Shaw Vs. Cooper

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Shaw v. Cooper

32 U.S. (7 Pet.) 292

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

SYLLABUS

Action for an alleged violation of a patent for an improvement, in guns and firearms.

The letters patent were obtained in 1822, and in 1829, the patentee having surrendered the same for an alleged defect in the specification, obtained another patent. This second patent is to be considered as having relation to the emanation of the patent of 1822, and not as having been issued on an original application.

The holder of a defective patent may surrender it to the Department of State and obtain a new one, which shall have relation to the emanation of the first.

The case of *Grant v. Raymond,* 6 Pet. 220, cited and affirmed.

A second patent granted on the surrender of a prior one being a continuation of the first, the rights of a patentee must be ascertained by the law under which the original application was made.

By the provisions of the Act of Congress of 17 April, 1800, citizens and aliens, as to patent rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases, the right must be tested by the same rule.

What use by the public, before the application is made for a patent, shall make void the right of a patentee.

From an examination of the various provisions of the acts of Congress relative to patents for useful inventions, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only, and that on condition that his invention was neither known nor used by the public before his application for a patent. If such use or knowledge shall be proved to have existed prior to the application for the patent, the act of 1793 declares the patent void, and the right of an alien is vacated in the same manner, by proving a foreign use or knowledge of his invention. That knowledge or use which would be fatal to the patent right of a citizen would be equally so to the right of an alien.

The knowledge or use spoken of in the Act of Congress of 1793 could have referred to the public only, for the provision would be nugatory if it were applied to

the inventor himself. He must necessarily have a perfect knowledge of the thing invented and of its use before he can describe it, as by law he is required to do preparatory to the emanation of a patent.

There may be cases in which a knowledge of the invention may be surreptitiously obtained and communicated to the public that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for

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such a presumption. It is undoubtedly just that every discoverer should realize the benefits resulting

from his discovery for the period contemplated by law. But those can only be

reserved by a substantial compliance with every legal requisite. This exclusive right does not rest alone on his discovery, but also upon the legal sanctions which have been given to it and the forms of law with which it has been clothed.

No matter by what means an invention may have been communicated to the public before a patent is obtained, any acquiescence in the public use by the inventor will be an abandonment of the right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stands in an entirely different relation to the inventor. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent.

The acquiescence of an inventor in the public use of his invention can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will in general be a fact for a jury, and if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use, as forever afterwards to prevent hint from asserting it. After his right shall be perfected by a patent, no presumption

arises against it from a subsequent use by the public.

A strict construction of the act of Congress as it regards the, public use of an invention before it is patented is not only required by its letter and spirit, but also by sound policy.

The question of abandonment to the public does not depend on the intention of the inventor. Whatever may be the intention, if he suffers his invention to go into public use through any means whatsoever without an immediate assertion of his right, he is not entitled to a patent, nor will a patent obtained under such circumstances protect his right.

At the October term, 1829, of the circuit court, the plaintiff in error, Joseph Shaw, instituted an action against the defendant, Joseph Cooper, for an alleged violation of a patent granted to him by the United States, dated 7 May, 1829, for

"a new and useful improvement in guns and firearms, which improvement consisted in a priming head and case applied to arms and firearms for the purpose of priming and giving them fire by the means or use of percussion, fulminating, or detonating powder,"

by which patent, the plaintiff alleged that there was granted to him, &c.;, for the term of fourteen years from 19 June,

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1822, the exclusive right to the said invention, and by virtue of which he became entitled to the same, for the residue of the term unexpired on 7 May, 1829. The declaration averred that the defendant had violated the patent right of the plaintiff on 1 August, 1829, and afterwards between that day and the institution of the suit.

The defendant pleaded not guilty and gave the following notice of the matters of defense.

"Please to take notice that on the trial of the above cause, the above-named Joseph Cooper will, under the plea of the general issue aforesaid, insist upon and

give in evidence that the pretended new and useful improvement in guns and firearms mentioned and referred to in the several counts of the said Joshua Shaw's declaration was not originally discovered or invented by the said Joshua Shaw; also that the said pretended new and useful improvement, or the material or essential parts or portions thereof, or some or none of them, had been known and used in this country, *viz.,* in the City of New York and in the City of Philadelphia, and in sundry other places in the United States, and in England, and in France, and in other foreign countries, before the said Joshua Shaw's application for a patent, as set forth in his said declaration, and also before the alleged invention or supposed discovery thereof by the said Joshua Shaw. And further, that the said alleged new and useful improvement, or the material or essential parts or portions thereof, or some or one of them, or the principle thereof, was the invention or discovery of a gunmaker or of some other person residing in England. And further that the said patent was void because in and by the specification or description therein referred to, no distinction or discrimination is made between the parts and portions previously known and used as aforesaid and any parts or portions of which the said Joshua Shaw may be the inventor or discoverer, the said Joseph Cooper at the same time protesting that he, the said Joshua Shaw, has not been the inventor or discoverer of any part or portion of the said alleged improvement. And further that the said patent is void because the said specification or description does not describe the improvement

