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Jones Vs. Morehead

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Court : US Supreme Court

Decided On : 1863

Appeal No. : 68 U.S. 155

Appellant : Jones

Respondent : Morehead

Judgement :

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Jones v. Morehead

68 U.S. (1 Wall.) 155

ERROR TO THE CIRCUIT COURT FOR THE

WESTERN DISTRICT OF PENNSYLVANIA

SYLLABUS

1. The claim of Sherwood, under his patent, granted in 1842, and extended in 1856, for "a new and useful improvement in door locks" -- so far as the claim is for

"making the cases of door locks and latches double faced, or so finished that either side may be used for the outside, in order that the same lock or cased fastening may answer for a right or left-hand

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door, substantially as described;"

that is to say, the *first* claim in his schedule is for a thing which is not original with him and void. And the question is raised by the court, but not decided, whether

"the making of the case which encloses the internal works of the lock, with two faces just alike, and so well finished off in point of style that either side may be presented outwards, is a matter which could be patented if no locks with such cases had ever been made before."

2. This *part* of the invention known as the Janus-faced lock, not being original, no action lies by Sherwood or his assignees for using it in combination with other inventions not patented by that person; nor can persons so using it be made infringers by an argument which, assuming the validity of Sherwood's invention, mingles it with these other parts, and then treats the whole as a *unit,* and gives to him or his assignees damages equivalent to the net profits on the manufacture of the entire lock.

3. Where parties in their answer, as originally filed, to a bill for infringing a patent admit that they did manufacture and sell the articles alleged to have been patented, the fact thus admitted in the answer must be accepted as established. As, however, the admission need go no further than its terms *necessarily* imply, the court will, under special circumstances and where this is promotive of justice, assume that the smallest number of articles were made consistent with the use of the word involved, in the plural, and with the use by the defendants of any part of the patent which is valid.

This was a bill filed in the Circuit Court for the Western District of Pennsylvania to restrain the infringement of a patent for protecting the manufacture of a certain sort

of door locks, called Janus-faced locks, and for an account, the parties to the suit being two large manufacturing firms in the City of Pittsburgh. The history of the invention or claim of invention in question was essentially thus: till within a few years past, most of the door locks used in this country were imported from England. It was thought desirable, therefore, to have, invent, or use some plan by which this article could be obtained more cheaply and better than the imported, notwithstanding the higher price of labor here, the article of door locks being one of immense consumption in this country. This object was in part effected by making the locks of cast iron, but some difficulty in the way of these cheaper productions was thought to exist in the fact that door locks had to be made *"right and left,"* and that a lock made for a right-hand door had to be turned upside

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down in order to be used on a left-hand door, and *vice versa.* It was conceived, therefore, that if this difficulty of right- and left-hand locks was obviated and every lock made equally capable of use on right- or left-hand doors, an advantage might be gained. An American named Sherwood -- under whom the complainants claimed -- conceiving that he had invented a mode of effecting the object and that finishing a lock on both faces was an invention and proper subject for letters, procured a patent in 1842 (extended in 1856), and established a manufactory of this sort of lock. His patent was for "a new and useful improvement in door locks." The language of his schedule was as follows:

"What I claim as my invention, and for which I desire an exclusive right by letters patent, is making the cases of door locks and latches *double-faced,* or so finished that either side may be used for the *outside, in order that the same lock or cased fastening may answer for a right- or left-hand door,* substantially as described."

"I also claim the peculiar construction and double action (upon an inclined and horizontal track or way) of the locking car B, as hereinbefore described, and the combination of the locking car B and safety cars G G2 with one another, and with the connecting or vibrating bar and bolt A, as within described, so as to fasten the bolt c securely and prevent its being picked."

"I also claim so constructing the bolt as hereinbefore described that by simple turning it over in the lock case, it is adapted to a right- or left-hand door."

But the two improvements claimed in the second and third of these claims, were superseded soon after Sherwood had obtained his patent, by the invention of a certain Calvin Adams -- *this Adams being a member of the firm who were the defendants in this suit.* He, applying his improvement in the specific internal arrangement to the *case* of the lock, as Sherwood had claimed and obtained a patent for *that,* made a new combination, called the Janus-faced lock, whose manufacture, the complainants -- successors to Sherwood's rights -- had brought this bill to restrain and have an account of. It was not proved nor argued that the defendants had used

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any part of Sherwood's patent except the double-faced casing. In fact, no locks with the particular internal mechanism specified in Sherwood's patent were ever made except one or two made by Sherwood himself.

