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REDUCING AN INVENTION TO PRACTICE.

[Continued from the October number.]

II. It is more difficult to reconcile what has been held by different courts as to the necessity of an invention having been reduced to actual practice. That it must have been so reduced under some circumstances, there can be no doubt. From the dicta uttered in the cases of *Seymour v. Osborne*, and *Pitts v. Wemple*, cited above, and *Woodman v. Stimpson*, 1 Fisher 98, it would seem, however, that there may be cases in which it would be found sufficient to embody the supposed invention in an apparatus so complete that it would be employed for business purposes to accomplish the work intended. In addition to these, the language of Judge STORY, in *Washburn v. Gould*, 3 Story 122, may be adduced. "At any rate he is the inventor who is entitled to a patent, who first brought the machine to perfection, and made it capable of useful operation." p. 133. And also his utterances in *Reed v. Cutter*, 1 Story 590: "In a race of diligence between two independent inventors, he who first reduces the invention to a fixed, positive and practical form, would seem to be entitled to a priority of right to a patent therefor;" thus apparently recognizing a practical machine as a reduction to practice. p. 599. On the other hand, he holds, on p. 596—"Under our patent laws, no person who is not the first, as well as the original inventor, by whom the invention has been perfected and put in actual use, is entitled to a patent." A comparison of the last two quotations will teach us how readily expressions may be employed which seem to recognize the more

incorporation of an idea into a material, operative form, as sufficient without its being tested in work, at the very time when no intention of dispensing with that requisite is entertained. It is evident that no expressions like those cited above, which were made without reference to the question, should be relied on to sustain the doctrine under discussion. Again, in *Ransom v. Mayor*, 1 Fish. 252, these remarks are attributed to Judge HALL: "The party who embodies the principle, and makes it available for practical use, is the party who is entitled to a patent, and to protection under the patent law." p. 270. It may be doubted whether he intended by this to negative the idea that it was necessary that the embodiment should have been put in practice, since nothing in the case called for such an expression. In *Parkhurst v. Kinsman*, 1 Blatchf. 488, Judge NELSON's language was this: "To constitute a prior invention the party alleged to have produced it must have proceeded so far as to reduce his idea to practice, and embodied it in some distinct form. It must have been carried into practical operation, for he is entitled to a patent, who, being an original inventor, has first perfected the invention, and adapted it to practical use." p. 494. (*Vide Post*. 677). In *Agawam Woolen Co. v. Jordan*, 7 Wall. 583, we have the views of the highest tribunal as conveyed by CLIFFORD, J.: "He is the inventor, and is entitled to a patent, who first brought the machine to perfection, and made it capable of useful operation." p. 602. We have them also in words about the same, of NELSON, J., in *Whitely v. Swayne*. Id. 685: "For he is the first inventor, and entitled to a patent, who, being an original discoverer, has first perfected and adapted the invention to actual use." p. 687. These grave declarations coming from such high authorities, deserve serious consideration; and if we could only be assured that they were uttered with reference to the principle of law under discussion, they would increase the difficulty of ascertaining what is the true doctrine. But it is by no means certain that those who pronounced them had in view the question whether the inventions spoken of had been in actual use or not. There is indeed no intimation that the distinction between an invention embodied in an apparatus capable of use, and a machine put into actual practice, was adverted to in any of these cases. In *Woodman v. Stimpson*, 1 Fish. 98, however, an enunciation of the law is given which nearly amounts to a denial of the supposed requirement of use: "They must have been working machines, not mere experiments. They must have done work, or been capable of doing work, and not have been mere experiments, afterward

abandoned. Whether they were in fact operated for a greater or less time is of no importance, except so far as that may tend to make you believe that they were or were not mere experiments; in that view the fact is of consequence. But if you are satisfied that they were machines capable of doing work, substantially by the same arrangements as the plaintiff's actual working machines, then the fact that they were operated but a short time, and then abandoned for other reasons than because they had failed as machines, is of no consequence." p. 105. (LOWELL, J.). Yet on examination it will be seen that something besides mere experiments in the operation of the machine is called for.

