Wilson Vs. Simpson

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Appeal No. : 50 U.S. 109

Appellant : Wilson

Respondent : Simpson

Judgement :

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Wilson v. Simpson

50 U.S. (9 How.) 109

APPEAL FROM THE CIRCUIT COURT

OF THE UNITED STATES FOR LOUISIANA

SYLLABUS

The documents showing the title to Woodworth's planing machine are set forth *in extenso* in 45 U. S. 4 How. 647, *et seq.*

The assignment from Woodworth and Strong to Toogood, Halstead, and Tyack (45 U. S. 4 How. 655) declared not to have been fraudulently obtained according to the evidence in this case.

An assignee of Woodworth's planing machine, having a right, under the decision in 4 Howard, to continue the use of the patented machine, has a right to replace new cutters or knives for those which are worn out.

The difference explained between repairing and reconstructing a machine.

It was a continuation of the case of *Simpson v. Wilson,* 4 How. 710, where a statement of the case is given, which need not be here repeated. All the documents relating to the patent and transfer of Woodworth's planing machine are set forth *in extenso* in the case of *Wilson v. Rousseau,* 4 How. 647, *et seq.*

The report of the case in 4 Howard shows that the two following questions were certified to this Court, *viz.:*

"1. Whether, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, inured to the benefit of the said defendant, to the extent that said defendant was interested in said patent before such renewal and extension."

"2. Whether, by law, the assignment of an exclusive right to the defendant, by the original patentee or those claiming under him, to use said machine, and to vend the same to others for use, within the County of Escambia, in the Territory of West Florida, did authorize said defendant to vend elsewhere than in said County of Escambia, to-wit, in the City of New Orleans, State of Louisiana, plank, boards, and other materials, products

of a machine establish and used within the said County of Escambia, in the Territory of West Florida."

On 18 April, 1846, the decisions of the supreme court in these questions were certified to the circuit court, as follows:

"1. That by law the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, did not inure to the benefit of said defendant to the extent that said defendant was interested in said patent before such renewal and extension. But the law secured to persons in the use of machines at the time the extension takes effect the right to continue the use of the same."

"2. That an assignment of an exclusive right to use a machine, and to vend the same to others for use, within the specified territory, does authorize an assignee to vend elsewhere, out of the said territory, plank, boards, and other materials, the product of such machine."

Thereupon, leave was granted by the circuit court to the defendant, Forsyth, to amend his plea, and to the complainant to amend his bill.

And thereupon the complainant amended his bill --

1. By charging that the mutual deed between Woodworth and Strong of the one part, and the assignee of Emmons' patent before mentioned, was procured by the latter by fraud upon Woodworth and Strong, not discovered until the extension of the patent.

2. That the defendants had put in operation one new machine since the extension of the patent of 1842 took effect, and that they had rebuilt, by the addition of new parts, being substantial parts of Woodworth's invention, the old machines which they had in actual use at the expiration of the first term of the patent, so that they were practically no longer the same machine, and thus that the use of those machines, under the color of machines which had been in actual use at the expiration of that term, was a fraud upon the law.

Issue was joined upon these new matters. Evidence was taken upon them, as well as upon the question of the extent of infringement.

It is not necessary to insert this evidence, because the substance of it is stated in the opinion of the Court.

On 4 May, 1849, the cause came on to be heard before the circuit court, upon the bill, answers, replication, exhibits, and evidence, when the court decreed that the bill should be dismissed.

The complainant appealed to this Court.

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MR. JUSTICE WAYNE delivered the opinion of the Court.

In the argument of this case, the counsel for the appellant put his right to the relief sought by his bill upon two points. We will consider them in the order in which they were presented.

The appellant's first point is that the title and right of the defendants to use the Woodworth invention are taken from them by the fraud and artifice of Emmons, Tyack, Toogood, and Halstead, in procuring from Woodworth and Strong the deed of 28 December, 1829. Rec. 51, 52

The fraud alleged in the bill is that Emmons, having pirated Woodworth's invention, contrived, by misrepresentation, to get a patent for the same, and, in conjunction with Toogood, Halstead, and Tyack, falsely and fraudulently represented to Woodworth, and to Strong, his assignee, that Emmons was the first inventor of the planing machine, for which Woodworth had received the first patent; and that Woodworth and Strong, regarding it possible that such might be the fact, not suspecting any fraudulent device, and fearing, notwithstanding Woodworth knew the invention to be his own, it might be established against him, executed the agreement of 28 November, 1829, for which no other consideration was received than Emmons' pirated patent.

The case is before us upon the original bill, and as it was afterwards amended, upon answers and replication. The defendants traverse this allegation of fraud, as

fully as persons so situated can do, and deny any notice or knowledge about it, when they became the assignees of the invention for a valuable

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consideration. The complainant, then, must establish his charge by proofs. We think it has not been done.

