

## RECENT DECISIONS RELATING TO PATENTS, ASSIGNMENTS, ETC.

### THE RIGHTS OF ASSIGNEES IN PATENTS.

It frequently happens that an inventor, in order to supply himself with the means to apply for a patent or introduce his invention, agrees with another person that, in consideration of the advance of funds, he will grant an assignment of the invention and of the letters patent therefor, in a certain State or States. The making of such assignments in advance of the issue of the patent is quite common; and when the patent is granted the assignee is the owner of the patent without further transfer, for the district originally conveyed to him.

There have been cases where the inventor has attempted to deprive his assignee of the benefits of the original assignment by dodges like the following: The inventor applies for the patent, and it is officially rejected. His assignee is informed that no patent can be obtained, and the matter is supposed to be closed. But on a subsequent occasion the inventor, having made changes in the invention, files an entirely new application. At last a patent is granted, but the inventor declines to admit the original assignee to any benefits therefrom on the ground that the patent is not for the application on which the advances were based.

The question whether the assignee has any right in such patent has been very forcibly decided in favor of the assignee by the U. S. Supreme Court in the well known coal-burner stove case.

An assignment of April 5, 1853, recites the granting to Littlefield of a patent on the 15th of April, 1851, "for a coal burner so constructed as to produce combustion of the inflammable gases of anthracite coal," and the fact that he had applied for a patent "securing to him a certain improvement in the invention so as aforesaid patented by him," and then assigns to Treadwell and Perry all the right, title, and interest which Littlefield "now has, or can or may hereafter have, in or to the aforesaid inventions, improvement, and patent, or the patent or patents that may be granted for said inventions or any improvements thereon, and in any extension or extensions thereof, within and throughout the district and territory embraced within the States of New York and Connecticut, for and during the term for which the aforesaid letters patent were granted, and the terms for which any patent for the aforesaid improvement, and any other improvement or improvements thereof, or extensions for or of either thereof, may be granted." The Supreme Court of the United States, in *Littlefield versus Perry* (21 Wallace, 205), held that this assignment, "taken by itself, contains, in most unmistakable language, an absolute conveyance by the patentee of his patent and inventions described, and all improvements thereon, within and throughout the States of New York and Connecticut," and that this assignment and a supplemental agreement executed between the same parties at the same time, when construed together, operated to constitute Treadwell and Perry the assignees of Littlefield within the patent laws in respect to the subject matter of the assignment, and to give them and those claiming under them the right to sue in this Court to prevent any infringement upon their rights.

On the 22d of July, 1853, Littlefield withdrew the application before mentioned, which had been filed December 30, 1852, and filed a new application, on which a patent was issued to him January 24, 1854. The Supreme Court held, in the case referred to, that the assignees became in equity the owners of this patent of 1854 under the assignment of April, 1853; that all the patents outstanding and the subject of the controversy in that suit, exclusive of the patent of 1851, were either reissues of the patent of 1854 or improvements upon it; and that the use of the said patents issued after January, 1854, by Littlefield and his co-defendant, Jagger, was an infringement of the rights of said assignees. The patents so referred to were these: A patent issued June 25, 1861; reissues, in two parts, 132 and 133, made November 19, 1861, of the patent of January 24, 1854; reissues, in four parts, 1,332, 1,333, 1,334, and 1,335, made August 26, 1862, of the patent of January 24, 1854, on the surrender of reissues 132 and 133; reissues, in two parts, 1,426 and 1,427, made March 3, 1863, of the patent of January 24, 1854, on the surrender of two of the four reissues of August 26, 1862; reissues, in two parts, 1,478 and 1,479, made May 19, 1863, of the patent of January 24, 1854, on the surrender of the remaining two of the four reissues of August 26, 1862; reissues, in two parts, 1,813 and 1,814, made November 8, 1864, of the patent of January 24, 1854, on the surrender of reissues 1,426 and 1,427; reissue 1,815, made November 8, 1864, of the patent of January 24, 1854, on the surrender of one of the two reissues of May 19, 1863; reissue 1,823, made November 22, 1864, of the patent of January 24, 1854, on the surrender of the remaining one of the two reissues of May 19, 1863; a patent issued December 19, 1862; a patent issued August 18, 1863; and reissue 1,594, made December 22, 1863, of the patent of August 18, 1863. The outstanding patents, when the bill of revivor and supplement was filed by John S. Perry, trustee, etc., against Littlefield and Jagger, on the 6th of February, 1865, were (exclusive of the patent of 1851), the patent of June 25, 1861, the patent of December 9, 1862, reissues 1,813, 1,814, 1,815, and 1,823 of the patent of January 24, 1854, and reissue 1,594 of the patent of August 18, 1863.

