Hobb Vs. Emerson

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Appeal No. : 47 U.S. 437

Appellant : Hobb

Respondent : Emerson

Judgement :

Hobb v. Emerson - 47 U.S. 437 (1848)
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Hobb v. Emerson

47 U.S. (6 How.) 437

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

SYLLABUS

When a case is sent to this Court under the discretion conferred upon the court below by the seventeenth section of the Act of July 4, 1836 (Patent Law), 5 Stat. 124, the whole case comes up, and not a few points only.

The specification constitutes a part of a patent, and they must be construed together.

Emerson's patent for "certain improvements in the steam engine, and in the mode of propelling therewith either vessels on the water or carriages on the land," decided not to cover more ground than one patent ought to cover, and to be sufficiently clear and certain.

A patentee, whose patent right has been violated, may recover damages for such infringement for the time which intervened between the destruction of the patent office by fire, in 1836, and the restoration of the records under the act of March 3, 1837.

This was a suit for the violation of a patent right, and the writ of error was allowed under the seventeenth section of the act of 1836.

On 8 March, 1834, John B. Emerson, the defendant in error, obtained the following letters patent, which were recorded anew on 5 March, 1841, *viz.:*

" *The United States of America, to all to whom these letters patent shall come: "*

"Whereas John B. Emerson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the steam engine, which improvement he states has not been known or used before his application; hath made

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oath that he doth 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 thirty dollars, 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 John B. Emerson, his heirs, administrators, or assigns, for the term of fourteen years from the eighth day of March, one thousand eight hundred and thirty-four, 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 John B. Emerson himself, in the schedule hereto 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 eighth day of March in the year of our Lord one thousand eight hundred and thirty-four and of the independence of the United States of America the fifty-eighth."

"ANDREW JACKSON"

"[L.S.]"

"By the President:"

"LOUIS Mc LANE, *Secretary of State* "

"CITY OF WASHINGTON, *to-wit:* "

"I do hereby certify, that the following letters patent were delivered to me on the eighth day of March in the year of our Lord one thousand eight hundred and thirty-four, 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 eighth day of March, in the year aforesaid."

"B. F. BUTLER"

" *Attorney General of the United States* "

The schedule referred to in these letters patent, and making part of the same, containing a description in the words of the said John Brown Emerson himself, of his improvement in the steam engine:

" *To all whom it may concern: "*

"Be it known, that I, John Brown Emerson, of the City of New York, have invented certain improvements in the steam engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, and that the following is a full and exact description thereof. "

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"One object of my improvement is to substitute for the crank motion a mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery for that purpose."

"This mode is applicable to an engine either with one or with two cylinders, and is carried into effect as follows. Alongside of the cylinder I place a shaft, the lower end of which may revolve in a step on the platform or foundation upon which the cylinder stands, in which case it must be somewhat longer than twice the length of the cylinder, as it must extend above it to a height somewhat greater than the length of the stroke of the piston. Sometimes, however, this shaft may have its lower gudgeon only a small distance below the upper end of the cylinders, whence it must extend above it as before. Its upper gudgeon must of course be sustained by a suitable frame. This shaft is to stand parallel to the piston rod, from which it is to receive its revolving motion. Upon the upper end of the shaft, above the top of the cylinder, there is to be placed a solid cylinder of wood or of any other convenient substance of such diameter as shall cause its periphery to come nearly into contact with the piston rod for its whole length, when the piston is raised. The solid cylinder above described is to be made to revolve in the following manner. I make a groove in it, which commences near its lower end, and, passing spirally, extends half-way round it by the time it reaches nearly to the upper end, or to a distance vertically equal to the stroke of the engine; from that point it passes down around the opposite half, and returns into itself at the point of beginning. Upon the upper end of the piston, against its side, I place a friction roller, which is to work in the groove in the solid cylinder; the piston rod rising between parallel guide pieces, by which it is kept in its proper place, and its tendency to turn round by the action

of the roller in the groove is checked. When the piston is down, this friction roller will stand in the V formed by the junction of the grooves on the opposite sides, and as it is raised, it will in its passage to the upper junction give half a revolution to the solid cylinder, and in descending will complete the revolution by the action of the friction roller on the other portion of the groove."

