

Gayler Vs. Wilder

Gayler Vs. Wilder

SooperKanoon Citation : sooperkanoon.com/80200

Court : US Supreme Court

Decided On : 1850

Appeal No. : 51 U.S. 477

Appellant : Gayler

Respondent : Wilder

Judgement :

Gayler v. Wilder - 51 U.S. 477 (1850)

U.S. Supreme Court Gayler v. Wilder, 51 U.S. 10 How. 477 477 (1850)

Gayler v. Wilder

51 U.S. (10 How.) 477

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

SYLLABUS

An assignment of a patent right, made and recorded in the Patent Office before the patent issued, which purported to convey to the assignee all the inchoate right which the assignor then possessed, as well as the legal title which he was about to

obtain, was sufficient to transfer the right to the assignee, although a patent afterwards was issued to the assignor.

When an assignment is made under the fourteenth section of the act of 1836 of the exclusive right within a specified part of the country, the assignee may sue in his own name, provided the assignment be of the entire and unqualified monopoly. But any assignment short of this is a mere license, and will not carry with it a right to the assignee to sue in his own name.

Therefore, an agreement that the assignee might make and vend the article within certain specified limits, upon paying to the assignor a cent per pound, reserving, however, to the assignor the right to establish a manufactory of the article upon paying to the assignee a cent per pound, was only a license, and a suit for an infringement of the patent right must be conducted in the name of the assignor.

Where a person had made and used an article similar to the one which was afterwards patented, but had not made his discovery public, using it simply for his own private purpose, and without having tested it so as to discover its usefulness, and it had then been finally forgotten or abandoned; such prior invention and use did not preclude a subsequent inventor from taking out a patent.

The defendant in error who was plaintiff in the court below brought an action against Gayler and Brown the plaintiffs in

Page 51 U. S. 478

error, for an alleged infringement of a patent right for the use of plaster of Paris in the construction of fire-proof chests.

In the declaration it was averred that one Daniel Fitzgerald was the original and first inventor of a new and useful improvement in fire-proof chests or safes, and that letters patent were granted him therefor bearing date 1 June, 1843. The patent was in the usual form, and was set out in the declaration, the specification annexed to which was as follows:

" *To all whom it may concern:*"

"Be it known that I, Daniel Fitzgerald, of the City, County, and State of New York, and a citizen of the United States, have discovered and made an improvement, new and useful, in the construction of iron chests, or safes, intended to resist the action of fire, and for the safe-keeping and preserving books and papers, and other valuables, from destruction by fire, which I call a Salamander safe or chest."

"The following is a full and exact description of the safe or chest, with my improvement combined therewith:"

"I make two iron chests, in the common and ordinary way of making iron chests, which is well known to those engaged in this branch of business, one smaller than the other, which, when the safe is put together, forms the inner chest, or inner part of the safe. The other chest is made about three inches larger than the inner one, and so as, when put together, it will form the outer part or crust of the safe, and leave a space between the inner and outer chests of the safe of about three inches, which space may vary a little, more or less, when the chests are put together, but should be the same all round, and in every direction. The inner and outer doors, where two doors are used, are prepared in the same way, leaving a space, as above, between the inner and outer crust of each door, which space is left for a like purpose with that left between the inner and outer chest of the safe. Where one door is used, it should be made in the same manner, leaving a like space between the inner and outer crust or face of the door, and for a like purpose, and should be fitted to the chest or safe with great accuracy. The edges and openings for the doors are to be neatly finished, as in other chests. I then take plaster of Paris or gypsum, and, having boiled it or baked it in an oven, and calcined it, and reduced it to a powder, I mix it with water till it is about the consistency of cream or thin paste, so fluid as that it may readily be poured into the space left as above to receive it, and I then fill all the space with the plaster of Paris, putting in some sheets of mica between the inner and outer chest, to aid, if necessary, in checking the progress of the heat. "

"But where pains are taken to have all the space left for the purpose properly filled with the plaster of Paris, as above, so that when set it will expand and adhere firmly to the surrounding parts, and completely fill the whole space, and all the cracks and joints, the mica may be dispensed with, and every other substance, and the plaster may be used alone. It may also be reduced to a powder, without being prepared as above, and used in that state, but I have not found it as good."

"The inner case or chest may be made of wood instead of iron, as for a bookcase, and if the space left between that and the outer chest be filled in the manner and with the materials above named, it will make a very durable safe, that will effectually resist the fire, as I have found by experience, but the safe may not be so strong or durable, though somewhat cheaper."

"The above composition or preparation of gypsum may be mixed with several other articles not contrary to its nature, with a view to increase its efficacy in resisting the action of fire, but from my experience I doubt if they have much effect. The gypsum alone, when properly prepared, and properly placed in the space left to receive it, and made to fill it completely, is quite sufficient to resist, for a long space of time, the most intense heat. The chemical properties of this article are such, that, by the application of intense heat, it imparts a vapor or gas, or some other properties, which effectually stay the progress of the fire, and arrest the influence and effects of the heat; this I have ascertained by various experiments; and I believe I am the first man that discovered the utility, and devised the method of applying gypsum, or plaster of Paris, to increase the safety of an iron chest. I am not aware that this article was ever used for the purposes above set forth, until I used it in the manner above described."

"I therefore claim as my discovery and invention and improvement, the application and use of plaster of Paris or gypsum in its raw state or prepared as above, either alone or with mica, in the construction of all iron chests or safes in the manner above described or in any other manner substantially the same."

"DANIEL FITZGERALD"

"Witnesses:"

"G. H. PATTERSON"

"BEVERLEY R. HENSON, Jr."