A new suit, brought by Perry against Littlefield, to recover ownership and damages in some other patents, additional to those named above, has just been decided in favor

of the assignees by Judge Blatchford, in the U. S. Circuit Court in the Northern District of New York.

### U. S. Circuit Court—Eastern District of New York.— Benedict, J.

BLACKMAN *et al.* versus HIBBLER *et al.*—GLASS BASE FOR COAL OIL LAMPS.

1. The invention embraced in patent to E. Blackman, February 6, 1872, No. 123,325, is a lamp chimney with the top or upper portion constructed of mica, and a glass base, the two being united and designed to be used together as a unit, and the reissue No. 7,417, December 5, 1876, describing and claiming the base separately, is invalid, as being for a different invention.

2. When the original patent described a certain form of mica chimney united to a glass base, a reissue claiming such glass base in combination with any form of chimney top was regarded as greatly enlarging the scope of the invention by dropping one element from the combination and putting in its place another, not its equivalent.

3. A lamp chimney constructed with base and top in one piece being old, no invention was required to conceive the idea that it could be made in two pieces, nor to form a surrounding rim upon the upper part of the base for the purpose of maintaining in position the separate top piece.

Bill dismissed for lack of novelty in the invention.

### U. S. Circuit Court.—Eastern District of Pennsylvania.— McKenna, J.

LORILLARD *et al.* versus RIDGEWAY.—THE MARKING OF PLUG TOBACCO BY PRESSURE NOT A PATENTABLE INVENTION.

1. Tobacco having been marked by pressing into its surface metallic or other hard substances, the imprint of which was left upon the tobacco, it was no invention to provide such plates with prongs or projections, and allow them to remain upon the tobacco.

2. Letters and other distinguishing marks having been produced upon tobacco, to put such marks upon a metallic tag, if greater prominence was desired, was readily suggested to the common mind, and did not rise to the dignity of an invention.

### Before the Commissioner of Patents.—Paine, Commissioner.

#### VEGETABLE-LIFE DESTROYER.

The motion is submitted in the following words:

In the application for patent for vegetable sprout killer by Francis B. Rodgers, filed January 2, 1878, the decision of the Examiner denying the patent has been overruled by the Board of Appeals. Applicant requests the allowance of the patent by the Examiner (unless the utility of the patent is denied) in accordance with the decision of the Examiners-in-Chief.

The application relates to a compound or mixture for the destruction of vegetable life.

One of the grounds upon which the Examiner rejected the application was that the mixture was a mere aggregation having no functions differing from those of its several ingredients. The applicant insisted that the compound operated more rapidly and effectually than either of its elements. The Examiners-in-Chief decided, on appeal, that if the mixture described operated more effectually and rapidly, and was more convenient in use, than its elements, the applicant was entitled to a monopoly of his new compound; but in their decision they stated that they were not informed on this point, and suggested that the applicant should be permitted to file affidavits, under Rule 31, in case the examiner should traverse his assertion that the mixture operated as above stated. Thereupon the applicant requested the allowance of the patent by the Examiner (unless the utility of the patent was denied), in accordance with the decision of the Examiners-in-Chief.

The examiner replied that he did not deny the usefulness or operativeness of the mixture, but denied its patentability.

The applicant appealed to the Commissioner because, as he alleged, the Examiner ignored the decision of the Examiners-in-Chief; and he asked that the Examiner might be instructed to act in accordance with that decision.

The Commissioner held that, inasmuch as the Examiners-in-Chief had decided that if the mixture was operative, as claimed, it was patentable in favor of the applicant, although their decision was obligatory upon the Primary Examiner, and that it was therefore the duty of the Primary Examiner, if he did not deny that the compound operated as the applicant claimed, to pass the case to issue. Thereupon the applicant requested that the Primary Examiner, inasmuch as he did not deny the operativeness of the invention, should, in obedience to the decision of the Commissioner, pass the case to issue without further delay.

