

But, in this country, Letters Patent for inventions are not granted in the exercise of prerogative, or as a matter of favor, but under article 1, section 8, of the Constitution of the United States, which gives Congress power—

“to promote the progress of science and useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective writings and discoveries.”

The patent act provides that every patent shall contain a grant to the patentee, his heirs and assigns, for a certain term of years, of—

“the exclusive right to make, use and vend the invention or discovery throughout the United States. (Rev. Stat. 4884.)”

And this Court has repeatedly and uniformly declared that the United States has no more right than any private person to use a patented invention without license of the patentee or making compensation to him. (United States v. Burns, 12 Wall. 246, 252; Cammeyer v. Newton, 11 O. G. 287, 94 U. S. 225, 235; James v. Campbell, 21 O. G. 337, 104 U. S. 356, 358; Hollister v. Benedict Manufacturing Co., 113 U. S. 59, 67; United States v. Palmer, 128 U. S. 262, 270-272.)

The United States, however, like all sovereigns, cannot be impleaded in a judicial tribunal, except so far as they have consented to be sued. This doctrine has been affirmed by this Court in cases too numerous to be cited; and was clearly stated by Mr. Justice Field, delivering judgment in the case of *The Siren*, as follows:

“It is a familiar doctrine of the common law, that the sovereign cannot be sued in his own courts without his consent. The doctrine rests upon reasons of public policy; the inconvenience and danger which would follow from any different rule. It is obvious that the public service would be hindered, and the public safety endangered, if the supreme authority could be subjected to suit at the instance of every citizen, and consequently controlled in the use and disposition of the means required for the proper administration of the government. The exemption from direct suit is, therefore, without exception. This doctrine of the common law is equally applicable to the supreme authority of the nation, the United States. They cannot be subjected to legal proceedings, at law or in equity, without their consent; and whoever institutes such proceedings must bring his case within the authority of some act of Congress. Such is the language of this Court in *United States v. Clarke*, 8 Pet. 444. The same exemption from judicial process extends to the property of the United States, and for the same reasons. As justly observed by the learned judge who tried this case, there is no distinction between suits against the Government directly, and suits against its property. (7 Wall. 152-154.)”

So much of this statement as regards suits against the United States, or against their property, was repeated by the present Chief Justice in the recent case of *Stanley v. Schwalby*, 147 U. S. 508, 512.

It necessarily follows that, unless expressly permitted by act of Congress, no injunction can be granted against the United States. (*United States v. McLemore*, 4 How. 286; *Hill v. United States*, 9 How. 386; *Case v. Terrell*, 11 Wall. 199.)

The United States, by successive acts of Congress, have consented to be sued upon their contracts, either in the Court of Claims, or in a circuit or district court of the United States. (Acts of February 24, 1855, ch. 122, sec. 1, 10 Stats., 612; March 3, 1863, ch. 92, sec. 2, 12 Stats. 765; Rev. Stats., sec. 1059; act of March 3, 1887, ch. 359, secs. 1, 2, 24 Stats. 505; *United States v. Jones*, 131 U. S. 1, 15, 16.) The United States may accordingly be sued by a patentee for their use of his invention under a contract made with him by the United States or by their authorized officers. (*United States v. Burns*, 12 Wall. 246; *United States v. Palmer*, 128 U. S. 262; *United States v. Berdan Co.*, 156 U. S. 552.)

But the United States have not consented to be liable to suits, founded in tort, for wrongs done by their officers, though in the discharge of their official duties. (*Gibbons v. United States*, 8 Wall. 269; *Morgan v. United States*, 14 Wall. 531, 534; *Langford v. United States*, 101 U. S. 341; *United States v. Jones*, 131 U. S. 1, 16, 18; *German Bank v. United States*, 148 U. S. 573, 579, 580; *Hill v. United States*, 149 U. S. 593.) The United States, therefore, are not liable to a suit for an infringement of a patent, that being an action sounding in tort. (*Schilling v. United States*, 69 O. G. 1505, 155 U. S. 163; *United States v. Berdan Co.*, 156 U. S. 552.)

A public officer is not personally liable on a contract, although under his own hand and seal, made by him in the line of his duty, by legal authority, and on account of the Government, and enuring to its benefit, and not to his own. (*Hodgson v. Dexter*, 1 Cranch 345. See, also, *Macbeath v. Haldimand*, 1 T. R. 172; *Unwin v. Wolseley*, 1 T. R. 674; *Palmer v. Hutchinson*, 6 App. Cas. 619.)

But the exemption of the United States from judicial process does not protect their officers and agents, civil or military, in time of peace, from being personally liable to an action of tort by a private person whose rights of property they have wrongfully invaded or injured, even by authority of the United States. (*Little v. Barreme*, 2 Cranch 169; *Bates v. Clark*, 95 U. S. 204.) Such officers or agents, although acting under order of the United States, are therefore personally liable to be sued for their own

infringement of a patent. (*Cammeyer v. Newton*, 11 O. G. 287, 94 U. S. 225, 235. See, also, *Feather v. The Queen*, 6 B. & S. 257, 297; *Vavasseur v. Krupp*, 9 Ch. D. 351, 355, 358.)

The extent to which officers or agents of the Government may be restrained by injunction from doing unlawful acts to the prejudice of private rights is illustrated by the decisions of this Court regarding injunctions from the courts of the United States to officers and agents of a State which, by the Constitution of the United States, is as exempt as the United States are from private suit. (*Hans v. Louisiana*, 134 U. S. 1.)

In a suit to which the State is neither formally nor really a party, its officers, although acting by its order and for its benefit, may be restrained by injunction, when the remedy at law is inadequate, from doing positive acts, for which they are personally and individually liable, taking or injuring the plaintiff's property, contrary to a plain official duty requiring no exercise of discretion, and in violation of the Constitution or laws of the United States. (*Osborn v. Bank of United States*, 9 Wheat, 738, 868, 871; *Board of Liquidation v. McComb*, 92 U. S. 531, 541; *Allen v. Baltimore & Ohio Railroad*, 114 U. S. 311; *Pennoyer v. McConnaughy*, 140 U. S. 1.)

But no injunction can be issued against officers of a State, to restrain or control the use of property already in the possession of the State, or money in its treasury when the suit is commenced; or to compel the State to perform its obligations; or where the State has otherwise such an interest in the object of the suit as to be a necessary party. (*Louisiana v. Jumel*, and *Elliott v. Wiltz*, 107 U. S. 711, 720-728; *Cunningham v. Macon & Brunswick Railroad*, 109 U. S. 446, 454-457; *Hagood v. Sothern*, 117 U. S. 52, 70; *In re Ayers*, 123 U. S. 443; *North Carolina v. Temple*, 134 U. S. 22; *McGahey v. Virginia*, 135 U. S. 662, 684.)

In support of the decree below, much reliance was placed upon *United States v. Lee*, 106 U. S. 196; *Stanley v. Schwalby*, 147 U. S. 508; and *The Virginia Coupon Cases*, 114 U. S. 269.

In *United States v. Lee*, the decision of the Court, speaking by Mr. Justice Miller, was that the owner of land held and occupied by the United States for public uses, but under a defective title, might maintain, against the officers in possession of the land under authority of the United States, an action of ejectment, notwithstanding the interposition of the Attorney-General in behalf of the United States.

A year afterward Mr. Justice Miller, again delivering the opinion of the Court, after mentioning a different class of cases, said:

“Another class of cases is where an individual is sued in

tort for some act injurious to another in regard to person or property, to which his defense is that he has acted under the orders of the Government. In these cases he is not sued as, or because he is, the officer of the Government, but as an individual, and the court is not ousted of jurisdiction because he asserts authority as such officer. To make out his defense he must show that his authority was sufficient in law to protect him."

After citing several cases to this point, he added:

"To this class belongs also the recent case of *United States v. Lee*, 106 U. S. 196, for the action of ejectment in that case is, in its essential character, an action of trespass, with the power in the Court to restore the possession to the plaintiff as part of the judgment. And the defendants Strong and Kaufman, being sued individually as trespassers, set up their authority as officers of the United States, which this Court held to be unlawful, and therefore insufficient as a defense. The judgment in that case did not conclude the United States, as the opinion carefully stated, but held the officers liable as unauthorized trespassers, and turned them out of their unlawful possession. (*Cunningham v. Macon & Brunswick Railroad*, 109 U. S. 446, 452.)"

This statement of the decision in *United States v. Lee* was repeated in *Stanley v. Schwalby*, in which the point decided was that the statute of limitations, or adverse possession, might be pleaded in defense of an action of trespass to try title against officers of the United States. (147 U. S. 508, 518.)

In *Cunningham v. Macon & Brunswick Railroad* above cited, a bill in equity to foreclose a second mortgage of a railroad, and to set aside as invalid a sale and conveyance of the road to the State of Georgia under a foreclosure of the first mortgage, was filed by holders of bonds secured by the second mortgage against the governor and the treasurer of the State, as well as against the railroad company and its directors; and was ordered to be dismissed for want of jurisdiction, because, as was said in the opinion—

"it may be accepted as a point of departure unquestioned, that neither a State nor the United States can be sued as defendant in any court in this country without their consent, except in the limited class of cases in which a State may be made a party in the Supreme Court of the United States by virtue of the original jurisdiction conferred on this court by the Constitution. This principle is conceded in all the cases, and whenever it can be clearly seen that the State is an indispensable party to enable the Court, according to the rules which govern its procedure, to grant the relief sought, it will refuse to take jurisdiction.

"In the case now under consideration, the State of Georgia is

an indispensable party. It is in fact the only proper defendant in the case. No one sued has any personal interest in the matter, or any official authority to grant the relief asked. No foreclosure suit can be sustained without the State, because she has the legal title to the property, and the purchaser under a foreclosure decree would get no title in the absence of the State. The State is in the actual possession of the property, and the Court can deliver no possession to the purchaser. The entire interest adverse to plaintiff in this suit is the interest of the State of Georgia in the property, of which she has both the title and possession. (109 U. S. 451, 457.)

In the cases cited by the appellee, reported under the head of *The Virginia Coupon Cases*, 114 U. S. 269, where a collector of taxes due to the State of Virginia refused to receive coupons of the State tendered in payment of such a tax, because forbidden to do so by a statute of the State, which was unconstitutional and void as impairing the obligation of the contract made by the State with the holders of such coupons in the statute under which they were issued, the Court, speaking by Mr. Justice Matthews, held that the collector was liable to an action of detinue, or of trespass, for distraining personal property for non-payment of the tax; or, where the remedy at law was inadequate might be restrained by injunction from making the distraint. (*Poin-dexter v. Greenhow*, 114 U. S. 270; *Chaffin v. Taylor*, 114 U. S. 309; *Allen v. Baltimore & Ohio Railroad*, 114 U. S. 311.)

But where the Circuit Court of the United States, at the suit of one who had tendered such coupons in payment of his taxes, issued an injunction against the attorney-general and other attorneys of the State of Virginia to restrain them from bringing any action in behalf of the State to recover such taxes, and, upon their bringing such actions, committed them for contempt in disobeying the injunction, they were discharged by this Court on writs of habeas corpus. Mr. Justice Matthews, again delivering its opinion, and fully reviewing the previous cases, said that from the decision in *Cunningham v. Macon & Brunswick Railroad*, above cited—

“the inference is, that where it is manifest, upon the face of the record, that the defendants have no individual interest in the controversy, and that the relief sought against them is only in their official capacity as representatives of the State, which alone is to be affected by the judgment or decree, the question then arising, whether the suit is not substantially a suit against the State, is one of jurisdiction;”

and added that actions had been sustained against officers acting in behalf of a State—

“only in those instances where the act complained of, considered

apart from the official authority alleged as to its justification, and as the personal act of the individual defendant, constituted a violation of right for which the plaintiff was entitled to a remedy at law or in equity against the wrong-doer in his individual character ;”

and that the eleventh amendment of the Constitution, declaring that—

“the judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by citizens of another State, or by citizens or subjects of any foreign State”—

must be held—

“to cover, not only suits brought against a State by name, but those also against its officers, agents and representatives, where the State, though not named as such, is, nevertheless, the only real party against which alone in fact the relief is asked; and against which the judgment or decree effectively operates ;”

and therefore concluded that the suit in which the injunction was granted was in substance and in law a suit against the State of Virginia, and consequently the circuit court was without jurisdiction to entertain it, the order of injunction and the commitments for contempt were null and void, and the imprisonment of the officers was without authority of law. (In re Ayers, 123 U. S. 443, 489, 502, 506, 507.)

When the matter of the Virginia coupons was last brought before this Court, Mr. Justice Bradley, delivering its unanimous opinion, summed up, as the result of the previous decisions, so far as concerns the subject now under consideration—

“that no proceedings can be instituted by any holder of said bonds or coupons against the Commonwealth of Virginia, either directly by suit against the Commonwealth by name, or indirectly against her executive officers to control them in the exercise of their official functions as agents of the State ;”

but that any holder—

“who tenders such coupons in payment of taxes, debts, dues and demands due from him to the State, and continues to hold himself ready to tender the same in payment thereof, is entitled to be free from molestation in person or goods on account of such taxes, debts, dues or demands, and may vindicate such right in all lawful modes of redress—by suit to recover his property, by suit against the officer to recover damages for taking it, by injunction to prevent such taking where it would be attended with irremediable injury, or by a defense to a suit brought against him for his taxes or the other claims standing against him. (McGahey v. Virginia, 135 U. S. 662, 684.)

And this summary was repeated and approved in *Pennoyer v. McConnaughy*, 140 U. S. 1, 15.

It only remains to apply the principles established by the former decisions to this suit under the patent act of the United States.

That act not only provides that—

“damages for the infringement of any patent may be recovered by action on the case;”

but also provides that—

“the several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same, or cause the same to be assessed under its direction. (Rev. Stat. 4919, 4921.)”

This bill in equity was filed by the owner of Letters Patent for an improvement in caisson-gates, and alleged that the defendants infringed the patent by manufacturing and using such gates. The defendants filed a plea to the whole bill, and the Attorney-General in behalf of the United States filed a suggestion, the single ground of each of which was that the only caisson-gate that the defendants had any relation with was not made by them, and was not used by them for their own benefit, but was made and used by the United States in a dry-dock at a navy-yard, and the defendants only operated and used it as officers, servants and employes of the United States. The fact so pleaded and suggested could not, consistently with the previous decisions, above cited, prevent the defendants from being held liable to the patentee for their own infringement of his patent. There was no error, therefore, in overruling the plea of the defendants, and the suggestion of the Attorney-General.

But the circuit court erred in awarding an injunction against the defendants.

As this Court, when deciding that things manufactured under Letters Patent of the United States were subject to be taxed by a State like other property, said:

“The right of property in the physical substance, which is the fruit of the discovery, is altogether distinct from the right in the discovery itself. (Patterson v. Kentucky, 97 U. S. 501, 506.)”

Title in the thing manufactured does not give the right to use the patented invention; no more does the patent right in the invention give title in the thing made in violation of the patent.

In an English case, quite analogous to the case at bar, where shells, bought and owned by a foreign sovereign, were brought

to England to be put on board his ships of war, the court of appeal held that his agents, if they used the shells in England in infringement of an English patent, might be liable in damages to the patentee, but that the court could not restrain the delivery of the shells to the sovereign to whom they belonged. Lord Justice Brett said: "The patent law has nothing to do with property;" and Lord Justice Cotton expressed the same idea more fully, as follows:

"The property in articles which are made in violation of a patent is notwithstanding the privilege of the patentee, in the infringer if he would otherwise have the property in them. The court, in a suit to restrain the infringement of a patent, does not proceed on the footing that the defendant proved to have infringed has no property in the articles; but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights, and does this as the most effectual mode of protecting the plaintiff's rights—not on the footing that there is no property in the defendant. The court cannot proceed to give that relief, and interfere with the articles, unless it has before it the person entitled to the articles in question, and has as against this person power to adjudicate that the articles are made or used in infringement of the plaintiff's rights. (*Vavasseur v. Krupp*, 9 Ch. D. 351, 358, 360.)"

In the present case, the caisson-gate was a part of the dry-dock in a navy-yard of the United States, was constructed and put in place by the United States, and was the property of the United States, and held and used by the United States for the public benefit. If the gate was made in infringement of the plaintiff's patent, that did not prevent the title in the gate from vesting in the United States. The United States, then, had both the title and the possession of the property. The United States could not hold or use it, except through officers and agents. Although this suit was not brought against the United States by name, but against their officers and agents only, nevertheless, so far as the bill prayed for an injunction, and for the destruction of the gate in question, the defendants had no individual interest in the controversy; the entire interest adverse to the plaintiff was the interest of the United States in property of which the United States had both the title and the possession; the United States were the only real party, against whom alone in fact the relief was asked, and against whom the decree would effectively operate; the plaintiff sought to control the defendants in their official capacity, and in the exercise of their official functions, as



representatives and agents of the United States, and thereby to defeat the use by the United States of property owned and used by the United States for the common defense and general welfare; and therefore the United States were an indispensable party to enable the court, according to the rules which govern its procedure, to grant the relief sought; and the suit could not be maintained without violating the principles affirmed in the long series of decisions of this Court, above cited.

There was also error in the final decree awarding profits to the plaintiff as against the defendants.

In a suit in equity for the infringement of a patent, the ground upon which profits are recovered is that they are the benefits which have accrued to the defendants from their wrongful use of the plaintiff's invention, and for which they are liable, *ex aequo et bono*, to the like extent as a trustee would be who had used the trust property for his own advantage. The defendants, in any such suit, are therefore liable to account for such profits only as have accrued to themselves from the use of the invention, and not for those which have accrued to another, and in which they have no participation. (*Elizabeth v. Pavement Co.*, 97 U. S. 126, 138-140; *Root v. Railway Co.*, 21 O. G. 1112, 105 U. S. 189; *Tilghman v. Proctor*, 43 O. G. 628, 125 U. S. 136, 144-148; *Keystone Co. v. Adams*, 66 O. G. 654, 151 U. S. 139, 147; *Coupe v. Royer*, 70 O. G. 779, 155 U. S. 565, 583.)

In the leading case of *Elizabeth v. Pavement Co.*, a suit in equity for the infringement of a patent for an improvement in wooden pavements was brought against a city, as well as against the contractor who had laid down the pavements. It being shown that the city had made no profits from the use of the invention, but that the contractor had, this Court held that profits could be recovered against the contractor only, and not against the city. Mr. Justice Bradley, in delivering judgment, said:

"One thing may be affirmed with reasonable confidence, that if an infringer of a patent has realized no profit from the use of the invention, he cannot be called upon to respond for profits; the patentee, in such case, is left to his remedy for damages. (97 U. S. 138.)"

In the case at bar, there was no evidence that the defendants themselves had made any profits whatever from the use of the plaintiff's invention; but the only gains, profits and advantages, upon which the report of the master and the decree of the court were based, were those which had accrued to the United States from the saving in the cost of the gate; and the master found that no damages, in addition to such gains, profits and advantages, had been proved.

The necessary result is that, even if the validity of the patent

and its infringement by the defendants are assumed, the plaintiff, upon this record, is not entitled to an injunction, to profits, or to damages.

The finding of the master, that no damages, in addition to profits, had been proved, does not indeed necessarily imply that the plaintiff had not sustained damages, independent of any profits. But no ground for equitable relief, by injunction, by account of profits, or otherwise, being shown, the proper remedy of the plaintiff against the defendants for such damages is by action at law. (*Elizabeth v. Pavement Co.*, and *Root v. Railway Co.*, above cited.)

The question whether the United States might be liable, in a suit against them in the Court of Claims, or other court of concurrent jurisdiction, as upon a contract, for their use of the caisson-gate, if an infringement of the plaintiff's patent, does not arise, and cannot be decided, in this case.

In order that the rights of all parties interested in the controversy may be preserved, the entry in this case will be: "Decree of the circuit court reversed, and case remanded to that court with directions to dismiss the bill, without prejudice to an action at law against the defendants, or to a suit against the United States."

Mr. Justice Peckham, not having been a member of the Court when this case was argued, took no part in the decision.

Mr. Justice Harlan dissenting.

I am unable to concur in the disposition which has been made of this case.

As stated in the opinion of the majority, this Court has frequently held that the United States has no more right than any private person to use a patented invention without license of the patentee or without making or securing compensation to him. It is not claimed that the defendants used the plaintiff's patent under a license from him, or that compensation or provision for compensation has been made. The Government is, therefore, under an implied obligation to compensate the plaintiff. That obligation arises from the Constitution, which declares that private property shall not be taken for public use without just compensation. Upon this point the Court in *United States v. Great Falls Mfg. Co.*, 112 U. S. 645, 657 said:

"Such an implication being consistent with the constitutional duty of the Government, as well as with common justice, the claimant's cause of action is one that arises out of implied contract, within the meaning of the statute which confers jurisdiction upon the Court of Claims of actions founded 'upon any contract, expressed or implied, with the Government of the United States.'"

The same principle was recognized in *Great Falls Mfg. Co. v. Attorney-General*, 124 U. S. 581, 597; *United States v. Alexander*, 148 U. S. 186, 191, and *Schillinger v. United States*, 69 O. G. 1505, 155 U. S. 163, 174, 175. In this view—the defendants being public officers who derive no personal advantage from the use by the Government of the plaintiff's invention—the prayer for an injunction might well have been denied upon the ground that there was an adequate and complete remedy by a suit against the United States as upon implied contract. But the Court does not proceed distinctly on that ground.

If the plaintiff cannot sue the United States to recover compensation for the use of his invention, actually appropriated by the Government for public use, then the only adequate remedy for him would be an injunction against the individual officers, who are proceeding without his license, and without any provision having been made for his being compensated. This must be so, unless the Court is prepared to hold that there is no remedy, under the Constitution, for the protection of private rights against illegal invasion by officers of the Government. In *United States v. Lee*, 106 U. S. 196, this Court said that when the citizen—

“in one of the courts of competent jurisdiction, has established his right of property, there is no reason why deference to any person, natural or artificial, not even the United States, should prevent him from using the means which the law gives him for the protection and enforcement of that right;”

that—

“no man in this country is so high that he is above the law; no officer of the law may set that law at defiance with impunity; all the officers of the Government, from the highest to the lowest, are creatures of the law, and are bound to obey it.”

If the United States may appropriate to public use the invention of a patentee, without his consent, and without liability to suit, as upon implied contract, for the value of the use of such invention; if, as the Court holds, a public officer acting only in the interest of the public, is not individually liable for gains, profits and advantages that may accrue to the United States from such use; and if the officer who thus violates the rights of the patentee cannot be restrained by injunction, then the Government may well be regarded as organized robbery so far as the rights of patentees are concerned.

Instead of leaving open the question whether the United States was liable to suit, as upon implied contract, the prayer for injunction, if denied, should have been denied upon the ground, and only upon the ground, that the plaintiff had a complete and adequate remedy by a suit against the Government.

823. GILL v. UNITED STATES, 160 U. S. 426, 40 L. ed. 480 (1896).\* \* \*

Mr. Justice Brown, after stating the facts in the foregoing language, delivered the opinion of the court.

This case raises the question, which has been several times presented to this court, whether an employe paid by salary or wages, who devises an improved method of doing his work, using the property or labor of his employer to put his invention into practical form, and assenting to the use of such improvements by his employer, may, by taking out a patent upon such invention, recover a royalty or other compensation for such use. In a series of cases, to which fuller reference will be made hereafter, we have held that this could not be done.

The principle is really an application or outgrowth of the law of estoppel in pais, by which a person looking on and assenting to that which he has power to prevent is held to be precluded ever afterwards from maintaining an action for damages. A familiar instance is that of one who stands by while a sale is being made of property in which he has an interest, and makes no claim thereto, in which case he is held to be estopped from setting up such claim. The same principle is applied to an inventor who makes his discovery public, looks on, and permits others to use it without objection or assertion of a claim for a royalty. In such case he is held to abandon his inchoate right to the exclusive use of his invention, to which a patent would have entitled him, had it been applied for before such use. As was said by Mr. Justice Story in *Pennock v. Dialogue*, 2 Pet. 1, 16: "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." "It is possible," said the trial court, in charging the jury, "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 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." This language was quoted with approval in *Grant v. Raymond*, 6 Pet. 218. So, also, in *Shaw v. Cooper*, 7 Pet. 292, 323, it was held directly that, "whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatsoever, without the immediate assertion of his right, he is not entitled to a patent."

The application of this principle to a single individual whom

the patentee has permitted to make use of his invention without claiming compensation therefor first arose in *McClurg v. Kingsland*, 1 How. 202. In this case the patentee, Harley, was employed by the defendants at their foundry upon weekly wages. While so employed, he invented the patented improvements, making experiments in the defendants' foundry, and wholly at their expense. The result proving useful, his wages were increased. He continued in their employment, during all of which time he made rollers for them, spoke about procuring a patent, and finally made an application, which was granted. He assigned the patent to the plaintiffs, after the defendants had declined his proposition that they should take out a patent, and purchase his right. He made no demand upon them for compensation for using his improvement, and gave them no notice not to use it, until a misunderstanding had arisen, when he left their employment, and made an agreement with plaintiffs to assign his right to them. The defendants continuing to make the rollers on his plan, the action was brought by the plaintiffs, without any previous notice by them. It was held that the facts above stated justified the presumption of a license to use the invention, and that the charge of the court that the defendants might continue to use it without liability to the plaintiffs was correct.

In the case of *Solomons v. U. S.*, 137 U. S. 342, 11 Sup. Ct. 88, one Clark, who was in the employ of the government as chief of the bureau of engraving and printing, conceived the idea of a self-canceling stamp, and prepared a die or plate therefor, making use of the services of the employes of the bureau and the property of the government. While his application for a patent was pending, he assigned his rights to the appellant, Solomons, in payment of an account between them. On taking out the patent the appellant notified the commissioner of internal revenue that he was the owner of the patent, and demanded compensation for the use of the stamp on whisky barrels. It further appeared that Mr. Clark, as chief of the bureau, had been assigned the duty of devising a stamp for this purpose, and it was not understood or intimated that the stamp which he was to device should be patented, or become his personal property. Indeed, before the final adoption of the stamp, he said that the design was his own, but he should make no charge to the government therefor, as he was employed on a salary by the government, and had used its machinery and other property in the perfection of the stamp. It was held that, having been employed and paid to devise a new stamp, the invention, when accomplished, became the property of the government, and that the patentee had practically sold in advance whatever he might be able to accomplish in that direction.

A similar case was that of *Lane & Bodley Co. v. Locke*, 150 U. S. 193, 14 Sup. Ct. 78, in which an engineer and draftsman at a fixed salary, in the employ of the defendants, and using their tools and patterns, invented a stop valve, which the firm used with his knowledge in certain elevators constructed by them until its dissolution, and after that a corporation organized by the firm used it in the same way, and with the like knowledge. It was held that the patentee, having made no claim for remuneration for the use of the patent, saying that he did not desire to disturb his friendly relations with the firm, might be presumed to have recognized an obligation to permit them to use the invention.

In *McAleer v. U. S.*, 150 U. S. 424, 14 Sup. Ct. 160, there was an express license by an employe in the treasury department to such department and its bureaus of a right to make and use machines containing the improvements of the patentee to the end of the patented term, and it was held that this agreement could not be varied by parol evidence that it was to terminate upon the discharge of the patentee from the employment of the government.

In *Keyes v. Mining Co.*, 158 U. S. 150, 15 Sup. Ct. 772, a person in the employ of a smelting company invented a new method of withdrawing molten metal from a furnace, took out a patent for it, and permitted his employer to use it without charge so long as he remained in its employ, which was about 10 years. It was held that there was at least an implied license to use the improvement without payment of royalties during the continuance of his employment, and also a license to use the invention upon the same terms and royalties fixed for other parties, from the time the patentee left the defendant's employment.

