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KleIn Vs. Russell

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Decided On : 1873

Appeal No. : 86 U.S. 433

Appellant : Klein

Respondent : Russell

Judgement :

Klein v. Russell - 86 U.S. 433 (1873)
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Klein v. Russell

86 U.S. (19 Wall.) 433

ERROR TO THE CIRCUIT COURT FOR

THE NORTHERN DISTRICT OF NEW YORK

SYLLABUS

1. Where on a trial for infringement of a reissue of letters patent -- the defense being a want of novelty -- a defendant requests the court below to direct the jury to bring in a verdict for the defendant (no objection being then or having during the

trial been taken by such defendant that the reissue was for a different invention from that secured by the original patent) and the request for the direction just stated not having been on that ground, but on the ground of the evidence "relative to the alleged prior use of the process, and the novelty, and usefulness, character, and effect of the alleged invention being so decisive as to, entitle the defendant to a verdict" -- and the request has been refused -- the defendant cannot assign as error the refusal to give the direction, because the reissue was not for the same invention as was the original patent.

2. A reissue is *prima facie* to be presumed to be for the same invention as is the original patent.

3. A direction to find for one party or the other can only be given where there is no conflict of evidence.

4. Where, on a question of novelty in a patented process, a witness has stated that after the patent, he was using a particular process which he had been using for twenty years before (a process which the defendant affirmed to be the same as the one patented), it is allowable to ask the witness whether the patentee had not forbade him to use what he was then using, the purpose of the question being to show that the patentee bad forbade him, and that the witness then disclaimed using the patented process, and said that he had "a way of his own" which he was using.

5. It is allowable to ask a witness of the opposite side, who has referred to and said that he had seen and copied a paper in reference to the expenses of the suit, subscribed by various persons, what were the contents of the paper, the purpose of the question being to show by the answer that the defendants' witnesses were in a combination to defeat the plaintiff and to share the expense of the opposition. It was not necessary prior to the question to call on anyone to produce the original paper.

6. When a patent is on trial and the question in issue involves the matter of novelty, utility, and *modus operandi,* it is proper enough to ask what the effect of

the patented invention has been.

7. In construing a patent, courts should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee if it can

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be done consistently with the language which he has employed, and this applies to a reissue as much as to an original patent.

8. Hence when there has been a reissue on an original patent, and the meaning of the specification and claim in the reissue is not perfectly clear, they may be read by the light of the specification and claim of the original patent, and if they can be sustained consistently with the language there used, be sustained by them.

9. A request which asks the court to charge that if a process patented was known to others more than two years *before the plaintiff applied for his patent,* the plaintiff's patent is void is rightly refused.

10. Where a specification in describing the mode of treating articles with a patented process (a liquid) said that "it is desirable to heat the latter *to or near the boiling point,* " and there was testimony that if *applied* while in that state to the articles to be treated, it would greatly injure them, as also that if it was suffered to cool before being applied, it possessed virtue, a request which asked the court to charge that the proper construction of the patent is that if the liquid applied at such a temperature is injurious and pernicious, the patent is void for want of utility, is rightly modified by a change which makes the charge say to the jury that the proper construction is that the liquid should be applied at or near the boiling point under the *common knowledge of persons skilled in the art* of treating the articles to be affected and to procure the desired results, and in reference to the fact whether [Footnote 1] such knowledge would make them wait until it was partially cooled before its application, and that if the application of the liquid at such a temperature as is required by the specification *under this qualification* was injurious and pernicious, then that the patent was void for want of utility.

11. Where one claim of a patent was for treatment by a compound composed of a liquid and other ingredients mentioned, a request for an instruction that the addition to the liquid of the ingredients is not patentable if such addition does not change the properties of the liquid or its effect or usefulness when applied to the *purposes mentioned in the patent* is rightly modified by charging as requested with the addition of the words *"or to other like purposes."*

12. A claim for a compound is not void because the specification does not prescribe exact and unvarying proportions in the ingredients of a compound; some of the ingredients being, *ex. gr.,* coloring matter, which the specification says may "be omitted or modified as desired."