It was also averred in the declaration that before the date of said letters patent, to-wit, on 7 April, 1839, the said Daniel Fitzgerald made an assignment, which was duly recorded in the Patent Office of the United States, on 1 June, 1839, as follows:

Page 51 U. S. 480

"Whereas I, Daniel Fitzgerald, of the City, County, and State of New York, have invented certain improvements in safes, which invention I call the 'Salamander safe,' for which I am about to make application for letters patent of United States."

"And whereas E. Wilder, of New York aforesaid, has agreed to purchase from me all right and title, and interest which I have or may have in and to the said invention in consequence of the grant of letters patent therefor, and has paid to me, the said Fitzgerald, the sum of five thousand dollars, the receipt whereof is hereby acknowledged, "

"Now this indenture witnesseth that for and in consideration of the said sum to me paid, I have assigned and transferred to E. Wilder aforesaid the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor. And I hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder and his legal representatives."

"In testimony whereof, I have hereunto set my hand, and affixed my seal this 11 April, 1839."

"DANIEL FITZGERALD [SEAL]"

"Witnesses:"

"OWEN G. WARREN"

"CHARLES H. FOSTER"

The declaration then proceeded as follows:

"And the said plaintiff further saith that the said Enos Wilder, in his lifetime, after the making of the said assignment by the said Daniel Fitzgerald to the said Enos Wilder as afore mentioned and before the committing of the several grievances hereinafter mentioned, to-wit, on the first day of September, in the year of our Lord 1843, and within the Southern District of New York aforesaid, did execute a certain instrument or agreement to the said plaintiff whereby the said Enos Wilder, in consideration of the agreement made with the said plaintiff, and of one dollar to him, the said Enos Wilder, in hand paid by the said plaintiff, bargained, sold, conveyed, and assigned to the said plaintiff all the right, title, and interest of him, the said Enos Wilder, in and unto the patent granted to the said Daniel Fitzgerald, for an improvement in fire-proof safes and chests by the use of prepared gypsum, dated June 1, 1843, and of which patent he, the said Enos Wilder, was the sole owner and assignee, as will appear by the records of the Patent Office, and which patent he, the said Enos Wilder, had good right to sell and convey to the said plaintiff, to be by him, the said plaintiff, held as his own property, free from all

Page 51 U. S. 481

claims from the said Enos Wilder or anyone claiming under him, the said Enos Wilder, as by the said instrument or agreement, sealed with the seal of the said Enos Wilder, ready in court to be produced, will, reference thereunto being had, fully and at large appear."

This last-mentioned instrument was averred to have been recorded in the Patent Office of the United States on 10 October, 1843.

It was then averred that by virtue of the last-mentioned instrument, plaintiff became, and ever since hath been, sole owner of said improvement &c.;, yet, the defendants well knowing &c.;

The defendants pleaded the general issue, and gave notice that they would offer evidence that Daniel Fitzgerald was not the first and original inventor of the improvement patented.

The bill of exceptions was as follows:

" *BENJAMIN G. WILDER v. CHARLES J. GAYLER AND LEONARD BROWN* "

"Be it remembered that, on the trial of the aforesaid issue, the plaintiff, to maintain the same, after having read said patent in evidence as set forth in the declaration, read the following conveyance and agreement, which was duly recorded, and a copy of which was, at the date of said patent, endorsed on the same, viz.: "

"[Here was inserted the conveyance from Fitzgerald to Enos Wilder of 11 April, 1839, already set out in full in the declaration.]"

"And thereupon the defendants insisted that said instrument did not convey the legal title of said patent to the said Enos Wilder, and that, upon such conveyance, he could not have brought a suit on the same, but said court decided that said instrument operated to convey the interest in said patent to said Enos Wilder, so that during his life he could have maintained an action at law on the same, to which opinion of said court the counsel for the defendants then and there excepted."

" *1st Exception* "

"And the plaintiff then read the conveyance from said Enos Wilder to him, as stated in his said declaration, which he insisted made out a right in him to sustain his aforesaid action, but the defendants, to show that, after the date of the conveyance to the plaintiff, and before he commenced this action, he made, executed, and delivered to Silas C. Herring, Esq., the following agreement and conveyance, namely:"

" Benjamin G. Wilder agrees with Silas C. Herring to grant to him the sole and exclusive right to make the safe, called the

Salamander safe, according to the terms and upon the plan pointed out and described in the patent and specification of Daniel Fitzgerald, which patent is dated June 1, 1843, and was assigned to Enos Wilder, and by him to Benjamin G. Wilder, who now owns the same; and this license is to be for the City, County, and State of New York, and said Herring is to have and enjoy the full and exclusive right to make and vend said safes in the City, County, and State of New York, and nowhere else; the said Herring is to have the same for the residue of the unexpired term of said patent, with all the improvements which may be made in the manufacture of said safes which said B. G. Wilder may have a right to use during said term, and said Herring agrees that said Wilder may use all the improvements which he may make or have a right to use during said term. In consideration whereof, said Herring agrees with said Benjamin G. Wilder to pay to him, for the use of the right aforesaid, one cent a pound for each and every pound said safes may weigh when finished and sold, which sum is to be paid monthly so long as said patent remains in full force and until the same has been set aside by the highest court of the United States to which the same may be carried; but said Herring agrees to pay the one cent a pound for the space of two years at all events and whether said patent shall be declared good or not. If sustained, then said Herring is to pay as aforesaid for the full term as aforesaid. All the safes so made and sold by said Herring are to have said Wilder's patent marked thereon, the same as heretofore, in a plate, or cast in letters, 'Wilder's patent safe.' Said Herring agrees to keep an accurate account of all the safes by him made or caused to be made under said contract and patent, with the weight of each when sold, and the names of the persons to whom sold, and their places of abode, and to render said account monthly, if so often called on for it, and to pay accordingly. Said Herring is to manufacture all the safes he may sell or offer to sell under and according to said patent, with such improvements as he may have a right to use, and be marked as above with the words, in large, legible letters, 'Wilder's patent safe.'"

