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**Teese Vs. Huntingdon**

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**Court** : US Supreme Court

**Decided On :** 1859

**Appeal No.** : 64 U.S. 2

**Appellant** : Teese

**Respondent** : Huntingdon

**Judgement** :

Teese v. Huntingdon - 64 U.S. 2 (1859)
U.S. Supreme Court Teese v. Huntingdon, 64 U.S. 23 How. 2 2 (1859)

**Teese v. Huntingdon**

**64 U.S. (23 How.) 2**

*ERROR TO THE CIRCUIT COURT OF THE UNITED*

*STATES FOR THE NORTHERN DISTRICT OF CALIFORNIA*

## SYLLABUS

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent right.

This point has been directly ruled by this Court, and is no longer an open question. By the fifteenth section of the Patent Act of the fourth of July, 1836, the defendant is permitted to plead the general issue and give any special matter in evidence, provided notice in writing may have been given to the plaintiff or his attorney thirty days before the trial.

It is not necessary that this should be served and filed by an order of the court, and it is sufficient if it was served and filed subsequently to the time when the depositions were taken and filed in court.

For the purpose of impeaching a witness, a question was asked of another witness "What is the reputation of the first witness for moral character?" This question was objected to, and properly not allowed to be put by the court below.

The elementary writers and cases upon this point examined.

Another witness was asked what was the reputation of the first witness for truth and veracity, who replied that he had no means of knowing, not having had any transactions with him for five years. This question was excluded by the court, which must judge according to its discretion whether or not it applies to a time too remote.

Page 64 U. S. 3

The history of the trial in the court below is fully set forth in the opinion of this Court.

Page 64 U. S. 6

MR. JUSTICE CLIFFORD delivered the opinion of the Court.

According to the transcript, the declaration in this case was filed on the eighteenth day of March, 1856. It was an action of trespass on the case for an alleged infringement of certain letters patent purporting to have been duly issued to the plaintiffs for a new and useful improvement in a certain machine or implement

called a sluice-fork, used for the purpose of removing stones from sluices and sluice-boxes in washing gold. As the foundation of the suit, the plaintiffs in their declaration set up the letters patent, alleging that they were the original and first



inventors of the improvement therein described, and charged that the defendants, on the second day of July, 1855, and on divers other days and times between that day and the day of the commencement of the suit, unlawfully and without license vended and sold a large number of the improved forks made in imitation of their invention. To this charge the defendants pleaded the general issue, and in addition thereto set up in their answer to the declaration two other grounds of defense. In the first place, they denied that the plaintiffs were the original and first inventors of the improvement described in the letters patent, averring that the supposed improvement was known and used by divers other persons in the United States long before the pretended invention of the plaintiffs. They also alleged that the improvement claimed by the plaintiffs as their invention was not the proper subject of a patent within the true intent and meaning of the patent law of the United States.

By the fifteenth section of the Patent Act of the fourth of July, 1836, the defendant, in actions claiming damages for making, using, or selling, the thing patented, is permitted to plead the general issue, and for certain defenses, therein specified, to give that act and any special matter in evidence which is pertinent to the issue, and of which notice in writing may have been given to the plaintiff or his attorney thirty days before the trial. Within that provision and subject to that condition, he may, under the general issue, give any special matter in evidence tending to prove that the patentee was not the original and first inventor or discoverer of the thing patented, or a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery by the patentee, or had been in public use, or on sale, with the consent and allowance of the patentee, before his application for a patent. But whenever the defendant relies in his defense on the fact of a previous invention or knowledge or use of the thing patented, he is required to

"state in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used. "

Page 64 U. S. 8

Two written notices were accordingly given by the defendants of special matter to be offered in evidence by them at the trial, in support of the first ground of defense set up in the answer to the declaration. One was dated on the twenty-eighth day of August, 1856, and the other on the nineteenth day of September of the succeeding year, but they were both duly served and filed in court more than thirty days before the trial. Upon this state of the pleadings, the parties on the twentieth day of October, 1857, went to trial, and the jury, under the rulings and instructions of the presiding justice, returned their verdict for the defendants. After the plaintiffs had introduced evidence tending to prove the alleged infringement of their patent, they claimed that counsel fees were recoverable as damages in this action, and offered proof accordingly in order to show what would be a reasonable charge in that behalf.

That evidence was objected to by the defendants, upon the ground that counsel fees were not recoverable as damages in actions of that description, and the court sustained the objection, and excluded the evidence. To which ruling the plaintiffs excepted. Little or no reliance was placed upon this exception by the counsel of the plaintiffs, and in view of the circumstances one or two remarks upon the subject will be sufficient. Suppose it could be admitted that counsel fees constituted a proper element for the consideration of the jury, in the estimation of damages in cases of this description; still the error of the court in excluding the evidence would furnish no ground to reverse the judgment, for the reason that the verdict was for the defendants. For all purposes connected with this investigation, it must be assumed, under the finding of the jury, that the plaintiffs were not entitled to any damages whatever; and if not, then the evidence excluded by the ruling of the court was entirely immaterial. But the evidence was properly rejected on the ground assumed by the presiding justice.