An attempt is made to differentiate the case under consideration from those above cited in the fact, stated in the third finding, that the invention in this case, until it was reduced to paper, in the form of an intelligible drawing, was made out of the hours of labor at the arsenal, and during the time which properly belonged to the patentee; and that, by finding 4, "the claimant did not use any property of the defendants or the services of any of the employes of the defendants in making or developing or perfecting the inventions themselves." This, however, must be taken in connection with the further finding that "the cost of preparing patterns for the iron and steel castings, and of preparing working drawings, and of constructing working machines was borne exclusively by the government," and that in each case one or more machines or articles of manufacture embodying the invention had been constructed, and was in operation or use in the arsenal, with the claimant's knowledge and

consent, before he filed an application for a patent. The inference to be deduced from the findings is, in substance, that, while the claimant used neither the property of the government nor the services of its employes in conceiving, developing, or perfecting the inventions themselves, the cost of preparing the patterns and working drawings of the machines, as well as the cost of constructing the machines themselves that were made in putting the inventions into practical use, was borne by the government, the work being also done under the immediate supervision of the claimant.

There is an assumption by the claimant in this connection that, if he did not make use of the time or property of the government in conceiving and developing his ideas, the fact is an important one as distinguishing this case from those above cited. In view of the finding that he did make use of the property and labor of the government in preparing patterns and working drawings and constructing his working machines, the distinction is a very narrow one—too narrow, we think, to create a difference in principle, or to prevent the application of the rule announced in those cases. In *Solomons' Case* the finding was that, while employed as chief of the bureau of engraving and printing, Clark conceived the idea of a self-canceling stamp, and under his direction the employes of that bureau, using government property, prepared a die or plate, and put into being the conception of Mr. Clark.

In every case the idea conceived is the invention. Sometimes, as in the case of *McClurg v. Kingsland*, a series of experiments is necessary to develop and perfect the invention. At other times, as in the case under consideration, and apparently in the *Solomons Case*, the invention may be reduced to paper in the form of an intelligible drawing, when nothing more is necessary than the preparing of patterns and working drawings, and the embodiment of the original idea in a machine constructed accordingly. Now, whether the property of the government and the services of its employes be used in the experiments necessary to develop the invention, or in the preparation of patterns and working drawings, and the construction of the completed machines, is of no importance. We do not care, in this connection, to dwell upon the niceties of the several definitions of the word "develop" as applied to an invention. The material fact is that in both this and the *Solomons Case* the patentee made use of the labor and property of the government in putting his invention into the form of an operative machine; and whether such employment was in the preliminary stage of elaborating and experimenting upon the original idea, putting that idea into definite shape by patterns or working drawings, or finally em-

bodying it in a completed machine, is of no consequence. In neither case did the patentee risk anything but the loss of his personal exertions in conceiving the invention. In both cases there was a question whether machines made after his idea would be successful or not, and, if such machines had proven to be impracticable, the loss would have fallen upon the government.

In this connection, too, it should be borne in mind that the fact, upon which so much stress has been laid by both sides, that the patentee made use of the property and labor of the government in putting his conception into practical shape, is important only as furnishing an item of evidence tending to show that the patentee consented to and encouraged the government in making use of his devices. The ultimate fact to be proved is the estoppel, arising from the consent given by the patentee to the use of his inventions by the government, without demand for compensation. The most conclusive evidence of such consent is an express agreement or license, such as appeared in the McAleer Case; but it may also be shown by parol testimony, or by conduct on the part of the patentee proving acquiescence on his part in the use of his invention. The fact that he made use of the time and tools of his employer put at his service for the purpose, raises either an inference that the work was done for the benefit of such employer, or an implication of bad faith on the patentee's part in claiming the fruits of labor which technically he had no right to enlist in his service.

There is no doubt whatever of the proposition laid down in Solomons' Case, that the mere fact that a person is in the employ of the government does not preclude him from making improvements in the machines with which he is connected, and obtaining patents therefor, as his individual property; and that in such case the government would have no more right to seize upon and appropriate such property than any other proprietor would have. On the other hand, it is equally clear that, if the patentee be employed to invent or devise such improvements, his patents obtained therefor belong to his employer, since in making such improvements he is merely doing what he was hired to do. Indeed, the Solomons Case might have been decided wholly upon that ground, irrespective of the question of estoppel, since the finding was that Clark had been assigned the duty of devising a stamp, and it was understood by everybody that the scheme would proceed upon the assumption that the best stamp which he could devise would be adopted, and made a part of the revised scheme. In these consultations it was understood that he was acting in his official capacity as chief of the bureau of engraving and printing, but it was not understood or intimated that the stamp he was to devise would be patented, or become his personal property.



In fact, he was employed and paid to do the very thing which he did, viz.: to devise an improved stamp; and, having been employed for that purpose, the fruits of his inventive skill belonged as much to his employer as would the fruits of his mechanical skill. So, if the inventions of a patentee be made in the course of his employment, and he knowingly assents to the use of such inventions by his employer, he cannot claim compensation therefor, especially if his experiments have been conducted or his machines have been made at the expense of such employer.

The following remarks of the court in the *Solomons Case* (page 346, 137 U. S., and page 88, 11 Sup. Ct.) are pertinent in this connection: "So, also, when one is in the employ of another in a certain line of work, and devises an improved method or instrument for doing that work, and uses the property of his employer and the services of other employes to develop and put in practical form his invention, and expressly assents to the use by his employer of such invention, a jury, or a court trying the facts, is warranted in finding that he has so far recognized the obligations of service flowing from his employment, and the benefits resulting from the use of the property and the assistance of the coemployes of his employer, as to have given to such employer an irrevocable license to use such invention."

The acquiescence of the claimant in this case in the use of his invention by the government is fully shown by the fact that he was in its employ; that the adoption of his inventions by the commanding officer was procured at his suggestion; that the patterns and working drawings were prepared at the cost of the government; that the machines embodying his inventions were also built at the expense of the government; that he never brought his inventions before any agent of the government as the subject of purchase and sale; that he raised no objection to the use of his inventions by the government; and that the commanding officer never undertook to incur a legal or pecuniary obligation on the part of the government for the use of the inventions or the right to manufacture thereunder. It further appeared that from time to time his wages were advanced from four to six dollars a day, and while it was never stipulated by the commanding officer, or understood by the claimant, that the advance of wages was a consideration for the use of the inventions, the practical ability of the claimant as an inventor, and the value of his inventions to the government, did operate on the minds of the officers in estimating the claimant's services and ordering his advancement.

Clearly, a patentee has no right, either in law or morals, to persuade or encourage officers of the government to adopt his

inventions, and look on while they are being made use of year after year without objection or claim for compensation, and then to set up a large demand, upon the ground that the government had impliedly promised to pay for their use. A patentee is bound to deal fairly with the government, and, if he has a claim against it, to make such claim known openly and frankly, and not endeavor silently to raise up a demand in his favor by entrapping its officers to make use of his inventions. While no criticism is made of the claimant, who was a simple mechanic, and, as found by the court of claims, "a faithful, intelligent, and capable employe, whose services were of great value to the government," and whose conduct was "fair, honest, and irreproachable," and while the government appears to have profited largely by his inventive skill, we are of opinion, for the reasons above stated, that the appeal in his behalf should be addressed to the generosity of the legislative, rather than to the justice of the judicial, department.

It may be added, in this connection, that the inventions which the claimant suggested to the commanding officer to adopt were mere undeveloped conceptions of his own, that had never been embodied in a machine; that it was uncertain at this time whether he could or would obtain patents for them. If he did not obtain patents, their use was open to anybody. Under such circumstances, it is impossible to say that an officer of the government, conceiving that he had full authority to make use of them, agreed by their adoption to pay for the value of the use of such machines under patents that might be applied for and granted in the future.

We are clearly of opinion that the case is covered by our former decisions, and that the judgment of the court below must be affirmed.

[For general discussion of implied license, shop-right, etc., see Part XII.]

824. CHAFFEE v. BOSTON BELTING CO., 22 How. (U. S.) 217, 16 L. ed. 240 (1850).\* \* \*

Under that provision, it has been repeatedly held by this court, that a party who had purchased a patented machine, and was using it during the original term for which the patent was granted, might continue to use the machine during the extended term. *Bloomer v. McQuewan et al.*, 14 How. 549; *Wilson v. Rousseau*, 4 How. 646. That rule rests upon the doctrine that the purchaser, in using the machine under such circumstances, exer-

cises no rights created by the act of congress, nor does he derive title to it by virtue of the franchise or the exclusive privilege granted to the patentee.

When the patented machine rightfully passes to the hands of the purchaser from the patentee, or from any other person by him authorized to convey it, the machine is no longer within the limits of the monopoly. According to the decision of this court in the cases before mentioned, it then passes outside of the monopoly, and is no longer under the peculiar protection granted to patented rights. By a valid sale and purchase, the patented machine becomes the private individual property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the State in which it is situated. Hence it is obvious, that if a person legally acquires a title to that which is the subject of letters patent, he may continue to use it until it is worn out, or he may repair it or improve upon it, as he pleases, in the same manner as if dealing with property of any other kind.

\* \* \*

825. GOODYEAR SHOE MACHINERY CO. v. JACKSON, 112 Fed. 146, 50 C. C. A. 159 (1901, First Circuit).\* \* \*

[In this case three patents were involved. The changes which were made may be indicated by consideration of the Fowler and Warren patent No. 564,986, from which the above figure is taken. The opinion referring to this patent says:

“It relates to what is known as a ‘pull off.’ In these machines the thread is held under tension, and the needle was obliged to pull off the thread against such tension. The pull off is a device to relieve the needle of this work. Pull offs were known at the date of this invention, as appears by the specification of the patent, which refers to several prior devices of this kind. This invention resided in the simplicity of the construction of the pull off mechanism, and it consisted in so timing the operation of the machine that the pull off operated when the needle held the thread under strain at the completion of its backward stroke. The specification says:

“‘Our present invention is an improved machine for doing this, its main novelty being that the pull-off mechanism does its work after the needle has completed its loop-drawing stroke and while the needle holds a loop of thread in its hook under the strain requisite to set the stitch, instead of relying upon a thread-brake to hold the thread against the action of the pull-off truck.’”

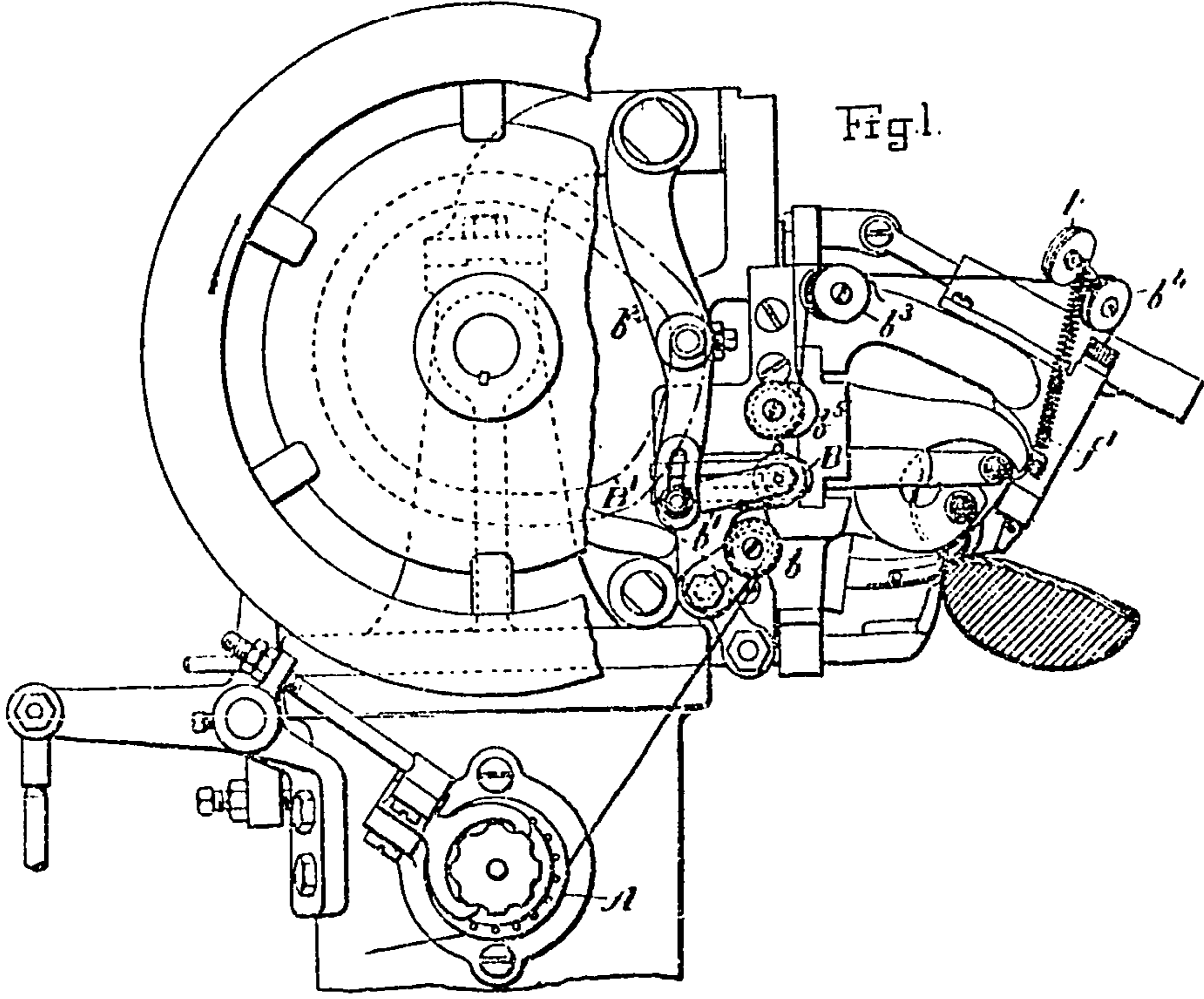


Fig. 1.

The specification is a good example of a presentation of a single specific feature so well ascertained that the distinction over the art may be accurately set forth.

The following from the specification sufficiently defines the above figure of the patent:

“The position of the parts when the stitch is set is shown in Fig. 1; that is, the needle is at the end of its back stroke and the last stitch has been set and the thread drawn taut from the hook of the needle through the last needle-hole in the work, through the looper, over truck  $b^4$  under the slack-taking truck F, over truck  $b^3$ , in front of trucks  $b^5$  and  $b$ , and in rear of pull-off truck B, to tension A. The needle is thus holding the thread, so that when the pull-off truck B is moved back by its cam B', acting through lever  $b^2$  and arm  $b'$ , the thread will be pulled off from the thread-supply through tension A, and cam B' is about to cause pull-off truck B to make its pull-off stroke, while the needle holds the thread under strain in its hook.”

The claim is also an interesting example of what is sometimes mistaken for a “functional” claim, but which clearly presents the feature of invention. It reads as follows:

“In a chain-stitch hook-needle sewing-machine the combination of tension; looper; hook-needle; a pull-off mechanism between the needle and the tension; and actuating mechanism timed to cause the pull-off mechanism to make its pulling-stroke after the hook-needle has completed its loop-drawing stroke and while the loop is held under strain by the hook of the needle; substantially as described.”

As will be observed from the opinion the defendants in this case had changed or replaced the very feature which gave point to the combination, but were held by both courts to have done no more than repair the machine.

In the other patents it will be observed that the parts replaced were cams. That is, familiar mechanical elements.]

Before Colt and Putnam, circuit judges, and Webb, district judge.

Colt, Circuit Judge.

There is presented on this appeal the single question of legitimate or illegitimate repair by the purchasers of a patented machine. The defendants, in rather a small way, were engaged in the business of general jobbing and repair work, and several purchasers sent their machines to the defendants' shop for repairs. In repairing the machines, the defendants made and replaced a number of parts, and the contention is that these repairs constituted an infringement of three of the complainant's patents for attachments to these machines.

It is admitted by counsel that the case stands the same as if the suit had been brought directly against the purchasers. This limits the issue strictly to the right of the purchasers to make these repairs, and eliminates any question of possible contributory infringement by the defendants by reason of making and selling parts of these machines.

But, although the case stands the same as if suit had been brought directly against the purchasers, the complainant's brief and argument have proceeded largely upon the assumption that infringement by the purchaser of a patented machine is closely allied to contributory infringement, in that both kinds of infringement relate to making a part of a patented invention, as distinguished from making the whole; and this has led the complainant to base infringement mainly upon the circumstance that the purchasers, in repairing their machines, replaced one of the material elements of the patented combinations. The fact is, however, that the two kinds of infringement are fundamentally different.

Infringement is the unlawful making or selling or using of a patented invention. Contributory infringement is "the intentional aiding of one person by another in the unlawful making or selling or using of the patented invention;" and this is usually done by making or selling a part of the patented invention with the intent and purpose of so aiding. The essence of contributory infringement lies in concerting or planning with others in an unlawful invasion of the patentee's rights. Howson, *Contrib. Infringe. Pat.* 1; *Thomson-Houston Electric Co. v. Kelsey Electric Ry. Specialty Co.*, (C. C.) 72 Fed. 1016; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, (C. C.) 78 Fed. 139; *Wallace v. Holmes*, 9 Blatchf. 65 Fed. Cas. No. 17,100; *Renwick v. Pond*, 10 Blatchf. 39, Fed. Cas. No. 11,702; *Saxe v. Hammond*, 1 Ban. & A. 629, Fed. Cas. No. 12,411; *Richardson v. Noyes*, 2 Ban. & A. 398 Fed. Cas. No. 11,792; *Schneider v. Pountney* (C. C.) 21 Fed. 399; *Travers v. Beyer* (C. C.) 26 Fed. 450, 23 Blatchf. 423; *Snyder v. Bunnell* (C. C.) 29 Fed. 47; *Celluloid Mfg. Co. v. American Zylonite Co.* (C. C.) 30 Fed. 437; *Singer Mfg. Co. v. Springfield Foundry Co.* (C. C.) 34 Fed. 393; *Schneider v. Missouri Glass Co.* (C. C.) 36 Fed. 582; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 25 C. C. A. 267, 77 Fed. 288, 35 L. R. A. 728.

Infringement by the purchaser of a patented machine consists in the substantial rebuilding of such machine. A contributory infringer necessarily only makes or sells a part of the patented invention. The purchaser of a patented machine, in order to infringe, must make or reproduce, in substance, the whole patented invention. To prove infringement, in one case, it is only necessary to show a partial infringement in aid of an unlawful

complete infringement, while in the other case a substantially full and complete infringement must be established. The rule that a person may be guilty of contributory infringement by making or selling a material element of the patented combination has no application to infringement by the purchaser of a machine embodying such patented combination. A purchaser stands in no different position from an ordinary infringer, except in the circumstance that he has bought a patented machine, and, consequently, his infringement does not consist in the construction of a wholly new machine, but in the reconstruction of such machine after it is worn out or substantially destroyed. The essence of the infringement is the same in both cases.

The ordinary infringer makes the entire patented machine; the infringing purchaser begins with what remains of the patented machine, and rebuilds it. To show infringement in the case of an ordinary infringer, where the patented invention comprises several elements in combination, it is necessary to prove that the alleged infringing machine contains all the elements (or their equivalents) which make up the combination, although some of the elements may not be material, or of the essence of the invention. To show infringement by the purchaser in such a case, the same strictness of proof is not required, for the reason that it may not be necessary for him to make the immaterial or unessential elements of the patented combination, because they may not be worn out or destroyed in his machine when the work of reconstruction begins. A practical reconstruction of the patented machine, and not necessarily a literal reconstruction of the patented combination, is all that is required to constitute infringement by the purchaser. For example, where the patent is for an improved lamp, and the whole invention resides in the burner, but the claim is for the combination of the burner and a chimney, in an ordinary suit for infringement it must be shown that the defendant made or used or sold the patented combination, namely, the burner and chimney; while in a suit for infringement against a purchaser of the lamp it would only be necessary to prove that he replaced the old burner with a new one, because, manifestly, that would constitute a substantial reconstruction of the patented invention. If a person other than the purchaser should make or sell the burner with the intent and purpose of its use by another in combination with the chimney, it would be a clear case of contributory infringement. *Wallace v. Holmes*, 9 Blachf. 65, Fed. Cas. No. 17,100.

In approaching the question of infringement by the purchaser of a patented machine, it is important to bear in mind what the patentee sold and the purchaser bought. The patentee has parted

with his machine and the monopoly that goes with it, and the purchaser has bought the machine with the right to use the patented invention until the machine is worn out or destroyed. When the machine is worn out, or substantially destroyed, his right to use the patented invention ceases; and when he rebuilds his machine, and thereby makes substantially a new machine, it becomes subject to the patentee's monopoly, the same as in the case of any other person who unlawfully makes the patented machine. When the patented machine has passed outside the monopoly by a sale and purchase, the patentee has no right to impose any restrictions on its use for his own benefit. He can not forbid the further use of the machine because it is out of repair in consequence of the wearing out or breaking of some of its parts, and so oblige the purchaser to buy a new machine. The purchased machine has become the individual property of the purchaser, and is like any other piece of property which he owns. He may sell it, or he may use it so long as its usefulness lasts, and then throw it away, or dispose of it for junk. He may prolong its life and usefulness by repairs more or less extensive, so long as its original identity is not lost. He is only prohibited from constructing a substantially new machine. He can not, under the pretext of repairs, build another machine. *Wilson v. Simpson*, 9 How. 109, 13 L. ed. 66; *Adams v. Burke*, 17 Wall. 453, 21 L. ed. 700; *Chaffee v. Belting Co.*, 22 How. 217, 223, 16 L. ed. 240; *Mitchell v. Hawley*, 16 Wall. 544, 546, 547, 21 L. ed. 322; *Hobbie v. Jennison*, 149 U. S. 355, 363, 13 Sup. Ct. 879, 37 L. ed. 766; *Cotton-Tie Co. v. Simmons*, 106 U. S. 89, 1 Sup. Ct. 52, 27 L. ed. 79; *Aiken v. Print Works*, 2 Cliff. 435, Fed. Cas. No. 113; *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 435, 14 Sup. Ct. 627, 38 L. ed. 500; *Gottfried v. Brewing Co.*, 5 Ban. & A. 5 Fed. Cas. No. 5,633; *Davis Electrical Works v. Edison Electric Light Co.*, 8 C. C. A. 615, 60 Fed. 276; *Id.* (C. C.) 58 Fed. 878.

A purchaser, then, may repair, but not reconstruct or reproduce, the patented device or machine. Repair is "restoration to a sound, good, or complete state after decay, injury, dilapidation, or partial destruction." Reconstruction is "the act of constructing again." Reproduction is "repetition," or "the act of reproducing." These definitions are instructive in bringing home to the mind that repair carries with it the idea of restoration after decay, injury, or partial destruction, and that reconstruction or reproduction carries with it the idea of a complete construction or production over again.

But the difficult question still remains, what is legitimate repair, and what is reconstruction or reproduction as applied to a particular patented device or machine? When does repair destroy the identity of such device or machine and encroach upon



invention? At what point does the legitimate repair of such device or machine end, and illegitimate reconstruction begin.

It is impracticable, as well as unwise, to attempt to lay down any rule on this subject, owing to the number and infinite variety of patented inventions. Each case, as it arises, must be decided in the light of all the facts and circumstances presented, and with an intelligent comprehension of the scope, nature, and purpose of the patented invention, and the fair and reasonable intention of the parties. Having clearly in mind the specification and claims of the patent, together with the condition of decay or destruction of the patented device or machine, the question whether its restoration to a sound state was legitimate repair, or a substantial reconstruction or reproduction of the patented invention, should be determined less by definitions or technical rules than by the exercise of sound common sense and an intelligent judgment.

When the patent is for a single thing, like a knitting needle, for example, and not for a device or machine composed of several things or elements combined, it is obvious that the replacement of an old needle by a new one in a knitting machine is not repair, but a reproduction of the patented thing. *Aiken v. Manchester Print Works*, 2 Cliff. 435, Fed. Cas. No. 113; *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 435, 14 Sup. Ct. 627, 38 L. ed 500; *Wilson v. Simpson*, 9 How. 109, 124, 13 L. ed. 66.

When the patent is for a device embracing the combination of several elements, a purchaser will infringe by reconstructing the device after it has fulfilled its purpose and is substantially destroyed. Where, for instance, the patent was for a cotton-bale tie, consisting of a band and buckle, and "licensed to use once only," it is manifest that the severance of the band at the cotton mill was intended to operate as a destruction of the tie, and that to roll and straighten the pieces of the band and rivet the ends together, at the same time using the old buckle, was a reconstruction of the tie, and not repair. *Cotton-Tie Co. v. Simmons*, 106 U. S. 89, 1 Sup. Ct. 52, 27 L. ed. 79.

Again, where the subject of the patent was an electric lamp, and the invention resided in the discovery that an attenuated carbon filament, if operated in a high vacuum, would withstand disintegration, and the claim was for the combination of carbon filaments with a receiver made entirely of glass, and conductors passing through the glass, from which receiver the air is exhausted, it is plain that, when the filament is destroyed, and the vacuum is destroyed by making a hole in the receiver, and nothing remains but a perforated glass bulb and the conductors, the lamp is practically destroyed, and that to replace the old filament with a new one, and again exhaust the air in the receiver, and

again seal it, is substantially the making of a new lamp. *Davis Electrical Works v. Edison Electric Light Co.*, 8 C. C. A. 615, 60 Fed. 276; *Id.* (C. C.) 58 Fed. 878.

Where the patent is for a machine, which commonly embraces the combination of many constituent elements, the question of infringement by the purchaser will turn upon whether the machine is only partially worn out or partially destroyed, or is entirely worn out, and so beyond repair in a practical sense. In the case of a patent for a planing machine composed of many parts it was held that the replacement of the rotary knives, "the effective ultimate tool" of the machine, was repair, and not reconstruction. *Wilson v. Simpson*, 9 How. 109, 13 L. ed. 66. In that case the supreme court rested its decision on two grounds: (1) The right of the owner to replace a material part of the patented combination; and (2) the right to replace a part of the machine which it was known would quickly wear out, such replacement being necessary to a continued use of the machine, and therefore contemplated by the patentee when the machine was sold. The decision in that case contains a careful discussion of the rights of a purchaser of a patented machine, and of the fundamental grounds on which those rights are based, and of the difference between repair and reconstruction:

"When the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists for restoration to its original use by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration, and not reconstruction. \* \* \* Repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use; and it is no more than that though it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys when the patentee sells to him a machine; and when he repairs the damages which may be done to it it is no more than the exercise of that right of care which every one may use to give duration to that which he owns, or has a right to use as a whole. \* \* \* And what harm is done to the patentee in the use of his right of invention, when the repair and replacement of a partial injury are confined to the machine which the purchaser has bought?"

"Nothing is gained against our conclusion by its being said that the combination is the thing patented, and that, when its intended result can not be produced from the deficiency of a part

of it, the invention in the particular machine is extinct. It is not so. Consisting of parts, its action is only suspended by the want of one of them, and its restoration reproduces the same result only, without the machine having been made anew."

The opinion then proceeds to discuss specifically the patented machine in controversy:

"It does not permit an assignee of the first term of a patent, after its renewal and extension, to make other machines, or to reconstruct it, in gross, upon the frames of machines which the assignee had in use when the renewal and extension of the patent took effect. But it does comprehend and permit the resupply of the effective ultimate tool of the invention, which is liable to be often worn out, or to become inoperative for its intended effect, which the inventor contemplated would have to be frequently replaced anew, during the time that the machine, as a whole, might last. \* \* \* The right of the assignee to replace the cutter knives is not because they are of perishable materials, but because the inventor of the machine has so arranged them as a part of its combination that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been but of little use to the inventor or to others. The other constituent parts of this invention, though liable to be worn out, are not made with reference to any use of them which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such a combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intentions they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, its inventor can not complain, if he sells the use of his machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used. Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material."

Each of the purchasers in the suit at bar bought from the Lincoln Sewing Machine Company, who then owned the patents in issue, machines called the "Lincoln Machine," an in-seam sewing machine designed to unite the sole and upper of a turned shoe, or the sole and welt of a welt shoe. There are always found

in such a machine a needle, a looper, and a tension for forming the stitch, and their actuating mechanism; guiding devices for guiding the work, and their actuating mechanism; and feeding devices for feeding the work, and their actuating mechanism. The hooked needle pierces the work with a forward and upward movement, and a double line of thread is left outside of the upper or welt, and a single line in the channel. The needle is first forced through the work; the thread is then led into the throat of the needle hook by the looper, and the needle is drawn back through the hole, pulling the loop of thread. The work is then moved along the length of one stitch, and the needle is again thrust through the work, again threaded, and again drawn back, pulling a second loop of thread through the work and through the first loop; and this process is repeated for each stitch. The thread is drawn from the spool, and extends from the spool to the work through the machine. In these machines the needle holes are approximately parallel to the surface of the sole, and the feeding instrument was either the needle itself or a puncturing instrument which made the holes substantially coincident with the holes made by the needle. This kind of feed was found objectionable in sewing around the pointed or sharply-curved toe of a shoe. This objection was overcome by a feeding instrument which penetrated the work substantially at right angles to the hole made by the needle.