" Said Wilder reserves to himself the right to manufacture, in this City and State of New York or elsewhere, safes to sell out of this state and city, but if sold within this state or city, then said Wilder is to pay said Herring one cent a pound on each safe so made and sold within this city or state. Said Wilder is not himself to set up or establish nor authorize anyone else to set up and establish any manufactory or works for making Salamander safes or safes similar to said Salamander safes at any place within fifty miles of this city. Said

Page 51 U. S. 483

Herring is to make all safes like Wilder's, and not vary in any substantial part therefrom, with such improvements as may be added."

" In presence of"

"S. P. STAPLES, *Witness to both signatures* "

"New York, January 6, 1844"

" If said patent should not be decided to be good till the end of three years, then for the time over the two years, till decided good, said Herring pays nothing. It is further understood and agreed that all safes made by said Herring or in the making of which or the selling thereof he shall in any way be directly or indirectly concerned, consisting of a double case or box with the intermediate space filled with plaster or any nonconducting substance, shall be considered within this agreement, and be paid accordingly."

"B. G. WILDER"

"SILAS C. HERRING"

"(Received and recorded 30 January, 1844)"

" *2d Exception* "

"And thereupon the defendants insisted that the plaintiff had parted with all his interest in said patent by virtue of said agreement, so that he could not sustain his

aforesaid action. But said court decided that the plaintiff had not in and by said agreement so far parted with his interest in said patent as to deprive him of the right to sustain his aforesaid action, to which opinion of said court the defendants did then and there except."

" *3d Exception* "

"And the defendants then and there objected that the invention and improvement set forth and claimed in said patent as the invention of the patentee was not the subject of a patent; that it was the mere application of an old, well known material to a new purpose, which they insisted could not be the subject of a patent. But said court overruled said objection and instructed the jury as herein set forth, to which, as well as to the said instructions to said jury, the defendants excepted."

"And the plaintiff, to maintain his aforesaid issue, called sundry witnesses to prove, and claimed that he had proved, that he made the discovery which was the foundation of his invention and improvement as early as some time in the year 1830, that he made experiments in various ways, to test the utility of his discovery and improvement at different times in the different years from 1830 to 1836, when he applied for his

Page 51 U. S. 484

patent, and that he pursued with due diligence that application until he obtained his aforesaid patent, and that the delay which had arisen in obtaining said patent was not caused by the fault or negligence of the patentee, or his assignee, Enos Wilder, nor anyone else, but arose from the burning of the Patent Office and other causes not under the control of the applicants for the patent, and that the defendants had infringed said patent as set forth in said declaration."

"And the defendants introduced evidence to prove and claimed that they had proved that said Daniel Fitzgerald was not the first and original inventor of what he claimed in said patent as his improvement. Among other witnesses, James Conner testified that, between 1829 and 1832, he was engaged in business as a stereotype founder and, knowing that plaster of Paris was a nonconductor of heat,

he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris -- the same, substantially, as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in his counting room while he used it, and known to the persons working in the foundry."

"This testimony was confirmed by his brother, John Conner, except that he fixes the time of constructing the safe in the year 1831 or 1832. But one safe was made by Conner, and since it passed out of his hands he has used others of a different construction."

"The defendants also claimed that if said Daniel Fitzgerald was the first and original inventor of said improvement, as he claimed, yet that he had made said iron safes, and sold them, under such circumstances as that he had thereby abandoned the same and suffered the same to go into public use in such manner as to lose all right to said invention and improvement, if any he ever had."

"And the court thereupon instructed the jury that if they found that Daniel Fitzgerald, the patentee, was the first and original inventor of the said improvement claimed in said patent, and that the use of plaster of Paris, in combination with and in the construction of an iron safe, is new and useful, as in the specification of said patent is set forth and claimed, then they would find that the patent was valid, and protected the invention and improvement as claimed, unless the plaintiff or those under whom he claimed had abandoned said improvement to the public and suffered the same to go into public use before the application for said patent, of which facts the jurors were the judges. "

Page 51 U. S. 485

"And said court further instructed said jury that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use after said Fitzgerald's discovery and experiments, then it was not

in the way of Fitzgerald's patent, and the same was valid, but if the jury found that said James Conner made his said safe as claimed, and tested it by experiments before Fitzgerald's invention and improvement and before he tested the same, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent."

"The court further charged that, independently of these considerations, there was another view of the case as it respected the Conner safe: that it was a question whether the use of it by him and been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him if he be an original, though not the first, inventor or discoverer of the improvement."

" *4th Exception* "

"And said court, in summing up said case to said jury, further instructed them that if they found that Daniel Fitzgerald was the first and original inventor of said improvement, as set forth in said patent, and had not abandoned or dedicated the same to the public, but had with reasonable diligence pursued his invention till he had perfected the same, and used due diligence in applying for, and in pursuing his application for a patent, until he obtained the same, and if they found the defendants had made and sold safes, as charged in the plaintiff's declaration, then they would find their verdict for the plaintiff for such actual damages as they judged just and reasonable; but if they found otherwise, then they would find for the defendants. To each and all of these instructions given to the jury the counsel for the defendants excepted."

"And forasmuch as the facts aforesaid and the decisions of the court thereon do not appear of record, the defendants pray that this their bill of exceptions may be allowed."

"Filed 23 February, 1848."

"S. NELSON [SEAL]"

Page 51 U. S. 492

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

Three objections have been taken to the instructions given by the circuit court at the trial, and none of them is perhaps entirely free from difficulty.