The proof relied upon is that, though Emmons received a patent for what he claimed to be his invention, it was subsequently proved to be identical with the principle of Woodworth's machine, and had been pirated from it. That at the time Emmons applied for a patent, he had not in any way carried his machine into such a practical result, either in a model or execution, as to entitle him to letters patent. To this is added the declaration of two witnesses, Harris and Gibson, in a joint deposition (one of them we may suppose interested, from not having disavowed it, as his associate Gibson does),

"that they called upon Emmons in the City of New York, several years since, and shortly previous to his death, for the purpose of obtaining information in relation to an invention of a planing machine, said to have been invented by him while residing at Syracuse. That he then informed them that in the year 1824, being engaged in the erection of salt vats at Syracuse, he had contrived a machine by which the plank used for salt vats could be joined by means of knives upon a revolving cylinder. That he went so far as to satisfy himself, that boards and plank might be joined in that way; but the machine was never so far completed as to perform work with it; that he left Syracuse in July, 1824, and thought no more of the subject, until after William Woodworth had obtained his patent, when he was employed by Toogood, Tyack, and Halstead to defeat it."

Such is the testimony in this record in support of the charge, that the mutual deed of 28 November, 1829, was obtained by fraud. It is under that deed that the defendants claim the right to use the Woodworth machines in their possession.

Apart from the insufficiency of such testimony, in combination or separately, to establish the fraud, if we suppose it had been sworn to by Emmons, it would be

only hearsay, and not within any exception to the rule rejecting hearsay testimony. It is not so, on account of its being a dying declaration, or one made by Emmons at variance with his interest. Neither can it be brought under the exception, as an admission by one who is a party to a suit with others identified in interest with him, nor as coming from one having any interest in the suit, without being a party to the record with others who are so. And it is not the admission of one interested in the subject matter of the suit, where the law, in regard to that source of evidence, looks chiefly to the parties in interest, and gives to

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their admissions the same weight as though they were parties to the record.

In fact the declaration said to have been made by Emmons is merely hearsay; it cannot be made evidence for any purpose, of itself, or in connection with any other proof in the case not liable to any objection; it can neither aid nor be aided by other evidence.

We have put its exclusion on the ground stated, on account of the relations which the record shows Emmons had with some of the parties, rather than upon the little credit to which such a declaration from him would be entitled, from the difference and opposition between it and such as Emmons must have made when he applied for, and obtained, letters patent for what he claimed to be his invention.

Let us suppose, however, Emmons to be a competent witness to avoid an instrument obtained by the fraudulent devices of himself and his associates; and that there were independent corroborating proofs in confirmation of his credit in such a case. Still the declaration imputed to him would not, in any way, have disparaged the right or title of the assignees, under the deed of 28 December, 1829, their right having been acquired without notice of the fraud which the complainant says was practiced upon Woodworth and Strong.

The complainant can have no benefit under the first point urged by his counsel.

The second point upon which the counsel rely is that the defendants, as assignees under the deed, continue to use their machines, in fraud of the law, and in violation of the rights of the complainant. The specifications under the general proposition are that the defendants have substituted other machines for those used by them, before the expiration of the first term of Woodworth's patent. That they have reconstructed Woodworth's entire combination in the frames of their old machines, or supplied an essential constituent part of it, to continue in use those machines which this Court said they had a right to use as assignees, when this case was before it, upon certified points, in the year 1846. 45 U. S. 4 How. 709, 45 U. S. 711 .

There is no proof of either the first or second specification.

But the questions which were argued by counsel -- when repairs destroy identity and encroach upon invention, or when the thing patented ceases to exist, so as to exclude the repair or replacement of anyone part of its combination, in connection with the rest of it, not requiring repair, or to be replaced -- are before the Court upon the evidence in the record.

We admit, for such is the rule in *Wilson v. Rousseau,* 4

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How. 646, that when the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination.

But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists, for restoration to its original use, by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration, and not reconstruction.

Illustrations of this will occur to anyone, from the frequent repairs of many machines for agricultural purposes. Also from the repair and replacement of broken or worn-out parts of larger and more complex combinations for manufactures.

In either case, repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use. And it is no more than that, thought it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys, when the patentee sells to him a machine; and when he repairs the damages which may be done to it, it is no more than the exercise of that right of care which everyone may use to give duration to that which he owns, or has a right to use as a whole.

This foundation of the right to repair and replace, and its application to the point we are considering, will be found in the answers which everyone will give to two inquiries.

The right to repair and replace in such a case is either in the patentee, or in him who has bought the machine. Has the patentee a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair, who has, in the whole of it, a right of use? And what harm is done to the patentee in the use of his right of invention, when the repair and replacement of a partial injury are confined to the machine which the purchaser has bought?