The defendants below answered the bill, *admitting that they had made locks of the kind described in the patent* and claiming that they were the rightful owners of that patent from Sherwood, and therefore had a right to manufacture those locks. Upon this issue considerable testimony was taken, when the defendants becoming satisfied that they were not the legal owners of the patent, asked leave to amend their answer by *denying that they had ever made locks of the kind described in it* and by asserting that the patent was invalid for want of novelty. The circuit court permitted them to assert the invalidity of the patent as wanting novelty, but *refused to allow them to deny that they had manufactured the locks* described in it. The admission that they had manufactured them stood, therefore, on the record as it came up to this Court.

On the trial below -- under the defense of want of originality -- great numbers of locks were brought into court, many of which were older than Sherwood's, and were undoubtedly cased on both sides. Certain ones were particularly relied on:

two from the gates of the New York City Hall; one from the custom house in that city; one or more from the city hospital, and one from the gate of St. Mark's Church. Several manufacturers of reputation, who were offered as experts, testified that in their opinion these were not essentially different in principle from Mr. Sherwood's lock. The counsel below for Sherwood's patent argued, however, that no one of these locks had been made with an *intention* to obviate the difficulty of having right- and left-hand locks, or that practically any of them had been so used, or that any person, before Sherwood, in seeing one of them, had thus applied them, or perceived that they could be so applied. He contended with a greater or less degree of force that the custom house lock was in fact from an open outdoor gate; that its inside was covered tight in order to preserve the works of the lock from the weather and from rust -- a device

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necessary in all outdoor gate locks; that it was not well suited for a Janus-faced lock, and was *finished* on one side only; that it was a left-hand lock, and not a door lock properly speaking at all. The lock taken from the city hospital gate, he argued, was a dead lock, a right-hand lock, though he admitted that by putting it wrong side out and making some alterations, it might be converted into a left-hand dead lock. The same he thought was to be said of the gate lock of St. Mark's Church, and of all the others. The circuit court reporter, in reporting the case, says, however (*see Legal Intelligencer,* vol. xviii, p. 293):

"And yet undoubtedly to the eye of high inventive genius, *the finished production of Sherwood was visible in nearly every one of these ruder productions.* It required but the vital spark of genius to kindle the train and to convert in an instant the manufacture designed for one purpose into an object applicable to quite another."

The question, of course, was one in a large degree of inspection. The locks which were exhibited below, having been made exhibits in the case, were now all exhibited here.

The circuit court entirely sustained Sherwood's claim, remarking that although the makers of these other locks were *near* inventing the "double-face," and might have done so if they had only thought of it, yet that these persons had not actually invented it, or certainly had not so done it as to make their discovery practically useful. The testimony of the experts, the court conceived,

"when analyzed, amounted to this, and no more: that these gate locks, being covered on the inside, might, by a little change, have been made into Janus-faced locks, though not so intended by the maker"

-- a fact which was now apparent to any mechanic who had the patented invention before him.

The injunction prayed for was accordingly granted, and a reference for an account ordered. The injunction restrained the defendants from

"making, constructing, vending, or using in any way the said invention and improvements, or either of them, *or any part thereof,* mentioned and described in the said patent. "

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Upon the coming in of the account as settled by the master -- the account being settled in part *upon proofs adduced by the complainants as to the fact and extent of the defendants' manufacture of these locks, the original admission being apparently not relied on* -- it appeared that the net profits upon all the locks *(including every part of the locks),* which the defendants made or sold, were $13,282.92. The complainants claimed this entire sum, and indeed that it should be "trebled." The defendants denied that they were liable to profits on the *whole lock* or for any profits except those properly springing from the *case* of the lock, that part of it alone of which Sherwood claimed to be the inventor, and of which, notwithstanding their resistance, he had just been declared by the court the rightful patentee. They contended that the court should apportion this sum of $13,282.92, reported as their profits, to the different *parts* of the lock, the *profits* on each part being fixed on an arithmetical proportion to the cost of each. The account, then,

would stand thus:

