

U.S. Supreme Court

Gayler v. Wilder, 51 U.S. 10 How. 477 477 (1850)

Gayler v. Wilder

51 U.S. (10 How.) 477

Syllabus

An assignment of a patent right, made and recorded in the Patent Office before the patent issued, which purported to convey to the assignee all the inchoate right which the assignor then possessed, as well as the legal title which he was about to obtain, was sufficient to transfer the right to the assignee, although a patent afterwards was issued to the assignor.

When an assignment is made under the fourteenth section of the act of 1836 of the exclusive right within a specified part of the country, the assignee may sue in his own name, provided the assignment be of the entire and unqualified monopoly. But any assignment short of this is a mere license, and will not carry with it a right to the assignee to sue in his own name.

Therefore, an agreement that the assignee might make and vend the article within certain specified limits, upon paying to the assignor a cent per pound, reserving, however, to the assignor the right to establish a manufactory of the article upon paying to the assignee a cent per pound, was only a license, and a suit for an infringement of the patent right must be conducted in the name of the assignor.

Where a person had made and used an article similar to the one which was afterwards patented, but had not made his discovery public, using it simply for his own private purpose, and without having tested it so as to discover its usefulness, and it had then been finally forgotten or abandoned; such prior invention and use did not preclude a subsequent inventor from taking out a patent.

The defendant in error who was plaintiff in the court below brought an action against Gayler and Brown the plaintiffs in

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error, for an alleged infringement of a patent right for the use of plaster of Paris in the construction of fire-proof chests.

In the declaration it was averred that one Daniel Fitzgerald was the original and first inventor of a new and useful improvement in fire-proof chests or safes, and that letters patent were granted him therefor bearing date 1 June, 1843. The patent was in the

usual form, and was set out in the declaration, the specification annexed to which was as follows:

"To all whom it may concern:"

"Be it known that I, Daniel Fitzgerald, of the City, County, and State of New York, and a citizen of the United States, have discovered and made an improvement, new and useful, in the construction of iron chests, or safes, intended to resist the action of fire, and for the safe-keeping and preserving books and papers, and other valuables, from destruction by fire, which I call a Salamander safe or chest."

"The following is a full and exact description of the safe or chest, with my improvement combined therewith:"

"I make two iron chests, in the common and ordinary way of making iron chests, which is well known to those engaged in this branch of business, one smaller than the other, which, when the safe is put together, forms the inner chest, or inner part of the safe. The other chest is made about three inches larger than the inner one, and so as, when put together, it will form the outer part or crust of the safe, and leave a space between the inner and outer chests of the safe of about three inches, which space may vary a little, more or less, when the chests are put together, but should be the same all round, and in every direction. The inner and outer doors, where two doors are used, are prepared in the same way, leaving a space, as above, between the inner and outer crust of each door, which space is left for a like purpose with that left between the inner and outer chest of the safe. Where one door is used, it should be made in the same manner, leaving a like space between the inner and outer crust or face of the door, and for a like purpose, and should be fitted to the chest or safe with great accuracy. The edges and openings for the doors are to be neatly finished, as in other chests. I then take plaster of Paris or gypsum, and, having boiled it or baked it in an oven, and calcined it, and reduced it to a powder, I mix it with water till it is about the consistency of cream or thin paste, so fluid as that it may readily be poured into the space left as above to receive it, and I then fill all the space with the plaster of Paris, putting in some sheets of mica between the inner and outer chest, to aid, if necessary, in checking the progress of the heat. "

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"But where pains are taken to have all the space left for the purpose properly filled with the plaster of Paris, as above, so that when set it will expand and adhere firmly to the surrounding parts, and completely fill the whole space, and all the cracks and joints, the mica may be dispensed with, and every other substance, and the plaster may be used alone. It may also be reduced to a powder, without being prepared as above, and used in that state, but I have not found it as good."

"The inner case or chest may be made of wood instead of iron, as for a bookcase, and if the space left between that and the outer chest be filled in the manner and with the

materials above named, it will make a very durable safe, that will effectually resist the fire, as I have found by experience, but the safe may not be so strong or durable, though somewhat cheaper."