"When two cylinders are used, they are to be placed parallel to each other, and at such a distance apart that the pistons of each may, in like manner, act upon the solid cylinder; the piston of one being up when the other is down. The boiler, the steam pipe, the valves for the admission and discharge of steam, and other appendages, may be similar to some of those already in use. From the revolving shaft, already described,

a rotary motion may be communicated to paddle wheels, steam carriages, or other objects. As it is my intention, in general, to place my cylinders and revolving shaft vertically, I communicate motion to the horizontal shaft of a paddle wheel by means of bevel geared wheels near the lower end, or at any convenient part of the shaft, and by similar gearing, carriages may be propelled upon rail or ordinary roads."

"When used for steamboats, I employ an improved spiral paddle wheel, differing essentially from those which have heretofore been essayed. This spiral I make by taking a piece of metal of such length as I intend the spiral propeller to be, and of a suitable width, say, for example, eighteen inches; this I bend along the center so as to form two sides, say of nine inches in width, standing at right angles, or nearly so, to each other, and give to it, longitudinally, the spiral curvature which I wish. Of these pieces I prepare two or three or more and fix them on to the outer end of the paddle shaft by means of arms of a suitable length, say of two feet, more or less, in such a position that the trough form given to them longitudinally shall be effective in acting upon the water. It must be entirely under water, and operate in the direction of the boat's way; instead of metal, the spiral propeller may be formed of wood, and worked into the proper form -- the shape, and not the material

thereof, being the only point of importance."

"Where a capstan is required, as on board of a steamboat, I allow the upper end of the vertical shaft before described to pass through the deck of the vessel, and attach the capstan thereto so that it may be made to revolve by the action of the shaft, using such ray wheels and falls to connect the shaft and the capstan as will allow of their being conveniently engaged and disengaged."

"What I claim as my invention and for which I ask a patent is the substituting for the crank in the reciprocating engine a grooved cylinder, operating in the manner hereinbefore described, by means of its connection with the piston rod, together with all the variations of which this principle is susceptible, as, for example, a bar of metal may be bent in the form of a groove, and attached to the revolving shaft, and friction wheels on the piston rod may embrace this on each side, producing an effect similar to that produced by the groove. I also claim the spiral propelling wheel, contracted and operating in the manner in which I have set forth, and likewise the application of the revolving vertical shaft to the turning of a capstan on the deck of a vessel. Not intending in either of these parts to confine myself to precise forms or dimensions, but to vary them in such manner as experience or convenience may

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dictate, whilst the principle of action remains unchanged, and similar results are produced by similar means."

"JOHN BROWN EMERSON"

At April term, 1844, Emerson brought an action of trespass on the case in the Circuit Court of the United States for the Southern District of New York against Hogg and Delamater for an infringement of his patent right. As one of the points decided by the court was whether or not the allegations of the declaration corresponded with the evidence of the patent, it is thought proper to insert the declaration. It was as follows, *viz.:*

"John B. Emerson, a citizen of the State of New York, by Peter Clark, his attorney, complains of Peter Hogg and Cornelius Delamater, citizens of the same state, defendants, in custody &c.;, of a plea of trespass on the case."

"For that, whereas the said plaintiff was the original inventor of a certain new and useful improvement, in the letters patent hereinafter mentioned and fully described, the same being a certain improvement in the steam engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, which was not known or used before his said invention and which was not, at the time of his application for a patent, as hereinafter mentioned, in public use with his consent or allowance. And the said plaintiff being so as aforesaid the inventor thereof, and being also a citizen of the United States, on the eighth day of March, one thousand eight hundred and thirty four, upon due application therefor, did obtain certain letters patent therefor, in due form of law, under the seal of the United States, signed by Andrew Jackson, then President, and countersigned by Louis McLane, then Secretary of State, bearing date the day and year aforesaid, whereby there was secured to him, the said plaintiff, his heirs, executors, administrators, or assigns, for the term of fourteen years from and after the date of the said patent, the exclusive right and liberty of making, using, and vending to others to be used, the said improvement, as by the said letters patent in court to be produced will fully appear. And the said plaintiff further says that the said defendants, well knowing the said several premises but contriving, and wrongfully and injuriously intending to injure the plaintiff and deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, and vending of the said invention or improvement after the making and issuing of the said letters patent, and within the term of fourteen years in said letters patent mentioned, to-wit, on the

first day of January, eighteen hundred and forty, and on divers other days and times between that time and the commencement of this suit, at the City of New York, and within the Southern District of New York, wrongfully and unjustly, without the leave or license, and against the will, of the plaintiff, made and sold divers, to-

wit, ten machines for propelling boats, in imitation of the said invention and improvement or a part of the said invention or improvement, to the benefit, use, and enjoyment whereof the said plaintiff was and is entitled as aforesaid, in violation and infringement of the said letters patent, and of the exclusive right and privilege to which the plaintiff was and is entitled as aforesaid, and contrary to the form of the statutes of the United States in such case made and provided."

