1896

Novelty in Patent Law

Michael L. Ryan
Cornell Law School

Follow this and additional works at: http://scholarship.law.cornell.edu/historical_theses

Part of the Law Commons

Recommended Citation
NOVELTY IN PATENT LAW.

---

Thesis presented by

Michael L. Ryan

for the Degree of LL. B.

---

Cornell University

School of Law.

1896.
NOVELTY IN PATENT LAW.

The patent System of the United States rests upon a constitutional provision and the statutes passed by Congress. Article first, section eight, of the Constitution confers upon Congress the power to promote the progress of science and the useful arts, by securing for limited periods, to authors and inventors, the exclusive right to their respective writings and discoveries.

Letters Patent are issued by the Federal Government, not as a special favor or act of grace, but as a matter of right, to the inventor who has complied with the conditions which the statute imposes. The granting of letters patent in this country is simply a contract between the individual and the state. The consideration for which a patent is granted is the benefit conferred upon the public by the inventor, in disclosing and making known the product of his skill and genius.

In England, inventors are never entitled, as of right, to letters patent, but they must obtain them from the crown by petition, and as a matter of grace and favor, the letters patent stating that the grant is so made. The power of the crown to grant patents was restrained and regulated by the "Statute of Monopolies", passed during the reign of James I. This statute has been modified by subsequent acts of Parliament.
The Patent Laws of the United States were designed, not so much for the benefit of inventors, as for the purpose of encouraging and stimulating a spirit of investigation and experiment, to the end that new and useful inventions, accruing the benefit of the public, might be produced. Were it not for the protection afforded by the patent laws, few inventors would be willing to devote their time, or labors, to the production of contrivances which, in many instances, prove of inestimable benefit to the public; but of no practical value to the inventor.

Congress inaugurated the patent system by an act passed in 1790. This act provided that it should be the duty of the Secretary of State, the Secretary of War, and the Attorney-General, or any two of them, to grant to every inventor whose discovery they deemed sufficiently useful and important, a patent securing to him the exclusive benefits of his invention for a period not exceeding fourteen years. In 1793 the duty of issuing patents was confided to the Secretary of State. But the number of applications for patents became so great that in 1836 Congress created a new sub-department, known as the Patent Office. The act of 1836 worked a complete revolution in the patent system. From 1790 to 1836 patents were granted to inventors upon their application, without any investigation as to the novelty or utility of the invention. The patentee received his grant entirely at his own risk and it was liable to be cancelled at any time upon proof of use or knowledge of the invention prior to his own.
His only means of ascertaining whether such use existed was by private inquiry. A patent obtained under such conditions could be of but little value to the inventor, unless he possessed the necessary means to develop his own invention; as few manufacturers could be induced to risk their capital on the chance of its validity. In order to remedy this evil, Congress, in 1836, established the Patent Office and conferred upon its officials executive and judicial powers. It is the duty of the officials of the Patent Bureau to make a thorough investigation of all questions upon which the validity of the proposed patent might depend.

An inventor who applies for a patent must show that the subject matter sought to be patented satisfies the requirements of certain well established, though not easily defined, tests.

The essentials of patentability are four in number, viz:—(1) It must be the proper subject matter of a patent, (2) Invention, (3) Novelty, and (4) Utility.

The following pages will be devoted exclusively to the consideration of the third requisite of a patentable invention,—Novelty.

There are two reasons for including novelty among the essentials of patentability. (1) Because no man can lawfully be deprived of the right to use a known art or trade. (2) Because if an invention is known, the public will receive no consideration from the patentee for the grant of the sole right of using it.
The Patent Laws of the United States require that an invention, in order to be patentable, must be new. But it should be borne in mind that the term "new", as used in the statutes, has a much broader meaning than is given to it in the dictionaries. "Novelty" is the conventional term which the courts make use of to designate newness, in the sense in which it is used in the statute. Many things are included under the head of "novelty" which are not really new in the ordinary meaning of the term.