Profits *on the case (the "improvement" for which*

Sherwood got his patent) $3,123.48

" latch and keeper 1,221.53

" other parts of the lock. 4,577.01

" trimmings. 4,360.90

$13,282.92

The said circuit court, however, was not of this opinion, conceiving that although a patentee might describe his invention as an *improvement,* still if the machine constituted a distinct machine -- a specific article known in the market -- on account of its peculiar functions, the measure of damages for infringement was the profit on the whole machine. The view was thus set forth by the judge delivering the opinion of that court:

"The great question recurs: is this Janus-faced lock a peculiar and distinct machine, introduced into market as a cheaper and better article than other machines without the peculiar characteristic of the patented one? Does the value of the patent to its owners consist in the close monopoly of the right to make

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and sell this species of lock as one individual machine? Has it peculiar characteristics which distinguish it from other machines of the same genus, and which give it a peculiar value in the market? If so, the complainants have a right to demand that the defendants, having infringed their exclusive right to make and sell this peculiar machine or manufacture, are justly liable to refund all the net profits made by such infringement. If, on the contrary, the patent is for some addition or improvement on an old and well known implement, or some separate part or

device thereof of small importance compared with the whole -- if the license to use the improvement or addition was sold as separate and distinct from the whole machine -- the measure of damage would be the price of a license, and not the profit made by the exclusive right to make and sell the whole machine."

The circuit court next stated that Court's idea as to the originality and merits of the invention, and continued:

"The claim of the Sherwood patent was, for 'making the case of door locks and latches double-faced, or so finished that either side may be used for the outside.' The arrangements of the internal parts of the lock, and devices necessary to such a lock, are set forth in the specification. They were rather complex, and required that, in order to change the lock from a right-hand to a left-hand lock, that it should be opened and some change made in the position and arrangement of the internal parts. For the purpose of the present discussion, it is unnecessary to describe these devices. The name 'Janus-faced' locks was given to this machine to distinguish it from others which had not its peculiar qualities."

"Now it is evident that although the patent of Sherwood may be said to be for an improvement in the manufacture of locks, a well known implement or machine, nevertheless the lock contrived by him was a new and distinct species, having certain qualities differing from all other locks; that the Janus-faced lock is a specific article (although of the genus lock), known in the market, having peculiar value, and that the value of the monopoly granted by the patent consisted in the exclusive right to manufacture this peculiar machine without any competition and have all the profits of such a monopoly. The respondents have made large gains by trespassing on the rights of the complainants. The profits they made by this trespass justly

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belong to the true owner. They have partaken equally with the complainants in the profits of the monopoly granted to them alone, without license and in defiance of their rights. The only measure of the redress to which the complainants are

entitled is an account of the actual profits made by respondents. The machine being a *unit* -- a specific article well known in the market, having peculiar value because of the patentee's discovery or invention -- the attempt to arbitrarily divide the profits of the monopoly of the whole machine among its parts is without precedent and receives no countenance from the case of *Seymour v. McCormick,* [Footnote 1] which has been relied on for an opposite idea."

The court accordingly confirmed the master's report giving to the complainants the whole profits, $13,282.92, and decree was entered accordingly.

Appeal to this Court now brought before it:

1. The originality of Sherwood's invention as set forth (*ante,* p. <68 U.S. 157|>157) in his *first* claim -- the claim, to-wit, in these words:

"What I claim as my invention and for which I desire an exclusive patent is making the cases of door locks and latches double-faced, or so finished that either side may be used for the outside, in order that the same lock or cased fastening may answer for a right- or left-hand door, substantially as described."

2. The correctness of the idea of *unity* in machines as held, apparently, from this record, by the court below.

MR. JUSTICE MILLER delivered the opinion of the Court:

It is the first claim as set forth which defendants charge to be invalid for want of novelty, and in this we think they are sustained by the testimony.

Indeed it may be doubted if the making of the case which encloses the internal works of the lock, with two faces just alike and so well finished off in point of style that either side may be presented outwards, is a matter which could be

patented if no locks with such cases had ever been made before. But we are not called on to decide this point, and therefore pass it without further comment.