"And the said plaintiff further says that the said defendant, well knowing the said several premises, but further contriving and intending as aforesaid, after the obtaining of the said letters patent by the said plaintiff as aforesaid, and within the said term of fourteen years, to-wit, on the said first day of January, eighteen hundred and forty and at divers other times between that day and the commencement of this suit, within the Southern District of New York aforesaid, wrongfully and unjustly, without the leave or license, and against the will of the plaintiff, did make and sell divers, to-wit, ten improved machines for propelling boats or vessels upon the water, constructed in a similar form and acting upon the same principle as the said machine or improvement, to the benefit, use, and enjoyment whereof the said plaintiff was and is entitled by his said letters patent as aforesaid, in violation and infringement of the exclusive right so secured to the said plaintiff by the said letters patent as aforesaid, and contrary to the form of the statute in such case made and provided."

"And the said plaintiff further says that the said defendant, well knowing the said several premises but contriving and intending as aforesaid, after the obtaining of the said letters patent by the said plaintiff as aforesaid and within the said term of fourteen years, to-wit, on the said first day of January, eighteen hundred and forty and at divers other times between that day and the commencement of this suit, in the Southern District of New York aforesaid, wrongfully and unjustly and without the consent or allowance and against the will of the plaintiff did imitate in part and make a certain addition to the said invention or improvement to the benefit, use, and enjoyment whereof the plaintiff was and is entitled as aforesaid, in breach of the said letters patent and in violation and infringement of the exclusive right and privilege so secured to the

said plaintiff as aforesaid, and contrary to the form of the statute in such case made and provided."

"By means of the committing of which said several grievances by the said defendants as aforesaid the said plaintiff is greatly injured and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived from the said invention and improvement in the said letters patent described and set forth, and in respect whereof he was and is entitled to such privilege as aforesaid, and was and is otherwise damnified to the damage of the said plaintiff of ten thousand dollars, and therefore,"

&c.;

To this declaration, the defendants pleaded the general issue and filed a copy of the special matters of defense to the action.

In May, 1847, the cause came on for trial. The patent was given in evidence, when the counsel for the defendants prayed the court to instruct the jury that the patent thus produced in evidence by the said plaintiff was void, for the reasons following:

1. That the claim of the plaintiff, as set forth in his specification annexed to his letters patent, embraces the entire spiral paddle wheel; the claim is therefore too broad upon the face of it, and the letters patent are void upon this ground, and the defendants are entitled to a verdict.

2. That the patent is void upon its face, for this, that purporting to be a patent for an improvement and specifying that the invention is of "an improved spiral paddle wheel, differing essentially from any which have heretofore been essayed," without pointing out in what the difference consists or in any manner whatever indicating the improvement by distinguishing it from the previously essayed spiral paddle wheels, it is wanting in an essential prerequisite to the validity of letters patent for an improvement.

3. That the patent is void upon its face, for this, that it embraces several distinct and separate inventions as improvements in several distinct and independent machines susceptible of independent operation not necessarily connected with each other in producing the result arrived at in the invention, and the subject matter of separate and independent inventions.

4. It appears in evidence that the drawing and model of the paddle wheel of plaintiff filed and deposited originally in the patent office had been lost by the destruction of that office in December, 1836, and that in restoring the record of the patent, under the act of March, 1837, the plaintiff sent from New Orleans to the office a new drawing, to be filed on 5 May, 1841, together with a court copy of the letters patent which were deposited in the office. The drawing was not

sworn to by he plaintiff, but remained in the office till January, 1844, when it was delivered to an agent of the plaintiff and sent to New Orleans, and sworn to by him, and filed in the department on 12 February, 1844. On an examination subsequently by the plaintiff, it was discovered that this drawing was imperfectly made, and thereupon a second drawing was procured by him, which he claimed and offered to prove to be an accurate one, and was sworn to, and filed on 27 March, 1844, an authenticated copy of which was offered in evidence on the trial by the plaintiff, which was objected to by the counsel for the defendants, but the objection was overruled and the evidence admitted, to which an exception was taken.

