construction of the act as it regards the public use of an invention before it is presented is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention; but if he may delay an application for his patent at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretense of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known or might have been known to the inventor, is the only safe rule which can be adopted on this subject." The last paragraph is as to the intention, in which the court say: "Whatever may be the intention of the inventor, if he suffers his invention to go into public use through any means whatsoever, without an immediate assertion of right, he is not entitled to a patent. Nor will a patent obtained under such circumstances protect his right." This view of the subject, it is considered, is a full bar to the claim of the appellants, and makes it unnecessary to consider what the case would have been upon the merits. The decision of the Commissioner must be affirmed.

Munn & Co., for the appellants.

R. W. Fenwick, for the appellee.

CHARLES STEARNS, APPELLANT,

vs.

ASAHEL DAVIS, APPELLEE. INTERFERENCE.

ORIGINAL INVENTOR—DELAY—EFFECT OF.—When the invention is "suggested" by one of the parties to the interference, and is reduced to practice by the other in accordance with such suggestion, the party first named is the first and only inventor, and the second party can acquire no title to the invention by the failure of the real inventor to follow up and perfect his invention with reasonable diligence. In such a case the invention would be forfeited, if at all, to the public.

(Before DUNLOP, J., District of Columbia, August, 1859.)

Opinion of the court.

STATEMENT OF THE CASE.

The patent issued to Stearns July 5th, 1859, No. 25,534, with the following claim: "The twisting rollers, constructed as described, in combination with the corrugated roller, for producing the corrugated twisted lightning-rod."

DUNLOP, J.

It is truly said by the Commissioner of Patents, in his reply of the 8th of August, 1859, to the reasons of appeal of Mr. Stearns, that the object of this appeal is not to decide who invented the lightning-rod, but the question of priority of invention in the rollers for twisting the rod. The whole evidence on both sides is directed to this issue.

I have carefully examined the proofs, and it seems to me there can be no doubt that the appellant Stearns was the original, first inventor of the twisting rollers exhibited in the models and specifications of appellant and appellee. This appears not only in Stearns' testimony, but is fully made out by the witnesses examined by Davis himself. I refer to the depositions of Thomas Trask, Thomas Richardson, Henry H. Wilder, Moses C. Crocker and others. But it is said by the Office that the "idea," the "suggestion" of Stearns was inchoate, and not reduced to practice; that it was first turned to practical use by the appellee Davis, and therefore the patent ought to be awarded to him. If this was a controversy between two original inventors or discoverers of the same thing, and the second inventor—or the original inventor, posterior in point of time of the two—first reduced it to use, the first original inventor would not, and ought not, to lose the fruits of his genius unless the second inventor could show that the first had forfeited his right by failing to pursue and perfect his invention by the use of reasonable diligence in reducing it to practice and making it available to the public. But this is not the case of two original inventors, each conceiving the same idea, unaided and unassisted. Stearns' "suggestion," it is conceded on all hands, and is even admitted by Davis himself, was communicated to him (Davis) by Charles Stearns and Moses Marshall, who is unimpeached; and others declare that the suggestion was at once practically applied, and produced the desired result—the twisted,

corrugated copper rod. In no sense, therefore, under the patent laws, can Davis be held to be an inventor of the twisting rollers. If Stearns, by want of diligence, has forfeited the fruit of his conception, he has forfeited it to the public and not to the appellee. But I see no reason to impute want of diligence either to Davis or Stearns. The invention was discovered in May or June, 1858, and the models and specifications of both parties presented to the Patent Office—Davis' on the 14th of December and Stearns' on the 18th of December, 1858. No want of diligence was imputed by the Office to Davis, and his application was only four days earlier than the application of Stearns.

It is also assumed by the Office that advertisements and sales of the machine with the twisting rollers by Davis in the year 1858, claiming it as his invention on several occasions with the knowledge of Stearns, and not denied by him, is evidence that Davis was the true inventor or owner; but this *prima-facie* presumption (even supposing it to exist) is rebutted by the positive proof of Davis' own witnesses that Stearns was the inventor, by the absence of all proof that Stearns ever assigned to Davis, and by the affidavit of Davis himself, which (although no evidence against Stearns, it does not lie in Davis' mouth to gainsay) admits that Stearns was entitled, on certain terms therein set forth, to half the patent right.

The last objection urged by the Office to the claim of the appellant for a patent is that his improvement in the twisting rollers is substantially different from Davis', and that there is no conflict. Upon inspection of the models and specifications of the contending parties, the principle of the improvement appears to be the same; the difference is in mere mechanical detail and more elaborate finish in the model of Davis; both machines producing the same corrugated vertical or twisted rod. The contending parties and the witnesses on both sides treat the principle as the same, and the dispute was, and is, who invented it. The Office has made the same affirmation in declaring the interference.

Upon the whole, I am of opinion that the Honorable Commissioner of Patents erred in awarding a patent to Asahel Davis for the improvement in the twisting rollers referred to in his decision of the 16th of June, 1859, and that his judgment be, and the same is hereby, reversed. I am also of opinion that a patent ought to

issue to Charles Stearns for said improvement, on a proper application made by him limiting his application to the improvement in the twisting rollers, in combination with the corrugating rollers, producing the corrugated twisted copper rod.

E. W. Scott, for the appellant.

Munn & Co., for the appellee.

JAMES SPEAR, APPELLANT,

vs.

—— BELSON, ASSIGNOR TO STUART AND PETERSON, APPELLEES. INTERFERENCE.

SECRET INVENTION—PETITION AND SALE.—The statutory bar in section 7 of the act of 1839 to the inventor who sells his invention more than two years before his application, would seem by analogy properly applicable to the inventor who secretes his invention more than two years, and thereby injures the public.

SM—DELAY IN APPLYING FOR A PATENT.—An inventor who seeks the monopoly afforded by a patent must present his perfected invention to the Patent Office at once. He cannot privately use the invention for his own gain during several years, and then claim and expect protection for fourteen years longer.

SM—SM.—The right of the first and original discoverer to a patent cannot be defeated by a subsequent patentee unless the latter shows that the former has been guilty of culpable neglect and laches.

CASE STATED.—B. invented and perfected and privately used the invention in 1853. In 1858 his neighbor S. independently invented and patented the same thing, and put it into public use with the full knowledge of B., who applied for a patent one year later: *Held*, That B. had shown gross and culpable negligence, and had forfeited his right to a patent.

(Before DUNLOP, J., August, 1859.)

DUNLOP, J.

The question of jurisdiction has been brought to my notice by the appellees. For the reasons assigned by the Commissioner of Patents and Judge Merrick in the case of Babcock *v.* Degener