

Case No. 4,578. EVERETT v. THATCHER ET AL.
[2 Flip. 234; 3 Ban. & A. 435; 16 O. G. 1046; Merw. Pat Inv. 254; 7 Am. Law Rec.
197.]¹

Circuit Court, N. D. Ohio.

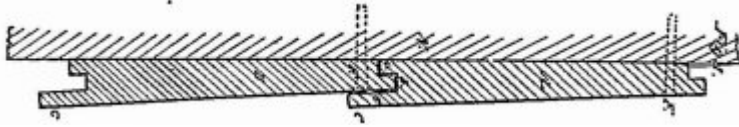
Sept. Term, 1878.

PATENTS—PATENTABILITY OF INVENTION—INSPECTION OF MODEL BY
COURT—EFFECT OF DECREE TAKEN PRO CONFESSO.

1. It is competent for the court to inspect a model exhibited in evidence, and, from such inspection, to decide as to the patentability or the alleged invention.
2. A decree of a circuit court taken pro confesso will not preclude full inquiry and investigation by another court.

In equity. Everett filed a bill in January, 1872, alleging the issue [on May 16, 1854] of a patent to William Baker for a new and improved clapboard joint; that in July, 1869, he acquired the exclusive right to make, use and sell the patent in Logan county; that since that time the defendants have made the patent joint and siding for houses, and that this patent was adjudged valid in the circuit court of the United States for the western district of Pennsylvania in November, 1870, in the case of Anderson v. Schmidt [unreported]. There was a prayer for injunction

and account. The defendants filed an answer, denying that Baker was the first and original inventor; alleging that before May, 1854, the invention was known and used by John Rowze and E. L. Small and by others, and that the re-issued patent of [January 19] 1869 was void because it was enlarged so as to cover matters not embraced in the first issue, and which were previously known and used. Further, the allegation was made that the siding made by defendants was, since 1844, in common use. There was a replication to the answer. The original patent No. 10,903 is to be found in Patent Office Report for 1854, vol. 1, p. 368; and the figure of the patent joint is in volume 11, at p. 43. The re-issue No. 3,268, is set out in volume 11, p. 805, of the Patent Office Report for 1869.



[Drawing published from the records of the United States patent office.]

The claim in this is as follows: "(1) The construction of the joint of clapboards, or jointed siding, for houses and other buildings, in such manner, that the boards when laid on the frame, shall lie flat and solid for their whole width against the frame of the building, and at the same time shall preserve the appearance and advantage of clap-boarding in front by the outer lip of the upper board, at each joint, overlapping outside the board next below it, for shedding the water as described. (2) The combination of the lock a, in the rear of the joint for holding the board to the frame at the lower edge as described with the extended lip C, Fig. 1, in front for covering the head of the nail, as described, the whole being constructed, combined, and arranged substantially in the manner and for the purposes herein setforth." In the schedule Baker claimed that he had "invented a new and useful improvement in the preparation and joining of clapboards, and the siding of houses and other buildings." He further claimed that the siding would "lie flat and solid against the posts and studs of the frame instead of touching the frame at their corners only, as is the case of ordinary clapboarding. At the same time they shall preserve outside the appearance and advantage of clapboarding by the outer lip on the lower edge of each board overlapping the full thickness of the upper edge of the board immediately below it for shedding the water. And second, by extending the outer up of the upper board sufficiently for that purpose, may also cover the heads of the nails by which the boards are fastened to the frame, these being driven near the upper edge of the boards, where a small nail is sufficient, as the boards are thin at this point." The figure intended to illustrate the invention is then described. A number of depositions were taken by defendants which tended to show that ordinary tongued and grooved flooring had been used for weather-boarding houses before the patent; that siding, though not exactly the same, yet similar, had been used by different persons, and specimens were annexed to some of the depositions. A witness testified that he had built a house in 1844 in Hudson, Ohio,

with siding like a specimen produced, the only difference between that and the patented article being in the bevel. The plaintiff read depositions, which tended to show that the specimens produced were different in principle from the patented article.

At the March term, 1878, the case was in part heard, and a portion of the evidence read, when the court intimated an opinion on inspection of a specimen of the siding described in the patent without reference to other evidence, that it was not patentable; but continued the case with leave to file briefs.

Wm. Lawrence and Willey, Sherman & Hoyt, for complainant.

A. T. Brewer and Mr. Kaiser, for defendants.

² [These made the following points:

{Wm. Lawrence, for complainant.