The first Fowler & Warren patent in issue—No. 545,625, dated September 3, 1895—covers this improved feed. The specification, after reciting the defects in the old machines, says:

“The object of our invention is to adapt this class of machines to work where the direction of the seam changes abruptly; and our invention consists in the combination with the needle of a feeding instrument which penetrates the work substantially at right angles to hole made by the needle. \* \* \* The feeding instrument has the usual four motions, but its penetrating and withdrawing motions are at right angles to the needle holes, instead of being parallel or in line with the needle holes, as heretofore.”

At the end of the specification the patentees set forth their invention as follows:

“What we claim as our invention is: In a sewing machine, the needle; mechanism for actuating it to cause it to penetrate the between substance; the feeding point; mechanism for actuating it to cause it to move endwise and penetrate the between substance in a path at right angles to the path of the needle; and mechanism to move the feed point sidewise after it has penetrated and while it is in the between substance, for feeding the work leaving the shoe free to be turned upon the feeding

as an axis during the feeding operation—all combined, and operating substantially as and for the purpose specified.”

It will be observed that the patentees do not claim their particular kind of feed for penetrating the work at right angles as their invention, but this feed in combination with the needle and mechanism for actuating it, and mechanism to move the feed point sidewise after it has penetrated and while it is in the work.

When the purchaser bought a Lincoln machine, he bought a machine which embodied all the elements in the patented combination, with the right to use that combination as a whole until it was worn out. He had the right to repair partial injuries to the combination arising from wear and tear, and so refit the machine for use, though it involved the replacement of an essential part of the combination. To prove that the purchaser of a Lincoln machine infringed this patent, it must be shown that the repairs on his machine involved a substantial reconstruction or reproduction of the patented combination which was sold to him, and which became his absolute property.

The complainant rests its charge of infringement upon the fact that the purchaser, in repairing his machine, replaced, in the feeding device, the cam which, with its connections, gives the vertical movement to the needle. The remaining repairs, so far as they relate to this patent, are admitted to have been immaterial. It is manifest, however, that a broken or wornout cam effected only a partial destruction of the patented combination composed of three separate groups of mechanism, and that the replacement of the old cam with a new one was not a substantial rebuilding of the combination. If the patented invention had been for this particular form of cam, or had been simply for an improved feed, and the whole invention had resided substantially in the cam, the case would have presented a different aspect.

The second Fowler & Warren patent in suit is No. 560,705, dated May 26, 1896, and it is stated to be for “a new and useful welt guide mechanism for sewing machines.” The improvement is for a welt guide which moves in the curved path of the needle, in place of the old welt guide, which only moved to and from the work in a straight line; so that, when the welt guide was a little too far in or a little too far out, the point of intersection was not in the bottom of the groove in the welt held in the welt guide, but a little to one side.

The invention claimed is as follows:

“What we claim as our invention is: In a curved needle sewing machine a welt guide; its holder; a carrier for the welt guide holder; and means for moving the holder with relation to its carrier and for moving the carrier toward and from the

curved needle, to cause a point in the welt guide to move in the arc in which the curved needle moves—all combined and operating substantially as described.”

Here again we have a combination patent embracing a number of essential elements. The purchaser of a Lincoln machine bought the whole of this combined mechanism, and was entitled to use it until its usefulness had ceased by reason of decay or destruction. The charge of infringement of this claim is substantially limited to the replacement of the cam which moves the carrier to and from the curved needle. But this cam is only one of the material elements of the patented combination; and, further, it only moves the carrier back and forth in a straight line, and is not productive of the curved movement of the welt guide, which is the essential feature of this invention. As for the carrier of the welt guide, which it is also said the purchaser replaced, this again is only one of the elements of the combination. On the whole, we fail to find in these repairs anything like a substantial rebuilding of the patented combination.

The remaining Fowler & Warren patent in issue is No. 564,986, granted August 4, 1896. This patent is for a new and useful improvement “in means for providing slack thread” in this class of sewing machines. It relates to what is known as a “pull off.” In these machines the thread is held under tension, and the needle was obliged to pull off the thread against such tension. The pull off is a device to relieve the needle of this work. Pull offs were known at the date of this invention, as appears by the specification of the patent, which refers to several prior devices of this kind. This invention resided in the simplicity of the construction of the pull off mechanism, and it consisted in so timing the operation of the machine that the pull operated when the needle held the thread under strain at the completion of its backward stroke. The specification says:

“Our present invention is an improved machine for doing this, its main novelty being that the pull off mechanism does its work after the needle has completed its loop drawing stroke, and while the needle holds a loop of thread in its hook under the strain requisite to set the stitch, instead of relying upon a thread brake to hold the thread against the action of the pull off truck.”

The patentees state their invention as follows:

“What we claim as our invention is: In a chain stitch, hook needle sewing machine the combination of tension, looper, hook needle, a pull off mechanism between the needle and the tension, and actuating mechanism timed to cause the pull off mechanism to make its pulling stroke after the hook needle has

completed its loop drawing stroke, and while the loop is held under strain by the hook of the needle; substantially as described."

There was sold to the purchaser of a Lincoln machine this patented combination, and he had the right to prolong its life and usefulness by any repairs which fell short of a reconstruction of substantially the whole combination. It cannot be said, therefore, that the replacement by the purchaser of the cam or the pull off lever which moves the pull off truck constituted an infringement of the patent, although it may be this cam was the characteristic and most essential element in the combination. The breaking or wearing out of this cam resulted in only a partial destruction of the patented combination, and its replacement by a new cam was plainly a restoration, and not a substantial reconstruction of the combination.

Under the general principles governing the rights of the parties in this class of cases, we are of the opinion that the purchasers of the Lincoln machines, by repairing their machines to the extent disclosed by the evidence, have not infringed any of the patents in suit.

The decree of the circuit court is affirmed, and the costs of appeal are awarded to the appellees.

826. BULLOCK ELEC. & MFG. CO. v. WESTINGHOUSE ELEC. & MFG. CO., 129 Fed. 105, 63 C. C. A. 607 (1904, Sixth Circuit).\* \* \*

The plaintiff in error was adjudged to be in contempt because, pending the injunction, it made and shipped to a customer in Canada the motor of the patent, with the expectation and intent that it would be there used in the devices of the combination claims and in the practice of the method of transmitting electrical power protected by the claim of the method patent. Was this, as matter of law, a contempt of the authority of the court?

The injunction forbid "the making, using, or selling of any apparatus embodying the inventions recited or specified" in the claims of the three patents heretofore set out. The monopoly of a patent extends to the making or selling, as well as the using, of the patented device within the United States. *Adams v. Burke*, 17 Wall. 453, 456, 21 L. ed. 700; *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 291, 25 C. C. A. 267, 35 L. R. A. 728; *Dorsey Rake Co. v. Bradley M. Co.*, 12 Blatchf. 202, Fed. Cas. No. 4,015.

While it is true that the monopoly of the plaintiff's patents did not extend beyond the limits of the United States, yet it would be no defense to say that the patented article had been made in the United States only for the purpose of being sold

and used in a country to which the protection of the laws of the United States did not extend. The patentee is entitled to monopolize the making of his device in the United States as well as a monopoly of there selling or using it. *Dorsey Harvester Co. v. Bradley Co.*, 12 Blatchf. 202, Fed. Cas. No. 4,015; *Ketchum Harvester Co. v. Johnson Co.*, (C. C.) 8 Fed. 586; *Adrian Platt Co. v. McCormack Co.*, (C. C.) 55 Fed. 288. *Gould v. Sessions*, 67 Fed. 163, 14 C. C. A. 366, is not in conflict, for in that case the only question concerned the alleged violation of an injunction against the future making, selling, or using of the patented article.

The articles sold in supposed violation of the temporary injunction had been made before the injunction was granted, and pending the injunction were shipped to Canada and there sold. There had been, therefore, no violation of the injunction, because there had been no making or selling or using of the patented device after the allowance of the injunction, within the limits of the United States. But it is elementary that neither the making, selling, nor using of one element of a combination is infringement. *Prouty v. Ruggles*, 16 Pet. 336, 10 L. ed. 985; *The Corn Planter Patent*, 23 Wall. 181, 224, 23 L. ed. 161; *Rowell v. Lindsay*, 113 U. S. 97, 101, 5 Sup. Ct. 507, 28 L. ed. 906. In the corn planter patent Mr. Justice Bradley said:

"Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration as conclusive, so far as that patent is concerned, as if it were expressed that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old or common and public."

In *Rowell v. Lindsay*, Mr. Justice Wood said:

"The patent of the plaintiffs is for a combination only. None of the separate elements of which the patent is composed are claimed as the invention of the patentee; therefore none of them, standing alone, are included in the monopoly of the patent."

It must follow, therefore, that, unless there be something to take this case out of the general rule, the making or selling or using of a single element of a combination patent does not per se constitute an infringement of a combination claim. Neither can it be said, in a legal sense, that any one element of a combination patent is an "apparatus embodying the invention,"



within the meaning of the injunction which the defendant is supposed to have disobeyed.

It may be true, as claimed, that the Tesla motor constitutes the real essence of the three Tesla inventions covered by the claims of the patents in suit. Tesla, however, neglected to claim the motor as a separable device. He deliberately elected to claim it only as he claimed the other elements of his combination claims, and thereby abandoned any claim to its novelty or to a monopoly of its use, except as a part of one or other of his combination claims. The method claim is not for any apparatus at all. The mere fact that the Bullock Company made and sold such a motor does not per se constitute an infringement of such a method claim. We are not now dealing with the question of contributory infringement for that will be considered later. What we decide is that the mere fact that one has made and sold an apparatus adapted to be used in following the methods of Tesla's method claim does not constitute infringement. He is not entitled to extend that claim so as to include apparatus adapted to its practice. A licensee thereunder may practice the method with any motor adapted to such method, and we see no reason, if the motor itself is not patented, why such a licensee might not supply himself with a motor adapted to so operate from any manufacturer.

But the Circuit Court found that after the granting of the injunction pendente lite the defendant company made and shipped to one John McDougal, of the Caledonia Iron Works, Montreal, Canada, a motor made according to the description of the Tesla patents in suit, and that this was done with the intent and expectation that the motor would be there installed and used in the devices of the patents in suit. Judge Thompson held upon these facts that the defendants "had not only infringed the plaintiff's patents by contributing to the device set up in Canada, but directly infringed the claim of patent No. 382,280."

But did the defendants infringe either of the combination claims, or disobey the injunction of the court, by making and sending to Canada a single element of those claims with the intention and for the purpose of being there used in one or other of the combinations of the patent? The monopoly of the patents did not extend to Canada. The patented devices were open to be there made or sold or used because the monopoly of the patent is limited to the United States and its territories. Unless, therefore, the making and selling of a single element of a patented device, within the limits of the United States, with the intention that it shall be sent without the United States, and there used in association with the other elements of the com-

bination, constitutes infringement, the defendants did not disobey the order of the court. But unless the making and sale of the single element was with the intention and purpose of aiding and abetting another to infringe there would be no contributory infringement under the well-settled law upon that subject.

No better definition of contributory infringement can be found than that given by Judge Taft when speaking for this court in *Thompson-Houston Electric Co. v. Ohio Brass Works*, 80 Fed. 712, 721, 26 C. C. A. 107, where that learned judge said:

“It is well settled that when one makes and sells one element of a combination covered by a patent with the intention and for the purpose of bringing about its use in such a combination he is guilty of contributory infringement, and is equally liable to the patentee with him who in fact organizes the complete combination. \* \* \* An infringement of a patent is a tort analogous to trespass or trespass on the case. From the earliest times, all who take part in a trespass, whether by actual participation therein, or by aiding and abetting it, have been held to be jointly and severally liable for the injury inflicted. There must be some concert of action between him who does the injury and him who is charged with aiding and abetting, before the latter can be held liable. When that is present, however, the joint liability of both the principal and accomplice has been invariably enforced.”

The intent and purpose that the element made and sold shall be used in a way that shall infringe the combination in which it is an element constitutes the necessary concert of action between him who furnished the single part and he who actually does the injury by the assembling and using of all the parts in such a way as to be an infringement. This principle runs through all the cases upon contributory infringement. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 297, 25 C. C. A. 267, 35 L. R. A. 728; *Saxe v. Hammond*, Fed. Cas. No. 12,411; *Wallace v. Holmes*, 9 Blatchf. 65, Fed. Cas. No. 17,100; *Thomson-Houston Co. v. Kelsey Electric Co.*, 75 Fed. 1005, 22 C. C. A. 1; *German-American Filter Co. v. Loew Filter Co.*, (C. C.) 103 Fed. 303, affirmed (C. C. A.) 107 Fed. 949.

In *Snyder v. Bunnell*, (C. C.) 29 Fed. 47, Judge Coxe gave his emphatic approval to the principle laid down by Judge Shipley in *Saxe v. Hammond*, cited above, where it was said that “the mere manufacture of a separate element of a patented combination, unless such manufacture be proved to have been conducted for the purpose and with the intent of aiding infringement, is not in and of itself infringement.” That the single element was made and sold was with the intent and purpose of

aiding another in infringing must appear, or the necessary concert of action will be missing. This may be shown presumptively, as it is when the article is incapable of any other use than an infringing one. If, on the other hand, it be adapted to other uses "the intention to assist in infringement must be otherwise shown affirmatively." *Thomson-Houston Co. v. Ohio Brass Works*, 80 Fed. 712, 723, 26 C. C. A. 107. These principles we think determine this case.

The finding that the intent and purpose in making and selling this motor was that it should be used in the patented devices in Canada is a finding against any infringing purpose. It would not be an infringement to put the motor to the use intended, because that use was beyond the protection of the patent. The defense is as complete as if the intent had been to furnish the motor to one having a license to make, sell, and use. In neither case would there be an intent to assist in an infringement, and without such intent the plaintiff in error was not infringing the patents or disobeying the order of the court.

What we have said applies as well to the method patent as to the combination claims. There must be shown an intent to assist another in an infringing use of the patented method. There being no intent to provide means by which another might unlawfully use the Tesla method, there is no contributory infringement.

The judgment, for these reasons, must be reversed, with directions to discharge the rule to show cause. \* \* \*

827. *THOMSON-HOUSTON v. KELSEY*, 75 Fed. 1005, 22 C. C. A. 1 (1896, Second Circuit).\* \* \*

Shipman, J.:

The Circuit Court of the United States for the District of Connecticut, after an exhaustive investigation of the validity and alleged infringement of letters-patent No. 495,443, dated April 11, 1893, and issued to the administrators of Charles J. Van Depoele, decreed that the Winchester Avenue Railroad Company had infringed claims 6, 7, 8, 12, and 16 of the patent. The complainant in the suit was the Thomson-Houston Electric Company, the assignee of the patentees. The combination covered by these claims and now used generally by the electric railroads of the country consisted generally in an electric railway having an overhead conductor and a car for said railway provided with a contact device carried by the car so as to form a unitary structure therewith and consisting of a trailing arm, hinged and pivoted to the car so as to bridge the space between it and the conductor, and move freely both laterally and vertically, and said arm carrying at its outer end a contact device capable of

being pressed upward by a suitable tension device into engagement with the under side of the conductor.

The important and distinctive part of the invention was the trailing arm hinged and pivoted to the car, and moving laterally and vertically, with a contact device at its outer end capable of being pressed upward by a suitable tension device into engagement with the under side of the conductor. The novel element of "the overhead, underrunning, spring-pressed, laterally-swinging contact-arm" was of great utility and has superseded pre-existing attempts at trolley-road equipment. The "trolley-stand," so called, is the means by which the trailing arm is hinged and pivoted to the car with a capacity for lateral and vertical movement and is pressed upward by some suitable spring. No particular form of stand was included in the Van Depoele invention, for any one of a number of forms would answer the purpose.

The defendant, the Kelsey Electric Railway Specialty Company, manufactures a particular form of trolley-stand, for which Letters Patent have been issued, which it has advertised for sale, and has also in its advertisements represented itself as a dealer in trolley-poles and overhead-trolley equipments. Its trolley-stand consisted in the main of a base secured to the car-roof, a frame revolvably mounted upon the same, so as to receive the end of a trolley-arm, and springs by which tension upon the arm is produced. The Thomson-Houston Electric Company having brought suit against the Kelsey Company for infringement of this Van Depoele patent, the Circuit Court for the District of Connecticut granted a motion for an injunction pendente lite against its making or selling any apparatus embodying the subject matter of or any trolley bases devised or intended to be used in infringement of those claims of said patent which were found to have been infringed in the Winchester case. The present appeal is from this order.

The question, as presented in the affidavits and briefs, relates particularly to the manufacture and sale of trolley-stands. As evidence of an intention to infringe the complainant relied upon the language of the defendant's advertisement, which offered for sale the stands and overhead-trolley equipment generally. The defendant admits that it has sold trolley-stands directly or indirectly to electric companies which purchased their equipment originally from the complainant's licensees, either by way of repair or because the purchasers wanted an improved stand. It denies that it has knowingly sold to an infringer of the patent in suit or to be used for the purpose of infringement. The circuit judge was of opinion that the defendant was selling stands capable of and designed for an un-

lawful use, and that, inasmuch as they are useful only for the purpose of performing functions involved in the operation of the patent, there was a presumption of an intention that these stands should be so used, which was not dispelled by the affidavits.

The question being one of contributory infringement, the appellant urges that there was not sufficient evidence that the defendant had concerted or was concerting or intended to concert with any person for the infringement of the complainant's patent, and that consequently the injunction order either ought not to have been issued or was too sweeping in its terms.

What contributory infringement is and why it should be enjoined was clearly shown in *Wallace v. Holmes*, 9 Blatchf. 65, the earliest case in this country upon the subject, and upon which the subsequent cases of contributory infringement rest. The complainant's patent in that case was for an improved lamp, which consisted of an improved burner or metallic portion and a glass chimney. The defendant made and sold the improved burner, which must be used with a chimney, and in order to make sales exhibited the burners with chimneys to customers, and the circuit judge thought that a concert with others to use the patented article, as a whole, was a certain inference from the obvious facts in the case and the efforts of the defendant to solicit sales by showing the operation of the whole patented article. The willingness of the defendant in this case to aid other persons in any attempts which they may be disposed to make toward infringement is also apparent. Its trolley-stands are designed to be used in the patented system and to be the means of enabling the trailing pole to perform its distinctive and novel part in the combination. It sufficiently appears from the defendant's advertisements and affidavits that it was ready to sell to any and all purchasers, irrespective of their character as infringers. A proposed concert of action with infringers, if they presented themselves, is fairly to be inferred from the obvious facts of the case, and an injunction order is the proper remedy against wrongful acts which are proposed or are justly to be anticipated. But the defendant says also that the order which was granted is capable of too sweeping an interpretation, because it has a right to supply purchasers who have acquired the right to use the patented combination with its trolley-stands, either by way of repair or because the stands which were furnished to them were not adapted to the needs of the cars upon which they were placed, and it invokes the principle which was stated in *Chaffee v. Boston Belting Company*, 22 How. 217, as follows:

“If a person legally acquires a title to that which is the subject of Letters Patent, he may continue to use it until it is worn out, or he may repair it or improve upon it, as he pleases, in the same manner as if dealing with property of any other kind.”

The complainant, which is utilizing its patent-rights by the manufacture and sale of trolley-railroad equipments, and desires to compel purchasers to continue to supply themselves with its form of stands, replies that the defendant's sales are not for the purpose of repair, but are for the reconstruction of the patented combination, and that a reconstruction of a destroyed or worn-out combination is an infringement. This proposition is true, and examples of the cases to which it is applicable are found in *Cotton-Tie Company v. Simmons*, 106 U. S. 89, and *Davis Electrical Works v. Edison Electric Light Co.*, 60 Fed. 276. In the *Cotton-Tie* case the continued use of patented ties, which consist of a band and buckle, was purposely destroyed by the purchaser by cutting the band after he had received the bale around which the tie was placed, and the parts were sold as waste material. A new purchaser bought the several parts, mended the bands, replaced the buckles, sold them to be used as ties, and was held to be an infringer.

In the *Edison* case the reconstruction was equally extensive. The infringer made a hole in the bulb of an Edison incandescent electric lamp, in which the carbon filament had been worn out, put in a new filament having its ends cemented in platinum sleeves, fused a tube of glass into the open end of the bulb, exhausted the air, and sealed the bulb. Inasmuch as “the filament duly charged is the light-giving thing,” the work of the infringer was the manufacture of a new lamp.

The complainant, recognizing that the facts in these cases are not analogous to those in the record now before us, urges that in order to constitute reconstruction of a patented device it is not necessary that the structure should have been destroyed intentionally or that the vital and peculiar element of the invention should have been worn out by use, but that the substitution of an important member of a patented combination which was intended to be permanent in place of the corresponding member which had been accidentally broken or had been worn out is reconstruction, and that there is a recognized distinction between such a substitution and the replacing of fragile members whose life is necessarily short. Reliance is placed upon the case of *Wilson v. Simpson*, 9 How. 108, which involved the question of the invention which the owners of a patented machine had in it, after the expiration of the first term of a patent, where there had been a renewal and extension of it, and which has been sometimes proposed to establish the rule that

the replacement by the purchaser of the parts of a patented machine which must from their nature be temporary is permissible, while in no event is the replacement permissible of a part which it was hoped would be permanent. The case related to the right of a purchaser of a Woodworth planing-machine to replace cutters which ordinarily had a life of only sixty or ninety days, and, as a necessity, the opinion dwells upon that fact; but the decision did not make it a *sine qua non* and did not intend to say that temporary cutters can be replaced and that an element intended to be permanent but accidentally broken in thirty days after it was purchased cannot be replaced. The distinction which the court was endeavoring to point out, and which it thought was well illustrated in the Woodworth planer, was the difference between the repair or replacement of a single element of a combination and the manufacture of a new machine in place of one which had become useless. The court says:

“We admit, for such is the rule in *Wilson v. Rousseau*, 4 Howard 646-647, that when the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists, for restoration to its original use, by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration, and not reconstruction. Illustrations of this will occur to any one, from the frequent repairs of many machines for agricultural purposes. Also from the repair and replacement of broken or worn-out parts of larger and more complex combinations for manufactures. In either case, repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys, when the patentee sells to him a machine; and when he repairs the damages which may be done to it, it is no more than the exercise of that right of care which every one may use to give duration to that which he owns, or has a right to use as a whole.”

This distinction is both natural and founded upon right reason and gives to the patentee all the benefits to which he is entitled by the grant of the patent. While it is not intended that a trolley-stand should be broken or should lose its useful capacity, either calamity may befall it, and the right to replace the injured part by a new stand from any person who can supply the article should be conceded by the owners of the patent.

It is not intended to permit the unauthorized substitution of the vital and distinctively new part of an invention in place of one worn out by use, as the substitution of a new filament in an Edison incandescent lamp or the substitution of a new for an old burner in the Wallace case, *supra*; but the trolley-stand is not the vital element of the invention, though a portion of it is an element of the combination. It is the means, and in most cases the non-patented means, for there are numerous forms of these bases, by which the pole is permitted to perform its functions.

The defendant also says that in order to obtain the use of an improved trolley-stand purchasers from the complainant are sometimes willing to discard its stands and substitute another form which has its own advantages. For example, the trolley-stand which is sold by the defendant is said to be less elevated above the top of the car than the stand of the complainant, and therefore it is said that the Norwalk Street Railway Company found it necessary to change the stands which were furnished by the complainant because of the low bridges recently constructed by a steam-railroad company over the tracks of the street electric road. A refusal to permit such a substitution is equivalent to a declaration that the street-railway company cannot be permitted to improve its stands except by the consent of the complainant. If a purchaser from the complainant chooses, the car after his purchase, to substitute a stand which is better made and better adapted to his peculiar needs, he has the right to do so; but it will be urged that such a permission opens the door to infringement and permits a spoliation of the conceded rights of the complainant. It does throw upon the defendant the duty of careful investigation into the objects of the purchasers of its stands and of an abandonment of indifference as to whether they are seeking to trench upon the rights of the owners of the patent, or else a liability to suffer the consequences of a violation of the injunction order.

The order is directed to be modified, without costs of this court, by adding the words:

“It is not intended to enjoin the defendant against the sale of trolley-stands by way of replacement of broken stands or stands worn by use, or of substitution for trolley-stands previously sold by the complainant to purchasers from it, but this permission does not give authority to reconstruct or rebuild a combination which has been sold by the complainant.”

Wallace, J.:

This case presents, in my view, an utterly unwarranted attempt on the part of the complainant to enlarge the monopoly which it had acquired as the owner of the patents in suit and to



dominate exclusively the manufacture and sale of articles which its patents do not cover and which others have a legal and moral right to make and sell. The preliminary injunction by which the defendants are restrained from making or vending their trolley-stands was granted without a particle of evidence that they had ever infringed any of the claims of the complainant's patents and, as I think, without the slightest evidence that they threaten to do so. They are as much entitled to make and sell their trolley-stands as they are to make and sell the rails, the poles, the wires, the screws, the paint, or any other article which may be required for use by those who own and operate electric railways in which the improvements covered by the patents of the complainant are utilized. The country is crowded with electric railways which utilize these improvements; but the improvements do not consist in the trolley-stand. They consist in various combinations of parts of which a trolley-stand in some form is one. These railways are generally owned and operated by corporations, a great number of which buy their outfit from the complainant, and thereby acquire the right to use the patented combinations during the life of the organized parts. Concededly they have a right to repair their trolley-stands, to substitute new ones for those old or worn out, or to substitute a better and improved kind for those originally bought of the complainant. The defendants have an equal right to make and sell the stands to such owners for that purpose.

The injunction was granted upon the theory that a case of contributory infringement had been shown. The only evidence of contributory infringement consists in the fact that the defendants are making, advertising, and selling their trolley-stands to the public. That they are concerting with infringers with a view to assist them in appropriating, without compensation, the inventions patented by the complainant there is not a particle of evidence. Being entitled to sell their article, they are under no obligation before selling it to inquire whether the purchaser intends to make an illegal use of it. Privity with a wrong-doer is not to be inferred from the exercise of a legal right. The man who sells a gun or a knife would be guilty of an impertinence if he should inquire of the purchaser whether he intends to use it legitimately, and is under no duty to do so. The same rule applies to one who makes or sells an article which is not patented, but which may be used by the purchaser to work an infringement of a patent if he so chooses. One who assists another to infringe a patent is of course a tort-feasor, and whether he is called a contributory infringer or merely an infringer is only a matter of nomenclature; but he does not assist or con-

cert with another to infringe merely because he sells him an article which may be used to effect an infringement. In other words, participation in a wrong is not established by doing a lawful act without evidence of an unlawful intention.

I think the order granting the preliminary injunction should be reversed.

§28. MORGAN ENVELOPE CO. v. ALBANY PAPER CO., 152 U. S. 425, 38 L. ed. 500 (1894).\* \* \*

This was a bill in equity to recover damages for the infringement of three letters patent issued to Oliver H. Hicks, of Chicago, and assigned to the appellant, viz.: Patent No. 325,410, issued September 1, 1885, for a "package of toilet paper," known as the "Oval Roll" or "Oval King" package; (2) patent No. 325,174, issued August 25, 1885, for a "toilet-paper fixture;" (3) patent No. 357,993, issued February 15, 1887, for an "apparatus for holding toilet paper." These are known as the "Oval King" fixtures.  
\* \* \*

Mr. Justice Brown, after stating the facts in the foregoing language, delivered the opinion of the court.

