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NOTE I.

Documents on the Subject of Blockades.

Extract of a Letter from Mr. King, minister plenipotentiary of the United States, at London, to Mr. Pickering, secretary of state, dated London, July 15th, 1799.

“SEVEN or eight of our vessels, laden with valuable cargoes, have been lately captured, and are still detained for adjudication ; these vessels were met in their voyages to and from the Dutch ports declared to be blockaded. Several notes have passed between Lord Grenville and me upon this subject, with the view, on my part, of establishing a more limited and reasonable interpretation of the law of blockade than is attempted to be enforced by the English government. Nearly one hundred Danish, Russian and other neutral ships have, within a few months, been in like manner intercepted, going to and returning from the United Provinces. Many of them, as well as some of ours, arrived in the Texel, in the course of the last winter, the severity of which obliged the English fleet to return to their ports, leaving a few frigates only to make short cruises off the Texel, as the season would allow.

“My object has been to prove, that in this situation of the investing fleet, there can be no effective blockade, which, in my opinion, cannot be said to exist, without a competent force stationed, and present, at or near the entrance of the blockaded port.”

*4] *Extract of a Letter from Mr. King to Lord Grenville, dated Downing street, London, May 23d, 1799.

“It seems scarcely necessary to observe, that the presence of a competent force is essential to constitute a blockade ; and although it is usual for the belligerent to give notice to neutral nations, when he institutes a blockade, it is not customary to give any notice of its discontinuance ; and that, consequently, the presence of the blockading force is the natural criterion by which the neutral is enabled to ascertain the existence of the blockade ; in like manner as the actual investment of a besieged place is the only evidence by which we decide, whether the siege is continued or raised. A siege may be commenced, raised, recommenced and raised again, but its existence at any precise time, must always depend upon the fact of the presence of an investing army. This interpretation of the law of blockade is of peculiar importance to nations situated at a great distance from each other, and between whom a considerable length of time is necessary to send and receive information.”

Extract of a Letter from Mr. Marshall, secretary of state, to Mr. King, dated September 20th, 1800.

“2d. THE right to confiscate vessels bound to a blockaded port has been unreasonably extended to cases not coming within the rule, as heretofore adopted. On principle, it might well be questioned, whether this rule can be applied to a place not com-

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pletely invested by land as well as by sea. If we examine the reasoning on which is founded the right to intercept and confiscate supplies designed for a blockaded town, it will be difficult to resist the conviction, that its extention to towns invested by sea only is an unjustifiable encroachment on the rights of neutrals. But it is not of this departure from principle, a departure which has received some sanction from practice, that we mean to complain. It is, that *ports, not effectually blockaded by a [25] force, capable of completely investing them, have yet been declared in a state of blockade, and vessels attempting to enter therein have been seized, and on that account confiscated. This is a vexation proceeding directly from the government, and which may be carried, if not resisted, to a very injurious extent. Our merchants have greatly complained of it, with respect to Cadiz and the ports of Holland.

"If the effectiveness of the blockade be dispensed with, then every port of all the belligerent powers may, at all times, be declared in that state, and the commerce of neutrals be thereby subjected to universal capture. But if this principle be strictly adhered to, the capacity to blockade will be limited by the naval force of the belligerent, and of consequence, the mischief to neutral commerce cannot be very extensive. It is, therefore, of the last importance to neutrals, that this principle be maintained unimpaired.

"I observe, that you have pressed this reasoning on the British minister, who replies, that an occasional absence of a fleet from a blockaded port ought not to change the state of the place. Whatever force this observation may be entitled to, where that occasional absence has been produced by accident, as a storm, which for a moment blows off the fleet, and forces it from its station, which station it immediately resumes, I am persuaded, that where a part of the fleet is applied, though only for a time, to other objects, or comes into port, the very principle, requiring an effective blockade, which is, that the mischief can then only be co-extensive with the naval force of the belligerent, requires, that during such temporary absence, the commerce of neutrals to the place should be free."

*Extract of a Letter from Mr. Madison to Mr. Charles Pinkney, minister plenipotentiary of the United States, at Madrid, dated, Department of State, Washington, October 25th, 1801.

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"THE pretext for the seizure of our vessels seems at present to be, that Gibraltar has been proclaimed in a state of blockade, and that the vessels are bound to that port. Should the proceeding be avowed by the Spanish government, and defended on that ground, you will be able to reply:

"1st. That the proclamation was made as far back as the 15th of February 1800, and has not since been renewed; that it was immediately protested against by the American and other neutral ministers at Madrid, as not warranted by the real state of Gibraltar, and that no violations of neutral commerce having followed the proclamation, it was reasonably concluded to have been rather a menace against the enemies of Spain, than a measure to be carried into execution against her friends.

2d. That the state of Gibraltar is not, and never can be, admitted by the United States to be that of a real blockade. In this doctrine, they are supported by the law of nations, as laid down in the most approved commentators, by every treaty which has undertaken to define a blockade, particularly, (a) those of latest date among the maritime nations of Europe, and by the sanction of Spain herself, as a party to the armed neutrality in the year 1781. The spirit of articles 15 and 16 of the treaty between the United States and Spain may also be appealed to, as favoring a liberal construction of the rights of the parties in such cases. In fact, this idea of an investment, a siege or a blockade, as collected from the authorities referred to, necessarily results from the force of those terms; and though it has been sometimes grossly

(a) See late treaties between Russia and Sweden, and between Russia and Great Britain.