The first question arises upon the assignment of Fitzgerald to Enos Wilder. The assignment was made and recorded in the Patent Office before the patent issued. It afterwards issued to Fitzgerald. And the plaintiffs in error insist that this

Page 51 U. S. 493

assignment did not convey to Wilder the legal right to the monopoly subsequently conferred by the patent, and that the plaintiff who claims under him cannot therefore maintain this action.

The inventor of a new and useful improvement certainly has no exclusive right to it until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against anyone for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. Fitzgerald possessed this inchoate right at the time of the assignment. The discovery had been made, and the specification prepared to obtain a patent. And it appears by the language of the assignment that it was intended to operate upon the perfect legal title which Fitzgerald then had a lawful right to obtain, as well as upon the imperfect and inchoate interest which he actually possessed. The assignment requests that the patent may issue to the assignee. And there would seem to be no sound reason for defeating the intention of the parties by restraining the assignment to the latter interest and compelling them to execute another transfer unless the act of Congress makes it necessary. The Court thinks it does not. The act of 1836

declares that every patent shall be assignable in law, and that the assignment must be in writing and recorded within the time specified. But the thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers -- the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the provisions of the act of Congress.

And we are the less disposed to give it a different construction because no purpose of justice would be answered by it, and the one we now give was the received construction of the act of 1793 in several of the circuits, and there is no material difference in this respect between the two acts. As long ago as 1825, it was held by Mr. Justice Story that in a case of this kind, an action could not be maintained in the name of the patentee, but must be brought by the assignee. 4 Mason 15. We understand the same rule has prevailed in other circuits, and if it were now changed, it might produce much injustice to assignees who have relied on such assignments, and defeat pending suits brought upon the faith

Page 51 U. S. 494

of long established judicial practice and judicial decision. Fitzgerald sets up no claim against the assignment, and to require another to complete the transfer would be mere form. We do not think the act of Congress requires it, but that when the patent issued to him, the legal right to the monopoly and property it created was, by operation of the assignment then on record, vested in Enos Wilder.

The next question is upon the agreement between the defendant in error and Herring. Is this instrument an assignment to Herring for the State or City of New York, upon which he might have sued in his own name? If it is, then this action cannot be maintained by the defendant in error.

Now the monopoly granted to the patentee is for one entire thing -- it is the exclusive right of making, using, and vending to others to be used, the

improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights, therefore, which may be exercised under it cannot be regulated by the rules of the common law. It is created by the act of Congress, and no rights can be acquired in it unless authorized by statute and in the manner the statute prescribes.

By the eleventh section of the act of 1836, the patentee may assign his whole interest or an undivided part of it. But if he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates.

By the fourteenth section, the patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assignment the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified -- excluding the patentee himself, as well as others. And any assignment short of this is a mere license. For it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed

Page 51 U. S. 495

by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place. Unquestionably a contract for the purchase of any portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of

justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. This is the view taken of the subject in the case of *Blanchard v. Eldridge*, J. W. Wallace 337, and we think it the true one.

Applying these principles to the case before us, the action was properly brought by the plaintiff below, and could not have been maintained by Herring.

The agreement is singularly confused and complicated. It purports to grant to Herring the exclusive right to make and vend the Salamander safe in the City, County, and State of New York, and Herring agrees to pay to the defendant in error a cent a pound for every pound the safes might weigh, to be paid monthly. But at the same time it reserves to Wilder the right to set up a manufactory or works for making these safes in the State of New York, provided it is not within fifty miles of the city, and to sell them in the State of New York, paying to Herring a cent a pound on each safe so sold within the state.

It is evident that this agreement is not an assignment of an undivided interest in the whole patent, nor the assignment of an exclusive right to the entire monopoly in the State or City of New York. It is therefore to be regarded as a license only, and under the act of Congress does not enable Herring to maintain an action for an infringement of the patent right. The defendant in error continues the legal owner of the monopoly created by the patent.

The remaining question is upon the validity of the patent on which the suit was brought.

It appears that James Conner, who carried on the business of a stereotype founder in the City of New York, made a safe for his own use between the years 1829 and 1832 for the protection of his papers against fire, and continued to use it until 1838, when it passed into other hands. It was kept in his counting room and known to the persons engaged in the foundry; and after it passed out of his hands, he used others of a different construction.

It does not appear what became of this safe afterwards. And there is nothing in the testimony from which it can be inferred that its mode of construction was known to the person into whose possession it fell, or that any value was attached

Page 51 U. S. 496

to it as a place of security for papers against fire, or that it was ever used for that purpose.

Upon these facts, the court instructed the jury

"That if Connor had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him, if he be an original, though not the first, inventor or discoverer."

The instruction assumes that the jury might find from the evidence that Conner's safe was substantially the same with that of Fitzgerald, and also prior in time. And if the fact was so, the question then was whether the patentee was "the original and first inventor or discoverer" within the meaning of the act of Congress.

The Act of 1836, ch. 357, § 6, authorizes a patent where the party has discovered or invented a new and useful improvement, "not known or used by others before his discovery or invention." And the 15th section provides that if it appears on the trial of an action brought for the infringement of a patent that the patentee "was not the original and first inventor or discoverer of the thing patented," the verdict shall be for the defendant.

Upon a literal construction of these particular words, the patentee in this case certainly was not the original and first inventor or discoverer if the Conner safe was the same with his and preceded his discovery.

But we do not think that this construction would carry into effect the intention of the legislature. It is not by detached words and phrases that a statute ought to be expounded. The whole act must be taken together, and a fair interpretation given

to it neither extending nor restricting it beyond the legitimate import of its language and its obvious policy and object. And in the 15th section, after making the provision above mentioned, there is a further provision that if it shall appear that the patentee at the time of his application for the patent believed himself to be the first inventor, the patent shall not be void on account of the invention or discovery's having been known or used in any foreign country, it not appearing that it had been before patented or described in any printed publication.

