

Bate Refrigerating Co. Vs. Hammond

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Appellant : Bate Refrigerating Co.

Respondent : Hammond

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Bate Refrigerating Co. v. Hammond - 129 U.S. 151 (1889)

U.S. Supreme Court Bate Refrigerating Co. v. Hammond, 129 U.S. 151 (1889)

Bate Refrigerating Company v. Hammond

No. 862

Argued January 2-4, 1889

Decided January 21, 1889

129 U.S. 151

*APPEAL FROM THE CIRCUIT COURT OF THE UNITED
STATES FOR THE DISTRICT OF MASSACHUSETTS*

SYLLABUS

A United States patent was granted November 20, 1877, for seventeen years, on an application filed December 1, 1876. A patent for the same invention had been granted in Canada, January 9, 1877, to the same patentee, for five years from that day, on an application made December 19, 1876. On a petition filed in Canada by the patentee December 5, 1881, the Canada patent was, on December 12, 1881, extended for five years from January 9, 1882, and, on December 13, 1881, for five years from January 9, 1887, under 17 of the Canada act assented to June 14, 1872 (35 Victoria, c. 26). *Held*, under 4857 of the Rev.Stat., that, as the Canada act was in force when the United States patent was applied for and issued,

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and the Canada extension was a matter of right at the option of the patentee, on his payment of a required fee, and the fifteen years' term of the Canada patent had been continuous and without interruption, the United States patent did not expire before the end of the fifteen years' duration of the Canada patent.

It was not necessary to the validity of the United States patent that it should have been limited in duration, on its face, to the duration of the Canada patent, but it is to be so limited by the courts, on evidence *in pais*, as to expire at the same time with the Canada patent, not running more than the seventeen years.

This is a suit in equity, brought in the Circuit Court of the United States for the District of Massachusetts December 16, 1886, by the Bate Refrigerating Company, a New York corporation, against George H. Hammond & Co., a Michigan corporation, founded on the alleged infringement of letters patent No. 197,314, granted to John J. Bate, November 20, 1877, for the term of seventeen years from that day on an application filed December 1, 1876, for an "improvement in processes for preserving meats during transportation and storage."

The plaintiff is the assignee of the patent. The bill alleges infringement, within the District of Massachusetts and elsewhere in the United States, by the making, using, and vending of the patented process, and alleges that the defendant has

been engaged in the business of shipping fresh meat from the port of Boston to ports in Great Britain by means of the process claimed in the patent. The claim is as follows:

"The herein-described process of preserving meat during transportation and storage by enveloping the same in a covering of fibrous or woven material and subjecting it when thus enveloped to the continuous action of a current of air of suitably low and regulated temperature, substantially as and for the purpose set forth."

The defendant filed a plea setting up, among other things, that on the 9th of January, 1877, letters patent of the Dominion of Canada, No. 6,938, for the same invention as that described and claimed in No. 197,314 were granted to the same John J Bate, for the term of five years from the 9th of January, 1877; that after No. 197,314 had expired,

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at the end of the term of five years for which such Canadian patent was granted, the Circuit Court of the United States for the District of New Jersey, upon being advised of the grant of such Canadian patent, vacated and set aside an injunction which it had theretofore granted, by an interlocutory decree made in a suit in equity founded on No. 197,314, brought by the Bate Refrigerating Company against Benjamin W. Gillett and others; that thereafter Bate and the Bate Refrigerating Company procured the rendition of a judgment by the Superior Court for Lower Canada, declaring the Canadian patent to have been void *ab initio* and vacating it and setting it aside; that such judgment of the superior court for Lower Canada being brought to the attention of the Circuit Court of the United States for the District of New Jersey, that court reinstated said injunction, and that afterwards the Superior Court for Lower Canada, in a suit brought by Sir Alexander Campbell, Minister of Justice and Attorney General for the Dominion of Canada against Bate and the Bate Refrigerating Company and others, adjudged that its said prior judgment had been "arrived at through the fraud to the law and collusion" of Bate the Bate Refrigerating Company and another other person,

"deceiving the Attorney General, the advocates, and the court, employing and paying counsel on both sides, as well, seemingly, against themselves as on their apparent behalf,"

and revoked and annulled its said prior judgment. The plea concluded by averring that No. 197,314 expired on the 9th day of January, 1882, and that the circuit court, sitting as a court of equity, had no jurisdiction to hear and determine an action in equity for the infringement of the patent.

