. It recited that a former patent had been issued in August, 1821, to the same person for the same improvement, "which had been cancelled, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent on which the suit is brought is to continue fourteen years from the day on which the original was issued.

One of the pleas filed by the defendants, contained the following averment:

"And the defendants aver that said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention, but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely, in said specification no proportion, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specifications or drawings, but the same is wholly omitted, and in other particulars said specifications and drawings are wholly defective, and the defendants aver that said specification annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his the said Joseph Grant's invention and improvement aforesaid and manner of using it in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch or with which it is most nearly connected to make and use the same, and that for the cause aforesaid, said letters patent are void."

The plaintiffs reply that they ought not to be barred

"because they say that the specification mentioned in the said last mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention, and because they say further that neither the said specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged in the said last mentioned plea, and this they pray may be inquired of by the country."

On this replication issue was joined.

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At the trial, the counsel for the defendants objected that the Secretary of State had no power by law to accept a surrender of and to cancel the said letters patent, or to inquire into or to decide upon the causes for so doing, or to grant said second

patent for the same invention with an amended specification for the unexpired portion of the term of fourteen years which had been granted by the first patent.

The court decided that such surrender might be made when the defect arose from inadvertence or mistake and without any fraud or misconduct on the part of the patentee, and that the Secretary of State had authority to accept such surrender and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent in manner aforesaid. To which decision the counsel for the defendants excepted.

After adducing the testimony on which they relied to support their plea hereinbefore stated, the counsel for the defendants moved the court to instruct the jury that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants, which instructions the court refused to give, but instructed the jury that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public, to which opinion the counsel for the defendants also excepted.

The jury found a verdict for the plaintiffs, and assessed their damages to \$3,266.66, the judgment on which is brought before this Court by a writ of error.

The first question in the cause respects the power of the Secretary of State to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired part of the fourteen years for which the original had been granted. The court was of opinion that this might be done "when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee."

The right of the patentee to surrender his patent has not been denied, but the plaintiffs in error insist that no power exists to grant a new patent for the unexpired term. The

words of the act, they say, do not confer this power. It cannot be exercised with its necessary guards by the Department of State, and inconvenience of no inconsiderable magnitude might result to the public from its exercise. The Secretary of State is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given.

It is undoubtedly true that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the act of Congress contains no words which expressly authorize the secretary to issue a corrected patent if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

To promote the progress of useful arts is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power

"To promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries"

is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition,

"granting to such petitioner, his heirs, administrators, or assigns for any term not exceeding fourteen years the sole and exclusive right and liberty of making, using, and vending to others to be used the said invention or discovery."

The law further declares that the patent "shall be good and available to the grantee or grantees by force of this act to all and every intent and purpose herein

contained." The emendatory act of 1793 contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been and continues to be to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent.

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It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made and to execute the contract fairly on the part of the United States where the full benefit has been actually received if this can be done without transcending the intention of the statute or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved, and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel pleads strongly against depriving the inventor of the compensation thus solemnly promised because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose if the mistake has been innocently committed by the inventor himself?

The counsel for the plaintiffs in error have shown very clearly that the question of inadvertence or mistake is a judicial question, which cannot be decided by the Secretary of State. Neither can he decide those judicial questions on which the validity of the first patent depends. Yet he issues it without inquiring into them.

Why may he not in like manner issue the second patent also? The correct performance of all those preliminaries on which the validity of the original depends is always examinable in the court in which a suit for its violation shall be brought. Why may not those points on which the validity of the amended patent depends be examined

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before the same tribunal? In the case under consideration, those questions were not supposed by the circuit court to have been decided in the Department of State, but were expressly submitted to the jury. The rightfulness of issuing the new patent is declared to depend on the fact that "the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee." The jury was, of course, to inquire into the fact. The condition on which the right to issue the patent depended could be stated to it for no other purpose.

It has been said that this permission to issue a new patent on a reformed specification when the first was defective through the mistake of the patentee would change the whole character of the act of Congress.

We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention by employing the same means for the correction of inadvertent error which are directed in the first instance cannot, we think, be a departure from the spirit and character of the act.

An objection much relied on is that after the invention has been brought into general use, those skilled in the art or science with which it is connected, perceiving the variance between the specification and the machine and availing themselves of it, may have constructed, sold, and used the machine without

infringing the legal rights of the patentee or incurring the penalties of the law. The new patent would retroact on them and expose them to penalties to which they were not liable when the act was committed.

This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention. They are not entitled to much favor. But the answer to the objection is that this defense is not made in this case, and the

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opinion of the circuit court does not go so far as to say that such a defense would not be successful. That question is not before the Court, and is not involved in the opinion we are considering. The defense, when true in fact, may be sufficient in law notwithstanding the validity of the new patent.

It has been also argued that the new patent must issue on the new specification and on the application which accompanies it. Consequently it will not be true that the machine was "not known or used before the application."

But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application, and if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application.

It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specification, and cannot be deprived of it by the grant of a new patent. The machine is no longer the subject of a patent.

This would be perfectly true if the second patent could be considered as independent of the first. But it is in no respect so considered. The communication of the discovery to the public has been made in pursuance of law, with the intent to exercise a privilege which is the consideration paid by the public for the future use

of the machine. If by an innocent mistake the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him.

It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the circuit court and have considered it as settled. We would not willingly disregard this settled practice in a case where we are not satisfied it is contrary to law and where we are satisfied that it is required by justice and good faith.

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We will now proceed to the second exception.