The questions that arise in determining whether or not the numerous inventions sought to be patented satisfy the requirements as to novelty are many and varied in their character: and it is, therefore, impossible to frame a concise definition of novelty which would be sufficiently broad to comprehend all that is included under the term.

Mr. Robinson, in his work on patents, says that legal novelty may be predicated of an invention whenever it is new to the public as a practically operative means; and that novelty consists in the substantial variation of the invention in question from all inventions, which, in contemplation of law, are already open to the public.

The definition given by Mr. Robinson is undoubtedly correct in theory, but when employed as a test to determine the presence or absence of novelty, it is of little practical value.

The majority of writers on patent law have not attempted an exact definition of novelty: but on the other hand,
they have endeavored to attain the same end by laying down certain well established rules by which the courts are uniformly governed in passing upon questions of novelty. The latter method has been adopted by Mr. Walker, who is undoubtedly the most eminent American authority on patent law. In his valuable work on that subject, Mr. Walker says that the boundaries of novelty can be delineated "only by enumerating and explaining those classes of facts which fall within them, but which fall without the boundaries of actual newness; those classes of facts which negative newness, but which do not negative novelty."

Of the many rules or tests employed by the courts in passing upon questions of novelty, some are based upon the clear and positive terms of the statute, while others have been formulated from time to time by the Justices of the United States Supreme Court, in interpreting and applying the statutes to new statements of fact. The pages which follow will be devoted to a discussion of the most important of these rules, together with the leading illustrative cases.
Rule I:-

NOVELTY IS NOT NEGATIVED BY KNOWLEDGE OR USE IN A FOREIGN COUNTRY.

This rule has not always been recognized in the United States. An act of Congress passed in 1800 provided that no patent should be granted for any invention which had been previously known and used in this or any foreign country. This law proved a great hardship to inventors. It gave rise to a vast amount of litigation and did much to discourage that spirit of investigation which it has always been the policy of this government to foster.

The law continued in full force and effect, however, until 1836, when the entire patent system of the United States was re-constructed and the clause relating to knowledge and use in foreign countries was stricken from the statute.

But a previous knowledge or use in a foreign country will render a contrivance unpatentable for lack of novelty, if it has been patented, or described in a printed publication. U. S. Revised Statutes, Sec. 4887; O'Reiley v. Morse, 15 Howard 62.

It was decided in Hays v. Sulsor, (1 Fisher 536), that use in a foreign land does not invalidate a patent afterwards taken out in this country, when the patentee, at the time of his application, supposed himself to be the first inventor, unless the prior invention has been patented, or described in some printed public work.

But the fact that letters patent have been surrep-
titiously obtained in a foreign country, will not deprive the true inventor of his rights under our laws. 9 O. G. 201.

Rule II:-

NOVELTY IS NOT NEGATIVED BY A "PRIVATE" PATENT GRANTED IN A FOREIGN COUNTRY.

The leading case in support of this rule is Brooks v. Narcross (2 Fisher 661). This was a bill in equity brought to restrain the infringement of letters patent for an improvement on the Woodworth planing machine. The defendants set up a prior patent obtained in France, for a similar improvement.

It appeared that under the laws of France, both public and private patents were granted and the court held that the defendant was bound to show whether the patent infringed was a public or private grant, and that in case it was a private grant, the defence would not be good. In the course of his opinion, Judge Woodbury said, referring to the act of 1836, "The word 'patented' as here used, must of course mean covered and made known to the world by a public grant, so as to bring home to the public, generally and probably, a knowledge of its existence, and deprive anyone of the credit and protection of being original, if he afterward construct a like machine."

Another important case which serves to illustrate the principle embodied in Rule II, is Willimantic Linen Co. v. Clark Thread Co. (4 Bann. and Ard. 133). The bill charged that the defendants had infringed letters patent for an im-
provement in machines for winding thread on spools. The defendants, in their answer, denied that the plaintiff was the original inventor, claiming that he had been anticipated by certain English patents. But the court held that the plaintiff's patent was not invalidated by the granting of a patent on a similar improvement in England, on a prior date, since it appeared from the proofs that the English patent had not been enrolled until a date subsequent to the issuing of plaintiff's patent.

