8FED.CAS.—55

Case No. 4,562.

EVANS v. HETTICK.

[3 Wash. C. C. 408;[1] 1 Robb, Pat. Cas. 166.]

Circuit Court, E. D. Pennsylvania. Oct. Term, 1818.[2]

PATENTS—RIGHT TO A PATENT—SPECIFICATIONS—CONSTRUCTION—WHETHER FOR IMPROVEMENT OR WHOLE MACHINE—INTERESTED WITNESS—DEPOSITION.

1. Action for an infringement of the plaintiff's right to the hopperboy, described in his patent. Evidence was allowed, on the part of the plaintiff, of his declarations in a particular year, that he had discovered and constructed the machine patented, all the parts of which he described. This evidence was admitted to prove, not that the plaintiff was the discoverer, but that he then asserted such a right, and described the machine.

2. A witness who had in use such a machine as that used by the defendant, and who, with other persons sued in similar actions with the present, had contributed a common fund, to defray the expenses of their witnesses in attending to the suits, was allowed to testify on the part of the defendant in this case. Between the contributors there was no agreement to participate in paying the damages or costs, which might be recovered against either of them in the actions. A verdict in this case, would not avoid the plaintiff's patent; and therefore, the witness had no interest in this case.

3. The counsel for the plaintiff, cannot ask the witness, if Jacob Stouffer had applied to the plaintiff for a license to use his improved hopperboy, and had offered to pay for it; it not being proved that Jacob Stouffer had a hopperboy of any kind, or had ever used one.

4. The court would not allow a witness to depose what he had heard said in the family of Stouffer, as to the Stouffer hopperboy being so called; it being merely hearsay evidence.

5. A deposition of a witness residing in this state, above one hundred miles from the place of holding the court, taken under a rule entered by the plaintiff in the clerk's office, but not in conformity with the requisitions of the 30th section of the judicial act [1 Stat. 88], cannot be read in evidence.

[Cited in Allen v. Blunt, Case No. 217.]

[6. Cited in Rhoades v. Selin, Case No. 11,740. Disapproved in Patapsco Ins. Co. v. Southgate, 5 Pet. (30 U. S.) 616; approved in Allen v. Blunt Case No. 217,—to the point that a deposition taken out of the district where the trial is had is inadmissible as evidence. Such testimony must be taken under a commission issued for the purpose.]

7. An examination of the law in relation to the taking of the depositions of witnesses, residing above one hundred miles from the place of holding the court.

8. A deposition having been read without objection, cannot be afterwards rejected and withdrawn, because the court, subsequently, refused to allow a deposition to be read, on account of an exception which would also have excluded the deposition which had been read, had it been objected to.

9. What questions cannot be put to a witness called as rebutting evidence.

10. Interest in a witness, short of that which would exclude him on the ground of incompetency, how far it should weigh.

11. If the patent and specification do not state in what the improvement consists, in full, clear, and exact terms, where the patent has been granted for an improvement; the plaintiff cannot recover for an alleged violation of it.
12. Oliver Evans's patent for the improved hopperboy, is not an exception from the general rule, either by force of the private act, under which the patent was granted, or the decision of the supreme court, in the case of Evans v. Eaton [3 Wheat. (16 U. S.) 454].
13. Oliver Evans's patent is not for the whole hopperboy,—whether he was the original inventor of it or not; nor does the opinion of the supreme court, in Evans v. Eaton, sanction such a claim.
14. Unless Oliver Evans shows himself to be the original inventor of the hopperboy, he can claim no right in virtue of the grant made to him by the act of assembly of Pennsylvania, passed in 1787.
15. The plaintiff cannot object to the originality or priority and use of another machine, alleged to have been similar to his own, on the ground that it had gone into disuse, or was not notoriously in use; since it is essential to his case, to prove he was the original inventor of the machine for which he has a patent.

[Cited in Whitney v. Emmett, Case No. 17,585.]

Action for an infringement of the plaintiff's right to the hopperboy, described in his patent. Plea, not guilty, and notice of special matter, under the sixth section of the act of congress [of 1793 (1 Stat. 322)], relative to patents. The evidence was the same as in the case of Evans v. Eaton [Case No 4,559], save that David Aby, one of the defendant's witnesses, said the hopperboy used by the defendant was the Stouffer hopperboy.

The following exceptions were taken to the evidence:—

1. By the counsel for the defendant, who objected to those parts of the deposition of Enoch Anderson, in which he states, "what the plaintiff told him in the year 1783, relatives a discovery, which he contemplated, and was bringing to perfection, for an improvement in the manufacture of flour; in which conversation, he described the different machines for effecting that purpose, and amongst others the hopperboy."

BY THE COURT. Although the information respecting this discovery came from the plaintiff, it is nevertheless a fact, that the disclosure was made at a particular period, and the evidence to prove that fact is unexceptionable. The question is, when was the discovery made? If the plaintiff told the witness, in 1783, that he had made it, and described it, which the witness says he did; then it is clear that he made it at that time, or at least supposed he had done so. This is all that it proves. It does not prove that he was the discoverer, but that he said he was so, at that time.