The plea assigns the particular defect supposed to exist in the specification, and then proceeds to aver, in the very words of the act, that it

"does not contain a written description of his the said Joseph Grant's invention and improvement aforesaid and manner of using it in such full, clear, and exact terms as to distinguish the same from all other things before known and so as to enable any person skilled in the art, &c.;, to make and use the same,"

&c.;

The plea alleges, in the words of the act, that the prerequisites to the issuing a patent had not been complied with.

If the matter alleged in this plea constituted no bar to the action, the plaintiffs might have demanded, and have submitted the question of law to the court. But they have chosen to deny the facts alleged in the plea and to aver in their replication "that neither the specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged." Issue was joined upon this replication, and it is that issue which the jury was sworn to try.

At the trial, the counsel for the defendants, after the evidence was closed, asked the court in substance to instruct the jury that if it should be of opinion that the defendants had maintained and proved the facts alleged in their plea, it must find for the defendants. The court refused this instruction. Ought it to have been refused? If in the opinion of the jury the defendants have proved maintained every fact alleged in the plea on which the issue they are sworn to try is joined, ought not the jury to find that issue for the defendants? Is not this required by their oaths? The conclusion, "and that for the cause aforesaid, said letters patent are void," is an inference of law from the facts previously alleged, not the allegation of a distinct fact to be submitted to the jury.

The court proceeded to instruct the jury

"that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design or for the purpose of deceiving the public."

Now this "design," this "purpose of deceiving the public," constituted no part of the issue. The defendants had not alleged it, and could not be supposed to come prepared to prove it. A verdict for them would not imply it. The instruction is

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understood to direct a verdict which finds in fact that the description or specification is not defective, and this verdict against the evidence is to be found because that defect "arose not from design, or for the purpose of deceiving the public."

But we must inquire whether the instruction, independent of its departure from the issue, be consistent with law. It is "that the patent would not be void unless," &c.;

The fifth section of the act gives the party aggrieved an action for the infringement of his patent right. The sixth provides

"That the defendant in such action shall be permitted to plead the general issue and give this act in evidence, and to give in evidence any special matter, of which

notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured,"

&c.;, "in either of which cases judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

Courts did not, perhaps, at first distinguish clearly between a defense which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement, and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

If the party is content with defending himself, he may either plead specially or plead the general issue and give the notice required by the sixth section of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defense is complete. He is entitled to the verdict of the jury and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to the sixth section. If he depends on evidence "tending to prove that the specification filed by the plaintiff

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does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect," it may avail him so far as respects himself, but will not justify a judgment declaring the patent void unless such "concealment or addition shall fully appear to have been made for the purpose of deceiving the public," which purpose must be found by the jury to justify a judgment of vacatur by the court. The defendant is permitted to proceed

according to the sixth section, but is not prohibited from proceeding in the usual manner so far as respects his defense, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in the sixth section.

This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor, although defect in the specification might not have arisen from design and for the purpose of deceiving the public. That such is the law we are entirely satisfied. The third section requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent. The necessary consequence of the ministerial character in which the secretary acts is that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case of the first impression, we should come to this conclusion, but it is understood to be settled.

The act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books

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are full of cases in which it has been held that a defective specification is a good bar when pleaded to, or a sufficient defense when given in evidence on the general issue, on an action brought from the infringement of a patent right. They are very well summed up in Godson's Law of Patents, title Specification, and also in the chapter respecting the infringement of patents; also in Holroyd on Patents,

where he treats of the specification, its form and requisites. It is deemed unnecessary to go through the cases, because there is no contrariety in them and because the question is supposed to be substantially settled in this country. [*Pennock & Sellers v. Dialogue*](#), 1 Pet. 1, was not, it is true, a case of defect in the specification or description required by the third section, but one in which the applicant did not bring himself within the provision of the first section, which requires that before a patent shall issue, the petitioner shall allege that he has invented a new and useful art, machine, &c.;, "not known or used before the application."

This prerequisite of the first section, so far as a failure in it may affect the validity of the patent, is not distinguishable from a failure of the prerequisites of the third section.

On the trial, evidence was given to show that the patentee had permitted his invention to be used before he took out his patent. The court declared its opinion to the jury that if an inventor makes his discovery public, he abandons the inchoate right to the exclusive use of the invention. "It is possible," added the court,

"that the inventor may not have intended to give the benefit of his discovery to the public. . . . But it is not a question of intention, . . . but of legal inference, resulting from the conduct of the inventor and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiff is not entitled to a verdict."

The jury found a verdict for the defendants, an exception was taken to the opinion, and the judgment was affirmed by this Court.

This case affirms the principle that a failure on the part of the patentee in those prerequisites of the act which authorize a patent is a bar to a recovery in an action for its infringement, and that the validity of this defense does not depend on

the invention of the inventor, but is a legal inference upon his conduct.

Upon these authorities and this reasoning, we are of opinion that the instruction was erroneous and that the judgment ought to be reversed and the cause remanded. One of the judges composing the majority thinks that the direction would have been erroneous on a plea properly framed upon the third section of the act and averring the facts of a defective specification and a noncompliance with other requisitions of that section, for that such a plea would be a good bar and defense to the action; but in his view the plea relies upon the facts as avoiding the patent entirely, and avers it to be void. He thinks, however, that the replication puts the facts, and not the point whether void or not, in issue, and that the direction of the court was erroneous since it was equivalent to a declaration that if all the facts were proved, the issue ought not to be found for the defendants unless the imperfection of the specification arose from a fraudulent design.

The judgment is reversed, and the cause remanded with directions to issue a venire facias de novo.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York and was argued by counsel, on consideration whereof it is the opinion of this Court that the said circuit court erred in instructing the jury

"that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public."

Whereupon it is ordered and adjudged by this Court that the judgment of the said circuit court in this cause be and the same is hereby reversed, and that this cause be and the same is hereby remanded the said circuit court with directions to award a *venire facias de novo*.