COMMISSIONER OF PATENTS *v.* WHITELEY.

1. Where an applicant for reissue of a patent has done all in his power to make his application effectual—has filed his application with the acting commissioner and paid the requisite amount of fees—the application is to be considered as properly before the commissioner.
2. Where a statute directed the commissioner of patents to grant a reissue of patents in certain cases, to "assignees," it is the duty of the commissioner to decide whether the applicant is an assignee with such an interest as entitled him to a reissue within the meaning of the statutory provision on the subject; and if he has thoroughly examined and decided that the applicant is not so, a *mandamus* will not lie commanding him to refer the application to "the proper examiner or otherwise examine or cause the same to be examined according to law." The preliminary question was within the scope of his authority. If the *mandamus* had ordered the commissioner to allow an appeal, the order under which it issued would have been held correct.
3. *Mandamus* cannot be made to perform the functions of a writ of error.
4. *Semble* that an applicant for a reissue of a patent under the thirteenth section of the Patent Act of 1836, which allows a reissue in certain cases to a patentee "and in case of his death or any *assignment* by him made of the *original patent*," vests a similar right "in his executors, administrators, or *assignees*," must be an assignee of the whole interest in the patent; and not the assignee of a sectional interest only. At least where the commissioner of patents had thus decided, this court, on the questions being raised in connection with other questions, whose decision rendered a decision on *it* unnecessary, say that "as at present advised they were not prepared to say that the decision of the commissioner was not correct."

ERROR to the Supreme Court of the District of Columbia.

Whiteley, the defendant in error, was the assignee of a sectional interest in a patent granted to Hains, on the 4th of September, 1855, for an improvement in mowing machines. He held, by virtue of several assignments, all the territory embraced in the patent, except the State of Ohio and the northern half of the State of Illinois; and in all the territory, except as just mentioned, was assignee of all the rights of the patentee.

In 1863, he applied to the commissioner of patents for a reissue of the patent, according to the thirteenth section of the Patent Act of 1836; a section which enacts that—

Statement of the case.

"Whenever any patent, &c., shall be inoperative or invalid, by reason of a defective or insufficient description or specification, &c., if the error has or shall have arisen by inadvertency, accident, or mistake, &c., it shall be lawful for the commissioner, upon the surrender to him of such patent, &c., to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or *any assignment* by him made of the original patent, a similar right shall vest in his executors, administrators, or *assignees.*"

The assignees for the State of Ohio, and of the northern half of Illinois, did not join in the application.

The commissioner of patents, after a laborious investigation of the law and comparison of various sections of the patent acts, decided that the applicant, not being the assignee of the whole interest in the patent, was not entitled to the reissue asked for.

Whiteley took no appeal from the commissioner's decision to the "board of examiners," but setting forth that his application for reissue was filed with the acting commissioner, and the refusal, petitioned the Supreme Court of the District of Columbia for a *mandamus* to send the application *to an examiner to be acted upon by him as though made by the patentee.*"

The commissioner, in reply—premising that for the reason that the proposed applicant was not such an assignee as the law contemplates, and that the application, therefore, was not filed, or entered upon the books of the office, and never had been, and that the fees required on such application, which had been paid by the relator to the chief clerk of the office, on the presentation of said application, had not been placed to the credit of the patent fund, but remain in the hands of the chief clerk, personally, and subject to the order of the relator—replied, among other reasons, against the *mandamus:*

1. That the object of it was to carry by appeal a preliminary question solely cognizable by him, to the Supreme Court of the District, and that such a *mandamus* would be nugatory.

2. That he had decided rightly in rejecting the application, the relator not coming within the meaning of the term "assignee," as contemplated in the thirteenth section of the act of 1836. And in support of this view he submitted as part of his answer a full law argument, which now came up in the record.

The Supreme Court of the District granted the *mandamus*, "commanding the commissioner of patents *to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.*" The case was now here on writ of error, brought by the commissioner of patents, to remove the proceeding to this court. Two principal questions were raised:

1. Supposing the decision of the commissioner to have been erroneous, and that the assignee of a sectional interest in a patent was entitled to a reissue, did a *mandamus* such as that above mentioned lie to correct the decision?

