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Case No. 10,904.

PEEK ET AL. V. FRAME ET AL.

{5 Fish. Pat Cas. 211.}[1]

Circuit Court, S. D. New York. Dec, 1871.

PATENTS—COSTS WHERE SOME OF THE CLAIMS ARE VOID—DISCLAIMER.

1. The mere fact that the plaintiff has obtained a verdict in an action on the case for the 98 infringement of a patent, is not conclusive that he is entitled to costs; for if the verdict be rendered in pursuance of section 9, Act 1837 {5 Stat. 194}, for the infringement of valid claims, while other claims are rejected as void for want of novelty, the plaintiff can not recover costs.
2. Nor does the fact that, since the verdict, the plaintiff has disclaimed one or more of the claims of the patent, deprive him of his right to recover costs. Such a disclaimer might be a ground for a new trial, but so long as the verdict remains in force the plaintiff is entitled to the benefit of it.
3. A disclaimer is necessary only where the thing claimed without right is a material and substantial part of the machine invented.
4. If the disclaimer be of immaterial matters, it would seem that the filing of it does not affect the plaintiff's right to costs.

{This was an action by Eben Peek and others against John Frame and others.}

Motion for the allowance of costs in an action at law referred to in the report of the case of Peek v. Frame {Case No. 10,903}. It appeared that after the verdict was rendered, the plaintiff had filed a disclaimer to some of the claims of the patent in suit, and it was insisted that this was equivalent to a verdict against those claims upon the trial, which would have deprived the plaintiff of the right to recover costs.

Frederic H. Betts for plaintiffs.

Keller & Blake, for defendants.

WOODRUFF, Circuit Judge. The papers submitted to me are wholly insufficient to show that

the plaintiffs are not entitled to costs herein. The brief of the plaintiffs' counsel recites some facts, but they are not decisive. On the one hand, the mere fact that the plaintiffs obtained a verdict is not conclusive that they are also entitled to costs; for they may have obtained the verdict tinder and in pursuance of section 9 of the act of 1837, which warrants a recovery for an infringement of what is, in fact, new, and claimed as the plaintiffs' invention, notwithstanding the patentee has also, through mistake, without fraud or intent to deceive, claimed something which is not new.

If this verdict was rendered for an infringement of valid claims, and it appeared that other claims were rejected in pursuance of that section, then, although the plaintiffs obtained a verdict, they are not entitled to costs. But if the verdict was, in fact, upon all the claims, in affirmance of the validity of each, and of the novelty of the inventions claimed in each, then the plaintiffs are entitled to costs.

On the other hand, the mere fact that the plaintiffs have, since the trial and verdict, disclaimed one or more of the claims made in the patent, is not alone conclusive that the plaintiffs are not entitled to costs. If the verdict was rendered as secondly above suggested, upon all the claims, affirming their validity, and the novelty of the invention claimed in each, then what the plaintiffs may have said or done, by disclaimer or otherwise, does not deprive them of the effect of the verdict; and so long as it remains in force, not set aside, it is conclusive between the parties. The fact of disclaimer is high evidence, in such case, that the verdict was wrong, and that the plaintiff should only have recovered on the parts of the invention or patent therefor, which are not disclaimed, and such evidence might warrant a new trial. But while such a verdict stands, it is conclusive.

And, finally, there is no evidence before me showing that, under the opinion in Hall v. Wiles [Case

No. 5,954], the disclaimer, or the admission which it imports, would, if made during the trial, have affected the plaintiffs' right to costs. In that case, it is held that a disclaimer is necessary only where the thing claimed without right is a material and substantial part of the machine invented. What has been disclaimed in this case does not appear by the bill of costs, nor by the plaintiffs' brief, and, of course, not by my minutes of the trial, and nothing else is before me.

Precisely what order I am expected to make on these papers is not very clear; but treating the matter as a motion for costs on the verdict, I can only say that no sufficient ground for withholding costs, which ordinarily follow a verdict, appears or is shown. If I could treat it as an appeal from taxation (which it is stated to be in the brief submitted, though the accompanying bill of costs has not yet been taxed), I must then say that no sufficient facts are laid before me to warrant any interference therewith.

[For other cases involving this patent, see note to Myers v. Frame, Case No. 9,991.]

[1] [Reported by Samuel S. Fisher, Esq., and here reprinted by permission.]