Case No. 4,975.

FOSTER v. LINDSAY et al.

[1 Ban. & A. 605;[1] 7 O. G. 514.]

Circuit Court, E. D. Missouri. Dec., 1874.

PATENTS—SUIT TO REPEAL INTERFERING PATENT UNDER ACT OF 1870—PLEADINGS—ANSWER.

1. Section 58 of the patent act of 1870 [16 Stat. 207], authorizing a court, in a suit thereunder, to adjudge and declare either of the interfering patents void, in whole or in part, is broader, in its application, than section 16 of the patent act of 1836 [5 Stat. 123]; and under the act of 1870 the court may review both patents on their merits, and decree the cancellation

of either or both on the ground of want of novelty, or any other ground that would, in an action for infringement, affect the validity of either of the patents.

2. The case of Mowry v. Whitney, 14 Wall. [81 U. S.] 434, in which section 16 of the patent act of 1836 was construed, considered and distinguished.

3. In a suit brought under section 58 of the act of 1870, to repeal an interfering patent, a motion was made to strike out such part of defendants' answer as related to an alleged lack of novelty in the invention, covered by complainant's patent, on the ground that the object of the statute was merely to enable the complainant to determine the question of priority as between himself and his adversary, prior to going before the public to test the validity of the patent on its merits: *Held,* that this allegation of the answer was admissible, and the motion was accordingly overruled.

This was a bill in equity, brought under section 58 of the patent act of 1870, for the repeal of certain letters patent [No. 149,589] granted to the defendants [William M. Lindsay and another], April 14, 1874, which were alleged to be for the same invention as was covered by a patent granted to complainant [Alfred F. Foster], May 12, 1874, and, therefore, to constitute an interfering patent The defendants, in their answer, besides denying that their patent was for the same invention as complainant's patent, and alleging that they were prior in date, asserted that complainant's patent was void for want of novelty, and set up alleged anticipations. The case came up upon a motion made by the complainant's counsel, to strike out that part of the answer which alleged want of novelty and the anticipations, as irrelevant and immaterial. In support of the motion, and in behalf of complainant, it was urged that the object of section 58, of the statute, was to enable the patentee to remove the cloud east over his prima facie right, by the improper action of the patent office in granting two patents for the same invention, prior to going before the public to test the validity of his patent upon its merits, and to place himself in the same position, no better and no worse than he would have occupied had the interference been declared and determined, as it should have been, in the patent office; that it was the design of the section, to enable the patentees to determine, between themselves, which was prior in rights, before either should be put to the expense of ascertaining whether his patent was valid as against the world; that, if the construction was otherwise, the patentee would derive no advantage whatever from this section, as he could, without it, in an action for infringement, determine the validity of the respective patents; while, if he was obliged, in an action under the section in question, to establish the validity of his patent, he would be put to the same trouble and expense as in an action for infringement, and at the same time fail to obtain a decree for profits or damages; that the object of the statute was not to provide an additional mode of determining the validity of a patent, since, if it were, there was no reason why it should not apply to the repeal of other patents, as well of interfering patents; that the court could, under the statute, decree the cancellation of either patent, only on the ground that it was in conflict with the other, since the statute makes no provision for cancellation on the ground of want of novelty, or upon any other ground than the existence of the other patent; that the statute provides in terms for the repeal of either of the interfering patents, but not of both; that the statute provides in terms for the defence of want of novelty in an action for infringement, and the fact that it makes no such provision in this case, supports the presumption that it contemplated no such defence; and that the fact that an earlier patent was defective, on grounds extraneous to the patent office record, was no reason why a later patent, which was defective on the very ground, and the only ground to which this statute referred, should not, upon that ground, be cancelled. It was insisted, on behalf of the defendants, that the complainant's right of action, being founded upon the existence of his patent, they were at liberty to attack its validity upon any ground that affected it

Hatch & Parkinson, for complainant.

Kellogg & Holmes, for defendants.

Before TREAT, District Judge.

The court delivered no written opinion, but after stating the nature of the motion, and the character of the suit in which it was made, referred to the 16th section of the statute of 1836 as analogous to the one it was called upon to construe. The case of Mowry v. Whitney, 14 Wall. [81 U. S.] 434, was referred to, as indicating the construction put upon that statute by the supreme court That was a suit in equity for the repeal of a patent, on the ground of fraud in the extension of it, brought in the name of a party who had been sued for an infringement. The supreme court held that "no one but the government, either in its own name or the name of its appropriate officer, or by some form of proceeding which gives official assurance of the sanction of the proper authority, can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual, except in the cases provided for in section sixteen of the act of July 4, 1836;" that under this 16th section the court was only authorized to try the conflicts of claim arising from two interfering patents, and only to annul or set aside one patent so far as is necessary to protect the rights of the other party; that the decree in such a suit, can have no validity, except between the parties to the suit, and that the general public is left to the protection of the government and its officers. The court, after a review of this case of Mowry v. Whitney {supra}, held the statute of 1870 to be broader in its application than that of 1836; that under it the court was authorized to review both patents on their merits, and to decree the cancellation, not only of either, but of both; and that it might do so on the ground of want of novelty in either, or both, or any other ground that would, in an action for infringement, affect the validity of either.

The motion was accordingly, overruled.

{NOTE. Subsequently, both patents were held void for want of novelty. Case No. 4,976.}

[1] {Reported by Hubert A. Banning, Esq., and Henry Arden, Esq., and here reprinted by permission}