13. A court is not bound to comply with requests for charges on points not raised by the evidence, nor when it has charged generally on the subject in its general charge, to repeat itself by answering requests for the same instructions.

Error to the Circuit Court for the Northern District of New York, in which court one Russell, a glover, of Gloversville,

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New York, brought suit against Klein, glover in the same place, for an infringement of a patent. The plaintiff got a verdict, the defendant having in the course of the trial taken various exceptions, on which the case was now here.

The case was thus:

In August, 1869, Russell obtained a patent for a new and useful improved process of treating leather so as to render it suitable for the manufacture of gloves. The specification said:

"My invention consists in a novel treatment of what is known as 'bark-tanned lamb or sheepskin,' an article used by bookbinders, and which, while sufficiently soft and supple for the purposes of their trade, is too harsh and stiff for glove making and a variety of other purposes. This objection is removed by my treatment of the article, and the leather rendered so soft and free, yet full in respect of body, as to

adapt it, among other purposes or uses, to the making of what are termed 'dogskin gloves.'"

"The process I adopt and which constitutes my invention is as follows: I take of 'fat liquor' obtained in scouring deerskin after tanning in oil, say ten gallons, and *warm the same by heating to or near the boiling point.* I then add to such *heated* fat liquor eight ounces of sal soda, twelve ounces of common salt, one pint of soft soap, and four ounces of Venetian red, and stir and mix these several ingredients with the fat liquor. This forms the treating mixture or compound, and when made in the foregoing quantity will suffice for five or six dozen skins, but of course such quantity may be more or less varied, as may also the proportions of the ingredients, and the Venetian red or other coloring matter is modified or omitted as desired."

"To effect the treatment hereinbefore referred to of the bark-tanned lamb or sheepskins, I lay said skin on a table or other suitable surface and *rub the above-described compound* on to both sides of it, using for the purpose a horse or other suitable brush or rubber by which it can be worked into the skin, that is afterward hung out to dry, and subsequently 'staked,' when the character of the skin will be found entirely changed from harshness to softness, and in other respects, thereby adapting it to the manufacture of gloves of the description previously named,

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and to a variety of other purposes for which said skin was not suitable prior to the treatment of it I have herein described."

The claim was thus:

"What is here claimed and desired to be secured by letters patent is the process, *substantially as herein described,* of treating bark-tanned lamb or sheepskin by means of a compound composed and applied *essentially as specified.* "

On the 1st of February, 1870, Russell got a reissue of this patent under the thirteenth section of the Patent Act, [Footnote 2] which permits a patentee,

whenever any patent is

"inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee's claiming in his specification as his own invention more than he had a right to claim as new if the error has arisen by inadvertency, accident, or mistake,"

to apply for a new patent, and in such case authorizes a new patent to be issued for *"the same invention"* in accordance with the patentee's corrected description and specification.

In the reissue, the invention having been described exactly as in the original patent, the specification said:

"The *principal* feature of the invention consists in the employment of what is known amongst tanners and others as 'fat liquor,' which is ordinarily obtained by scouring deerskins after tanning in oil, but which, when it is not convenient to obtain in this manner, may be produced as a liquor having the same character obtained by the cutting of oil with a suitable alkali."

"In treating leather with the 'fat liquor,' it is *desirable* to *heat* the latter *to or near the boiling point,* and it is *preferred* to use the same in connection with other ingredients. Thus, for instance, there may be added to each ten gallons of such heated fat liquor eight ounces of sal soda, twelve ounces common salt, one pint of soft soap or an equivalent quantity of hard soap, and four ounces of Venetian red, such ingredients to be well stirred and mixed with the fat liquor."