5. That if from the evidence the jury are satisfied that no propelling wheels were made by the defendants between 27 March, 1844, the date of the alleged completion of the record of the plaintiff's patent, under the Act of March 3, 1837, and the commencement of this suit in April following, that, upon this ground, the defendants are entitled to a verdict.

The court charged, in respect to the instructions prayed for, that

"The claim of the plaintiff was for an improvement on the spiral paddle wheel or propeller; that, by a new arrangement of the parts of the wheel, he had been enabled to effect a new and improved application and use of the same in the propulsion of vessels; that the ground upon which the claim is grounded was this: it is the getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others by placing the spiral paddles or propelling surfaces on the ends of arms instead of carrying the paddles themselves in a continued surface to the hub or shaft. It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that the improved wheel is made stronger. It was made a question on the former trial whether the plaintiff did not claim or intend to claim the entire wheel. But we understand it to be for an improvement upon the spiral paddle wheel, claimed to be new and useful in the arrangement of its parts, and more effective, by fixing the spiral paddles upon the extremity of arms, at a distance from the shaft."

The court further instructed the jury that "the description of the invention was sufficient, and that the objection, that the parts embraced several distinct discoveries, was untenable."

The court further charged

"That the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the patent office, and the bringing of the suit. Such a limitation assumes

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that there can be no infringement of the patent after the destruction of the records, in 1836, until they are restored to the patent office, and that during the intermediate time, the rights of patentees would be violated with impunity."

We do not assent to this view.

In the first place, the act of Congress providing for the restoration was not passed till 3 March, 1837, and in the second place, in addition to this, a considerable time

must necessarily elapse before the act would be generally known, and then a still further period before copies of the drawings and models could be procured. Patentees are not responsible for the fire, nor did it work a forfeiture of their rights.

The ground for the restriction claimed is that the community have no means of ascertaining, but by a resort to the records of the patent office, whether the construction of a particular machine or instrument would be a violation of the rights of others, and the infringement might be innocently committed.

But if the embarrassment happened without the fault of the patentee, he is not responsible for it; nor is the reason applicable to the case of a patent that has been published, and the invention known to the public. The specification in this case had been published. It is true if it did not sufficiently describe the improvement without the aid of the drawing, this fact would not help the plaintiff. If there had been unreasonable delay and neglect in restoring the records, and in the meantime a defendant had innocently made the patented article, a fair ground would be laid for a mitigation of the rule of damages, if not for the withholding them altogether, and the court left the question of fact as to reasonable diligence of the patentee or not in this respect, and also all questions of fact involved in the points of the case for the defendants, to the jury.

The counsel for the defendants excepted to each and every part of the charge of the court so far as said charge did not adopt the prayer on the part of the defendants.

The verdict of the jury was that

"The said Peter Hogg and Cornelius Delamater, the defendants, are guilty of the premises within laid to their charge in manner and form as the said John B. Emerson hath within complained against them, and they assess the damages of the said plaintiff, on occasion thereof, over and above his costs and charges by him about this suit in this behalf expended, at one thousand five hundred dollars, and for those costs and charges at six cents."

The judgment of the court was

"That the said John B. Emerson do recover against the said Peter Hogg and Cornelius Delamater his damages, costs, and charges in form aforesaid

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by the jurors aforesaid assessed, and also three hundred and twenty four dollars and fifteen cents for his said costs and charges by the said court now here adjudged of increase to the said John B. Emerson, and with his assent, which said damages, costs, and charges, in the whole, amount to one thousand eight hundred and twenty four dollars and fifteen cents. "

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MR. JUSTICE WOODBURY delivered the opinion of the Court.

This is a writ of error brought under some peculiarities which are first to be noted.

It comes here by virtue of the 17th section of the general patent law of July 4, 1836, 5 Stat. 124.

That section grants a writ of error from decisions in actions on patents, as in ordinary cases, and then adds the privilege of it "in all other cases in which the court shall deem it reasonable to allow the same." This was doubtless intended to reach suits where the amount in dispute was less than $2,000, on account of the importance of the points sometimes raised, and the convenience of having the decisions on patents uniform, by being finally settled, when doubtful, by one tribunal, such as the Supreme Court.

The judges below, in this case, deemed it reasonable, that only a certain portion of the questions raised at the trial, concerning the validity of the patent, should come here, and the record was made up accordingly.

