U.S. Supreme Court

Evans v. Eaton, 20 U.S. 7 Wheat. 356 356 (1822)

Evans v. Eaton

20 U.S. (7 Wheat.) 356

Syllabus

A party cannot entitle himself to a patent for more than his own, invention, and if the patent be for the whole of a machine, he can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation.

If the same combination existed before in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery or some improved mode of operation to the old, the patent should be limited to such improvement, for if it includes the whole machine, it includes more than his invention, and therefore cannot be supported.

When the patent is for an improvement, the nature and extent of the improvement must be stated in the specification, and it is not sufficient that it be made out and shown at the trial or established by comparing the machine specified in the patent with former machines in use.

The former judgment of this Court in the same case, 16 U. S. 3 Wheat. 454, commented on, explained, and confirmed.

A person having an interest only in the question, and not in the event of the suit, is a competent witness.

In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him.

This is the same case which was formerly before this Court and is reported at 16 U. S. 3 Wheat. 454, and by a reference to that report, the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause was now again brought before the Court upon a writ of error to the judgment of the circuit court, rendered upon the new trial had in pursuance of the mandate of this Court.

Upon the new trial, several exceptions were taken

by the counsel for the plaintiff Evans. The first was to the admission of one Frederick as a witness for the defendant, upon the ground of his interest in the suit. The witness, on his examination on the *voir dire,* denied that he had any interest in the cause or that he was bound to contribute to the expenses of it. He said that he had not a Hopperboy in his mill at present, it being then in court, that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia, and that his Hopperboy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the court.

Another exception was to the refusal of the court to allow the deposition of one Shetter to be read in evidence by the plaintiff, which had been taken according to a prevalent practice of the state courts instead of being taken pursuant to the provisions of the act of Congress.

But the principal exceptions were to the charge by the circuit court in summing up the cause to the jury, which it is deemed necessary here to insert at large.

"MR. JUSTICE WASHINGTON. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be,"

"1. For the whole of the machine employed in the manufacture of flour, called the Hopperboy."

"2. For an improvement on the Hopperboy."

"The question is, is the plaintiff entitled to recover upon either of these claims? The question is stated

Page 20 U. S. 358

thus singly because the defendant admits that he uses the very Hopperboy for which the patent is, in part, granted, and justifies himself by insisting"

"1st. That the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent, the Hopperboy, as patented."

"2d. That his patent for an improvement is bad because the nature and extent of the improvement is not stated in his specification, and if it had been, still the patent comprehends the whole machine, and is therefore too broad."

"1st. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the description which the plaintiff has given of this machine in his specification, a model of which is now before you. Its parts are (1) an upright round shaft to revolve on a pivot in the floor; (2) a leader or upper arm; (3) an arm set with small inclining boards, called flights and sweepers; (4) cords from the

leader to the arm to turn it; (5) a weight passing over a pulley, to keep the arm tight on the meal; (8) a log at the top of the shaft to turn it, which is operated upon by the water power of the mill."

"The flights are so arranged as to track the one below the other and to operate like ploughs, and at every revolution of the machine to give the meal two turns towards the center. The sweepers are to receive the meal from the elevator and to trail it round the circle for the flights to gather it to the center, and also to sweep the meal into the bolt. "

Page 20 U. S. 359

"The use of this machine is stated to be to spread any granulated substance over a floor, to stir and expose it to the air, to dry and cool it, and to gather it to the bolt."

"The next inquiry under this head is when was this discovery made? Joseph Evans has sworn that in 1783, the plaintiff informed him that he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind sometime in July of that year. In 1784 he constructed a rough model of the Hopperboy, but having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn around the arm by hand. In 1785 he set up a Hopperboy in his mill resembling the model in court and the machine described in his specification. The evidence of Mr. Anderson strongly supports this witness, and indeed the discovery as early as 1784 or 1785 is scarcely controverted by the defendant."