Two cases are reported in which the question would appear to have been the express subject of consideration. In one of these, *Parker v. Ferguson*, 1 Blatchf. 407, it was shown on the part of the defense that a water-wheel, similar in construction to the patented one, had been made for a customer a number of years previous, and carried away by him to be put into a mill. The presiding judge charged the jury that they might find that the patented wheel was wanting in novelty without evidence that the other had been actually used. The report is unusually brief, and the reasons upon which these instructions were founded, are not hinted at. The patent was dated in 1829, the trial took place in 1849; yet nothing is said on the subject of the abandonment of the old wheel, although there must have been a strong presumption to that effect from the lapse of time. The case stands in striking contrast with that of *Parker v. Hulme*, hereafter cited, p. 669, which was brought upon the same patent, and when we compare with it the marked caution with which the evidence of a previous construction was there received, we cannot resist the conjecture that the report in *Parker v. Ferguson*, is very imperfect, and great hesitation must be felt in relying upon it. This doubt will be increased when the ruling of the same learned jurist, in *Foot v. Silsby*, 1 Blatchf. 445, is read.

The other case is *Coffin v. Ogden*, 3 Fish. 640, which has sometimes been cited as determining that it is not necessary to show that a device has been in use in order to defeat a patent for it, obtained by another afterward. The learned judge who presided laid down no such doctrine, however, but rather appears to have held the contrary. He did say, indeed, that the invention might be shown to be complete, "without being put to use in the general acceptation of that word." His view was that the only object of proving a use was to demonstrate the completeness of the invention, and

that this might be shown by something short of use as "generally understood." The learned judge expressly recognized, at the same time, the necessity of showing a prior use, but considered it as having been made out under the circumstances. These, he said, "must be regarded substantially as a use of the reversing mechanism." Some hesitation may be felt as to the soundness of this conclusion; the decision, it is clear, can hardly be cited as an authority against requiring proof of use in such cases.

It must be conceded, nevertheless, that the language of the learned judge lends countenance to the idea that the primary, perhaps the only object of insisting that it should be shown that what is alleged to have anticipated the patentee in his invention was employed in work, is to establish that it was a complete and practical embodiment of it. If that be all, it follows that other proof of its completeness may be substituted. Now, there is no question but that proof of such employment has been treated as material in this country as well as in England, when the question has been raised whether the former embodiment was a mere experiment, or was a perfected machine. An extensive examination of the reported cases will make one thing clear, however, which can hardly be reconciled with the view taken in the case mentioned. In nearly every instance in which the defendant has claimed that the invention had been made by some one else before the patentee, he has been called upon, as an indispensable condition, to show that it had been put in use; and this has been insisted upon without any reference to the completeness or imperfection of the former embodiment of it, and even where no such question was raised. The proof has been held essential on an entirely distinct ground; because it is prescribed by the statute. And it is so prescribed for the same reason that it was in the English system, in order that the knowledge of it by the public might be insured.

In *Watson v. Bladen*, 4 Wash. 580, it was the very question made by the plaintiff's counsel that the machine, which the defendant claimed to have been an anticipation of the one patented, had never been in use. And the court admitted the principle, but held that the evidence was not sufficient to sustain the plea. The objection had also been taken that the prior machine was imperfect, and it was answered upon grounds entirely distinct from that of its completeness having been demonstrated by its successful operation. The necessity of its being shown to have been worked was founded altogether on the language of the statute. Judge WASHINGTON, when taking up the question, says: "But the point mainly

relied upon by the plaintiff's counsel is that no evidence was given that Christian's machine was ever *used within the true meaning of that expression in the patent law.*" p. 583. There is not the slightest indication that such evidence was called for in order to repel the charge that the machine was not practically successful. The views of Judge STORY on this question may be gathered from his language of his in *Bedford v. Hunt*, 1 Mason 302. "Every subsequent patentee, although an original inventor, may be defeated of his patent right upon proof of his prior invention being put in use." p. 304. The intent of the statute was to guard against defeating patents by setting up a prior invention which had never been reduced to practice (p. 305); not, it seems, to repel the presumption of imperfection arising from its abandonment. And also from what fell from his lips in *Reed v. Cutter*, 1 Story 509: "Under our patent law, no person who is not the first, as well as the original inventor, by whom the invention has been perfected, and put in actual use, is entitled to a patent." p. 596. While it is true that in both these cases the earlier embodiments of the invention were charged with not being effective, the fact that they had been in operation was not once alluded to as a refutation of the charge. Other means were taken to show that they were capable of accomplishing their proposed functions. That they had not been in use was taken up as an independent objection to their being interposed as a bar to the plaintiff's patent. It was treated not only as an independent, but as in itself a sufficient answer to the defense. It was met in fine, not by proof that the machines were practical and effective, but by proof that they had been actually employed in business, as the only way of satisfying the court that the inventions were not new when patented as required by the statute.