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent right. That point has been directly

Page 64 U. S. 9

ruled by this Court, and is no longer an open question. Jurors are required to find the actual damages incurred by the plaintiff at the time his suit was brought, and if in the opinion of the court the defendant has not acted in good faith or has caused unnecessary expense and injury to the plaintiff, the court may render judgment for a larger sum, not exceeding three times the amount of the verdict. 5 Stat. 123. *Day v. Woodworth,* 13 How. 372. To maintain the issue on their part, the defendants offered three depositions, each tending to prove that the plaintiffs were not the original and first inventors of the improvement described in their letters patent.

Objection was seasonably made by the plaintiffs to the introduction of each of these depositions on two grounds:

1. Because the first notice of special matter to be introduced at the trial did not accord with the proof offered, as contained in these depositions.

2. Because the second notice of special matter to be thus introduced was served and filed without any order from the court, and therefore should be disregarded.

Exceptions were duly taken to the respective rulings of the court, in admitting each of these depositions; but as they all depend upon the same general considerations, they will be considered together.

It is conceded by the defendants that the first notice was, to some extent, insufficient. On the other hand, it is admitted by the plaintiffs that the terms of the second notice were sufficiently comprehensive and specific to justify the rulings of the court, in allowing the depositions to be read to the jury. They, however, insist upon the objection, taken at the trial, that it was served and filed without any order of the court and that it was insufficient because it was served and filed

subsequently to the time when the depositions were taken and filed in court.

But neither of these objections can be sustained. All that the act of Congress requires is that notice of the special matter to be offered in evidence at the trial shall be in writing and be given to the plaintiff or his attorney more than thirty days before the trial. By the plain terms of the law, it is a



right conferred upon the defendant, and of course he may exercise it in the manner and upon the conditions therein pointed out, without any leave or order from the court. When the notice is properly drawn, and duly and seasonably served and filed in court as a part of the pleadings, nothing further is required to give the defendant the full and unrestricted benefit of the provision.

Such notice is required in order to guard patentees from being surprised at the trial by evidence of a nature which they could not be presumed to know or be prepared to meet, and thereby subject them either to delay or a loss of their cause. To prevent such consequences, the defendant is required to specify the names and places of residence of the persons on whose prior knowledge of the alleged improvement he relies to disprove the novelty of the invention, and the place or places where the same had been used. *Wilton v. Railroads,* 1 Wall Jr. 195.

Compliance with this provision, on the part of the defendant, being a condition precedent to his right to introduce such special matter under the general issue, it necessarily follows that he may give the requisite notice without any leave or order from the court; and for the same reason, if he afterwards discovers that the first notice served is defective, or not sufficiently comprehensive to admit his defense, he may give another to remedy the defect or supply the deficiency, subject to the same condition that it must be in writing and be served more than thirty days before the trial.

Having given the notice as required by the act of Congress, the defendant at the trial may proceed to prove the facts therein set forth by any legal and competent testimony. For that purpose, he may call and examine witnesses upon the stand or

he may introduce any deposition which has been legally taken in the cause. Under those circumstances, depositions taken before the notice was served, as well as those taken afterward, are equally admissible, provided the statements of the deponents are applicable to the matters thus put in issue between the parties.

After the defense was closed, the plaintiffs offered evidence



to impeach one of the witnesses who had given material testimony for the defendants. When called, the impeaching witness stated that he knew the witness sought to be impeached and knew other persons who were acquainted with the witness, and that they both resided in the City of Sacramento, whereupon the counsel of the plaintiffs put the question, "What is the reputation of the witness for moral character?" To that question the counsel of the defendants objected on the ground that the inquiry should be limited to the general reputation of the witness for truth and veracity, with the right to put the further inquiry whether the witness testifying would believe the other on his oath, and the court sustained the objection and rejected the testimony.

No reasons were assigned by the court for the ruling, and of course the only point presented is whether the particular question propounded was properly excluded.

courts of justice differ very widely, whether the general reputation of the witness for truth and veracity is the true and sole criterion of his credit, or whether the inquiry may not properly be extended to his entire moral character and estimation in society. They also differ as to the right to inquire of the impeaching witness whether he would believe the other on his oath. All agree, however, that the first inquiry must be restricted either to the general reputation of the witness for truth and veracity or to his general character, and that it cannot be extended to particular facts or transactions, for the reason that while every man is supposed to be fully prepared to meet those general inquiries, it is not likely he would be equally so without notice to answer as to particular acts.