"The defendant insists that a Hopperboy similar to the plaintiff's was discovered and in use many years anterior even to the year 1783, and relies upon the testimony of the following witnesses: "

"Daniel Stouffer, who deposes that he first saw the Stouffer Hopperboy in his father's, Christian Stouffer's mill, in the year 1764. In the year 1775 or 1776 he erected a similar one in the mill of his brother Henry and another in Jacob Stouffer's mill in 1777, 1778, or 1779. "

Page 20 U. S. 360

"Philip Frederick swears that in 1778 he saw a Stouffer Hopperboy in operation in Christian Stoutfer's mill, and in the year 1783 he saw one in Jacob Stouffer's mill and another in U. Charles' mill, and that it was always called Stouffer's machine."

"George Roup stated that in 1784 he erected one of these Hopperboys in the mill of one Braniwar, and that in 1782 Abraham Stouffer described to him a similar machine, which his father used in his mill."

"Christopher Stouffer, the son of Christian, has sworn, that his father, having enlarged his mill in the year 1780, erected a new Hopperboy of the description above mentioned, which is still in use in the same mill, now owned by Peter Stouffer."

"If these witnesses are believed by the jury, they establish the fact asserted by the defendant that the Stouffer Hopperboy was in use prior to the plaintiff's discovery."

"The next inquiry is into the parts, operation, and use of the Stouffer Hopperboy. This consists of an upright square shaft which passes lightly through a square mortice in an arm, underneath which are fixed slips of wood, called flights, and the arm is turned by a log on the upper end of it, which is moved by the power which moves the mills."

"The arm, with the flights, operates as it turns upon the meal placed below it, and its use is in a degree to cool the meal and to conduct it to the bolt. It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars. They each consist of a shaft or log to turn it by the power of the mill, and an arm

Page 20 U. S. 361

with flights on the under side of it. They each operate on the mill below the arm to cool, dry, and conduct it to the bolt."

"In what do they differ? The plaintiff's shaft is round, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords which connect the extremities of the arm to those of the leader. The shaft of the Stouffer Hopperboy is square, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are, and consequently it does not, in the opinion of most of the witnesses, cool or prepare the flour for packing as well as the plaintiff's."

"The question of law now arises, which is are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the Hopperboy as the original inventor of it? I take the rule to be, and so it has been settled in this and in other courts, that if the two machines be substantially the same and operate in the same manner to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle, and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted because he cannot be considered as the original inventor of the machine. If the alleged inventor of a machine which differs from another previously patented merely in form and proportion,

Page 20 U. S. 362

but not in principle, is not entitled to a patent for an improvement, which he cannot be by the 2d section of the law, he certainly cannot in a like case claim a patent for the machine itself."

"The question for the jury, then, is are the two Hopperboys substantially the same in principle?, not whether the plaintiff's Hopperboy is preferable to the other. Because if that superiority amounts to an improvement, he is entitled to a patent only for an

improvement, and not for the whole machine. In the latter case, the patent would be too broad, and therefore void when the patent is single."

"If you are of opinion that the plaintiff is not the original inventor of the Hopperboy, he cannot obtain a verdict on that claim unless his is an excepted case. The 1st, 2d, 3d, and 6th sections of the general patent law conclusively support this opinion. But the judgment of the Supreme Court in this case is relied upon by the plaintiff's counsel to prove that this is an excepted case insomuch that the plaintiff is entitled to a verdict although you should be satisfied that he is not the original inventor of the Hopperboy. But we are perfectly satisfied that the interpretation put upon the last clause of the judgment by the plaintiff's counsel is incorrect, and that for the following reasons."

"1. The question of priority of invention was not before the Supreme Court, and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point. The error in the charge which

Page 20 U. S. 363

this part of the judgment was obviously intended to correct is stated by THE CHIEF JUSTICE in the following words: "

"The second error alleged in the charge is in directing the jury to find for the defendant if it should be of opinion that the Hopperboy was in use prior to the improvement alleged to be made thereon by Oliver Evans."