"This forms a good treating mixture or compound, and, when made in the foregoing quantity, will suffice for five or six dozen

skins, but of course such quantity may be more or less varied, as may also the proportions of the ingredients and the Venetian red or other coloring matter *be modified or omitted as desired.* "

"To effect the treatment hereinbefore referred to, of the bark-tanned lamb or sheepskin, the same should be well dipped in or saturated with the *fat liquor OR compound* of which fat liquor is the base. This may be done by laying the skin to be treated on a table or other suitable surface and rubbing the *fat liquor or compound* on or into both sides of the skin, using for the purpose a horse or other suitable brush or rubber by which it can be worked into the skin, that is afterward hung out to dry and subsequently 'staked,' when the character of said skin will be found entirely changed from harshness to softness, and other respects, thereby adapting it to the manufacture of gloves of the description previously named and to a variety of other purposes for which said skin was not suitable prior to the treatment of it I have herein described."

The claim was thus:

"What is here claimed and desired to be secured by letters patent is:"

"1. The employment of *fat liquor* in the treatment of leather *substantially as specified.* "

"2. The process, substantially as herein described, of treating bark-tanned lamb or sheepskin by means of a *compound* composed and applied *essentially as specified.* "

Upon *this reissue* Russell sued Klein as an infringer. His allegation was that bark-tanned leather before his treatment of it was harsh, "squeaky," and unsuitable for gloves, but that by his process, which, as he alleged, included *heating* the fat liquor, the "squeak" was removed and the leather rendered soft, pliable, and suitable for a fine glove; that the treatment, costing little, greatly enhanced the value of the leather and furnished a cheaper material for gloves than any other of the same quality and value.

The plaintiff's charge of infringement was wholly confined to the use of his process, including heat, and there was no allegation that the defendant had violated the plaintiff's rights by using fat liquor without heating it.

The defense was want of novelty. The case was heard before the district judge, sitting on the circuit. Numerous witnesses in behalf of the defendant swore that the application of fat liquor to leather for the purpose of making it soft and pliable had been known and in more or less use for many years, though they did not swear clearly that the application of fat liquor in a *heated* state with the effects which, in *that* state, it produced had been thus known or in use, and there was no proof by them of any use of fat liquor since the plaintiff's process had been patented otherwise than by heating the ingredients. Nor did they all swear so fully that the application and value of it was known in regard to *bark-tanned* skins; a good deal of their testimony relating to *oil-tanned* skins; and some of it to tanning raw skins or skins imperfectly tanned. Some stated that fat liquor heated near the boiling point and so applied would ruin the skins.

On the other hand, numerous witnesses of the plaintiff, glovers, at Gloversville and elsewhere, more or less familiar with the glove business in the vicinity and during the term of alleged prior knowledge spoken of by the witnesses of the defendant, testified that they had no knowledge of such leather as that which the plaintiff produced till about the date of his patent; that then the kind of leather produced by him with heated fat oils &c.;, went into extensive use, and that there was a great demand for it in the market. Some of these witnesses stated that heating the fat liquor to the boiling point and allowing it to cool so as to make it capable of being worked in did not destroy its properties. And the testimony of the witnesses of the defendant on cross-examination, tended perhaps to show that their knowledge of the means of softening leather at all by fat oils was very imperfect, and that what product was produced from bark-tanned skins was much inferior to that produced by the plaintiff, and was still affected with "squeak," and could not be used for the better sorts of glove; and that while they had experimented with heated fat oil, they had

never brought any of their ideas to a practical use, and had abandoned them.

In the course of the trial, one *Uriel Case,* a witness of the defendant, having testified as to the manner in which skins were treated twenty years ago, which manner the defendant asserted was substantially like the patented process, and having testified further that he had treated skins in this manner for twenty years until after the issue of the plaintiff's patent, was asked by the plaintiff:

"Did the plaintiff come and forbid you going on?"

A question to which the defendant objected as immaterial, incompetent, and as calling for the declaration of the plaintiff. But the court allowed the question to be put; the defendant excepting. The witness stated that the plaintiff did not forbid him, but asked him, "Are you not interfering with my patent?" and that he, the witness, "might have told him that he had a way of his own of fixing bark-tanned skins," "that he did not remember having said anything about its being an old thing, or having been done so twenty years ago."