The examiner replied that the Commissioner's decision was that he should pass the case to issue if he did not deny that the mixture operated more effectually and rapidly than any of its elements; and that, while he did not deny the operativeness of the mixture, he did deny that it acted more effectually than its component parts. And he added that, while the suggestion of the Examiners-in-Chief that the applicant should be permitted to submit affidavits would have been consistent with the rules if the Examiner had denied the operativeness or usefulness of the compound, nevertheless, inasmuch as he did not deny its operativeness or usefulness, but only denied that it would act more effectually

or rapidly or conveniently than any of its elements, affidavits were expressly prohibited by the last clause of Rule 31, in which it is provided that "affidavits in support of applications will not be received at any stage of the examination unless the office denies that the invention is operative or useful." Upon this action of the Examiner the present motion for the transfer of the case to another division is based.

This motion cannot be granted. The Primary Examiner has not disregarded the decision of the Commissioner, nor has he disobeyed the decision of the Board of Examiners-in-Chief; and, while he has declined to comply with their suggestion that applicant should be permitted to submit affidavits in the case, he has done so in the belief that this course was forbidden by the rules of the office. I am not prepared to say that this impression was incorrect.

But I see no good why the applicant should not be permitted, if he can do so, to show that this mixture acts more rapidly and more effectually than the elements of which it is composed, and is more conveniently used. I think that, under Section 483 of the Revised Statutes, I have authority by an order made with the approval of the Secretary to authorize him to introduce such affidavits.

It is accordingly ordered that the applicant be permitted, within sixty days after the date of this order, to submit affidavits for the purpose of showing that his compound or mixture operates more effectually or rapidly and is more convenient in use than any of the substances of which it is compounded.

The relief demanded by the applicant is denied.

[Approved by the Secretary.]

An undue zeal for the observance of forms and ceremonies is apt to make the ablest officials lose sight of the main object for which they are individually housed in the Patent Office, and for which the patent laws were enacted, to wit: *the promotion of the useful arts by the grant of patents to authors and inventors.* In times past some of the Commissioners and some examiners seemed to labor under the mistaken notion that the chief purpose of their official life was the opposing of inventors, the placing of obstacles in their way, and preventing the grant of patents.

The foregoing case illustrates our meaning: The Examiner in the first place appears to have wrongfully denied the patent. The applicant was then put to the expense of an appeal to the Board of Examiners, who practically decided that a patent should be granted. But the Examiner then holds back the patent on a technicality; the applicant is then put to the further expense of appealing to the Commissioner in person, who supports the little point raised; which now subjects the inventor to further delays and costs in getting up expert testimony. All the trouble to all the parties concerned would have been avoided had the Examiner in the first instance simply issued the patent.

We doubt whether there is any instance where a Patent Office mistake made in favor of the inventor ever hurt the Examiner, the Commissioner, the Secretary of the Interior, or any other official. On the other hand such wrangles as the foregoing are always unprofitable, and do them little credit.

### Yankee Inquisitiveness.

The *Price Current*, Portland, Me., suggests a legitimate and wise plan to increase the demand for the products and manufactures of any and every country. When a man has a really valuable article to offer to the world, he should devise the best ways and means to let the buyer and consumer know the source from whence it came, and, if possible, the means and expense by which the recipient may obtain more of the same kind. The result of this justifiable inquisitiveness will be the doubling of the crop of good apples in Maine within a few years. L. J. Stout, of Limington, Me., while barreling apples to be shipped to parts entirely unknown to him, conceived the novel idea of ascertaining their destination by putting a letter, inclosing money to pay the postage on a letter, in one of the barrels, kindly asking the purchaser to write him the date of opening it; his name and residence, the price paid, the condition of the apples when opened, etc. In about three months Mr. Stout received a letter from a merchant in London, England, saying one of his customers found the letter and passed it to him, and by him it was neatly answered, giving all the desired information in regard to the apples, etc. Last winter Mr. Stout received a letter from the same merchant in relation to filling an order for Maine apples, but the quality and scarcity of the fruit last year prevented his filling the order satisfactorily to himself. Last week Mr. Stout received another order by cable for several hundred barrels as samples, from the same person. As Mr. Stout will undoubtedly fill the order, the English gentleman will no doubt be surprised at the size and quality of the fruit—which is this year probably a third larger than two years ago.

### The Metric System.

It may not be generally known that we have, in the nickel five cent piece of our coinage, a key to the tables of linear measures and of weights. The diameter of this coin is 2 centimeters, and its weight is 5 grammes. Five of them placed in a row will, of course, give the length of the decimeter; and two of them will weigh a decagramme. As the kiloliter is a cubic meter, the key to the measure of length is also the key to measures of capacity. Any person, therefore, who is fortunate enough to own a five cent nickel may carry in his pocket the entire metric system of weights and measures.