"This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for the Hopperboy itself, and not for an improvement on the Hopperboy."

"It contradicts what is [elsewhere] stated, where it is said that the plaintiff's claim is to the machine 'which he has invented,' &c. Now if he did not invent the Hopperboy, he has no claim to it, and if so, could the court mean to say that he was nevertheless entitled to recover under that claim? Such a decision was certainly not called for by the terms of the 'act for the relief of Oliver Evans,' but would seem to be in direct violation of it. The act directs a patent to issue to Oliver Evans not for his Hopperboy, elevator, &c., but 'for his invention, discovery, and improvement in the art, &c., and on the several machines which he has discovered, invented, and improved.' Now if the Hopperboy was not invented, &c., by O.E., this act, without which O.E. could not have obtained a patent, did not authorize the Secretary of State to grant him one for that machine, or if granted it is clear that it was

Page 20 U. S. 364

improvidently done. If indeed the Supreme Court had been of opinion, that the fact of Oliver Evans' prior invention was decided, and could constitutionally have been decided by Congress, there might have been more difficulty in the case; but the argument of

counsel, which pressed that point upon the Court, was distinctly repudiated. We conceive that the meaning of that part of the opinion is that this Court erred in stating to the jury that O. Evans was not entitled to recover, if the Hopperboy (that is the original Hopperboy) had been in use prior to the plaintiff's alleged discovery of it, because if the plaintiff was entitled to claim an improvement on the Hopperboy, which this Court had denied and which the Supreme Court affirmed, this Court was clearly wrong in saying to the jury that the plaintiff could not recover for his improvement, which in effect was said. Upon the whole, then, the court is of opinion that O. Evans is not entitled to a verdict in his favor as the inventor of the Hopperboy; if you should be of opinion that another Hopperboy, substantially the same as his in principle, as before explained, up to the point where any alteration or improvement exists in his Hopperboy, was invented and in use prior to the plaintiff's invention or discovery, however they may differ in mere form, proportions, and utility."

"2d. The plaintiff's next claim is to an improvement on a Hopperboy, which claim, we were of opinion in another case, has received the sanction of the Supreme Court. His counsel contend that his improvement is (1) on the original method of supplying the

bolt by manual labor, (2) on his own Hopperboy, and (3) on some Hopperboy invented by some other person. Let this position be analyzed."

"1. It is said to be an improvement on the original method by manual labor. But it is obvious that if this be the invention, it is of an original machine, because wherever the patent law speaks of an improvement, it is on some art, machine or manufacture, &c., and not on manual labor which was applied to the various arts long before the invention of machinery to supply its place."

"2. An improvement on his own discovery."

"But where is the evidence of such invention? It is true that Joseph Evans has stated that the plaintiff constructed, in 1784, a rude model of a Hopperboy; but it was no substitute for manual labor, because without the cords or leading lines, the arm could not move, and it was therefore turned by hand. It was, in fact, in an incomplete state, in progress to its completion, but not given out or prepared to be given out to the world as a machine before 1785, when the cords to turn the arm were added."

"3. An improvement on a former machine."

"This is a fair subject for a patent, and the plaintiff has laid before you strong evidence to prove that his Hopperboy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is that the plaintiff's patent for an improvement is void because

Page 20 U. S. 366

the nature and extent of his improvements are not stated in his specification."