So too, one *Place,* a witness of the defendant, having disclosed on cross-examination the facts that he was a glover at Gloversville in partnership with his brother, and that the plaintiff in the present case had sued *him* and his said brother some time before for an infringement of this same patent; that he, the witness, was now present, as his brother also was, without any payment of witness fees, as a witness for the defendant; that his brother had given him a paper in reference to the expenses of this suit; that he, the witness, had copied it and given it back to his brother, and had not seen it since -- was asked by the plaintiff to state the substance of that paper. This was objected to by the defendant, 1st upon the ground that the statement of the witness was not the best evidence; 2d, because no foundation had been laid for the production of the secondary evidence of the contents of the papers in question, and 3d because the testimony would be immaterial and incompetent. But the

court held the question admissible, the defendant excepting. The witness answered:

"It was merely in substance to defendant the manufacturing interests against Russell's patent. I didn't know who signed it."

The defendant having given evidence of the use of fat liquor upon oil-tanned skins for many years prior to plaintiff's patent, which use, he asserted, was the same, substantially, as the patented process -- and the plaintiff having given evidence that the oil-tanned skins referred to in such testimony, were skins dressed "from the raw" in oil, and that the fat liquor used upon them was a part of, or in aid of, the oil-dressing process -- and the plaintiff asserting that the use of the fat liquor in the process of oil tanning was essentially different from the patented process, that in oil dressing, as it is termed, the fat liquor was used in connection with oil for the purpose of *tanning* the pelt, or, in other words, of *converting it into leather from the raw state,* while in the patented process, the fat liquor was applied to a skin *already tanned,* and for the purpose of softening and adding new properties to it -- called a witness, one Dr. Porter, who stated that he was a physician and chemist, and had examined the patent of Russell and the specifications, and had made tests and experiments in relation to the fat liquor and the process therein described. The plaintiff then asked him:

"Will you state whether the effect of fat liquor applied to oil-tanned and bark-tanned skins is the same."

The defendant objected to the question "as immaterial, the purpose for which the process is used being immaterial, if the process is the same," but the court allowed the question to be put. The witness answered "that the general effect was the same, but that the combination by the fat liquor with the different skins produced compounds essentially different."

The record, which set out the substance of the evidence, proceeded:

"The evidence here closed, and the foregoing comprised the

substance of all the evidence given *relative to the alleged prior use of the process mentioned in the patent, and the novelty and usefulness, character and effect, of the alleged invention of plaintiff;* and thereupon the counsel for the defendant insisted before the said judge that the said several matters so produced and given in evidence as aforesaid were sufficient, and ought to be allowed as decisive evidence to entitle the defendant to a verdict, and requested the said judge to direct the said jury to find a verdict for the defendant."

The judge refused so to direct the jury, and proceeded to charge, charging among other things:

"That, taking the reissued patent as the basis of the plaintiff's claim, the true construction of the first claim is the employment of fat liquor generally in the state in which it comes from the mills, in the treatment of leather substantially as described; that this claim covered the employment of fat liquor in its pure and simple state."

"That the second claim covered the compound substantially as described in the specification, and that the heating of the liquor was an essential portion of the patented process under this claim."

"That specifications are not addressed to men entirely ignorant of the manufacture to which the specification relates, but to persons skilled in the art to which it appertains; that if, upon reading this specification, parties skilled in the art of dressing skins would know that this heating was for the purpose of making this compound with the fat liquor or for some other purpose, and that it would not do to apply the fat liquor at or near the boiling point, because it would destroy the leather, such parties would not be misled by it, and therefore it would not be a fatal defect; but that if persons skilled in the art, in attempting to put the plaintiff's invention in practice under this specification, would ordinarily apply the liquor to the skins used while it was at or near the boiling point, and thus destroy them, then, of course, this specification was bad."