The bill was then amended by averring that the application for the Canadian patent was not made until December 19, 1876, while the application for No. 197,314 was made December 1, 1876, and that the Canadian patent was not actually or legally issued until on or about June 26, 1878, on or about which date a model of the invention, as required by law, was filed in the Canadian Patent Office. The amendment to the bill also set forth the two judgments of the Superior Court for Lower Canada, and averred that, by virtue of an act of the

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Parliament of the Dominion of Canada assented to May 25, 1883, 46 Vict. c. 19, the original term of the Canadian patent was actually fifteen years, instead of five years, and it would not terminate before the 9th of January, 1892.

Subsequently the defendant filed an answer to the bill setting up, among other defenses, want of novelty in the patented invention, but not denying that it had used the invention subsequently to the granting of the patent, and also setting up the granting of the Canadian patent for five years from January 9, 1877; that No. 197,314 was void because it was issued for seventeen years, and its term was not limited by the Commissioner of Patents to five years from January 9, 1877; that the Canadian application was not made until after the application for No. 197,314 was filed; that Bate did not file a model in the Canadian Patent Office until after the grant of the Canadian patent, and that the Canadian patent was actually patented to Bate on the 9th of January, 1877, and took effect on that date, although not actually delivered to the patentee until after the filing of the model. It also sets forth

the two Canadian judgments, and avers that, on the 30th of November, 1881, Bate made a petition to the Commissioner of Patents for Canada for the extension of No. 6,938 in which he averred that, on the 9th of January, 1877, he

"obtained a patent for the period of five years from the said date, for new and useful improvements on apparatus and process for ventilation, refrigeration, etc.,"

and that he was the holder of that patent in trust for the Bate Refrigerating Company, and prayed that it might be extended "for another period of ten years;" that, on the filing of that petition, an extension of the patent was granted, on December 12, 1881, "for a second period of five years" from January 9, 1882; that a further extension of the patent was granted, December 13, 1881, "for a third period of five years" from January 9, 1887; that the plaintiff is thereby estopped from denying the fact that No. 6,938 was legally granted, January 9, 1877, for a period of five years; that by virtue of the act of 46 Vict. c. 19, the original term for which No. 6,938 was granted was not fifteen years instead of five years; that said act can have no effect on the

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duration of No. 197,314; that by reason of the prior patenting of the invention by Bate in Canada for five years from January 9, 1877, No. 197,314, if valid at all, expired on January 9, 1882, and that therefore this Court, sitting in equity, has no jurisdiction to hear and determine an action for its infringement.

Without the filing of any replication to this answer, the parties entered into a written stipulation setting forth as follows:

"Whereas the answer of the defendant corporation in this cause sets up, in addition to other defenses, that the patent on which this suit is brought, being No. 197,314, granted to John J. Bate, complainant's assignor and president, on the twentieth day of November, A.D. 1877, expired on the ninth day of January, A.D. 1882, by reason of the prior grant to said John J. Bate of a patent in the Dominion of Canada for the same invention, and prays the same benefit of said defense as if the same had been pleaded to the bill of complaint, and whereas both parties

desire to have said matter of defense argued and decided without incurring the great expense of taking testimony necessary to present for final hearing all the defenses raised in said answer, it is therefore stipulated and agreed by and between the parties that the defense above named shall be submitted to the court, as on plea set down for argument, upon the following agreed state of facts."