In order to negative novelty by showing a prior publication, it must appear that the description contained in the publication is full enough to enable a person skilled in the art to which it relates, to construct the article described. Cahill v. Brown, 15 O. G. 697.

Rule III:—

NOVELTY IS NOT NEGATIVED BY ANY PRIOR ABANDONED APPLICATION FOR A PATENT.

Owing to the ambiguous wording and apparent contradiction of the statutes relating to printed publications, the correctness of the principle embodied in Rule III, has not always been conceded by leading patent attorneys and jurists. It has been contended, by those who question the correctness of the rule, that a description in an abandoned application, constitutes a "publication" within the meaning of the statute. The contents of an abandoned application are liable to be subjected to the scrutiny of any person who happens to be engaged in making a search in the patent office, so that,
strictly speaking, all applications are, in a sense, public
documents. It has also been urged in opposition to the rule,
that the description contained in the abandoned application
establishes the fact of invention and so disproves the novelty
of an invention subsequent in date.

The latter objection was very forcibly urged, but
without success, in the case of The N. W. Fire Extinguisher

Mr. Walker, in his work on patent law, effectually
disposes of this question in the following language,— "They
(abandoned applications) furnish no evidence that any speci-
men of the things they describe was ever made or used any-
where. Being only pen and ink representations of what may
have existed only as mental conceptions of the men who put
them upon paper, they do not prove that the things which they
depict were ever known in any country."

A more difficult question was raised by the objec-
tion that an application for a patent falls within the scope
of the statutory provisions relating to "printed publications". The solution of this question hinged entirely upon the con-
struction to be given to the statutes. In describing the kind
of publication which shall render a patent void for lack of
novelty, the statute makes use of terms which are hard to re-
concile. Section fifteen of the act of 1836 provides that it
must be a description in "some public work", while in the
proviso of the same section the expression made use of is,
"any printed publication". It is clear that the phrase "any
printed publication", taken by itself, is sufficiently broad to include any printed description regardless of form, if published and circulated to any extent or in any manner, whatever. Construing the whole section together, however, the courts finally decided that the description, in order to come within the statute, must be so printed and published as to be accessible to the public. This construction was first adopted in N. W. Fire Extinguisher Co. v. The Philadelphia Fire Extinguisher Co. (6 C. G. 34 - 1874). The rule is more clearly and forcefully stated in the leading case of The Lyman Ventilating Co. v. Lalor, (1 Bann. and Ard. 403). The following is an extract from Judge Blatchford's opinion,- "It is now well settled, that a written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention, within the meaning of the patent laws. Such a description has not the same effect as a printed publication. It lacks the essential quality of such a publication, for even though deposited in the Patent Office, it is not designed for *general circulation*, nor is it made accessible to the public *generally*, being so deposited for the special purpose of being examined and passed upon by the Patent Office, and not that it may thereby become known to the public, although it may *incidentally* become known, the deposit of it is not a publication of it, within the meaning of the statute, or the law." See also The Corn Planter Case, (23 Wall. 211).

But abandoned or rejected specifications and draw-
ings are not, under all circumstances, inadmissible as evidence. In cases where the inventor has perfected his invention by putting it into practical operation, in the form of a mechanism, such evidence is admissible in order to prove the date of the invention, the design, function, and principle involved. This class of cases constitute the only qualification to Rule III.

Rule IV:-

NOVELTY IS NOT NEGATIVED BY ANY UNPUBLISHED DRAWING, OR PRIOR MODEL.

The object of the patent laws is to encourage useful inventions which may prove of practical value to the public, and for this reason the courts have uniformly held that the mere conception of an idea of a new and useful invention is not sufficient, on the ground that the public derives no benefit therefrom. The idea must be carried into practical operation in order that it may become the subject of a patent or be set up and relied on to defeat a patent. This rule is also designed to prevent fraud and perjury. If the rule were otherwise, it would be an easy matter for an unscrupulous mechanic to construct a model of some existing patent and then claim that he had invented it long before.

