

the statute law, and on one of the greatest exponents of our system of jurisprudence, and I ask that faith be kept with me and that I have justice."

Is it an answer to such a petition to say: "No, what you have done, though new and useful, 'seems to us not to spring from that intuitive faculty of the mind put forth in the search for new results, or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; but, on the other hand, to be the suggestion of that common experience, which arose spontaneously and by necessity of human reasoning, in the minds of those who had become acquainted with the circumstances with which they had to deal?'"

And yet this is what the supreme court did say in the case of *Hollister v. Benedict* (see 113 U. S., page 72). But the question still remains, in a given case, by what formula, by what process of reasoning, are we to determine that subtle and essentially metaphysical distinction between invention and mechanical skill; and, in the face of a clear statute, which makes no such distinction, are we in each equity case to leave it to the judgment of a chancellor to say, in respect to admittedly new and useful things, "This is invention; that is mere mechanical skill?" Was it "the intuitive faculty of the mind put forth in the search of new results, or new methods, creating what had not before existed or bringing to light what lay hidden from vision," which told the man who knew that broken glass on the top of a brick wall or spikes on an iron fence would turn a thief, that a barb on a wire fence would repel a steer; or was it but the "suggestion of that common experience which arose spontaneously and by the necessity of human reasoning in the minds of those who had become acquainted with the circumstances with which they had to deal?" Yet in the barbed wire cases, 143 U. S., 275,* decided in 1892, the supreme court said that the barb on the fence wire was patentable invention, while in *Hollister v. Benedict*, 113 U. S., 593, decided in 1885, the same court said that the invention there under consideration was merely mechanical skill. In both cases the particular subjects of the patents were each recognized as new and useful; but in the barbed wire case the supreme court, without express reference to Judge Marshall's views, but in fact recognizing them and the force of the statute, applied those principles and up-

*In the case of the barbed wire patent, 143 U. S., 275, the invention of Glidden was not as broad as the difference between broken glass on the top of a wall or spikes on an iron fence and a barb on a fence wire; it was the difference between the substitution of a coiled wire prong, illustrated at page 276 of 143 U. S., and the diamond-shaped prong of the prior Kelly patent, illustrated at page 279 of 143 U. S.; and yet, as this difference was just the difference between failure and success, it was held to be a patentable difference.

held the patent, while in the case of *Hollister v. Benedict*, the supreme court, rejecting the plain language of the statute and the principles of Chief Justice Marshall, went into metaphysics, and as a result held the patent invalid, because, on its own metaphysical distinction, it found therein only the evidence of mechanical skill. There is nothing in the statute law which says a thing which is new and useful and the result of mechanical skill is not patentable. On the contrary, on its face and on any liberal construction of this statute, such as Chief Justice Marshall's opinion would imply, anything which comes within the broad terms and classes of the statute and is new and useful is patentable, whether or not it be the result of mechanical skill.

It is true there are certain obvious cases, such as the mere substitution of material—making a door-knob of clay or porcelain, instead of brass, iron, or wood,*—which, involving merely the selection of material, are held not to constitute a novel thing, and are, therefore, not patentable, because, in such cases, it is not "new" to merely substi-

**Hotchkiss v. Greenwood*, 11 Howard, 248. Mr. Justice Nelson, rendering the opinion of the supreme court in that case, is thus careful in stating the premises upon which the conclusion of the court is based, so much respect does he show for the language of the patent statute:

"The instruction assumes, and, as was admitted on the argument, properly assumed, that knobs of metal, wood, etc., connected with a shank and spindle, in the mode and by the means used by the patentees in their manufacture, had been before known, and were in public use at the date of the patent; and hence the only novelty which could be claimed on their part was the adaptation of this old contrivance to knobs of potter's clay or porcelain; in other words, the novelty consisted in the substitution of the clay knob in the place of one made of metal or wood, as the case might be. *And in order to appreciate still more clearly the extent of the novelty claimed, it is proper to add, that this knob of potter's clay is not new, and therefore constitutes no part of the discovery.* If it was, a very different question might arise, as it might very well be urged, and successfully urged, that a knob of a new composition of matter, to which this old contrivance had been applied, and which resulted in a new and useful article, was the proper subject of a patent.

"The novelty would consist in the new composition, made practically useful, for the purposes of life, by the means and contrivances mentioned. *It would be a new manufacture, and none the less so, within the meaning of the patent law, because the means employed to adapt the new composition to a useful purpose were old or well-known.*

"But in the case before us, the knob is 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 is securely fastened therein. All these were well-known, and in common use; and the only thing new is the substitution of a knob of a different material from that heretofore used in connection with this arrangement.

"Now it may very well be that, by connecting the clay or porcelain knob with the metallic shank in this well-known mode, an article is produced better and cheaper than in the case of the metallic or wood knob; but this does not result from any new mechanical device or contrivance; but from the fact that the material

tute one material for another; but, on the other hand, let it be shown that the new material in its new application performs some new function, as in the case of gutta-percha used as a non-conductor for wire, when a similar material had previously been used simply to prevent wire from rusting, and, *presto*, we have a patentable invention (*Colgate v. Western Union Telegraph Co.*, 15 Blatchf., 365).†

Novelty and Utility.

These cases illustrate that, after all, it is only novelty, combined with utility, that is, in fact, the test which should be applied. In the door-knob case, as the court found, from the facts presented, that the patented device did not show the slightest discovery, in any sense, but merely the selection of material applied in exactly the old way, and because the patented contrivance did not show the slightest mechanical skill or ingenuity, but merely the selection of old materials, accomplishing the same purpose in the same way, the court held the patent void for want of novelty. It distinctly appears from the opinion of the court in

of which the knob is composed happens to be better adapted to the purpose for which it is made. The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob.

"But this, of itself, can never be the subject of a patent. No one will pretend that a machine, made, in whole or in part, of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, can be distinguished from the old one; or, in the sense of the patent law, can entitle the manufacturer to a patent."

†In showing the novelty of the patent in the case of *Colgate v. Western Union Telegraph Co.*, Judge Blatchford, rendering the opinion of the court, states:

"The combination of gutta-percha and metallic wire in such form as to incase a wire or wires, or other conductors of electricity, with the non-conducting substance (gutta-percha), making a 'submarine telegraph cable,' at once flexible and convenient, which may be suspended on poles in the air, submerged in water, or buried in the earth to any extent, for atmospheric and submarine telegraphic communication, and for other electric, galvanic, and magnetic uses, as hereinbefore described.

"It is manifest," said the court, in this case, "that the gist of the invention is the discovery of the fact that gutta-percha is a non-conductor of electricity and the application of that fact to practical use by combining gutta-percha, by the means specified, with a metallic wire, in the manner described, and then using the cable formed by such combination for the purpose of conducting electricity along the enclosed wire. The point of the invention is not the mere mechanical covering of a metallic wire with gutta-percha, as a mechanical protection from abrasion or injury from without, or for any purpose aside from a use of the covered wire as a conductor of electricity. * * The claim is valid even though a metallic wire covered with gutta-percha existed before the plaintiff's invention, if it was not known that gutta-percha was a non-conductor of electricity and could be used to insulate the wire. The use by the patentee of the wire so covered to conduct electricity was not a double use of the covered wire, even though the covered wire existed before."