Prior to the inventions covered by the patents in this case, toilet paper had been put up in packages of sheets cut to a convenient size, sometimes attached together by a wire, or in cylindrical rolls of continuous length, either perforated transversely at proper intervals for the convenient detachment of the sheets, or in similar rolls not perforated, but designed to be cut by a device having a sharp edge to which the rolls were attached. All these methods proved to be objectionable on account of the temptation offered to greed or wastefulness, in the facility with which unnecessary amounts of paper could be detached, which were either carried off or allowed to fall on the floor. Where perforated paper was employed in roll form, the litter was increased by the dropping of small particles of paper intended to have been removed by the perforating machine, but which remained attached until the paper was unwound, when they fell upon the floor, and became very difficult to remove.

1. In the specification of his patent No. 325,410, which is for a package of toilet paper, the patentee states that he had in view to furnish a toilet paper in the form which would prevent in a large measure this vast amount of wastage. "In carrying out this object, I have put up one or more lengths of paper in the form of a continuous band (as contradistinguished from a roll) of oblong or oval shape; the short, rounded ends of the bundle thus produced serving as guides for determining the proper points at which the paper has to be separated in order to produce sheets of a size desirable for use, and affording also

the most advantageous surfaces upon which to tear the paper. The band I make of a thickness calculated to produce sheets severed at the point stated of practical and economical lengths from the time the bundle is opened until it is consumed."

The band he makes of an oblong or oval shape, so that it may be mounted in a fixture shown in a previous patent for that purpose, or used detached from the fixture, one hand of the user being slipped into the interior, and the other hand being employed to grasp the pendant end of the paper, and, by drawing the paper tightly over one of the short, rounded ends of the bundle, causing it to separate at that point, and produce a sheet of convenient length. His claim was for "a bundle of paper consisting of one or more lengths, formed into a continuous band, whose internal diameter is greater than the thickness of the paper, substantially as described." The invention in question, as described in the specification and illustrated in the drawings annexed to the patent, is for a band of paper rolled in an oval instead of the usual cylindrical shape, with a view of affording a convenient method of tearing off sheets of a proper size, the fracture in each case being at the end of the roll. It is difficult to see, however, how any waste is thereby prevented, since it is nearly, if not quite, as easy to unwind long strips of this paper from an oblong as from a cylindrical roll. So, too, if the patent were construed as for an oblong roll, the fact that, from time immemorial, cotton and woolen goods and silks have been almost universally wound about a flat board or core, precisely as described in the patent, would indicate that there is no novelty in the oblong or oval shape, and that the patent, if supported at all, must be for the different purpose for which toilet paper is wound in this form.

Upon examining the claim, however, in connection with the original application, it appears that, if the patent involved any invention at all, it is not limited to bands of oval or oblong shape, since the claim contained in the original application was for "a bundle of toilet paper consisting of one or more lengths of paper formed into a flexible continuous band of oblong or oval shape, the short rounded ends of such band serving as guides for determining the proper points at which the paper is to be separated in order to produce sheets of a size desirable for use, and affording, also, the most advantageous surfaces upon which to tear the paper, substantially as described." This claim, which corresponds with the specification and drawings, and was Hicks' real invention, was rejected as indefinite, because it failed to point out any construction over an ordinary paper roll, and was also rejected upon a prior patent to one Peacock. The patentee thereupon amended his application by changing

his claim to "a bundle of paper consisting of one or more lengths, formed into a continuous band, whose internal diameter [by which we understand the internal diameter when rolled into a cylindrical form] is greater than the thickness of the paper, substantially as described."

If this claim be good, it would seem to follow that any band of paper wound in such manner that the internal diameter is greater than the thickness of the paper would be an infringement, whatever be its shape, or for whatever purpose used. The size of the roll, too, is not made material, except that it must bear a certain relation to its inner diameter. Certainly it would apply to all toilet paper, even if wound in a cylindrical form, as the language of the claim, though not of the specification, indicates that it should be. It would also follow that, even if the roll of paper, when purchased, had an internal diameter less than the thickness of the paper, such internal diameter would become relatively greater with the progressive using of the paper, until its thickness was so far reduced as to become less than the internal diameter, when it would fall within the description of the claim. Indeed, it is difficult to see what function is performed by a band of paper so constructed, or what difference it makes whether the internal diameter is greater or less than the thickness of the paper, unless the paper be made in an oval form.

It is insisted in this connection, however, that under the words, "substantially as described," the patentee is entitled to claim a band of oval or oblong shape, and that, looking at his specification and drawing in connection with the claim, it is obvious that the latter should be so limited. But, the patentee having once presented his claim in that form, and the patent office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto. *Leggett v. Avery*, 101 U. S. 256; *Shepard v. Carrigan*, 116 U. S. 593, 6 Sup. Ct. 493; *Crawford v. Heysinger*, 123 U. S. 589, 606, 8 Sup. Ct. 399; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 5 Sup. Ct. 475.

It is true that these were cases where the original claim was broader than the one allowed, but the principle is the same if the rejected claim be narrower. Why the claim of the present patent was allowed after the rejection of the narrower claim does not appear. The objections made to the claim as originally presented seem to be equally applicable to this.

But, construing this claim as for an oval or oblong roll, it is clearly anticipated by the patent granted March 6, 1883, to

one Peacock, for a toilet-paper case, used for carrying toilet paper, which was wound in an oval form about a spool or core, precisely as described in plaintiff's patent. Apparently it differs from the Hicks roll only in being smaller, and having its core hinged to a stiff case, in which the paper, for convenience, was carried.

There was also put in evidence by the defendants a device known as the "Wheeler Pocket Companion," which was a small package of toilet paper of an oval form, differing from those covered by the Hicks patent only in size, and in the fact that no attention was paid to the relation of the inner to the outer convolutions, and no intent shown that, when one convolution was torn off, the end of the next one would drop down into position to be grasped. While neither of these devices is a precise anticipation of the Hicks patent in the manner in which they are used, it is impossible to say that a mere enlargement of these devices to the size contemplated by Hicks would constitute invention, although by such enlargement the roll became capable of being used in a somewhat different manner.

2. Patents No. 325,174 and No. 357,993 are practically the same, and are for a combination of the paper roll described in the former patent, with a mechanism for the delivery of the paper to the user in an economical manner. The object of both inventions is said to be "to so arrange the paper as to prevent more than a given quantity of it to be withdrawn from the roll at a single operation, and so that in the act of withdrawing such given quantity it shall be automatically severed from the roll, leaving pendant from the roll a free end, which shall serve as a means of withdrawing a like quantity by the next user." This is accomplished by the combination of an oscillating roll of toilet paper actuated in one direction by a pull upon its free end, of a knife or cutter co-operating with the roll to sever the unwound portion when the roll has reached the limit of its motion in one direction, and a stop for so limiting the motion of the roll. The principle difference between the two patents is that No. 325,174 is limited to an appliance in which a knife or cutter for arresting the roll of paper, when oscillated, is employed; while the later one—No. 357,993—is broad enough in its scope to include a structure in which a mere stop, which has no cutting action at all, is employed to arrest the roll.

Each patent contains five claims, and in all of them, except the fourth and fifth of the first patent and the fifth of the second, the paper roll is included as an element of the combination.

No question is made but that the mechanism of these patents, by which the paper is served out to the user, involves a

patentable novelty; but it is claimed—First, that, the roll of paper being perishable, and the machine being constructed for the purpose of delivering this paper to users in convenient lengths, such a roll is not a proper part of the combination; second, that, conceding it to be a part of the combination, there was no infringement.

The first defense raises the question whether, when a machine is designed to manufacture, distribute, or serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. If this be so, then it would seem to follow that the log which is sawn in the mill, the wheat which is ground by the rollers, the pin which is produced by the patented machine, the paper which is folded and delivered by the printing press, may be claimed as an element of a combination of which the mechanism doing the work is another element. The motion of the hand necessary to turn the roll and withdraw the paper is analogous to the motive power which operates the machinery in the other instances.

But, without expressing an opinion upon this point, we think the facts of this case fail to sustain the charge of infringement. Defendants neither made, sold, nor used the mechanism invented by Hicks to serve out the toilet paper, except as they purchased it of the patentee; and the only acts proven against them were in selling oval rolls of paper of their own manufacture, with fixtures manufactured and sold by the plaintiff, in combination with its (the plaintiff's) paper, to persons other than the defendants, the fixtures having been obtained by defendants from the original purchasers of the patented combination; and also of selling oval rolls of paper of defendants' own manufacture to persons who had previously purchased fixtures and paper from the plaintiff, with the knowledge and intention that the paper so sold was to be used in connection with the plaintiff's fixtures. In this connection it appeared that it had not been the practice of the plaintiff to sell its fixtures independently of its paper, and that it sold only to such parties as dealt in and used its paper. Purchasers were also required to buy a given quantity of paper to a given number of fixtures, to be sold only in connection with the paper; the rule being not to sell more than one fixture to one case of paper. The fixtures were also sold to hotels and other public buildings, with the understanding that their paper would be subsequently purchased of the plaintiff company. It appears to have been its invariable rule to refuse to sell fixtures except to persons also ordering paper.

So far as fixtures sold by defendants, which had been originally manufactured and sold by the patentee to other parties, are

concerned, it is evident that by such original sale by the patentee they passed out of the limits of the monopoly, and might be used or sold by any one who had purchased them from the original vendees. The patentee having once received his royalty upon such device, he cannot treat the subsequent seller or user as an infringer. *Bloomer v. McQuewan*, 14 How. 539. As was said by Mr. Justice Clifford in *Chaffee v. Belting Co.*, 22 How. 217, 223: "When the patented machine rightfully passes to the hands of the purchaser from the patentee, or from any other person authorized to convey it, the machine is no longer within the limits of the monopoly. \* \* \* By a valid sale and purchase, the patented machine becomes the private individual property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the state in which it is situated." See, also, *Bloomer v. Millenger*, 1 Wall. 340; *Paper Bag Cases*, 105 U. S. 766. In this latter case one Morgan had purchased a machine for making paper bags of the patentee, and it was held that, having the absolute ownership of the machine, he had the right either to use it during the existence of the letters patent, or to transfer such ownership and right to another. It was said that "the power to sell the machine and transfer the accompanying right of use is an incident of unrestricted ownership." *Birdsell v. Shaliol*, 112 U. S. 485, 5 Sup. Ct. 244; *Woodworth v. Curtis*, 2 Woodb. & M. 524, Fed. Cas. No. 18,013; *Goodyear v. Rubber Co.*, 1 Cliff. 348, Fed. Cas. No. 5,557.

The real question in this case is whether, conceding the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such combination, with the intent that it shall be used with the other element, is an infringement. We are of opinion that it is not. There are doubtless many cases to the effect that the manufacture and sale of a single element of a combination, with intent that it shall be united to the other elements, and so complete the combination, is an infringement. *Saxe v. Hammond*, Holmes 456, Fed. Cas. No. 12,411; *Wallace v. Holmes*, 9 Blatchf. 65, Fed. Cas. No. 17,100; *Barnes v. Straus*, 9 Blatchf. 553, Fed. Cas. No. 1,022; *Schneider v. Pountney*, 21 Fed. 399. But we think these cases have no application to one where the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed periodically, whenever the device is put to use. Of course, if the product itself is the subject of a valid patent, it would be an infringement of that patent to purchase such product of another than the patentee; but, if the product be unpatentable, it is giving to the patentee of the ma-

chine the benefit of a patent upon the product by requiring such product to be bought of him. To repeat an illustration already put: If a log were an element of a patentable mechanism for sawing such log, it would, upon the construction claimed by the plaintiff, require the purchaser of the sawing device to buy his logs of the patentee of the mechanism, or subject himself to a charge of infringement. This exhibits not only the impossibility of this construction of the patent, but the difficulty of treating the paper as an element of the combination at all. In this view, the distinction between repair and reconstruction becomes of no value, since the renewal of the paper is, in a proper sense, neither the one nor the other.

The case of *Cotton-Tie Co. v. Simmons*, 106 U. S. 89, 1 Sup. Ct. 52, presents no difficulty whatever. In that case the owner of a patent for a metallic cotton bale tie, each tie consisting of a buckle and band, granted no licenses to manufacture the ties, but supplied the market with them, and stamped upon the metal of each buckle the words, "Licensed to use once only." After the bands had been once used and severed, defendants, who had bought the bands of the buckles as strap iron, rolled and straightened the pieces of the bands, and riveted together their ends. They then cut them into proper lengths, and sold them with the buckles, to be used as ties, nothing having been done to the buckles. It was held that they thereby infringed the patent. The gist of the decision is that the use of a tie once, and its subsequent severance, were intended to operate as a destruction of it, and that the defendants had no right to put the same parts together for use a second time. Says Mr. Justice Blatchford: "Whatever rights the defendants could acquire to the use of the old buckle, they acquired no right to combine it with a substantially new band to make a cotton bale tie. They so combined it when they combined it with a band made of the pieces of the old band in the way described. What the defendants did in piecing together the pieces of the old band was not a repair of the band or tie in any proper sense. The band was voluntarily severed by the consumer at the cotton mill, because the tie had performed its function of confining the bale of cotton in its transit from the plantation or the press to the mill. Its capacity for use as a tie was voluntarily destroyed."

It is evident that the use of the tie was intended to be as complete a destruction of it as would be the explosion of a patented torpedo. In either case, the repair of the band or the refilling of the shell would be a practical reconstruction of the device. In this case, however, the purchaser of the new roll does precisely what the patentee intended he should do; he replaces that which is in its nature perishable, and without the re-



placement of which the remainder of the device is of no value. The replacement is of a product which it is the object of the mechanism to deliver. The case is more nearly analogous to that of *Wilson v. Simpson*, 9 How. 109, in which the invention involved was a planing machine, and the patent sued upon covered the combination with the cutting knives or planes of a pressure roller to effect the planing of the planks. It was proved that one of the machines would last in use for several years, but that its cutting knives would wear out, and must be replaced at least every 60 or 90 days. It was said by Mr. Justice Wayne (page 125) that "the right to replace them was a part of the invention transferred to the assignee for the time he bought it, without which his purchase would be useless to him, except for sixty or ninety days after a machine had been put in use. It has not been contended, nor can it be, that such can be a limitation of the assignee's right in the use of the invention. \* \* \* If, then, the use of the machine depends upon the replacement of the knives, \* \* \* frequently replacing them, according to the intention of the inventor, is not a reconstruction of the invention, but the use only of so much of it as is absolutely necessary to identify the machine with what it was in the beginning of its use, or before that part of it had been worn out. The right of the assignee to replace the cutter knives is not because they are perishable materials, but because the inventor of the machine has so arranged them, as a part of his combination, that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been of little use to the inventor or to others."

The true distinction is stated by Mr. Justice Clifford in *Aiken v. Print Works*, 2 Cliff. 435, Fed. Cas. No. 113, where the invention was of a knitting machine, with which the vendor was accustomed to send a package of the needles used in the machine, which needles were the subject of a separate patent. It was held that the purchase of the knitting machine, and the needles accompanying the same, did not confer upon the purchaser any right, after the needles were worn out and became useless, to manufacture other needles, and use the same in the knitting machine so sold and purchased. The case of *Wilson v. Simpson* was distinguished from this in the fact that the cutters and knives in that case were not subject to a patent, and of course the respondent had a right to use them as materials to repair his machine; "but," says the court, "unfortunately for the defendants in this case, the needle is subject to a patent, and in making and using it they have infringed the right of the plaintiff." As we have already held that the paper roll in this case

was not the subject of a valid patent, it follows that the defendants cannot be held as infringers for the manufacture and sale of such roll.

Considerable stress is laid by plaintiff upon the fact that Mr. Wheeler, president of the defendant corporation, in February, 1885, and before the first patent was issued, bought one of the plaintiff's fixtures, known as the "Oval King" fixture, together with some of its paper, and dispatched them to England, with instructions to his agents to file an application for a patent there, which patent was subsequently issued; that, before a patent was issued, Hicks himself applied for protection in England, and, learning of the filing of the application there by Wheeler, filed a protest against the issuance of a patent to the latter, who thereupon, to thwart his obtaining a patent, made an affidavit that he did not obtain the knowledge of the invention from Hicks or any other person, but by seeing it in public use in the United States. Wheeler's own testimony in this case indicates that this affidavit contained a *suppressio veri*, if not a *suggestio falsi*. But, however reprehensible his conduct may have been in this connection, it does not affect the issue between the parties here. It does not show that the Hicks patent upon the roll is a valid patent, or that the conduct of the defendants in making and selling such roll is an infringement upon the combination patents.

The decree of the court below is therefore affirmed.

Mr. Justice White, not having been a member of the court when this case was argued, took no part in its decision.

828a. THOMSON-HOUSTON ELECTRIC CO. v. OHIO BRASS CO., 80 Fed. 712, 26 C. C. A. 107 (1897, Sixth Circuit).

Before Taft, Lurton, and Clark, Judges.

Taft, J., (after stating the facts as above):

The catalogue of the defendant shows that it is offering for sale to the public without restriction the switch and trolley to be used as part of the equipment of an electric street railway. Defendant has not shown, and we infer from the evidence that it cannot be shown, that either the switch or trolley and harp can be used in an electric railway except in the combinations described and claimed in the two patents here in suit. The third claim of Patent No. 424,695 is for a combination of an overhead wire for receiving an underneath contact and a switch-plate attached to the wire in about the same horizontal plane as the wire. The description of the article sold by the defendant in its catalogue is that of an "underrunning adjustable switch," and it is said to make a perfectly straight underrunning approach for the trolley-wheel. It is apparent that the switch-plate has no

practical utility except in such an arrangement of parts as that stated in the third claim. The same thing is true of the fourth and eleventh claims of that patent. The sixth claim of Patent No. 495,443 is a combination, in an electric railway, of (1) a suitable track, (2) a supply-conductor suspended above the track, (3) a car provided with (4) a swinging arm carrying (5) a contact device in its outer extremity, and (6) means for imparting upward pressure to the outer portion of the arm and contact to hold the latter in continuous working relation with the under side of the supply-conductor. The evidence sufficiently shows that neither the trolley nor the harp is adapted to be used on electric street-railways except in the above combination. Purchasers buy articles for practical use, and would only buy the switch and trolley, therefore, for use in complainant's patented combinations. One is legally presumed to intend the natural consequences of his act. Hence the defendant in offering the switch and trolley for sale to the general public may be reasonably held to intend that they should be used in combinations in an electric railway covered by the claims of complainant's patents.

It is well settled that where one makes and sells one element of a combination covered by a patent, with the intention and for the purpose of bringing about its use in such a combination; he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination. The leading case on the subject is *Wallace v. Holmes*, 9 Blatchf., 65, 29 Fed. Cas. 79. It was cited with approval in *American Cotton Tie Co. v. Simmons*, 106 U. S. 89, and the same doctrine was applied and extended by this court in *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, to a case where the article sold was not even an element of the patented combination, but was an article the use of which in connection with patented combination was a violation of the conditions of a license and destroyed the protection the license would otherwise have afforded. The cases in the circuit courts where the same general principle has been applied are legion. We cite a few of them: *Bowker v. Dows*, 3 Fed. Cas. 1070; *Richardson v. Noyes*, 20 Fed. Cas. 723; *Travers v. Beyer*, 26 Fed. 450; *Willis v. McCullen*, 29 Fed. 641; *Alabastine Co. v. Payne*, 27 Fed. 559; *Celluloid Manufacturing Co. v. American Zylonite Co.*, 30 Fed. 437. The contention of the counsel for the defendant, if we understand it, is that the effect of the decision of the Supreme Court in the case of *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, is to do away altogether with the doctrine of contributory infringement.

If this is a proper reading of the judgment of the Supreme Court in that case, it was a somewhat startling departure from previously understood principles in the law of torts. An infringement of a patent is a tort analogous to trespass or trespass on the case. From the earliest times all who take part in a trespass, either by actual participation therein or by aiding and abetting it, have been held to be jointly and severally liable for the injury inflicted. There must be some concert of action between him who does the injury and him who is charged with aiding and abetting before the latter can be held liable. When that is present, however, the joint liability of both the principal and the accomplice has been invariably enforced. If this healthful rule is not to apply to trespass upon patent property, then, indeed, the protection which is promised by the Constitution and laws of the United States to inventors is a poor sham. Many of the most valuable patents are combinations of non-patentable elements, and the only effective mode of preventing infringement is by suits against those who by furnishing the parts which distinguish the combination make it possible for others to assemble and use the combination and who by advertisement of the sale of such parts and otherwise intentionally solicit and promote such invasions of the patentee's rights. The Morgan Envelope Company Case, so far from departing from the doctrine of contributory infringement, expressly recognizes it and the authorities in which it is announced and enforced. The Court held, however, that the doctrine of contributory infringement could not apply in a case in which the claim of the patent embraces a machine and something to be treated thereby which is perishable in its nature and the alleged infringer furnishes the latter element to be used with the machine and consumed. Whether this holding is really a limitation upon the doctrine of contributory infringement or is to be regarded only as in effect deciding that such combinations are impossible in a patent may admit of question.

In *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, this court was obliged to consider with much care the Morgan Envelope Case. After quoting at length from Mr. Justice Brown's opinion, Judge Lurton, speaking for this court, said:

"It is true that Mr. Justice Brown, in discussing the question involved in that case, assumes a combination of the machine for delivering the paper with the paper to be delivered was valid. But, before he finishes the argument, he shows that the assumption leads to an absurdity; and the decision, in effect, is that form of argument known as the *reductio ad absurdum*, establishing that his original assumption was not founded in reason. The illustration of the result of such a combination shows that what

the court was deciding was that a combination of the machine with an unpatentable paper or material to be operated upon by the machine was an impossibility, and the sale of the machine involved and implied the right of use of the material with which it was to be combined; and this is shown by the case of *Wilson v. Simpson*, 9 How. 109, which is cited by Mr. Justice Brown as a case sustaining his conclusion. \* \* \* Thus, with respect to the paper-holder, the Supreme Court in effect held that the sale of the paper-fastener with the paper in it contained the implication of a right to renew the paper when that paper sold should be exhausted, and did not require the purchase of the paper from the original patentee, the paper itself not being patented."

We are very clearly of opinion that the *Morgan Envelope Company Case* does not affect the question of contributory infringement before us.

It is said that no concert of action by defendant with any one for the purpose of accomplishing an infringement of complainant's patent-rights is shown. As already stated, it does appear that defendant is offering for sale articles that can only be used in combination covered by complainant's claims. This is an effort to secure a concert of action by which the combinations of complainant's patents may be assembled. If successful, infringement will follow. Hence the preliminary steps which are intentionally taken to bring about the injury may be enjoined.

In considering the same point in *Wallace v. Holmes*, 29 Fed. Cas. 79, Judge Woodruff said:

"Here the actual concert with the other is a certain inference from the nature of the case, and the distinct effort of the defendants to bring the burner in question into use, which can only be by adding the chimney. The defendants have not, perhaps, made an actual prearrangement with any particular person to supply the chimney to be added to the burner; but every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do it, or cause it to be done."

Now it is suggested that defendant had the right to sell parts to be used in complainant's combinations to the licensees of complainant and to those who, having once bought the articles of the combination from the complainant, it is said, have the implied right to repair and renew parts worn out with use. It being established that defendant is offering for sale articles, intending them to be used in combinations which, if unlicensed by complainant, would be infringements of complainant's patents, we think that it is the duty of the defendant to see to it that such combinations which it is intentionally inducing and promoting

shall be confined to those which may be lawfully organized. We are unable to see why any different rule should be applied in such a case from that applicable to a case in which a defendant makes a patented machine to order. He may make such a machine upon the order of the patentee or a licensee, but not otherwise. Upon him is the peril of a mistake as to the lawful authority of him who gives the order. So he may knowingly assist in assembling, repairing, and renewing a patented combination by furnishing some of the needed parts; but when he does so he must ascertain, if he would escape liability for infringement, that the one buying and using them for this purpose has a license, express or implied, to do so.

What we have said has application only to cases in which it affirmatively appears that the alleged infringer is offering the parts with the purpose that they shall be used in the patented combination. We have found that it does so appear here and is a matter of certain inference from the circumstance that the parts sold can only be used in the combinations patented. Of course such an inference could not be drawn had the articles the sale or offering of which was the subject of complaint been adapted to other uses than in the patented combination. In the latter case the intention to assist in infringement must be otherwise shown affirmatively, and can not be inferred from the mere fact that the articles are in fact used in the patented combinations or may be so used. If defendant avers that he is selling to express or implied licensees of the patentee, the injunction should be granted in such form as shall permit the continuance of these lawful sales. In the case at bar the circuit court offered thus to modify the order; but the defendant declined to apply for the modification. It is hardly in a position now to assign for error the failure of the court to insert such a modification.

The conclusion we have reached as to contributory infringement is supported by the decision of the Circuit Court of Appeals of the Second Circuit on similar facts in *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co.*, 76 O. G., 2008, 22 C. C. A. 1, 75 Fed. 1005, affirming an order of injunction by Judge Townsend in the circuit court. Judge Wallace dissented; but we think the reasoning of the majority more satisfactory. The learned dissenting judge likened the case to one in which the seller of wire or rails should be enjoined from selling them because the articles might be used in any unlawful combination on an electric railway. Such articles could of course be used in so many lawful ways other than in the combinations of the patent that it would be quite unlikely that the sellers could have an intention to promote infringement of particular patents in their sale, and it would be most difficult to prove such inten-

tion; but where the article can only be used in a patented combination the inference of the intention of the maker and seller is certain, and the right of the patentee to injunction ought, we think, to be equally certain.

829. LEEDS & CATLIN CO. v. VICTOR, 213 U. S. 325, 53 L. ed. 816 (1909).\* \* \*

Mr. Justice McKenna delivered the opinion of the Court.

This writ was issued to bring up for review the judgment of the circuit court, affirmed by the circuit court of appeals, adjudging petitioner guilty of contempt of court for violating the injunction which has just been considered in No. 80, and to pay a fine of \$1,000, one-half to the United States and one-half to complainants in the suit, respondents here.

The injunction, as we said in the opinion in No. 80, enjoined petitioner, the Leeds & Catlin Company, from manufacturing, using or selling the method expressed in claim 5 of Letters Patent No. 534,543 to Emil Berliner, dated February 19, 1895, or the apparatus covered by claim 35.

On the 15th of November, 1906, respondent, Victor Talking Machine Company, filed a petition in the circuit court, charging petitioner with a violation of such injunction. A rule was issued against the Leeds & Catlin Company to show cause why an attachment should not issue against it for contempt of court for violating the injunction, which came on to be heard upon supporting and opposing affidavits and the answer of the Leeds & Catlin Company.

A judgment was entered adjudging the Leeds & Catlin Company guilty of contempt, which was affirmed by the circuit court of appeals. (150 Fed. 147; 154 Fed. 58.)

The answer of petitioner referred to the record in No. 80 and in this Court it is stipulated that that record shall be used as part of the record in the pending cases, and certain of the defenses there made are repeated here. For instance, it is contended, and the record in No. 80 is adduced to support the contention, that (1) the patent in suit having expired before the suit was begun, the circuit court was without jurisdiction to entertain the suit; (2) claims in suit being for the functions of a machine are void. And it is further contended that—

“hence the judgment finding defendant [petitioner] in contempt (a) was void, because beyond the jurisdiction of the court; and (b) should be set aside, because the claims being void the injunction was improperly granted.”

These contentions are disposed of by the opinion in No. 80, and we may confine our discussions to the other defenses made in the contempt proceedings.

The facts are practically undisputed, and a detail of them is unnecessary. It is enough to say that petitioner is a manufacturer of disk records, such as are described in No. 80. That is, a record upon which is inscribed a lateral undulating groove of even depth, which, when the disk is revolved, compels the reproducing stylus to be vibrated and propelled across its face.

It will be observed how important the record is to the invention embodied in the claims. It is the undulations in the side walls of the spiral groove which vibrate the stylus back and forth, transmitting the recorded sound-waves to the diaphragm, at the same time propelling the stylus as it engages with the record. If a comparison may be made between the importance of the elements, as high a degree (if not a higher degree) must be awarded to the disk with its lateral undulations as to the stylus. It is the disk that serves to distinguish the invention—to mark the advance upon the prior art.

“As to the reproducing stylus—”  
as is said by respondent—

“it is only necessary that it should be shaped for engagement with the record and so positioned and supported as to be free to be vibrated and propelled by the record.”