2. David Aby was called as a witness by the defendant, who, it was admitted, used a hopperboy similar to that for the use of which, by the defendant, this suit was brought. Upon his examination, on his voir dire, he stated; that he, together with six other persons, defendants in suits now depending in this court for infringements of the patent on which this action was brought, agreed to contribute a fund, to defray the expenses of this witness in coming to Philadelphia, remaining here, attending to the business of these suits, and returning; and that the agreement extended no further.—That all the counsel fees had been

paid; and there was no engagement to pay more; and the agreement did not extend to a contribution to damages or costs, either in the circuit court, or in the supreme court of the United States. If he should, while attending on the trial, advance money for any purpose besides his own personal expenses, the contributors were not bound by the agreement to reimburse him.

The witness was objected to, by the counsel for the plaintiff, on the ground of incompetency. 1st Because the tendency of his testimony was to disprove the originality of the plaintiff's invention of the hopperboy, for which he has a patent; and consequently, to induce its avoidance by the judgment of the court, of which the witness could avail himself when the trial of his own case should come on. 2d. Because the witness was a contributor to a general fund, for the expenses of this, as well of his own suit; and stood in the condition of the insured, under a consolidation rule, or of a commoner.

The following cases were cited: 1 Phil. Ev. 34, 43, 44, 49, 50, 95, note, 53, 51, note, 45, 46, note, 42; 5 Johns. 258; 1 Mass. 239; 1 Caines, 378; 2 Day, 472.

WASHINGTON, Circuit Justice. The plaintiff's claim is to an improved hopperboy. If that which the defendant and the witness uses, be not that machine, there is no reason, in point of law, why the witness and the defendant may not each use the machine, which they have, without offence to the plaintiff. It is sufficient for the defendant, on the general issue, to prove that he is not guilty of using the plaintiff's improved hopperboy; although he should use some other machine called by that name, and possessing similar properties with those of the improved hopperboy; and a verdict in his favour, upon that issue, can in no respect produce the destruction of the patent; because the originality of the invention is not in issue on the plea of not guilty; consequently the witness, who owns a hopperboy similar to the defendant's, may have his wishes, but he has no interest dependent upon the event of this cause.

2. The agreement, which is the foundation of this objection, is for a contribution to a general fund to be used in defraying the expenses of this witness, as an agent to attend to the causes in which the contributors are defendants, and as a witness in these causes; but the witness has distinctly stated, that the fund is not pledged, or intended to answer for damages, or costs, in this or in

a superior court; and that the agreement in no respects binds the parties to it, to participate in any loss, which either or all of them may sustain; or in any gain, which may result from a successful termination of the suit. Where then is the interest which can disqualify him as a witness? It must be an interest in the event of the cause;—so much money has already been contributed, and placed in the witness's hands, to defray his expenses. If it should exceed his wants, he will have to refund the overplus to the other contributors, retaining his own seventh part; and if it should fall short of supplying his wants, his associates may be bound in honour, at least, to make up the deficiency; but the fund already raised, must be applied to the objects contemplated by the parties, whatever may be the event of this suit, not dependent on that event, but in virtue of the agreement. If the parties are bound by that agreement, to contribute a larger sum in order to defray the expenses of this witness, they must in like manner do so; not as a consequence of the event of this suit, one way or the other, but because the agreement has bound them to do so; and even if the witness had a power, under that agreement, to increase the fees of counsel, and to incur any other expense, on account of these suits, the legal result would be the same; because the creation of these charges upon the fund raised, or to be raised, and their discharge, would be precisely the same, whether the plaintiff or defendant should gain the cause. If the former should happen, the defendant would have to pay the plaintiff his costs; but for which, neither the fund raised, nor the other contracting parties, are bound to contribute one cent. If the latter should take place, the defendant would recover his costs of the plaintiff; in which the other parties to the contract, are not entitled, by the terms of it, to participate. So that it is plain that the witness has not a shadow of an interest dependent on the event of the suit; and he is therefore competent to give testimony.

The counsel for the plaintiff, tendered a bill of exceptions to this opinion.

3. The witness, David Aby, was asked, upon his examination in chief, by the defendant's counsel, if the hopperboy used by the defendant was like the model of the plaintiff's hopperboy, then in court? This was objected to; but THE COURT decided that the question was proper; and the counsel for the plaintiff took an exception to the opinion of the court.

4. Philip Frederick, was examined on his voir dire; and stated that he has in his mill what is called a Stouffer, or S hopperboy, which he described. He was also asked by the defendant's counsel, where was the first hopperboy he had seen—both of these questions were objected to by the plaintiff's counsel; and the same objections to the competency of the witness were made, on a similar ground, as to Aby's; all of which objections were overruled, and the opinions of the court were excepted to.

5. Joseph Evans was asked by the plaintiff's counsel, if Peter Stouffer and Jacob Stouffer, offered to take from him licenses to use the plaintiff's hopperboy, and to pay for the same? This was objected to; and THE COURT was of opinion, that the question was

improper, as it had not been proved, that Peter Stouffer and Jacob Stouffer used, or had in their mills, a hopperboy of any kind; and the opinion of the supreme court, in the case of Evans v. Eaton [3 Wheat. (16 U. S.) 454], is confined to the case of an offer made by a person having a hopperboy.

WASHINGTON, J., stated that he was not willing to go a step further than the supreme court had gone, in admitting such evidence. Upon the authority of Evans v. Eaton, we have admitted evidence of Daniel Huston's offer to purchase a license from the plaintiff; because it appears, that he uses a hopperboy, and did so when the offer was made. This being the opinion of the court, an exception was taken to it by the plaintiff's counsel.