The facts so agreed to were substantially as follows:

1. The patent in suit, No. 197,314, was granted to John J. Bate on November 20, 1877, and the application therefor was filed in the United States Patent Office, December 1, 1876, and said patent was assigned to complainant before this suit was brought, the said Bate being a citizen of the United States at the time of said application, and the said invention having been made and reduced to practice by him therein.
2. On December 19, 1876, said John J. Bate filed in the Patent Office of the Dominion of Canada an application for a patent for improvements in apparatus and processes for ventilation, refrigeration, etc., including therein, as one feature, the process described and claimed in said patent No. 197,314.
3. In pursuance of said application, the Commissioner of

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Patents for the Dominion of Canada caused letters patent of the Dominion of Canada, No. 6,938, for the invention set forth in said application, and granting to said John J. Bate, his executors, administrators, and assigns, the exclusive right, privilege, and liberty of making, constructing, using, and vending to others to be used, the said invention, to be signed and sealed with the seal of the Patent Office on January 9, 1877, and the be registered on January 11, 1877, and that the period of said grant expressed in said patent was five years from and after January 9, 1877.

4. On January 12, 1877, said Commissioner of Patents called upon said John J. Bate to furnish to the Patent Office a model of his said invention, and such model

was furnished by said Bate on June 26, 1878, on which day said patent No. 6,938 was mailed to said John J. Bate.

5. On December 5, 1881, said John J. Bate filed a petition in the Canada Patent Office, setting forth

"that on the 9th day of January, A.D. 1877, your petitioner obtained a patent for the period of five years from the said date, for new and useful improvements on apparatus and process for ventilation, refrigeration, etc.; that he is the holder of the said patent in trust for the 'Bate Refrigerating Company,' and therefore prays that it may be extended for another period of ten years."

6. On December 12, 1881, said patent No. 6,938 was extended for five years from January 9, 1882, under renewal No. 13,812, and on December 13, 1881, said patent was further extended for five years from January 9, 1887, under renewal No. 13,813, in pursuance of the above-named petition.

7. On or about July 9, 1883, and June 30, 1886, the Superior Court for Lower Canada rendered two judgments affecting said Canada patent, to the purport set forth in the plea and the answer. The stipulation further provided that if the decision of the circuit court should be in favor of the plaintiff, it should have a reasonable time thereafter to file a replication in the answer, and the cause should proceed in the ordinary manner; that if the circuit court should decide the cause in favor of

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the defendant, a decree should be entered dismissing the bill, so that the plaintiff might take an appeal therefrom to the Supreme Court of the United States, and that if the circuit court should decide the cause in favor of the defendant, and the Supreme Court of the United States should, on appeal, reverse that decision, the defendant should have a right to proceed in the circuit court, under its answer, as to all defenses set up therein, except the one mentioned in the stipulation, as it might have proceeded if the stipulation had not been made.

The cause was heard on the pleadings and stipulation, and the circuit court entered a decree dismissing the bill, 35 F. 151, from which decree the plaintiff has appealed to this Court. The circuit court gave no opinion on the merits of the case, but in deciding it followed, as it stated, the decision of the Circuit Court of the United States for the District of New Jersey, held by MR. JUSTICE BRADLEY, in August, 1887, made in the case of *Refrigerating Co. v. Gillett*, 31 F. 809.

MR. JUSTICE BLATCHFORD delivered the opinion of the Court.

The questions discussed at the bar arise under 4887 of the Revised Statutes, which is as follows:

"No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one at the same time with the one having the shortest term, and in no case shall it be in force for more than seventeen years."

Two propositions as to the construction of this section are contended for by the appellant: (1) that the words "first patented or caused to be patented in a foreign country" do not mean "first patented or caused to be patented" before the issuing, or granting, or date, of the United States patent, but

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mean "first patented or caused to be patented" before the date of the application for the United States patent; (2) that the declaration of the section that

"Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one at the same time with the one having the

shortest term"

does not mean that the patent so granted shall expire at the same time with the term to which the foreign patent was in fact limited at the time the United States patent was granted, but that it means that it shall expire when the foreign patent expires, without reference to the limitation of the term of such foreign patent in actual force at the time the United States patent was granted.

We do not find it necessary to consider the first of these questions, because we are of opinion that the proper construction of 4887 upon the second question is that the patent in the present case does not expire before January 9, 1892, the time when the Canadian patent, No. 6,938, will expire.