But the appellants contend for their right to bring here all the questions which arose in the case, and this is a preliminary point to be settled before going into the merits. The present is believed to be the first writ of the kind, which has given occasion for settling the construction of any part of the above provision, and

therefore, without the aid of precedent, after due consideration of the words and design of the statute, we have come to the conclusion, that the position of the plaintiffs in error, in this respect, is the correct one, and that when a court below deem it "reasonable" to allow a writ of error at all, under the discretion vested in them by this special provision, it must be on the whole case.

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The word "reasonable" applies to the "cases," rather than to any discrimination between the different points in the cases.

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

We shall therefore proceed to examine all the questions made at the trial, which it is supposed are relied on, and are now before us on the original writ and a certiorari issued since.

Looking to the declaration, the action is for a violation of a patent for an "improvement in the steam engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The evidence offered at the trial was a patent for "a new and useful improvement in the steam engine," "a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents."

In the schedule annexed is described fully what he says he invented, *viz.,* "certain improvements in the steam engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The first question arising on this statement is whether the evidence proves such a patent as is set out in the writ to have been violated by the respondents.

If the patent is to be ascertained from the letters alone, or rather from what is sometimes called their title or heading, without reference to the schedule annexed, the evidence is undoubtedly defective, as the writ speaks of a patent for an "improvement in the steam engine and in the mode of propelling" vessels &c.;, therewith, while the letters themselves, in their title or heading, speak only of a patent for "a new and useful improvement in the steam engine." But the schedule annexed and referred to for further description, after "improvement in the steam engine," adds, "and in the mode of propelling therewith" vessels &c.;

It can hardly be doubted, therefore, that the improvement

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referred to in the writ and in the letters patent, with the schedule or specification annexed, was in truth one and the same.

Coupling the two last together, they constitute the very thing described in the writ. But whether they can properly be so united here, and the effect of it to remove the difficulty, have been questioned and must therefore be further examined. We are apt to be misled in this country by the laws and forms bearing on this point in England being so different in some respects from what exist here.

There, the patent is first issued, and contains no reference to the specification except a stipulation that one shall, in the required time, be filed giving a more minute description of the matter patented. Webster on Pat. 5, 88; Godson on Pat. 6, App. It need not be filed under two to four months, in the discretion of the proper officer. Godson on Pat. 176.

Under these circumstances, it will be seen that the patent, going out alone there, must in its title or heading be fuller than here, where it goes out with the minute specification. But even there it may afterwards be aided, and its matter be made more clear by what the specification contains. They are, says Godson on Pat. 108, "connected together," and "one may be looked at to understand the other." *See also* 2 Hen.Bl. 478; 1 Webst.Pat. 117; 8 D. & E. 95.

There, however, it will not answer to allow the specification, filed separately and long after, to be resorted to for supplying any entire omission in the patent, else something may be thus inserted afterwards which had never been previously examined by the proper officers, and which, if it had been submitted to them in the patent and examined, might have prevented the allowance of it, and which the world is not aware of, seeing only the letters patent without the specification, and without any reference whatever to its contents. 3 Brod. & Bingh. 5.

The whole facts and law, however, are different here. This patent issued March 8, 1834, and is therefore to be tested by the act of Congress then in force, which passed February 21, 1793, 1 Stat. 318.

In the third section of that act it is expressly provided "that every inventor, before he can receive a patent," "shall deliver a written description of his invention," &c.;, thus giving priority very properly to the specification rather than the patent.

This change from the English practice existed in the first patent law, passed April 10, 1790, 1 Stat. 109, and is retained in the last act of Congress on this subject, passed July 4, 1836, 5 Stat. 119.

It was wisely introduced in order that the officers of the government might at the outset have before them full means to

examine and understand the claim to an invention better and decide more judiciously whether to grant a patent or not, and might be able to give to the world fuller, more accurate, and early descriptions of it than would be possible under the

laws and practice in England.

In this country, then, the specification being required to be prepared and filed before the patent issues, it can well be referred to therein *in extenso,* as containing the whole subject matter of the claim or petition for a patent, and then not only be recorded for information, as the laws both in England and here require, but beyond what is practicable there, be united and go out with the letters patent themselves, so as to be sure that these last thus contain the substance of what is designed to be regarded as a portion of the petition, and thus exhibit with accuracy all the claim by the inventor.