6. Christian Markle, was asked by the plaintiff's counsel, to state what he had heard from the different members of the Stouffer family, as to the S hopperboy being called the Stouffer hopperboy.

THE COURT decided that this question was improper. The persons from whom the witness received information on this subject, ought to have been called on to give it on oath, and in a regular way. The attempt now is to introduce mere hearsay evidence, of what others told the witness as to the reputation of the name and invention of the machine.

7. Michael Former's deposition, taken under a rule entered by the plaintiff in the clerk's office, was offered by the plaintiff, and objected to, on the ground, that the place of residence of the witness is in the district, and more than one hundred miles from Philadelphia; and the requisites of the 30th section of the act of congress, passed September 24th, 1789, not having been observed, neither did the case come within the provisions of any of the rules of the court.

The counsel for the plaintiff, insisted, that the practice of the court had always been contrary to what is contended for on the other side.

WASHINGTON, Circuit Justice. What has been the practice in relation to this matter, is unknown to the court; it certainly has not received our sanction, by any one decision. If the practice be contrary to the act of congress, it ought to be, at once, put an end to. Even a positive written rule of this court, repugnant to that law, would be void.

The question is, whether, under the act

of congress, and the rules of this court consistent therewith, this deposition can be read; and this may be as fair an occasion as any that can occur, to examine and to decide this subject, that the practice of taking depositions in and without the district, may be laid down and pursued, so as to prevent future mistakes.

By the act of congress of the 24th of September, 1789 (section 30th) it is enacted, that "when the testimony of any person shall be necessary, in any civil cause depending in any district in any court of the United States, who shall live at a greater distance from the place of trial than one hundred miles, or is bound on a voyage to sea, or is about to go out of the United States, or out of such district, and to a greater distance from the place of trial than as aforesaid, before the time of trial, or is ancient or very infirm, the deposition of such person may be taken, de bene esse, before any justice or judge of the courts of the United States, or before any chancellor, justice, or judge of a supreme or superior court, mayor, or chief magistrate of a city, or judge of a county court, or court of common pleas, of any of the United States, not being of counsel, or attorney to either of the parties, or interested in the event of the cause; provided that a notification from the magistrate before whom the deposition is to be taken, to the adverse party, to be present at the taking of the same, and to put interrogatories, if he think fit, be first made out and served on the adverse party or his attorney, as either may be nearest, if he is within one hundred miles of the place of such caption, allowing time for their attendance, after notification, not less than at the rate of one day, Sundays exclusive, for every twenty miles travel. And in causes of admiralty and maritime jurisdiction, or other cases of seizure, when a libel shall be filed, in which an adverse party is not named, and depositions of persons circumstanced as aforesaid, shall be taken before the claim be put in, the like notification as aforesaid, shall be given to the person having the agency or possession of the property libelled, at the time of the capture or seizure of the same, if known to the libellant. And every person deposing as aforesaid, shall be carefully examined and cautioned, and sworn or affirmed to testify the whole truth; and shall subscribe the testimony, by him or her given, after the same shall be reduced to writing, which shall be done only by the magistrate taking the deposition, or by the deponent, in his presence. And the depositions, so taken, shall be retained by such magistrate, until he deliver the same, with his own hand, to the court for which they are taken, or shall, together with the certificate of the reasons, as aforesaid, of their being taken, and of the notice, if any given, to the adverse party, be by him, the said magistrate, sealed up and directed to such court, and remain under his seal until opened in court."

The rules of court applicable to the matter, were framed at different times by this court, for the purpose of regulating its practice. The first bears date on the 23d of May, 1805, and provides that a party may take depositions of witnesses, being within one hundred miles of the place of holding the court, by entering a rule in the clerk's office, giving

a reasonable notice, which in no case need exceed ten days, to the adverse party, if living within one hundred miles; otherwise to him or to his attorney, of the time and place of taking such depositions; and the deposition is to be forthwith filed, and is to be considered as taken de bene esse.[3]

The next rule, relating to this subject, was made on the 13th of May, 1814; and declares, "that a rule to take depositions on notice given, shall be confined to taking them within the district, unless otherwise agreed; and if taken by agreement, out of the district, the description of judicial character, before whom it is agreed to be taken, shall be designated in the rule; and all depositions are to be considered as taken de bene esse, if the place of caption be within the reach of the process of the court.[4] The act of congress must necessarily be so construed, as to confine its operation to depositions taken within the district where the witness lives, more than one hundred miles from the place of trial; because, the process to compel the attendance of witnesses, could run to any greater distance within the district; and on that account, the deposition is to be de bene esse. But a subpoena could not, at that time, run into another district. The act which declared that such process for witnesses to attend in one district, might run into any other district, provided, that in civil cases, the witnesses do not live more than one hundred miles from the place of holding the court, did not pass into a law, until the 2d of March, 1793 [1 Stat. 335]. But this act, It is conceived, could not affect the construction of

