

# U.S. Supreme Court

**Pennock & Sellers v. Dialogue, 27 U.S. 2 Pet. 1 1 (1829)**

**Pennock & Sellers v. Dialogue**

**27 U.S. (2 Pet.) 1**

*ERROR TO THE CIRCUIT COURT FOR THE*

*EASTERN DISTRICT OF PENNSYLVANIA*

## *Syllabus*

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial of the cause by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose; it is not properly before this Court for consideration, and forms an expensive and unnecessary burden upon the record. This Court has had occasion in many cases to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court, delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

It is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions.

If either party considers any point presented by the evidence omitted in the charge of the court, it is competent for such party to require an opinion from the court upon that point. The court cannot be presumed to do more in ordinary cases than to express its opinion upon questions which the parties themselves have raised on the trial.

It has not been and indeed it cannot be denied that an inventor may abandon

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his invention, and surrender or dedicate it to the public. This inchoate right, thus gone, cannot afterwards be resumed at his pleasure, for when gifts are once made to the public in this way, they become absolute. The question which generally arises on trials is a question of fact, rather than of law; whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public.

It is obvious that many of the provisions of our patent act are derived from the principles and practices which have prevailed in the construction of the law of England in relation to patents.

Where English statutes, such for instance as the statute of frauds and the statute of limitations, have been adopted into our own legislation, the known and settled construction of those statutes by courts of law has been considered as silently incorporated into the acts, or has been received with all the weight of authority. This is not the case with the English statute of monopolies, which contains an exception, on which the grants of patents for inventions have issued in that country. The language of that clause in the statute is not identical with the patent law of the United States, but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known, and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

The true meaning of the words of the patent law "not known or used before the application" is not known or used *by the public* before the application.

If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly and make and sell the invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then and then only, when the danger of competition should force him to procure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it during his fourteen years, it would materially retard the progress of science and the useful arts and give a premium to those who should be least prompt to communicate their discoveries.

If an invention is used by the public with the consent of the inventor at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, how can the court extract the case from its operation and support a patent when the suggestions of the patentee were not true and the conditions on which alone the grant was authorized do not exist?

The true construction of the patent law is that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use or to be publicly sold for use before he makes application for a patent. This voluntary act, or acquiescence in the public sale or use, is an abandonment of his right, or rather creates a disability to comply with the terms and conditions of the law on which alone the Secretary of State is authorized to grant him a patent.

In that court, the plaintiffs in error had instituted their suit against the defendants for an infringement of a patent right for "an improvement in the art of making tubes or hose for conveying air, water, and other fluids." The invention claimed by the patentees was in the mode of making the hose so that the parts so joined together would be tight and as capable of resisting the pressure as any other part of the machine.

The bill of exceptions, which came up with the record, contained the whole evidence given in the trial of the cause in the circuit court. The invention for which the patent right was claimed was completed in 1811, and the letters patent were obtained in 1818. In this interval, upwards of *13,000 feet of hose* constructed according to the invention of the patentees had been made and sold in the City of Philadelphia. One Samuel Jenkins, by the permission of and under an agreement between the plaintiffs as to the price, had made and sold the hose invented by the plaintiffs, and supplied several hose companies in the City of Philadelphia with the same. Jenkins, during much of the time, was in the service of the plaintiffs, and had been instructed by them in the art of making the hose. There was no positive evidence that the agreement between Jenkins and the plaintiffs in error was known to or concealed from the public. The plaintiffs, on the trial, did not allege or offer evidence to prove that they had delayed making application for a patent for the purpose of improving their invention, or that from 1811 to 1818 any important modifications or alterations had been made in their riveted hose. The plaintiffs claimed before the jury that all the hose which had been made and sold to the public prior to their patent had been constructed and vended by Jenkins under their permission.

