

Moffitt Vs. Garr

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Court : US Supreme Court

Decided On : 1861

Appeal No. : 66 U.S. 273

Appellant : Moffitt

Respondent : Garr

Judgement :

Moffitt v. Garr - 66 U.S. 273 (1861)

U.S. Supreme Court Moffitt v. Garr, 66 U.S. 1 Black 273 273 (1861)

Moffitt v. Garr

66 U.S. (1 Black) 273

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE SOUTHERN DISTRICT OF OHIO

SYLLABUS

1. The surrender of a patent under the 13th section of the Act of July 4, 1836, in judgment of law, extinguishes it -- is a legal cancellation of it, and no right can afterwards be asserted upon it.

2. Suits pending for an infringement of such a patent fall with its surrender, because the foundation upon which they were commenced no longer exists.

3. But moneys recovered or paid under a patent previous to its surrender cannot be recovered back afterwards.

The plaintiff in error, who was also plaintiff below, filed a declaration in case against defendants in error for the infringement of letters patent of the United States, granted to him November 30, 1852, for an improvement in grain separators. This declaration was filed March 22, 1859. On the 25th of October following, one of the defendants filed the following plea:

"And now comes the said John M. Garr and says that the said John R. Moffitt ought not further to maintain this action against him because, he says, that since the commencement thereof and before the 17th day of May, 1859,

Page 66 U. S. 274

to-wit, on the ___ day of _____, the said John R. Moffitt surrendered to the United States the patent before that time issued to him, and for the alleged infringement of which this suit is brought, and this he is ready to verify. Wherefore,"

etc. To this plea the plaintiff demurred, and the court overruled the demurrer. Judgment for defendant. The plaintiff took this writ of error.

Page 66 U. S. 282

MR. JUSTICE NELSON.

The suit was brought by Moffitt against the defendants for the infringement of a patent for an "improvement in grain separators."

The defendants plead to the declaration that since the commencement of the suit, the plaintiff had surrendered his patent to the United States for the alleged infringement of which the action was brought. To which the plaintiff put in a general demurrer. The court overruled the demurrer and sustained the plea, and

gave judgment accordingly.

The 13th section of the Act of Congress of July 4, 1836, provides

"That if a patent shall be inoperative &c.;, it shall be lawful for the commissioner, upon the surrender to him of such patent, . . . to cause a new patent to be issued &c.;, and the patent so reissued . . . shall have the same effect and operation in law on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in the connected form,"

&c.;

Now the point in the case is whether or not the patentee may maintain a suit on the surrendered patent instituted before the surrender if he has not availed himself of the whole of the provision and taken out a reissue of his patent with an amended specification. The construction given to this section,

Page 66 U. S. 283

so far as we know, and the practice under it in case of a surrender and reissue, are that the pending suits fall with the surrender. A surrender of the patent to the commissioner within the sense of the provision, means an act which, in judgment of law, extinguishes the patent. It is a legal cancellation of it, and hence can no more be the foundation for the assertion of a right after the surrender, than could an act of Congress which has been repealed. It has frequently been determined that suits pending, which rest upon an act of Congress, fall with the repeal of it. The reissue of the patent has no connection with or bearing upon antecedent suits; it has as to subsequent suits. The antecedent suits depend upon the patent existing at the time they were commenced, and unless it exists, and is in force at the time of trial and judgment, the suits fail.

It is a mistake to suppose that, upon this construction, moneys recovered on judgments in suits, or voluntary payment under the first patent upon the surrender, might be recovered back. The title to these moneys does not depend upon the patent, but upon the voluntary payment or the judgment of the court.

We are satisfied the judgment of the court below is right, and should be

Affirmed.

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