In the case thus provided for, the party who invents is not strictly speaking the first and original inventor. The law assumes that the improvement may have been known and used before his discovery. Yet his patent is valid if he discovered it by the efforts of his own genius, and believed himself to be

Page 51 U. S. 497

the original inventor. The clause in question qualifies the words before used, and shows that by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public. If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would therefore derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. But if the foreign discovery is not patented nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach, and as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor and protects his patent although the improvement had in fact been invented before and used by others.

So too as to the lost arts. It is well known that centuries ago discoveries were made in certain arts the fruits of which have come down to us, but the means by

which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if anyone now discovered an art thus lost and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention.

Upon the same principle and upon the same rule of construction, we think that Fitzgerald must be regarded as the first and original inventor of the safe in question. The case as to this point admits that although Conner's safe had been kept and used for years, yet no test had been applied to it, and its capacity for resisting heat was not known; there was no evidence to show that any particular value was attached to it after it passed from his possession or that it was ever afterwards used as a place of security for papers, and it appeared that he himself did not attempt to make another like the one he is supposed to have invented, but used a different one. And upon this state of the evidence, the court put it to the jury to say whether this safe

Page 51 U. S. 498

had been finally forgotten or abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he obtained the patent, directing them, if they found these two facts, that their verdict must be for the plaintiff. We think there is no error in this instruction. For if the Conner safe had passed away from the memory of Conner himself and of those who had seen it, and the safe itself had disappeared, the knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own efforts, without any knowledge of Conner's, he invented an improvement that was then new and at that time unknown, and it was not the less new and unknown because Conner's safe was recalled to his memory by the success of Fitzgerald's.

We do not understand the circuit court to have said that the omission of Conner to try the value of his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent, provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent.

The circumstances above mentioned, referred to in the opinion of the circuit court, appeared to have been introduced as evidence tending to prove that the Conner safe might have been finally forgotten, and upon which this hypothetical instruction was given. Whether this evidence was sufficient for that purpose or not was a question for the jury, and the court left it to them. And if the jury found the fact to be so, and that Fitzgerald again discovered it, we regard him as standing upon the same ground with the discoverer of a lost art or an unpatented and unpublished foreign invention, and like him entitled to a patent. For there was no existing and living knowledge of this improvement or of its former use at the time he made the discovery. And whatever benefit any individual may derive from it in the safety of his papers he owes entirely to the genius and exertions of Fitzgerald.

Upon the whole, therefore, we think there is no error in the opinion of the circuit court, and the judgment is therefore

Affirmed.

MR. JUSTICE Mc LEAN.

I dissent from the opinion of a majority of the judges in this case. The point of difference, I think, is essential to the maintenance of the rights of the public and also of inventors.

Page 51 U. S. 499

It was proved by James Conner, as appears from the bill of exceptions,

"that between 1829 and 1832 he was engaged in business as a stereotype founder, and knowing that plaster of Paris was a nonconductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris, the same, substantially, as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in the counting room while he used it, and was known to the persons working in the foundry."

This evidence was confirmed by another witness.

By the sixth section of the patent act of 1836 it is provided

"That any person or persons having discovered or invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, manufacture, or composition of matter, *not known or used by others before his or their discovery or invention thereof* "

may apply for a patent &c.; The applicant is required to *"make oath or affirmation that he does verily believe that he is the original and first inventor," &c.;*, *"and that he does not know or believe that the same was ever before known or used."*

The seventh section authorizes and requires the commissioner of Patents

"to make or cause to be made an examination of the alleged new invention or discovery, and if on such examination it shall not appear to the commissioner that the same had been *invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country,* "

&c.;, the commissioner may grant a patent.

In the fifteenth section it is provided,

"That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof, having before been known or used *in any foreign country*, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication."

From the above extracts it is seen that the patentee must be the inventor of the machine or the improvement of it or he can have no right. If the thing was known or used by others, he cannot claim a patent. Or if it was patented in a foreign country or described in any publication at home or in any

Page 51 U. S. 500

foreign country, he has no right to a patent. To this there is only the exception in the fifteenth section above cited. But this can have no influence in the present case.

Let these provisions of the statute be compared with the last two paragraphs of the charge of the court, as stated in the third exception:

"And said court further instructed the jury, that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid; but if the jury found that said James Conner made his said safe, as claimed, *and tested it by experiments*, before Fitzgerald's invention and improvements, *and before he tested the same*, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent."

This charge stands disconnected with any other facts in the case except those named, and in my judgment it is erroneous. If Conner's safe were identical with Fitzgerald's, and though it was of prior invention, *yet if it were not tested by experiments* before Fitzgerald's improvement and before he tested the same, the jury under the instruction were bound to find for Fitzgerald. And the case was thus

made to turn, not on the priority of invention only, but upon that *and the fact of its having been tested by experiments*. This introduces a new principle into the patent law. The right under the law depends upon the time of the invention. An experimental test may show the value of the thing invented, but it is no part of the invention.

"The court further charged that independently of these considerations, there was another view of the case as it respected the Conner safe; that it was a question whether the use of it by him had been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him if he be an original, though not the first, inventor or discoverer of the improvement."

If there be anything clear in the patent law, it is that the original inventor means the first inventor, subject only to the provision stated in the fifteenth section. This instruction presupposes that the safes are the same in principle. Now if the invention was patented abroad or was described in a foreign publication, both of which were unknown to the inventor in

Page 51 U. S. 501

this country, still his patent is void. So it is void if such invention has been known to any person in this country. The instruction says if Conner's invention "had been forgotten or abandoned," it was no obstacle to Fitzgerald's right. Can a thing be forgotten or abandoned that was never known? If known before Fitzgerald's invention, it is fatal to it. By whom must it have been forgotten? By the inventor, or the public, or both? And how must it have been abandoned? When an invention is abandoned, it is said to be given up to the public, and this is the sense in which the term abandonment is used in the patent law. Such an abandonment would be fatal to the right of Fitzgerald.