"The above composition or preparation of gypsum may be mixed with several other articles not contrary to its nature, with a view to increase its efficacy in resisting the action of fire, but from my experience I doubt if they have much effect. The gypsum alone, when properly prepared, and properly placed in the space left to receive it, and made to fill it completely, is quite sufficient to resist, for a long space of time, the most intense heat. The chemical properties of this article are such, that, by the application of intense heat, it imparts a vapor or gas, or some other properties, which effectually stay the progress of the fire, and arrest the influence and effects of the heat; this I have ascertained by various experiments; and I believe I am the first man that discovered the utility, and devised the method of applying gypsum, or plaster of Paris, to increase the safety of an iron chest. I am not aware that this article was ever used for the purposes above set forth, until I used it in the manner above described."

"I therefore claim as my discovery and invention and improvement, the application and use of plaster of Paris or gypsum in its raw state or prepared as above, either alone or with mica, in the construction of all iron chests or safes in the manner above described or in any other manner substantially the same."

"DANIEL FITZGERALD"

"Witnesses:"

"G. H. PATTERSON"

"BEVERLEY R. HENSON, Jr."

It was also averred in the declaration that before the date of said letters patent, to-wit, on 7 April, 1839, the said Daniel Fitzgerald made an assignment, which was duly recorded in the Patent Office of the United States, on 1 June, 1839, as follows:

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"Whereas I, Daniel Fitzgerald, of the City, County, and State of New York, have invented certain improvements in safes, which invention I call the 'Salamander safe,' for which I am about to make application for letters patent of United States."

"And whereas E. Wilder, of New York aforesaid, has agreed to purchase from me all right and title, and interest which I have or may have in and to the said invention in consequence of the grant of letters patent therefor, and has paid to me, the said Fitzgerald, the sum of five thousand dollars, the receipt whereof is hereby acknowledged, "

"Now this indenture witnesseth that for and in consideration of the said sum to me paid, I have assigned and transferred to E. Wilder aforesaid the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor. And I hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder and his legal representatives."

"In testimony whereof, I have hereunto set my hand, and affixed my seal this 11 April, 1839."

"DANIEL FITZGERALD [SEAL]"

"Witnesses:"

"OWEN G. WARREN"

"CHARLES H. FOSTER"

The declaration then proceeded as follows:

"And the said plaintiff further saith that the said Enos Wilder, in his lifetime, after the making of the said assignment by the said Daniel Fitzgerald to the said Enos Wilder as afore mentioned and before the committing of the several grievances hereinafter mentioned, to-wit, on the first day of September, in the year of our Lord 1843, and within the Southern District of New York aforesaid, did execute a certain instrument or agreement to the said plaintiff whereby the said Enos Wilder, in consideration of the agreement made with the said plaintiff, and of one dollar to him, the said Enos Wilder, in hand paid by the said plaintiff, bargained, sold, conveyed, and assigned to the said plaintiff all the right, title, and interest of him, the said Enos Wilder, in and unto the patent granted to the said Daniel Fitzgerald, for an improvement in fire-proof safes and chests by the use of prepared gypsum, dated June 1, 1843, and of which patent he, the said Enos Wilder, was the sole owner and assignee, as will appear by the records of the Patent Office, and which patent he, the said Enos Wilder, had good right to sell and convey to the said plaintiff, to be by him, the said plaintiff, held as his own property, free from all

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claims from the said Enos Wilder or anyone claiming under him, the said Enos Wilder, as by the said instrument or agreement, sealed with the seal of the said Enos Wilder, ready in court to be produced, will, reference thereunto being had, fully and at large appear."

This last-mentioned instrument was averred to have been recorded in the Patent Office of the United States on 10 October, 1843.

It was then averred that by virtue of the last-mentioned instrument, plaintiff became, and ever since hath been, sole owner of said improvement &c., yet, the defendants well knowing &c.

The defendants pleaded the general issue, and gave notice that they would offer evidence that Daniel Fitzgerald was not the first and original inventor of the improvement patented.