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violate or evaded by powerful nations, in pursuit of favorite objects, it has invariably kept its place in the code of public law, and cannot be shown to have been expressly renounced, in a single stipulation between particular nations.

*3d. That the situation of the naval force at Algesiras, in relation to Gibraltar, has not the shadow of likeness to a blockade, as truly and legally defined. [*_7] This force can neither be said to invest, besiege or blockade the garrison, nor to guard the entrance into the port. On the contrary, the gun-boats infesting our commerce have their stations in another harbor, separated from that of Gibraltar by a considerable bay; and are so far from beleaguering their enemy at that place, and rendering the entrance into it dangerous to others, that they are, and ever since the proclamation of the blockade, have been, for the most part, kept at a distance by a superior naval force, which makes it dangerous to themselves to approach the spot.

4th. That the principle on which the blockade of Gibraltar is asserted, is the more inadmissible, as it may be extended to every other place, in passing to which vessels must sail within the view and reach of the armed boats belonging to Algesiras. If, because a neutral vessel bound to Gibraltar can be annoyed and put in danger by way-laying cruisers, which neither occupy the entrance into the harbor, nor dare approach it, and by reason of that danger is liable to capture, every part of the Mediterranean coasts and islands, to which neutral vessels must pass through the same danger, may, with equal reason, be proclaimed in a state of blockade, and the neutral vessels bound thereto made equally liable to capture: Or, if the armed vessels from Algesiras alone should be insufficient to create this danger in passing into the Mediterranean, other Spanish vessels, co-operating from other stations, might produce the effect, and the ports thereby not only blockade any particular port of any particular nation, but blockade at once a whole sea surrounded by many nations. Like blockades might be proclaimed by any particular nation, enabled by its naval superiority to distribute its ships at the mouth of the same, or any similar sea, or across channels or arms of the sea, so as to make it dangerous for the commerce of other nations to pass to its destination. These monstrous consequences condemn the principle from which they flow, and ought to unite against it every nation, Spain among the rest, which has an interest in the rights of the sea. Of this Spain herself appears to have been sensible, in the year 1780, when she yielded to Russia ample satisfaction *for seizures of her vessels, made under the pretext of a general blockade of the Mediterranean, and [*_8] followed it with her accession to the definition of a blockade contained in the armed neutrality.

5th. That the United States have the stronger ground for remonstrating against the annoyance of their vessels, on their way to Gibraltar, inasmuch as, with very few exceptions, their object is not to trade there, for the accommodation of the garrison, but merely to seek advice or convoy, for their own accommodation, in the ulterior objects of their voyage. In disturbing their course to Gibraltar, therefore, no real detriment results to the enemy of Spain, whilst a heavy one is committed on her friends. To this consideration, it may be added, that the real object of the blockade is, to subject the enemy to privations, which may co-operate with external force, in compelling them to surrender; an object which cannot be alleged in a case, where it is well known, that Great Britain can, and does, at all times, by her command of the sea, secure to the garrison of Gibraltar every supply which it wants.

6th. It is observable, that the blockade of Gibraltar is rested, by the proclamation, on two considerations: one, that it is necessary to prevent illicit traffic, by means of neutral vessels, between Spanish subjects and the garrison there; the other, that it is a just reprisal on Great Britain, for the proceedings of her naval armaments against Cadiz and St. Lucar. The first can surely have no weight with neutrals, but on a supposition, never to be allowed, that the resort to Gibraltar, under actual circumstances, is an indulgence from Spain, not a right of their own; the other consideration, without examining the analogy between the cases referred to, and that of Gibraltar, is equally without weight with the United States, against whom no right can accrue to Spain from its complaints against Great Britain; unless it could be shown that the

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United States were in an unlawful collusion with the latter; a charge which they well know that Spain is too just and too candid to insinuate. It cannot even be said, that the United States have acquiesced in the depredations committed by Great Britain, under *9] whatever pretexts, on their lawful commerce. Had this, indeed, been the *case, the acquiescence ought to be regarded as a sacrifice made by prudence to a love of peace, of which all nations furnish occasional examples, and as involving a question between the United States and Great Britain, of which no other nation could take advantage against the former. But it may be truly affirmed, that no such acquiescence has taken place. The United States have sought redress for injuries from Great Britain, as well as from other nations. They have sought it by the means which appeared to themselves, the only rightful judges, to be the best suited to their object; and it is equally certain, that redress has, in some measure, been obtained, and that the pursuit of complete redress is by no means abandoned.

7th. Were it admitted, that the circumstances of Gibraltar, in February 1800, the date of the Spanish proclamation, amounted to a real blockade, and that the proclamation was, therefore, obligatory on neutrals; and were it also admitted, that the present circumstances of that place amount to a real blockade (neither of which can be admitted), still, the conduct of the Algesiras cruizers is altogether illegal and unwarrantable. It is illegal and unwarrantable, because the force of the proclamation must have expired, whenever the blockade was actually raised, as must have been unquestionably the case, since the date of the proclamation, particularly and notoriously, when the port of Algesiras itself was lately entered and attacked by a British fleet, and because on a renewal of the blockade, either a new proclamation ought to have issued, or the vessels making for Gibraltar ought to have been premonished of their danger, and permitted to change their course as they might think proper. Among the abuses committed under the pretext of war, none seem to have been carried to a greater extravagance, or to threaten greater mischief to neutral commerce, than the attempt to substitute fictitious blockades, by proclamation, for real blockades, formed according to the law of nations; and consequently, none against which it is more necessary for neutral nations to remonstrate effectually, before the innovations acquire maturity and authority, from repetitions on one side, and silent acquiescence on the other.