Upon the whole evidence in the case, the circuit court charged the jury:

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"We are clearly of opinion that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice; he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him had it been applied for before such use. And we think it makes no difference in the principle that the article so publicly used and afterwards patented was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured, and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make or use the subject of the invention would at least be put upon their guard. But if the public, with the knowledge and the tacit consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterwards to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public, and may have supposed that by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention, which is involved in the principle which we have laid down, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings

this case within the principle which has been stated. If it does, the court is of opinion that the plaintiffs are not entitled to a verdict."

To this charge the plaintiffs excepted, and the jury gave a verdict for the defendant.

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MR. JUSTICE STORY delivered the opinion of the Court.

This is a writ of error to the Circuit Court of Pennsylvania. The original action was brought by the plaintiffs in error for an asserted violation of a patent, granted to them on 6 July, 1818, for a new and useful improvement in the art of making leather tubes or hose for conveying air, water, and other fluids. The cause was tried upon the general issue, and a verdict was found for the defendant upon which judgment passed in his favor, and the correctness of that judgment is now in controversy before this Court.

At the trial, a bill of exceptions was taken to an opinion delivered by the court in the charge to the jury, as follows, *viz.*,

"That the law arising upon the case was that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention of which the public might take notice; he abandons

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the inchoate right to the exclusive use of the invention, to which a patent would have entitled him had it been applied for before such use. And that it makes no difference in the principle that the article so publicly used and afterwards patented was made by a particular individual, who did so by the private permission of the inventor. And thereupon did charge the jury *that if the evidence brings the case within the principle which had been stated*, that court was of opinion that the plaintiffs were not entitled to a verdict."

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial, by each party, in support of the issue. It is very voluminous, and as no exception was taken to its competency, or sufficiency, either generally or for any particular purpose; it is not properly before this Court for consideration, and forms an expensive and unnecessary burden upon the record. This Court has had occasion in many cases to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

In the argument at the bar, much reliance has been placed upon this evidence by the counsel for both parties. It has been said on behalf of the defendants in error that it called for other and explanatory directions from the court, and that the omission of the

court to give them in the charge furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial. But it is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point. If he does not, it is a waiver of it.

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The court cannot be presumed to do more in ordinary cases than to express its opinion upon the questions which the parties themselves have raised at the trial.

On the other hand, the counsel for the defendant in error has endeavored to extract from the same evidence strong confirmations of the charge of the court. But for the reason already suggested, the evidence must be laid out of the case, and all the reasoning founded on it falls.

The single question then is whether the charge of the court was correct in point of law. It has not been, and indeed cannot be denied, that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure, for where gifts are once made to the public in this way, they become absolute. Thus, if a man dedicates a way or other easement to the public, it is supposed to carry with it a permanent right of user. The question which generally arises at trials is a question of fact, rather than of law; whether the acts or acquiescence of the party furnish in the given case, satisfactory proof of an abandonment or dedication of the invention to the public. But when all the facts are given, there does not seem any reason why the court may not state the legal conclusion deducible from them. In this view of the matter, the only question would be whether, upon general principles, the facts stated by the court would justify the conclusion.

In the case at bar it is unnecessary to consider whether the facts stated in the charge of the court would, upon general principles, warrant the conclusion drawn by the court independently of any statutory provisions, because we are of opinion that the proper answer depends upon the true exposition of the act of Congress under which the present patent was obtained. The Constitution of the United States has declared, that Congress shall have power

"to promote the progress of science and useful arts by securing *for limited times* to authors and inventors the exclusive right to their respective writings and discoveries."

It contemplates, therefore, that this exclusive right shall exist but

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for a limited period, and that the period shall be subject to the discretion of Congress. The Patent Act of 21 February, 1793, ch. 11, prescribes the terms and conditions and manner of obtaining patents for inventions, and proof of a strict compliance with them lies at the foundation of the title acquired by the patentee. The first section provides

"That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, or composition of matter, *not known or used before the application*, and shall present a petition to the Secretary of State signifying a desire of obtaining an exclusive property in the same and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition and giving a short description of the said invention or discovery, and thereupon granting to the said petitioner, . . . *for a term not exceeding fourteen years*, the full and exclusive right and liberty of *making, constructing, using, and vending to others to be used*, the said invention or discovery,"

&c. The third section provides

"That every inventor, before he can receive a patent, shall swear, or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent."