"That the jury were to consider the claim of the plaintiff as embracing two distinct and independent things; that the plaintiff had a right, if he was the first and original inventor of the use of fat liquor, in its simple and pure state, in this process to secure that to himself pure and simple, and to hold as an infringer

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anyone who used it without adding the other ingredients that went to make up the compound specified; that he had a right to secure the use of the fat liquor and the other ingredients also, but that the difficulty was, so far as this case was concerned, that the party having embraced within his claim the use of fat liquor in its pure and simple state, the question of heat or of the use of the compound was not very important to the interests of the parties because, if the party claimed in his patent what was not new, or a substantial or material part of which was not new, the patent was void."

"That if the jury were satisfied that this process of employing fat liquor in the treatment of leather, as substantially described in the patent was known, that the process had been perfected, and had been used prior to this time of the plaintiff's invention, and that the persons who used the process had an intelligent comprehension of its character and the effect produced, the patent would be void; and that, upon the question of the validity of the patent, they were to look to the proof in regard to the use of fat liquor, substantially in the manner described when fat liquor alone is used, unconnected with the other ingredients constituting the compound, which is covered by the second claim in the patent; that if the jury should find that this process had been used prior to plaintiff's alleged invention by other persons, as stated and claimed here, that the persons who used the process were aware of the object and character of it, observed and comprehended the beneficial results produced by its use, then the patent would be void upon the ground of want of novelty, although some circumstances might have induced them to abandon temporarily the actual practice of the invention, or the use of the process."

"That if they came to the conclusion that the process claimed in the first specification, that is the fat liquor had been so used substantially as described in the specification before this invention, that was the end of the case."

"But if they should come to the conclusion, upon the other hand, that all these other experiments were failures and were abandoned, then they would come to the question of infringement."

"That the proof in regard to the quality and character of leather produced and the knowledge of it at Gloversville and vicinity, and the want of knowledge of it, was proper for the

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consideration of the jury, in connection with the question of whether these experiments were failures, whether this process was perfected and used, or whether the experiments and trials never reached the point of invention and were consequently abandoned. But it was not a question whether the result of the use of the process was as perfect at the time as it is now. It was a question whether, substantially, the same process was used."

The PLAINTIFF'S counsel then requested the judge to charge the jury,

"That the application of heat to the liquor, and the use of liquor, as described, while in a heated state, are essential parts of the invention or discovery; but it is not by necessary construction required by the patent that the liquor should be applied to the skins at or near the boiling heat."

The judge declined to thus charge on the ground that, under the first claim of the patent, neither the heating of the fat liquor nor the application or use of it, in a heated state, was an essential portion of the process.

The DEFENDANT'S counsel then requested the judge to charge,

"1st. That the invention, as described in the patent of February, 1870, is the treatment of bark-tanned sheep and lamb skins by the employment of fat liquor,

and if such treatment was known to others, and more than two years before the plaintiff applied for his patent, his patent is void."

Refused.

"2d. That the proper construction of the patent is that the fat liquor should be applied at or near the boiling point, and if the application of fat liquor at such a temperature to leather is injurious and pernicious, the patent is void for want of utility."

Refused in the form put, but modified and given thus:

"The proper construction of the second claim of the patent so far as it relates to the application of heat is that the compound composed of fat liquor and the other ingredients required, should be applied at or near the boiling point, *under the common*

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knowledge of persons skilled in the art of treating this leather, to procure softness and pliability[? [Footnote 3]], would make them wait until it was partially cooled before its application, and if the application of fat liquor at such a temperature to leather as is required by the specification under this qualification is injurious and pernicious the patent is void for want of utility, and the defendant entitled to a verdict."

"3d. That if the patent did not intend that the fat liquor be applied to leather when at or near the boiling point, it is, in respect to the application of heat, void for ambiguity."

Refused for the reasons substantially appearing in the modification of the last preceding request.

"4th. That if cooling the fat liquor after boiling is an essential point of the plaintiff's process, then the patent is void for not indicating that such process of cooling is necessary or how it is to be accomplished."

Refused in the form put, but modified and given by adding thereto the words:

"Unless the common knowledge of persons skilled in the art of treating this leather to produce softness and pliability would make the operator wait until it was partially cooled before its application."