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*Mr. Smith, secretary of the navy, to Commodore Preble.

Navy Department, Feb. 4, 1804.

Sir: Your letter of the 12th of November, inclosing your circular notification of the blockade of the port of Tripoli, I have received. Sensible, as you must be, that it is the interest, as well as the disposition of the United States, to maintain the rights of neutral nations, you will, I trust, cautiously avoid whatever may appear to you to be incompliable with those rights. It is, however, deemed necessary, and I am charged by the President to state to you, what, in his opinion, characterizes a blockade. I have, therefore, to inform you, that the trade of a neutral in articles not contraband, cannot be rightfully obstructed to any port, not actually blockaded by a force so disposed before it, as to create an evident danger of entering it. Whenever, therefore, you shall have thus formed a blockade of the port of Tripoli, you will have a right to prevent any vessel from entering it, and to capture, for adjudication, any vessel that shall attempt to enter the same, with a knowledge of the existence of the blockade. You will, however, not take as prize, any vessel attempting to enter the port of Tripoli, without such knowledge; but, in every case of an attempt to enter, without a previous knowledge of the existence of the blockade, you will give the commanding officer of such vessel notice of such blockade, and forewarn him from entering. And if, after such a notification, such vessel shall again attempt to enter the same port, you will be justifiable in sending her into port for adjudication. You will, sir, hence perceive, that you are to consider your circular communication to the neutral powers, not as an evidence that every person attempting to enter has previous knowledge of the blockade, but merely as a friendly notification to them of the blockade, in order that they

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might make the necessary arrangements for the discontinuance of all commerce with such blockaded port. I am, &c. (Signed) R. SMITH.

Commodore Preble.

(Signed)

R. SMITH.

*(Copy.)

[*11]

Mr. Merry to Mr. Madison.

Washington, April 12, 1804.

Washington, April 15, 1801.

Sir: Mr. Thornton not having failed to transmit to his majesty's government an account of the representation which you were pleased to address to him, under date of the 27th of October, last year, respecting the blockade of the islands of Martinique and Guadaloupe, it is with great satisfaction, Sir, that I have just received his majesty's commands, signified to me by his principal secretary of state for foreign affairs, under date of the 6th of January last, to communicate to you the instructions which have, in consequence of your representation, been sent to Commodore Hood, and to the judges of the vice-admiralty courts in the West Indies. I have, accordingly, the honor to transmit to you, Sir, inclosed, the copy of a letter from Sir Ewan Napean, secretary to the board of admiralty, to Mr. Hammond, his majesty's under-secretary of state for foreign affairs, specifying the nature of the instructions which have been given.

His majesty's government doubt not that the promptitude which has been manifested in redressing the grievance complained of by the government of the United States, will be considered by the latter as an additional evidence of his majesty's constant and sincere desire to remove any ground of misunderstanding, that could have a tendency to interrupt the harmony which so happily subsists between his government and that of the United States. I have the honor to be, with high respect and consideration, your most obedient humble servant.

(Signed)

ANTH. MERRY

*(Copy.)

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Admiralty Office, 5th January 1804.

Admiralty Alice, 3rd January 1801.

Sir: Having communicated to the lords of the admiralty, Lord Hawkesbury's letter of the 23d ultimo, inclosing the copy of a dispatch which his lordship had received from Mr. Thornton, his majesty's *charge d'affaires* in America, on the subject of the blockade of the islands of Martinique and Guadaloupe, together with the report of the advocate-general. Thereupon, I have their lordship's commands to acquaint you, for his lordship's information, that they have sent orders to Commodore Hood, not to consider any blockade of those islands as existing, unless in respect of particular ports which may be actually invested, and then not to capture vessels bound to such ports, unless they shall previously have been warned not to enter them, and that they have also sent the necessary directions on the subject to the judges of the vice-admiralty courts in the West Indies and America. I am, &c.

(Signed)

EVAN NEBRAN

George Hammond, Esq.

Mr. Merry to Mr. Madison.

Washington, April 12, 1804.

Sir: I have the honor to acquaint you, that I have just received a letter from rear-admiral Sir John Duckworth, commander-in-chief of his majesty's squadron at Jamaica, dated the second of last month, in which he desires me to communicate to the government of the United States, that he has found it expedient for his majesty's service, to convert the siege, which he lately attempted, of Curagoa, into a blockade of that island. I cannot doubt, sir, that this blockade will be conducted conformably to the instructions which, as I have had the honor to *acquaint you in another letter of this date, have been recently sent on this subject to the commander in chief of his majesty's forces, and to the judges of the vice-admiralty courts in the [**13]

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West Indies, should the smallness of the island of Curagoa still render necessary any distinction of the investment being confined to particular ports. I have the honor to be, &c.

(Signed)

ANT. MERRY.

NOTE II.

On the Patent Laws.¹

THE patent acts of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute on the same subject. It may be useful, therefore, to collect together the cases which have been adjudged in England, with a view to illustrate the corresponding provisions of our own laws; and then bring in review the adjudications in the courts of the United States.