In *Parker v. Hulme*, 1 Fish. 44, again, an attempt was made to show that a wheel similar to that for which the plaintiff held a patent had been made before the patentee originated it. Respecting this, the presiding Judge, KANE, gave these instructions to the jury: "One portion of Mr. Hulme's testimony calls for this remark, that it is not enough for the defendant to show that wheels like the patented ones were *made*, but that he must also show that they were *used* before the plaintiff's invention. *This is the test of what is required to defeat the title of a patentee of an improved machine.* In the present case, moreover, the mere proof of the use of such wheels would not suffice, unless it was also proved that water was introduced into the wheel with the proper direction given to it, as otherwise it could not have involved the prin-

principle of the improvement patented." It will be observed that the first rule is laid down as one of universal application, irrespective of its bearing upon the circumstances in proof before him; that the prior alleged invention should have been in actual use is declared to be the test in all cases. The propriety of insisting that the water must have been introduced into the wheel in a certain manner will be manifest when it is understood that the means of introducing it thus constitutes an essential feature of the invention. It is this which makes the report of *Parker v. Ferguson*, seem so meager and renders it probable that it falls short of representing the most important incidents of that trial.

There are other cases in which the invention set up as having anticipated the one on which the suit was founded, was charged with being an abandoned experiment, and there was on the other hand evidence of its having been employed in actual work; yet the terms in which the court discuss the effect of that evidence, cannot fairly be considered as attaching no other importance to it but that of refuting the charge thus made. They plainly look upon actual use as a necessary requisite to the sufficiency of such a defense in every instance; and they lay it down as a general rule that to render a former embodiment of a principle a bar to a patent, it must have been in employment for business purposes.

To expatiate at equal length on all the cases in which this subject has been agitated, would be regarded as tedious, and seems unnecessary. It will probably be deemed sufficient to give brief extracts from some of the opinions pronounced in them, especially since they bear the same character with those already quoted—that of legal principles, or rules of universal application. For instance, in *Many v. Jagger*, 1 Blatchf. 372, Judge NELSON'S language was, without any qualifying terms: "The new idea must be reduced to some practical use before it can be relied on to defeat a patent." p. 283. That of Judge GRIER, in *Winans v. N. Y. & H. R. Co.*, 31 Jo. Fr. Inst. N. S. 3d Ser. 316, was this: "It is not the person who has produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine, and reduced it to practical use." p. 352. Although it was claimed in these cases that what was set up as anticipating the plaintiff's discovery had been given up, yet it will be perceived that the quotations are not qualified by any reference to that circumstance. They are uttered as principles governing on all such occasions. In other cases, from which extracts will be given, it is not impossible that a similar answer was made to the same defense.

There is not the slightest allusion to it in the reports, however, and the expressions used by the learned Judge are the more confidently to be regarded as unrestricted in their bearing. Judge WASHINGTON, in *Penock v. Dialogue*, 4 Wash. 533, when speaking of what had been set up as a counterpart of the patented device produced before it by one Bedford, remarked as follows: "If they are the same in principle, but Bedford's was never *in use* before the plaintiff's invention, then it cannot impeach the validity of their patent." p. 543.

In *Ellithorpe v. Robinson*, 2 Fish. 83, Judge INGERSOLL, declared his views in this manner; "To constitute such a prior invention as will avoid a patent that has been granted, it must be made to appear that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also that he has reduced the idea to practice, and embodied it in some practical and useful form. The idea must have been carried into practical operation." p. 85. And again Judge INGERSOLL said in *Poppenhauser v. N. Y. G. P. Comb Co.* 2 Fish. 62; "Or if, gentlemen, before the invention of Meyer, either Goodyear, or any one else, at Roxbury, did invent the same thing, and *put the same in actual practice*, I lay emphasis on that, *put the same in practice*, in such an event the right granted to Meyer was void." p. 68.