The lower courts found that most of the sales (we quote from the opinion of the circuit court of appeals) of the records by petitioner—

“were knowingly made to enable the owners of the Victor Talking Machines to reproduce such musical pieces as they wished by the combination of the Leeds & Catlin record with said machines; and that the Leeds & Catlin Company made no effort to restrict the use to which their records might be put until after motion to punish for contempt had been made; that the only effort at such restriction ever made was to answer upon the face of the record and notice to the effect that such record was intended and sold for use with the “feed-device machine;” that the records sold by plaintiff in error [petitioner] were far more frequently bought to increase the repertory of the purchaser’s Victor machine than to replace worn-out or broken records.”

The “feed-device machine” referred to by the court was a talking-machine bought by petitioner after, as petitioner avers, the circuit court of appeals affirmed the injunction, and in connection with which it sold, as it also avers, and used, its sound-records. The court assumed, for the purpose of the cause, that the feed-device machine might be regarded as not infringing any of the rights of the Victor Company under the Berliner patent. The court further found that it was established by the evidence that the disks were equally suitable for that machine as for the machine of the Victor Company, but that it—



“was not at or before the time of beginning this proceeding a practically or commercially known reproducer of musical or spoken sound, whereas the Victor machine, embodying the claims of the Berliner patent here under consideration, was at such times widely known and generally used, and that the plaintiff in error [petitioner] knew, and sold its records with the knowledge, that if its output was to be used at all by the public it would be used with the Victor machine, and in the combination protected by the claims of the Berliner patent, before referred to.”

And the court concluded that upon these facts it was clear that petitioner had—

“made and sold a single element of the claims of the Berliner patent, with the intent that it should be united to the other elements and complete the combination. And this is infringement. (Heaton-Peninsular Co. v. Eureka Co., 77 Fed. 297; adopted by this court; Cortelyou v. Lowe, 111 Fed. 1005.)”

Petitioner contests the conclusion and opposes it by the principle, which, it is contended, is established by cases in this Court, as well as at circuit, that—

“the person who has purchased a patented combination from the patentee has the right to replace an unpatented element of the combination and for such purpose to purchase such element from another than the patentee or his licensee.”

To bring this principle in clear relief it is said that—

“the majority of the circuit court of appeals has held that such replacement of a single unpatented element of the combination is reconstruction and not within the rights of the purchaser of the patented combination from the patentee.”

And, to complete its argument, petitioner adds that where an inventor so arranges the parts of his patented combination that it cannot satisfactorily, successfully or usefully be continued in use, without successive replacements of one of its elements—

“the replacement of such element, if unpatented, by the purchaser of the combination from the patentee is in accordance with the intention of the patentee and not a reconstruction of the patented combination, but an act within the rights of the purchaser.”

For these principles *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425; *Wilson v. Simpson*, 9 How. 109; *Goodyear Co. v. Jackson*, 112 Fed. 146, are adduced.

The question in the case, therefore, is single and direct, and its discussion may be brought to a narrow compass. Its solution depends upon the application of some rudimentary principles of patent law.

A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or non-composite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its elements or all of its elements are unpatented. For instance, in the case at bar the issue between the parties would be exactly the same, even if the record-disk were a patented article which petitioner had a license to use or to which respondent had no rights independent of his right to its use in the combination. In other words, the fact that the disk sold by petitioner is unpatented does not affect the question involved except to give an appearance of a limitation of the rights of an owner of a Victor machine other than those which attach to him as a purchaser. The question is, what is the relation of the purchaser to the Victor Company? What rights does he derive from it? To use the machine, of course, but it is the concession of the argument of petitioner that he may not reconstruct it. Has he a license to repair deterioration, and when does repair become reconstruction? It would seem that on principle when deterioration of an element has reached the point of unfitness there is a destruction of the combination and a renewal of the element is a reconstruction of the combination. And it would also seem on principle that there could be no license implied from difference in the durability of the elements or periodicity in their use. This, however, is asserted, and we come to the consideration of the cases upon which the assertion is based, and how far it has application under the facts of this record.

Great stress is put upon *Morgan Envelope Co. v. Albany Co.*, supra. That case was a bill in equity for the infringement of three Letters Patent, one for a "package of toilet-paper," known as an "oval roll" or "oval king" package; one for a "toilet paper fixture," and one for an "apparatus for holding toilet-paper." The first patent was declared invalid for want of novelty. Of the other two it was said that they were practically the same and were for a—

"combination of the paper-roll described in the former patent, with a mechanism for the delivery of the paper to the user in an economical manner."

It was conceded that the mechanism of the patents involved patentable novelty, but it was contended that it being constructed for the purpose of delivering paper to users in con-

venient length such a roll was not a proper part of the combination, and that, conceding it was a part of the combination, there was no infringement. The first contention, the Court said, raised the question whether, when a machine is designed to manufacture, distribute or serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. In commenting on the question the Court expressed the view that if the contention could be sustained—

“it would seem to follow that the log which is sawn in the mill, the wheat which is ground by rollers, the pin which is produced by the patented machine, the paper which is folded and delivered by the printing-press—”

might be claimed as an element of a combination. The Court, however, refrained from expressing an opinion upon the point, because it conceived that the facts of the case failed to sustain the charge of infringement. And this on the ground that the defendants in the suit had neither made, sold nor used the patented mechanism, except as they purchased it from the patentee, and the only acts proven against them were that they sold rolls of paper of their own manufacture with fixtures manufactured and sold by the plaintiff, the fixtures having been obtained by defendants from the original purchasers of the patented combination; and also of selling oval rolls of paper of their own manufacture to persons who had previously purchased fixtures and paper from the plaintiff, with the knowledge and information that the paper so sold was to be used in connection with plaintiffs' fixtures. The Court stated the question to be whether, considering the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such a combination with the intention that it should be used with the other elements was an infringement. The answer was in the negative. The Court, however, stated, that there were cases to the effect that the sale of one element of a combination with intention that it should be used with another was an infringement, but decided that they had no application to one where the element made by the alleged infringer was—“an article of manufacture, perishable in its nature, which it is the object of the mechanism to deliver, and must be renewed periodically whenever the device is put to use.”

The case, therefore, is not a precedent for the decision of that at bar. Not one of the determining factors there stated exist in the case at bar. If the operative relation of the paper-roll to the mechanism was as illustrated (and the Court left no doubt that it was), that is, of the log to the saw in the mill, wheat to the rollers which grind it, pins which are produced by

a patent machine; in other words, in no more operative relation than a machine and its product are, the invalidity of the combination was hardly questionable. And, besides, it was made a determining circumstance that the paper perished by its use, and a periodical renewal was indicated to be a renewal "whenever the device was put to use." The case has no principle or reasoning applicable to the case at bar. The combination in the case at bar is valid, as we have unhesitatingly declared. The function it performs is the result of the joint action of the disk and the stylus. The disk is not a mere concomitant to the stylus; it coacts with the stylus to produce the result. Indeed, as we have seen, it is the distinction of the invention, constituting, by its laterally-undulating line of even depth and the effect thereof, the advance upon the prior art. To confound its active co-operation with the mere passivity of the paper in the mechanism described in the Morgan Envelope Company is not only to confound essential distinctions made by the patent laws, but essential distinctions between entirely different things. Besides, the lower courts found that the disks were not perishable. As said by the court of appeals, by Judge Hough:

"Disk records are fragile, i. e., brittle and easily broken; but they are not perishable, i. e., subject to decay by their inherent qualities, or consumed by few uses or a single use. Neither are they temporary, i. e., not intended to endure; on the contrary, we find that they are capable of remaining useful for an indefinite period, and believe they usually last as long as does the vogue of the sounds they record."

Can petitioner find justification under the right of repair and replacement as described in *Wilson v. Simpson et al.*, 9 How. 109, and *Chappel v. Breslan Billing Co.*, 22 How. 217? The court of appeals, in passing on these cases, considered that there was no essential difference between the meaning of the words "repair and replacement." That they both meant restoration of worn-out parts. This distinction was recognized in *Wilson v. Simpson*, supra, where it is said that the language of the court in *Wilson's and Rousseau's Case*, 4 How. 709, did not permit the assignee of a patent to make other machines or reconstruct them in gross upon the frame of machines which the assignee had in use—

"but it does comprehend and permit the resupply of the effective ultimate tool of the invention, which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplated would have to be frequently replaced anew, during the time that the machine as a whole might last."

But there is no pretense in the case at bar of mending broken or worn-out records, or of repairing or replacing "the

operative ultimate tool of the invention" which has deteriorated by use. The sales of petitioner, as found by the courts below, and as established by the evidence, were not to furnish new records identical with those originally offered by the Victor Company, but, to use the language of Judge Lacombe in the circuit court—

"more frequently in order to increase the repertory of tunes than as substituted for worn-out records."

The right of substitution or "resupply" of an element depends upon the same test. The license granted to a purchaser of a patented combination is to preserve its fitness for use so far as it may be affected by wear or breakage. Beyond this there is no license.

It is further contended by petitioner that the disk records, being unpatented articles of commerce which could be used upon the mechanical feed-device machine or exported to foreign countries, or concededly for repair of machines sold by respondent, petitioner could legally sell the same. A detailed comment on this contention or of the case cited to support it we need not make. The facts of the case exclude petitioner from the situation which is the foundation of the contention. The injunction did not forbid the use of the records, except in violation of claims 5 and 35 of respondent's patent. The judgment for contempt was based upon the facts which we have detailed and they show a sale of the records for use in the Victor machine, "an entirely voluntary and intentional" (to use the language of Judge Lacombe) contributory infringement.

We have seen that the circuit court of appeals assumed, for the purposes of this cause, that the feed-device machine was not an infringement of the machine of the patent. We may assume the same, and we are relieved from reviewing the very long and complex affidavits submitted by the petitioner to explain the same, petitioner's relation to it or its position in the art of sound reproduction. Petitioner was found guilty of selling records which constituted an element in the combination of the patent in suit, and for that petitioner was punished. Upon whatever questions or contentions may arise from the use of the feed-device machine we reserve opinion.

We have not reviewed or commented upon the other cases cited respectively by petitioner and respondents in support of their contentions, deeming those we have considered and the principles we have announced sufficient for our decision.

Judgment affirmed.

[Libel and slander and threatening circulars have been the subject of frequent and variable discussion by the courts.]

830. EMACK v. KANE, 34 Fed. 46 (1888, C. C. III).

Blodgett, J.:

\* \* \* Many more extracts might be made from these circulars, which appear in the proof, but this is enough to show the spirit in which the defendant attempted to intimidate the complainant's customers from dealing with him, or dealing in the slates manufactured by him; and the proof shows abundantly that much business has been diverted from the complainant by these threats and circulars; that the complainant's business has been seriously injured, and his profits very much abridged by the course pursued in sending out these circulars. The proof in this case also satisfies me that these threats made by defendants were not made in good faith. The proof shows that defendants brought three suits against Emack's customers, for alleged infringement of the Goodrich patent by selling the Emack slates; that Emack assumed the defense in these cases, and, after the proofs were taken, and the suits ripe for hearing, the defendants voluntarily dismissed them—the dismissals being entered under such circumstances as to fully show that the defendants knew that they could not sustain the suits upon their merits; that said suits were brought in a mere spirit of bravado or intimidation, and not with a bona fide intent to submit the question of infringement to a judicial decision.

The defense interposed is—First, that these circulars were mere friendly notices to the trade of the claims made by defendants as to what was covered by the Goodrich patent; second, that a court of equity has no jurisdiction to entertain a bill of this character, and restrain a party from issuing circulars, even if they are injurious to the trade of another.

In support of this latter point defendants rely upon the opinion of Mr. Justice Bradley, in *Kidd v. Horry*, 28 Fed. 773, and *Wheel Co. v. Bemis*, 29 Fed. 95, decided by Judges Coit and Carpenter in the district court of Massachusetts. *Kidd v. Horry* was an application for an injunction restraining the defendant from publishing certain circular letters alleged to be injurious to the patent-rights and business of the complainant, and from making and uttering libelous and slanderous statements, written or oral, of, or concerning the business of, complainant, or concerning the validity of their letters patent, or of their title thereto, pending the trial and adjudication of a suit which had been brought to restrain the infringement of said patents; and Mr. Justice Bradley in deciding the case said:

“The application seems to be altogether a novel one, and is urged principally upon a line of recent English authorities, such as *Dixon v. Holden*, L. R. 7 Eq. 488; *Food Co. v. Massam*, 14 Ch. Div. 763; *Thomas v. Williams*, Id. 864; and *Loag v. Bean*,

26 Ch. Div. 306. An examination of these and other cases relied on convinces us that they depend on certain acts of the parliament of Great Britain, and not on the general principles of equity jurisprudence. \* \* \* But neither the statute law of this country, nor any well-considered judgment of a court, has introduced this new branch of equity into our jurisprudence. There may be a case or two looking that way, but none that we deem of sufficient authority to justify us in assuming the jurisdiction. \* \* \* We do not think that the existence of malice in publishing a libel, or uttering slanderous words, can make any difference in the jurisdiction of the court. Malice is charged in almost every case of libel; and no cases or authority can be found, we think, independent of statute, in which the power to issue an injunction to restrain a libel or slanderous words has ever been maintained, whether malice was charged or not."

The principle of this case, concisely stated, is that a court of equity has no jurisdiction to restrain the publication of a libel or slander. But it seems to me the case now under consideration is fairly different and distinguishable from the cases relied upon by the defendants in what seems to me a material and vital feature. In *Kidd v. Horry* the owner of a patent sought the interference of a court of equity to restrain the defendants from publishing and putting in circulation statements challenging the validity of his patent, and of his title thereto, on the ground that such publications were libelous attacks upon his property. Here the complainant seeks to restrain the defendants from making threats intended to intimidate the complainant's customers under the pretext that complainant's goods infringe a patent owned or controlled by defendants, and threats that if such customers deal in complainant's goods they will subject themselves to suit for such infringement; the bill charging, and the proof showing, that these charges of infringement are not made in good faith, but with a malicious intent to injure and destroy the complainant's business. While it may be that the owner of a patent cannot invoke the aid of a court of equity to prevent another person from publishing statements denying the validity of such patent by circulars to the trade, or otherwise, yet, if the owner of a patent, instead of resorting to the courts to obtain redress for alleged infringements of his patent, threatens all who deal in the goods of a competitor with suits for infringement, thereby intimidating such customers from dealing with such competitor, and destroying his competitor's business it would seem to make a widely different case from *Kidd v. Horry*, and that such acts of intimidation should fall within the preventive reach of a court of equity. It may not be libelous

for the owner of a patent to charge that an article made by another manufacturer infringes his patent; and notice of an alleged infringement may, if given in good faith, be a considerate and kind act on the part of the owner of the patent; but the gravamen of this case is the attempted intimidation by defendants of complainant's customers by threatening them with suits which defendants did not intend to prosecute; and this feature was not involved in *Kidd v. Horry*. I cannot believe that a man is remediless against persistent and continued attacks upon his business, and property rights in his business, such as have been perpetrated by these defendants against the complainant, as shown by the proofs in this case. It shocks my sense of justice to say that a court of equity cannot restrain systematic and methodical outrages like this, by one man upon another's property rights. If a court of equity cannot restrain an attack like this upon a man's business, then the party is certainly remediless, because an action at law in most cases would do no good, and ruin would be accomplished before an adjudication would be reached. True, it may be said that the injured party has a remedy at law, but that might imply a multiplicity of suits which equity often interposes to relieve from; but the still more cogent reason seems to be that a court of equity can, by its writ of injunction, restrain a wrongdoer, and thus prevent injuries which could not be fully redressed by a verdict and judgment for damages at law. Redress for a mere personal slander or libel may perhaps properly be left to the courts of law, because no falsehood, however gross and malicious, can wholly destroy a man's reputation with those who know him; but statements and charges intended to frighten away a man's customers and intimidate them from dealing with him, may wholly break up and ruin him financially, with no adequate remedy if a court of equity cannot afford protection by its restraining writ.

The effect of the circulars sent out by the defendant Kane certainly must have been to intimidate dealers from buying of the complainant, or dealing in slates of his manufacture, because of the alleged infringement of the Goodrich patent. No business man wants to incur the dangers of a lawsuit for the profits which he may make as a jobber in handling goods charged to be an infringement of another man's patent. The inclination of most business men is to avoid litigation, and to forego even certain profits, if threatened with a law suit which would be embarrassing and vexatious, and might mulct them in damages far beyond their profits; and hence such persons, although having full faith in a man's integrity, and in the merit of his goods, would naturally avoid dealing with him for fear of possibly becoming involved in the threatened litigation. The complainant as



I have already stated, was engaged in the manufacture of school slates under the Butler and Mallett patents; the Butler patent being much older than the Goodrich, and the Mallett patent being nearly contemporaneous in issue with the Goodrich patent, under which the defendant was manufacturing. But the proof in this case shows a still older patent, granted to one Munger, in 1860, for a muffled or noiseless slate, which most clearly so far anticipates the patents of both complainant and defendants, as to limit them, respectively, to their specific devices. But I do not think the fact that complainant was the owner of these patents or operating under them, material to the questions in this case. The defendants claim that complainant's slates infringe the Goodrich reissue patent, and threaten complainant's customers with suits if they deal in complainant's slates. The state of the art to which the Goodrich patent pertains may be examined for the purpose of aiding the court in passing upon the question of defendants' good faith in making such threats, and the state of the art is only material, as it seems to me, for this purpose. The court will not attempt, in a collateral proceeding like this, to pass upon the validity of the Goodrich patent, but will consider, in the light of the proof as to the state of the art, and the proof as to defendant's conduct, whether the defendant made these threats against complainant's customers because he in good faith believed that complainant's slates infringed his patent, and intended to prosecute for such infringement, or whether such threats were made solely to intimidate and frighten customers away from complainant, and with no intention of vindicating the validity of his patent by a suit or suits. Instead of going into the courts to test the validity of the Butler patent, or the right of complainant to make the kind of slates he was putting upon the market, the defendant, in a bullying and menacing style, asserts to the trade by these circulars that complainant is infringing the Goodrich patent, and threatens all who deal in complainant's slates with lawsuits, and all the perils and vexations which attend upon a patent suit. The average business man undoubtedly dreads, and avoids, if he can, a lawsuit of any kind, but a suit for infringement of a patent is so far outside of the common man's experience that he is terrorized by even a threat of such a suit. There seems to me certainly good grounds for doubting the validity of the Goodrich patent in the light of the state of the art at the time he entered the field; and that any lawyer well versed in the law of patents would surely hesitate to advise that the complainant's slates infringed the Goodrich patent, either before or after the reissue; and the conduct of the defendant in dismissing his suits for such alleged in-

fringement without trial, shows that he did not believe that such infringement could be established.

I am, therefore, of opinion that complainant has made a case entitling him to the interposition of a court of equity to prevent the issue of circulars, or other written or oral assertions, that the slates made by the complainant are an infringement upon the defendant's patent; and a decree may accordingly be entered as prayed in the bill.

830a.

Note—Various cases are cited and the conclusion reached that when the notices are not in good faith injunctive relief may be granted. *A. B. Farquhar Co. v. National Harrow Co.*, 42 C. C. A. 600, 102 Fed. 714, 715. To the same effect is Judge Wallace in *Adriance Platt & Co. v. National Harrow Co.*, 30 C. C. A. 94, 121 Fed. 827, (quoted *infra*).

In *Kelley v. Ypsilanti Co.*, 44 Fed. 19, 23, Judge Brown, while thinking it an act of prudence, if not of kindness, upon the part of the patentee, to notify the public of his invention, and to warn persons dealing in the article of the consequence of purchasing from others, says:]

“There is undoubtedly authority for holding that, if the language of such letters or circulars be false, malicious, offensive, or opprobrious, or used for the willful purpose of inflicting an injury, the party is entitled to his remedy by injunction; and this is the extent to which the authorities go. *Hovey v. Rubber Tip Pencil Co.*, 57 N. Y. 119; *Snow v. Judson*, 38 Barb. 210; *Emack v. Kane*, 34 Fed. 46; *Croft v. Richardson*, 59 How. Pr. 356; *Wren v. Weild, L. R.*, 4 Q. B. 730.

[The following under this heading are brief extracts to complete the discussion]:

831. *CASEY v. CINCINNATI UNION*, 45 Fed. 135.

[Judge Sage quotes and discusses with approval *Emack v. Kane*, applying the case as an authority for the general principle of the power of an equity court to enjoin the publication and circulation of injurious posters, hand bills, circulars, etc.]

832. *COMPUTING SCALE CO. v. NATIONAL COMPUTING SCALE CO.*, 79 Fed. 962, 963, 965.

[Judge Sage in a matter involving a patent discusses *Emack v. Kane*, *Casey v. Typographical Union*, *Barr v. Trades Council*, 53 N. J. Eq. 101, 30 Atl. 881. He also discusses *Grand Rapids v. Haney*, 92 Mich. 558, 52 N. W. 1009, applying these cases in a cause where he refused to enjoin the complainants from suing users of the alleged infringing machine, or from warning users by letters or advertisements.

In this case the court by pointing out the element of fraud and misrepresentation in the cited cases, distinguished the particular case before him.]

833. LEWIN v. WELSBACH LIGHT CO., 81 Fed. 904 (C. C. P., 1897).

[It is apparent from this case that the reason for the court not enjoining the sending out of circulars by complainant was because there was no case made out of an attempt to destroy the complainant's business in advance of any adjudication of the question of their right to maintain and continue it.]

834. NASHVILLE RY. CO. v. DUCKWORTH, 82 Fed. 65, 78 (C. C. Tenn. 1897).

]The court says:]

"So, in *Shoe Co. v. Saxey*, 131 Mo. 212, 32 S. W. 1106, the supreme court of Missouri held that a court of equity might interfere by injunction to prevent persons from attempting, by intimidation, threats or other unlawful means, to force employes to quit work and join a strike, and that a court of equity might enjoin acts threatening irreparable injury to property rights, notwithstanding such acts were also a violation of the criminal law. *Klein v. Livingston Club*, 177 Pa. St. 224, 35 Atl. 606; *Davis v. Zimmerman*, (Sup.) 36 N. Y. Supp. 303, and *Elder v. Whitesides*, 72 Fed. 724, are in accord."

[At page 81 the court cites at some length from an English case affirming the power of a court of equity to restrain one doing a certain act which might result in requiring a person to perform another contract.

Appended to this case is a note by the judge upon the questions of when an injunction is a proper remedy to restrain criminal acts and the relation between federal and state courts, and the protection of trade and business against fraud.

In *Adriance, Platt & Co. v. National Harrow Co.*, 98 Fed. 118, above cited, Judge Coxe was strongly against the extension of the power of equity, admitting, however, that in a flagrant case equity would be obliged to interfere.]

834a. ELECTRIC RENOVATOR MFG. CO. v. VACUUM CLEANER CO., 189 Fed. 754 (C. C. Pa. 1911).\* \* \*

Orr, J.: \* \* \*

Inasmuch as the allegations of the bill were supported by affidavits, the court upon proof of notice to the defendants of the application for a preliminary injunction, being satisfied that unfair business methods had been resorted to and were being resorted to by the defendants, and adopting the views of the cir-

cuit court of appeals of this circuit in *Farquhar Co. Ltd. v. National Harrow Co.*, 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755, and the views of the Court of Appeals for the Second Circuit in *Adriance, Platt & Co. v. National Harrow Co.*, 121 Fed. 827, 58 C. C. A. 163, issued an order "restraining the defendants, and each of them, their officers, agents and employes from further in any manner issuing or making any notice, warning, threat or statement charging the complainant, its officers, agents or employes, or any one engaged in selling or using vacuum cleaning apparatus manufactured by complainant, with infringement," of said letters-patent, giving leave to the defendant to apply within ten days for a modification of said order. Subsequently, on May 19, 1911, the defendants moved for an order dissolving and vacating the preliminary injunction. There is nothing in the averments contained in the affidavits in support of the motion to amend the order which indicates that the defendants or either of them were acting in good faith in sending out the notices and warnings complained of in the bill. At that time no bill had been filed by the defendants against the complainant alleging the infringement of the Kenney patent. One had been prepared to be filed against the First Baptist Church of Pittsburgh, but on the argument of the motion to amend the order of injunction the court intimated strongly the view that until an action at law or in equity was brought against the complainant in the bill in this case for infringement of the patents claimed to be owned by the defendants, the injunction would not be disturbed. It appears in the defendants' affidavit that many people have taken licenses under the defendant. This may have resulted from the campaign carried on by the defendants against users to the neglect of proceeding against manufacturers, although demanded by the latter.

\* \* \*

A preliminary injunction was properly issued; but, since the defendants have filed their bill against the complainant to have the question of the validity of the Kennedy patent determined, the injunction will be somewhat modified, so as to read that:

"The defendants, and each of them, their officers, agents and employes, be, and they are hereby enjoined, until the further order of this court, from further in any manner issuing or making any warning, threat, improper notice, or improper statement charging the complainant, its officers, agents or employes, or any one engaged in selling or using vacuum cleaning apparatus manufactured by the complainant, with infringement of the letters-patent of the United States granted on the application of David T. Kenney."

835. ASBESTOS SHINGLE CO. v. JOHNSON-MANVILLE CO., 189 Fed. 611 (1911, C. C. N. Y.).

[Judge Hand, after stating that the common-law power to punish as for contempt and misstatement of the effect of the decision of a court had been taken away from federal judges by § 723 of the Revised Statutes, says:]

"The misuse of a decree of the court in so far as it constitutes an offense against the dignity of the court certainly would not come within its power to punish, but this is a case where one party claims to be suffering damage from the acts of another. Even if it be a contempt, it is also a civil wrong, and it would surely be an absurdity that it should not carry a remedy in some tribunal and by some procedure. May a party, therefore, apply in the main suit either on motion, or by petition, or must he bring a plenary suit? Or may the defendant apply by cross-bill? If the proceeding were in the nature of a contempt there would be no difficulty, since it is then regarded as a part of the suit itself, but this is not and can not be, a punishable contempt. The relief has been granted by either motion or petition in several cases. *Barnum v. Goodrich*, Fed. Cas. No. 1,036; *Birdsell v. Hagerstown Mfg. Co.*, 1 *Hughes* 64, Fed. Cas. No. 1,437; *Ide v. Ball Engine Co. (C. C.)* 31 Fed. 901, and *Nat. Cash Register Co. v. Boston Cash Indicator, etc., Co. (C. C.)* 41 Fed. 51.

[After referring to these cases the court says, however, that it is probably true that all these cases were wrongly decided in view of *Birdsell v. Shaliol*, 112 U. S. 485, 28 L. ed. 768, then discussing various views of the practice in *Kelley v. Ypsilanti*, 44 Fed. 19; *N. Y. Filter Co. v. Schwarzwald*, 58 Fed. 577; *Ide v. Ball Co. supra*; *Allis v. Stowell*, 16 Fed. 783, 789; *International Tooth Crown Co. v. Carmichael*, 44 Fed. 350; *Rumford v. Hecker*, Fed. Cas. No. 12,132, 5 O. G. 644, with the apparent suggestion that these cases assumed control over the original suit. The court then says:]

"There are a number of other cases, in which an application was considered upon the merits without any indication that the procedure was wrong."

[citing *Tuttle v. Matthews*, 28 Fed. 98; *Computing Scale Co. v. National Computing Scale Co.*, 79 Fed. 862; *Warren Featherbone Co. v. Landauer*, 151 Fed. 130, and especially *Commercial Acetylene Co. v. Avery*, 152 Fed. 642, and *Mitchell v. International Tailoring Co.*, 169 Fed. 145, and some state court cases, concluding:]

"I have no doubt of the court's power at least to control the complainant's use of the decree to the extent of staying further proceedings and perhaps of reopening the decree itself."

[Then upon the merits of the proposition]:

"But I take it there can be no question that a trade injury is actionable when it arises from actual misstatement. Judge Blodgett's opinion in *Emack v. Kane* (C. C.) 34 Fed. 46, which has been much cited and the decision of the circuit court of appeals of this circuit in *Adriance Platt & Co. v. National Harrow Co.*, 121 Fed. 827, 58 C. C. A. 163, were both weaker cases for the aggrieved party than this; indeed, in the latter case, Judge Coxe, who had dismissed the bill, mentions the fact that there was no false statement of fact in any of the circulars. I think there can be no reasonable dispute of the rule that any false statement of the contents of the decree would require some action."