By the statute of 21 Jac. I., ch. 3, commonly called the statute of monopolies, it is enacted (§ 1), "that all monopolies, and all commissions, grants, licenses, charters and letters-patent, heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working or using of anything within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty or faculty to dispense with any others, or to give license or toleration to do, use or exercise anything against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeiture, limited by any statute, or of any grant or *14] promise of the benefit, profit *or commodity of any forfeiture, penalty or sum of money that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering or countenancing the same, or any of them, are altogether contrary to the laws of the realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution." The 6th section, however, provides, "that any declaration before mentioned, shall not extend to any letters-patent, and grants of privilege, for the term of fourteen years, or under, hereafter to be made, of the sole working or making of any manner of new manufactures, within this realm, to the true and first inventor and inventors of such manufactures, which others, at the time of making such letters-patent and grants, shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters-patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this act had never been made, and none other."

It is under this last section, that patents for new and useful inventions are now granted in England; and by a proviso or condition, always inserted in every patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same is to be constructed or made, by an instrument in writing, under his hand and seal, and to cause the same to be enrolled in the court of chancery, within a specified time. *Harmar v. Payne*, 11 East 101; *Boulton v. Bull*, 2 H. Bl. 463; *Hornblower v. Boulton*, 8 T. R. 95; 2 Bl. Com. 407, note by Christian, 7. This instrument is usually termed the specification of the invention; and all such instruments are preserved in an office for public inspection.

¹ This note was written by Mr. Justice STORY. See *Curtis on Patents*, § 271, n

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Upon the construction of the British patent act, taken in connection with the conditions inserted in the letters-patent, a great variety of decisions have been made.

1. As the statute contains no restriction confining the grants to British subjects, *it is every day's practice, to grant patents to foreigners, and no such patent has [*15 ever been brought into judicial doubt.

2. A patent can be granted only for a thing new ; but it may be granted to the first inventor, if the invention be new, in England, though the thing was practised beyond sea before ; for the statute speaks of new manufactures, within this realm ; so that if it be new here, it is within the statute, and whether learned by travel or study, is the same thing. *Edgeberry v. Stevens*, 2 Salk. 447; Hawk. P. C. b. 1, ch. 79. And see *Noy* 182, 183.

3. The language of the statute is new manufacture ; but the terms are used in an enlarged sense, as equivalent to new device or contrivance, and apply not only to things made, but to the practice of making. Under *things made*, we may class, in the first place, new compositions of things, such as manufactures in the ordinary sense of the word ; secondly, all mechanical inventions, whether made to produce old or new effects ; for a new piece of mechanism is certainly a thing made. Under the practice of making, we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public. When the effect produced is some new substance, or composition, it would seem, that the privilege of the sole working, or making, ought to be for such new substance or composition, without regard to the mechanism or process, by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no new substance, or composition of things, the patent can only be for the mechanism, if new mechanism is used ; or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced. *Per Eyre*, Ch. J., in *Boulton v. Bull*, 2 H. Bl. 463, 492, and *Lawrence*, J., in *Hornblower v. Boulton*, 8 T. R. 95, 106. A patent, therefore, under certain circumstances, may be good for a method, as well as for an engine or machine. *Ibid.* ; and 8 T. R. 95, 106 ; *Rex v. Cutler*, 1 Starkie 354.

4. A patent cannot be for a mere principle, properly so called ; that is, for an elementary truth. But the word principle is often used in a more lax sense, to signify constituent parts, peculiar structure, or process ; and in specifications, it is generally used in this latter sense ; and *in this view, it may well be the subject of a [*16 patent. *Ibid.*

5. It was formerly considered, that a patent could not be for an improvement (3 Inst. 184) ; but that opinion has been long since exploded ; and it is now held, that a patent may well be for a new improvement. *Harmar v. Playne*, 14 Ves. 130; *Ex parte Fox*, 1 Ves. & Beame 67; *Boulton v. Bull*, 2 H. Bl. 463, 488; 8 T. R. 95; *Bull. N. P.* 77.

6. A patent must be of such manufacture or process, as no other did, at the time of making the letters-patent, use ; for though it were newly-invented, yet, if any other did use it, at the time of making the letters-patent, or grant of the privilege, it is declared void by the act. 3 Inst. 184. And in a very recent case of a patent for a new mode of making verdigris, one of the objections was, that the invention was in public sale by the patentee, before the grant of the patent ; and *Gibbs*, Ch. J., on that occasion, said, "with respect to this objection, the question is somewhat new. Some things are obvious, as soon as they are made public ; of others, the scientific world may possess itself by analysis ; some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void. It is in evidence, that a great quantity was sold in the course of four months, before the patent was obtained." And if the jury were satisfied of that fact, his lordship added, "that he thought the patent void." *Wood v. Zimmer*, 1 Holt 58.

7. The invention must not only be new, but useful ; for if it be contrary to law, or

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mischievous, or hurtful to trade, or generally inconvenient, it is, by the terms of the statute, void. 3 Inst. 184.

8. A patent can legally be granted only to the first and true inventor; for such are the descriptive terms of the statute. 3 Inst. 184. But if the original inventor has confined the invention to his closet, and the public be not acquainted with it, a second inventor, who makes it public, is entitled to a patent. *Boulton v. Bull*, 2 H. Bl. 463; and *Dolland's patent*, cited 2 H. Bl. 470, 487.

