EVANS v. ROBINSON.

Case No. 4,571.

[Brunner, Col. Cas. 400;[1] 1 Car. Law Repos. 209.]

Circuit Court, D. Maryland. 1813.

PATENTABILITY OF INVENTIONS—EXTENSION OF PATENTS—POWER OF CONGRESS—EX POST FACTO LAWS.

1. An inventor of a new and useful improvement on an old principle, whereby it is applied to a new and useful purpose, is entitled to a patent thereon.

2. Congress has the exclusive power to grant patents, and to renew or prolong the time for the continuance of the same.

3. Ex post facto laws are laws which affect solely crimes and criminal cases. The term is not used with reference to laws affecting civil cases.

The following brief statement was furnished to Mr. Oliver Evans by his counsel, for the purpose of exhibiting to the committee of congress appointed on the subject of his patent right. The Hon. Judge Duval in his testimony before the committee of the senate of the United States confirmed it; and has observed that he did not consider the representation so full in favor of Mr. Evans as the evidence warranted.

"At the last (November) term of the circuit court of the United States, Baltimore, several actions came to trial which had been brought by Oliver Evans against different persons for infringing his patent right by using his mill machine without his permission. The millers near Baltimore, with the Ellicotts and Tysons at their head, made a common cause with the defendants. The defense set up was that Evans was not the original inventor of the machines for which he had obtained the patent. To support this defense witnesses were summoned from various and distant places, particularly from the neighborhood of Christiana, in the state of Delaware, where Evans resided at the time when, as he alleges, the invention took place. The causes were twice continued, on the application of the defendants to give them an opportunity of procuring the attendance of all their witnesses. All did attend at the

trial. The machines in question were the conveyor, the elevator, and the hopperboy. Evans' patent included others, but they are not in general use by the defendants. As to the conveyor, the proof was that Johnathan Ellicott, previous to the invention of Oliver Evans, had invented and used a machine something like the conveyor of Evans; but it was proved on the part of Evans that his conveyor differed essentially from that of Ellicott, was an improvement on it, and was much better adapted to the purpose to which Evans applied it. It was also proved that Ellicott had never applied his machine to that purpose until the application was made and practiced by Evans, who, consequently, not only improved the machine in a new and useful manner, but invented a new and useful application of it when so improved, making, thereby, a new and useful improvement in the art of manufacturing flour. The elevator came next in question. Here the defendant gave evidence of various hydraulic machines, something resembling an elevator, that had formerly been used in Europe (or proposed to be) for raising water; but it appeared that none of those machines had ever been applied to the raising of meal or grain, or were fit for that purpose. The elevator of Mr. Evans was essentially different and a great improvement, which not only applied for this new purpose in the manufacture of flour, but was extremely useful for that purpose. They then produced a miller from the state of Delaware, of the name of Stroud, who, after Evans told him grain and flour might be raised by a machine, did in fact make an elevator similar to that of Evans, though not complete. But Stroud declares he never should have thought of it but for the information he received from Evans; and it was proved on the part of Evans that he invented his elevator and made a complete model of it before Stroud's was made. On this head Stroud was so well satisfied that he purchased a license from Evans to use his elevator, together with his other improvements. As to the hopperboy, the defendant gave evidence that some millers in Delaware of the name of Marshall, having heard of Evans' discoveries, which were kept concealed, invented and attempted to use a very imperfect machine for the purpose to which Evans applied his hopperboy. But the Marshalls, who were produced as witnesses, proved that their machine did not answer the purpose on account of several essential defects in its principle and construction, and that as soon as that of Evans, which was very different and very complete, made its appearance, they adopted it by license from him, and threw aside their own. All these machines were admirably combined in an original and useful manner by the patentee.

"The defendants thus defeated on the evidence next attacked the case on the construction, and even the constitutionality of the act of congress {act for the relief of Oliver Evans (6 Stat. 70)}; but the court, composed of Mr. Duval, a judge of the supreme court, and, Mr. Houston, the district judge, decided against them on every point. They then gave up the defense, and confined all their evidence to the mitigation of damages. The jury found a verdict of one thousand eight hundred and fifty dollars for the plaintiff in the first case,

who declined demanding the treble damages allowed by law. The defendants in all the subsequent cases which came to trial, to the number of four, confined themselves entirely to excuses in mitigation of damages. In all the cases there were verdicts for the plaintiff, with ample damages, which gave universal satisfaction. The special act of congress, it will be observed, under which the patent in controversy was granted, gives a right of action against such only as have used, since its passage, or may hereafter use the machines, without having purchased license therefor. All who paid under the former defective patent are expressly protected; nor can there be any recovery for using the machines prior to the present patent, even without having paid for them. The special act is not retrospective in its operation, or in the construction put upon it by the patentee and his counsel.