[I. The court cannot on inspection, declare the siding or clapboard joint not patentable.

[1. The letters patent make it prima facie evidence that it is patentable. a. This is the effect of the patent law. Act July 4, 1836, § 15 [5 Stat. 123]; Act. July 8, 1870, § 61 [16 Stat. 208], etc.; *Union Paper Bag Co. v. Newell* [Case No. 14,390]. b. It is on general principles. The law gives the commissioner of patents power to examine applications for issue patents. It presumes he has done his duty. “*Omnia praesumuntur rite et solemniter esse acta*,” etc., is the maxim. It would violate all comity for the court to declare this patent void without evidence. c. It is decided by the courts. *Reckendorfer v. Faber* [92 U. S. 347]; *American Nicholson Pavement Co. v. Elizabeth City* [Case No. 311]; *Stimpson v. Woodman*, 10 Wall. [77 U. S.] 117; *Westlake v. Cartter* [Case No. 17,451]; *Herring v. Nelson* [Id. 6,424]. In this ease the court say the patent is presumed valid, and can only be overthrown by “clear and satisfactory proof.” The court can compare “patent papers,” but can “not compare the patents” in conflicts. *Westlake v. Cartter*

{Case No. 17,451} At most can only “examine models” to understand evidence. *Birdsell v. Hagerstown Agricultural Implement Manuf’g Co.* {Case No. 1,436}. The decision in *Anderson v. Schmidt* referred to in the plaintiff’s bill, though the decree was on default, is a respectable authority. This patent was also litigated in the southern district of Ohio, and no question made as to patentability.

{2. There is neither pleading nor evidence directed to a denial of patentability. The answer practically admits the patentability.

{3. The court has a limited range of judicial knowledge. But this cannot extend to questions of non-patentability on inspection. 1 Best, Ev. (Morgen’s Notes) 1 Am. Ed., from 6 London Ed., § 688; 1 Starkie, Ev. (3d Ed.) 524; Id. (4th Ed.) 816. In *Manley v. Shaw, Car. & M.* 361, a juror who knew a stamp on a bill to be a forgery was not permitted to act on his knowledge, and gave a verdict against his knowledge. It would be hazardous for the court to act on their own knowledge of the art in 1854, when the patent was granted. To do so would deprive parties of the benefit of a cross examination or the right to show the court mistaken.

{II. This siding is patentable. There is no evidence to deny its utility. There is none to disprove its patentability. The evidence all assumes its utility. The authorities show that a new combination of old and long known and used elements is patentable, if it has utility, however slight. Act July 4, 1836 (5 Stat. 118, § 6); *Roberts v. Dickey* {Case No. 11,899}; *Woodman v. Stimpson* [Id. 17,979]; *Forbush v. Cook* [Id. 4,931]; *Clark’s Steam & Fire Regulator Co. v. Copeland* [Id. 2,866]; *Sanford v. Merrimac Hat Co.* [Id. 12,313]; *Hailes v. Van Wormer*, 20 Wall. [87 U. S.] 353; *Reckendorfer v. Faber* [supra]; *Gilbert & B. Manuf’g Co. v. Wal worth Manuf’g Co.* {Case No. 5,418}; *Heide v. Wirtz*, 8 O. G. 817. *Westlake v. Cartter* [supra] holds patent valid, if “in any measure, however slight,” it has utility. *Lynch v. Dryden*, 3 O. G. 407.

{III. The evidence shows the novelty and utility. It has been extensively used all over the country. This proves its utility. The want of novelty is not shown by the evidence that “similar” siding was used before this patent. Similarity is not identity. A bad plow is similar to a good one. The slightest variation in the combination of its parts may give it great utility. Even in a plea of misnomer, in criminal proceedings, the rule is “Similiter sonans non est idem sonans.”

{The Summit county deposition is incompetent: 1. Because the knowledge and use referred to therein are not set up in the answer. *[Seymour v. Osborne]* 11 Wall. [78 U. S.] 517; *[Ex parte McCardle]* 7 Wall. [74 U. S.] 506; *Russell & Erwin Manuf’g Co. v. Mallory* {Case No. 12,166}. 2. Because a specimen of the boards or siding alleged to have been used is not produced. It is better original evidence than the opinion of the witness. It must be produced so other witnesses can give opinion as to it, and so the court can

compare and judge, just as specimens of handwriting must be produced by experts. The witness only testifies to a conclusion, not to a for expert opinion.

{Willey, Sherman & Hoyt, for plaintiff.