9. The patent must not be more extensive than the invention; therefore, if the invention consist in an addition or improvement only, and the patent is for the whole machine, or manufacture, it is void. *Buller's N. P.* 76; *Boulton v. Bull*, *2 H. Bl. 463, and cases there cited; *King v. Else*, 11 East 109, note; *Harmar v. Playne*, *Ibid.* 101; s. c. 14 Ves. 180. Therefore, where a patent was for the exclusive liberty of making lace, composed of silk and cotton thread mixed, not of any particular mode of making it; and it was proved, that silk and cotton thread were before mixed on the same frame for lace, in some mode or other, though not like the plaintiff's, the patent was held void, as being more extensive than the invention. *King v. Else*, 11 East 109, note. A person may obtain a patent for a machine, consisting of an entirely new combination of parts, although all the parts may have been separately used in former machines; and the patent may correctly set out the whole, as the invention of the patentee. But if a combination of a certain number of those parts have previously existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should comprehend such improvements only. *Bovill v. Moore*, 2 Marsh. 211.

10. If a person has invented an improvement upon an existing patented machine, he is entitled to a patent upon his improvement; but he cannot use the original machine, until the patent for it has expired. *Ex parte Fox*, 1 Ves. & Beame 67.

11. Although the specification is not annexed to a patent in England, and the patent contains a concise description only of the invention, yet, as there is a proviso in the patent, requiring the enrolment of a specification in chancery, within a specified time, and in default, making the patent void, the patent is always construed in connection with the specification, and the latter is deemed a part of the patent, at least, for the purpose of ascertaining the nature and extent of the invention claimed by the patentee. *Boulton v. Bull*, 2 H. Bl. 463; *Hornblower v. Boulton*, 8 T. R. 95.

12. Care should be taken, that the specification comports with the patent; for otherwise, it will not sustain the grant. For, where a patent was obtained for an improved mode of lighting cities, it was held by *LE BLANC, J.*, that it was not supported by a specification, describing an improved lamp. The patent ought to have been for an improved street lamp. *Lord Cochrane v. Smethurst*, 1 Starkie 205. No technical words, however, are necessary to explain the subject *of a patent; but the court will construe the terms of the patent and of the specification, in a liberal manner, and give them such a meaning as best comports with the apparent intention of the patentee. *Hornblower v. Boulton*, 8 T. R. 95; *Boulton v. Bull*, 2 H. Bl. 463. Therefore, where the patent was "for a method of lessening the consumption of steam and fuel in fire-engines," one objection was, that the patent was for a philosophical principle only, neither organized, nor capable of being organized, whereas, it ought to have been for a formed machine; a second objection was, that if it was a patent for a formed machine, it was for the whole machine, when the invention was only an improvement or addition to an existing machine. But the court of king's bench, on examining the specification, were of opinion, that both of the objections were unfounded, although the terms of the specification were so doubtful and obscure, as to have produced a division of opinion in the court of common pleas. *Hornblower v. Boulton*, 8 T. R. 95; *Boulton v. Bull*, 2 H. Bl. 463. Both of these cases were very elaborately discussed, and contain more learning on the subject of patents than can be found in any other adjudications, and are, therefore, deserving of the most accurate attention of every lawyer. In both of them, all the judges agreed, that a mere mistake in terms, or in the correct sense of words, would not vitiate a patent, if the court could give a reason-

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able construction to the whole specification. Mr. Justice HEATH said, "when a mode of doing a thing is referred to something permanent, it is properly termed an engine; when to something fugitive, a method." "If method and machinery had been used by the patentee as convertible terms, and the same consequences would result from both, it might be too strong to say, that the inventor should lose the benefit of his patent, by the misapplication of this term." "Method is a principle reduced to practice; it is, in the present instance, the general application of a principle to an old machine." "A patent for an improvement of a machine, and a patent for an improved machine, are, in substance, the same. The same specification would serve for both patents; the new organization of parts is the same in both." Mr. Justice ROOKE said, "a new invented method *conveys to my understanding the idea of a new mode of construction. I think, those words are tantamount to fire-engines of a newly-[*19] invented construction; at least, I think they will bear this meaning, if they do not necessarily exclude every other. The specification shows that this was the meaning of the words, as used by the patentee, for he has specified a new and particular mode of constructing fire-engines. It seems, therefore, but reasonable, that if he sets forth his improvement intelligibly, his specification should be supported, though he professes only to set forth the principle." Mr. Justice BULLER said, "the method and mode of doing a thing are the same; and I think it impossible to support a patent for a method only, without having carried it into effect, and produced some new substance." "When the thing is done, or produced, then it becomes the manufacture which is the proper subject of a patent." The remarks of Lord Chief Justice EYRE have been already stated. He, however, considered the patent not to be for a fire-engine, but in effect for a manner of working a fire-engine, so as to lessen the consumption of steam; and he added, "the specification calls a method of lessening the consumption of steam in fire-engines a principle, which it is not; the act (of parliament) calls it an engine, which, perhaps, also, it is not; but both the specification and statute are referrible to the same thing, and when they are taken with their correlative, are perfectly intelligible." "A narrower ground was taken in the argument, which was to expound the word engine, in the body of this act (meaning the special act of parliament for this patent), in opposition to the title of it, to mean a method; and I am ready to say, I would resort to that ground, if necessary, in order to support the patent, *ut res magis valeat quam pereat.*" In the king's bench, Mr. Justice LAWRENCE observed, "engine and method mean the same thing, and may be the subject of a patent. Method, properly speaking, is only placing several things, and performing several operations, in the most convenient order; but it may signify contrivance or device; so may an engine; and therefore, I think it may answer the word method. So, principle may mean an elementary truth; but it may also mean constituent parts."

