

Lowell v. Lewis, 15 Fed. Cas. 1018 (1817)
United States Circuit Court, D. Massachusetts.

Prepared by UNCTAD's Intellectual Property Unit

Summary

This case concerned three main issues in the context of patent infringement litigation: (1) who bears the burden of proving validity or invalidity of the patent; (2) what is required for an invention to be “useful” or “capable of industrial application”; and (3) what degree of similarity is needed for an accused product to infringe a patent. The Circuit Court of Massachusetts/United States decided that the plaintiff in a patent infringement suit bears the burden of proving the validity of its patent by establishing novelty and industrial application. In support of such proof, the fact that the patent was granted establishes a *prima facie* case of patent validity, but only “of a very slight nature”, according to the Court. The Court made clear that requirements for utility should not be too high. It considered “useful” anything that was not detrimental to society. An accused product, in the view of the Court, infringes a patent when it has substantially the same structure to pursue the same purpose.

The facts¹

On March 23, 1813, Mr. Jacob Perkins obtained a patent for a new and useful invention in the construction of pumps, and afterwards assigned his interest therein to the plaintiff [Francis C. Lowell]. The defendant [Winslow Lewis], became the assignee of a similar patent, taken out in 1817, by a Mr. James Baker; and it was for the constructing and vending pumps under this second patent, that the action was brought.

The principle object of both the inventions was, by dispensing with the box used in the common pumps, to obtain a larger waterway. To effect this, Perkins so constructed the valves of his pump, that they completely filled the area of the shaft, and fell upon its sides in the same manner, as by the old construction they did upon the box; thus leaving the whole of the area, excepting that occupied by the valves themselves, for a water-way. The valves were of a triangular shape and adapted only to a pump of a square form. This pump seemed to be principally useful, when it was desirable to throw up large quantities of water in a short space of time, and a number of hands could be put to the working of it. The valves of Baker's pump were fitted to a round shaft, and occupied, like the other, the whole of its area: but instead of resting upon the sides of the shaft, were supported by a brass rim, which prevented the friction against the sides of the shaft consequent upon the other construction, and to obviate which, Perkins, since obtaining his patent, had adopted a checkbolt. It appeared, that Baker's invention required fewer hands to work it, and could be applied to the common house pump.

The defendant contended, that the invention of Perkins was neither new or useful, and therefore, not entitled to a patent. That the specification was so loose and insufficient, as not to answer the requisites of the law in this particular, and the patent, therefore,

¹ Source: <https://law.resource.org/pub/us/case/reporter/F.Cas/0015.f.cas/0015.f.cas.1018.2.pdf>

void on that account: and further, that the invention of the defendant was substantially different from that of the plaintiff.

The plaintiff endeavored to show, that the improvement invented by Perkins was entirely new, and highly useful; and the specification sufficient to answer the requisites of the law, which only required, that it should be so particular, as that persons, acquainted with the construction of the same kind of machines, might be able to follow the description of it. And that, although differing in shape and some other unimportant particulars, it was, in principle, the same as that made and recorded by the defendant, under the patent of Baker.

The legal issues

The Court reasoned as follows:

“To entitle the plaintiff to a verdict, he must establish, that his machine is a new and useful invention; and of these facts his patent is to be considered merely prima facie evidence of a very slight nature. He must, in the first place, establish it to be a useful invention; for the law will not allow the plaintiff to recover, if the invention be of a mischievous or injurious tendency. The defendant, however, has asserted a much more broad and sweeping doctrine; and one, which I feel myself called upon to negative in the most explicit manner. He contends, that it is necessary for the plaintiff to prove, that his invention is of general utility; so that in fact, for the ordinary purposes of life, it must supersede the pumps in common use. In short, that it must be, for the public, a better pump than the common pump; and that unless the plaintiff can establish this position, the law will not give him the benefit of a patent, even though in some peculiar cases his invention might be applied with advantage. I do not so understand the law. The patent act (Act Feb. 21, 1793, c. 11 [1 Stat. 318]) uses the phrase “useful invention” mere incidentally; it occurs only in the first section, and there it seems merely descriptive of the subject matter of the application, or of the conviction of the applicant. The language is, “when any person or persons shall allege, that he or they have invented any new and useful art, machine,” &c., he or they may, on pursuing the directions of the act, obtain a patent Neither the oath required by the second section, nor the special matter of defence allowed to be given in evidence by the sixth section of the act, contains any such qualification or reference to general utility, to establish the validity of the patent. Nor is it alluded to in the tenth section as a cause, for which the patent may be vacated. To be sure, all the matters of defence or of objection to the patent are not enumerated in these sections. *Whitemore v. Cutter* [Case No. 17,600]. [1 Robb. Pat. Cas. 28–33.]² But if such an one as that now contended for, had been intended, it is scarcely possible to account for its omission. In my judgment the argument is utterly without foundation. All that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. The word “useful,” therefore, is incorporated into the act in contradistinction to mischievous or immoral. For instance, a new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the interests of the patentee, but of no importance to the public. If it