that of September 1789, before mentioned; because, otherwise, this absurdity would follow, that a deposition, taken de bene esse, might be taken of a witness living in another state, at any distance from the court or even beyond seas: because, they would live, within the words of the law, more than one hundred miles from the place of trial. Besides, it would have been something like a legal solecism in the act of 1789, to declare a deposition taken out of the district, to be de bene esse, when the party had no means to compel the attendance of the witness. The act of 1789, being confined to depositions of witnesses living within the district, but beyond one hundred miles from the place of trial, the rules above noticed, were framed in order to provide for cases not within the law; that is, where the witness lives within the distance of one hundred miles from the place of trial; and whether within or without the district, or in the Words of the rule, "within the reach of the process of the court." These depositions may be taken on rules entered during the session of the court, or in the clerk's office, in vacation. But in either case, unless the rule specify that the deposition is to be taken without the district, it is to be confined to witnesses living within it; and such special rule, to extend to witnesses out of the district, must be made by agreement of the parties; and the character of the person taking it must be designated in the rule; and all such depositions are to be de bene esse.—This opinion is not to be construed to exclude cases of depositions taken differently from what the law or rules prescribe, under the agreement of the parties, or any special rule of the court, in any particular case.

Under either rule, reasonable notice of the time and place of taking the depositions, must be served on the adverse party, if living within one hundred miles; otherwise, upon him or his attorney; not only because this is reasonable and consistent with the spirit of the law, but because it is required by the rule of the 23d May, 1805. Where witnesses live out of the district, and more than one hundred miles from the place of trial, their depositions, if taken, must be under a commission, and will, of course, be absolute. Although the point now in controversy relates only to depositions taken without commissions, it may not be improper, in this place, to record two other rules of the court upon the subject, in order that the whole may be brought into one view. The rule of the 23d May, 1805, provides, that "a rule for a commission to any of the United States, or foreign parts, shall be of course, and may be entered, by either party, in the clerk's office. But the interrogatories must be filed in the office at the time; a copy thereof, and written notice of the rule, and of the names of the commissioners, to be served on the adverse party, fifteen days, at least, before the commission issues, in order that he may file cross interrogatories, and name commissioners on his part, if he pleases." The rule of the 27th April 1811, declares, "that a copy of the interrogatories, and written notice of the rule to issue a commission, and of the names of the commissioners, may be served either on the adverse party, or his attorney."

8. As soon as the opinion on the last point was delivered, the plaintiff's counsel moved the court to reject the deposition which had been read in evidence by the defendant's counsel, in the course of the trial, on the ground that this witness resided in Pennsylvania, more than one hundred miles from this city.

BY THE COURT. The deposition was read in evidence, without objection; and it is now too late to make an objection to it.—To this opinion an exception was taken, by the counsel for the plaintiff.

9. Philip Frederick, who was called by the defendant, to rebut what Joseph Evans, one of the plaintiff's witnesses, who had been examined to rebut the defendant's testimony, relative to an application, deposed by Joseph Evans to have been made to him by Frederick, to purchase a license from the plaintiff; was asked by the plaintiff's counsel, on his cross examination, "if Daniel Stouffer (one of the defendant's witnesses) was subject to fits of mental derangement?"

This was objected to and overruled by THE COURT, as improper to be asked in this stage of the cause. If allowed, the whole case might be opened to a new examination of the witnesses, to draw forth testimony which might have been obtained on the primary examination of the witnesses. The question, THE COURT observed, is not warranted by any thing which has fallen from the witnesses since the defendant closed his testimony, a part of which was Daniel Stouffer's deposition.

Ingersoll, Rawle, and C. J. Ingersoll, for plaintiff, contended,—

1. That the plaintiff's rights under his patent, are to the machine called the hopperboy, and also to his improvements on that machine; and that these rights have received the sanction of the supreme court, in the ease of Evans v. Eaton, 3 Wheat. [16 U. S.] 517. Consequently, that if the jury should be of opinion that the plaintiff's improvement on the hopperboy has not been used by the defendant, still, the plaintiff is entitled to a verdict, if the jury should be of opinion, that the defendant has used the plaintiff's hopperboy, without his improvement.

2. That upon the evidence, it does not appear, that what is called the Stouffer hopperboy, was discovered and used before the plaintiff's discovery in 1783; and that in fact, it is only an humble imitation of the plaintiff's invention, though the same in principle; and although the jury should, upon the evidence, be of opinion, that the Stouffer hopperboy was invented, and even in use in one or two

mills, still, this would not be such a use as the law intends, not being public, and generally known to be in use, so as to charge the plaintiff with notice of it; and that this was the kind of notoriety which attended this hopperboy, is evident, from the circumstance that it was never heard of by the many witnesses produced by the plaintiff, some of whom had travelled through the state before and since 1783.

3. That the effect of the act of the assembly of Pennsylvania, granting to the plaintiff an exclusive right to his hopperboy, amounted to a grant of the hopperboy then in existence; (should the jury believe, that the Stouffer hopperboy was in existence and use prior to the plaintiff's discovery,) the same being then the property of the public; it being competent to the legislature to make such a grant.

4. That the Stouffer hopperboy, if invented and used prior to the plaintiff's discovery, fell into disuse; and if the jury should be of that opinion, then a prior discovery and use of that hopperboy, will present no objection to the plaintiff's patent, as an original discoverer.

5. That though the jury should be of opinion, that the plaintiff is not the original inventor of the hopperboy, still, the defendant would not be entitled to a verdict. The defendant's counsel relied upon the opinion of the supreme court in Evans v. Eaton, 3 Wheat. [16 U. S.] 519, which states, that there is error in the charge of this court, in saying, "that the said Oliver Evans was not entitled to recover, for the hopperboy in his declaration."