13. The patent being granted upon *condition that the invention is new (at least, in England) and useful, and also that the patentee shall deliver and enrol in chancery a specification of his invention, it is necessary for the patentee to establish, by proof, when his invention is called in question in a suit, that he has complied with these conditions. If, therefore, the novelty or effect of the invention be disputed, the patentee must show in what his invention consists, and that he produced the effect proposed by the patent, in the manner specified. Slight evidence of this, on his part, is sufficient; and it is then incumbent on the defendant, to falsify the specification. *Turner v. Winter*, 1 T. R. 602.

14. In respect to specifications (objections to which form the most common, and indeed, usually, the most fatal defence to suits for infringements of patents), several rules have been laid down. In the first place, a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret, and specify his invention, in such a way, that others of the same trade, who are artists, may be taught to do the thing for which the patent is granted, by following the directions of the specification, without any new invention, or addition of their own. *Rex v. Arkwright*, Bull. N. P. 77. In the second place, he must so describe it, that the public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the pat-

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entee himself uses it ; and therefore, if the specification describe many parts of an instrument or machine, and the patentee uses only a few of them, or does not state how they are to be put together or used, the patent is void. *Rex v. Arkwright*, Bull. N. P. 77; *Harmar v. Playne*, 11 East 101. So, if the patentee could only make the article with two or three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So, if he makes the article with cheaper materials than those which he has enumerated, although the latter will answer the purpose, the patent is void. *Turner v. Winter*, 1 T. R. 602. In the third place, if the specification be, in any part of it, materially false or defective, or obscure and ambiguous, or give directions which tend to mislead the public, the patent is void. *Rex*

*21] *v. Arkwright*, Bull. N. P. 77; *Turner v. Winter*, 1 T. R. 602. *Therefore, where,

in a patent for trusses for ruptures, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow, Lord MANSFIELD held the patent, for want of it, void. *Liardet v. Johnson*, Bull. N. P. 76. s. c. cited 1 T. R. 602, 608, *per BULLER*, J. So, where a patent was for a new mode of making verdigris, and the specification omitted an ingredient (*aqua fortis*) which, though not necessary to the composition for which the patent was claimed, was a more expeditious and beneficial mode of producing the same effects, and was, as such, used by the patentee, Lord Ch. J. GIBBS held the patent void. *Wood v. Zimmer*, 1 Holt 58. So, if the specification direct an ingredient to be used, which will not answer the purpose, or is never used by the patentee, the patent is void. *Turner v. Winter*, 1 T. R. 602. So, if the patentee says, in his specification, he can produce three things by one process, and he fails in any one, the patent is void. *Ibid.* 602. So, if the specification direct the same thing to be produced several ways, or by several different ingredients, and any of them fail, the patent is void. *Ibid.* 602. In the fourth place, if the invention be of an improvement only, it is indispensable, that the patent should not be more broad than the invention, and the specification should be drawn up in terms which do not include anything but the improvement. *Boulton v. Bull*, 2 H. Bl. 463; Bull. N. P. 76; *Bovill v. Moore*, 2 Marsh. 211. And in the specification for such improvement, it is essential to point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument, without such distinction, although a plate be annexed, containing detached and separate representations of the parts in which the improvement consists. Therefore, where a patent was "for certain improvements in the making of umbrellas and parasols," and the specification contained a minute description of the construction of them, partly including the usual mode of stitching the silk, and also certain improvements in the insertion of the stretches, &c., and throughout the whole specification no distinction was made between

*22] what was new and what was old, Lord ELLENBOROUGH *said, "the patentee ought,

in his specification, to inform the person who consults it, what is new and what is old. He should say, my improvement consists in this, describing it by words, if he can, or, if not, by reference to figures. But here, the improvement is neither described in words nor figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. A person ought to be warned by the specification against the use of a particular invention." *McFarlane v. Price*, 1 Starkie 199. And it may be added also, that the public have a right to purchase the improvement by itself, and not to be incumbered with other things, where the improvement is of an old machine. But where the patentee obtained a patent for a new machine, and afterwards, another patent for improvements in the said machine, in which the grant of the former was recited, it was held, that a specification, containing a full description of the whole machine, so improved, but not distinguishing the new improved parts, or referring to the former specification, otherwise than as the second recited the first, was sufficient. Lord ELLENBOROUGH, on that occasion, said, "it may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions, it may be sufficient to refer generally to them. As, in the instance of a common watch, it may

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be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." *Harmar v. Playne*, 11 East 101; s. c. 14 Ves. 130. The case also of *Bovill v. Moore*, already cited (2 Marsh. 211), affords very important instruction on this point. In the fifth place, if a patentee in his specification sum up the principle in which his invention consists, if this principle be not new, the patent cannot be supported, although it appear that the application of the principle, as described in the specification, be new; for the patentee, by such summing up, confines himself to the benefit only of the principle so stated. *Rex v. Cutler*, 1 Starkie 354.

15. If a patent is void, the patentee cannot enforce performance of a *covenant for the observance of the exclusive right, entered into by the covenantor, in contemplation of the patent being good. *Hayne v. Maltby*, 3 T. R. 438. [*23]

16. The right of a patentee is assignable at law; and upon such an assignment, the assignee has the exclusive right to maintain an action for any infringement of the patent. See *Boulton v. Bull*, 2 H. Bl. 463.

