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Jacobs Vs. Baker

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Court : US Supreme Court

Decided On : 1868

Appeal No. : 74 U.S. 295

Appellant : Jacobs

Respondent : Baker

Judgement :

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Jacobs v. Baker

74 U.S. (7 Wall.) 295

APPEAL FROM A JUDGMENT OF THE

CIRCUIT COURT FOR SOUTHERN OHIO

SYLLABUS

1. *Semble* that an improvement in the plan of constructing a jail is not a subject of patent within the Patent Acts of 1836 or 1842.

2. Jacobs was not the first inventor of the improvements patented to him in 1859 and 1860 for improvements in the construction of jails.

Jacobs filed a bill in the Circuit Court for Southern Ohio against Baker, seeking relief for the infringement of four separate patents which had been granted to him, Jacobs, *for improvements in the construction of prisons.* The bill set forth the different patents.

The first, dated January 7, 1859, was for an improvement in the construction of prisons, which the complainant set forth in his specification with very numerous plates and designs. The claim concluded thus:

"What I claim as my invention and desire to secure by letters patent is a secret passage, or guard-chamber, around the outside of an iron-plate jail and between said jail and a surrounding enclosure, constructed and arranged substantially as described, for the purpose set forth."

[The purpose was to allow the keeper to oversee and overhear the prisoners without their being conscious of his presence.]

The next patent was dated 20 December, 1859, and purported to be for an "improvement in iron-plate jails." The claim was for

"the improved iron walls for the same, consisting

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of the following parts arranged and united as set forth, to-wit: the entire wall plates (A) having their edges closely abutting, the joint plates (e) united to and uniting the plate A, by rivets (i), which have their riveted ends inwards, and countersunk to the depth of the thickness of the plate A, in the manner and for the purposes herein set forth."

This specification was also accompanied by numerous plates.

The third patent, dated 21 February, 1860, was for an "improvement in joining plates of metal," and was stated to be specially applicable to prisons. The claim was for

"the construction of the joint, made by means of the closely abutting plates (A A), and the flat and semicylindrical plates B B, and rivets (c), substantially in the manner and for the purpose set forth."

This too had numerous drawings.

The fourth patent, dated 24 July, 1860, was for an "improvement in iron prisons." The claim was for

"constructing and arranging plate iron cells in jails separately from each other, with vertical spaces (e) between the cells upon the same level, and horizontal spaces between cells arranged one above another, substantially as and for the purpose described."

This was also profusely illustrated by drawings.

The bill, which averred that the complainant was the original and first inventor of all these improvements and that the defendant was an infringer of his patents, asked that the defendant might answer the bill under oath and be compelled to state how extensively, and where he had sold the improvements patented, and to describe his modes of construction &c.;

The defendant did answer on oath, denying that the improvements were original with the complainant or new but averring that they had been long in use, and setting out various jails in different parts of the country where they had been used in 1855, 1857, 1858 &c.;, all before the date of the patents relied on.

A large amount of testimony was taken on both sides, upon which the court below, considering that the defendant had established his case, dismissed the bill with costs. The case was now here on an appeal by the patentee.

MR. JUSTICE GRIER delivered the opinion of the Court.

The patent act of 1836 [Footnote 1] enumerated the discoveries or inventions for which patents shall be issued, and describes them as "any new and useful art, machine, manufacture, or composition of matter."

We have been at some loss to discover under which category to class the four patents which are the subjects of this bill. The complainant alleges that he has invented a new and useful improvement in the construction of jails. Now a jail can hardly come under the denomination of "a machine," nor, though made by hands, can it well be classed with "manufactures;" nor, although compounded of matter, can it be termed a "composition of matter," in the meaning of the patent act. "But if the subject matter be neither a machine nor a manufacture, nor a composition of matter, then," says an author on the subject of patents, [Footnote 2] "it *must* be an art, for there can be no valid patent except it be for *a thing made,* or for the art or *process of making* a thing." Now, without attempting to define the term "art" with logical accuracy, we take as examples of it, some things which, in their concrete form, exhibit what we all concede to come within a correct definition, such as the art of printing, that of telegraphy, or that of photography. The art of tanning leather might also come within the category, because it requires various processes and manipulations. The difficulty still exists, however, under which category of the patent act an improvement in the construction of jails is to be classed, or whether under any.

The patent act of 1842 [Footnote 3] gives a copyright for

"new and

original designs for manufacture, whether of metal or other material, for bust, statue &c.;, or any new and original shape or configuration of any article of manufacture, to any inventor who shall desire to obtain an exclusive property, to make, use, and vend the same, or *copies* of the same."

Now, although the complainant might contend (as one would suppose from the immense number of plans, designs, and drawings with which the record in the case has been encumbered) that his patent could be supported under this act, yet still the difficulty remains whether the erection of a jail can be treated as the infringement of a *copyright.*

But waiving all these difficulties as hypercritical, and assuming the correctness of the positions taken, that whatever is neither a machine, nor a manufacture, nor a composition of matter, must (*ex necessitate*) be "an art;" that a jail is a thing "made;" and that the patent is for the " *process* of making it," let us examine the case as presented by the bill and answer.

The bill relies upon four several patents which it sets forth. They are dated January 7 and 20 December, 1859; 21 February and 24 July, 1860. It would seem from the quick succession of these patents and before the plans for building jails which they severally suggested could well be put practically into operation, and before any inquiry was made as to how other persons constructed jails, that as a new idea came into the complainant's mind, he immediately proceeded to the Patent Office to get it patented.

It is not necessary to the decision of this case to examine whether all or any of the suggestions made by the complainant were proper subjects of patent. The bill presents a number of interrogatories to the defendant and requires him to answer them under oath. The answer of the defendant denies that the complainant was the original and first inventor of the several inventions claimed or of any of them, and avers that the devices described in the complainant's patents were well known and in use prior to the pretended invention of them by the complainant. And it enumerates many persons who had used the devices before the complainant.

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The record presents no question of law as to the construction of these patents. The only issues were of fact. It would be a tedious as well as an unprofitable task to attempt to vindicate the correctness of our decision of this case by quoting the

testimony and examining the volume of plates annexed to it. The decision could never be a precedent in any other case. It is enough to say that we see no reason to doubt the correctness of the decision of the circuit court on the issues made or the pleadings.

Decree affirmed.

[Footnote 1]

§ 6, 5 Stat. at Large 119.

[Footnote 2]

Curtis on Patents 91.

[Footnote 3]

§ 3, 5 Stat. at Large 544.

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