But before inquiring more particularly into the effect of this change, it may be useful to see if it is a compliance with the laws in respect to a petition which existed when this patent issued, but were altered in terms shortly after.

A petition always was and still is required to be presented by an inventor when he asks for a patent, and one is recited in this patent to have been presented here. It was also highly important in England that the contents of the petition as to the description of the invention should be full in order to include the material parts of them in the patent, no specification being so soon filed there as here, to obtain such description from, or to be treated as a portion of the petition, and the whole of it sent out with the patent, and thus complying with the spirit of the law and giving fuller and more accurate information as to the invention than any abstract of it could.

In this view, and under such laws and practice here, it will be seen that the contents of the petition, as well as the petition itself, became a very unimportant form, except as construed to adopt the specification, and the contents of the latter to be considered substantially as the contents of the former.

Accordingly it is not a little curious that though the act of 1793, which is to govern this case, required, like that of 1790, a petition to be presented, and the patent when issued, as in the English form, to recite the "allegations and suggestions of the petition," 1 Stat. 321, sec. 1, and 110, sec. 3, yet, on careful inquiry at the

proper office, so far as its records are restored, it appears that after the first act of 1790 passed, the petitions standing alone seldom contained anything as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions or descriptions whatever except those in the

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schedule or specification. The only exception found is the case of *Evans v. Chambers,* 2 Wash.C.C. 125, in a petition filed December 18, 1790.

Though the records of the patent office before 1836 were consumed in that year, many have been restored, and one as far back as August 10, 1791, where the petition standing alone speaks of having invented only "an easy method of propelling boats and other vessels through the water by the power of horses and cattle." All the rest is left to the schedule. Other petitions, standing alone, are still more meager -- one, for instance, in 1804, asks a patent only of a "new and useful improvement, being a composition or tablets to write or draw on"; another only "a new and useful improvement in the foot stove"; and another only "a new and useful improvement for shoemaking," and so through the great mass of them for nearly half a century. But the specification being filed at the same time and often on the same paper, it seems to have been regarded, whether specially named in the petition or not, as a part of it and as giving the particulars desired in it, and hence, to avoid mistakes as to the extent of the inventor's claim and to comply with the law by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. This may have grown out of the decision of *Evans v. Chambers* in order to remedy one difficulty there. Cases have been found as early as 1804, and with great uniformity since, explicitly making the schedule annexed a part of the letters patent. Proofs of this exist also in our reports as early as 1821, in *Grant v. Raymond,* 6 Pet. 222, and one 1 Oct., 1825, in *Gray v. James,* Pet.C.C. 394, and 27 Dec. 1828, *Wilson v. Rousseau,* 4 How. 649.

Indeed it is the only form of a patent here known at the patent office, and the only one given in American treatises on patents. Phillips on Pat. 523. Doubtless this use of the schedule was adopted because it contained, according to common understanding and practice, matter accompanying the petition as a part of its substance and all the description of the invention ever desired either in England or here in the petition. Hence it is apparent, if the schedule itself was made a part of the patent and sent out to the world with it, all, and even more, was contained in it than could be in any abstract or digest of a petition as in the English form.

We regard this mode and usage on this subject, adopted so early here and practiced so long, as not proper to be overruled now, to the destruction of every patent, probably, from 1791 to

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1836, and this too when the spirit of all our system was thus more fully carried out than it could have been in any other way.

As this course, however, sometimes was misunderstood and led to misconstructions, the revising act as to patents, in July 4, 1836, changed the phraseology of the law in this respect, in order to conform to this long usage and construction under the act of 1793, and required not in terms any abstract of the petition in the patent, but rather "a short description" or title of the invention or discovery, "correctly indicating its nature and design," and "referring to the specification for the particulars thereof, a copy of which shall be annexed to the patent." And it is that -- the specification or schedule -- which is fully to specify "what the patentee claims as his invention or discovery." Sec. 5, 5 Stat. 119.

It was therefore, from this long construction, in such various ways established or ratified that, in the present patent, the schedule, or, in other words, the specification, was incorporated expressly and at length into the letters themselves -- not by merely annexing them with wafer or tape, as is argued, but describing the invention as an

"improvement, a description whereof is given in the words of the said John B. Emerson himself in the schedule hereto annexed, and is made a part of these presents."