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of which the said Joshua Shaw claims to be the inventor or discoverer, 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. And further that the said patent is void because it was not granted, issued, or obtained according to law. And further that the said patent is void because it was surreptitiously obtained by the said Joshua Shaw."

The cause was tried in January, 1832, and a verdict and judgment given for the defendant. The plaintiff prosecuted this writ of error. The following bill of

exceptions was tendered by the counsel for the plaintiff and sealed by the court.

"The plaintiff, to maintain the issue on his part, gave in evidence the letters patent of the United States of America, as set forth in the declaration of the said plaintiff, issued on 7 May, 1829, and also that the improvement for which the said letters patent were granted, was invented or discovered by the said plaintiff in the year 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent. And thereupon the said defendant, to maintain the said issue above joined on his part, then and there proved by the testimony of one witness that he had used the said improvement in England and had purchased a gun of the kind there, and had seen others use the said improvement and had seen guns of the kind in the Duke of York's armory in 1819, and also proved by the testimony of five other witnesses that in 1820 and 1821 they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they never had seen guns of the kind prior to those years, and also proved that in 1821 it was known and used in France, and also that the said improvement was generally known and used in the United States of America, after 19 June, 1822. Whereupon the said plaintiff, further to maintain the said issue on his part, then and there gave in evidence that the said plaintiff, not being a worker in iron, in 1813 or 1814 employed his brother

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in England, under strict injunctions of secrecy, to execute or fabricate the said improvement for the purpose of the said plaintiff's making experiments. And that the said plaintiff, afterwards, in 1817, left England and came to reside in the United States of America, and that after the departure of the said plaintiff from England, *viz.,* in 1817 or 1818, his said brother divulged the said secret, for a certain reward, to an eminent gunmaker in London; that the plaintiff, on his arrival in this country in 1817, disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same and whom he wished to engage to join and assist him. That the plaintiff made said disclosures under injunctions of secrecy, claiming the improvement as his own and declaring that he should patent

it. That the said plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it, and that he assigned as a reason for delaying to patent it that it was not so perfect as he wished to make it before he introduced it into public use, and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements and others did not. That in this country, the said invention was never known or used prior to the said 19 June, 1822; that on that day letters patent were issued to the said plaintiff, being then an alien, for his said invention, and that the said plaintiff immediately brought the said invention into public use under the said letters patent. That afterwards, and after suits had been brought for violation of the said letters patent, the said plaintiff was advised to surrender them on account of the specification's being defective, and that he did accordingly, on 7 May, 1829, surrender the same into the Department of the Secretary of State of the United States of America, and that thereupon the letters patent first above mentioned were issued to the said plaintiff."

"And the said plaintiff also gave in evidence that prior to the said 19 June, 1822, the principal importers of guns from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the said invention, or that the same was known or used in England, and that no guns of the kind were imported

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into this country until in the years 1824 or 1825. And that letters patent were granted in England on 11 April, 1807, to one Alexander J. Forsyth for a method of discharging or giving fire to artillery and all other firearms, which method he describes in his specification as consisting in"

"the use or application, as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire's being applied thereto, and merely by a blow or by any sudden or strong pressure of friction given or applied thereto without extraordinary violence -- that is to say, some one of the compounds of

combustible matter such as sulphur or sulphur and charcoal, with an oxmuriatic salt -- for example, the salt formed of dephlogisticated marine acid and potash (or potasse), which salt is otherwise called oxmuriate of potash, or such of the fulminating metallic compounds as may be used with safety -- for example, fulminating mercury or of common gunpowder -- mixed in due quantity with any of the above-mentioned substances or with any oxmuriatic salt as aforesaid, or of suitable mixtures of any of the before-mentioned compounds,"