Binney, Sergeant and Joseph R. Ingersoll, for defendant, contended:—

1. That the patent does not grant to the plaintiff, any thing more than the general result of the combined power of the different machines, and the several improved machines, or in other words, his improvements on these several machines; the supreme court having decided, that these expressions import substantially the same thing. This construction has received the sanction of the supreme court, as appears from the whole course of the reasoning of the chief justice, in the case of Evans v. Eaton [supra]. This right to the improved hopperboy, is asserted by Mr. Harper, the plaintiff's counsel in that cause; and the claim to the hopperboy itself, is distinctly disavowed by him. A patent to the same person, for an original invention, and also for an improvement on it, would be a legal absurdity, altogether inconsistent with the provisions of the patent laws. The petition and affirmation of Oliver Evans, confine his discovery and patent to his improved hopperboy; and he could not obtain a patent broader than his petition and affirmation, filed in the patent office.

2. If the rights of the plaintiff be those which his counsel contend for, still, in relation to his claim for a violation of his improved hopperboy, he cannot have a verdict; because the nature of his improvement is not stated in his specification. No evidence has been given to the jury, to prove what these improvements are, nor have the counsel pretended to point them out. But it is essential to the validity of the patent that they should ap-

pear in the specification, as required by the 3d section of the patent law [1 Stat. 318]. The supreme court in Evans v. Eaton, 3 Wheat. [16 U. S.] 518, confirms this doctrine. But, even if the plaintiff had shown in what his improvements consist, he cannot recover against this defendant since it is in evidence, that he uses only the original Stouffer hopperboy.

3. The plaintiff cannot recover as an original inventor of the Stouffer hopperboy; the evidence proving, incontestably, that the Stouffer hopperboy was discovered, and in use,—in public use,—though this is not required by the law,—in many mills, long prior to the year 1783, the earliest period of the plaintiff's invention contended for even by himself.

4. There is no evidence that the Stouffer hopperboy ever sunk into disuse; but if that were proved, still it could not be patented by the plaintiff, as he could not swear that he was the first inventor.

WASHINGTON, Circuit Justice (charging jury). After stating the evidence on both sides, the facts intended to be proved by the evidence given in this cause, may be arranged under the following heads:—1. Such as respect the value of the plaintiff's hopperboy. 2. The time of its discovery. 3. The kind of machine used by the defendant 4. The time of its discovery and use.

First. As to the first, the court has no observations to make, except that if you should find a verdict for the plaintiff, you will give the actual damages which the plaintiff has sustained, by reason of the defendant's use of his invention, which the court will treble.

Second. The evidence applicable to this head, if believed by the jury, proves, that in 1783, Oliver Evans communicated his investigation of the subject of an improvement in the manufactory of flour; and, in the summer of the same year, declared he had accomplished it. In 1784, he made a model of his hopperboy, which had no cords, weights, or pully; and, consequently, the lower arm was, for the sake of experiment, turned by the hand. In 1785, it was in operation in a mill, in as perfect a state as it now is.

Third. If the witness, who has been called to prove the kind of instrument used by the defendant, is believed by the jury—it consists of an upright square shaft, with a cog-wheel that turns it; and which is moved by the water power of the mill. This shaft is inserted into a square mortice in an arm or board, somewhat resembling an S., with strips of wood fixed on its under

side; and so arranged, as to turn the meal below it, cool, dry, and conduct it to the bolting chest. This arm slips with ease up and down the shaft, and must be raised by hand, and kept suspended, until the meal is put under it. It has no upper arm, pulley, weight, or leading lines; and the strips below the arm, are like the rake, as it is called, in the plaintiff's hopperboy. The machine bas acquired the name of the S, or Stouffer hopperboy.

Fourth. The witnesses examined, to prove the originality and the use of the defendant's hopperboy, if believed by the jury, date them as early as the year 1765; and its erection and actual use, in many mills, in 1775, 1778, and progressively to later periods.

Objections have been made on each side, to the credit of some of the witnesses who have been examined on the other side; not on the ground of want of veracity, or character, but of interest short of that which can affect their competency. These objections have been pressed so far beyond their just limits, as to require from the court an explanation of their real value. Where the evidence of witnesses, opposed by other witnesses, is relied upon by either side to prove a particular fact, the jury must necessarily weigh their credit, in order to satisfy their own minds, on which side the truth is most likely to be; and, in making this inquiry, every circumstance which can affect the veracity of the witnesses, whether it concern their moral character, or arise from some interest which they may have in the question; or from feelings and wishes favourable to one or other of the parties, should be taken into the calculation. But, if the fact in controversy may exist, without a violation of probability, and the proof is by witnesses exclusively on that side; there is nothing to put into the opposite scale, against which to weigh the credit of these witnesses; and, if the objection to their credit be worth any thing, it must be to the full extent of rejecting their testimony altogether, or else it is worth nothing. The jury cannot compromise the matter, or halt between two opinions. They must decide that the fact is so, or is not so; and if the latter, because of objections to the credit of the witnesses, it would amount to a confounding of the questions of competency and credibility; for the effect would be the same, whether the court refused to permit the witness to testify, on the ground of incompetency, or the jury should reject the testimony when given on that of want of credibility. We have thought it proper to submit these general observations to the consideration of the jury.