The Canadian patent was extended for the two periods of five years each under the provisions of 17 of the Canadian act assented to June 14, 1872, 35 Vict. c. 26, which was in force when the United States patent, No. 197,314, was applied for and granted, and which read as follows:

"17. Patents of invention issued by the Patent Office shall be valid for a period of five, ten, or fifteen years at the option of the applicant, but at or before the expiration of the said five or ten years, the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years may again obtain a further extension for another period of five years, not in any case to exceed a total period of fifteen years in all, and the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted, to be attached, with reference to the patent, and under the signature of the Commissioner, or of any other member of the Privy Council in the case of absence of the Commissioner."

This statute appears to have been strictly complied with in

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the present case. The Canadian patent No. 6,938 ran, on its face, for five years from January 9, 1877, and, prior to the expiration of that time, and on the 5th of

December, 1881, Bate applied for its extension for ten years, and it was, before the five years expired, and on the 12th of December, 1881, extended for five years from January 9, 1882, and, on December 13, 1881, for five years from January 9, 1887. The Canadian patent therefore has never ceased to exist, but has been in force continuously from January 9, 1877. It was in force when No. 197,314 was issued, and it has, by virtue of a Canadian statute, in force when the application for No. 197,314 was filed, continued to be in force at all times since the latter patent was granted. This is true although the Canadian patent, No. 6,938, as originally granted, stated on its face that it was granted "for the period of five years" from January 9, 1877, and although the instrument granting the first extension of five years states that it is granted "for another period of five years, to commence and be computed on and from the ninth day of January, which will be in the year one thousand eight hundred and eighty-two," and although the instrument granting the second extension of five years states that it is granted

"for another period of five years, to commence and be computed on and from the ninth day of January, which will be in the year one thousand eight hundred and eighty-seven."

By the language of 17 of the Canadian act of 1872, what was granted under it was "an extension of the patent" -- of the same patent -- for a further term. Therefore the Canadian patent does not expire, and it never could have been properly said that it would expire, before January 9, 1892, and hence No. 197,314, if so limited as to expire at the same time with the Canadian patent, cannot expire before January 9, 1892.

Section 6 of the Act of March 3, 1839, 5 Stat. 354, provided that a United States patent for an invention patented in a foreign country more than six months prior to the application of the inventor for the United States patent should be limited to a term of fourteen years from the date of publication of the foreign patent. Section 25 of the Act of July 8, 1870, 16

Stat. 201, provided that the United States patent for an invention "first patented or caused to be patented in a foreign country" should

"expire at the same time with the foreign patent, or, if there be more than one at the same time with the one having the shortest term, but in no case shall it be in force more than seventeen years."

Section 4887 of the Revised Statutes provides that

"Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

These provisions of the act of 1870 and of the Revised Statutes mean that the United States patent shall not expire so long as the foreign patent continues to exist, not extending beyond seventeen years from the date of the United States patent, but shall continue in force, though not longer than seventeen years from its date, so long as the foreign patent continues to exist. Under 4887, although, in the case provided for by it, the United States patent may on its face run for seventeen years from its date, it is to be so limited by the courts, as a matter to be adjudicated on evidence *in pais*, as to expire at the same time with the foreign patent, not running in any case more than the seventeen years, but, subject to the latter limitation, it is to be in force as long as the foreign patent is in force.

A contrary view to this has been expressed by several circuit courts of the United States.

In October, 1878, in the Circuit Court for the District of Rhode Island, in *Henry v. Providence Tool Co.*, 3 Ban. & Ard.Pat. 501, it was held that the 25th section of the Act of July 8, 1870, meant that the United States patent should expire at the same time with the original term of a foreign patent for the same invention, without regard to any prolongation of the foreign patent which the patentee might procure from the foreign government. In that case, the United States patent was granted October 10, 1871. A British patent for the same invention had been granted to the

patentee on the 15th of

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November, 1860, for fourteen years, and expired November 15, 1874. Thirteen days after the latter date, an order was made for the extension of the British patent for four years, the extension bearing date as of the day after the expiration of the original term; but the court held that the United States patent expired on the 15th of November, 1874.