17. Where the patentee has assigned his patent, in an action by the assignee against the patentee, for an infringement of the patent, the latter will not be permitted to aver against his deed, that the invention is not new. *Oldham v. Langmead*, cited 3 T. R. 439.

18. Where the patent is void, from any of the causes before stated, the party sued for an infringement may, under the general issue, avail himself of any such matter in his defence.

19. Or the patent itself may be repealed by a *scire facias* by the king, upon the ground of fraud, or false suggestion. The mode of proceeding on *scire facias* may be seen in 2 *Saunders* 72, Williams's note, (4) § 4.

These are the principal doctrines established in the English courts upon the subject of patents for new inventions. In respect to the adjudications under the patent laws of the United States, it is matter of regret, that so few of them have been published; but the following are the leading provisions of the act, and the principles which have been recognised as applicable to it. It may be convenient to follow the order of the patent act itself, and to arrange the decisions under the corresponding heads, to which they properly belong.

The first patent act of the United States was passed in the year 1790 (Act of the 10th of April 1790, ch. 34), and was repealed by another act passed in the year 1793 (Act of the 21st of February 1793, ch. 11), and this last act, as amended by the act of 1800 (Act of the 17th of April 1800, ch. 25), constitutes the present general patent law of the United States.

1. By the first section of the act of 1793, any citizen who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements therein, not known or used before the application, may, on application and petition to the secretary of state, obtain a patent for the exclusive right and liberty of making, constructing, using and *vending to others to be used, the [*24] said invention or discovery, upon complying with the regulations of the act; and the patent is required to recite all the allegations and suggestions of the petition, and give a short description of the invention or discovery. The letters-patent, previous to their being issued, are to be examined by the attorney-general, and are by him to be certified to be conformable to law, and are then to be recorded in the office of the secretary of state. The act of 1800, ch. 25, § 1, 2, extends this provision to aliens who have resided two years in the United States; and also to the legal representatives and devisees of a person entitled to a patent, who dies before it is obtained. The original inventor of a machine, who has reduced his invention first into practice, is entitled to a priority of the patent-right; and a subsequent inventor, although an original inventor, cannot sustain his claim although he has obtained the first patent; for *qui prior est in tempore, potior est in jure*. *Woodcock v. Parker*, 1 Gallis. 438. *Odiorne v. Winkley*, 2 Ibid. 51. And therefore, every subsequent patentee, although an original inventor, may be defeated of his patent-right, upon proof of such prior invention put into actual use (*Bedford v. Hunt*, 1 Mason 302); for then, the invention cannot be

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considered as new. If an inventor make a gift of his invention to the public, and suffer it to go into general use, he cannot afterwards resume the invention and claim an exclusive right under a patent. *Whittemore v. Cutter*, 1 Gallis. 478. By useful invention, in the patent act, is meant an invention which may be applied to a beneficial use in society, in contradistinction to an invention injurious to the morals, health or good order of society, or frivolous and insignificant. *Bedford v. Hunt*, 1 Mason 302; *Lowell v. Lewis*, *Ibid.* 182. It is not necessary to establish, that it is in all cases superior to the modes now in use for the same purpose. *Ibid.*

2. By the second section, any person who shall have invented an improvement shall not be at liberty to use the original discovery, nor shall the original inventor be at liberty to use the improvement. And the simply changing the form or the proportions of ^{*25]} any machine, or composition of matter, in any degree, shall not be *deemed a discovery. (See *Odiorne v. Winkley*, 2 Gallis. 51.) If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. *Woodcock v. Parker*, 1 Gallis. 439; *Whittemore v. Cutter*, *Ibid.* 478; *Odiorne v. Winkley*, *Ibid.* 51.

3. By the third section, every inventor, before he can obtain a patent, is required to swear, that he is the true inventor or discoverer of the art, machine or improvement, for which he solicits a patent, and to deliver a written description of his invention, and of the manner of using, or process of compounding, it, in such full, clear and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character, by which it may be distinguished from other inventions; and he is to accompany the whole with drawings and written references, where the nature of the case admits of drawings; or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is a composition of matter; which description, signed by himself, and attested by two witnesses, is to be filed in the office of state; and the inventor is moreover to deliver a model of his machine, if the secretary shall deem it necessary. The patentee must describe in his specification, with reasonable certainty, in what his invention consists; otherwise, it will be void for ambiguity. If it be for an improvement in an existing machine, he must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for, if both are mixed up together, and a patent is taken for the whole, it is void. *Lowell v. Lewis*, 1 Mason 182. The taking of the oath is directory to the party; but if, by mistake, the oath is not taken before the issuing of the patent, the patent is not thereby rendered void. *Whittemore v. Cutter*, 1 Gallis. 429.

4. By the fourth section, patentees may assign their rights, and, upon the assignment being recorded in the office of ^{*26]} state, the assignee shall stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assignees in any degree. Where the patentee has assigned an undivided moiety of his patent-right, the action for an infringement of the right should be in the joint names of the patentee and the assignee. *Whittemore v. Cutter*, 1 Gallis. 429. But an assignee of the patent-right, by an assignment, excepting certain places, is not an assignee entitled to sue, within the act. *Tyler v. Tuel*, 6 Cranch 324.