**836. COMMERCIAL ACETYLENE CO. v. AVERY PORTABLE LIGHTING CO.**, 152 Fed. 642, (C. C. Wisconsin 1906).

[In this case Judge Quarles cites numerous authorities including those of these excerpts, holding that the federal court of equity has power to enjoin either party to a suit before it from prosecuting other suits subsequently brought relating to the same subject-matter where it would be contrary to equity and good conscience, although such suits may be in foreign jurisdictions.

As to suits which were commenced before the application for injunction was made, the defendant was left to his remedy by applying for a stay to the courts before which they were pending.

This case discusses at length *Emack v. Kane* and upon the point of that case says further:]

"In *Farquhar v. National Harrow Co.*, 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755, the Circuit Court of Appeals for the Third Circuit held that equitable relief might be granted against a party who was in bad faith, sending notices and trade circulars among the customers of a rival, solely for the purpose of destroying the business of such manufacturer. The same doctrine was held in *Adriance, Platt & Co. v. National Harrow Co.*, 121 Fed. 827, 58 C. C. A. 163, by the Circuit Court of Appeals, Second Circuit.

"In *Warren Featherbone Co. v. Landauer et al.*, 151 Fed. 130, there is an opinion by Judge Bunn, then district judge of the western district of Wisconsin, concurred in by his honor, Judge Seaman, wherein the doctrine of *Emack v. Kane*, *supra*; *Farquhar v. National Harrow Company*, and *Adriance Platt & Co. v. National Harrow Co.*, are cited with approval."

837. **VIRTUE v. CREAMERY PACKAGE MFG. CO.**, 179 Fed. 115, 102 C. C. A. 413.

Sanborn and Adams, C. J., and Riner, D. J.

That the owner of a patent may notify infringers of his claims, and warn them that unless they desist, suits will be brought to protect him in his legal rights, is sustained by numerous decisions. *Kelley v. Ypsilanti Dress Stay Manufacturing Co.* (C. C.) 44 Fed. 19, 10 L. R. A. 686; *Computing Scale Company v. National Computing Scale Company* (C. C.) 79 Fed. 962; *Farquhar Company v. National Harrow Company*, 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755; *Adriance Platt & Co. v. National Harrow Company*, 121 Fed. 827, 58 C. C. A. 163; *Warren Featherbone Company v. Landauer* (C. C.), 151 Fed. 130; *Mitchell v. International, etc., Company* (C. C.), 169 Fed. 145, 30 Cyc. 1054.

The only limitation on the right to issue such warnings is the requirement of good faith. There is nothing in the warnings given in this case to show that the letters or notices were false, malicious, offensive, or opprobrious, or that they were used for the willful purpose of inflicting injury.

838. **WARREN FEATHERSTONE CO. v. LANDAUER**, 151 Fed. 130 (1903, C. C. Wisconsin).

[The court said that in the adjudged cases such relief may be granted in a proper case as well on the application of the defendant as that of the complainant, citing *Emack v. Kane*, *Adriance, Platt & Co. v. National Harrow Co.*, *Farquhar v. National Harrow Co.* and discussing the first named case and quoting from it at length. The court then said:]

“This case (*Emack v. Kane*) was heard on the merits, and the relief was granted in favor of the complainant in the form of a decree for a perpetual injunction. But it is evident, to bring a case within the doctrine so laid down, it should appear that the threatening letters and circulars should be resorted to in bad faith, which is generally shown, as was in that case, by the complainant neglecting or refusing to bring suit.”

839. **MITCHELL v. INTERNATIONAL TAILORING CO.**, 169 Fed. 145 (1909, C. C. N. Y.).

Ward, J.:

The petition contends that the patents are obviously invalid and that the circularizing is done in bad faith. The general rule in equity certainly is that a defendant can obtain affirmative relief only by filing a cross-bill. 16 Cyc. 324. It is true that applications like this have been considered. *New York Filter Co. v. Schwarzwald* (C. C.), 58 Fed. 577; *Warren Featherbone Co.*

v. Landauer (C. C.) 151 Fed. 130. But injunctive relief was denied, and the question of practice was not raised. In Kelley v. Ypsilanti Co., 44 Fed. 19, 23, 10 L. R. A. 686, the question was raised, but not passed upon, because the injunction was denied.

Conceding that I have power to do so, I think I should not grant the relief prayed for. No opinion upon the patents need now be expressed, because at this stage of the case they must be taken to be valid. The papers submitted do not satisfy me that the complainant is acting in bad faith. The statements contained in its circulars are truthful, and it has in support of its patents brought suit in this circuit against the defendant, a manufacturer, and in the circuit court for the district of Indiana against a local dealer, who is alleged to have furnished the defendant with a mailing list of his customers. There is no reason to suppose that the complainant doubts the validity of his patents, and, if they are valid, local dealers who furnish mailing lists to the defendant, knowing or having reason to know that the defendant will use them for the purpose of circulating infringing devices, do contribute to the infringement.

840. SEWALL v. JONES, 91 U. S. 171, 23 L. ed. 275.

He is entitled to protect himself from all other modes of making the same application; and every question of infringement will present the question whether the different mode, be it better or worse, is in substance an application of the same principle.

841. SMITH v. NICHOLS, 88 U. S. 112, 22 L. ed. 566.

The prior patentee can not use it without the consent of the improver, and the latter can not use the original invention without the consent of the former.

842. THOMSON-HOUSTON ELECTRIC CO. v. OHIO BRASS CO., 80 Fed. 712, 26 C. C. A. 107.

Since the case of O'Reilly v. Morse, 15 How. 62, 121, 133, it has been well settled that a patent may issue for an improvement on an earlier invention either to the original inventor or to a stranger. Of course, no one can use the improvement without right or license to use the fundamental invention; but, on the other hand, the right to use the original invention does not confer the right to use the improvement without license from the tributary inventor.

843. GLOBE-WERNICKE CO. v. MACEY, 119 Fed. 696, 56 C. C. A. 304.

If the thing done is wrongful, the lack of intention would not excuse.



844. HOE v. MIEHLE, ETC., MFG. CO., 149 Fed. 213, 79 C. C. A. 171.

Infringement is to be determined by a consideration of the claims, and if their language is such that, upon a fair construction of them, defendant's structure does not fall within their terms, infringement can not be found.

845. HUTTER v. DE Q. BOTTLE STOPPER CO., 128 Fed. 283, 62 C. C. A. 652.

A single sale made in circumstances which indicate a readiness to make other similar sales upon application is sufficient to make out a prima facie case.

846. WELSBACH LIGHT CO. v. UNION, ETC., LIGHT CO., 101 Fed. 131, 41 C. C. A. 255.

If it was a patent for a process, it would not be infringed by selling the product, and no conditions should have been annexed to the exercise of the vendor's rights. The broad proposition that the vendor of a product which has been made in infringement of a patented process is an infringer, or liable to any extent to the patentee, is untenable and does not require discussion. The patentee's remedy is against the manufacturer.

847. McCUNE v. BALTIMORE, ETC., R. CO., 154 Fed. 63, 83 C. C. A. 175.

The plaintiff offered to prove the utility and advantages of his patented device, that it had been appropriated and used by a number of other railroads, and that this use, being without his consent, prevented the establishment of a market value therefor. This offer the court rejected. \* \* \* It will thus be seen that *Suffolk Co. v. Hayden*, has been approvingly cited and considered as authority for the principle, therein enunciated, that, in the absence of license fee or royalty, other proof can in an action at law be resorted to, to show the damage done to the owner of the patent. The law thus announced is conclusive of the case before us, unless *Suffolk Co. v. Hayden* was overruled by the supreme court in *Coupe v. Royer*, 155 U. S. 567, 39 L. ed. 263 \* \* \* Holding, then as we do, that *Suffolk Co. v. Hayden*, is unreversed and unqualified by *Coupe v. Royer*, it follows the court below erred.

848. CLANCY v. TROY BELTING, ETC., CO., 157 Fed. 554, 85 C. C. A. 314.

Although both the parties are citizens of New York, as the action was for the infringement of a patent, and was so tried and decided in the courts below, this court has jurisdiction, notwithstanding that one of the defenses depends upon the construction of a contract of license. We do not think that the decision in *Hartell v. Tilghman*, 99 U. S. 547, 25 L. ed. 357, implies.

849. PITTSBURG METER CO. v. PITTSBURG SUPPLY CO., 109 Fed. 644, 48 C. C. A. 580.

That the defendant's meter and the meter of the Young's patent may effect the same result is not determinative of the question of infringement.

850. UNION STEAM PUMP CO. v. BATTLE CREEK STEAM PUMP CO., 104 Fed. 337, 43 C. C. A. 560.

If, however, such changes of size, form or location effect a change in the principle or mode of operation such as breaks up the relation and co-operation of the parts, this results in such a change in the means as displaces the conception of the inventor, and takes the new structure outside of the patent.

851. KINLOCH TEL. CO. v. WESTERN ELECTRIC CO., 113 Fed. 652, 51 C. C. A. 369.

Mere changes of the form of a device or of some of the mechanical elements of a combination secured by a patent will not avoid infringement, where the principle or mode of operation is adopted, unless the form of the machine or of the elements changed is the distinguishing characteristic of the invention.

852. ROGERS TYPOGRAPH CO. v. MERGENTHALER LINOTYPE CO., 64 Fed. 799, 12 C. C. A. 422.

Yet, notwithstanding these changes and some others, the defendant really has copied the substance of the inventions in different forms. In principle the two machines are alike, and they accomplish the same result.

853. JEWELL FILTER CO. v. JACKSON, 140 Fed. 340, 72 C. C. A. 304.

But the rule that changes of form do not avoid infringement has at least two exceptions—when the form of the mechanical element is the distinguishing characteristic of the invention, and when the change in the form of the element changes the principle or mode of operation of the combination.

854. HEEKIN CO. v. BAKER, 138 Fed. 63, 70 C. C. A. 559.

Identity of result is, however, not a sufficient test of infringement. There must also be substantial identity of the means and manner of its accomplishment.

855. ELECTRIC R. R. SIGNAL CO. v. HALL R. SIGNAL CO., 114 U. S. 87, 29 L. ed. 96, 5 Sup. Ct. 1069.

The object of the patented combination was the accomplishment of a particular result. \* \* \* But this result or idea is

not monopolized by the patent. The thing patented is the particular means devised by the inventor by which that result is attained, leaving it open to any other inventor to accomplish the same result by other means. To constitute identity of invention, and therefore infringement, not only must the result attained be the same, but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function, provided, however, that the differences alleged are not merely colorable, according to the rule forbidding the use of known equivalents.

856. *PLUMMER v. SARGENT*, 120 U. S. 442, 30 L. ed. 737, 7 Sup. Ct. 640.

The fact that by careful workmanship the products are indistinguishable by mere inspection does not establish the identity of the processes; and as the patent for the product must be limited to an article made by the particular process, the inquiry must be determined by a comparison between the methods actually employed.

857. *EAMES v. GODFREY*, 68 U. S. 78, 17 L. ed. 547.

The law is well settled by repeated adjudications in this court and the circuit courts of the United States that there is no infringement of a patent which claims mechanical powers in combination, unless all the parts have been substantially used. The use of a part less than the whole is no infringement.

858. *DOWAGIAC MFG. CO. v. MINNESOTA, ETC., PLOW CO.*, 118 Fed. 136, 55 C. C. A. 86.

This principle, however, is qualified by another principle, which is that the absent element must be an essential one, and that the substitute for it must not be a mechanical equivalent for it.

859. *UNIVERSAL BRUSH CO. v. SONN*, 154 Fed. 665, 83 C. C. A. 422.

If, for any reason, the defendants are enabled to dispense with one of the elements of the claim, or, to speak more accurately, with one step of the process, they can not be held as infringers.

860. *PORTLAND GOLD MIN. CO. v. HERMANN*, 160 Fed. 91, 87 C. C. A. 247.

A combination is not infringed unless all of its elements as they are claimed are used, whether they are essential or not.

861. UNITED STATES v. BERDAN FIREARMS MFG. CO., 156 U. S. 552, 39 L. ed. 530, 15 Sup. Ct. 420.

Where several elements, no one of which is novel, are united in a combination which is the subject of a patent, and these several elements are thereafter united with another element into a new combination, and this new combination performs a work which the patented combination could not, there is no infringement.

862. FAY v. CORDESMAN, 109 U. S. 408, 27 L. ed. 979, 3 Sup. Ct. 236.

The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim or by such a reference to the descriptive part of the specification as carries such elements into the claim, he makes such element material to the combination, and the court can not declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination and be restricted to specified elements, all must be regarded as material, leaving open only the question, whether an omitted part is supplied by an equivalent device or instrumentality.

863. DE LORIEA v. WHITNEY, 63 Fed. 611, 11 C. C. A. 355.

The rule, *prima facie*, is that, while the use of equivalents for an element in a combination is not lawful, yet a combination which does not include all the elements does not infringe. There may be exceptions where the nature of the invention is of such a primary or broad character that it is plain some of the elements named are unessential; in other words, where the invention is so broad that the range of equivalents will be correspondingly broad, under the liberal construction which the courts give to such inventions.

864. INTERNATIONAL MFG. CO. v. BRAMMER MFG. CO., 138 Fed. 396, 71 C. C. A. 633.

If no one can be held to infringe a patent for a combination unless he uses all the parts of the combination and the same identical machinery as that of the patentee, then will no patent for a combination ever be infringed; for certainly no one capable of operating a machine could be incapable of adopting some formal alteration in the machine or of substituting mechanical equivalents. It is true no one infringes a patent for a combination who does not employ all the ingredients of the combination; but if he employs all the ingredients, or adopts mere for-

mal alterations, or substitutes for one ingredient another which performs substantially the same function as the one withdrawn, he does infringe.

865. *STIMPSON v. BALTIMORE, ETC., R. CO.*, 10 How. (U. S.) 329, 13 L. ed 441.

The patent is for a combination. \* \* \* None of the parts referred to are new, and none are claimed as new. \* \* \* The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others, is therefore not the thing patented. It is not the same combination, if it substantially differs from it in any of its parts.

866. *MURPHY MFG. CO. v. EXCELSIOR CAR ROOF CO.*, 76 Fed. 965, 22 C. C. A. 658.

Nothing in the law of patents is better settled than the rule the absence from a device or construction, that is alleged to infringe, of a single essential element of a patentable combination of old elements, is fatal to the claim of infringement.

867. *PITTSBURG METER CO. v. PITTSBURG SUPPLY CO.*, 109 Fed. 644, 48 C. C. A. 580.

Nothing in the law of patents is better settled than the rule that a claim for a combination is not infringed if any one of the described and specified elements is omitted, without the substitution of anything equivalent thereto.

868. *CENTRAL FOUNDRY CO. v. COUGHLIN*, 141 Fed. 91, 72 C. C. A. 93.

A combination is an entirety. If one of its elements is omitted, it ceases to exist. It is well settled, therefore, that the omission of any one ingredient of the combination covered by the claim of the patent averts any charge of infringement.

869. *MURPHY MFG. CO. v. EXCELSIOR CAR-ROOF CO.*, 76 Fed. 965, 22 C. C. A. 658.

The question of infringement or non-infringement in this case, as in every case, must be determined under this rule by the limitations placed upon the patent by the state of the art when it was issued, and by the specifications and claims of the inventor.

870. *NATHAN v. HOWARD*, 143 Fed. 889, 75 C. C. A. 97.

Neither the joinder of two elements into one integral part accomplishing the purpose of both and no more, nor the separa-

tion of one integral part into two, together doing precisely or substantially what was done by the single element, will evade a charge of infringement. \* \* \* This principle is even more applicable when the change made relates to mere matter of form not of the essence of the invention.

**871. DUNLAP v. WILLBRANDT SURGICAL MFG. CO.,** 151 Fed. 223, 80 C. C. A. 575.

Of course, there are cases in which, in determining whether a subsequent device infringes, it is unimportant whether it is made in two pieces instead of three, or whether a member is mechanically attached to the remainder of the structure or made integral with it. \* \* \* They are, however, inapplicable to a case in which the very divisibility into parts or in which the particular method of attachment constitutes the law of the structure or is declared or appears to be of the essence of the supposed invention.

**872. BONNETTE, ETC., SPRINKLER CO. v. KOEHLER,** 82 Fed. 428, 27 C. C. A. 200.

It seems clear to us that Anderson took the principle of Bonnette's invention, and merely doubled the parts. \* \* \* It is well settled that the mere doubling of parts to produce the same result does not prevent infringement, even though it may involve tributary invention.

**873. ADAM v. FOLGER,** 120 Fed. 260, 56 C. C. A. 540.

The validity of the patent had not been adjudicated, and Folger relied upon acquiescence to secure an injunction pendente lite. Without deciding how far, if at all, the use and sale of the Victor heater before the patent was issued should be taken as evidence of acquiescence in the validity of the patent (see *Sargent v. Seagraves*, 2 Curt. 553, Fed. Cas. No. 12,365; *Wilson v. Store Service Co.*, 31 C. C. A. 553, 88 Fed. 286; *McDowell v. Kurtz*, 23 C. C. A. 119, 77 Fed. 206; *Corser v. Overall Co.* [C. C.] 59 Fed. 781; *White v. Hunter* [C. C.] 47 Fed. 819), we are of opinion, on this branch of the case, that the temporary injunction was not improvidently issued. The purpose of showing adjudication against others or acquiescence by the public is not to foreclose the question of validity, but to aid the presumption which the patent raises to a point where the court is satisfied that the probabilities of a final decree in the complainant's favor are so strong that the defendant should be excluded at once from practicing the alleged invention. Three years before the patent issued, Adam took from Folger a license to make heaters ac-

according to Folger's specifications. True, he could not examine the claims in the patent office, but he could examine the heater, interrogate Folger, and search the whole of the prior art for himself, if he chose. He built the heaters in accordance with the specifications furnished by Folger. After the patent was granted, he did not surrender the license. On the contrary, the record seems to indicate that he would be holding it yet if Folger had not canceled it. His use of the patent imprint, and his present contention that, after the withdrawal of the license, he altered the construction so as to avoid the claims, are strong concessions of the patent's validity. No other member of the public has questioned it. So far as Adam is concerned, his actions evidence a sufficient acquiescence. *Blount v. Societe Anonyme du Filtre Chamberland Systeme Pasteur*, 3 C. C. A. 455, 53 Fed. 98; *White v. Surdam* (C. C.) 41 Fed. 790; *Steam Gauge & Lantern Co. v. Ham Mfg. Co.* (C. C.) 28 Fed. 618; *Burr v. Kimbark* (C. C.) 28 Fed. 574. We think it rests with him to convince the court on final hearing that the patent is void. Till then let the point of validity stand in Folger's favor.

\* \* \*

It is well settled that there is no infringement, if any one of the material parts of the combination is omitted, and that a patentee will not be heard to deny the materiality of any element included in his combination claim. *Vance v. Campbell*, 1 Black. 427, 17 L. ed. 168; *Meter Co. v. Desper*, 101 U. S. 337, 25 L. ed. 1024; *McClain v. Ortmyer*, 141 U. S. 423, 12 Sup. Ct. 76, 35 L. ed. 800. If a patentee claims eight elements to produce a certain result, when seven will do it, anybody may use the seven without infringing the claim; and the patentee has practically lost his invention by declaring the materiality of an element that was in fact immaterial. But form, location and sequence of elements are all immaterial, unless form or location or sequence is essential to the result or indispensable, by reason of the state of the art, to the novelty of the claim. *Winans v. Denmead*, 15 How. 330, 14 L. ed. 717; *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 958; *Bundy Mfg. Co. v. Detroit Time Register Co.*, 36 C. C. A. 375, 94 Fed. 524; *Extraction Co. v. Brown*, 43 C. C. A. 568, 104 Fed. 345; *Norton v. Jensen*, 1 C. C. A. 452, 49 Fed. 859; *Consolidated Safety-Valve Co. v. Crosby Steam-Gauge & Valve Co.*, 113 U. S. 157, 5 Sup. Ct. 513, 28 L. ed. 939; *Hoyt v. Horne*, 145 U. S. 302, 12 Sup. Ct. 922, 36 L. ed. 713.

\* \* \*

The name "Victor" was adopted to denote the heater manufactured in accordance with the specifications of the patent. We pass the question of farming out trade-marks on competitive

articles as inapposite. The word "Victor" stands as the identifying and generic name of the patented article. \* \* \* As Folger had the right to license Adam to use the thing, he had the right, as a part of the same transaction, to license him to use the name of the thing. The very fact that it would be a fraud upon the public to allow one to hold a monopoly of the name of a thing after his monopoly of the thing itself had expired. (*Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. ed. 118. And, see further, *Holzapfel's Compositions Co. v. Rahtjen's American Composition Co.*, 183 U. S. 1, 22 Sup. Ct. 6, 46 L. ed. 49; *Centaur Co. v. Heinsfurter*, 28 C. C. A. 581, 84 Fed. 955; *Gally v. Manufacturing Co.* (C. C.) 30 Fed. 118; *Stimpson Computing Scale Co. v. W. F. Stimpson Co.*, 44 C. C. A. 241, 104 Fed. 893) emphasizes the conclusion that it would be a fraud upon the public, during the life of the patent, to permit a stranger to palm off a spurious for the patented article by means of the identifying and generic name of the latter.

We do not regard a bill multifarious which seeks to enjoin an unauthorized person from using a patented article, and also from using the generic name of that article. *Animarium Co. v. Neiman* (C. C.) 98 Fed. 14; *Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co.* (C. C.) 60 Fed. 622; *Weir v. Gas Co.* (C. C.) 91 Fed. 940; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (C. C.) 94 Fed. 651; *Harper v. Holman* (C. C.) 84 Fed. 222; *U. S. v. Amercian Bell Tel. Co.*, 128 U. S. 315, 9 Sup. Ct. 90, 32 L. ed. 450; *Oliver v. Piatt*, 3 How. 333, 11 L. ed. 622.

**874. NATIONAL NEWSBOARD CO. v. ELKHART EGG CASE CO.**, 123 Fed. 431, 59 C. C. A. 471.

The whole testimony impresses us with the belief that the introduction of the soda ash was intended, not to bring about a product essentially different from the patented product, but to interpose a process so colorably different that it might be used as a shelter against the charge of infringement; and in this respect we are constrained to look upon the defense of infringement differently from the view taken by the circuit court.

**875. COMPTOGRAPH CO. v. MECHANICAL ACCOUNTANT CO.**, 145 Fed. 331, 76 C. C. A. 205.

If the infringing device performs the same function as the patented device, it is immaterial that it also performs some other function. It is still none the less an equivalent of the patented device, and an appropriation of the patented invention.



876. COLUMBIA WIRE CO. v. KOKOMO STEEL, ETC., CO., 143 Fed. 116, 74 C. C. A. 310.

All the elements of the patent combination are employed with substantial identity in their use, and departure appears from the letter of the claims only, in the arrangement of these elements, without substantial difference in the principle of operation. The policy and rules of the patent law require that the patentee be protected against such evasions of the wording of a claim in form or nonessential details, when the substance of the invention is thus used and is unmistakably shown in the specification and claims.

877. BRAMMER v. SCHROEDER, 106 Fed. 918, 46 C. C. A. 41.

If, however, one invents and secures a patent for a new combination of old mechanical elements which first performs a useful function, he is protected against all machines and combinations which perform the same function by equivalent mechanical devices to the same extent and in the same way as one who invents and patents a machine or composition of matter of like primary character.

878. AMERICAN SULPHITE PULP CO. v. DE GRASSE PAPER CO., 157 Fed. 660, 87 C. C. A. 260.

The defendant certainly has the patented lining; what else it has is not important. Of course, the addition of the inner brick wall does not avoid infringement.

879. WESTERN TEL. MFG. CO. v. AMERICAN ELEC. TEL. CO., 131 Fed. 75, 65 C. C. A. 313.

If appellees are using Fisk's invention as it is defined in the patent, it is immaterial how much of the prior art they also employ.

880. DEVLIN v. PAYNTER, 64 Fed. 398, 12 C. C. A. 188.

The appellants have transposed the position of the soft-metal face. Do they escape infringement by the transposition of parts? We think not. \* \* \* The appellants, therefore, have appropriated the gist of the invention. The changes found in their device do not at all affect either the principle of operation or the result.

881. UNION WATER-METER CO. v. DESPER, 101 U. S. 332, 25 L. ed. 1024.

It is a well known doctrine of patent law, that the claim of a combination is not infringed if any of the material parts of the

combination are omitted. It is equally well known that if any one of the parts is only formally omitted, and is supplied by a mechanical equivalent, performing the same office and producing the same result, the patent is infringed.

882. YALE LOCK MFG. CO. v. SARGENT, 117 U. S. 373, 29 L. ed. 950, 6 Sup. Ct. 931.

The defendant does not use the same combination, and employs no device as an equivalent and substitute for the omitted element. It is not, therefore, liable as an infringer.

883. RUMFORD CHEMICAL WORKS v. HYGIENIC CHEMICAL CO., 159 Fed. 436, 86 C. C. A. 416.

It is, therefore, the use of such powder which constitutes infringement and when a manufacturer of acid phosphates sells a manufacturer of baking powder a barrel of granular acid phosphate the presumption is not unfair that he expects it to be used for baking powder.

884. GRISWOLD v. HARKER, 62 Fed. 389, 10 C. C. A. 435.

Actions often speak louder, and frequently more truthfully, than words. It is not impossible that the reason why the appellees are not using the old devices they plead is that the improvements described in this patent have made them useless and unmerchantable. If this is not so, they can abandon the improvements of Selden and Griswold, and go back to the devices they plead.

885. CROWN CORK, ETC., CO. v. ALUMINUM STOPPER CO., 108 Fed. 845, 48 C. C. A. 72.

The court will look through the disguises, however ingenious, to see whether the inventive idea of the original patentee has been appropriated, and whether the defendant's device contains the material features of the patent in suit, and will declare infringement even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement.

886. LOURIE IMPLEMENT CO. v. LENHART, 130 Fed. 122, 64 C. C. A. 456.

One may not escape infringement by adding to or subtracting from a patented device, by changing its form, or by making it more or less efficient, while he retains its principle and mode of operation, and attains its result by the use of the same or of equivalent mechanical means.

887. MITCHELL v. EWART MFG. CO., 81 Fed. 390, 26 C. C. A. 443.

While the appellant has avoided a mere servile copy of form, he has appropriated the substance of the Dodge invention. That in doing so he has rendered inoperative the function on one groove will not suffice to relieve him from the charge of infringement.

888. PENFIELD v. CHAMBERS BROS. CO., 92 Fed. 630, 34 C. C. A. 579.

An infringer can not evade liability for his infringement by deliberately diminishing its utility without changing materially its form, its chief function, or its manner of operation.

889. KING AX CO. v. HUBBARD, 97 Fed. 795, 38 C. C. A. 423.

This is an instance, not infrequent in patent litigation, where the infringer has sought to evade the claims of a patent, the substance of which he is appropriating, by deliberately impairing the function of one element, without destroying the substantial identity of structure, operation and result.

890. NATHAN v. HOWARD, 143 Fed. 889, 75 C. C. A. 97.

A segment has been omitted. That which remains performs the function of the complete ring, perhaps not so well as if the ring had been completed. \* \* \* But the impairment of the function of this hollow ring by omitting a short segment will not escape infringement.

891. DOWAGIAC MFG. CO. v. SUPERIOR DRILL CO., 115 Fed. 886, 53 C. C. A. 36.

The Packham invention is not obscured by the change, which does not affect its distinguishing feature or the leading purpose thereof—that of keeping the furrow clear—though it modifies to some extent the manner of effecting the distribution of the seed in the furrow.

892. VULCAN IRON WORKS v. SMITH, 62 Fed. 444, 10 C. C. A. 493.

The Koefod device goes further than to make merely formal changes in the complainants' patent. Its deviations therefrom do not consist in the mere transposition of parts, \* \* \* but it introduces such change in the construction of parts as to avoid the elements of the complainant's invention, limited, as we have found the same to be by the pre-existing devices. \* \* \* These differences, slight as they may be, are, in our judgment, as great as the changes which the complainant made in adopting the former devices, and are sufficient to relieve the defendant of the charge of infringement.