We pass to other cases in which the requisites prescribed must have been irrespective of there being any presumption, arising from disuse, that the supposed previous invention was incomplete, since there was nothing in the proof to suggest it, and the declaration of the judges could have had no reference to that subject. They seem to be applicable on every occasion where the objection that the invention was an old one, is raised against the patent. The terms employed by Judge NELSON in *Foot v. Silsby*, 1 Blatchf. 445, are especially worthy of notice in view of his rulings in *Parkhurst v. Kinsman*, and *Parker v. Ferguson*, cited in previous pages, 666-7. "The person who first reduces the idea to *practical application and use* is entitled to the patent." p. 464. He thus excludes the one who has merely given it a form capable of application. So in *Coll v. Mass. Arms Co.* 1 Fish. 103, Judge WOODBURY, makes the observation, "It is no matter whether the prior inventions were patented or not, if they existed, if they were discovered, if they were used." p. 115. Still more decisive is the phraseology of Judge LEAVITT, in *Swift v. Whisen*, 3 Fish. 343: "As has been well said by the counsel, that which a person perfects, or invents, and applies to a practical use, that is to be regarded as the invention, and the mere knowledge by an individual of a prior mechanical

structure similar to the one patented, which has not been *used practically*, would not be an answer to the novelty of the patent." p. 360. Judge GILES delivered his sentiments to the same effect in *Singer v. Walmsey*, 1 Fish. 558: "For the law is that whoever perfects a machine, and brings it into useful operation, is entitled to the patent, and is the real inventor." p. 532. He thus equally excludes him who has gone no farther than to make a practical machine, without using it. So also Judge DRUMMOND, in *Cox v. Griggs*, 2 Fish. 174: "It is necessary in order to prevent a man from having the benefit of his patent, that another should have first discovered the thing, and reduced it to actual practice," p. 177.

In order to assist us in forming a just estimate of the significance and bearing of the discrepant opinions which have been referred to on this branch of the subject, it is worth while, before passing to another part of it, to call attention more particularly to the marked contrast between the two classes. Among those first cited there is but one, *Pitts v. Wimple*, ante 617, in which the distinction between a mere embodiment of an invention in a working machine, on the one hand, and an actual employment in business transactions, on the other, can be safely asserted to have been present in the mind. How readily an opinion might be expressed in such terms as to countenance the sufficiency of the former, without considering the necessity of the latter, can be easily imagined, and was illustrated by the quotations from Judge STORRY'S decision in *Reed v. Cutler* 665, ante 665. But in every instance where the employment of the device in actual work has been insisted on, it is evident that the distinction has been clearly in view. In several of them it is the very principle that is sought to be enforced. The authorities upon one side are to a great extent mere incidental expressions, which may have been intended to assert the doctrine they are supposed to involve, or they may not. The others are for the most part unequivocal, and are manifestly designed to assert the principle in support of which they are cited.

III. Another requisite is commonly supposed to be essential in order to render the previous existence of the invention in the hands of others than the patentee fatal to his title; that it should have been in public use. By this is to be understood, as observed before, a use in public; not necessarily a use by the public. The earliest case in which the subject came distinctly under judicial consideration is *Bolton v. Hunt*, 1 Mas. 392, decided in 1817, and already cited. It was shown that the article monopolized by the plaintiff had been manufactured many years before he originated it. The principal

question on the trial was as to the extent to which it must have been used in order to render the patent void. Judge STORY answered the question thus: "But if the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never could intend that the greater or less use, in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention." p. 305. This decision was founded upon the statute of 1793; but after the passage of that of 1836, he held the same doctrine even more unequivocally in *Beal v. Culler*, STORY 500, declaring himself in these terms: "If the invention is perfected and put into actual use by the first and original inventor, it is of no consequence whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself." p. 596. And in connection with this he took occasion to pronounce *Dolan's case* not a "just exposition of the patent law of this country, however correctly it may have been decided under that of England." p. 598.