"5th. That the addition to the fat liquor of the other ingredients mentioned in the specifications is not patentable if such addition does not change the properties of the fat liquor, or its effect or usefulness, when applied to the purposes mentioned in the patent or specification."

Refused in the form put, but thus modified and given:

"The addition to the fat liquor of other ingredients mentioned in the specifications is not of itself patentable, if such addition does not change the properties of the fat liquor or its effect or usefulness, when applied to the purposes mentioned in the patent or specification *or to other like purposes.* "

"6th. That the process of preparing leather by means of a

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compound, as claimed by the plaintiff, is not patentable because the proportions of such compound are not fixed, but are in all respects indefinite and uncertain, and may be waived or omitted by the terms of the patent."

Refused.

"7th. That if fat liquor had been used substantially in the manner specified in the plaintiff's patent for the purpose of rendering any kind of leather soft and supple more than two years [before the plaintiff applied for a patent], the plaintiff cannot recover, even though it had not been so used in dressing bark-tanned lamb or sheepskins."

Refused. The defendant then modified his request by substituting "used before the plaintiff's invention" for "before the plaintiff applied for a patent," and thereupon the

court charged,

"That the application of an old invention or an old machine to produce a new result, because it is applied to a different material, is not an invention, and the question of novelty is to be determined in the same way. That under the first claim of the plaintiff's, if this particular process was used for the purpose of softening leather, it is not material that it was bark-tanned sheep or lamb skins, if it be used as a process for that purpose."

"8th. That if the object of plaintiff's process was to substitute a less valuable article for that commonly known as 'dogskin,' and to impose upon the public by representing gloves made of softened sheep and lamb skins as dogskin gloves, the patent is void for fraud, and plaintiff cannot recover."

Refused, and the jury thus charged:

"If the process patented cannot be made useful for any honest purpose, and can be used only for perpetrating a fraud upon the public, and is therefore not useful, but pernicious, the plaintiff cannot recover."

"9th. That if anything claimed by the plaintiff in his patent as used was in fact old, the entire patent was void and plaintiff could not recover."

Refused except as had already been charged.

"10th. That the patent could not be sustained in the matter

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of the mere degree of heat, if the principle of applying heat to any extent is an old process."

Refused except as had already been charged.

The jury found for the plaintiff.

On a motion made for a new trial (the circuit judge, Woodruff, J., now sitting), that learned justice was of opinion that there was no sufficient reason for disturbing the verdict. He said:

"The conflict of evidence upon the questions of fact was great, and made it a very proper case for submission to the jury. The impression on my own mind, after a careful examination of the testimony, is that the verdict is right, and the plaintiff is in fact the inventor of a new and useful process secured to him by his patent, and that the defendant is a willful and deliberate infringer of his rights."

Adverting to the construction of the patent given by the learned district judge, he observed that it differed from a construction which he had himself put upon it on the trial on the circuit of another case by this same plaintiff against another defendant on the same patent (*Russell v. Place*), and where he instructed the jury that "the use of heat in the treatment of skins was an essential part of the patented process." The learned justice continued:

"But this instruction was not excepted to by the defendant, and he is not, as a matter of right, entitled to question the correctness of the charge to the jury on that point. In that particular, the question on a motion for a new trial is not simply whether the instruction was correct. If it appeared to me to be erroneous and yet it was clear that it worked no injustice to the defendant, it would be no reason for granting a new trial."

The exceptions to the evidence he considered were not well taken, independently of which the evidence led to nothing. And on the principal questions, the learned circuit judge considering, as already said, that the instructions of the court to the jury were,

"at any rate, as favorable to the defendant as he had a right to require, and that the

special instructions sought were charged as fully as the law would allow,"

denied the motion for a new trial. The case was now here in this position.

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MR. JUSTICE SWAYNE delivered the opinion of the Court.

The action was for the infringement of a reissued patent. The plaintiff in error was the defendant in the court below. A verdict and judgment were rendered against him. In the progress of the trial he took numerous exceptions. We have considered them, and will proceed to dispose of the case.