Conner's safe, as appears from the bill of exceptions, was used in his counting house, being accessible to everyone, some six or eight years. In 1838, it passed into other hands, but into whose hands it does not appear. In 1843, Fitzgerald obtained his patent. How long before that he made experiments to test the invention is not proved. At most, the time must have been less than five years. This is a short period on which to found a presumption of forgetfulness. The law authorizes no such presumption. It can never become the law. It is not founded on probability or reason. The question is was Conner's invention prior to that of Fitzgerald? That it was of older date by some ten or twelve years is proved. And the instruction, it must be observed, was founded on the supposition that both inventions were similar.

The instruction seems to attach great importance to the fact that Conner's safe was used only for his private purpose. This is of no importance. The invention is the question, and not the manner in which the inventor used it. The safe was constructed at the foundry, and must have been known to the hands there employed. How can it be ascertained that Fitzgerald was not informed by some of these hands of the structure of Conner's safe, or by someone of the many hundreds who had seen it in his counting house in the City of New York? It was to guard against this, which is rarely if ever susceptible of proof, that the act is express -- *if the thing patented was known before, the patent is void*. If the fact of this knowledge in anyone be established, it is immaterial whether the patentee may have known it or not -- it avoids his patent.

The law on this subject is not founded upon any supposed notions of equity. A foreign patent for the same thing, or a description of the thing in a foreign publication, is as effectual to avoid the patent as if the patentee had seen the prior invention. Notice to him is not important. The law is adopted on

Page 51 U. S. 502

a settled public policy which, while it is just to inventors, protects the rights of the public. Any other basis would open the door for endless frauds by pretended inventors, without the probability of detection. And especially does this new

doctrine of forgetfulness, or abandonment, used in any other sense than as recognized in the patent law, leaving such matters to a jury, overturn what I consider to be the settled law on this subject. Of the same character is the fact that the invention was used for private purposes. A thing may be used in that way and at the same time be public, as was the case with the Conner safe, and yet the jury are necessarily misled by such an instruction.

MR. JUSTICE DANIEL, dissenting.

Differing from the majority in the decision just pronounced, I proceed to state the grounds on which my dissent from that decision is founded.

On two essential points in this cause, it seems to me that the learned justice who tried it at the circuit has erred and that the decision here should therefore have been for a reversal of his judgment. Those points involve first the right of the plaintiff below to maintain his action upon the title or right of action deduced from Fitzgerald through Enos and Benjamin Wilder, and secondly a right to, or interest in the subject of the suit on the part of the plaintiff below, admitting to have been originally invented and used by some other person than Fitzgerald -- a right founded upon an assumption that this subject had been used in private only, or had, in the language of the learned justice, been "finally forgotten or abandoned" by such first inventor. These points are presented by the first and third exceptions of the plaintiffs in error to the rulings at the trial below. The plaintiff in the circuit court claimed by assignment from B. G. Wilder, assignee of Enos Wilder, assignee of Daniel Fitzgerald, alleged to have been the inventor of the Salamander safe. By the paper deduction of title it appears that, on 11 April, 1839, Fitzgerald, alleging that he had invented an improvement called the Salamander safe, for which he was about to apply for letters patent, for the consideration of five thousand dollars, sold the interest he then had or might thereafter have in this invention to Enos Wilder; that Enos Wilder, on 1 September, 1843, for the consideration of one dollar, assigned and transferred to the plaintiff all the right, title, and interest which he had derived from Fitzgerald under the agreement of 11 April, 1839; that no patent issued for this Salamander safe until the year 1843, when a patent was granted to Daniel Fitzgerald,

as the original inventor; that no patent for this invention has ever been granted either to Enos or B. G. Wilder, either as inventor or assignee of this safe; that the title, whatever it may be, rests upon the agreement between Fitzgerald and Enos Wilder of 11 April, 1839, before the patent to the former.

It must be recollected, that this is an action at law, and in order to maintain it, the plaintiff was bound to set out and to prove *a legal title*. Has he done either? What was the character of the interest or title transferred from Fitzgerald to Enos Wilder? This could not transcend the interest or title possessed by Fitzgerald himself, and what was this? A title to any specific machine which he may have constructed, and of which no person could rightfully deprive him, and a claim upon the goodwill and gratitude of the community, if in truth he should have conferred upon them a benefit by the discovery and construction of his machine. I speak now in reference to rights derivable from the common law, and independently of the Constitution or of statutory provisions. The mere circumstances of inventing and constructing a machine could no more inhibit its imitation than would the structure or interior arrangement of a house of peculiar ingenuity or convenience prevent the like imitation by anyone who could possess himself of its plan. The mere mental process of devising an invention enters not into the nature of property according to the common law; it forms no class or division in any of its enumerations or definitions of estates or property, and is a matter quite too shadowy for the practical character of that sturdy system.