{1. The adjudication in Pennsylvania should be conclusive of the validity of the patent, unless impeached, as it is not.

{2. The patent is prima facie evidence of novelty, and this can only be impeached by proof of prior use. The statute contemplates this by requiring notice as to the places where, and witnesses by whom, prior knowledge and use are to be proved. How can the court do what the parties cannot be allowed to do?

{3. Slight invention will sustain a patent. Whether there be invention or not is to be ascertained on proof. To decide on view would imperil inventions of great value where the differences were, perhaps, apparently but slight, or even not perceivable by a hasty glance.

{4. As to utility, the test is whether the thing to be made is useful; of that there can be no question here.

{A. T. Brewer, for defendant.

{I. The patent is void because it claims too much in (1) claiming the feature of laying flat and solid; (2) in claiming the lock a, for holding the boards on the frame, which is as old as common flooring. Patent Act of 1836, § 5460; Act 1837, §§ 7-9 [5 Stat. 191]; O'Reilly v. Morse, 15 How. [56 U. S.] 122. Neglect to file disclaimer a defense. Wyeth v. Stone [Case No. 18,107]; Brunton v. Hawkes, 4 Barn. & Aid. 549; Hovey v. Stevens [Case No. 6,745]; Lowell v. Lewis [Id. 8,568].

{II. Assuming that the bevel shown in Fig. 3 of the specification, is new, it is not sufficient to support a patent. It is a mere change of form. Hall v. Wiles [Case No. 5,954]; Curt Pat. § 50.

{III. The bevel is not new. This is shown by Webb and Coen's rejected application, which is admissible as showing the state of the art. Pettibone v. Derringer [Case No. 11,043]; Vance v. Campbell, 1 Black [66 U. S.] 427. Substantially similar bevels existed before this, which defeats patent. Evans v. Eaton [Case No. 4,560]; Howe v. Abbott [Id. 6,766]; Brooks v. Bicknell [Id. 1,944]; Gorham Co. v. White, 14 Wall. [81 U. S.] 511.

{William Lawrence, in reply.

{The patent is not void because it claims too much.

I. There is no evidence that this form of

siding ever laid flat Ordinary flooring used AS siding did lay flat, but the novelty of this patent is that a siding may lay flat, in which, as the patent claim is, “the outer lip of the upper boards at each joint overlapping outside the board next below it (has the effect of) shedding the water.” Now such a board as this never did lay flat before. How can the court say so without evidence? The same may be said of “lock a for holding the boards in the frame.” Besides, this patent is for an improvement and it is such.

{II. It is said the bevel “is a mere change of form,” not patentable. But the new combination is patentable, as shown by authorities cited.

{At Sept term of court, 1878.

{William Lawrence, for plaintiff (orally).

{The court cannot, on inspection of specimen produced, declare it is not patentable.

{1. All usage is against it. If there be any case where the court has ever done this, I have been unable to find it. I venture to say there is none.

{2. If the patentable product has utility and novelty, it is patentable. Its utility is not denied. It is apparent on inspection. Ordinary clapboards shed water, but they do not lay flat. This does both. Ordinary jointed flooring as siding will lay flat, but it does not shed the water. In this patent the nail heads are covered and saved from oxidation; they are not in flooring or ordinary clapboards. A smaller nail can be used with the patent, because, where the nail is driven, the board is thin. It is the most useful, and most extensively used siding for houses in the whole country. Its novelty is not a question of law, but one of fact. Upon the authorities cited, a new combination of old and well known instrumentalities, if it produce a new or “materially better” effect, is patentable. How can the court know without evidence that prior to the date of this patent this combination had been known and used? The evidence fails to show it. The court cannot know, what cannot be proved. The patent is evidence of the fact that in 1854 this invention had not been previously known or used.

{3. Upon the authorities cited this product is prima facie patentable, and this presumption can only be overthrown “upon clear and satisfactory proof.” When the specimen is produced it is made by law evidence per se of patentability and validity. The patent is perfect infallibility in law until disproved by clear evidence. The knowledge of a judge is not evidence. Evidence can be looked into, questioned, cross-examined. The law, says the court, looking at the specimen, must, in the absence of all other evidence, say “it is patentable.” This legal quality inheres in it as an instrument of evidence. Now to hold that the court can look at it and say it is not patentable, is to affirm that the law may require the specimen to testify patentability and validity, and that the court may declare this testimony not true. It is the duty of the court to say what the law says, not what the court may think.