2. Did the commissioner, in deciding as he did, that the applicant as owner of but a sectional interest was not entitled to a reissue, decide correctly?

In order to judge of the first question it is necessary to state—

1. That the Patent Act of 1836, by its seventh section, provides that on the filing of any application for a patent, "the *commissioner* shall make or cause to be made an examination of the alleged new invention or discovery," and if on such examination it does not appear that the same had been invented or discovered by any other person, &c., he shall issue the patent. But if, on the contrary, he shall decide that the applicant was not the original and first inventor, &c., and the applicant shall insist on his claim, "such applicant may *on appeal have the decision of a board of examiners* to be composed of three disinterested persons who shall be appointed by the Secretary of State for that purpose," which board shall have power "to reverse the decision of the commissioner, either in whole or in part."

2. That by an act of 1837, in addition to the former act, it is provided that in cases of application to the commis-

sioner for *re*-issue, the applicant, if dissatisfied with the decision of that officer, "shall have the same remedy and be entitled to the same privileges and proceedings as are provided by law in the case of *original* applications."

Mr. Foote, for the plaintiff in error, contended:

On the first point. That if the decision was erroneous it could not be corrected in the manner in which the relator had proceeded. The commissioner had already done just that thing which the writ commanded him to do. He had examined the matter very fully, and the proof of this was in the document found in the record as the chief reply to the application for the *mandamus* granted. The remedy was appeal.

On the second point. The decision of the commissioner was believed by him to be correct; but that officer had no personal interest in the questions. All that he wished was that it should be settled by this court. Similar questions frequently arose in the Patent Office, and it was important to the public interest that the statute should receive an authoritative construction.

He conceded that an extension of the act to assignees of sectional interests would be very convenient to them. That the necessity of a reissue might be as great to them as to the owner of the whole interest. Indeed that their rights might be impaired and even lost for want of such a power.

But there were serious objections to such a construction of the statute.

1st. It might lead to as many different patents for the same invention as the patentee should grant sectional interests in it.

2d. Upon a reissue the original patent must be surrendered.

In *Moffatt* v. *Garr*,* this court held that a surrender of the patent to the commissioner in judgment of law extinguishes the patent. It is a legal cancellation of it; and

* 1 Black, 273.

hence can no more be a foundation for a right after the surrender than could an act of Congress which had been repealed. If the patent be cancelled by one assignee, how could a suit be maintained upon it by another who had not joined in the reissue? Or if the sectional assignee did not happen to possess the patent, how could he surrender it to be cancelled?

3d. The omission in the thirteenth section of the act to mention the grantees of sectional interests, as would be seen on reference to it that the act does in other sections, in connection with the requirement of a surrender of the patent, would seem to imply that it was not the intention of the act to extend its provisions beyond the patentee and the assignee of the whole interest.

Messrs. Coombs and Fisher, contra.

So far as it was possible, Whiteley complied with all the forms and requirements of the law. The case, therefore, presents general questions of right applicable to many cases.

I. Has the Supreme Court of the District of Columbia jurisdiction and power to grant and enforce a "writ of *mandamus*" commanding the commissioner of patents to do an act enjoined by law?

The writ is a remedial writ, issuing out of the King's Bench, or other highest court of original jurisdiction; it commands the party to whom it is directed to do his duty, and summarily enforces its command by attachment; and it is the appropriate remedy where the law has prescribed no specific remedy, and where justice and good government require one. It is based upon the principle, that there should be a remedy to enforce every right. Without such writ, of such general application, and of such power *in terrorem*, the frequent failure of justice would be intolerable. Nowhere in the country is there so great need of the writ of *mandamus* as in the District of Columbia, where all the great departments of the general government have their

offices, and where the rights of the people are so liable to infringement.

