U.S. Supreme Court

Hotchkiss v. Greenwood, 52 U.S. 11 How. 248 248 (1850)

Hotchkiss v. Greenwood

52 U.S. (11 How.) 248

Syllabus

A patent granted for a "new and useful improvement in making door and other knobs of all kinds of clay used in pottery, and of porcelain" by having the

"cavity in which the screw or shank is inserted by which they are fastened largest at the bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state"

was invalid.

The invention claimed in the schedule was manufacturing knobs as above described, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing, and also of porcelain.

The knob was not new, nor the metallic shank and spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank was securely fastened therein. Knobs had also been used made of clay.

The only thing new was the substitution of a knob made out of clay in that peculiar form for a knob of metal or wood. This might have been a better or cheaper article, but is not the subject of a patent.

The test was that if no more ingenuity and skill was necessary to construct the new knob than was possessed by an ordinary mechanic acquainted with the business, the patent was void, and this was a proper question for the jury.

This was a question involving the validity of a patent right, under the following circumstances.

The patent and specification were as follows:

"The United States of America, to all to whom these letters patent shall come."

"Whereas John G. Hotchkiss, New Haven, Conn., John A Davenport, and John W. Quincy, New York, have alleged that they have invented a new and useful improvement in making door and other knobs of all kinds of clay used in pottery, and

of porcelain, which they state has not been known or used before their application; have made oath that they are citizens of the United States, that they do verily believe that they are the original and first inventors or discoverers of the said improvement, and that the same hath not, to the best of their knowledge and belief, been previously known or used; have paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: these are therefore to grant, according to law, to the said John G. Hotchkiss, John A. Davenport, and John W. Quincy, their heirs, administrators, or assigns, for the term of fourteen years from 29 July, 1841, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Hotchkiss, Davenport, and Quincy, in the schedule hereunto annexed, and is made a part of these presents."

"In testimony, whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed. Given under my hand at the City of Washington, this 29 July, A.D. 1841, and of the independence of the United States of America the sixty-sixth."

"DANIEL WEBSTER, *Secretary of State*"

"Countersigned and sealed with the seal of the Patent Office."

"HENRY L. ELLSWORTH, *Commissioner of Patents*"

"The schedule referred to in these letters patent, and making a part of the same. To all whom it may concern: "

"Be it known that we, John G. Hotchkiss, of the City and County of New Haven, and State of Connecticut, and John A. Davenport and John W. Quincy, both of the City, County, and State of New York, have invented an improved method of making knobs for locks, doors, cabinet furniture, and for all other purposes for which wood and metal, or other material knobs, are used. This improvement consists in making said knobs of potter's clay, such as is used in any species of pottery; also of porcelain; the operation is the same as in pottery, by moulding, turning, and burning and glazing; they may be plain in surface and color, or ornamented to any degree in both; the modes of fitting them for their application to doors, locks, furniture, and other uses, will be as various as the uses to

which they may be applied, but chiefly predicated on one principle, that of having the cavity in which the screw or shank is inserted, by which they are fastened, largest at the

bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state. In the annexed drawing, A represents a knob with a large screw inserted, for drawers and similar purposes; B represents a knob with a shank to pass through and receive a nut; C, the head of the knob calculated to receive a metallic neck; D, a knob with a shank calculated to receive a nut on the outside or front. What we claim as our invention, and desire to secure by letters patent, is the manufacturing of knobs, as stated in the foregoing specifications, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing, and also of porcelain."

"JOHN G. HOTCHKISS"

"J. A. DAVENPORT"

"JOHN W. QUINCY"

"Witnesses:"

"ALPS. SHERMAN"

"JAMES MONTGOMERY"

In October, 1845, the plaintiffs in error brought an action in the Circuit Court of the United States for Ohio, against the defendants, for a violation of the patent right.

The defendants pleaded not guilty, and gave the following notice:

"The plaintiffs will please take notice, that on the trial of the above cause the defendants will give in evidence to the jury, that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay or of porcelain. They will also prove that the making of knobs from potter's clay, and also from porcelain and other clays used by potters, was known and practiced, and such knobs were made, used, and sold, in the Cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey City, in the State of New Jersey; also in the City of Philadelphia, State of Pennsylvania; by John Mayer, Thomas Frere, William Lundy, Jr., and Charles W. Vernerck, residing in the City of New York; also by John Harrison, residing in Jersey City, in the State of New Jersey; and by Littlefield, Hattrick & Shannon, of Philadelphia, in the State of Pennsylvania, long before 29 July, in the year 1841, the date of the patent in the declaration mentioned. They will also prove that similar knobs were manufactured of potter's clay, and also of porcelain, and were also used and sold, long prior to the said 29th day of July, 1841, in the town of Burslem, in Staffordshire,

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England; also in the Town of Sandyford, near Tunstall; also in the Town of Hanley, Staffordshire, England; also at Woodenbose Village, in the County of Derbyshire, England. And the said defendants will prove the manufacture and use of said knobs, so made of clay and porcelain, by Godfrey Webster and John Webster, who now reside in East Liverpool, Columbiana County, Ohio, and also by Enoch Bulloch, who now resides in Wellsville, in the same county; also by Daniel Bennett, who now [resides] in the City of Pittsburgh, Pennsylvania; all of whom formerly resided in Staffordshire, England. The defendants will also prove that the said patentees, John G. Hotchkiss, John A. Davenport, and John W. Quincy, at the time of making application for the said patent, well knew that the said knobs so patented had been previously made and sold in a foreign country, to-wit, in the Kingdom of Great Britain, and also in Germany, and did not believe themselves to be the first inventors or discoverers of manufacturing knobs from potter's clay or porcelain. All of which will be insisted upon in bar of the action."