be not extensively useful, it will silently sink into contempt and disregard. There is no pretence, that Mr. Perkins pump is a mischievous invention; and if it has been used injuriously to the patentee by the defendant, it certainly does not lie in his mouth to contest its general utility, indeed the defendant asserts, that Baker's pump is useful in a very eminent degree, and, if it be substantially the same as Perkins's, there is an end of the objection; if it be not substantially the same, then the plaintiff must fail in his action. So that, in either view the abstract question seems hardly of any importance in this cause.”²

[...]

“Another (and under the circumstances of this case, probably the most material) inquiry is, whether the defendant has violated the patent-right of the plaintiff; and that depends upon the fact, whether the pumps of Mr. Perkins and of Mr. Baker are substantially the same invention. I say substantially the same invention, because a mere change of the form or proportions of any machine cannot, per se, be deemed a new invention. If they are the same invention, then Mr. Perkins, being clearly the first inventor, is entitled exclusively to the patent right, although Mr. Baker may have been also an original inventor; for the law gives the right, as among inventors, to him, who is first in time.

The manner, in which Mr. Perkins's invention is, in his specification, proposed to be used, is in a square pump, with triangular valves, connected in the centre, and resting without any box on the sides of the pump, at such an angle as exactly to fit the four sides. The pump of Mr. Baker, on the other hand, is fitted only for a circular tube, with butterfly valves of an oval shape, connected in the centre, and resting, not on the sides of the pump, but on a metal rim, at a given angle, so that the rim may not be exactly in contact with the sides, but the valve may be. If from the whole evidence the jury is satisfied, that these differences are mere changes of form, without any material alteration in real structure, then the plaintiff is entitled to recover; if they are substantially different combinations of mechanical parts to effect the same purposes, then the defendant is entitled to a verdict. This is a question of fact, which I leave entirely to the sound judgment of the jury.”³

Points of significance

- While the Court considered the grant of the patent as *prima facie* evidence for the validity of the patent, it assessed such evidence as being only of “very slight nature” and obliged the plaintiff / patent holder to demonstrate that its patent was useful. The case is from 1817. In the meantime, the grant of a patent has gained significantly in importance in burden of proof issues. A granted patent is usually considered as establishing a presumption of validity, obliging the alleged infringer to demonstrate that the patent is not valid for lack of novelty, inventive step or utility. The burden of proof has since *Lowell*

² https://sites.oxy.edu/whitney/xaccess/ec357/cases/property/lowell_v_lewis.htm , second paragraph.

³ *Ibid*, at the end of the judgment.

v. Lewis shifted in favor of the patent holder, facilitating its task of proving patent infringement.⁴

- The comparison by the Court of the two inventions as cited above may be considered a predecessor of the so-called “doctrine of equivalents”, which was subsequently established in many jurisdictions. In essence, this doctrine seeks to accommodate the difficulty of patent applicants to foresee every possible infringement of their claims. The doctrine helps establish a case of patent infringement even where the accused action does not fall literally within the scope of the claimed invention, provided the accused action may be considered equivalent to the claimed invention. In the case at hand, the judge clarified that an accused product that pursues the same purpose as the patented invention, but through substantially different means, will not infringe the patent. For the United States, this concept was much later elaborated to affirm infringement where the accused technology performs the same function in the same way to achieve the same result as the patented invention.⁵
- On utility, the Court rejected a requirement that the invention should be more useful than the prior art. Instead, the Court considered the utility criterion as broadly describing anything that is not detrimental to society. Subsequent case law has elaborated on this, requiring “substantial” and “specific” utility (see *Brenner v. Manson*, 1966, in this database).

Key words

Patent validity, burden of proof, utility/industrial application, doctrine of equivalents.

Available at:

https://sites.oxy.edu/whitney/xaccess/ec357/cases/property/lowell_v_lewis.htm

<https://law.resource.org/pub/us/case/reporter/F.Cas/0015.f.cas/0015.f.cas.1018.2.pdf>

⁴ See for example 35 US Code § 282(a) : « **In General.**— A patent shall be presumed valid. [...]”

⁵ US Supreme Court in *Graver Tank v Linde Air Products Co.*, 339 U.S. 605, 85 USPQ2d 328 (1950). For a discussion, see UNCTAD, “Using Intellectual Property Rights to Stimulate Pharmaceutical Production in Developing Countries. A Reference Guide”, p. 96. Available at https://unctad.org/system/files/official-document/diaepcb2009d19_en.pdf