According to the views of Mr. Greenleaf the inquiry in all cases should be restricted to the general reputation of the witness for truth and veracity, and he also expresses the opinion that the weight of authority in the American courts is against allowing the question to be put to the impeaching witness whether he would believe the other on his oath. In the last edition of his work on the law of evidence, he refers to several decided cases which appear to support these positions,

Page 64 U. S. 12

and it must be admitted that some of these decisions, as well as others that have since been made to the same effect, are enforced by reasons drawn from the analogies of the law to which it would be difficult to give any satisfactory answer. 1 Greenl.Ev., sec. 461; *Phillips v. Kingfield,* 19 Me. 375, per Shepley J.; *Goss v. Stimpson,* 2 Sum. 610; *Wood v. Mann,* 2 Sum. 321; *Craig v. State,* 5 Ohio N.S. 605; *Gilbert v. Sheldon,* 13 Barb. 623; *Jackson v. Lewis,* 13 Johns. 504; *United States v. Van Sickle,* 2 McLean 219; *State v. Bruce,* 24 Me. 72; *Com. v. Morse,* 3 Pick. 196; *Gilchrist v. McKee,* 4 Watts 380; *State v. Smith,* 7 Vt. 141; *Frye v. Bank of Illinois,* 11 Ill. 367; *Jones v. State,* 13 Tex. 168; *State v. Randolph,* 24 Conn. 363; *Uhl v. Com.,* 6 Gratt. 706; *Wike v. Lightner,* 11 S. & R. 338; *Kemmel v. Kemmel,* 3 S. & R. 338; *State v. Howard,* 9 N.H. 485; *Buckner v. State,* 20 Ohio 18; *Ford v. Ford,* 7 Humphr. 92; *Thurman v. Virgin,* 18 B.Munroe 792; *Perkins v. Nobley,* 4 Ohio N.S. 668; *Bates v. Barber,* 4 Cush. 107.

On the other hand, a recent English writer on the law of evidence of great repute maintains that the inquiry in such cases properly involves the entire moral character of the witness whose credit is thus impeached and his estimation in society, and that the opinion of the impeaching witness as to whether he is entitled to be believed on his oath is also admissible to the jury. 2 Taylor Ev. secs. 1082, 1083.

That learned writer insists that the regular mode of examining into the character of the witness sought to be impeached is to ask the witness testifying whether he knows his general reputation, and if so what that reputation is and whether, from

such knowledge, he would believe him upon his oath. In support of this mode of conducting the examination he refers to several decided cases, both English and American, which appear to sustain the views of the writer. *Rees v. Watson,* 22 How.St.Tr. 496; *Mawson v. Hartsink,* 4 Esp.R. 104; *Rex v. Rockwood,* 13 How.St.Tr. 211; *Carpenter v. Wall,* 11 Ad. & El. 803; *Anonymous,* 1 Hill S.C. 259; *Hume v. Scott,* 3 A.K.Marshall 262; *Day v. State,* 13 Mis. 422; 3 Am.Law Jour. N.S. 145.



Both Mr. Greenleaf and Mr. Taylor agree, however, that the impeaching witness must be able to state what is generally said of the other witness by those among whom he resides and with whom he is chiefly conversant, and in effect admit that unless he can so speak, he is not qualified to testify upon the subject for the reason that it is only what is generally said of the witness by his neighbors that constitutes his general reputation. To that extent they concur, and so, as a general remark, do the authorities which on the one side and the other support these respective theories; but beyond that the views of these commentators as well as the authorities appear to be irreconcilable.

In referring to this conflict of opinion among text writers and judicial decisions, we have not done so because there is anything presented in this record that makes it necessary to choose between them or even renders it proper that we should attempt at the present time to lay down any general rule upon the subject. On the contrary, our main purpose in doing so is to bring the particular question exhibited in the bill of exceptions to the test of both theories in order to ascertain whether under either rule of practice it ought to have been allowed. Under the first mode of conducting the examination, it is admitted that it was properly rejected, and we think it was equally improper, supposing the other rule of practice to be correct. Whenever a witness is called to impeach the credit of another, he must know what is generally said of the witness whose credit is impeached by those among whom the last-named witness resides in order that he may be able to answer the inquiry either as to his general character in the broader sense or as to his general

reputation for truth and veracity. He is not required to speak from his own knowledge of the acts and transactions from which the character or reputation of the witness has been derived, nor indeed is he allowed to do so, but he must speak from his own knowledge of what is generally said of him by those among whom he resides and with whom he is chiefly conversant, and any question that does not call for such knowledge is an improper one, and ought to be rejected. No case has been cited

Page 64 U. S. 14

authorizing such a question or even furnishing an example where it was put, and our researches in that direction have not been attended with any better success. For these reasons, we think the question was properly excluded. Some further attempts were made by the plaintiffs to impeach this witness, and with that view they called another witness who testified that he knew the one sought to be impeached, and had had business transactions with him during the years 1852-1853 in the city where they resided. On being asked by the counsel of the plaintiffs what was the reputation of the witness for truth and veracity, he replied that he had no means of knowing what it was, not having had any dealings with him since those transactions; thereupon the same counsel repeated the question, limiting it to that period.

Objection was made to that question by the counsel of the defendants on the ground that the period named in the question was too remote, and the court sustained the objection and excluded the question. To this ruling the plaintiffs excepted. Such testimony undoubtedly may properly be excluded by the court when it applies to a period of time so remote from the transaction involved in the controversy as thereby to become entirely unsatisfactory and immaterial, and as the law cannot fix that period of limitation, it must necessarily be left to the discretion of the court. Considering that the witness had already stated that he was not able to answer the question, we do not think that the discretion of the court in this case was unreasonably exercised. None of the exceptions can be sustained, and the judgment of the circuit court is therefore

*Affirmed with costs.*

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