A very important case, which is frequently cited as authority for Rule IV, is Ellithorp v. Robertson, (4 Blatchford 309). The bill charged that the plaintiff had, in 1847, invented certain improvements in sewing machines, and that he had made drawings of the same at that time, prepara-
tory to making application for a patent, but that he was de-
layed in presenting his application until 1858, for want of
the necessary means and for other reasons enumerated in the
bill, and that when plaintiff finally applied for a patent in
1858 his application was denied by the Commissioner, on the
ground that it interfered with a patent granted to the de-
fendant in 1854. The Commission decided that if the
plaintiff was the first inventor he had, by delay, abandoned
the invention.

The decision of the Commission was sustained on
appeal. In handing down the opinion, Judge Ingersoll said,
"It should be borne in mind, that there is no allegation in
the bill, and no claim made by the plaintiff, that the de-
fendant surreptitiously or unjustly obtained his patent, for
that which was in fact invented and discovered by the plain-
tiff, who was using reasonable diligence in adapting and per-
fecting the same. An invention is not patentable until it is
perfected, and adapted to use. In a race of diligence be-
tween two independent inventors, he who first reduces his in-
vention to a fixed, positive, and practical form, has a
priority of right to a patent."

One of the earliest questions which the courts were
called upon to decide under the patent acts was whether or
not a use by the inventor, himself, before application for a
patent, would not deprive him of his right to a patent. The
question was decided in the negative. It was a case of stat-
tutory construction. Section I of the act of 1793, Ch. 55,
contained the words "not known or used before the application". These words were construed as meaning not known or used by the public before the application.

The rule of construction, in cases of this character, was first laid down by Justice Story, in Pinnock v. Dialogue, (2 Peters I). Whatever doubts may have existed as to the proper interpretation to be given to the statute, were finally swept away by the amendment of 1836 which added the words "by others", causing the statute to read, "not known or used before the application by others."

Rule V:

NOVELTY IS NOT NEGATIVED BY ANYTHING SUBSTANTIALLY DIFFERENT FROM THAT COVERED BY THE PATENT.

The patent laws regard every invention as new which is substantially different from what has gone before it. The rule is simple and clear in its terms. The difficulty does not consist in determining what the rule is, but in its application to a complicated state of facts.

Newness is usually a question of fact, for the jury.

A simple alteration, such as an increase in size, or a mere change in form, is not a change within the meaning of the law. An improvement upon an old contrivance, in order to be of sufficient importance to entitle the inventor to a patent, must contain some element of originality and the change must be of such a radical character as to produce a more useful result. The change or new combination, as the case may be, must introduce or embody some new mode of operation, or
accomplish some new effect.

The leading case of O'Reiley v. Morse, (15 Howard 62), is frequently cited as authority for the proposition that a patent may be granted for a new means of producing an old result. This is the famous "Morse Telegraph Case".

But an application of an old invention to a new purpose, cannot become the subject of a patent. In Bean v. Smallwood, (2 Story 411), Mr. Justice Story states the rule as follows, viz:- "The machine must be new, not merely the purpose to which it is applied. A purpose is not patentable, but the machinery, only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a new purpose or object. A coffee-mill applied for the first time to grind oats, or corn, would not give a title for a patent for the machine."