We come now to the question of law which arises out of these facts, which is:—What are the things, in which the plaintiff alleges, and has proved, an exclusive property, which he asserts the defendant has used, and which he denies? The first claim is for an improved hopperboy, which the plaintiff insists is granted by his patent, which has received the sanction of the supreme court, and which the defendant acknowledges. This then being conceded ground, the court will proceed to examine it; and the inquiry in point of law will be, whether the plaintiff is entitled to a verdict, for an infringement of his patent, for an improved hopperboy? The objection stated by the defendant is, that the plaintiff

has not set forth, in his specification, what are the improvements, of which he claims to be the inventor; so that a person skilled in the art, may comprehend distinctly in what they consist. This objection is, in point of fact, fully supported; neither the specification, nor any other document connected with the patent, states, or even alludes to any specific improvement in the hopperboy. Taking this as true, how stands the law? The 3d section of the patent law declares, "that before an inventor can receive a patent, he shall deliver a written description of his invention, in such full, clear, and exact terms, as to distinguish the same from all other things before known; and to enable a person skilled in the art, &c., of which it is a branch, to make and use the same." What then is the plaintiff's invention, as asserted by the plaintiff, conceded by the defendant, and sanctioned by the supreme court, in the case of Evans v. Eaton? The answer is, an improvement on the hopperboy, or an improved hopperboy, which that court have declared to be substantially the same. If this be so, then the section of the law, before mentioned, has declared, that he must specify this improvement, in full, clear, and exact terms. If he has not done so, he has no valid patent, on which he can recover.

The English decisions correspond with the injunctions of our law. The American decisions, so far as we have any report of them, maintain the same doctrine. Mr. Justice Story, in the case of Lowel v. Lewis [Case No. 8,568], lays it down, that "if the patent be for an improvement in an existing machine, the patentee, must in his specification distinguish the new from the old, and confine his patent to such parts only as are new; for, if both are mixed together, and a patent is taken for the whole, it is void." What is the reason for all this? In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described upon record, that any person, skilled in the art of which the invention is a branch, may be able to construct it. The next reason is, to put every citizen upon his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee, and subjecting himself to the consequences of litigation. The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy the full benefit of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not

chosen to ask for a monopoly, but abandons it to the public, then it becomes public property, and any person has a right to use it. The inventor of the improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine, or by any other person. The rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original invention, and honestly disposed to avoid an infraction of the improver's right, is unable to ascertain from any certain and known standard, where the original invention ends, and where the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another?—and to what acts of oppression might not this lead? Might not the patentee of his mysterious improvement, obtain from the ignorant, the timid, and even the prudent members of society, who wish to use the original discovery, the price he chooses to ask for a license to use his improvement; and in this way compel them to purchase it, rather than incur expenses and inconveniences far greater than the sum demanded would pay for or compensate? If this may happen, then the improver enjoys in a degree the benefit of a discoverer, both of the original machine, and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep all others at arm's length as to the original invention, or make them pay him for it in derogation of the rights of the inventor of the original machine. If this be the law applicable to the cases in general, is this an excepted case? The plaintiff's counsel have not directly asserted it to be so; but they have referred, with some emphasis, to what is said by the supreme court, in the case of Evans v. Baton, 3 Wheat. [16 U. S.] 518. The expressions are, "in all cases where the plaintiff's claim is for an improvement, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject, may comprehend distinctly in what it consists." This decision does not state, in what way the extent of the plaintiff's improvement is to be proved, nor did the case require that the supreme court should be more explicit. The obvious conclusion is, that the court left that matter undecided, and meant that the extent of the plaintiff's improvement should be shown, according to the rules of law; a contrary construction would be most unfair, and unwarranted.

Is it possible to believe, that if the supreme court intended to decide contrary to the 3d section of the patent law, and to the English and American decisions, that this was a case without the influence of that law, and those decisions, such intention would have been expressed in such guarded terms? This cannot be admitted. Neither can the private act for the relief of Oliver Evans, warrant the argument, that this case is freed from the restrictions contained in the 3d section of the patent law; because, except as to the extent of the grant it refers to; and the supreme court, in the case cited, considers it as within the provisions of that law, is it likely that the supreme court could have meant, that the plaintiff might cure the defect of his specification, by proving to the jury in what

his improvements consisted? If so, then as to the present defendant, such an explanation would be unavailing, to save him from the consequences of an error, against which the sagacious wit of man could not have guarded him. He has sinned already, if he has invaded the plaintiff's right; and it is now too late to convince him of his error, if he must be a victim of it, for the want of that light which is now shed upon the act, long after his supposed transgression. But of what avail would this explanation be, after the expiration of the plaintiff's monopoly? The parol evidence given in a court of justice, is evanescent, and affords the most unsafe notice of facts, particularly when they respect matters of art, that can be supposed. What man, who wishes not to invade the plaintiff's patent, would venture to erect a hopperboy, merely from the information which he could gather from this trial? He could obtain none upon which he could safely rely; nor could any artist, after the expiration of the plaintiff's right, be enabled from such a source, to know how to construct this improvement. But, even if the extent of the improvement could be traced in this way, the plaintiff has not attempted to prove it; and what is more, his counsel, although repeatedly called on to point it out, have not attempted to do it. Can the jury, without evidence, and without the aid of the plaintiff or his counsel, say in what these improvements consist? If they had never seen another hopperboy, supposed to be the original, this would be impossible. If having seen the Stouffer hopperboy, they can do so, by comparing with it the plaintiff's improved hopperboy, then the consequence seems to be almost inevitable, that the Stouffer hopperboy is the original one, the point which, under the next head, is denied by the plaintiff. But if the specification had stated in what the plaintiff's improvement consisted, still he is not entitled to a verdict for a violation of that right, unless he has proved, to your satisfaction, that the plaintiff has infringed that right.