"and that the said letters patent continued in force for the period of fourteen years from and after granting of the same. (It is understood that the patent and specification of Forsyth, may be at any time referred to on the argument, for correction or explanation of the bill of exceptions.) And thereupon the defendant, further to maintain the said issue on his part, gave in evidence a certain letter from the plaintiff to the defendant dated in December, 1824, from which the following is an extract,"

" Sometime since, I stated that I had employed counsel respecting regular prosecutions for any trespasses against my rights to the patent; I have at length obtained the opinions of Mr. Sergeant of this city, together with others eminent in law, and that is that I ought (with a view to insure success) to visit England and procure the affidavits of Manton and others, to whom I made my invention known, and also of the person whom I employed to make the lock, at the time of invention, for it appears very essential that I should also prove that I did actually reduce the principle to practice; otherwise a verdict might be doubtful. It is therefore my intention to visit

England in May next for this purpose; in the meantime, proceedings which have commenced here are suspended for the necessary time."

"And the said judges of the said court did thereupon charge and direct the said jury that the patent of 7 May, 1829, having been issued, as appeared by its recital, on the surrender and cancelment of the patent of 19 June, 1822, and being intended

to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained. That the plaintiff's case, therefore, came under the act passed 17 April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know in 1822 that the invention for which he was taking out a patent had before that time been in use in a foreign country, but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act for any invention which it should afterwards appear had been known or used previous to such application for a patent should be utterly void. That there was nothing in the act confining such use to the United States, and that if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case, but the court was of opinion that he had slept too long on his rights, and not followed them up as the law requires to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it or by others who knew of the piracy would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor, and if, as appeared from the evidence in this case, the public had fairly become possessed of the invention before plaintiff applied for his patent, it was

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sufficient in the opinion of the court to invalidate his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he entrusted the knowledge of it. "

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MR. JUSTICE Mc LEAN delivered the opinion of the Court.

This writ of error brings before this Court for its revision a judgment of the Circuit Court of the United States for the Southern District of New York. An action was brought in the circuit court by Shaw against the defendant Cooper for the violation of a certain patent right claimed by the plaintiff. The defendant pleaded the general issue and gave notice that on the trial he would prove

"that the pretended new and useful improvements in guns and firearms mentioned and referred to in the several counts in the declaration, also that the said pretended new and useful improvements or the essential parts or portions thereof or some or one of them, had been known and used in this country, *viz.,* in the City of New York and in the City of Philadelphia and in sundry other places in the United States and in England, in France, and in other foreign countries before the plaintiff's application for a patent, as set forth in his declaration,"

&c.; On the trial, the following bill of exceptions was taken.

"To maintain the issue joined, the plaintiff gave in evidence certain letters patent of the United States, as set forth in the declaration, issued on 7 May, 1829, and also that the improvement for which the letters were granted was invented or discovered by the plaintiff in 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent. And the defendant then proved by the testimony of one witness that he had used the said improvement in England and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York's armory in 1819. And also proved by the testimony of five other witnesses that in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they had never seen guns

of the kind, prior to those years, and also proved that in the year 1821, it was used and known in France, and also that the said improvement was generally known and used in the United States after 19 June, 1822."

"And the plaintiff, further to maintain the issue on his part, then gave in evidence that he, not being a worker in iron, in 1813 or 1814, employed his brother, in England, under strict injunctions of secrecy, to execute or fabricate the said improvement, for the purpose of making experiments. And that the plaintiff afterwards, in 1817, left England and came to reside in the United States, and that after his departure from England, in 1817 or 1818, his said brother divulged the secret, for a certain reward, to an eminent gunmaker in London. That on the arrival of the plaintiff in this country, in 1817, he disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made this disclosure, under injunctions of secrecy, claiming the improvement as his own, declaring that he should patent it. That the plaintiff treated his invention as a secret, after his arrival in this country, often declaring, that he should patent it, and that this step was only delayed, that he might make it more perfect, before it was introduced into public use, and that he did make alterations which some witnesses considered improvements in his invention, and others did not. That in this country, the invention was never known or used, prior to the said 19 June, 1822; that on that day, letters patent were issued to the plaintiff, being then an alien, and that he immediately brought his invention into public use. That afterwards, and after suits had been brought for a violation of the said letters patent, the plaintiff was advised to surrender them, on account of the specification being defective, and that he did accordingly, on 7 May in the year 1829, surrender the same into the Department of the Secretary of State, and received the letters patent first above named."