In connection with Rule V, it may be stated, as a general proposition, that novelty is not negatived by an "unsuccessful abandoned experiment". But this doctrine is subject to many qualifications. If, for example, an experiment proves successful and has actually been reduced to a working basis, this, in itself, is sufficient to render a subsequent patent void for lack of novelty, even though the first experiment had been abandoned long before the granting of such patent. The rule is made clear in a charge to the jury by Shipman, J., in Waterman v. Thompson, (2 Fisher 561). This was an action to recover damages for the infringement of
letters patent for an improvement in tempering wire and steel. The following is an extract from Judge Shipman's charge. "If the jury are satisfied that Ely did work this process substantially as he has described on this trial, at the time (prior to plaintiff's patent) he states, then the defendants are entitled to a verdict. By working this process, I mean successfully working it, by performing substantially the same thing as the plaintiff performs with his machine, in substantially the same manner. If he merely made an experiment and failed, abandoning his contrivance because it would not work, then it is of no account. But the mere fact that he ceased to use it because he had no further occasion to do so, is, of itself, of no importance."

Rule VI:-

NOVELTY IS NOT NEGATIVED BY ANYTHING APPARENTLY SIMILAR OR CHEMICALLY IDENTICAL, BUT PRACTICALLY USELESS.

The leading case of Money v. Lockwood, reported in 8 Wallace 230, is frequently cited in support of this rule. In this case, the plaintiff filed a bill in equity to restrain Money and others from infringing letters patent on what is known as the Davidson Syringe.

Prior to the utilization of rubber in the manufacture of surgical instruments, the only syringe known or used, to any extent, was the old metallic syringe, with a plunger, known as the pump syringe. In 1852 Charles Davidson, at the suggestion of his brother, Doctor Davidson, devised and made a drawing of a syringe which was to consist of an elastic sac,
with a single opening, at which point two flexible tubes were attached. In 1853 the Davidson brothers made an improvement on their invention. The improved syringe consisted of a globular India rubber sac or bulb, to which were attached flexible tubes or pipes: to the ends of the pipes were attached valve boxes. The syringe was operated by the alternate compression and expansion of the rubber bulb.

On the trial of the suit for infringement of the Davidson Syringe, the defendants set up the defense that plaintiff's patent was void for lack of novelty, and in support of their allegation they introduced the "Maw Syringe", as an example of a prior invention. The Maw Syringe was composed of an India rubber chamber, cylindrical in form, with metallic rims or casings at the ends. From these casings projected small metallic tubes containing valves. To the metallic tubes were attached flexible pipes. The mode of using was meant to be the same as in the Davidson Syringe. It was conceded that the mechanical principles involved in the construction of the Maw Syringe, and also the mode of operation, were substantially the same as in the Davidson Syringe. The two contrivances differed slightly in form, but not in principle.

But the Maw Syringe proved to be of no practical value, owing to the fact that the metallic heads or casings, attached to the flexible cylinder, rendered it almost impossible to compress the rubber walls of the cylinder. The degree of strength required in its operation precluded the possibility
of its use by invalids, and, as a natural result, very few were ever sold. For these reasons the Supreme Court held that it did not negative novelty in the Davidson patent.

Rule VII:–

NOVELTY IS NOT NEGATIVED BY ANTIQUITY OF PARTS.

The novelty of a design cannot be negatived by showing that all its constituent parts have been used before in various prior inventions. It is not sufficient to prove that part of the new combination is to be found in one mechanism and part in another. The patent will be sustained if it can be shown that the combination, as shown entirely, is "new, useful and original."

The practical application of Rule VII is well illustrated by the case of Johnson v. Railroad Co., which was tried in the Circuit Court for the Southern District of New York, in 1888, before Judge Cox. This was an equity action for infringement, founded upon letters patent granted for improvements in switches for horse-railroads.

The chief ground of defense relied upon was "lack of novelty". The defendants claimed that the patentee was not the inventor, and offered to show that the different mechanical parts of which plaintiff's switch was composed, had been used in prior inventions. But the Court held that the validity of the patent was not affected by the fact that the separate elements of the combination were old. The following is an extract from Judge Cox's opinion. "The art discloses several rocking platforms and several horizontally-
moving switches, but the structures which show the platform do not show the switch, and those which show the switch, do not show the platform. Newman's combination is not found in the antecedent art. The accusation that the separate elements of the combination were old, is of no moment. By an ingenious assembling of known appliances, this inventor solved the problem, the solution of which had been sought for in vain through a long series of years. Although the goal was frequently in sight, it had never been reached; always some necessary requisite of success had been lacking. The practical disentanglement of the difficulty was left to Newman. He made that a success which before had been tentative and rudimentary."