The bill of exceptions was as follows:

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"Be it remembered that, on the trial of the aforesaid issue, the plaintiff, to maintain the same, after having read said patent in evidence as set forth in the declaration, read the following conveyance and agreement, which was duly recorded, and a copy of which was, at the date of said patent, endorsed on the same, viz.:"

"[Here was inserted the conveyance from Fitzgerald to Enos Wilder of 11 April, 1839, already set out in full in the declaration.]"

"And thereupon the defendants insisted that said instrument did not convey the legal title of said patent to the said Enos Wilder, and that, upon such conveyance, he could not have brought a suit on the same, but said court decided that said instrument operated to convey the interest in said patent to said Enos Wilder, so that during his life he could have maintained an action at law on the same, to which opinion of said court the counsel for the defendants then and there excepted."

"1st Exception"

"And the plaintiff then read the conveyance from said Enos Wilder to him, as stated in his said declaration, which he insisted made out a right in him to sustain his aforesaid action, but the defendants, to show that, after the date of the conveyance to the plaintiff, and before he commenced this action, he made, executed, and delivered to Silas C. Herring, Esq., the following agreement and conveyance, namely:"

" Benjamin G. Wilder agrees with Silas C. Herring to grant to him the sole and exclusive right to make the safe, called the

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Salamander safe, according to the terms and upon the plan pointed out and described in the patent and specification of Daniel Fitzgerald, which patent is dated June 1, 1843, and was assigned to Enos Wilder, and by him to Benjamin G. Wilder, who now owns the same; and this license is to be for the City, County, and State of New York, and said Herring is to have and enjoy the full and exclusive right to make and vend said safes in the City, County, and State of New York, and nowhere else; the said Herring is to have

the same for the residue of the unexpired term of said patent, with all the improvements which may be made in the manufacture of said safes which said B. G. Wilder may have a right to use during said term, and said Herring agrees that said Wilder may use all the improvements which he may make or have a right to use during said term. In consideration whereof, said Herring agrees with said Benjamin G. Wilder to pay to him, for the use of the right aforesaid, one cent a pound for each and every pound said safes may weigh when finished and sold, which sum is to be paid monthly so long as said patent remains in full force and until the same has been set aside by the highest court of the United States to which the same may be carried; but said Herring agrees to pay the one cent a pound for the space of two years at all events and whether said patent shall be declared good or not. If sustained, then said Herring is to pay as aforesaid for the full term as aforesaid. All the safes so made and sold by said Herring are to have said Wilder's patent marked thereon, the same as heretofore, in a plate, or cast in letters, 'Wilder's patent safe.' Said Herring agrees to keep an accurate account of all the safes by him made or caused to be made under said contract and patent, with the weight of each when sold, and the names of the persons to whom sold, and their places of abode, and to render said account monthly, if so often called on for it, and to pay accordingly. Said Herring is to manufacture all the safes he may sell or offer to sell under and according to said patent, with such improvements as he may have a right to use, and be marked as above with the words, in large, legible letters, 'Wilder's patent safe.'"

" Said Wilder reserves to himself the right to manufacture, in this City and State of New York or elsewhere, safes to sell out of this state and city, but if sold within this state or city, then said Wilder is to pay said Herring one cent a pound on each safe so made and sold within this city or state. Said Wilder is not himself to set up or establish nor authorize anyone else to set up and establish any manufactory or works for making Salamander safes or safes similar to said Salamander safes at any place within fifty miles of this city. Said

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Herring is to make all safes like Wilder's, and not vary in any substantial part therefrom, with such improvements as may be added."

" In presence of"

"S. P. STAPLES, *Witness to both signatures*"

"New York, January 6, 1844"

" If said patent should not be decided to be good till the end of three years, then for the time over the two years, till decided good, said Herring pays nothing. It is further understood and agreed that all safes made by said Herring or in the making of which or the selling thereof he shall in any way be directly or indirectly concerned, consisting of a double case or box with the intermediate space filled with plaster or any nonconducting substance, shall be considered within this agreement, and be paid accordingly."