Nothing is gained against our conclusion by its being said that the combination is the thing patented, and that, when its intended result cannot be produced from the deficiency of a part of it, the invention in the particular machine is extinct. It is not so. Consisting of parts, its action is only suspended by the want of one of them, and its restoration reproduces the same result only, without the machine having been made anew. Of course, when we speak of the right to restore a part of a deficient combination, we mean the part of one entirely

original, and not of any other patented thing which has been introduced into it, to aid its intended performance.

Nor is it meant that the right to replace extends to everything that may be patented. Between repairing and replacing there is a difference.

Form may be given to a piece of any material -- wood, metal, or glass -- so as to produce an original result, or to aid the efficiency of one already known, and that would be the subject for a patent. It would be the right of a purchaser to repair such a thing as that, so as to give to it what was its first shape, if it had been turned from it, or, by filing, grinding, or cutting, to keep it up to the performance of its original use. But if, as a whole, it should happen to be broken, so that its parts could not be readjusted, or so much worn out as to be useless, then a purchaser cannot make or replace it by another, but he must buy a new one. The doing of either would be entire reconstruction.

If, however, this same thing is a part of an original combination, essential to its use, then the right to repair and replace recurs. That this is so may be more satisfactorily shown by the Woodworth planing machine than any other we know, and particularly by the complaint here made against these defendants.

Woodworth's greatest merit, showing his inventive genius, is the adaptation of a well known tool to a new form and mechanical action, giving an almost wonderful efficiency to its use, and which, in the hundred efforts which had been made before, had not been accomplished. We mean its cutters for planing, tonguing, and grooving.

The complaint now is that the defendants, in the use of their old machines, have replaced new cutters for those which were worn out, in fraud of the ruling of this Court in its answer to the first point certified when this case was formerly here. *Simpson v. Wilson,* 4 How. 709.

This Court then said, that the renewal of the patent granted to William Woodworth, to William W. Woodworth, his executor, did not inure to the benefit of the defendants, to the extent they were interested in it before the renewal and

extension, but that the law saved to persons in the use of the machines at the time the extension took effect the right to continue the use. *Simpson v. Wilson,* 4 How. 711.

Wilson and Rousseau's Case, 4 How., was very fully considered by this Court. There were differences of opinion between the judges, as to the interest which assignees of an invention had in it under the eighteenth section of the act of

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1836, after the expiration of the first term of a patent, when there had been a renewal and extension of it. But it certainly did not occur to either of us, that the language then used by the court, and afterwards in *Simpson v. Wilson,* could make any difficulty in its application, or that it was subject to misapprehension.

It does not permit an assignee of the first term of a patent, after its renewal and extension, to make other machines, or to reconstruct it, in gross, upon the frames of machines which the assignee had in use when the renewal and extension of the patent took effect. But it does comprehend and permit the resupply of the effective ultimate tool of the invention, which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplated would have to be frequently replaced anew, during the time that the machine, as a whole, might last.

The proof in the case is that one of Woodworth's machines, properly made, will last in use for several years, but that its cutting knives will wear out and must be replaced at least every sixty or ninety days.

The right to replace them was a part of the invention transferred to the assignee for the time that he bought it, without which his purchase would have been useless to him, except for sixty or ninety days after a machine had been put in use. It has not been contended, nor can it be, that such can be a limitation of the assignee's right in the use of the invention.

If, then, the use of the machine depends upon the replacement of the knives, and the assignee could replace them from time to time, as they were needed, during the first term of the patent, though they are an essential and distinct constituent of the principle or combination of the invention, frequently replacing them, according to the intention of the inventor, is not a reconstruction of the invention, but the use only of so much of it as is absolutely necessary to identify the machine with what it was in the beginning of its use, or before that part of it had been worn out.

The right of the assignee to replace the cutter knives is not because they are of perishable materials, but because the inventor of the machine has so arranged them as a part of its combination, that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been but of little use to the inventor or to others. The other constituent parts of this invention, though liable to be worn out, are not made with reference to any use of them which will require them to be

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replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such a combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intentions, they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, its inventor cannot complain, if he sells the use of his machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used.

Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material.

Such being the case, and this Court having determined that the statute providing for the extension and renewal of patents saves the rights of assignees in the use of the machines which they may have in operation when the extension takes effect, we do not think that the defendants in this case, from having replaced cutter knives in their machines, have been using them in fraud of the law, or in violation of the rights of the complainant.

We shall therefore direct the decree of the court below, dismissing the complainant's bill, to be

Affirmed.

ORDER

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Louisiana, and was argued by counsel. On consideration whereof it is now here ordered, adjudged, and decreed by this Court that the decree of the said circuit court in this cause be and the same is hereby affirmed, with costs.