

# U.S. Supreme Court

Godfrey v. Eames, 68 U.S. 1 Wall. 317 317 (1863)

Godfrey v. Eames

68 U.S. (1 Wall.) 317

## *Syllabus*

If an applicant for a patent choose to withdraw his application for a patent, intending at the time of such withdrawal to file a new petition, and he accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the seventh sections of the Patent Acts of 1836 and 1839. CLIFFORD, J., dissenting.

The question of the continuity of the application is a question to be submitted to the jury.

The Patent Act of 1836 provides [[Footnote 1](#)] that on the filing of an application for a patent,

"the commissioner shall make or cause to be made an examination of the alleged new invention or discovery, and if on any such examination it shall not appear to the commissioner that the same had been . . . in public use or on sale with the applicant's consent or allowance prior to the application, . . . it shall be his duty to issue a patent therefor, but whenever on such examination it shall appear to the commissioner that . . . the applicant was not the original and first inventor or discoverer thereof, or that what is claimed as new had before been invented or discovered, . . . or that the description is defective and insufficient, he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of *renewing his application* or of altering his specification to embrace only that part of the invention or discovery which is new."

"In every such case," the act goes on to say,

*"if the applicant*

Page 68 U. S. 318

*shall elect to withdraw his application*, relinquishing his claim to the model, he shall be entitled to receive back \$20, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office. . . . But if the applicant in such case shall *persist* in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner aforesaid, and if the specification or claim shall not have been so modified, as in the opinion of the

commissioner shall entitle the applicant to a patent, he may on appeal, and upon request in writing, have the decision of a board of examiners,"

&c.

A subsequent act -- an act of 1839 [[Footnote 2](#)] -- provides that those who shall have purchased, sold, or made the thing patented "prior to the application of the inventor or discoverer for a patent, shall be held to possess the right to use and vend to others to be used" the same, and that

"no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid except on proof of abandonment of such invention to the public or that such purchase, sale, or prior use has been *for more than two years prior to such application for a patent.*"

With these enactments in force, Godfrey, on the 31st January, 1855, filed an application for a patent for boot trees. This application the commissioner, on the 17th May, 1855, rejected for want of novelty. On the 24th April, 1857, within the time required by the rules, Godfrey submitted his case again. The old application was withdrawn and a new one filed *simultaneously*, the withdrawal fee of \$20 going to make part of the new application fee of \$30, and not in fact being received by the applicant. These different applications were made through different attorneys, and the description of invention, the claims of novelty, and the models were in some respects different. It was admitted, however, at the bar, "that that which was finally patented might, if it had been properly introduced, have been engrafted as an amendment

[Page 68 U. S. 319](#)

to the first application." A patent was issued March 2, 1858.

It was part of the case "that the patentee, in the summer and fall of 1854, and since, publicly manufactured and sold boot trees containing his alleged invention."

On a suit by the patentee, Godfrey, in the Circuit Court for the District of Massachusetts against Eames for the use of the boot tree patented, the question was whether Godfrey had forfeited his patent by more than two years' public use or sale of his invention prior to his application. The court below instructed the jury that he had, and accordingly that the plaintiff could not recover. The correctness of this instruction, was the matter now before this Court on error.

[Page 68 U. S. 324](#)