concerned, yet they effected no change in the mode of disposing of the public lands, nor was the colonization policy of 1824, at all altered by them, for they expressly declare that "in alienations of lands, the existing laws will be observed and what the colonization laws determine."

In any aspect of this case, the claim for this large tract of land has no foundation to rest upon. The Departmental Assembly, aided in a certain sense by the governor, usurped the prerogative of the supreme government, and no ingenuity of reasoning can sanction a proceeding, which was not only without authority of law, but contrary to the forms prescribed by it.

JUDGMENT REVERSED, and the cause remanded to the court below, with directions to enter a decree

DISMISSING THE PETITION.

TUCKER *v.* SPALDING.

1. In an action at law, where a patent of prior date is offered in evidence as covering the invention described in the plaintiff's patent, on a charge of infringement, the question of the identity of the two instruments or machines, must be left to the jury, if there is so much resemblance as raises the question at all.
2. It is no ground for rejecting the prior patent that it does not profess to do the same things that the second patent does.
3. If what it performs is essentially the same, and its structure and action suggest to the mind of an ordinarily skilful mechanic its adaptation to the same use as the second patent, by the same means, this adaptation is not a new invention, and is not patentable.

ERROR to the Circuit Court for the District of California.

Spalding brought an action at law against Tucker, to recover damages for the infringement of a patent for the use of movable teeth in saws and saw-plates.

The plaintiff's patent claimed the forming of recesses or sockets in saws or saw-plates for detachable or removable

teeth on circular lines, and in combination with these recesses, teeth having their base or bottom parts formed on circular lines as described.

The defendant offered in evidence as covering the subject-matter of the plaintiff's patent a patent to Jonah Newton, confessedly prior in date and invention to that of plaintiff. This patent of Newton's had cutters of the same general shape and form, including circular base, as the saw-teeth of the other patent, attachable to a circular disk, and removable as in the other, but attached by screws or nuts, and the *claim or purpose of the Newton patent was for cutting tongues and grooves, mortices, &c.* In connection with the offer of the patent to Newton, the defendant offered to prove by experts that the process of Newton's patent, and of the machine made thereunder, and of the result produced thereby, were the same process, machine, and result as were involved in the patent of the plaintiff; that saws were made under Newton's patent, and were in practical operation (the exhibition of the saws so made and operated being also offered); that the machine made under Newton's patent rotated in precisely the same manner and with the same effect as a circular saw, and that what in Newton's patent were designated "cutters," performed the same functions as the detachable teeth, described in the plaintiff's patent, and accomplished the same result; and that the said "cutters" were nothing in reality but detachable saw-teeth, inserted on circular lines, and rounded at the base and inserted in circular sockets, and secured an equal distribution of the pressure on the said "cutters," over and upon the circular sockets in which they were set, and thus prevented fracture of the disk or plate.

The court refused to admit the patent to Newton in evidence. Verdict and judgment were rendered accordingly for the plaintiff, Spalding, and the other party brought the case here on error, assigning several errors in the rejection of evidence and in the charge of the court. The cardinal point of the case, however, was the refusal of the court to permit the Newton patent to be read to the jury; the bills

of exception including, however, the rejection of the testimony of experts, to prove the identity of the invention described in the Newton patent with that of the plaintiff.

Mr. W. C. Witter, for the plaintiff in error (*a brief of Mr. George Gifford being filed*), argued that the evidence rejected ought to have been submitted to the jury; and went also into a full exhibition of diagrams and models to show that the two inventions were in truth the same.

Messrs. M. A. Wheaton and J. J. Coombs, contra.

Mr. Justice MILLER delivered the opinion of the court.

We are of opinion that the court erred in refusing to admit the patent to Newton, confessedly prior in date and invention to that of the plaintiff, which the defendant offered as covering the subject-matter of the plaintiff's patent.

Whatever may be our personal opinions of the fitness of the jury as a tribunal to determine the diversity or identity in principle of two mechanical instruments, it cannot be questioned that when the plaintiff, in the exercise of the option which the law gives him, brings his suit in the law in preference to the equity side of the court, that question must be submitted to the jury, if there is so much resemblance as raises the question at all. And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may on this mixed question of law and fact, lay down to the jury the law which should govern them, so as to guide them to truth, and guard them against error, and may, if they disregard instructions, set aside their verdict, the ultimate response to the question must come from the jury.

The court in rejecting the patent of Newton seems to have been mainly governed by the use which was claimed for it, and also that no mention is made of its adaptability as a saw. But if what it actually did, is in its nature the same as sawing, and its structure and action suggested to

the mind of an ordinarily skilful mechanic this double use to which it could be adapted without material change, then such adaptation to the new use, is *not* a new invention, and is not patentable.

The defendant offered to prove that such was the relation of the principle of the Newton patent and plaintiff's patent by experts, and we are clear that the resemblance was close enough to require the submission of the question of identity to the jury, and the admission of the testimony of experts on that subject.

This subject was fully considered in the case of *Bischoff* v. *Wethered*,* decided since the present writ of error was issued.

This court has no more right than the court below to decide that the one patent covered the invention of the other, or that it did not; and it is obvious that extended argument here, to prove such general resemblance as would require the submission of both patents to the jury, might prejudice the plaintiff's case on the new trial which must be granted. We therefore forbear to discuss the matter further; for the same reason we refrain from comment on the instruction. It is to be understood that in declining to pass upon the other alleged errors of the record, this court neither affirms or overrules the action of the court on those points, and the case is reversed for this fundamental error, which includes several others resting on that.

JUDGMENT REVERSED AND A NEW TRIAL ORDERED.

BUTLER *v.* WATKINS.

1. On a suit for damages by a patentee against a British corporation and its "managing agent," sent to this country, in having been fraudulently pretending in a series of negotiations to conclude an agreement with him, the patentee, to make use of his patent—the alleged real purpose

* 9 Wallace, 815.