"And the plaintiff also gave in evidence, that prior to 19 June, 1822, the principal importers of guns from England in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the

said invention, or that the same was used or known in England, and that no guns of the kind were imported into this country until in the years 1824 or 1825. And that letters patent were granted in England, on 11 April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery and all other firearms,

which method he described in his specification as consisting in the"

"use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding, without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction given or applied thereto, without extraordinary violence; that is to say, some one of the compounds of combustible matter, such as sulphur, or sulphur and charcoal, with an oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash (or potasse), which salt is otherwise called oxmuriate of potash; or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt, as aforesaid, or of suitable mixtures of any of the before-mentioned compounds,"

"and that the said letters patent continued in force for the period of fourteen years from the time of granting the same."

"And the defendant, further to maintain the issue on his part, gave in evidence a certain letter from the plaintiff to the defendant, dated in December, in the year 1824, from which the following is an extract:"

" Sometime since, I stated that I had employed counsel respecting regular prosecutions for any trespass against my rights to the patent; I have at length obtained the opinion of Mr. Sergeant of this city, together with other eminent in the law, and that is that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others, to whom I made my intention known, and also of the person whom I employed to make the lock, at the time of invention, for it appears very essential that I should prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is therefore my intention to visit England in May next for this purpose; in the meantime,

proceedings which have commenced here are suspended for the necessary time."

"And the court, on these facts, charged the jury that the patent of 7 May, 1829, having been issued, as appears by its recital, on the surrender and cancelment of the patent of 19 June in the year 1822, and being intended to correct a mistake or remedy a defect in the latter; it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in the year 1822, when the patent was first obtained. That the plaintiff's case therefore came under the act passed 17f April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath, that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know in the year 1822 that the invention for which he was taking out a patent had, before that time, been in use in a foreign country; but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act, for any invention which, it should afterward appear, had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States, and that if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case, but the court was of opinion that he had slept too long on his rights and not followed them up as the law requires to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor, and if, as appears from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient in the opinion of the court to invalidate the

patent, even though the invention may have originally gotten into public use through the fraud or misconduct of his brother, to whom he entrusted the knowledge of it."

Under this charge, the jury found a verdict for the defendant on which a judgment was entered. There is a general assignment of errors, which brings to the consideration of the court the principles of law which arise out of the facts of the case, as stated in the bill of exceptions.

It may be proper in the first place to inquire whether the letters patent which were obtained in 1829, on a surrender of the first patent, have relation to the emanation of the patent in 1822, or shall be considered as having been issued on an original application? On the part of the plaintiff, it is contended that "the second patent is original and independent, and not a continuation of the first patent." That in adopting the policy of giving, for a term of years, exclusive rights to inventors in this country, we adopted at the same time the rules of the common law, as applied to patents in England, and that by the common law, a patent, when defective, may be surrendered to the granting power, which vacates the right under it, and the King may grant the right *de novo* either to the same or to any other person. This being the effect of the surrender of a patent in England, it is insisted that the same consequence should follow a surrender in this country. On this subject, it is said that the decisions of the English courts are uniform, and that not even a *dictum* can be found that a second patent is a continuation of the first.

The counsel seems to consider this point of great importance, as the plaintiff was an alien when the first patent was obtained, but had become naturalized before the date of the second, and consequently that this right under the second patent cannot be governed by the law applicable to aliens. As the inquiry on this head is whether the second patent has relation to the first, it is not necessary to look into the laws, to ascertain the respective rights of aliens and citizens on this subject. In regard to the right of the patentee to surrender a defective patent and take out a new one, there can be no difference between a citizen and an alien.

That the holder of a defective patent may surrender it to the Department of State and obtain a new one, which shall have relation to the emanation of the first, was

decided by this Court at the last term in the case of *Grant v. Raymond,* 6 Pet. 220. THE CHIEF JUSTICE, in giving the opinion of the Court says

"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."

As this decision must be considered as settling the construction of the patent laws on this point, it is conclusive in the present case, and it is therefore unnecessary to examine the argument of the plaintiff's counsel, which was designed to lead to a different conclusion.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made.

This law was passed on 17 April, 1800, and provides

"That all and singular the rights and privileges given to citizens of the United States, respecting patents for new inventions, &c.;, shall be extended to aliens who, at the time of petitioning, shall have resided for two years within the United States, &c.;, provided that every person petitioning for a patent for any invention, art, or discovery pursuant to this act shall make oath or affirmation before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used, either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void."

By the Act of 21 February, 1793, which limits patent rights to citizens, it is provided,

"that every person or persons,

in his or their application for a patent, shall state that the machine, &c.;, was not known or used before such application."