"B. G. WILDER"

"SILAS C. HERRING"

"(Received and recorded 30 January, 1844)"

"2d Exception"

"And thereupon the defendants insisted that the plaintiff had parted with all his interest in said patent by virtue of said agreement, so that he could not sustain his aforesaid action. But said court decided that the plaintiff had not in and by said agreement so far parted with his interest in said patent as to deprive him of the right to sustain his aforesaid action, to which opinion of said court the defendants did then and there except."

"3d Exception"

"And the defendants then and there objected that the invention and improvement set forth and claimed in said patent as the invention of the patentee was not the subject of a patent; that it was the mere application of an old, well known material to a new purpose, which they insisted could not be the subject of a patent. But said court overruled said objection and instructed the jury as herein set forth, to which, as well as to the said instructions to said jury, the defendants excepted."

"And the plaintiff, to maintain his aforesaid issue, called sundry witnesses to prove, and claimed that he had proved, that he made the discovery which was the foundation of his invention and improvement as early as some time in the year 1830, that he made experiments in various ways, to test the utility of his discovery and improvement at different times in the different years from 1830 to 1836, when he applied for his

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patent, and that he pursued with due diligence that application until he obtained his aforesaid patent, and that the delay which had arisen in obtaining said patent was not caused by the fault or negligence of the patentee, or his assignee, Enos Wilder, nor anyone else, but arose from the burning of the Patent Office and other causes not under the control of the applicants for the patent, and that the defendants had infringed said patent as set forth in said declaration."

"And the defendants introduced evidence to prove and claimed that they had proved that said Daniel Fitzgerald was not the first and original inventor of what he claimed in said patent as his improvement. Among other witnesses, James Conner testified that, between 1829 and 1832, he was engaged in business as a stereotype founder and, knowing that plaster of Paris was a nonconductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris -- the same, substantially, as testified to and claimed by Fitzgerald, except there was no

plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in his counting room while he used it, and known to the persons working in the foundry."

"This testimony was confirmed by his brother, John Conner, except that he fixes the time of constructing the safe in the year 1831 or 1832. But one safe was made by Conner, and since it passed out of his hands he has used others of a different construction."

"The defendants also claimed that if said Daniel Fitzgerald was the first and original inventor of said improvement, as he claimed, yet that he had made said iron safes, and sold them, under such circumstances as that he had thereby abandoned the same and suffered the same to go into public use in such manner as to lose all right to said invention and improvement, if any he ever had."

"And the court thereupon instructed the jury that if they found that Daniel Fitzgerald, the patentee, was the first and original inventor of the said improvement claimed in said patent, and that the use of plaster of Paris, in combination with and in the construction of an iron safe, is new and useful, as in the specification of said patent is set forth and claimed, then they would find that the patent was valid, and protected the invention and improvement as claimed, unless the plaintiff or those under whom he claimed had abandoned said improvement to the public and suffered the same to go into public use before the application for said patent, of which facts the jurors were the judges. "

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"And said court further instructed said jury that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid, but if the jury found that said James Conner made his said safe as claimed, and tested it by experiments before Fitzgerald's invention and improvement and before he tested the same, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent."

"The court further charged that, independently of these considerations, there was another view of the case as it respected the Conner safe: that it was a question whether the use of it by him and been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him if he be an original, though not the first, inventor or discoverer of the improvement."

"4th Exception"

"And said court, in summing up said case to said jury, further instructed them that if they found that Daniel Fitzgerald was the first and original inventor of said improvement, as set forth in said patent, and had not abandoned or dedicated the same to the public, but had with reasonable diligence pursued his invention till he had perfected the same, and used due diligence in applying for, and in pursuing his application for a patent, until he obtained the same, and if they found the defendants had made and sold safes, as charged in the plaintiff's declaration, then they would find their verdict for the plaintiff for such actual damages as they judged just and reasonable; but if they found otherwise, then they would find for the defendants. To each and all of these instructions given to the jury the counsel for the defendants excepted."

"And forasmuch as the facts aforesaid and the decisions of the court thereon do not appear of record, the defendants pray that this their bill of exceptions may be allowed."

"Filed 23 February, 1848."

"S. NELSON [SEAL]"

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