Whatever disposition to treat these decisions as obsolete may be felt, they have been clearly recognized, and their authority acknowledged in cases of too late a period and of too high a character to allow of their being disregarded. In *Gayler v. Wilder*, 10 How. 477, decided in 1850, the subject must have been under consideration in the Supreme Court of the United States. In determining the case several points were noticed, which, after all, cannot be esteemed very significant; such as that the producer of the safe, which it was alleged was made before that of the patentees, never became aware of the value of his invention; that its construction was unknown to others, though, as was remarked, the mechanics who made it must have been cognizant of it. It is difficult to see that much importance could be attached to these and other incidents connected upon. When the very able jurist who pronounced the judgment of the court, Chief Justice TANEY, came to discuss the import of the expression in the sixth section of the law of 1836, "not known or used by others before his or their invention or discovery," he founded his interpretation of it upon the clause in the fifteenth section, in which it is provided that a patent shall not be held void on account of the invention being known or used abroad, if the patentee was not aware of it. He inferred from this that to entitle himself to a patent, an original discoverer of an improvement need not be in a strict sense the first inventor,

since his title could not be impeached although the improvement had been made by others before him. He said, therefore, that "the clause in question" (that contained in the fifteenth section) "qualifies the words before used" (those quoted from the sixth), "and shows that by knowledge and use the Legislature meant knowledge and use existing in a manner accessible to the public." p. 457. Now, if the judgment of the court had been made to turn on this interpretation, and the Connor safe had been pronounced no bar to the patent in suit, on the ground that it was not accessible to the public, it would have been a reversal of the doctrine advanced in *Bedford v. Hunt* and *Reed v. Cutter*. And if that doctrine was not approved by the court there could have been no fairer opportunity to have set the profession right in relation to it. But apart from the quotation given above there is not the slightest allusion to it. On the contrary the decision assumes that the Connor safe was *prima facie* fatal to plaintiff's title; but asserts that it had ceased to have that effect because the jury must be presumed to have found that it had been forgotten, and buried in oblivion, like a lost art. The learned judge even holds this remarkable language concerning it: "We do not understand the Circuit Court to have said that the omission of Connor to try the value of his safe by proper tests would deprive it of its priority; *nor his omission to bring it into public use*. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet if it was the same as Fitzgerald's, the latter could not, upon such grounds, be entitled to a patent; provided Connor's safe, and its mode of construction, were still in the memory of Connor before they were recalled by Fitzgerald's patent." p. 498. In other words, Connor's safe was a bar to a patent for the same improvement to any subsequent inventor of it, so long as Connor remembered its construction, notwithstanding it had never been in public use. Considering that the decision turned on the knowledge of Connor's safe having been lost, and not on its having been kept secret, it is very manifest that the court felt the weight of Judge STORY's decisions, and it was to avoid the effect of them that they resorted to the expedient of treating Connor's safe as having been forgotten.

In *Rich v. Lippincott*, 2 Fish. 1, which was tried two or three years after *Gayler v. Wilder*, the validity of the patent for Fitzgerald's safe was again contested before Judge GRIER. In his instructions to the jury he emphatically re-asserted the doctrine advanced in *Bedford v. Hunt* and *Reed v. Cutter*, going so far as to adopt the very language quoted above from

the former report. There can be little doubt, therefore, that the law of those cases was in the minds of the court when they had that of *Gayler v. Wilder* under consideration. The same question must have arisen also in *Cahoon v. Ring*, 1 Fish. 397, and 1 Cliff. 592, which was tried before Judge CLIFFORD in 1859, and at subsequent times. It was shown by the defendant that before the plaintiff made his invention, one Luce had constructed a perfect machine embodying it. It would seem that it was kept secret; but it is evident that this was not deemed sufficient to prevent its operating fatally against the suit. The court, therefore, adopted a course similar to that pursued in *Gayler v. Wilder*, and charged the jury that, whether it had been used or not, if it had been broken up, and its materials used for other purposes, or lost (of all which there was proof), and its construction was only recalled to the memory of the maker by the present controversy, etc., its existence would not invalidate Cahoon's patent. (p. 411). The learned judge must therefore have regarded the secret existence of the machine as in itself a bar to a patent obtained by any subsequent inventor, unless that objection were removed in the way he pointed out. Again in *Hall v. Bird*, 3 Fish. 595, tried before Judge BLATCHFORD in 1867, the prior machine, upon which the defendant relied, had always been kept carefully secluded from observation. Yet this was manifestly considered as not a sufficient answer to it. Instead of pronouncing against it on the ground that it had never been in public use, the court laid hold of circumstances from which they condemned it as an abandoned experiment. And they cite at length the case of *Gayler v. Wilder* as analogous to the one before them, and as sustaining their decision.