Changes in the construction of an old machine, which increase its usefulness, are patentable. The change effected may be in the nature of a new combination of the old parts; or the change may be effected by replacing one or more of the old parts by something newly discovered. It is not necessary, however, that the substituted part should be new. The requirements of the patent law may be satisfied by showing that the substituted ingredient, by reason of the combination, is made to perform some new function. But if the change consists simply in supplanting one of the constituent parts of a patented combination by something which was known at the date of the patent, as a common substitute or mechanical equivalent for the part withdrawn; such change would not be a good defense to a charge of infringement. Seymour v. Osborn, 11
A union of old elements which amounts simply to an aggregation without producing any new effect, as the result of the combination, is not patentable. Pickering v. McCullough, (104 U. S. 318), is a leading case in point. In the course of his opinion Justice Mathews said, "In Minnow's apparatus it is perfectly clear that all the elements of the combination are old, and that each operates only in the old way. Beyond the separate and well-known results produced by them severally, no one of them contributes to the combined result any new feature. In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other: to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention, seized each of every part, per my et per tout, and not mere tenants in common, with separate interests and estates."

In Beckendorfer v. Faber, (92 U. S. 347), the court held that letters patent granted for a combination which consisted simply in fastening a small rubber eraser to the end of a lead pencil, were void for lack of invention. Both the lead pencil and the rubber eraser had long been in use before it occurred to any one that it would be convenient to combine the two. But the union of the rubber and pencil was a mere aggregation, each part performing the same work that it had performed before.
Rule VIII:—

NOVELTY IS NOT NEGATIVED BY ANY PRIOR ACCIDENTAL PRODUCTION OF THE SAME THING, UNACCOMPANIED BY KNOWLEDGE ON THE PART OF THE PRODUCER SUFFICIENT TO ENABLE HIM TO REPEAT THAT PRODUCTION.

In the case of Pelton v. Waters, (I Banning and Arden 599), the defendant undertook to show that he was the original inventor of a certain lubricator, which consisted of a glass globe with an impervious joint upon the neck; and in order to prove his allegation he introduced evidence to the effect that on a date prior to the application for a patent by the plaintiff, he, the defendant, had cast an impervious joint upon the neck of a glass globe, tested it with steam, and placed it upon the cross-head of an engine, where it worked successfully for three years. But the defendant's own testimony disclosed the fact that the casting of this single globe was a mere accident and that he tried in vain for five months thereafter to cast another, and that he did not learn how to produce a close joint until after the plaintiff had commenced the manufacture and sale of his. The court held that a single accidental success is not an invention, within the protection of the patent law. "He not only did not and could not give it to the public, but he did not possess it himself." Another case to the same effect, which is perhaps more widely cited than any other, is Tilghman v. Proctor, (102 U. S. 707).

It may be stated, as a qualification of Rule VIII,
that novelty is negatived by proof of a prior use of an article or process where the method of using or manufacturing, was thoroughly understood. This proposition holds good even in cases where the prior user or manufacturer was ignorant of the beneficial results to be obtained from such use or manufacture. Schultz v. Williamson Belting Co. is a case in point. The plaintiff brought a bill to restrain the infringement of a patent for an alleged improvement in the method of tanning leather.

The old process of tanning consisted in immersing the hides in tan liquid for a long period of time, so that the interior of the hide was tanned as thoroughly as the outside. But tanned leather is much weaker than raw hide, and the plaintiff, in order to combine the advantages of raw hide and fully tanned leather, devised a process which differed from the old method only in the fact that the hides were immersed in the liquid for a much shorter period; the result being that the outer surface of the leather would be well tanned, while the interior would retain all the strength of raw hide.

The defendants set up that neither the process described, nor the product claimed in the patent, was new.