The sixth section of this act provides that a defendant, when prosecuted for a violation of a patent right, may give in evidence, under a notice, among other matters,

"that the thing secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person, in either of which cases, judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

It would seem from the above provisions that citizens and aliens, as to patent rights, are placed substantially upon the ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases, the right must be tested by the same rule.

From the facts in the case, it appears that the plaintiff, while residing in England, in 1813 or 1814, invented the instrument secured by his patent. That before the came to the United States, he made known his invention to his brother, to Mr. Manton, a gunmaker in London, and to others. That shortly after he came to the United States in 1817, he disclosed his invention to a gunmaker in Philadelphia, and that in 1817 or 1818, the plaintiff's brother sold the invention to a gunmaker in London. That in 1819, the invention was sold and used in England, and that in the two following years it was in public use there, and in the latter year, also in France. That on 19 June, 1822, his first patent was obtained. It also appears that in April, 1807, a patent was granted in England to one Forsyth for fourteen years for an invention on the same subject. This fact was shown by the plaintiff, it is presumed, as a reason why he did not take out a patent in England. The question arises from these facts and others which belong to the case whether there was such a use in the public of this invention at the date of the plaintiff's first patent as to render it

void.

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By the plaintiff's counsel it is insisted that if an invention has been pirated or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property, and it makes no difference that the public has acquired the use of the invention without any participation in the fraud unless the inventor has acquiesced in such use. The right of the plaintiff to his invention is compared to his right to other property, which cannot be divested by fraud or violence, and the case of *Millar v. Taylor,* 4 Burr. 2303, where seven judges against four held that at common law, an author, by publishing a literary composition, does not abandon his right, is referred to as illustrative of the principle.

Several decisions by the circuit courts of the United States are cited to sustain the right of the plaintiff. In the case of *Whittemore v. Cutter,* 1 Gallis. 482, the court said

"It will not protect the plaintiff's patent that he was the inventor of the improvements if he suffered them to be used, freely and fully, by the public at large, for so many years, combined with all the usual machinery, for in such case he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use."

In the case of *Goodyear v. Mathews,* 1 Paine 301, the court in substance said "that if the plaintiff be the inventor, it is immaterial, that the invention has been known and used for years before the application." And in the case of *Morris v. Huntington,* 1 Paine 354, the court said that

"No man is to be permitted to lie by for years, and then take out a patent. If he has been practicing his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent

of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment, or present, of it to the public."

This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though the public

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had been in possession of the invention for six years before the emanation of the second patent.

Of the same import are the cases cited from 4 Mason 108, and 4 W.C.C. 438, 703.

The question what use in the public, before the application is made for a patent, shall make void the right of the patentee, was brought before this Court by the case of *Pennock v. Dialogue,* 2 Pet. 1. In this case, the Court said that

"It has not been, and indeed, cannot be, denied that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus gone, cannot afterwards be resumed at his pleasure, for when gifts are once made to the public in this way, they become absolute."

And again,

"If an invention is used by the public with the consent of the inventor at the time of his application for a patent, how can the courts say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, how can the court extract the case from its operation and support a patent when the suggestions of the patentee were not true, and the conditions on which alone the grant was authorized do not exist. . . . The true construction of the patent law is,"

the Court said

"that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use or to be publicly sold for use before he makes application for a patent."

In this case it appeared that the thing invented had been in use by the public, with the consent of the inventors, and through which they derived a profit, for seven years before the emanation of a patent. And this use was held by the court to be an abandonment of the right by the patentees.

The policy of granting exclusive privileges in certain cases was deemed of so much importance in a national point of view, that power was given to Congress in the federal Constitution

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

This power was exercised by Congress, in the passage of the acts which have been referred to. And from an examination of

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their various provisions, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only, and that on condition that his invention was neither known nor used by the public before his application for a patent. If such use or knowledge shall be proved to have existed prior to the application for the patent, the act of 1793 declares the patent void, and as has been already stated, the right of an alien is vacated in the same manner, by proving a foreign use or knowledge of his invention. That knowledge or use which would be fatal to the patent right of a citizen would be equally so to the right of an alien.

The knowledge or use spoken of in the act of 1793 could have referred to the public only, for the provision would be nugatory if it were applied to the inventor himself. He must necessarily have a perfect knowledge of the thing invented and

its use, before he can describe it, as by law he is required to do, preparatory to the emanation of a patent. But there may be cases in which a knowledge of the invention may be surreptitiously obtained, and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption.