Upon the whole, this patent, so far as it is for an improvement, cannot be supported; and as to any claim founded on that right, the plaintiff is not entitled to your verdict.

2d. The plaintiff contends, that he is the original inventor, not only of the improved hopperboy, but of the whole machine;—that his patent grants him the exclusive right to both, and that this claim has received the sanction of the supreme court. Whether, in point of fact, he is the original inventor of

the hopperboy, will be attended to hereafter; neither shall we stop to inquire whether the plaintiff's patent grants him the right; because, if the supreme court has sanctioned the claim, that is law for this court. The part of the decision of that court, relied upon by the plaintiffs counsel, is to be found in page 517, 3 Wheat. [16 U. S.], where the chief justice says: "The opinion of the court, then, is, that Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvement's in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered." It would seem almost impossible to misunderstand, this positive declaration of the court. It appears to be the result of the previous reasoning. It states that the plaintiff may claim: 1. The exclusive use of his improvements and inventions in the art of manufacturing flour. 2. In the several machines which he has invented. 3. In his improvements on machines previously discovered. As to the first, there is no dispute in this cause. The third has been already disposed of. The second is now to be examined.

It is contended, by the defendant's counsel, that this is not the correct construction of this sentence in the decision of the court, because it is inconsistent with the pretensions of the plaintiff's counsel (see Mr. Harper's argument, 3 Wheat. [16 U. S.] 499), and with the course of argument of the chief justice, throughout the opinion which led to the foregoing conclusion. This supposed inconsistency may, in the opinion of this court, be explained by the following observations:—The exceptions taken to the charge of this court, in the case of Evans v. Eaton, were—1st. He stating that the patent of Oliver Evans was only for the combined effect of all the machines mentioned in his patent; and 2d. In directing the jury to find for the defendant, if they should be of opinion, that the hopperboy was in use prior to the improvement alleged to have been made by Oliver Evans. These were the only questions presented to the view of the supreme court, upon which it was deemed proper by that court to give an opinion. The reasoning of the chief justice, therefore, is intended to prove and to correct these errors in the charge, by showing that Oliver Evans was entitled by his patent and the accompanying documents, not only to the general result, but to an improvement on the hopperboy, one of the machines used in combination, to produce that result. If he had regard to an improvement on the hopperboy, this court was clearly wrong, in directing the jury to find a verdict for the defendant, if they should be of opinion, that the hopperboy was in use prior to the plaintiff's improvement; because, it was unimportant who was the original discoverer of the hopperboy, provided the plaintiff had a patent for an improved hopperboy, and the defendant used that improvement; and the charge precluded that inquiry. But whilst the judge aims to prove that Oliver Evans was entitled to this double claim, he does not exclude any other claim. There is one expression, relied upon by the defendant's counsel as having this appearance; but it is more likely that the word relied on is a typographical error, than that the court should

both deny and affirm the plaintiff's right, as an original inventor of the hopperboy. When the court came to state, definitively, what were the plaintiff's claims, under his patent, the whole are distinctly stated. The act "for the relief of Oliver Evans," authorizes a grant to him of his improvement in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements, &c. The court says, 3 Wheat. [16 U. S.] 508, that the application "is coextensive with the act." If, then, in this enumeration of the plaintiff's rights under the patent, that to the machines had been omitted, it might have been supposed, that it was not recognized by that court; and it was consequently introduced in order to prevent a conclusion against its validity, although it had not been brought into view in the previous argument, because a matter not in dispute. This course of reasoning is, we think, strongly fortified by what the court says, 3 Wheat [16 U. S.] 518. "In all cases, where his claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject, may comprehend distinctly in what it consists." Now, if his claim was confined to an improvement, produced by the combined operation of all the machines, and to an improvement in the separate machines, why should the court have stated hypothetically what was to be proved, in case the plaintiff claimed for an improvement? This sentence, following immediately that which has been relied upon by the defendant's counsel, seems to explain it, and to fortify the construction which we have given to it.

Upon the whole, we are of opinion, that the question, who is the original inventor of the hopperboy, is left open by the supreme court, and is now to be decided by this jury. If, then, the jury should be of opinion, upon the evidence, that the hopperboy which the defendant uses, was invented and in use prior to the discovery of Oliver Evans, then your verdict ought to be for the defendant. But to this instruction, there are objections which it is proper to notice. It is contended, that the judgment of the supreme court, in Evans v. Eaton, 3 Wheat [16 U. S.] 519, where it is said that there is error in the proceedings below, in that, in the charge the opinion is expressed that Oliver Evans is not entitled to recover, if the hopperboy in his declaration mentioned, had been in use previous to his alleged discovery, entitles the plaintiff to a verdict; although the jury should be of opinion, that he is not the original inventor of the hopperboy. That the

court did not mean this, is most obvious, from what is said in page 517, that "Oliver Evans may claim the exclusive use of the several machines, which he has invented;" could the supreme court intend to say, immediately after, that he is entitled to a verdict for a machine which he has not invented? Can it be supposed, that the court meant to ride over the third section of the patent law, and set up a different rule to govern this case, without having stated the reasons for so extraordinary a distinction? This is altogether inadmissible.