The sixth section provides that the defendant shall be permitted to give in defense, to any action brought against him for an infringement of the patent, among other things,

"that the thing thus secured by patent was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, *anterior to the supposed discovery of the patentee*."

These are the only material clauses bearing upon the question now before the court, and upon the construction of them, there has been no inconsiderable diversity of

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opinion entertained among the profession, in cases heretofore litigated.

It is obvious to the careful inquirer that many of the provisions of our patent act are derived from the principles and practice which have prevailed in the construction of that of England. It is doubtless true, as has been suggested at the bar, that where English statutes, such for instance as the statute of frauds and the statute of limitations, have been adopted into our own legislation; the known and settled construction of those statutes by courts of law, has been considered as silently incorporated into the acts, or has been received with all the weight of authority. Strictly speaking, that is not the case in respect to the English statute of monopolies, which contains an exception on which

the grants of patents for inventions have issued in that country. The language of that clause of the statute is not, as we shall presently see, identical with ours, but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

By the very terms of the first section of our statute, the Secretary of State is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c., "*not known or used before the application?*" The authority is a limited one, and the party must bring himself within the terms, before he can derive any title to demand, or to hold a patent. What then is the true meaning of the words "*not known or used before the application?*" They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prohibit him from the only means of obtaining a patent. The use, as well as the knowledge of his invention, must be indispensable to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words then, to have any rational interpretation, must

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mean, not known or used by others, before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself, or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed, that the legislature had within its contemplation such knowledge or use.

We think, then, the true meaning must be not known or used by the public before the application. And, thus construed, there is much reason for the limitation thus imposed by the act. While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was "to promote the progress of science and useful arts;" and this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible, having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent and thus exclude the public from any further use than what should be derived under it during his fourteen years, it would materially retard the progress of science and the useful arts and give a premium to those who should be least prompt to communicate their discoveries.

A provision, therefore, that should withhold from an inventor the privilege of an exclusive right unless he should, as early as he should allow the public use, put the public in

possession of his secret and commence the running of the period that should limit that right would not be deemed unreasonable. It might be expected to find a place in a

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wise prospective legislation on such a subject. If it was already found in the jurisprudence of the mother country, and had not been considered inconvenient there, it would not be unnatural that it should find a place in our own.

Now in point of fact, the statute of 21 Jac. ch. 3, commonly called the Statute of Monopolies, does contain exactly such a provision. That act, after prohibiting monopolies generally, contains, in the sixth section, an exception in favor of

"letters patent and grants of privileges for *fourteen years or under*, for the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which *others, at the time of making such letters patent and grants, shall not use.*"

Lord Coke, in his commentary upon this clause or proviso, 3 Inst. 184, says that the letters patent

"must be of such manufactures, which *any other at the time of making such letters patent did not use*, for albeit it were newly invented, yet if any other did use it at the making of the letters patent, or grant of the privilege, it is declared and enacted to be void by this act."

The use here referred to has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor.

In the case of *Wood v. Zimmer*, 1 Holt's N.P. 58, this doctrine was fully recognized by Lord Chief Justice Gibbs. There, the inventor had suffered the thing invented to be sold, and go into public use for four months before the grant of his patent, and it was held by the court that on this account the patent was utterly void. Lord Chief Justice Gibbs said

"To entitle a man to a patent, the *invention* must be *new to the world*. The *public* sale of that which is afterwards made the subject of a patent, *though sold by the inventor only*, makes the patent void."

By "invention," the learned judge undoubtedly meant, as the context abundantly shows, not the abstract discovery, but the thing invented; not the new secret principle, but the manufacture resulting from it.

