SMITH v. HIGGINS.

District Court, S. D. New York. 1857.

PATENTS—COMBINATION—DAMAGES—PRESUMPTIONS—PRIOR KNOWLEDGE AND USE—IDENTITY.

1. Where the right of recovery rests on a combination, the plaintiff must prove that all those parts substantial to their combination 561 have been used by the defendants. The employment of one or more of those parts less than the whole will not constitute an infringement.

2. No precise standard by which damages are to be measured is supplied by the law. The statute gives the patentee his actual damages, but these must be proved; they cannot be presumed. If he fails to give evidence to the point, the jury can award no other than nominal damages.

3. It is exceedingly difficult to give direct evidence of the real amount of damages. Facts, which imply damages, may be regarded as proof of damages, under the restriction that they do not warrant giving presumptive or speculative damages. There must be either positive proof of damages, or facts proved which import the amount proper to be awarded.

4. It is a presumption of law that what the patentee does not distinctly assert to be his invention was known before.

5. It is to be assumed that persons obtaining patents have acquainted themselves with the state of the art in which they are interested as made known in books, or by machines built and put in use, and evidence is not admissible to prove the contrary; nor is it matter of inquiry whether machines described in printed works were ever practically put to use or not.

6. A change in the forms or proportions of instrumentalities—a substitution of one motive-power for another, a different position or gearing of the working apparatus, a superior finish in any other particular, resting in mere mechanical skill or taste, and not involving invention—does not render machines appearing to the eye exceedingly unlike substantially different in judgment of law.

7. As to the question of infringement, it is a standing principle of law that every person is entitled to the free use of whatever was known and used prior to the patent which

attempts to appropriate it as a new discovery; and it is unimportant whether the character and capacities of machinery open to general use are understood or not by the public at large, or had been used by many. It is sufficient to show the public had free means of access to it, and to employ it, and the law then presumes it was well known and in public use.

8. If the thing used by a defendant corresponds substantially with that known and in use before the discovery of the patentee, or described in printed works, then his acts are no infringement of any right of a patentee; and, if the thing used by the defendants and that patented to the plaintiff are substantially alike, the question of infringement will still depend upon the further inquiry whether the patentee was the first and original discoverer of the patented invention.

9. The question of identity is one of fact to be determined by the jury upon the evidence, under the instructions of the court as to what in law constitutes a substantial identity.

10. One machine need not be a perfect transcript of the other, nor correspond exactly in arrangements manner of action, or results. But a patentee is protected against any use of his invention by the employment of means apparently dissimilar to his own, if they possess the same functions, are employed for the same purpose, and embody a common principle.

11. Nor is the substantial identity of two machines established by proof that they bring out the same products, and use the same mechanical powers, and have other resemblances. But in such case the evidence must show that the two are of the same nature and character, and constructed and operated upon a common principle, and to the same purpose.

12. And it is exclusively the province of the jury to ascertain and determine whether the patentee is the original inventor of the invention described in the patent, and whether the patent embraces the thing used by the defendants.

[Cited in Law, Pat. Dig. 190, 239, 284, 337, 364, 439, 457, to the points as stated above. Nowhere reported: opinion not now accessible.]