Judge STORY'S doctrine has also been supposed to have been directly affirmed in *Coffin v. Ogden*, 3 Fish. 640; but this is not borne out by a careful examination of the report. It was ruled by the court that an exhibition of the alleged previous invention to two or three persons was equivalent to giving the knowledge of it to the public. The necessity of a public use of it was distinctly recognized, therefore, although the evidence by which it was held to have been made out, might not generally be held sufficient.

If the doctrine has never been asserted anew in any of our courts in express terms since the case of *Reed v. Cutter*, it has never, on the other hand, been condemned in any instance in which it was the proper subject of adjudication. And an elementary writer of high authority evidently entertains an opinion in conformity to it. In the 3d edition of Curtis on

Patents may be found this sentence: "If the thing patented has once been actually and completely invented or discovered before, *however limited the use*, the patent is invalidated," etc., Sec. 87. Again, when speaking of some English decisions, it is said: "If we examine the facts of the several cases, and the tests applied to them, taking care to remember that under our law on the question of novelty, the *publicity of the prior use is not otherwise important* than as a circumstance tending to show that there was or was not a completed invention," etc. Sec. 88. He has nowhere declared his opinion more explicitly, it is true; but what his views are is evident enough.

While this matter has not been made the subject of any distinct adjudication of late, there have been several occasions in which remarks have fallen from the bench, plainly indicating that a different view of the law was entertained. The first extract, which was given from the opinion of Judge TANEY in *Gayler v. Wilder* (*Ante.* 673) shows that such were his impressions, although he avoided a conflict with the authority of those cases. In *Haselden v. Ogden*, 3 Fish. 378, Judge SHERMAN in a brief summary of the law upon the subject included this principle: "The prior use of an invention must be a public use and not a private use. If an invention is made and used in a private way, and then thrown aside, and not given to the public, a patent granted to a subsequent inventor would be a valid patent." p. 380. In *Adams v. Edwards*, 1 Fish. 1, Judge WOODBURY, after commenting upon the effect of using an invention two years, leaves that subject and proceeds thus: "If a man has an invention, and nobody knows of it, then the use of it cannot debar another person from inventing or patenting it." p. 12.

The expression of these opinions so widely differing from those of Judge STORY, justify an inquiry into the grounds on which his were founded. The only reason he gives for them is to be found in that clause of the law which, as he says, "expressly declares that the applicant for a patent must be the *first* as well as an original inventor." In support of this he quotes from his own opinion in *Pennock v. Dialogue*, 2 Pet. 1, where he said the Patent Act "gives the right to the *first* and true inventor, and to him only; if known or used before his supposed discovery, he is not the first, although he may be the true inventor, and that is the case to which the clause looks," p. 23. Now it is a little remarkable that the very same expression is used in the English Statute of Monopolies, which restricts the grant of a patent "to the true and first inventor." Our statute reads, "the original

and first inventor;" but the learned judge lays no stress on the word original; in fact, he uses it as interchangeable with the word true in the last extract. It is the more remarkable because it was in this very case of *Pennock v. Dialogue* that he explained how greatly we were dependent upon the construction of the English law for the proper interpretation of our own as mentioned on a former page. (612.) He said further on that occasion, "The words of our statute are not identical with those of the statute of James, but it can scarcely admit of a doubt that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord COKE." p. 20. There is not one expression in the Statute of Monopolies the meaning of which had become better settled than that of the words "first inventor," as may be seen from the quotation made from *Dolland's Case*, ante p. 614. According to Lord LYNDEHURST'S remark in *Househill Co. v. Neilson*, already quoted, "The first person who discloses the invention to the public is the first inventor." No reason can be suggested why this construction was not contemplated by those who framed the Act of 1836, and why it was not intended to be embodied in it as much as the construction upon another point adopted by Lord COKE. Such indeed has been the import attached to the phrase by our own courts. A large portion of the reasoning of the court in *Gayler v. Wilder* is addressed to this very subject, and is intended to show that it is not to be interpreted literally, but is to be applied properly to the one who brings a discovery to the knowledge of the public. How common it is to attach this meaning to the phrase may be seen on recurring to the extracts which have been given from the decisions in *Symour v. Osborne*, ante p. 617, *Washburn v. Guild*, p. 655, *Aquawam Co. v. Jordan*, p. 657, *Whitely v. Swayne*, p. 633, and *Singer v. Walmsley*, p. 672. Another may be added on account of its especial pertinency from the decision of Judge HALL in *Ransom v. Mayor*, 1 Fish. 252. "If the plaintiffs did not use reasonable diligence to perfect the invention patented after the idea of it was first conceived, and in the meantime other persons not only conceived the idea, but perfected the invention, and practically applied it to public use before the invention of the plaintiffs had been so far perfected that it could be applied to practical use, the plaintiffs' patent is void, because they were not the first and original inventors of the thing patented." p. 272.