893. WAGNER TYPEWRITER CO. v. WYCKOFF, 151 Fed. 585, 81 C. C. A. 129.

A licensee under the first patent who uses the mechanism therein described, can not be held an infringer under the second patent. In order to hold him it is necessary to show that he uses the devices of the first patent plus the improvements of the second patent; not any and all improvements calculated to produce similar results, but the precise improvement described and claimed.

894. INDIANA MFG. CO. v. CASE THRESHING MACH. CO., 154 Fed. 365, 83 C. C. A. 343.

What is sought is an injunction against appellee's unlawful invasion of appellant's lawful patent monopoly. If appellee had not invaded, or if the monopoly is unlawful, appellant fails. If appellant had chosen to accept appellee's repudiation of the license, a bill to exclude appellee utterly from the domain of the patents would have lain. By declining to recognize the fact or the right of repudiation, appellant did not estop itself from asking to exclude appellee from that part of the domain which had not been granted, namely, the control of prices and methods. Stripped of all averments in relation to appellant's business built up on licenses, the bill states a good cause of action for infringement of the patents. These averments, as appellant rightly claims, show an aggravation of the injury resulting from the infringement, and constitute, therefore, an additional appeal for injunctive relief. That the bill properly invokes the aid of a court of equity we have no doubt.

895. RUPP, ETC., CO. v. ELLIOTT, 131 Fed. 730, 65 C. C. A. 544.

That the complainants were entirely within the boundary of their patent rights in permitting the use of their invention only in connection with wire sold by themselves is not an open question in this court.

896. STANDARD COMPUTING SCALE CO. v. COMPUTING SCALE CO., 126 Fed. 639, 61 C. C. A. 541.

Of course, if it made or sold scales having peculiar provision for the intended incorporation therein of a valid patented device of the appellee, it would be liable as a contributory, if the expected incorporation should thereafter be made by another. But if it makes and sells scales having simply adaptations for a proper adjustment, such as was known in the art, it would not be liable if another person should of his own volition put into the scales a form of adjustment patented by the appellee.

897. RED JACKET MFG. CO. v. DAVIS, 82 Fed. 432, 27 C. C. A. 204.

They make and sell pumps in all essential respects like that of the patent. They do not, indeed, make the lower cylinder, but they manufacture pumps to be used in tubular wells, the tube and valve placed therein supplying the lower cylinder and valve of the patent. Their pumps are inoperative and useless unless so constructed. The case presented is therefore one of contributory infringement.

898. LOEW FILTER CO. v. GERMAN-AMERICAN FILTER CO., 107 Fed. 949, 47 C. C. A. 94.

It would seem clear enough that the judge who granted this injunction made no mistake in holding that the making and selling these filters, adapted to and intended, as they were, for no other use than filtering beer or similar fluids, should be held as contributing to such use by brewers, and as standing on the same liability as the parties actually using them.

899. CANDA v. MICHIGAN MALLEABLE IRON CO., 124 Fed. 486, 61 C. C. A. 194.

If the defendant constructed and sold an essential part of the infringing structure for the purpose of enabling another person to infringe the patent by adding something else to make the entire infringing article, it made itself a contributory to, and liable for, the infringement. And we have no doubt that this was the fact. The casings without bottoms which the defendant made and sold were good for nothing else. Their form and characteristics plainly indicated their purpose. The case is not like one where the thing made is also adapted to use in other ways. It would be wholly inadmissible to shut out the manufacture or sale of things adapted to a proper and lawful use. That would interfere with the rights and privileges of the public. But it has been held that, even in that case if it were proven that the thing, although adapted to other uses, was nevertheless intended by the seller to go into, and contribute to, the infringement by another, the furnisher could not escape the consequences of the infringement.

900. JOHNSON v. FOOS MFG. CO., 141 Fed. 73, 72 C. C. A. 105.

They have infringed the process of Johnson because they supplied the apparatus adapted to employ Johnson's process with intent that the plant should be or would be operated as that put in for the Tennessee Fiber Company. It was therefore guilty of contributing to the infringement.

\* \* \*

The arrangement of the different parts was therefore of the essence of the invention, and the Foos Company had a legal right to continue to make and sell attrition mills and other parts of the mechanism which were old, provided only that they did so with no purpose to contribute to the plans of one intending an infringement by combining the parts.

901. *BULLOCK, ETC., MFG. CO. v. WESTINGHOUSE, ETC., MFG. CO.*, 129 Fed. 105, 63 C. C. A. 607.

The intent and purpose that the element made and sold shall be used in a way that shall infringe the combination in which it is an element constitutes the necessary concert of action between him who furnished the single part and he who actually does the injury by the assembling and using of all the parts in such a way as to be an infringement. This principle runs through all the cases upon contributory infringement.

902. *NATIONAL CASH REGISTER CO. v. GROBET*, 153 Fed. 905, 82 C. C. A. 651.

But the purchaser of the No. 78 machine acquired no right to infringe the patentee's right to manufacture said combination known as No. 79. When these defendants, therefore, supplied said attachment and added it to said No. 78 machine, and therefore converted it into a No. 79 machine by uniting to it the patented attachment which made up the complete combination of No. 79, they infringed said right of manufacture of the patented combination, with which complainant had not parted by the same of a No. 78 machine.

The well-settled rule is that the purchaser of a patented article from the patentee acquires the absolute right to the unrestricted use of said article; that by the sale it passes beyond the limit of the monopoly. But it would be perversion of this rule to say that such a purchaser may use a portion of said article for the purpose of enabling the owner of a machine sold by the patentee, without said portion, to construct a patented combination which he is not licensed to manufacture or use.

903. *UNITED STATES v. BURNS*, 79 U. S. 246, 20 L. ed. 388.

If an officer in the military service, not especially employed to make experiments with a view to suggest improvements, devises a new and valuable improvement in arms, tents, or any other kind of war material, he is entitled to the benefit of it and to letters-patent for the improvement from the United States equally with any other citizen not engaged in such service; and the government can not, after the patent is issued, make use of

the improvement any more than a private individual, without license of the inventor or making compensation to him.

**904. DASHIELL v. GROSVENOR, 66 Fed. 334, 13 C. C. A. 593.**

The United States may appropriate and use the invention of an individual for its necessary uses, the fifth amendment to the constitution requiring only that due compensation shall be made. But this provision does not prescribe that the usual method of condemnation of property is essential. (Chief of Ordnance used a patent breech-loading mechanism without asking or obtaining license, proceeded to use it without license or right.) It does not appear, and it was not the fact that this was the only mechanism available.

**905. DICKERSON v. MATHESON, 57 Fed. 524, 6 C. C. A. 466.**

A purchaser in a foreign country of an article patented in that country and also in the United States, from the owner of each patent, or from a licensee under each patent, who purchases without any restrictions upon the extent of his use or power of sale, acquires an unrestricted ownership in the article, and can use or sell it in this country. \* \* \*

A purchaser in a foreign country of an article patented in that country and also in the United States, from a licensee under the foreign patent only, does not give the purchaser a right to import the article into, and to sell it in, the United States, without the license or consent of the owner of the United States patent.

**906. DICKERSON v. TINLING, 84 Fed. 192, 28 C. C. A. 139.**

The right to sell the patented article in the United States is not governed by the laws of Germany or of England, but by the laws of this nation; and under those laws and the patent before us. Bayer & Co. has the "exclusive right to make, use and vend" phenacetine in the United States. Thus, in *Boesch v. Graff*, 133 U. S. 697, a case in which the defendant had purchased in Germany, from one Hecht, who had the legal right to sell them there, certain burners, which had been patented in both Germany and the United States, Chief Justice Fuller said:

"The right which Hecht had to make and sell the burners in Germany was allowed him under the laws of that country, and purchasers from him could not be thereby authorized to sell the articles in the United States, in defiance of the rights of the patentees under a United States patent."

907. *BULLOCK, ETC., MFG. CO. v. WESTINGHOUSE, ETC., MFG. CO.*,  
129 Fed. 105, 63 C. C. A. 607.

While it is true that the monopoly of the plaintiff's patents did not extend beyond the limits of the United States, yet it would be no defense to say that the patented article had been made in the United States only for the purpose of being sold and used in a country to which the protection of the laws of the United States did not extend. The patentee is entitled to monopolize the making of his device in the United States as well as a monopoly of there selling or using it.

908. *ADRIANCE, ETC., CO. v. NATIONAL HARROW CO.*, 121 Fed. 827,  
58 C. C. A. 163.

It is impossible to read the communications warning the complainant's customers against selling its harrows, with which the defendant seems to have flooded the country, without being led to believe that they were inspired by a purpose to intimidate the complainant's customers, and coerce the complainant, by injuring its business, into becoming a licensee of the defendant. In view of its failure to bring an infringement action, under circumstances which made an action practically compulsory, the defendant can not shelter itself behind the theory that its circulars and letters were merely legitimate notices of its rights. We are satisfied that they were sent, not for the purpose of self-protection, but in execution of the defendant's threat to stop the complainant from building harrows by other means than legal remedies.

\* \* \*

Undoubtedly the owner of a patent is acting within his rights in notifying infringers of his claims, and threatening them with litigation if they continue to disregard them; nor does he transcend his rights when, the infringer being a manufacturer, he sends such notices to the manufacturer's customers, if he does so in good faith, believing his claims to be valid, and in an honest effort to protect them from invasion.



## PART XV.

### COURTS—PARTIES—CAUSES — JURISDICTION—ADJUDICATIONS—COMITY—PRACTICE—EVIDENCE—ETC.

#### STATUTES.

##### 909. COPIES OF RECORDS, ETC., OF PATENT OFFICE.

§ 892. Written or printed copies of any records, books, papers, or drawings belonging to the patent office, and of letters-patent authenticated by the seal and certified by the commissioner or acting commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof.

##### 910. COPIES OF FOREIGN LETTERS PATENT.

§ 893. Copies of the specifications and drawings of foreign letters-patent certified as provided in the preceding section, shall be prima facie evidence of the fact of the granting of such letters patent, and of the date and contents thereof.

##### 911. PRINTED COPIES OF SPECIFICATIONS AND DRAWINGS OF PATENTS.

§ 894. The printed copies of specifications and drawings of patents, which the commissioner of patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. (See § 490.)

##### 912. SUBPOENA TO WITNESSES.

§ 4906. The clerk of any court of the United States for any district or Territory wherein testimony is to be taken for use in any contested case pending in the patent office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or territory, commanding him to appear and testify before any officer in such district or territory authorized to take

depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him.

#### 913. WITNESS FEES.

§ 4907. Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

#### 914. PENALTY FOR FAILING TO ATTEND OR REFUSING TO TESTIFY.

§ 4908. Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

[For provisions relating to the Court of Appeals of the District of Columbia, see Parts V and VI.]

### JUDICIAL CODE.

§ 24. The district courts shall have original jurisdiction as follows:

\* \* \*

Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws.

§ 48. In suits brought for the infringement of letters-patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon the defendant may be made by service upon the agent or agents, engaged in conducting such business in the district in which suit is brought.

§ 50. When there are several defendants in any suit at law or in equity, and one or more of them are neither inhabitants of nor found within the district in which the suit is brought, and do not voluntarily appear, the court may entertain jurisdiction, and proceed to the trial and adjudication of the suit between the parties who are properly before it; but the judgment or decree rendered therein shall not conclude or prejudice other parties not regularly served with process nor voluntarily appearing to answer; and non-joinder of parties who are not inhabitants of nor found within the district, as aforesaid, shall not constitute matter of abatement or objection to the suit.

§ 51. Except as provided in the five succeeding sections, no person shall be arrested in one district for trial in another, in any civil action before a district court; and, except as provided in the six succeeding sections, no civil suit shall be brought in any district court against any person by any original process or proceeding in any other district than that whereof he is an inhabitant; but where the jurisdiction is founded only on the fact that the action is between citizens of different States, suit shall be brought only in the district of the residence of either the plaintiff or the defendant.

§ 52. When a State contains more than one district, every suit not of a local nature, in the district court thereof, against a single defendant, inhabitant of such State, must be brought in the district where he resides; but if there are two or more defendants, residing in different districts of the State, it may be brought in either district, and a duplicate writ may be issued against the defendants, directed to the marshal of any other district in which any defendant resides. The clerk issuing the duplicate writ shall indorse thereon that it is a true copy of a writ sued out of the court of the proper district; and such original and duplicate writs, when executed and returned into the office from which they issue, shall constitute and be proceeded on as one suit; and upon any judgment or decree rendered therein, execution may be issued, directed to the marshal of any district in the same State.

§ 53. When a district contains more than one division, every suit not of a local nature against a single defendant must be brought in the division where he resides; but if there are two or more defendants residing in different divisions of the district it may be brought in either division. All mesne and final process subject to the provisions of this section may be served and executed in any or all of the divisions of the district, or if the State contains more than one district, then in any of such districts, as provided in the preceding section. All prosecutions for crimes or offenses shall be had within the division of such districts

where the same were committed, unless the court, or the judge thereof, upon the application of the defendant, shall order the cause to be transferred for prosecution to another division of the district. When a transfer is ordered by the court or judge, all the papers in the case, or certified copies thereof, shall be transmitted by the clerk, under the seal of the court, to the division to which the cause is so ordered transferred; and thereupon the cause shall be proceeded within said division in the same manner as if the offense had been committed therein. In all cases of the removal of suits from the courts of a State to the district court of the United States such removal shall be to the United States district court in the division in which the county is situated from which the removal is made; and the time within which the removal shall be perfected, in so far as it refers to or is regulated by the terms of the United States courts, shall be deemed to refer to the terms of the United States district court in such division.

§ 58. Any civil cause, at law or in equity, may, on written stipulation of the parties or of their attorneys of record signed and filed with the papers in the case, in vacation or in term, and on the written order of the judge signed and filed in the case in vacation or on the order of the court duly entered of record in term, be transferred to the court of any other division of the same district, without regard to the residence of the defendants, for trial. When a cause shall be ordered to be transferred to a court in any other division, it shall be the duty of the clerk of the court from which the transfer is made to carefully transmit to the clerk of the court to which the transfer is made the entire file of papers in the cause and all documents and deposits in his court pertaining thereto, together with a certified transcript of the records of all orders, interlocutory decrees, or other entries in the cause; and he shall certify, under the seal of the court, that the papers sent are all which are on file in said court belonging to the cause; for the performance of which duties said clerk so transmitting and certifying shall receive the same fees as are now allowed by law for similar services, to be taxed in the bill of costs, and regularly collected with the other costs in the cause; and such transcript, when so certified and received, shall henceforth constitute a part of the record of the cause in the court to which the transfer shall be made. The clerk receiving such transcript and original papers shall file the same and the case shall then proceed to final disposition as other cases of a like nature.

§ 117. There shall be in each circuit a circuit court of appeals, which shall consist of three judges, of whom two shall

constitute a quorum, and which shall be a court of record, with appellate jurisdiction, as hereinafter limited and established.

§ 118. There shall be in the second, seventh, and eighth circuits, respectively, four circuit judges, in the fourth circuit, two circuit judges, and in each of the other circuits, three circuit judges, to be appointed by the president, by and with the advice and consent of the Senate. They shall be entitled to receive a salary at the rate of seven thousand dollars a year, each, payable monthly. Each circuit judge shall reside within his circuit.

§ 120. The Chief Justice and the associate justices of the Supreme Court assigned to each circuit, and the several district judges within each circuit, shall be competent to sit as judges of the circuit court of appeals within their respective circuits. In case the Chief Justice or an associate justice of the Supreme Court shall attend at any session of the circuit court of appeals, he shall preside. In the absence of such Chief Justice, or associate justice, the circuit judges in attendance upon the court shall preside in the order of the seniority of their respective commissions. In case the full court at any time shall not be made up by the attendance of the Chief Justice or the associate justice, and the circuit judges, one or more district judges within the circuit shall sit in the court according to such order or provision among the district judges as either by general or particular assignment shall be designated by the court: Provided, That no judge before whom a cause or question may have been tried or heard in a district court, or existing circuit court, shall sit on the trial or hearing of such cause or question in the circuit court of appeals.

§ 126. A term shall be held annually by the circuit courts of appeals in the several judicial circuits at the following places, and at such times as may be fixed by said courts, respectively; In the first circuit, in Boston; in the second circuit, in New York; in the third circuit, in Philadelphia; in the fourth circuit, in Richmond; in the fifth circuit, in New Orleans, Atlanta, Fort Worth, and Montgomery; in the sixth circuit, in Cincinnati; in the seventh circuit, in Chicago; in the eighth circuit, in Saint Louis, Denver or Cheyenne, and Saint Paul; in the ninth circuit, in San Francisco, and each year in two other places in said circuit to be designated by the judges of said court: and in each of the above circuits, terms may be held at such other times and in such other places as said courts, respectively, may from time to time designate: Provided, That terms shall be held in Atlanta on the first Monday in October, in Fort Worth on the first Monday in November, in Montgomery on the third Monday in October, in Denver or in Cheyenne on the first Monday in September, and in Saint Paul on the first Monday in May. All appeals,

writs of error, and other appellate proceedings which may be taken or prosecuted from the district courts of the United States in the State of Georgia, in the State of Texas, and in the State of Alabama, to the circuit court of appeals for the fifth judicial circuit shall be heard and disposed of, respectively, by said court at the terms held in Atlanta, in Fort Worth, and in Montgomery, except that appeals or writs of error in cases of injunctions and in all other cases which, under the statutes and rules, or in the opinion of the court, are entitled to be brought to a speedy hearing may be heard and disposed of wherever said court may be sitting. All appeals, writs of errors, and other appellate proceedings which may hereafter be taken or prosecuted from the district court of the United States at Beaumont, Texas, to the circuit court of appeals for the fifth circuit, shall be heard and disposed of by the said circuit court of appeals at the terms of court held at New Orleans: Provided, That nothing herein shall prevent the court from hearing appeals or writs of error wherever the said courts shall sit, in cases of injunctions and in all other cases which, under the statutes and the rules, or in the opinion of the court, are entitled to be brought to a speedy hearing. All appeals, writs of error, and other appellate proceedings which may be taken or prosecuted from the district courts of the United States in the States of Colorado, Utah, and Wyoming, and the supreme court of the Territory of New Mexico to the circuit court of appeals for the eighth judicial circuit, shall be heard and disposed of by said court at the terms held either in Denver or in Cheyenne, except that any case arising in any of said States or Territory may, by consent of all the parties, be heard and disposed of at a term of said court other than the one held in Denver or Cheyenne.

§ 129. Where upon a hearing in equity in a district court, or by a judge thereof in vacation, an injunction shall be granted, continued, refused, or dissolved, by an interlocutory order or decree, or an application to dissolve an injunction shall be refused, or an interlocutory order or decree shall be made appointing a receiver, an appeal may be taken from such interlocutory order or decree granting, continuing, refusing, dissolving, or refusing to dissolve, an injunction, or appointing a receiver, to the circuit court of appeals, notwithstanding an appeal in such case might, upon final decree under the statutes regulating the same, be taken directly to the Supreme Court: Provided, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court, or the appellate court, or a judge thereof, during the pendency of

such appeal: Provided, however, That the court below may, in its discretion, require as a condition of the appeal an additional bond.

§ 145. The Court of Claims shall have jurisdiction to hear and determine the following matters:

First. All claims (except for pensions) founded upon the Constitution of the United States or any law of Congress, upon any regulation of an Executive Department, upon any contract, express or implied, with the government of the United States, or for damages, liquidated or unliquidated, in cases not sounding in tort, in respect of which claims the party would be entitled to redress against the United States, either in a court of law, equity, or admiralty, if the United States were suable.

§ 239. In any case within its appellate jurisdiction, as defined in section one hundred and twenty-eight, the circuit court of appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision; and thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the circuit court of appeals in such case, or it may require that the whole record and cause be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

§ 240. In any case, civil, or criminal, in which the judgment or decree of the circuit court of appeals is made final by the provisions of this title, it shall be competent for the Supreme Court to require, by certiorari or otherwise, upon the petition of any party thereto, any such case to be certified to the Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.

§ 250. Any final judgment or decree of the court of appeals of the District of Columbia may be re-examined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:

First. In cases in which the jurisdiction of the trial court is in issue; but when any such case is not otherwise reviewable in said Supreme Court, then the question of jurisdiction alone shall be certified to said Supreme Court for decision.

Second. In prize cases.

Third. In cases involving the construction or application of the Constitution of the United States, or the constitutionality of any law of the United States, or the validity or construction of any treaty made under its authority.

Fourth. In cases in which the constitution, or any law of a State, is claimed to be in contravention of the Constitution of the United States.

Fifth. In cases in which the validity of any authority exercised under the United States, or the existence or scope of any power or duty of an officer of the United States is drawn in question.

Sixth. In cases in which the construction of any law of the United States is drawn in question by the defendant.

Except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases arising under the patent laws, the copyright laws, the revenue laws, the criminal laws, and in admiralty cases; and except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases not reviewable as hereinbefore provided.

Writs of error and appeals shall be taken within the same time, in the same manner, and under the same regulations as writs of error and appeals are taken from the circuit courts of appeals to the Supreme Court of the United States.

§ 251. In any case in which the judgment or decree of said court of appeals is made final by the section last preceding, it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to it for its review and determination, with the same power and authority in the case as if it had been carried by writ of error or appeal to said Supreme Court. It shall also be competent for said court of appeals, in any case in which its judgment or decree is made final under the section last preceding, at any time to certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for their proper decision; and thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon said court of appeals in such case, or it may require that the whole record and cause be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

§ 256. The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States:

\* \* \*

Fifth. Of all cases arising under the patent-right, or copyright laws of the United States.



§ 262. The Supreme Court and the district courts shall have power to issue writs of scire facias. The Supreme Court, the circuit courts of appeals, and the district courts shall have power to issue all writs not specifically provided for by statute, which may be necessary for the exercise of their respective jurisdictions, and agreeable to the usages and principles of law.

§ 263. Whenever notice is given of a motion for an injunction out of a district court, the court or judge thereof may, if there appears to be danger of irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge.

[See also act of February 13, 1911, An act to diminish the expense of proceedings on appeal and writ of error or of certiorari.]

[For §§ 721 and 914, Rev. Stat. U. S., relating to actions at law see Part XVI.]

### EQUITY RULES.

[On November 12, 1912, the Supreme Court of the United States promulgated an entire new set of rules of practice for the courts of equity of the United States to take effect February 1, 1913.

These rules render many of the previous decisions of the courts inapplicable, though they are still important as presenting the history of procedure.

They approximate the procedure in an action at law, especially in patent causes.

Rule 1 provides that a district court shall be always open for certain purposes, and for Orders at Chambers.

Rule 2, that the Clerk's office shall always be open except on Sundays and legal holidays, etc.

Rule 3, that books shall be kept by the Clerk, especially an Equity Docket, Order Book and Equity Journal.

Rule 4, that the noting of an order in the Equity Docket nor its entry in the Order Book shall not be deemed sufficient notice. It provides also that the clerk may give notice by mailing copy.

Rule 5 provides for certain motions being grantable of course, by the clerk.

Rule 6 provides a motion day for each district court, not less than once each month.

Rule 7, for process, mesne and final, by means of the usual process of subpoena, writ of attachment, and if necessary, writ of sequestration, or writ of assistance.

Rule 8 provides for the enforcement of final decrees by writ of execution, writ of attachment, writ of sequestration, etc., in accordance with the circumstances.

Rule 9 provides for writ of assistance.

Rule 10 for a decree for deficiency in foreclosures, etc.

Rule 11, for process in behalf of and against persons not parties.

Rule 12 provides for the issue of subpoena upon the filing of a bill, returnable twenty days from the issuing thereof, at which time answer shall be made.

Rule 13 provides for the manner of serving subpoena and Rule 14 for alias subpoena.

Rule 15 states by whom the process shall be served.

Rule 16 provides that if defendants do not answer within the time named in the subpoena as required by Rule 12, the plaintiff may take an order that the bill be taken pro confesso, and thereupon the cause shall be proceeded in ex parte.

Rule 17 provides that the decree pro confesso shall be followed by a final decree and provides also for setting aside the default.

Rule 18 is,—

“Unless otherwise prescribed by statute or these rules the technical forms of pleadings in equity are abolished.”

Rule 19 provides for amendments generally but provides also that “The court at every stage of the proceeding, must disregard any error or defect in the proceedings which does not affect the substantial rights of the parties.”

Rule 20 provides for the requirement of a further and particular statement in pleading, upon order of the court.

Rule 21 abolishes exceptions for scandal or impertinence, “but the court may, upon motion or its own initiative, order any redundant, impertinent or scandalous matter stricken out, upon such terms as the court shall think fit.”

Rule 22 provides that an action at law erroneously begun as a suit in equity shall be forthwith transferred to the law side “and be there proceeded with with only such alteration in the pleadings as shall be essential.”

Rule 23 provides that matters ordinarily determinable at law, when arising in a suit in equity, shall be disposed of therein.

Rule 24 provides that the signature of counsel shall be sufficient to cover what has been hitherto covered by the averment of counsel.

Rule 25, with reference to the bill of complaint, reads as follows:

“Hereafter it shall be sufficient that a bill in equity shall contain, in addition to the usual caption:

“First, the full name, when known, of each plaintiff and defendant and the citizenship and residence of each party. If any party be under any disability that fact shall be stated.

“Second, a short and plain statement of the grounds upon which the court’s jurisdiction depends.

Third, a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence.

“Fourth, if there are persons other than those named as defendants who appear to be proper parties, the bill should state why they are not made parties—as that they are not within the jurisdiction of the court, or cannot be made parties without ousting the jurisdiction.

“Fifth, a statement of and prayer for any special relief pending the suit or on final hearing, which may be stated and sought in alternative forms. If special relief pending the suit be desired the bill should be verified by the oath of the plaintiff, or someone having knowledge of the facts upon which such relief is asked.”

Rule 26 provides for the joinder of as many causes of action, cognizable in equity, as the plaintiff may have against the defendant, but upon occasion provides for the separation of causes.

Rule 27 provides for a stockholder’s bill.

Rule 28, for amendment of a bill, as of course.

Rule 29, with reference to defenses, reads as follows:

“Demurrers and pleas are abolished. Every defense in point of law arising upon the face of the bill, whether for misjoinder, nonjoinder, or insufficiency of fact to constitute a valid cause of action in equity, which might heretofore have been made by demurrer or plea, shall be made by motion to dismiss or in the answer; and every such point of law going to the whole or a material part of the cause or causes of action stated in the bill may be called up and disposed of before final hearing at the discretion of the court. Every defense heretofore presentable by plea in bar or abatement shall be made in the answer and may be separately heard and disposed of before the trial of the principal case in the discretion of the court. If the defendant move to dismiss the bill or any part thereof, the motion may be set down for hearing by either party upon five days’ notice, and, if it be denied, answer shall be filed within five days thereafter or a decree pro confesso entered.”

Rule 30, with reference to answer, contents, counterclaim, reads as follows:

“The defendant in his answer shall in short and simple terms, set out his defense to each claim asserted by the bill, omitting any mere statement of evidence and avoiding any general denial

of the averments of the bill, but specifically admitting or denying or explaining the facts upon which the plaintiff relies, unless the defendant is without knowledge, in which case he shall so state, such statement operating as a denial. Averments other than of value or amount of damage, if not denied, shall be deemed confessed, except as against an infant, lunatic or other person non compos and not under guardianship, but the answer may be amended, by leave of the court or judge, upon reasonable notice, so as to put any averment in issue, when justice requires it. The answer may state as many defenses, in the alternative, regardless of consistency, as the defendant deems essential to his defense.

“The answer must state in short and simple form any counter-claim arising out of the transaction which is the subject-matter of the suit, and may, without cross-bill, set out any set-off or counter-claim against the plaintiff which might be the subject of an independent suit in equity against him, and such set-off or counter-claim, so set up, shall have the same effect as a cross-suit, so as to enable the court to pronounce a final judgment in the same suit both on the original and cross-claims.”