A doctrine contrary to this, though with some discrepancy amongst the judges as to its extent, seems at one time to have obtained in the King's Bench, as propounded in the case of *Millar v. Taylor*, in 4 Burr. 2305, in opposition to the profound and unanswerable reasoning of Mr. Justice Yates; but upon a review of the same question in the Lords, in the case of *Donaldsons v. Becket*, the doctrine of the King's Bench was repudiated and that of the common law, as asserted by Yates, Justice, vindicated and restored. And indeed if, according to the opinions of some of the judges in the case of *Millar v. Taylor*, the mere mental process of invention constituted an estate or property at the common law, and property

vested *in perpetuo*, except so far as it should be transferred by the owner, it is difficult to perceive the necessity of a cautious and complicated system for the investment and security of interests already perfect and surrounded with every guard and protection which is inseparable under the

Page 51 U. S. 504

common law from every right it has created or recognized. But if the mere mental and invisible process of invention, apart from the specific, sensible, and individual structure, can be classed at all as property at law, it must partake of the character of a chose in action, much more so than an obligation or contract, the terms and conditions of which are defined and assented to by the contracting parties. To choses in action, it can scarcely be necessary here to remark, assignability is imparted by statutory enactment only, or by commercial usage. To hold that the single circumstance of invention creates an estate or property at law and an estate and legal title transmissible by assignment appears to me a doctrine not merely subversive of the common law, but one which contravenes the origin and course of legislation in England in relation to patent rights, and renders useless and futile both the constitutional provision and all the careful enactments of Congress for the security and transmissibility of the same rights. For why, as has been already remarked, should that provision and these enactments have been made for the establishment and security of that which was established and safe independently of both? I hold it, then, to be true, that the circumstance of *invention* invests no such perfect estate or right of property as can be claimed and enforced at law or in equity against the *user* of the same invention, either by subsequent inventors or imitators, and that any estate or property in the mere mental process of invention must be traced to and deducible from the Constitution and the acts of Congress alone. I cannot but regard as mischievous and alarming an attempt to introduce a *quasi* and indefinite, indefinable, and invisible estate, independently of the Constitution and acts of Congress and unknown to the rules and principles of the common law.

It is the *patent alone* which creates an estate or interest in the *invention* known to the law, and which can be enforced either at law or in equity, either by the

inventor or by the person to whom, by *virtue of the statute*, he may assign his rights. Down to the Act of Congress of 1837, nothing but the estate, interest, or property created or invested by *the patent itself* was made assignable. The language of the law is that "*every patent*," "*the exclusive right under any patent*," "*the thing patented*," may be assignable. The fact or existence of *a patent* is in every instance inseparable from the right given. It is this fact and this only which impresses the quality of assignability. Of course, under these provisions there could be no transfer of the legal title previously to a patent.

By section sixth of the Act of Congress approved March

Page 51 U. S. 505

3, 1837, it is provided that *thereafter* any patent *to be issued* may be made to the assignee of the inventor or discoverer, upon the conditions set forth in that section. Yet still it is presumed that until the issuing of a patent, so far is it from being true that a legal estate or title existed in such assignee, it is clear, on the contrary, that no *legal title* existed before the patent in the inventor himself, for it is the patent which constitutes his title. Of course, then, the assignee can at most hold nothing but an equity under such an assignment, which he may insist upon under this assignment against the inventor or against the government; but he has no legal title by force merely of such an assignment, and *a fortiori* he has no legal title, if the patent, notwithstanding such an assignment, is in fact issued to the inventor, but is thereby entirely excluded from all pretension to a legal title. Thus, in the case before us, the patent under which the plaintiff claims was, subsequently to the agreement between Fitzgerald and Enos Wilder, issued to Fitzgerald, the inventor, and according to the proofs in the cause has never been renewed to Enos Wilder, nor to any claimant under him, nor been assigned to any such claimant, but remains still in the alleged inventor, Fitzgerald. It seems to me, then, indisputable that the legal title indispensable for the maintenance of this suit *at law* never was in the plaintiff, and that he could not maintain the action.

The second instance in which I hold the learned justice who tried this cause to have erred is that in which he instructed the jury as follows:

"That if Conner had not made his *discovery public*, but had used it simply for his own private purpose, and it had been *finally forgotten or abandoned*, such *discovery* and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not *the first, inventor or discoverer* of the improvement."

In considering this instruction of the learned judge, the first vice with which it appears to be affected is its violation of a rule thought to be universally applicable to instructions to juries in trials at law, and that rule is this -- that instructions should always arise out of, and be limited to, the facts or the evidence in the cause to which the questions of law propounded from the bench should be strictly applicable, and that instructions which are general, abstract, or not springing from and pertinent to the facts of the case are calculated to mislead the jury and are therefore improper. Tried by this rule, the instruction of the learned judge, so far as it relates to Conner's not having made his discovery *public* or having finally forgotten or abandoned it, is certainly irrelevant to and unsustained by any evidence in the record. So far is the

Page 51 U. S. 506

existence of such testimony from being shown, the converse is proved and is justly inferable throughout, for although it does not appear that Conner advertised his invention in the public papers or claimed a patent for it, it is admitted that he used this safe in an extensive business establishment to which it is certain from the nature of his business the public had access, and it is not pretended that he made any effort at concealment of what he had invented, and the record is entirely destitute of evidence of an abandonment of his invention.

As to the assumption of his having forgotten it, there is neither a fact, an inquiry, nor conjecture in the testimony pointing to such a conclusion. The instruction appears to me to be wholly gratuitous and irrelevant. But supposing this instruction to have been founded upon testimony introduced before the jury, let us consider for a moment its correctness as a rule of law applicable to this cause. This charge, it must be recollected, admits that Conner was or might have been the first

inventor, and notwithstanding, asserts that Fitzgerald, though posterior in time, might, upon the conditions and considerations assumed by the judge, become the owner of the right. Are these conditions warranted either by the rules of public policy or by the terms and language of legislative provisions on such subjects?

It is said that patent privileges are allowed as incitements to inventions and improvements by which the public may be benefited. This position, that may be conceded in general, should not be made a means of preventing the great and public purposes its legitimate enforcement is calculated to secure. The admission of this principle leaves entirely open the inquiries whether he is more the benefactor of the public who makes a useful improvement which he generously shares with his fellow citizens or he who studies some device which he denies to all and limits by every means in his power to a lucrative monopoly, and still more whether the latter shall be permitted to seize upon that which had already as is here admitted been given to the public, thereby to levy contributions, not only on the community at large, but upon him even who had been its generous benefactor.