It was conclusively shown on the trial, that prior to the granting of plaintiff's patent, large quantities of leather, having tanned surfaces, and an interior of raw hide, had been manufactured and sold at a reduced price, as imperfectly tanned leather; the manufacturers, as well as the
dealers, believing, erroneously, that it was inferior to the well tanned article, for all purposes.

The Court held the patent void on the ground that the process was not new, the same article having been produced before by manufacturers who understood how to produce it before the plaintiff filed his specifications. In the course of the opinion Judge Thayer said that if the plaintiff made any discovery, it consisted in his finding out that leather imperfectly tanned,—which every tanner knew how to make,—was preferable for some uses (notably for belting) to perfectly tanned leather. But that discovery, even if it could be patented, has not been claimed.

Rule IX:—

NOVELTY IS NOT NEGATIVED BY ANYTHING WHICH WAS NEITHER DESIGNED, NOR APPARENTLY ADAPTED, NOR ACTUALLY USED, FOR THE SAME PURPOSE AS THE INVENTION.

Under the United States Patent Laws, an inventor has an exclusive right to his invention for all purposes; but a slight alteration made in a machine, or other structure, will oftentimes work a complete transformation in the results to be obtained from it. The change may amount to a new combination, producing results not before attained. In such a case the person affecting the change is an inventor, and is so regarded by the courts. The rule of law governing cases of this character is clearly stated by Justice Brown in Topliff v. Topliff (145 U. S. 156). This was a bill in equity for the infringement of certain improvements in carriage
springs. The following is an extract from the opinion,

"While it is possible that the Stringfellow and Surles patent might, by a slight modification, be made to perform the function of equalizing the springs, which it was the object of the Augur patent to secure, that was evidently not in the mind of the patentees, and the patent is inoperative for that purpose. Their device evidently approached very near the idea of an equalizer, but the idea did not apparently dawn upon them. It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

It has been decided by the courts that a prior patent which is capable of performing the same functions for which a later contrivance is designed, will render the subsequent patent void for lack of novelty. This rule holds good, even in cases where the advantages of the device were neither known to nor claimed by the prior inventor; provided his specifications disclose them. If the structure or operation of the old device was of such a character as to suggest to the mind of the ordinary mechanic the fact that it could be adapted to a new use, without making any material change, the mere application of the old device to the new use is not regarded as an invention, and therefore it is not patentable. The statute requires that there should be some original invention. Cases frequently arise in which it is found extremely diffi-

Rule X:-

NOVELTY IS NOT NEGATIVED BY ANYTHING WHICH WAS INVENTED, PATENTED, OR DESCRIBED IN A PRINTED PUBLICATION, PRIOR TO THE GRANTING OF THE PATENT SOUGHT TO BE ANTICIPATED, UNLESS THE ANTICIPATING EVENT OCCURRED BEFORE THE DATE OF THE INVENTION SECURED BY THAT PATENT.

Section 4920 of the U. S. Revised Statutes provides that any person sued for an infringement of an American patent, may show in defense that the invention claimed was patented or described in some printed publication prior to the patentee's supposed invention or discovery thereof.

In accordance with Rule X and the foregoing section, the courts have uniformly held that a foreign patent or printed publication describing an invention, is no defense to a suit upon a patent in the United States, unless it can be shown that such patent was issued or publication made on a date prior to the making of the invention or discovery secured by the latter patent. It is necessary, however, that the American patentee, when he made application for the patent, believed that he was the first discoverer or inventor of the subject matter of the patent, and he is required to make an affidavit to that effect. (Elizabeth v. Pavement Co., 97 U. S. 126; Cochrane v. Deemer, 94 U. S. 791)

The first preliminary step to the successful appli-
cation of Rule X, is to fix the date of the invention covered by the patent sought to be anticipated. The law does not require the applicant to reduce his invention to actual use before obtaining a patent. The requirements of the patent law are satisfied, in this respect, when the inventor has described his invention by a drawing, model, or any other means sufficient to enable a person skilled in the art, to make and use the same. The patent will date from the completion of such model or drawings. (Deering v. Winona Harvester Works, 155 U. S. 298; Perry v. Cornell, 1 McArthur's Patent Cases 78)