"Evans, to show the utility as well as the originality of his improvements, produced at the trial many respectable witnesses, and read the following certificate from Messrs. Ellicotts, near Baltimore, the most skillful millwrights and experienced millers in this or any other part of the United States: 'We do certify that we have erected Mr. Evans' new invented mode of elevating, conveying, and cooling meal, etc. As far as we have experienced we have found them to answer every valuable purpose, well worthy the attention of any person, concerned in merchant, or even extensive country mills, who wishes to lessen the labor and expense of manufacturing wheat into flour. John Ellicott. Johnathan Ellicott. George Ellicott. Nath. Ellicott. Ellicott's Mills, Baltimore County, Md., August 4, 1790.'

"Respecting the utility of these machines and improvements, it was fully proved that in a mill which can manufacture twenty barrels of flour in a day they save at least three hundred dollars a year in labor alone; that the operation is more perfectly performed, and with less waste; that more work can be done by the same mill, and a larger proportion of superfine flour produced from a given quantity of wheat, equal to at least fifty cents gain to the miller on each barrel; that the saving on the whole in such a mill, upon the most moderate computation, amounts to one thousand two hundred dollars a year, probably much more; and that no mill without these improvements can be employed in competition with such as have them.

"We were counsel for Mr. Oliver Evans in these cases, and have given this statement

at his request. We certify it to be true, and have no doubt that the judges who heard the cause, if applied to, will confirm it.

"Robert G. Harper,

"Nathaniel Williams.

"Baltimore, January 6, 1813."

The following is a copy of a note addressed by William Pinkney, Esq., attorney-general of the United States, one of Mr. Evans' counsel, to Mr. Williams: "Baltimore, January 12, 1813. Dear Sir—I find the statement signed by you and Mr. Harper relating to the trials at the last session of the circuit court of Maryland, of Mr. Oliver Evans' cases, to be perfectly correct; and you are at liberty to use this note as a proof of my entire concurrence in that statement. I am, dear sir, etc., William Pinkney."

In the progress of this cause the defendant's counsel contended before the court that the letters patent granted in this case were not conformable with the act of congress passed for the plaintiff's relief; that the declaration did not correspond with the proof, as in the construction of the defendant's counsel the breach was alleged to consist in the use of machines, whereas the patent comprehended the discovery of principles as well as machines; that the plaintiff was not entitled to a patent for the conveyor, inasmuch as J. Ellicott had previously invented a screw to mix flour, although the plaintiff's conveyor was differently constructed from Ellicott's and applied to different purposes; that the defendant was not liable to pay for using the machine in question, it having been erected before the passage of the special act, or the grant of letters patent to the plaintiff, and after the expiration of the former letters patent, when it was not unlawful to erect or use the same; and lastly, that the act for Oliver Evans' relief was ex post facto; that it impaired the obligation of contracts, and was therefore unconstitutional, he having obtained letters patent in 1790 for the same improvements which had expired before the act aforesaid was passed, it not altering the case that the first patent was declared judicially to be null and void for defect of form.

THE COURT (DUVAL, Circuit Justice, and HOUSTON, District Judge) declared that the letters patent in controversy were issued conformably to law; that the declaration was good and sufficient to maintain the plaintiff's case established in proof, some of the counts alleging that the defendant used the patented improvements generally, and others part of the improvements; that the plaintiff's conveyor, being a new and useful improvement on the continued spiral screw, and applied to a new and useful purpose, entitled him to patent for his improved conveyor; that the second proviso in the act for Evans' relief, passed January 21, 1808 [6 Stat. 70], protected the defendant from any liability to pay damages for using the machinery without a license previously to the granting of the license, but not for any subsequent use; and that in the opinion of the court the act referred to is not an ex post facto law, for that relates to criminal cases only; that it does

not impair the obligation of contracts, or interfere with any rights previously acquired by the community; that on the contrary, the legislature has evinced its attention to individual rights by exempting, in a special proviso, all persons from the obligation to renew a license purchased under the former patent; that congress have the exclusive right by the constitution to limit the times for which a patent right shall be granted, and are not restrained from renewing a patent or prolonging the time of its continuance; more especially in the present case, where the patent granted in the first instance had been decided by judicial authority to be null and void on account of some defect in the patent.

{NOTE. For other cases involving this patent, see note to Evans v. Hettick, Case No. 4,562.}

[1] {Reported by Albert Brunner, Esq., and here reprinted by permission.}

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