In *Griffith* v. *Cochran*,* a rule was granted upon Cochran, Secretary of the Land Office, "commanding him to prepare and deliver patents to Griffith" for certain tracts of land. The court said:

"Where a ministerial act is to be done, and there is no other specific remedy, a *mandamus* will be granted to do the act which is required; but where the complaint is against a person who acts in a judicial or deliberative capacity, he may be ordered by *mandamus* to proceed to do his duty, by deciding according to the best of his judgment, but the court will not direct him in what manner to decide. This was the principle adopted by the Supreme Court of the United States, in the case of *United States* v. *Lawrence*,† and it has been frequently recognized by this court. If the secretary had in this case refused to make any calculation, or take any step whereby the business of the applicant might be despatched, it would certainly have been our duty to compel him by *mandamus*."

In *Kendall* v. *United States*,‡ in this court—the leading authority upon the question,—the court said:

"Congress has entire control over the District for every purpose of government; and it is reasonable to suppose that, in organizing a judicial department here, all judicial power necessary for the purposes of government would be vested in the courts of justice. The Circuit Court here is the highest court of original jurisdiction; and if the power to issue a *mandamus* in a case like the present exists anywhere, it is vested in that court."

In *Decatur* v. *Paulding*,§ Taney, C. J., in delivering the opinion of the court, said:

"In the case of *Kendall* v. *United States*, it was decided in this court, that the Circuit Court for Washington County, in the

* 5 Binney, 103–105.
† 3 Dallas, 42.
‡ 12 Peters, 524.
§ 14 Id. 515.

District of Columbia, has the power to issue a *mandamus* to an officer of the Federal government commanding him to do a ministerial act."

The act of Congress of 3d March, 1863,* which established the Supreme Court of the District of Columbia, in section third, says:

"The Supreme Court organized by this act shall possess the same powers and exercise the same jurisdiction as is now possessed and exercised by the Circuit Court of the District of Columbia," &c.

II. Is the commissioner of patents commanded by law to examine, or cause to be examined, a proper and lawful application for a reissue, and does the writ of *mandamus* lie to enforce that command?

The relator holds, that when an application for a reissue is made in due form of law, it is the duty of the commissioner to examine it, and take such action upon the case as will enable the applicant to appeal from his decision if it be unfavorable. To this the commissioner objects, that the relator is not entitled to apply for a reissue, because he does not own the entire patent; that the legal question involved is *preliminary*, and determinable by him alone, without appeal; and refuses to put the case upon the files of the Patent Office in such form, that his refusal to grant the reissue, would give the applicant an appeal to a Justice of the Supreme Court of the District of Columbia. And the object in praying for the writ was, that the commissioner might be compelled to "examine" this case. Before the examination can be made, the case must be duly *filed*, and then, if the commissioner refuses the patent, for any reason, we are entitled to an appeal; but as long as the commissioner keeps us completely out of the Patent Office, we are subject to his will, which deprives us of the right of appeal.

The thirteenth section of the act of 1836; the eighth sec-

* 12 Statutes at Large, 762.

tion of the act of 1837, which is supplemental to it, and the seventh section of the act of 1836, are co-active sections of the law and command the commissioner to make, &c., an examination.

This being the case, the writ of *mandamus* lies to enforce that command.

Formerly the received idea was, that a *mandamus* would lie only to command the performance of a ministerial duty; but modern cases have gone much further, and it is now the practice to grant the writ to command the performance by any inferior jurisdiction or officer, of any public duty, for which there is no specific remedy. The duty must be a public one, though the value to the public is not scrupulously weighed.

Adjudged cases* cover the present one, and demonstrate the power of the court below to command and compel the commissioner of patents "to hear the application;" "to exercise his discretion;" "to determine the one way or the other;" "to put himself in motion to do the thing;" "to proceed to do his duty," by examining, or causing to be examined, our application for a reissue, according to law.

III. Has the grantee of an exclusive territorial interest in a patent a legal right to apply for a reissue of that patent?

In *Shaw* v. *Cooper*,† the court say, "That the *holder* of a defective patent may surrender it to the Department of State, and obtain a new one, which shall have relation to the emanation of the first, was decided by this court at the last term, in the case of *Grant and Others* v. *Raymond*."‡

The word "holder" here used, it must be observed, is a general term, and cannot be so restricted as to apply only to one who holds the entire interest in a patent; but is equally applicable to those who hold any exclusively territorial interest.