Another reason may be urged against the conclusion drawn by the plaintiff's counsel, from the judgment, which is this:—The error to be corrected by that part of the judgment relied on, that "the court instructed the jury to find for the defendant, if they should be of opinion, that the hopperboy was in use prior to the invention of Oliver Evans's improvement." Now, the words "in the declaration mentioned," are not in the charge of the circuit court, as stated by the chief justice, which the supreme court proposes to condemn; and it is the insertion of these words into the judgment, which produces all the difficulty. Leave them out, and then the judgment is consistent with the whole reasoning of the chief justice, which condemned the charge of the circuit court; because it precluded Oliver Evans from obtaining a verdict for his improvement, if he was not the inventor of the elementary parts of the machine. Retain them, and it follows, that if Oliver Evans was proved not to be the inventor of the hopperboy, in his declaration mentioned, still, the defendant was not entitled to a verdict. This would be in such direct opposition to the 6th section of the patent law, that we cannot suppose this was the meaning of the supreme court.

2. The next objection to this instruction is, that the act of the legislature of Pennsylvania, conveyed to Oliver Evans the original hopperboy; and consequently, its existence and use, at a period prior to the plaintiffs discovery, cannot now be urged to invalidate his patent. There are two conclusive answers to this argument—(1) That it is by no means to be admitted, that the act operates to make such a transfer; but (2) if it did, still, the plaintiff cannot recover, if he appears not to be the first, or original inventor of the hopperboy. This claim in this action is not derived either from the state, or from an individual. His suit is founded on his patent, and unless he was himself the original inventor of the hopperboy, he cannot recover.

3. Another objection stated by the plaintiff's counsel, is, that the Stouffer hopperboy, although the jury should believe that it was in use, in many mills, before the plaintiff's discovery, had fallen into disuse; and, therefore, it cannot be used to invalidate the plaintiff's right to recover. The answer to this is, that whether it fell into disuse, or not, if it was used before the plaintiff's discovery, the plaintiff could not obtain a patent for it, so as to exclude the defendant from using it, if he chose to do so.

4. The last objection is, that the use of the Stouffer machine, cannot affect the plaintiff's patent, unless it was public, so as to affect the plaintiff, or other inventors, with notice.

Whether that hopperboy was in public use, or not, the jury will judge, from the testimony of the witnesses. It was erected, and used in four or five mills; if the witnesses are believed, who have testified for the defendant, on that point. But this argument has no foundation in the act of congress, which does not speak of public use, of the nature represented by the counsel. It is immaterial, whether the patentee had notice of the prior invention, or not. If it was in use, in any part of the world, however unlikely or impossible that the fact should come to the knowledge of the patentee, his patent for the same machine cannot be supported.

Verdict for the defendant.

{NOTE. This judgment was affirmed by the supreme court in Evans v. Hettich, 7 Wheat. (20 U. S.) 453, Mr. Justice Story delivering the opinion. The affirmance rested chiefly upon the grounds set forth in Evans v. Eaton, 7 Wheat. (20 U. S.) 356. See note to Id., Case No. 4,560.

{Patent was granted to O. Evans, December 18, 1790. For other cases involving this patent, see Evans v. Eaton, Case No. 4,560: Id., 3 Wheat. (16 U. S.) 455, 7 Wheat. (20 U. S.) 356; Evans v. Robinson, Case No. 4,571; Dox v. Postmaster General of the United States, 1 Pet. (26 U. S.) 322; Evans v. Chambers, Case No. 4,555; Evans v. Jordan, Id. 4,564; Id., 9 Cranch (13 U. S.) 199; Evans v. Weiss, Id. 4,572; Evans v. Kremer, Case No. 4,565; Evans v. Hettich, 7 Wheat. (20 U. S.) 453.]

[1] {Originally published from the MSS. of Hon. Bushrod Washington, Associate Justice of the Supreme Court of the United States, under the supervision of Richard Peters, Jr., Esq.}

[2] {Affirmed in 7 Wheat. (20 U. S.) 453.}

[3] April Session, 1805, May 23d. Ordered—That a rule for a commission to any of the United States, or to foreign parts, shall be, of course, and may be, entered by either party in the clerk's office; but the interrogatories must be filed in the clerk's office at the time; a copy thereof, and written notice of the rule and of the names of the commissioners, must be served on the adverse party, at least fifteen days before the commission issues, in order that he may file cross interrogatories, or nominate commissioners on his own part, if he shall deem it eligible.

[4] April Session, 1814, May 13th. Ordered—That a rule to take depositions in any cause, or notice given, be confined to taking such depositions within the District unless otherwise specially agreed. And if taken by agreement, out of the District the description of the judicial character, before such depositions shall be agreed to be taken, shall be designated in such rule. All depositions to be considered as taken de bene esse, if the place of caption be within the reach of the process of this court.