In England it has been decided that if an inventor shall suffer the thing invented to be sold and go into public use for four months, and in a later case, for any period of time, before the date of his patent, it is utterly void. In that country, the right emanates from the royal prerogative; in this it is founded exclusively on statutory provisions. But the policy in both governments is the same in granting the right and in fixing its limits. Vigilance is necessary to entitle an individual to the privileges secured under the patent law. It is not enough that he should show his right by invention, but he must secure it in the mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it.

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The patent law was designed for the public benefit, as well as for the benefit of inventors. For a valuable invention, the public, on the inventor's complying with certain conditions, give him, for a limited period, the profits arising from the sale of the thing invented. This holds out an inducement for the exercise of genius and skill, in making discoveries which may be useful to society, and profitable to the discoverer. But it was not the intention of this law, to take from the public, that of which they were fairly in possession.

In the progress of society, the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind, and the diversity of talents and pursuits, which exist in every intelligent community. And it would be extremely impolitic, to retard or embarrass this advance, by withdrawing

from the public any useful invention or art, and making it a subject of private monopoly. Against this consequence, the legislature have carefully guarded in the laws they have passed on the subject.

It is undoubtedly just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it and the forms of law with which it has been clothed.

No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps, no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor.

The invention passes into the possession of innocent persons, who have no knowledge of the fraud, and at a considerable expense, perhaps, they appropriate it to their own use. The inventor or his agent has full knowledge of these facts, but fails to assert his right; shall he afterwards be permitted to assert it with effect? Is not this such evidence of

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acquiescence in the public use, on his part, as justly forfeits his right?

If an individual witness a sale and transfer of real estate under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterwards be permitted to assert it. On this principle it is that a discoverer abandons his right if, before the obtainment of his patent, his discovery goes into public use. His right would be secured, by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose anything more than reasonable diligence on the inventor? And would anything short of this be just to the public?

The acquiescence of an inventor in the public use of his invention, can in no case be presumed, where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use, as forever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.

When an inventor applies to the Department of State for a patent, he should state the facts truly, and indeed, he is required to do so, under the solemn obligations of an oath. If his invention has been carried into public use by fraud, but for a series of months or years, he has taken no steps to assert his right; would not this afford such evidence of acquiescence as to defeat his application, as effectually, as if he failed to state that he was the original inventor? And the same evidence which should defeat his application for a patent would, at any subsequent period, be fatal to his right. The evidence he exhibits to the Department of State is not only *ex parte,* but interested, and the questions of fact are left open, to be controverted by anyone who shall think proper to contest the right under the patent.

A strict construction of the act, as regards the public use of an invention, before it is presented, is not only required

by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention by the inventor; but if he may delay an application for his patent, at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretense of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule which can be adopted on this subject.

In the case under consideration, it appears, the plaintiff came to this country, from England, in the year 1817, and being an alien, he could not apply for a patent, until he had remained in the country two years. There was no legal obstruction to his obtaining a patent in the year 1819; but it seems that he failed to apply for one, until three years after he might have done so. Had he used proper diligence in this respect, his right might have been secured; as his invention was not sold in England, until the year 1819. But in the two following years, it is proved to have been in public use there, and in the latter year, also in France. Under such circumstances, can the plaintiff's right be sustained?

His counsel assigns as a reason for not making an earlier application, that he was endeavoring to make his invention more perfect, but it seems, by this delay, he was not enabled essentially to vary or improve it. The plan is substantially the same as was carried into public use through the brother of the plaintiff in England. Such an excuse, therefore, cannot avail the plaintiff. For three years before the emanation of his patent, his invention was in public use, and he appears to have taken no step to assert his right. Indeed, he sets up, as a part of his case, the patent of Forsyth as a reason why he did not apply for a patent in England. The Forsyth patent was dated six years before.

Some of the decisions of the circuit courts which are referred to, were overruled in the case of *Pennock v. Dialogue.* They made the question of abandonment to turn upon the

intention of the inventor. But such is not considered to be the true ground. Whatever may be the intention of the inventor, if he suffers his invention to go into public use through any means whatsoever, without an immediate assertion of his right he is not entitled to a patent, nor will a patent, obtained under such circumstances, protect his right. The judgment of the circuit court must be

Affirmed with costs.

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 adjudged and ordered by this Court that the judgment of the said circuit court in this cause be and the same is hereby affirmed with costs.