"The patent is for an improved Hopperboy, as described in the specification, which is referred to, and made part of the patent. Now does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention, the machine, the peculiar properties or principles of it, *viz.,* the spreading, turning, and gathering the meal, and the rising and lowering of its arm, by its motion to accommodate itself to the meal under it. But does this description designate the improvement or in what it consists? Where shall we find the original Hopperboy described either as to its construction, operation, or use or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is that the specification communicates no information whatever upon any of these parts. This being so, the law as to ordinary cases is clear that the plaintiff cannot recover for an improvement. The 1st section of the general patent law speaks of an improvement as an invention, and directs the patent to issue for this said invention. The 3d section requires the applicant to swear or affirm that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent, and further that he shall deliver a written description of his invention in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use

Page 20 U. S. 367

the same, &c. That it is necessary to the validity of a patent that the specification should describe in what the improvement consists is decided by MR. JUSTICE STORY in the cases referred to in the appendix to 3 Wheat. and in the cases of *Bombon v. Bule, Boville v. Poor, McFarlane v. Price, Harmer v. Playne,* and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against an unintentional infringement of the patent during its continuance and to enable an artist to make the improvement by a reference to some known and certain authority to be found among the records of the office of the Secretary of State after the patent has run out. But it is contended by the plaintiff's counsel that the law would be unreasonable to require, and that it does not require this to be done, unless the improvement is upon a patented machine, a description of which can be obtained by a reference to the records of the Secretary of State's office; that it might often be impossible for the patentee to discover and consequently to describe the parts of a machine in use perhaps only in some obscure part of the world. The answer to this is that an improvement necessarily implies an original, and unless the patentee is acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement."

"If he knows nothing of an original, then his invention is an original, or nothing, and the subsequent appearance of an original to defeat his patent is one of the risks which every patentee is exposed to under

our law. As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases, the improvement must be described, but with this difference -- that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine and then to state in what the improvements or such original consists, whereas in the latter case it would be necessary to describe the original machine and also the improvement. The reason for this distinction is too obvious to need explanation."

"If the general law upon this subject has been correctly stated, the next question is is this an excepted case? It is contended by the plaintiff that it is so, 1st, in virtue of the act for the relief of O.E., and 2d, by the decision of the Supreme Court."

"1. Under the private act. That declares that the patent is to be granted in the manner and form prescribed by the general patent law. What constitutes the manner and form in which a patent is granted by the law? The obvious answer is the petition -- the patent, with the signature of the President and the seal of the United States affixed to it -- the oath or affirmation -- the specification, or description of the invention, as required by the 3d section -- the drawings and models, if required. Will it be contended that a patent would be granted in the manner and form prescribed by this law if there were no description whatever of the invention? And if it would not, which is taken for granted, where is the difference between the total absence of a specification and one which has no reference

at all to the invention for which the patent is granted?"

"This is not the case of an imperfect or obscure description, but of one which relates exclusively to the whole machine, whereas the invention for which the patent is granted is for an improvement."

"2. The opinion of the Supreme Court, which states"

"that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists."

"But how is it to be shown? The court has not pointed out the manner, and we therefore think the only fair implication is that it must be shown as the statute of the United States and the general principles of law require -- *i.e.* by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff's counsel contend it may, then it may be fairly asked *cui bono?* which sort of a showing would then be, so far as it would be productive of any useful purpose? As to the defendant, the evidence comes too late to save him from the consequences of an error innocently committed. As to the public at

large with a view to caution, during the continuance of the patent, and to information of the nature of the improvement after its termination, the evidence given in this cause must be evanescent and totally useless."

"We feel perfectly convinced that the meaning of the Supreme Court as to this point is again misunderstood by the plaintiff's counsel, not only for the reasons above mentioned, but because the extent and

Page 20 U. S. 370

construction of the plaintiff's patent, and not the validity of it, in relation to any one of the machines, were the questions before that Court, and none others (in reference to the charge) were argued at the bar or reasoned upon by THE CHIEF JUSTICE, in delivering the opinion."

"Upon the whole, we are of opinion, that the plaintiff is not entitled to a verdict for the alleged infringement of his patent, for an improvement of the Hopperboy."

Whereupon a verdict and judgment thereon were rendered for the defendant in the circuit court, and the cause was again brought by writ of error to this Court.

Page 20 U. S. 423