Hence too, wherever this form has been adopted, either before or since the act of 1836, it is as much to be considered with the letters -- *literae patentes* -- in construing them, as any paper referred to in a deed or other contract. Most descriptions of lands are to be ascertained only by the other deeds and records expressly specified or referred to for guides, and so of schedules of personal property, annexed to bills of sale. *Foxcroft v. Mallett,* 4 How. 378; 21 Me. 69; 20 Pick. 122; Phil. on Pat. 228; *Earle v. Sawyer,* 4 Mason C.C. 9; *Ex Parte Fox,* 1 Ves. & Beames 67. The schedule, therefore, is in such case to be regarded as a component part of the patent. Pet.C.C. 394, and *Davis v. Palmer,* 2 Brockenbrought 301. The oath of Emerson, too, that he was inventor of the improvement must thus be considered as extending to all described in the schedule no less than the title, and this is peculiarly proper when the specification is his own account of the improvement and the patent is usually only the account of it by another, an officer of the government. Taking, then, the specification and letters together, as the patent office and the inventor have manifestly in this instance intended that they should be, and they include what has long been deemed a part and the substance of the petition, and the patent described in them is quite broad enough to embrace what is alleged in the writ to have been taken out as a

patent by the plaintiff, and to have been violated by the defendants. They are almost *ipsissimis verbis.* And when we are called upon to decide the meaning of the patent included in these letters, it seems our duty not only to look for aid to the specification as a specification, which is customary, 1 Gall. 437; 2 Story 621; 1 Mason C.C. 477, but as a schedule, made here an integral portion of the letters themselves and going out with them to the world, at first, as a part and parcel of them, and for this purpose united together forever as identical.

It will thus be seen that the effect of these changes in our patent laws and the long usage and construction under them is entirely to remove the objection that the patent in this case was not as broad as the claim in the writ, and did not comply substantially with the requirements connected with the petition.

From want of full attention to the differences between the English laws and ours on patents, the views thrown out in some of the early cases in this country do not entirely accord with those now offered. Paine C.C. 441; *Pennock v. Dialogue,* 2 Pet. 1. Some other diversity exists at times in consequence of the act of 1793 and the usages under it in the patent office not being in all respects as the act of 1836. But it is not important, in this case, to go farther into these considerations.

The next objection is that this description in the letters thus considered covers more than one patent, and is therefore void.

There seems to have been no good reason at first, unless it be a fiscal one on the part of the government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed or patent for land. Phillips on Pat. 217.

Each could be set out in separate articles or paragraphs as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

But to obtain more revenue, the public officers have generally declined to issue letters for more than one patent described in them. Renouard 293; Phillips on Pat. 218. The courts have been disposed to acquiesce in the practice as conducive to clearness and certainty. And if letters issue otherwise inadvertently, to hold them, as a general rule, null. But it is a well established exception that patents may be united, if two or more, included in one set of letters, relate to a like subject, or are in their nature or operation connected together. Phil. on Pat. 218, 219; *Barrett v. Hall,* 1 Mason C.C. 447; *Moody v. Fiske,* 2 Mason C.C. 112; *Wyeth v. Stone,* 1 Story 273.

Those here are of that character, being all connected with the use of the improvements in the steam engine as applied to propel carriages or vessels, and may therefore be united in one instrument.

Another objection is that these letters, even when thus connected with the specification, are not sufficiently clear and certain in their description of the inventions.

This involves a question of law only in part, or so far as regards the construction of the written words used. *Reutgen v. Kanowrs,* 1 Wash.C.C. 168; *Davis v. Palmer,* 2 Brockenbrough C.C. 303; *Wood v. Underhill,* 5 How. 1. The degree of clearness and freedom from ambiguity required in such cases is, by the patent act itself of 1793, to be sufficient

"to distinguish the same from all other things before known, and to enable any person skilled in the are or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same."

1 Stat. 321. *See also,* on this, Godson on Pat. 153, 154; 2 Hen.Bl. 489; *Wood v. Underhill,* 5 How. 1; *Davoll v. Brown,* 1 Woodb. & Min. 57; Pet.C.C. 301; *Sullivan v. Redfield,* Paine C.C. 441.