Moreover, the thirteenth section of the act of 1836, which

* Rex *v.* Bp. of Litchfield, 7 Modern, 218; Rex *v.* JJ. of Kent, 14 East, 220; Rex *v.* JJ. of North Riding, 2 Barnewall and Cresswell, 291; and Griffith *v.* Cochrane, 5 Binney, 103.

† 7 Peters, 292.

‡ 6 Id. 220.

first established the reissue, as now granted, grants unto *any assignee* the same right to a reissue that it grants to the patentee. Had it been the intention of Congress to restrict the remedy of reissue to the assignee of the *whole* interest, it would have been easy to use words of limitation, or to have used the restrictive and definite article "the" instead of the distributive pronoun "any," before the word "assignment."

[The learned counsel followed, and replied to the argument of the commissioner, as set forth in the opinion annexed to his answer, and made part of the argument; contending, also, that Whiteley was not a mere grantee of an exclusive territorial right.]

Mr. Justice SWAYNE delivered the opinion of the court.

This case was brought here by a writ of error to the Supreme Court of the District of Columbia.

On the 4th of September, 1855, a patent was issued to Jonathan Haines for an improvement in mowing machines.

On the 22d of November, 1856, Haines sold and assigned to Ball, Aultman & Co., an exclusive right to the invention and patent, within the limits of the State of Ohio.

On the 13th of April, 1858, upon the surrender of the original patent by Haines, and upon his application, without the assent of Ball, Aultman & Co., a reissue of the patent was granted to him.

On the 15th of January, 1860, Jonathan Haines sold and assigned to his brother, Ansel Haines, one undivided third part of his interest in the patent.

On the 25th of January, 1860, Jonathan and Ansel Haines sold and granted to Isaac and Wm. C. Hawley the exclusive right to the invention and patent in certain counties in the State of Illinois.

On the 10th of April, 1863, Ansel Haines reassigned to Jonathan Haines all his interest in the patent.

On the 17th of April, 1863, Jonathan Haines sold and assigned all his interest in the patent to Andrew Whiteley, the defendant in error. Haines, at the same time, delivered

the patent to Whiteley, in order that he might surrender it and procure another reissue.

Ball, Aultman & Co. were applied to; but declined to concur. It does not appear that the Hawleys were advised upon the subject.

On the 25th of January, 1863, Whiteley filed his application for a reissue in the Patent Office, in conformity with the provisions of the thirteenth section of the act of 1836.

The commissioner of patents declined to entertain the application, upon the ground that the applicant was only the grantee of an exclusive sectional interest, and not of the entire patent. He also declined to allow an appeal to be taken from this decision. An application was thereupon made to the Supreme Court of the District of Columbia for a writ of *mandamus*. That court awarded a peremptory writ, commanding the commissioner "to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law." This writ of error is prosecuted to reverse that order. Did the court err in making it?

The thirteenth section of the act of 1836 declares that, under the circumstances therein stated, "it shall be lawful for the commissioner, upon the surrender to him of such patent," . . . . "to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specifications; and in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assigns."

The seventh section of this act provides that, on the filing of any application for a patent and the payment of the duty required, "the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery," &c.

The eighth section of the act of 1837 provides, in regard

to applications for the reissue of patents, and the decisions of the commissioner, that "in all such cases the applicant, if dissatisfied with such decision, shall have the same remedies, and be entitled to the benefit of the same privileges and proceedings as are provided by law in case of original applications for patents."

This renders it necessary to recur to the act of 1836, and to consider carefully its provisons touching the applications to which it relates.

Both acts should be liberally construed to meet the wise and beneficent object of the legislature. Patentees are a meritorious class, and all the aid and protection which the law allows, this court will cheerfully give them.

If the commissioner should hold that a party applying originally for a patent "was not the original and first inventor," and should decide against him upon that ground, the applicant could undoubtedly take an appeal from his decision. The commissioner having reached this conclusion, would be under no obligation to go further and examine any other question arising in the case, and it would not be necessary to the right of appeal that he should do so.