It has been held that an oral description or explanation of an invention, made by the inventor to a person who was capable of understanding such description, and repeating it with sufficient accuracy to enable a person skilled in the business to construct the thing described, is sufficient to enable the patentee to date his invention back to the time of such description. (McCormick Harvesting Co. v. Minneapolis Harvester Works, 42 Federal Reporter 152)

It should be borne in mind that the rule allowing an invention to date back to an oral or written description, drawing, or model, applies only to patented inventions. The reason for this distinction in favor of patented inventions is to be found in the equitable principle that the rights of a patentee ought not to be impaired by an invention which has never been developed into a patent.
Rule XI:-

NOVELTY IS NEGATIVED BY A SINGLE INSTANCE OF PRIOR KNOWLEDGE AND USE IN THIS COUNTRY.

This rule is of purely statutory origin. The sixth section of the patent act of 1836 provides that an applicant shall not secure a patent for his invention or discovery if it was "known or used by others before his invention or discovery thereof." And the fifteenth section of the same act provides that a party sued for infringement may prove, as a defense, that the patentee "was not the original and first inventor of the thing patented, or of a substantial and material part thereof claimed to be new."

The patent laws require that the person applying for a patent must be the first as well as the original inventor. A subsequent, though original, inventor is not entitled to a patent. (Coffin v. Ogden, 18 Wall. 120; Bush v. Condit, 132 U. S. 39)

"If the invention is perfected and put into actual use by the first and original inventor, it is of no consequence whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself. It is sufficient that he is the first inventor, to entitle him to a patent; and no subsequent inventor has a right to use his own prior invention." (Story, J. in Reed v. Cutler, 1 Story 596)
Rule XII:-

NOVELTY IS NEGATIVED BY PRIOR MAKING WITHOUT USING.

This rule is founded upon Sec. 4886 of the Revised Statutes which provides that to entitle a person to a patent, the invention must be one not known or used by others in this country. At first it was contended that by a proper construction of the patent law, as a whole, both prior knowledge and use must be proved to negative novelty; but it is now well settled that the statute will not be given such a broad construction.

Parker v. Ferguson, (1 Blatchford 407), was a case in which the rule was applied. This was an action for infringement of letters patent granted for an improved water wheel. On the trial the defendant set up as a defense want of novelty, and introduced a witness who swore that ten years prior to the granting of plaintiff's patent he had assisted in constructing a waterwheel which embodied the principles of the patentee's invention. He also testified that the wheel was constructed for a man who lived twelve miles distant from the place of manufacture, and was carried away by him to be put in a mill; and that the witness never saw it afterwards. In his charge to the jury Nelson, J. said that if the wheel spoken of by the witness was constructed before the plaintiff's wheel, and was perfect, the evidence, if believed, was sufficient to establish the fact of a want of novelty in the plaintiff's invention, although there was no evidence that the prior wheel was ever actually used.
It should be stated, as an exception to Rule XII, that if the construction of the prior invention fails to demonstrate that it is within the principle of the patented invention, an infringer who relies upon the prior invention, as a defense, must show that it has been successfully employed to perform the functions claimed for the patented article, prior to the granting of the patent. (Sayles v. Chicago & N. W. Ry. Co., 4 Fisher 584)

Cases frequently arise where a person who has succeeded in perfecting some useful invention, after long years of patient labor and experiment, finds, upon application for a patent, that he has been forestalled by an earlier patent for substantially the same contrivance. It seems hard that such a person should be denied a patent for a device which is the sole product of his own genius and industry; but the rule of law is inflexible, it being conclusively presumed that each inventor has knowledge of all prior inventions of the same character. Then, too, it is clear that if the applicant does not confer upon the public something that it did not possess before, he fails to give the consideration which the law demands for the grant of a patent.