There are some further and laudable objects in having exactness to this extent, so as, when the specification is presented, to enable the Commissioner of Patents to judge correctly whether the matter claimed is new or too broad. 16 U. S. 3 Wheat. 454; 3 Brod. & Bingh. 5; 1 Starkie N.P. 192. So also to enable courts, when it is contested afterwards before them, to form a like judgment. 1 Starkie N.P. 192. And so that the public, while the term continues, may be able to understand what the patent is and refrain from its use unless licensed. Webster on Pat. 86; 11 East 105; 3 Merivale 161; Evans v. Eaton, 3 Wash.C.C. 453; 4 Wash.C.C. 9; *Bovill v. Moore,* Davies' Cas. 361; *Lowell v. Lewis,* 1 Mason C.C. 182, 189.

In the present instance, yielding to the force of such reasons in favor of a due and rational degree of certainty in describing any improvements claimed as new, there still seems to us, though without the aid of experts and machinists, no difficulty in ascertaining from the language used here the new movement intended to be given to the steam engine by substituting a continued rotary motion for a crank motion, and the new form of the spiral wheel, when the engine is used in vessels, by changing the form of the paddles and placing them near the ends of the arms, and the new connection of the power with the capstan of such vessels by inserting the upper end of the shaft into the capstan. It is obvious also that the inventor

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claims as his improvement not the whole of the engine nor the whole of the wheel, but both merely in the new and superior form which he particularly sets out. He therefore does not claim too much, which might be bad. *Hill v. Thompson,* 2 J. Marsh. 435; 4 Wash.C.C. 68; Godson on Patents 189; *Kay v. Marshall,* 1 Mylne & Cranch 373; 1 Story 273; 2 Mason C.C. 112; 4 Barn. & Ald. 541; *Bovill v. Moore,* 2 Marsh.Com.P. 211.

The novelty in each he describes clearly, as he should; and it is not necessary he should go further. 1 Story 286; Webster on Pat. 86, note. *MacFarlane v. Price,* 1 Starkie 199; and *King v. Cutler, id.,* 354; 3 Car. & Payne 611; 2 Mason C.C. 112; Kingsby & Pirsson on Pat. 61; Godson on Pat. 154; *Isaacs v. Cooper,* 4 Wash.C.C. 259.

He need not describe particularly, and disclaim all the old parts. 20 U. S. 7 Wheat. 435; Phil. on Pat. 270, and cases cited.

And the more especially is that unnecessary, when such disclaimer is manifestly, in substance, the result of his claiming as new only the portions which he does describe specially. All which is required on principle in order to be exact, and not ambiguous, thus becomes so.

It is to be recollected likewise that the models and drawings were a part of this case below, and are proper to be resorted to for clearer information. *Earle v.*

Sawyer, 4 Mason C.C. 9. With them and such explanatory testimony as experts and machinists could furnish, the court below were in a condition to understand better all the details and to decide more correctly on the clearness of the description; but from all we have seen on the record alone, we do not hesitate to concur in the views on this point as expressed in that court.

In conclusion, on the other objections to the proof, as to the drawings and to the charge below in relation to the effect of them and to the destruction of them by fire, we likewise approve the directions given to the jury.

The destruction by fire was no fault of the inventor, and his rights had all become previously perfected. This is too plain to need further illustration. We cannot consent to be over-astute in sustaining objections to patents. 4 East 135; *Crosley v. Beverly,* 3 Car. & Payne 513, 514. The true rule of construction in respect to patents and specifications and the doings generally of inventors is to apply to them plain and ordinary principles, as we have endeavored to on this occasion, and not, in this most metaphysical branch of modern law, to yield to subtleties and technicalities, unsuited to the subject and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate

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and unskilled in business as men of genius and inventors usually are.

Indeed, the English letters patent themselves now, however different may have been once their form or the practice under them, declare that "they are to be construed . . . in the most favorable and beneficial sense, for the best advantage" of the patentee. Godson on Pat. 24, App. 7; Kingsby & Pirsson on Patents 35. *See also* on this rule *Grant v. Raymond,* 6 Pet. 218; *Ames v. Howard,* 1 Sumner 482, 485; *Wyeth v. Stone,* 1 Story 273, 287; *Blanchard v. Sprague,* 2 Story 164; 2 Brockenbrough C.C. 303; 2 Barn. & Ald. 345, in *The King v. Wheeler,* 5 How. 708, in *Wilson v. Rousseau,* 1 Crompt., Mees. & Ros. 864, 876, in *Russell v. Cowly.*

The judgment below is

Affirmed.

Note -- After the delivery of this opinion, the counsel for the plaintiffs in error suggested that other questions were made below which they desired to be considered, and therefore moved for another certiorari to bring them up. This was allowed and judgment suspended till the next term.