"CHAS. FOX, *Attorney for the Defendants*"

And in July, 1848, the following additional notice:

"The plaintiffs in this cause will please take notice, that on the trial of the cause the defendants will give in evidence to the jury that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay, or of porcelain; they will also prove that knobs made of potter's clay, and of porcelain and other clays, had been previously publicly used and sold in the cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey City, in the State of New Jersey; also in New Haven and Middletown, in the State of Connecticut, long before and at the date of the patent under which the plaintiffs claim; the defendants will likewise prove, on said trial, that John Mayer, residing in Staten Island; Hoope & Lee, residing in the City of Brooklyn, in the State of New York; Edward H. Higgins, John Penfield, John Duntze, residing in Hew Haven, in the State of Connecticut; Matthew Fifo, William Fifo, Jane Fifo, John C. Smith, and certain persons doing business under the name of Smith, Fifo & Co., residing in the City of Philadelphia, in the State of Pennsylvania, as early as the year 1831, and from that time on, and until, and at the time of obtaining the patent under which the plaintiffs claim, and before the alleged discovery and invention set forth in said patent, made, manufactured, and publicly sold and used, knobs made of potter's

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clay, and of other clays, and of porcelain, in the several cities and places named."

The following bill of exceptions was taken during the trial:

"The plaintiffs offered in evidence the patent specifications and drawings, and other evidence, tending to prove the originality, novelty, and usefulness of the inventions as described in said specification; and other evidence, tending to show the violation of said patent by the defendant, and rested. Whereupon the defendants offered evidence

tending to show that the said alleged invention was not originally invented by anyone of the said patentees; and that if said invention was original with any of the said patentees, it was not the joint invention of all of said patentees; and other evidence, tending to show that the mode of fastening the shank or collet to the knob, adopted by the plaintiffs, and in said specification described, had been known and used in Middletown, Connecticut, prior to the alleged inventions of the plaintiffs, as a mode of fastening shanks or collets to metallic knobs. And the evidence being closed, the counsel for the plaintiffs insisted in the argument, that, although the knob, in the form in which it is patented, may have been known and used in the United States prior to their invention and patent; and although the shank and spindle, by which it is attached, may have been known and used in the United States prior to said invention and patent, yet if such shank and spindle had never before been attached to a knob made of potter's clay or porcelain, and if it required skill and thought and invention to attach the said knob of clay to the metal shank and spindle, so that the same would unite firmly, and make a solid and substantial article of manufacture, and if the said knob of clay or porcelain so attached were an article better and cheaper than the knob theretofore manufactured of metal or other materials, that the patent was valid, and asked the court so to instruct the jury, which the court refused to do; but, on the contrary thereof, instructed the jury, that if knobs of the same form, and for the same purposes with that described by the plaintiffs in their specifications, made of metal or other material, had been known and used in the United States prior to the alleged invention and patent of the plaintiffs, and if the spindle and shank, in the form used by the plaintiffs, had before that time been publicly known and used in the United States, and had been theretofore attached to metallic knobs by means of the dovetail and the infusions of melted metal, as the same is directed in the specification of the plaintiffs to be attached to the knob of potter's clay or porcelain, so that if the knob of clay or porcelain

is the mere substitution of one material for another, and the spindle and shank be such as were theretofore in common use, and the mode of connecting them to the knob by dovetail be the same that was theretofore in use in the United States, the material being in common use, and no other ingenuity or skill being necessary to construct the knob than that of an ordinary mechanic acquainted with the business, the patent is void, and the plaintiffs are not entitled to recover. The counsel for the defendants asked the court to instruct the jury that if they should be satisfied that anyone of the patentees was the original inventor of the article in question, and that the same was new and useful, yet if they should be satisfied from the evidence that all the patentees did not participate in the invention, the patent is void, and the plaintiffs cannot recover. The court gave the above, modified by the remark, that the patent was *prima facie* evidence that the invention was joint, though the fact might be disproved on the trial; and the court remarked, there was no evidence except that of a slight presumption against the joint invention as proved by the patent; to which refusal of the court to instruct the jury as asked by the counsel for the plaintiffs, and to the instructions given, the plaintiffs, by their counsel, except, and pray the court to sign this their bill of exceptions."

"JOHN McLEAN [SEAL]"

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