It was doubtless to prevent consequences like those here presented that the *priority* and *originality* of inventions are so uniformly and explicitly insisted upon in all the legislation of Congress, as will presently be shown. The tendency of the learned judge's charge to mislead the jury from its want of precision and its failure to define any certain predicament upon which the action of the jury should be founded is of itself an insuperable objection to that charge. Thus it is said, if Connor "had not *made his discovery public*. " In what mode? it may be asked. What form of publicity did

Page 51 U. S. 507

the learned judge intend the jury should require? It is shown that Conner used his safe publicly -- that is, he concealed it from no one, and if any mode or kind of publication or concealment was requisite either to establish or conclude the right of Conner or to conclude common right a delinquency in the nature of a forfeiture, surely that mode, if found either in any statute or in the rules of the common law, ought to have been clearly laid down so as to guard the rights of all. In the next

place, it is said by the learned judge that if Conner had *abandoned* this improvement which the charge admits him to have invented, this would justify a patent to another who had not known of the improvement, although a subsequent inventor. I have always understood it to be indisputable law, that wherever an inventor abandons or surrenders an invention or improvement which he has certainly made, and neither claims and exclusive right in himself nor transfers it to another, the invention or improvement is given to the public; but by the charge in this case, such an abandonment transfers *an exclusive right* to one who, by the case supposed, *is admitted not to be the first inventor*. So too with respect to the hypothesis of the learned judge that the invention had, or might have, been forgotten. To this the same objections of vagueness and uncertainty, and the graver objection of injustice to the real inventor or to the public, are applicable. By whom and for what interval of time must this improvement have been forgotten in order to transfer it from the originator thereof? For a term of years? And if so, for how long a term? But suppose he forgets it for his lifetime, shall his executor or his posterity, upon the exhibition of indisputable proofs of the invention -- yea, the very machine itself, perfect in all its parts and in its operation -- be cut off? This surely cannot be; but at any rate the jury should have been furnished with some rule or measure of obliviousness if this was to be made the substantive cause of deprivation as to the original inventor or the foundation of right and of exclusive right in one confessedly not the first inventor.

An attempt has been made to compare the doctrine propounded by the Court to what it might be thought is the law as applicable to the discovery, or rather *recovery*, of the processes employed in what have been called "the lost arts." This illustration is in itself somewhat equivocal, and by no means satisfactory, for if that process could certainly be *shown* to be the same with one claimed by the modern inventor, his discovery could scarcely have the merit of originality or be the foundation of exclusive right. But in truth the illustration attempted to be drawn from a revival of a lost art is not apposite to the present case. The term "lost art" is applicable peculiarly

to certain monuments of antiquity still remaining in the world, the process of whose accomplishment has been lost for centuries, has been irretrievably swept from the earth, with every vestige of the archives or records of the nations with whom those arts existed, and the origin or even the identity of which process none can certainly establish. And if a means of producing the effect we see and have amongst us be discovered, and none can either by history or tradition refer to a similar or to the identical process, the inventor of that means may so far claim the merit of originality, though the work itself may have been produced possibly by the same means. But not one principle drawn from such a state of things can be applied to a recent proceeding which counts from its origin scarcely a period of fifteen years. In fine, this ruling of the learned judge is regarded as being at war not less with the policy and objects than it is with the express language of all the legislation by Congress upon the subject of patent rights, which legislation has uniformly constituted *priority of invention* to be the foundation and the test of all such rights. Thus, in the Act of April 10, 1790, the first patent law, 1 Stat. 109, it is declared by the first section,

"That upon the application of any person or persons &c.;, setting forth that he, she, or they hath or have invented or discovered any useful art &c.;, *not before known or used*, "

&c.; and the second section of the same statute, requiring a specification of any invention or discovery, declares that it shall be so described "as to distinguish it from all other things known or used."

The Act of February 21, 1793, 1 Stat. 318, provides that when any citizen or citizens of the United States shall allege that he or they have invented any "*new and useful art &c.;, not known or used before the application*," &c.;

By the Act of April 17, 1800, 2 Stat. 38, which extends the privilege of patents to aliens, proof is required that the art, invention, or discovery hath not *been known or used* in that or any foreign country. It is true that this requisition has been so far relaxed as to admit of the patenting in this country inventions which had been invented and used abroad, but with respect to this country, the invention &c.;, must

still be original.

The act of July 4th, 1836, 5 Stat. 117, reorganizing the Patent Office, the language of the sixth section is as follows: "That any person or persons having discovered or invented any new and useful art &c.;, *not known or used by others before his or their discovery*, " &c.; The language and import of the laws here cited are too plain to require comment,

Page 51 U. S. 509

and I think that the production of a single instance from the statute book may safely be challenged by which the requisites above mentioned have been dispensed with. Every law, on the contrary, has emphatically demanded originality and priority as indispensable prerequisites to patent privileges, and every aspirant to such privileges is expressly required to swear to these prerequisites, as well as to establish them. These tests ordained by the laws are not only founded upon the true reason for the privileges conferred, but they are simple and comprehensible, whereas the innovations permitted by the ruling of the learned judge not only conflict with the true reason and foundation of patent privileges, but tend to an uncertainty and confusion which cannot but invite litigation and mischief. I think that the judgment of the circuit court should be reversed and the cause remanded for a *venire facias de novo*.

MR. JUSTICE GRIER also dissented.

ORDER

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 now here ordered and adjudged by this Court that the judgment of the said circuit court in this cause be and the same is hereby affirmed with costs and damages at the rate of six percentum per annum.