There was no error in the refusal of the court to direct a verdict for the defendant. The evidence is fully set out in the record. It was well remarked by the circuit judge, in deciding the motion for a new trial, that "the conflict of evidence upon the questions of fact is very great, and made it a very proper case for submission to the jury." Where it is entirely clear that the plaintiff cannot recover, it is proper to give such a direction, but not otherwise.

It is insisted, in this connection, that the reissue is void, because it was not for the same invention as the original patent.

This point does not appear to have been taken in the court below, and, therefore, cannot be made here. No instruction was asked or given touching the subject. It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent.

The question put to *Uriel Case,* and his answer, were within the proper limits of a cross-examination. [Footnote 4]

The question to Place was proper, and his answer was not objected to. His answer as to his connection with the paper to which he referred also passed without objection. But it is insisted that it was error to require him to state its contents,

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no notice to produce it having been given. To this there are two answers: it was an incidental and collateral matter drawn out to test the temper and credibility of the witness. It in no wise affected the merits of the controversy between the parties. The witness stated that he did not know who signed the paper. The contents could not, therefore, have operated to the injury of the defendant.

The question to Porter involved the novelty, utility, and *modus operandi* of the alleged invention of the plaintiff, and the answer was competent evidence.

Elaborate instructions covering the entire case were given to the jury. None of them was excepted to by the defendant.

Numerous instructions were asked by his counsel. An exception was taken in relation to each one of them, and is assigned for error.

We shall refer to them as they are numbered in the record.

I. That the patent is for

"the treatment of bark-tanned sheep and lamb skins, by the employment of fat liquor, and if the jury believe such treatment was known to others more than two years before the plaintiff applied for his patent, his patent is void."

This instruction was properly refused. It stated inaccurately the rule of law which it involved. A patent relates back, where the question of novelty is in issue, to the date of the invention, and not to the time of the application for its issue. The jury had already been sufficiently instructed upon the subject. The instruction assumes that the reissue was for the use of fat liquor, without reference to the point whether it were hot or cold. This renders it necessary to construe the patent with a view to the solution of that question.

The original specification declared that the invention consisted "in a novel treatment of bark-tanned lamb or sheepskins." The patentee said:

"The process I adopt, and which constitutes my invention, is as follows: I take of 'fat liquor,' obtained in scouring deerskins after tanning in oil, say ten gallons, and

warm the same to or near the boiling point. I then add to such heated fat liquor eight ounces of

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sal soda, twelve ounces of common salt, one pint of soft soap, and four ounces of Venetian red, and stir and mix these several ingredients with the fat liquor."

The claim is as follows:

"What is here claimed and desired to be secured by letters patent, is the process substantially as herein described of treating bark-tanned lamb or sheepskins by means of a compound and applied essentially as specified."

With this specification and claim, it was apprehended that the patent did not cover the use of heated fat liquor *alone* -- which the patentee claimed as a part of his invention -- but that it would be held to cover the use of such heated liquor only in combination with the ingredients specified. If so, the omission of any one or all of the ingredients would have given immunity to an infringer. To remedy this defect the reissue was procured. In the specification in that case, the patentee says: "My invention consists in a novel treatment of what is known as bark-tanned lamb or sheepskin."

"The principal feature of my invention consists in the employment of what is known amongst tanners as fat liquor, which is ordinarily obtained by scouring deerskins, after tanning in oil, but which, when it is not convenient to obtain in this manner, may be produced as a liquor having the same character -- obtained by the cutting of oil with a suit able alkali. In treating leather with the 'fat liquor,' it is desirable to heat the liquor to or near the boiling point, and it is preferred to use the same in connection with other ingredients. Thus, for instance, there may be added to each ten gallons of such heated fat liquor eight ounces sal soda, twelve ounces common salt, one pint of soft soap, or an equivalent quantity of hard soap, four ounces of Venetian red, such ingredients to be well stirred and mixed with the fat liquor."