5. The third section of the act of 1800 (which is a substitute for the fifth section of the act of 1793) declares, that any person who, without the written consent of the patentee, &c., shall "make, devise, use or sell," (the words of the fifth section of the act of 1793 were, "make, devise, and use or sell") the thing patented, shall forfeit three times the actual damages sustained by the patentee, &c., to be recovered by an action on the case in the circuit court of the United States having jurisdiction thereof. Upon this section, it has been held, that the making of a patented machine, fit for use, and with a design to use it for profit, in violation of the patent-right, is, of itself, a breach of this section, for which an action lies; but where the making only, without a

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user, is proved, nominal damages only are to be given for the plaintiff. *Whittemore v. Cutter*, 1 Gallis. 429, 478. If a *user* is proved, the measure of damages is the value of the use during the time of the *user*. *Ibid.* But the act gives the plaintiff a right to his actual damages only, and not to a vindictive recompense, as in other cases of tort. *Ibid.* And neither the price of, nor the expense of making, a patented machine, is a proper measure of damages, in such case. *Ibid.* The sale of the materials of a patented machine, by a sheriff, upon an execution against the owners, is not a sale which subjects the sheriff to an action, under the third section of the act of 1800. *Sawin v. Guild*, 1 Gallis. 485. In an action on this section, the jury are to find the single damages, and the court are to treble them. *Whittemore v. Cutter*, 1 Gallis. 479.

6. The sixth section authorizes the defendant to plead the general issue, and give this act, and any special matter, in evidence, of which notice in writing may have been given to the plaintiff *thirty days before trial, tending to prove, (1) that the [*27] specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, which concealment, or addition, shall fully appear to have been made for the purpose of deceiving the public; (2) or that the patented thing was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee; (3) or that he had surreptitiously obtained a patent for the discovery of another person: in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void. Besides the points decided in the principal case in the text (*Evans v. Eaton*), the following are deserving of notice. It is clear, that this section does not include all the matters of defence which the defendant may be legally entitled to make: as, for instance, it does not include the case of the non-existence of the fact of infringement in any shape; the case of an assignment from the plaintiff, or a written license, or purchase from the plaintiff; or that the patentee is an alien, not entitled to a patent; which are clearly bars to the action, upon the very terms of the act, as well as the general principles of law. *Whittemore v. Cutter*, 1 Gallis. 429, 435. So, if the specification do not describe the invention in clear and exact terms, so as to distinguish it from other inventions, but be so ambiguous and obscure, that it cannot be with reasonable certainty ascertained for what the patent is taken, or what it includes, the patent is void for ambiguity; and the fact may be shown in his defence by the defendant. *Lowell v. Lewis*, 1 Mason 182. But if the invention is definitely described in the patent and specification, so as to distinguish it from other inventions before known, the patent is good, although it does not describe the invention in such full, clear and exact terms that a person skilled in the art or science, of which it is a branch, could construct or make the thing; unless such defective description or concealment was with intent to deceive the public. *Whittemore v. Cutter*, 1 Gallis. 429. *Lowell v. Lewis*, 1 Mason 182. In order to defeat a patent, it is not necessary to prove that the invention has previously been in general use, *and generally known to the public. It is sufficient, if it has been previously known to, and put in use by, other persons, however limited in extent the use or the knowledge of the invention may have been. *Bedford v. Hunt*, 1 Mason 302.

7. The seventh section applies only to the case of patents under state authority, before the constitution of the United States.

8. The eighth section applied only to applications then pending for patents under, the patent act of 1790.

9. The ninth section directs that, in cases of interfering applications, for a patent for the same invention, the same may be referred to arbitrators, chosen by the applicants and the secretary of state, whose award shall be final "as far as respects the granting of the patent;" and if either of the applicants refuse to choose an arbitrator, the patent shall issue to the opposite party. It has been held, that such an award is not conclusive in any other respect than as to the mere issuing of the patent; and that it decides nothing as to the right of invention or other claims of either party, but that either party may contest, in a suit at law, the validity of the patent. *Stearns v. Barrett*, 1 Mason 10.

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10. The tenth section provides, that upon oath or affirmation being made before the district judge of the district where the patentee, his executors, &c., reside, that any patent was obtained "surreptitiously, or upon false suggestion" (the words of the act of 1790 are, "surreptitiously by or upon false suggestion"), the district judge may, if the matter appear sufficient, at any time within three years after the issuing of the patent, grant a rule that the patentee show cause why process should not issue against him to repeal the patent; and, if sufficient cause be not shown, the rule shall be made absolute, and the judge shall order process to be issued against such patentee, &c., with costs of suit. And if no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by the court for the repeal of the patent; and if the plaintiff fails in his complaint, the defendant shall recover costs.

It has been held, that the proceedings upon the rule to show cause or summary; and that when it is made absolute, it is not, that the patent be repealed, but only that process issue to try the validity of the patent, on ^{*29]} the suggestions stated in the complaint. That this process is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of fact, if any, are to be tried, not by the court, but by a jury; that the judgment upon this process is in the nature of a judgment on a *scire facias* at common law, upon which a writ of error lies, as in other cases, to the circuit court, where there is matter of error apparent on the record, by bill of exceptions, or otherwise. That the patent itself is slight, but *prima facie* evidence, in favor of the patentee, that it is his invention; that if it appear, that he is but a joint inventor, and he takes out the patent as his sole invention, it is an obtaining of the patent upon false suggestion within the act. *Stearns v. Barrett*, 1 Mason 10.

11. The remaining sections of the act (§ 11 and 12) contain no matter of any general importance; the eleventh being directory only as to the fees of office, and the twelfth being a repealing clause of the act of 1790.