

Syllabus.

districts and towns, giving them, as they have supposed, the monopoly of the patented machine or article within the district purchased. The decision of the court in this case will, in my view, utterly destroy the value of a great portion of this property.

I do not regard the authorities cited as establishing a different doctrine from that now contended for. The remark of Chief Justice Taney, in *Bloomer v. McQuewan*, that "when a machine passes to the hands of a purchaser, it is no longer within the limits of the monopoly; it passes outside of it, and is no longer under the protection of the act of Congress," is perfectly true in the sense and application in which the Chief Justice made it. He was speaking of time, not territory; of the right to use a machine after the original patent had expired and a renewal had been granted, not of using it in a place outside of the grant. All the effects mentioned by the Chief Justice would undoubtedly follow so far forth as it was in the power of the vendor to produce them, but no further. And he would never have contended that those effects would follow any further than the vendor's power to produce them extended. That is the very question in this case. How far did the assignee's interest and, therefore, his power extend? In my judgment it was limited in locality, both as to manufacture and use, and that he could not convey to another what he did not have himself. I hold, therefore, that the decree should be reversed.

PHILP ET AL. *v.* NOCK.

In a suit by a patentee, for damages against an infringer, the plaintiff can recover only for actual damages, and he must show the damages by evidence. They cannot be left to conjecture by the jury. Where he has sought his profit in the form of a royalty paid by his licensees and there are no peculiar circumstances, the amount to be recovered will be regulated by that standard. Counsel fees cannot be included in the verdict, and an instruction which directed the jury to award to the plaintiff "such sum as they should find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in

Argument for the plaintiff in error.

order to establish his right," was held to be erroneous as too broad and vague, and as tending to lead the jury to suppose that it was their duty to allow counsel fees and perhaps other charges and expenditures equally inadmissible.

ERROR to the Supreme Court of the District of Columbia.

Nock brought an action in the court below against Philp and others to recover damages for the infringement of a patent granted to him by the United States for an improvement touching the lids of inkstands and the hinge whereby such lids are attached. The case came on to be tried in March, 1870, and therefore while the Patent Act of July 4th, 1836,* which in suits against infringers gives to patentees "the actual damages sustained" by them, was in force; a similar provision, however, being made in the subsequent Patent Act of July 8th, 1870.† The bill of exceptions showed that the plaintiff gave in evidence that during the term of the patent "the defendants had sold inkstands having hinges that were infringements of the plaintiff's patent, to the number of seventy-five dozen, and that the royalty which the plaintiff received for the use of his patent was at the rate of \$2 per gross." The testimony being closed, the court instructed the jury as follows:

"If the jury shall find a verdict for the plaintiff under the foregoing instructions, they will award him such sum as they shall find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right."

To this instruction the defendant excepted.

A verdict and judgment having been given for the plaintiff in the sum of \$500 the defendants brought the case here.

Mr. R. D. Mussey, for the plaintiff in error:

All the injury proved was that the defendants withheld royalty to the amount of \$12.50. There was no evidence of any "expenditure" by Nock, and the instruction had no

* 5 Stat. at Large, 123.

† 16 Id. 207.

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foundation in the evidence. Its inevitable effect upon the minds of the jury was to lead them to believe they might lump counsel fees, and such other expenditures as they *inferred*, and out of them make a total. The jury followed this evident lead of the court, and returned a verdict for forty times the amount proven.

Mr. G. W. Paschall, contra :

The bill of exceptions does not show all the evidence in the case, but it may be gathered that the plaintiff below proved that the defendants had infringed his right by selling seventy-five dozen inkstands. What further facts he proved is not stated.

Mr. Justice SWAYNE delivered the opinion of the court.

The measure of the damages to be recovered against infringers prescribed by the act of 1836 as well as by the act of 1870, is "the actual damages sustained by the plaintiff." Where the plaintiff has sought his profit in the form of a royalty paid by his licensees, and there are no peculiar circumstances in the case, the amount to be recovered will be regulated by that standard. If that test cannot be applied, he will be entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy. In arriving at their conclusion, the profit made by the defendant and that lost by the plaintiff are among the elements which the jury may consider. Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It cannot be as if the entire thing were covered by the patent; or, where that is the case, as if the infringement were as large as the monopoly. Counsel fees cannot be included in the verdict. The plaintiff must show his damages by evidence. They must not be left to conjecture by the jury. They must be proved, and not guessed at.

The instruction under consideration was too broad and too vague. The jury could have hardly doubted that it was their duty to allow the counsel fees paid or to be paid by

Statement of the case and opinion of the court.

the plaintiff, and perhaps other charges and expenditures equally inadmissible.

JUDGMENT REVERSED, and the cause remanded to the court below, with directions to issue

A VENIRE DE NOVO.

CARLTON *v.* BOKEE.

1. Where a claim in a patent uses general terms of reference to the specification, such as "substantially in the manner and for the purpose herein set forth," although the patentee will not be held to the precise combination of all the parts described, yet his claim will be limited, by reference to the history of the art, to what was really first invented by him.
2. General claims inserted in a reissued patent will be carefully scrutinized, and will not be permitted to extend the rights of the patentee beyond what is shown by the history of the art to have been really his invention. If made to embrace more the claim will be void.
3. One void claim, if made by inadvertence and in good faith, will not vitiate the entire patent.

APPEAL from the Circuit Court for the District of Maryland.

William Carlton et al., as assignees of Christian Reichmann, filed their bill in equity in the court below to restrain Howard Bokee from infringing a patent for an improvement in lamps, granted to Reichmann on the 21st of September, 1858, and reissued to Carlton and one Merrill on the 11th of August, 1868.

The court below dismissed the bill, and the complainant took this appeal.

The case can be gathered from the facts stated in the opinion of the court.

Messrs. J. H. B. Latrobe and B. R. Curtis, for the appellant ;
Messrs. C. F. Blake and C. M. Keller, contra.

Mr. Justice BRADLEY stated the facts and delivered the opinion of the court.

The lamp, as patented to Reichmann, was one of a large