That decision was followed by the Circuit Court for the Southern District of New York in *Reissner v Sharp*, 16 Blatchford 383, in June, 1879, which case arose under 4887 of the Revised Statutes. In that case, the United States patent, granted October 20, 1874, for seventeen years, was held to have expired on the 15th of May, 1878, because a patent was granted in Canada, under the authority of the patentee, for the same invention on the 15th of May, 1873, for five years from that day, although in March, 1878, the Canada patent was extended for five years from the 15th of May, 1878, and also for five years from the 15th of May, 1883.

In *Bates Refrigerating Co. v Gillett*, 13 F. 533, in the Circuit Court for the District of New Jersey, in August, 1882, and in the same suit in the same court in August, 1887, 31 F. 809, in regard to the patent in question in the present suit and on the same facts here presented, it was held, on the strength of the two circuit court cases above referred to, that the United States patent expired when the original term of the Canadian patent expired

But we are of opinion that in the present case, where the Canadian statute under which the extensions of the Canadian patent were granted was in force when the United States patent was issued and also when that patent was applied for, and where, by the Canadian statute, the extension of the patent for Canada was a matter entirely of right at the option of the patentee, on his payment of a required fee, and where the fifteen-years term of the Canadian patent has been continuous and without interruption, the United States patent does not expire before the end

of the fifteen-years duration of the Canadian patent. This is true although the United States patent runs on its face for seventeen years from its date, and is not on its face so limited as to expire at the same time with

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the foreign patent; it not being necessary that the United States patent should on its face be limited in duration to the duration of the foreign patent.

In [O'Reilly v. Morse](#), 15 How. 62, the patent to Morse was issued June 20, 1840, for fourteen years from that day, while 6 of the Act of March 3, 1839, 5 Stat. 354, was in force, which required that every United States patent for an invention patented in a foreign country should be "limited to the term of fourteen years from the date of publication of such foreign letters patent." Morse applied for his United States patent April 7, 1838. He obtained a patent in France for his invention October 30, 1838. The objection was taken in the answer that the United States patent was void on its face because not limited to the term of the French patent. The circuit court held that the patent was not void, but that the exclusive right granted by it must be limited to fourteen years from October 30, 1838. The same objection was urged in this Court, and the same ruling was made. In [Smith v. Ely](#), 15 How. 137, which was a suit on the same patent under the same facts, the same question arose and was decided in the same way. A full and interesting discussion of the question is to be found in *Canan v. The Pound Mfg. Co.*, 23 F. 185, in regard to 4887, which contains the same word "limited" found in 6 of the act of 1839, which word is not found in 25 of the Act of July 8, 1870, from which 4887 was taken.

Under this view, the time of the expiration of the foreign patent may be shown by evidence *in pais*, either by the record of the foreign patent itself, showing its duration, or other proper evidence, and it is no more objectionable to show the time of the expiration of the foreign patent by giving evidence of extensions such as those in the present case, and thus to show the time when, by virtue of such extensions, the United States patent will expire.

We find in the record in this case, among the papers which it states were submitted to the court under the stipulation above referred to, a certificate of the Commissioner of Patents, dated July 3, 1883, appended to a certified copy of the United States patent, stating that the term thereof is limited so that

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it shall expire with the patent obtained by the patentee in Canada, No. 6,938, dated January 9, 1877, for the same invention; that the proper entries and corrections have been made in the files and records of the Patent Office; that it had been shown that the original patent had been lost, and that the certificate is made because that patent was issued without limitation, as required by 4887 of the Revised Statutes. While it may be proper, in a case where the date of a foreign patent issued prior to the granting of a United States patent to the same patentee for the same invention is made known to the Patent Office prior to the granting of the United States patent, to insert in that patent a statement of the limitation of its duration, in accordance with the duration of the foreign patent, it does not affect the validity of the United States patent if such limitation is not contained on its face.

It results from these views that

The decree of the circuit court must be reversed, and the case be remanded to that court with a direction to take such further proceedings as shall be in accordance with law and with the stipulation between the parties, above referred to, and not inconsistent with this opinion.