Here an assignee applied for *the reissue* of a patent. It was clearly competent for the commisioner, and it was his duty, to decide whether the applicant was an assignee at all, and, if so, whether he was an assignee with such an interest as entitled him to a reissue within the meaning of the statutory provision upon the subject. The latter question is an important one. It is as yet unsettled, and awaits an authoritative determination.

The commissioner says, in his answer to the rule, that he could not examine the application, because none had been filed in the Patent Office.

This position is untenable. It is averred in the petition, and not denied in the answer—and, therefore, as in other like cases of pleading, to be taken as conceded– that the application was filed with the acting commissioner. It is also admitted, in the answer, that the requisite amount of fees had been paid by the relator, but, it is added, that it

had not been placed to the credit of the office, and was in the hands of the chief clerk, subject to the relator's order.

The relator had done all in his power to make his application effectual, and had a right to consider it properly before the commissioner.

It was so. If it was not, a *mandamus* would clearly lie to compel the commissioner to receive it. It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow.

The commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties? It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough, and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.

From this decision, whether right or wrong, the relator had a right, under the statute, to appeal.

If the *mandamus* had ordered the commissioner to allow the appeal, we should have held the order under which it was issued to be correct. But the order was that he should proceed to examine the application. That he had already done. The preliminary question which he decided was as much within the scope of his authority as any other which could arise. Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views, it would have been idle to do so. *The question* was vital to the application, and its resolution was fatal, so far as he was concerned. Only a reversal by the tribunal of appeal could revive it, and cast upon him the duty of further examination.

The principles of law relating to the remedy by *mandamus* are well settled.

It lies where there is a refusal to perform a ministerial act involving no exercise of judgment or discretion.

It lies, also, where the exercise of judgment and discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.

It is applicable only in these two classes of cases. It cannot be made to perform the functions of a writ of error.

In *Decatur* v. *Paulding*,* referring to an act of Congress under which the relator in that case claimed a pension which had been refused her by the Secretary of the Navy, this court said: "If a suit should come before this court which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by any head of a department; and if they supposed his decision to be wrong, they would of course so pronounce their judgment. But their construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of Congress in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the secretaries, nor reverse his judgment in any case where the law authorizes him to exercise discretion or judgment; nor can it by *mandamus* act directly upon the officer, and guide or control his judgment or discretion in the matters committed to his care in the ordinary discharge of his official duties. . . . The interference of courts with the performance of the ordinary duties of the executive department of the government would be productive of nothing but mischief, and we are quite satisfied that such a power was never intended to be given to them."

This case, as presented to the court below, was within neither of the categories above mentioned. The court, therefore, erred in making the order to which the commissioner objected.

The main question passed upon by the commissioner, and

* 14 Peters, 515.

which was supposed to underlie this case, is not before us for consideration. If it were, as at present advised, we are not prepared to say that the decision of the commissioner was not correct.

The order of the court below, awarding the *mandamus*, is reversed with costs, and it is ordered by this court that the application of the relator be by that court

OVERRULED AND DISMISSED.

VON HOFFMAN *v.* CITY OF QUINCY.

1. Where a statute has authorized a municipal corporation to issue bonds and to exercise the power of local taxation in order to pay them, and persons have bought and paid value for bonds issued accordingly, the power of taxation thus given is a contract within the meaning of the Constitution, and cannot be withdrawn until the contract is satisfied. The State and the corporation in such a case are equally bound.
2. A subsequently passed statute which repeals or restricts the power of taxation so previously given, is, in so far as it affects bonds bought and held under the circumstances mentioned, a nullity.
3. It is the duty of the corporation to impose and collect the taxes in all respects as if the second statute had not been passed.
4. If it does not perform this duty a *mandamus* will lie to compel it.

THIS case was brought up by a writ of error to the Circuit Court of the United States for the Southern District of Illinois.

The relator filed his petition in that court, alleging, among other things, as follows:

At the June Term, 1863, and before that time, he was the owner and holder of certain coupons on interest notes of the City of Quincy. They were past due and unpaid. When issued and negotiated they were attached to certain bonds made and delivered by that city, in payment for the stock of the Northern Cross Railroad Company, and of the Quincy and Toledo Railroad Company, subscribed for by