{4. The law appoints the officers of the patent office as the highest experts known to the law. The court are not presumed to be experts. For the court to declare the judgment of the patent office wrong is to annul the highest experts' evidence by the opinion of those whom the law does not recognize as experts. This judgment of the patent office has been three times declared in 1854, 1863, and 1869. Upon the authority of *Manley v. Shaw*, Carr. & M. Rep. 361, it is the duty of the court to take the opinion of these experts, even if the court, as a matter of fact, know they are wrong.

[5. The court cannot declare the patent void without evidence except by judicial knowledge. Judicial knowledge has never yet been extended to cover the knowledge which experts only have. When or where was it so extended? See Steph. Dig. Ev. 62; *Brown v. Piper*, 91 U. S. 37; 1 Greenl. Ev. § 3, etc. And judicial knowledge has never yet in any book been extended to a question of fact as to the date when a valuable invention was first used.}]³

Before BAXTER, Circuit Judge, and WELKER, District Judge.

BAXTER, Circuit Judge. When this case was before us in March last, we inspected the model of the invention and intimated an opinion adverse to complainant. But his counsel are now insisting that we ought not to base our judgment in this case upon a personal inspection of the model, because they say it is not one of the things of which the court can take judicial notice. The proposition is certainly correct. We cannot take judicial notice of the model, nor have we assumed to do so. The patent is prima facie evidence of its own validity, and if nothing more appeared in the case, we would declare it valid and protect it against infringement. But it is only prima facie good and not conclusive. The responsibility of adjudicating it valid or invalid is with the court, and we must do this upon legitimate evidence legally adduced in the case. The model is competent evidence, and has been exhibited as such by the complainant.

If the court is not authorized to inspect and pass judgment upon it, why is it introduced? It is a prevalent, if not universal, practice for the courts in litigation of this character to examine such models. And why may they not do so? Witnesses may be called to examine models of inventions as experts and give their opinions of their merits. And may

not judges, upon whom the law imposes the duty and responsibility of deciding the question, exercise their natural senses in the same way and to the same extent? It seems to us that judges, sitting in judgment upon the law and the facts, and called upon to decide whether a piece of coin offered in evidence and produced to the court is genuine or spurious, are at liberty to examine the coin for themselves, and apply such tests as are ordinarily applied, and exercise their own judgment in the determination of the question, and in doing so, they would not be exceeding their judicial functions, because the coin thus exhibited is made evidence before them. And if it were made a question of fact, whether a yard-measure produced before a court was greater or less than the legal length, the court would have the right to decide the disputed fact by an actual measurement. And if it is competent for a court to inspect a piece of coin or measure a yardstick offered in evidence, may we not with equal propriety and under the same rules of evidence examine the model exhibited in evidence by the parties to this suit? The decisions of the supreme court afford numerous instances of criticisms of models exhibited before that court. The model offered in this case is not so complex as to be beyond the comprehension of the court. It is simply a piece of weather-boarding, grooved on one edge and beveled on the other. The invention is not such a new and useful improvement in that branch of mechanism as in our judgment makes it patentable. It, therefore, belongs to the public, and we think the complainant has not acquired such an exclusive right as entitles him to the protection of this court.

There is, however, other testimony on file showing the state of the art at the time which supports the view we have taken. But as we are entirely satisfied, from the personal inspection we have made, that the pretended invention is not patentable, we are content to rest our judgment on this evidence alone, and do not, therefore, desire to hear the evidence read. But in order to preserve the rights of defendants, we will consider it as having been read and as a part of the files of the case.

It has been urged that the patent involved has been adjudged valid by the circuit court of the United States for the western district of Pennsylvania, and this adjudication is relied on as authority here. The judgment of that court, if based upon a bona fide contest, and after careful consideration, would be entitled to great respect. But, as we are advised, that judgment was rendered on a pro confesso without answer or hearing, and upon the complainant's statement of his case. Such decrees are rendered upon mere motion, without investigation, and are not such adjudications as to preclude full inquiry by us.

A decree will be entered dismissing complainant's bill with costs.

¹ [Reported by William Searcy Flippin, Esq., and by Hubert A. Banning, Esq., and Henry Arden, Esq., and here compiled and reprinted by permission. Syllabus from 3 Ban. & A. 435; statement and opinion, except as otherwise noted, from 2 Flip. 234.]

² [From 7 Am. Law Rec. 197.]

³ [From 7 Am. Law Rec. 197.]