Another thing which seems to have had its influence in leading Judge STORY to his conclusion, is the provision contained

in the Acts of 1793 and of 1836, for determining controversies between two conflicting applications. This introduced into our system a feature undoubtedly new, though since adopted to some extent in that of Great Britain. But it went no further than to settle the contest between two competitors, and to provide means for ascertaining which is entitled to the patent. It introduced no change in the principles upon which priority of invention is to be determined. That is left to be ascertained by the same criteria as in a trial at law upon the validity of a patent. There is not a word in either of the statutes that countenances the idea that by a prior inventor is meant anything else than the person who shows that he is the man whom the courts would adjudge to be the rightful patentee; not a syllable that countenances the supposition that the person intended is he who has conceived the invention, but has never reduced it to practice, whatever progress he has made short of that toward perfecting it.

We fail, therefore, to discover in what was alleged by Judge STORY or in any other quarter, the slightest reason for dispensing with what is manifestly an essential feature in any well-regulated patent system, and one which has been commended to us by the long experience of the oldest one known, that of Great Britain. It is the system which our legislature adopted, and there is no indication that they did not intend to embrace this principle as well as the rest. The whole spirit of both seems to require that inducements should be held out not merely to prosecute new inventions, but to bring them before the world. The rewards each holds out are intended for these who give their fellow-citizens the fruits of their ingenuity, and it is an entire perversion to put such a construction on our legislation as bestows those rewards on the man who withholds them from his country.

In short, it defeats the principal object of requiring that the former embodiment of an invention should have been put in use in order to invalidate a patent, which is that the public should obtain a knowledge of it. That such is the real object cannot be reasonably doubted, and should not be forgotten. But to secure it the use must manifestly be a public one. To require that it should have been in use, yet allow a use in private to satisfy the requirement, involves an absurdity.

Some scruple has been expressed (by DALLAS, J., for instance, in *Hill v. Thompson*, W. P. C. 239) as to the power of the State to deprive a man of the privilege of using anew a device which he had discovered before the patentee, and had in actual use. No one ever thought, however, of its being

wrong to deny such a privilege to the person who makes the same discovery afterward, though his discovery is an independent one. Yet he has just as good a title to the products of his ingenuity as the one who anticipated the patentee. The mere invention, or discovery, of the new idea gives no exclusive right to it. It is the statute alone that vests the title in the original inventor. And it vests it in him from whom the country obtains the benefit of it; she has no rewards for any other. Whatever inchoate interest the original discoverer may be supposed to have must give way to the right, akin to that of eminent domain, under which the State appropriates the discovery by whomsoever made, and vests it exclusively in that inventor to whom the public is indebted for making it known. And the rights of one who made the discovery before him are no more sacred, and can no more prevail against this action, on the part of the State, than the rights of him who makes the discovery afterward.

To sum up this discussion, the following are the conclusions at which we arrive:

1. Before an invention can be considered as having been so reduced to practice as to give its author, without further effort on his part, an irrefragable title to it, if duly asserted, it must have been embodied in a practical working machine, capable of being operated to perform its intended functions for business purposes. If not capable of such embodiment, it must have been brought to an equivalent state of perfection in some other way. Upon this point there is no conflict in our judicial tribunals.

2. The weight of the authorities is decidedly in favor of requiring that such machine should have been put in actual use for business purposes.

3. While, upon principle, it would seem that such use should be in public, it must be confessed that many of the decisions recognize a private use as sufficient.

Such are the results which seem necessarily to follow from a somewhat extensive examination of the reports, although they are not altogether such as were anticipated, nor such as commend themselves to the judgment. No one will be more gratified than the writer should it be found, upon a thorough study of the cases, that they should be modified in essential particulars.

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