Several locks were produced on the trial below, and were shown to us here -- being made exhibits by the record -- which we are satisfied are the same in principle as the double faces of the Sherwood lock. Two of these locks are from the gates of the New York City Hall. They are cased both sides alike, enclosing the internal works completely, and are so finished that one side may be presented outward as well as the other, and the locks can be applied to a door swinging from right to left or from left to right. Locks from the city hospitals having the double-faced case, both sides alike, have also been produced, and one from the entrance gate of St. Mark's Church. A lock from the custom house is shown which has the double-faced case, both sides alike, and which by being turned laterally, can be used for a door opening either to the right or left without even turning the keyhole upside down. These locks are all proven to have been in use several years before Sherwood set up any claim to his invention. They are taken from the most public places in the great commercial city of the Union. These facts are incompatible with the claim of novelty on the part of Sherwood for this part of his patent.

As to the two remaining claims in the schedule accompanying the patent, it appears clearly that they were never infringed by defendants. In fact no locks were ever made with the particular internal arrangements as to bolts, latches &c.;, specified in Sherwood's patent except one or two by Sherwood.

Very shortly after he obtained his patent, one Calvin Adams made an improvement upon it which entirely superseded the use of the specific internal arrangement claimed by Sherwood in his invention. Combining this improvement with the double-faced case of Sherwood, Adams made a lock which has ever since been known as the Janus-faced lock, and which is the lock manufactured by complainants, of whom Mr. Adams is one.

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It is not shown by any proof in the case that defendants ever used any part of Sherwood's patent except the double-faced casing. Nor is it seriously claimed in argument that they did. But it is urged that this double-faced case, when used in

connection with a latch or bolt and keeper, susceptible of such an arrangement that it may be placed upon a door opening either to the right or left, constitutes a unit, and the real invention of Sherwood, which is infringed by the defendants.

This mode of viewing the matter cannot be admitted. Sherwood claims that he is the inventor of three distinct parts going to make up his lock, which thus made up answers a certain purpose -- namely a lock capable of being applied indifferently to a door opening from the right or left. Two of these claims have been long since superseded by other improvements and abandoned by everybody, and have never been used by the defendants. The other claim which they have used is found to be invalid for want of novelty. What is left of the Sherwood patent? It is clear that no part of the patent which is valid has been used by defendants, and they cannot be made infringers by an argument that mingles the valid and invalid parts of a patent and calls it a unit, and then claims that defendants are infringers because they have used one part of this unit, although it was a part as to which the patent is void.

It therefore appears that, in point of fact, the defendants have not infringed the Sherwood patent, and if we were unembarrassed by the pleadings, we should dismiss the bill with costs.

But the defendants have admitted in their answer that they did make locks as described in Sherwood's patent, and when they afterwards asked leave of the court to retract that admission and deny the infringement, the court refused such permission. This request was made after the issue was made up, after much testimony had been taken, and its object was to deny a fact previously admitted under oath. It was a matter in the discretion of the circuit court, and we are not disposed to review its action on that subject here,

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under these circumstances, if indeed it can be done under any.

An effort has been made by counsel to show that this admission has been waived by the act of plaintiffs in going into the proofs and otherwise treating it as an open

question. But this would violate a principle of universal application both in proceedings at common law and in chancery, to-wit that the proofs must correspond with the allegations. It would be subversive of all sound practice, and tend largely to defeat the ends of justice, if the court should refuse to accept a fact as settled, which is distinctly alleged in the bill and admitted in the answer. [Footnote 2]

The fact that the defendants did manufacture and sell locks of the character of those patented by Sherwood must be accepted as established in this case by the pleadings. The admission, however, need go no further than its terms necessarily imply. The language of the admission is satisfied, by assuming that the smallest number of locks were made consistent with the use of that word in the plural, and with the use by defendants of any part of the patent which is valid.

The circuit court, by its decree, ordered an injunction, restraining defendants from making, using, and vending said invention, or any part thereof, mentioned in said patent, and the payment by defendants to plaintiffs of $13,282.92 profits made by them.

The result of the views we have expressed is that this decree must be reversed, and the injunction modified so as to restrain the defendants from using any part of the Sherwood patent except that embraced in the first claim of invention mentioned in the schedule attached to said patent, and a decree rendered for a nominal sum of one dollar for profits.

The appellants in this Court must recover their costs.

Decree accordingly.

[Footnote 1]

57 U. S. 16 How. 480.

[Footnote 2]

Crocket v. Lee, 7 Wheat. 522.

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