The claims are as follows:

"1. The employment of fat liquor in the treatment of leather, substantially as specified."

"2. The process, substantially as herein described, of treating bark-tanned lamb or sheepskins by means of a

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compound composed and applied essentially as specified."

The mode of application prescribed in both specifications is the same.

The first claim, it has been argued, is for the use of fat liquor generally, hot or cold. If it be for the former only, the patent may be valid, while if for the latter, it may be too broad, and therefore void.

The counsel for the patentee insists that the claim is limited to fat liquor in a heated state. The subject is to be examined in the light of both specifications and of both sets of claims. The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself if this can be done consistently with the language which he has employed.

The original specification and claim were clearly confined to heated fat liquor. The law [Footnote 5] required that the reissue should be for the same invention as the original patent. It is to be presumed the Commissioner did his duty. If the reissue be for fat liquor generally, it is for a thing then patented for the first time, and the patent involves a violation of the law.

The second specification says:

"The principal feature of the invention is the employment of 'fat liquor.' It then proceeds to direct how the liquor shall be prepared. In doing this, it is said 'it is desirable to heat the liquor to or near the boiling point.'"

This is the foundation of the first claim, which is for "the employment of fat liquor in the treatment of leather, *substantially as specified.* " The heated condition of the liquor is before distinctly specified, and if it be applied in any other state its condition will not be as specified, either exactly or substantially. After the words "boiling point," the specification proceeds:

"And it is preferred to use the same in connection with other ingredients. Thus, for instance, there may be added to each ten gallons of such *heated* fat liquor,"

&c.; The ingredients are then named. This is the ground

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of the second claim, to-wit:

"The process substantially as herein described of treating bark-tanned lamb or sheepskins by means of a compound composed and applied essentially as specified."

Here, *heated* fat liquor is clearly one of the constituents of the compound. A chemist proved on the trial that heat was an element essential, in a large degree, to the efficacy and utility of both the simple liquor and the compound, when so applied. We think the better opinion is that the first claim was intended to cover and does cover only the use of heated liquor.

The first instruction might well have been refused for the reason also that it was too broad as to this point.

II. The next prayer and the action of the court are thus set forth in the bill of exceptions:

"2. The defendant's counsel also requested the said judge to charge that the proper construction of the patent is that the fat liquor should be applied at or near the boiling point, and if the jury believe that the application of fat liquor at such a temperature to leather is injurious and pernicious, the patent is void for want of utility, and the defendant entitled to a verdict; but the said judge refused so to

charge the jury, but modified the said request and instructed the jury that the proper construction of the second claim of the patent, so far as it relates to the application of heat, is that the compound, composed of fat liquor and the other ingredients required, should be applied at or near the boiling point, under the common knowledge of persons skilled in the art of treating this leather, to procure softness and pliability, would make them wait until it was partially cooled before its application, and if the jury believe that the application of fat liquor at such a temperature to leather as is required by the specification under this qualification is injurious and pernicious, the patent is void for want of utility and the defendant entitled to a verdict; and the counsel for defendant then and there duly excepted."

We think this ruling of the court was correct.

III and IV. These exceptions are sufficiently answered by what was said by the circuit court as to the second prayer.

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V. This instruction was properly modified. The state of the evidence hardly justified the judge in giving any instruction upon the subject to which it related.

The remaining five exceptions may be grouped and disposed of together. Neither of them requires any special remark.

We are satisfied with the rulings of the learned judge who tried the case as to each and all of them.

We find nothing in the record of which the plaintiff in error has a right to complain.

Judgment affirmed.

Dissenting, JUSTICES FIELD and HUNT.

[Footnote 1]

See infra, p. 86 U. S. 444 , note.

[Footnote 2]

5 Stat. at Large 122.

[Footnote 3]

Something was left out here in the transcript. In the syllabus, I have assumed that it was the words, "and in reference to the fact whether such knowledge," &c.;

[Footnote 4]

Johnston v. Jones, 1 Black 210.

[Footnote 5]

Act of 1836, 13, 5 Stat. at Large 122.

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