The words of our statute are not identical with those of

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the statute of James, but it can scarcely admit of doubt that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord Coke. But if there were no such illustrative comment, it is difficult to conceive how any other interpretation could fairly be put upon these words. We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought, in some cases, to import a hardship, or tie up beneficial rights within very close limits. If an invention is used by the public with the consent of the inventor at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorized to be made, do not exist? In such a case, if the court could perceive no reason for the restrictions, the will of the legislature must still be obeyed. It cannot and ought not to be disregarded where it plainly applies to the case. But if the restriction may be perceived to have a foundation in sound policy, and be an effectual means of accomplishing the legislative objects, by bringing inventions early into public and unrestricted use, and above all, if such policy has been avowed and acted upon in like cases in laws having similar objects, there is very urgent reason to suppose that the act in those terms embodies the real legislative intent, and ought to receive that construction. It is not wholly insignificant in this point of view that the first patent act passed by Congress on this subject, Act of 1790, ch. 34, ch. 7, which the present act repeals, uses the words "*not known or used before,*" without adding the words "*the application,*" and in connection with the structure of the sentence in which they stand, might have been referred either to the time of the invention, or of the application. The addition of the

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latter words in the patent act of 1793, must therefore have been introduced, *ex industria*, and with the cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature.

The Act of 17 April, 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are aliens; contains a proviso declaring,

"That every patent which shall be obtained pursuant to the act for any invention, art or discovery, *which it shall afterwards appear had been known or used previous to such application for a patent,* shall be void."

This proviso certainly certifies the construction of the act of 1793, already asserted, for there is not any reason to suppose that the legislature intended to confer on aliens, privileges, essentially different from those belonging to citizens. On the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act.

The only real doubt which has arisen upon this exposition of the statute, has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defense as a bar, that "the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee." It has been asked if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor, why were not the words "*anterior to the application*" substituted, instead of "*anterior to the supposed discovery?*" If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor or piratically, were to use it without the knowledge of the first inventor, his right would be gone. In respect to a use by piracy, it is not clear that any such fraudulent use is within the intent of the statute, and upon general principles it might well be held excluded. In respect to the case of a second invention, it is questionable

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at least, whether, if by such second invention a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common use of an invention fairly and without fraud, there might be sound reason for presuming that the legislature did not intend to grant an exclusive right to anyone to monopolize that which was already common. There would be no *quid pro quo* -- no price for the exclusive right or monopoly conferred upon the inventor for fourteen years.

Be this as it may, it is certain that the sixth section is not necessarily repugnant to the construction which the words of the first section require and justify. The sixth section certainly does not enumerate all the defenses which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. The sixth section in the clause under consideration may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor and to him only; if known or used before his supposed discovery, he is not the *first*, although he may be a true inventor, and that is the case to which the clause looks. But it is not inconsistent with this doctrine that although he is the *first* as well as the *true* inventor, yet if he shall put it into public use or sell it for public use before he applies for a patent, that this should furnish another bar to his claim. In this view, an interpretation is given to every clause of the statute without introducing any inconsistency or interfering with the ordinary meaning of its language. No public policy is overlooked, and no injury can ordinarily occur to the first inventor, which is not in some sort the result of his own laches or voluntary inaction.

It is admitted that the subject is not wholly free from difficulties, but upon most deliberate consideration we are all of opinion, that the true construction of the act is that the first inventor cannot acquire a good title to a patent; if he suffers the thing invented to go into public use or to be

publicly sold for use before he makes application for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right, or rather creates a disability to comply with the terms and conditions on which alone the Secretary of State is authorized to grant him a patent.

The opinion of the circuit court was therefore perfectly correct, and the judgment is

*Affirmed with costs.*

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Pennsylvania and was argued by counsel, on consideration whereof it is the opinion of this Court that there is no error in the judgment of the said circuit court. Whereupon it is considered, ordered, and adjudged by this Court that the said judgment of the said circuit court in this cause be and the same is hereby affirmed with costs.