Rule 31, with reference to reply and cause at issue, reads as follows:

“Unless the answer asserts a set-off or counter-claim, no reply shall be required without special order of the court or judge, but the cause shall be deemed at issue upon the filing of the answer, and any new or affirmative matter therein shall be deemed to be denied by the plaintiff. If the answer include a set-off or counter-claim, the party against whom it is asserted shall reply within ten days after the filing of the answer, unless a longer time be allowed by the court or judge. If the counter-claim is one which affects the rights of other defendants they or their solicitors shall be served with a copy of the same within ten days from the filing thereof, and ten days shall be accorded to such defendants for filing a reply. In default of a reply, a decree pro confesso on the counter-claim may be entered as in default of an answer to the bill.”

Rule 32 provides for an answer to an amended bill within ten days.

Rule 33, with reference to testing sufficiency of defense, reads as follows:

“Exceptions for insufficiency of an answer are abolished. But if an answer set up an affirmative defense, set-off or counter-claim, the plaintiff may, upon five days' notice, or such further time as the court may allow, test the sufficiency of the same by motion to strike out. If found insufficient but amendable the

court may allow an amendment upon terms, or strike out the matter."

Rule 34 provides for supplemental pleading during the progress of the cause upon reasonable notice and just terms.

Rule 35 provides that ordinarily the statements of the original suit need not be set forth in bill of revivor or supplemental bill.

Rule 36 provides for verifying pleadings before practically any officer empowered to administer an oath.

Rule 37 provides for joining parties interested and for intervention.

Rule 38 provides for suits by representatives of a class.

Rule 39 provides for proceeding with a cause in the absence of persons who would be proper parties but who can not be made parties because of some obstacle.

Rule 40 provides for proceedings in case of nominal parties.

Rule 41 refers to suit to execute trust of will and where the heir is a party.

Rule 42 provides for either joint or several demands.

Rule 43 provides for suggestion by the defendant of defective parties and for treatment of the cause, where the plaintiff resists the objection, in accordance with the discretion of the court.

Rule 44 provides for tardy objection for defective parties.

Rule 45 for revivor of a cause upon death of party.

Rule 46, with reference to testimony, reads as follows:

"In all trials in equity the testimony of witnesses shall be taken orally in open court, except as otherwise provided by statute or these rules. The court shall pass upon the admissibility of all evidence offered as in actions at law. When evidence is offered and excluded, and the party against whom the ruling is made excepts thereto at the time, the court shall take and report so much thereof, or make such a statement respecting it, as will clearly show the character of the evidence, the form in which it was offered, the objection made, the ruling, and the exception. If the appellate court shall be of opinion that the evidence should have been admitted, it shall not reverse the decree unless it be clearly of opinion that material prejudice will result from an affirmance, in which event it shall direct such further steps as justice may require."

Rule 47 with reference to depositions in exceptional cases, reads as follows:

"The court, upon application of either party, when allowed by statute, or for good and exceptional cause for departing from the general rule, to be shown by affidavit, may permit the deposition of named witnesses, to be used before the court or upon a reference to a master, to be taken before an examiner or other named officer, upon the notice and terms specified in the order. All depositions taken under a statute, or under any such order

of the court, shall be taken and filed as follows, unless otherwise ordered by the court or judge for good cause shown: Those of the plaintiff within sixty days from the time the cause is at issue; those of the defendant within thirty days from the expiration of the time for the filing of plaintiff's depositions; and rebutting depositions by either party within twenty days after the time for taking original depositions expires."

Rule 48, with reference to testimony of expert witnesses in patent and trade-mark cases, reads as follows:

"In a case involving the validity or scope of a patent or trade-mark, the district court may upon petition, order that the testimony in chief of expert witnesses, whose testimony is directed to matters of opinion, be set forth in affidavits and filed as follows: Those of the plaintiff within forty days after the cause is at issue; those of the defendant, within twenty days after plaintiff's time has expired; and rebutting affidavits within fifteen days after the expiration of the time for filing original affidavits. Should the opposite party desire the production of any affiant for cross-examination, the court or judge shall, on motion, direct that said cross-examination and any re-examination take place before the court upon the trial, and unless the affiant is produced and submits to cross-examination in compliance with such direction, his affidavit shall not be used as evidence in the cause."

Rule 49, with reference to evidence taken before examiners, reads as follows:

"All evidence offered before an examiner or like officer, together with any objections, shall be saved and returned into the court. Depositions, whether upon oral examination before an examiner or like officer or otherwise, shall be taken upon questions and answers reduced to writing, or in the form of narrative, and the witness shall be subject to cross and re-examination."

Rule 50 provides for the appointment of a stenographer when deemed necessary by the court, and the expense of taking the deposition and the cost of a transcript, shall be advanced by the party calling the witness or ordering the transcript.

Rule 51, with reference to evidence taken before examiners, reads as follows:

"Objections to the evidence, before an examiner or like officer, shall be in short form, stating the grounds of objection relied upon, but no transcript filed by such officer shall include argument or debate. The testimony of each witness, after being reduced to writing, shall be read over to or by him, and shall be signed by him in the presence of the officer, provided, that if the witness shall refuse to sign his deposition so taken, the officer shall sign the same, stating upon the record the reasons, if any, assigned by the witness for such refusal. Objection to any question or questions shall be noted by the officer upon the deposition,

but he shall not have power to decide on the competency or materiality or relevancy of the questions. The court shall have power, and it shall be its duty to deal with the costs of incompetent and immaterial or irrelevant depositions, or parts of them, as may be just."

Rule 52, with reference to attendance of witnesses before commissioner, master or examiner, reads as follows:

"Witnesses who live within the district, and whose testimony may be taken out of court by these rules, may be summoned to appear before a commissioner appointed to take testimony, or before a master or examiner appointed in any cause, by subpoena in the usual form, which may be issued by the clerk in blank and filled up by the party praying the same, or by the commissioner, master, or examiner, requiring the attendance of the witnesses at the time and place specified, who shall be allowed for attendance the same compensation as for attendance in court; and if any witness shall refuse to appear or give evidence it shall be deemed a contempt of the court, which being certified to the clerk's office by the commissioner, master, or examiner, an attachment may issue thereupon by order of the court or of any judge thereof, in the same manner as if the contempt were for not attending, or for refusing to give testimony in the court.

"In case of refusal of witnesses to attend or be sworn or to answer any question put by the commissioner, master or examiner or by counsel or solicitor, the same practice shall be adopted as is now practiced with respect to witnesses to be produced on examination before an examiner of said court on written interrogatories."

Rule 53 with reference to notice of taking testimony, reads as follows:

"Notice shall be given by the respective counsel or parties to the opposite counsel or parties of the time and place of examination before an examiner or like officer for such reasonable time as the court or officer may fix by order in each case."

Rule 54 with reference to depositions under the statutes, reads as follows:

"After a cause is at issue, depositions may be taken as provided by sections 863, 865, 866 and 867, Revised Statutes. But if in any case no notice has been given the opposite party of the time and place of taking the deposition, he shall, upon application and notice, be entitled to have the witness examined orally before the court, or to a cross-examination before an examiner or like officer, or a new deposition taken with notice, as the court or judge under all the circumstances shall order."

Rule 55 provides that a deposition shall be deemed published when filed.

Rule 56 provides that on the expiration of the time for taking the deposition the case shall go on the trial calendar.

Rule 57 provides for continuances and reads as follows:

“After a cause shall be placed on the trial calendar it may be passed over to another day of the same term, by consent of counsel or order of the court, but shall not be continued beyond the term save in exceptional cases by order of the court upon good cause shown by affidavit and upon such terms as the court shall in its discretion impose. Continuances beyond the term by consent of the parties shall be allowed on condition only that a stipulation be signed by counsel for all the parties and that all costs incurred theretofore be paid. Thereupon an order shall be entered dropping the case from the trial calendar, subject to reinstatement within one year from application to the court by either party, in which event it shall be heard at the earliest convenient day. If not so reinstated within the year, the suit shall be dismissed without prejudice to a new one.”

Rule 58 deals with discovery, interrogatories, inspection and production of documents, admission of execution or genuineness, all these matters being within the discretion of the court. The rule provides, however, that interrogatories shall be answered and the answers filed in the clerk's office within fifteen days after they have been served but that within ten days after the service of interrogatories objections may be presented to the court, the answers being then deferred. Also that by a demand served ten days before the trial, either party may call on the other to admit in writing the execution or genuineness of any document, letter or other writing, and if such admission be not made within five days after such service, the costs shall be upon the party refusing to do so unless it shall appear that the refusal was reasonable.

Rule 59 provides that the references to a master shall be exceptional and not usual excepting in matters of account, and that the reference shall be presented to the master for hearing within twenty days unless a longer time be specially granted by the court or judge.

Rule 60 provides for proceedings before the master.

Rule 61 for the master's report and that documents shall be identified but not set forth.

Rule 62 recites the powers of the master as follows:

“The master shall regulate all the proceedings in every hearing before him, upon every reference; and he shall have full authority to examine the parties in the cause, upon oath, touching all matters contained in the reference; and also to require the production of all books, papers, writings, vouchers, and other documents applicable thereto; and also to examine on oath, viva voce, all witnesses produced by the parties before him, or by



deposition, according to the acts of Congress, or otherwise, as here provided; and also to direct the mode in which the matters requiring evidence shall be proved before him; and generally to do all other acts, and direct all other inquiries and proceedings in the matters before him, which he may deem necessary and proper to the justice and merits thereof and the rights of the parties."

Rule 63 provides for the form of account before the master, all being required to bring them in in the form of debtor and creditor.

Rule 64 provides for former depositions, etc., being used before the master.

Rule 65 provides for examination in a manner such as the nature of the case may appear to the master to require.

Rule 66 relates to the return of master's report—exceptions and hearing, twenty days being given from the time of filing of the report to file exceptions.

Rule 67 provides for costs on exceptions to master's report.

Rule 68 for the appointment and compensation of master.

Rule 69 relates to petition for rehearing.

Rule 70 to suits by or against incompetents.

Rule 71, with reference to form of decrees, reads as follows:

"In drawing up decrees and orders, neither the bill, nor answer, nor other pleadings, nor any part thereof, nor the report of any master, nor any other prior proceedings, shall be recited or stated in the decree or order; but the decree and order shall begin, in substance, as follows: 'This cause came on to be heard (or to be further heard, as the case may be) at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was ordered, adjudged, and decreed as follows, viz.:' (Here insert the decree or order.)"

Rule 72, with reference to correction of clerical mistakes in orders and decrees, reads as follows:

"Clerical mistakes in decrees or decretal orders, or errors arising from any accidental slip or omission, may, at any time before the close of the term at which final decree is rendered, be corrected by order of the court or a judge thereof, upon petition, without the form or expense of a rehearing."

Rule 73, with reference to preliminary injunctions and temporary restraining orders, reads as follows:

"No preliminary injunction shall be granted without notice to the opposite party. Nor shall any temporary restraining order be granted without notice to the opposite party, unless it shall clearly appear from specific facts, shown by affidavit or by the verified bill that immediate and irreparable loss or damage will result to the applicant before the matter can be heard on notice. In case a temporary restraining order shall be granted without

notice, in the contingency specified, the matter shall be made returnable at the earliest possible time, and in no event later than ten days from the date of the order, and shall take precedence of all matters, except older matters of the same character. When the matter comes up for hearing the party who obtained the temporary restraining order shall proceed with his application for a preliminary injunction, and if he does not do so the court shall dissolve his temporary restraining order. Upon two days' notice to the party obtaining such temporary restraining order, the opposite party may appear and move the dissolution or modification of the order, and in that event the court or judge shall proceed to hear and determine the motion as expeditiously as the ends of justice may require. Every temporary restraining order shall be forthwith filed in the clerk's office."

Rule 74 provides for suspending, modifying or restoring an injunction during the pendency of an appeal.

Rule 75, with reference to the record on appeal and to its reduction and preparation, reads as follows:

In case of appeal:

"(a) It shall be the duty of the appellant or his solicitor to file with the clerk of the court from which the appeal is prosecuted, together with proof or acknowledgment of service of a copy on the appellee or his solicitor, a praecipe which shall indicate the portions of the record to be incorporated into the transcript on such appeal. Should the appellee or his solicitor desire additional portions of the record incorporated into the transcript, he shall file with the clerk of the court his praecipe also within ten days thereafter, unless the time shall be enlarged by the court or a judge thereof, indicating such additional portions of the record desired by him.

"(b) The evidence to be included in the record shall not be set forth in full, but shall be stated in simple and condensed form, all parts not essential to the decision of the questions presented by the appeal being omitted and the testimony of witnesses being stated only in narrative form, save that if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness. The duty of so condensing and stating the evidence shall rest primarily on the appellant, who shall prepare his statement thereof and lodge the same in the clerk's office for the examination of the other parties at or before the time of filing his praecipe under paragraph a of this rule. He shall also notify the other parties or their solicitors of such lodgment and shall name a time and place when he will ask the court or judge to approve the statement, the time so named to be at least ten days after such notice. At the expiration of the time named or such further time as the court or judge may allow, the statement, together with any objections

made or amendments proposed by any party, shall be presented to the court or the judge and if the statement be true, complete and properly prepared, it shall be approved by the court or judge, and if it be not true, complete or properly prepared, it shall be made so under the direction of the court or judge and shall then be approved. When approved, it shall be filed in the clerk's office and become a part of the record for the purposes of the appeal.

“(c) If any difference arise between the parties concerning directions as to the general contents of the record to be prepared on the appeal, such difference shall be submitted to the court or judge in conformity with the provisions of paragraph b of this rule and shall be covered by the directions which the court or judge may give on the subject.”

Rule 76 deals with record on appeal and especially with costs and correction of omissions.

Rule 77, with reference to record on appeal and agreed statement, reads as follows:

“When the questions presented by an appeal can be determined by the appellate court without an examination of all the pleadings and evidence, the parties, with the approval of the district court or the judge thereof, may prepare and sign a statement of the case showing how the questions arose and were decided in the district court and setting forth so much only of the facts alleged and proved, or sought to be proved, as is essential to a decision of such questions by the appellate court. Such statement, when filed in the office of the clerk of the district court, shall be treated as superseding, for the purposes of the appeal, all parts of the record other than the decree from which the appeal is taken, and, together with such decree, shall be copied and certified to the appellate court as the record on appeal.”

Rule 78 provides for affirmation in lieu of oath.

Rule 79 provides for additional rules by district court.

Rule 80 provides for computation of time, excluding Sundays and holidays.

Rule 81 provides that these rules shall be effective February 1, 1913, and that the old rules be then abrogated.

915. *EVANS v. EATON*, 3 Wheaton (17 U. S.) 454, 4 L. ed. 433 (1818).

Marshall, C. J.:

In this case exceptions were taken in the circuit court, by the counsel for the plaintiff in error.

1. To the opinion of the court, in admitting testimony offered by the defendant in that court.

2. To its opinion in rejecting testimony offered by the plaintiff in that court.

3. To the charge delivered by the judge to the jury.

Under the 6th section of the act for the promotion of useful arts, and to repeal the act heretofore made for that purpose, the defendant pleaded the general issue, and gave notice that he would prove at the trial, that the improved hopper-boy, for the use of which, without license, this suit was instituted, had been used previous to the alleged invention of the said Evans, in several places (which were specified in the notice), or in some of them, and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States. Having given evidence as to some of the places specified in the notice, the defendant offered evidence as to some other places not specified. This evidence was objected to by the plaintiff, but admitted by the court; to which admission the plaintiff's counsel excepted.

The 6th section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act which may have some influence on this point. It has been already observed, that the notice is substituted for a special plea; it is further to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence on a special plea, the prior use of the machine at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

But there is still another view of this subject, which deserves to be considered. The section which directs this notice, also directs that if the special matter in the section stated be proved, "judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." The notice might be intended not only for the information of the plaintiff, but for the purpose of spreading on the record the cause for which

the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the court are sufficient to prevent, and will, undoubtedly, be so exercised, as to prevent, the patentee from being injured by the surprise.

This testimony having been admitted, the plaintiff offered to prove that the persons, of whose prior use of the improved hopper-boy the defendant had given testimony, had paid the plaintiff for licenses to use his improved hopper-boy in their mills since his patent. This testimony was rejected by the court, on the motion of the defendant; and to this opinion of the court, also, the plaintiff excepted.

The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject, as all testimony is, to the animadversion of the court. \* \* \*

916. BROWN ET AL. v. PIPER, 91 U. S. 37, 23 L. ed. 200 (1875).

[See, for facts, Part II.] \* \* \*

There is another view of the case that may properly be taken.

Evidence of the state of the art is admissible in actions at law under the general issue without a special notice, and in equity cases without any averment in the answer touching the subject. It consists of proof of what was old and in general use at the time of the alleged invention. It is received for three purposes, and none other—to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.

Of private and special facts, in trials in equity and at law, the court or jury, as the case may be, is bound carefully to exclude the influence of all previous knowledge. But there are many things of which judicial cognizance may be taken. "To require proof of every fact, as that Calais is beyond the jurisdiction of the court, would be utterly and absolutely absurd." *Gresley's Ev. in Eq.* 294. Facts of universal notoriety need not be proved. See *Taylor's Ev.*, § 4, note 2. Among the things of which judicial notice is taken are the law of nations; the general customs and usages of merchants; the notary's seal; things which must happen according to the laws of nature; the coincidences of the days of the week with those of the month; the meaning of words in the vernacular language; the customary abbreviations of Christian names; the accessions of the Chief

Magistrate to office, and his leaving it. In this country, such notice is taken of the appointment of members of the cabinet, the election and resignations of senators, and of the appointment of marshals and sheriffs, but not of their deputies. The courts of the United States take judicial notice of the ports and waters of the United States where the tide ebbs and flows, of the boundaries of the several States and judicial districts, and of the laws and jurisprudence of the several States in which they exercise jurisdiction. Courts will take notice of whatever is generally known within the limits of their jurisdiction; and, if the judge's memory is at fault, he may refresh it by resorting to any means for that purpose which he may deem safe and proper. This extends to such matters of science as are involved in the cases brought before him. See 1 Greenleaf's Ev. 11; Gresley's Ev., *supra*; and Taylor's Ev., § 4, and *post*.

In the *Ohio L. & T. Co. v. Debolt*, 16 How. 435, it was said to be "a matter of public history, which this court cannot refuse to notice, that almost every bill for the incorporation of companies" of the classes named is prepared and passed under the circumstances stated. In *Hoare v. Silverlock*, 12 Ad. & Ell. N. S. 624, it was held that where a libel charged that the friends of the plaintiff had "realized the fable of the frozen snake," the court would take notice that the knowledge of that fable existed generally in society. This power is to be exercised by courts with caution. Care must be taken that the requisite notoriety exists. Every reasonable doubt upon the subject should be resolved promptly in the negative. \* \* \*

Here the principle and substance of the appellee's claim are set forth as belonging to the general domain of knowledge and science. It is known that Lord Bacon applied snow to poultry to preserve it. He said the process succeeded "excellently well." The experiment was made in his old age, imprudently, and brought on his last illness.

Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answers and testimony, *sua sponte*, if the objection were not taken by counsel, well have adjudged in favor of the defendant.

These views render it unnecessary to consider the exceptions will be remanded, with directions to dismiss the bill.

The decree of the Circuit Court is reversed; and the cause to the master's report.

917. COCHRANE v. DEENER, 94 U. S. 780, 24 L. ed. 139 (1876).\* \* \*

Mr. Justice Bradley delivered the opinion of the court.

This is a suit in equity, instituted in the Supreme Court of the District of Columbia for injunction and relief against an alleged infringement of various patents belonging to the complainants. The bill was dismissed, and the complainants have appealed.

The patents sued on are six in number, originally five, granted to the appellant Cochrane on the 13th of January, 1863, and numbered respectively 37,317, 37,318, 37,319, 37,320, and 37,321. They all related to an improved method of bolting flour, the first being for the general process, and the others for improvements in the different parts of the machinery rendered necessary in carrying on the process. Three of the original patents, Nos. 37,317, 37,318, and 37,321, were surrendered, and reissues taken in 1874, which reissues were numbered 5,841, 6,029, and 6,030, the first being for the process, and the other two for portions of the machinery. Reissue 6,029, being in place of the original patent numbered 37,321, was also subsequently surrendered, and two new reissued patents substituted therefor, numbered 6,594 and 6,595.

The case has been mainly argued on the question of infringement, the defendants using a bolting apparatus constructed according to letters-patent issued to Edward P. Welch in April, 1873, for improvements upon machines patented to Jesse B. Wheeler and Ransom S. Reynolds, which, as well as the process employed, they contend, are radically different from the apparatus and process of Cochrane.

A preliminary question is raised with regard to the jurisdiction of the court below to hear the case on a bill in equity, before a determination of the rights of the parties in an action at law.

The powers of the Supreme Court of the District of Columbia in patent cases are the same as those of the circuit courts of the United States. See Revised Statutes relating to the District of Columbia, secs. 760, 764.

The circuit courts were first invested with equity jurisdiction in patent cases by the act of Feb. 15, 1819, which declared that these courts should have "original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, should have authority to grant injunctions, according to the course and principles of courts of equity," etc.

This law was substantially re-enacted in the seventeenth section of the patent law of July 4, 1836, and the fifty-fifth section of that of July 8, 1870, special powers to assess damages in equity cases being also conferred by the latter act.

Before the act of 1819 was passed, the circuit courts had cognizance of actions at law brought to recover damages for the infringement of patents, but not of suits in equity in relation thereto unless the parties happened to be citizens of different States. Phillips on Pat. 379; Livingston v. Van Ingen, 1 Paine, 54; Sullivan v. Redfield, Id. 447. Under that act and the subsequent acts in which it became incorporated, bills in equity for injunction, discovery, and account have constantly been sustained, frequently without any previous action at law. As said by Mr. Justice Grier, in a case decided at the circuit, "It is true that, in England the chancellor will generally not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not universal: it is a practice founded more on convenience than necessity. It always rests in the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles. In the United States, the practice is by no means so general as in England." Goodyear v. Day, 2 Wall. Jr. 296. Subsequently, in the case of Sickles v. Gloucester Manufacturing Co., 3 Id. 196, the same judge said: "The courts of the United States have their jurisdiction over controversies of this nature by statute, and do not exercise it merely as ancillary to a court of law." And, after quoting the statute, he proceeds: "Having such original cognizance, \* \* \* the courts of the United States do not, in all cases, require a verdict at law on the title, before granting a final injunction, or concede a right to every party to have every issue as to originality or infringement tried by a jury."

The position of Mr. Justice Grier is undoubtedly true, that whether a case shall be first tried at law is a matter of discretion, and not of jurisdiction; and in this matter the courts of the United States, sitting as courts of equity in patent cases, are much less disposed than the English courts are to send parties to a jury before assuming to decide upon the merits.

But the counsel for the defendants suggest that the Revised Statutes have not preserved in entirety the previous enactments on this subject, but have omitted the vesting of original cognizance in the circuit courts sitting as courts of equity in patent cases. From a careful consideration, however, of all the sec-



tions of the Revised Statutes on the subject, we think that no intention is evinced to make any change in the law. The original enactments are separated into distinct parts, and somewhat condensed; but the substance of them is retained. By sec. 629, the circuit courts are invested with jurisdiction, among other things, "Ninth, of all suits at law or in equity arising under the patent or copyright laws of the United States." And, by sec. 4921, it is declared, that "the several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity," etc., following precisely the language used in the act of 1870, the last previous revision of this branch of the law. The grant of jurisdiction is as broad and general as it could well be, and the mode of exercising it is prescribed in precisely the same terms as in previous statutes.

In the present case, we see no special reason for sending the case to a court of law or to a jury for trial. There are no such issues depending upon the credibility of witnesses, or on the intricacy of machinery, as to make the case susceptible of easier solution or greater certainty as to the truth before such a tribunal than it admits of when presented to the consideration of a chancellor. It would, perhaps, be desirable if all cases of this sort could be referred to a commission of intelligent experts and practical men to report their opinion thereon, with their reasons, for the final action of the court. A proceeding of this kind was probably in the mind of Congress in passing the act of Feb. 16, 1875, authorizing a reference to a jury of five persons. Neither courts nor ordinary juries are perfectly adapted to the investigation of mechanical and scientific questions. The court below, however, exercised its discretion to decide the case upon its merits, without the aid of a jury of any sort, and their action is not a ground of appeal. If we were convinced, however, that the case was not properly decided, and could not be properly decided without such a reference, we might undoubtedly, in the exercise of our own discretion, remand it to the court below for that purpose. But we see nothing in the questions raised which requires that such a course should be adopted.

\* \* \*

918. THE EXCELSIOR WOODEN PIPE CO. v. PACIFIC BRIDGE CO., 185  
U. S. 282, 46 L. ed. 910 (1902).

On appeal from the Circuit Court of the United States for the District of Washington.

Statement of the Case.

This was a bill in equity filed by the Excelsior Wooden Pipe Company, a California corporation, against the Pacific Bridge

Company, also a California corporation, but having a branch in the city of Seattle, Wash., and Charles P. Allen, for the infringement of a patent issued to Allen, one of the defendants, for a wooden pipe.

Besides the usual allegations of a bill for the infringement of a patent, the plaintiff averred that, prior to the acts charged against the respondents, the said Charles P. Allen, one of the defendants, had granted December 20, 1892, unto the Excelsior Redwood Company, a California corporation, the exclusive right within the Pacific States of manufacturing and selling wooden pipe under his patent to the full end of its term; that the Excelsior Redwood Company had, with the written consent of Allen, the patentee, on December 22, 1892, transferred unto the Excelsior Wooden Pipe Company, plaintiff, the said exclusive license to it, from Allen, with all rights and privileges thereunder, and that Allen had been, and still was, the exclusive owner of the patent, and the plaintiff the sole and exclusive licensee; that the plaintiff has ever since and still is engaged in the manufacture and sale of the patented articles, and has filled all orders therefor, and is well known as the exclusive licensee, and that Allen has joined with the plaintiff in suits against infringers of his patent, all of which have resulted in his favor. The gravamen of the bill lies in the allegation that, notwithstanding all this, the defendant, the Pacific Bridge Company, and the said Allen, have since such license conspired to make and sell, and without the license and consent of your orator, exclusive licensee as aforesaid, have made and sold, within one year last past, within the State of Washington, wooden pipe substantially the same as that described in the patent and embodying the invention; and therefore it brought this bill to recover damages for this infringement and for an injunction.

The answer which was a joint one of both defendants, admitted the issue and validity of the patent and its ownership by defendant Allen. It is also admitted a license by defendant Allen to plaintiff's assignor, whereby the latter obtained the exclusive right to make and sell the patented articles in the territory described, and set out the license in full; but it denied that this license was a subsisting one, and alleged an abandonment of the same by the plaintiff, a forfeiture of all rights thereunder by failure and refusal to comply with its terms and conditions, and by acts of bad faith toward the patentee by seeking to defeat the patent and destroy its monopoly; and a revocation of the license by Allen for cause in pursuance of the terms of the contract. It also set up that after the alleged revocation of the license the defendant Allen granted a license to his joint defendant, the Pacific Bridge Company. In short, the only de-

fense was a denial of the license which lies at the basis of plaintiff's suit, and constitutes its title to the patent.

The usual replication was filed, and, pending an application on the part of defendants for an extension of time to take proofs, the plaintiff, apparently at the suggestion of the court, moved for a decree in its favor upon the pleadings and affidavits on file. Upon argument, which was upon the question of jurisdiction alone, the court held that the suit was not one arising under the patent laws, but solely out of a contract; that the court had no jurisdiction, and a decree was entered to that effect. Plaintiff thereupon appealed to the circuit court of appeals, which dismissed the case upon the ground that it had no jurisdiction itself over the appeal, and that, as such appeal was prosecuted from an order dismissing the bill solely for want of jurisdiction, it should have been taken to this Court. (109 Fed. 497.) Whereupon the mandate of the circuit court of appeals being filed in the circuit court, an appeal from the final decree of that court, which had been entered November 5, 1900, was taken to this Court. \* \* \*

Mr. Justice Brown delivered the opinion of the Court.

1. Motion is made by defendants to dismiss this appeal upon the ground that no appeal was taken, and no certificate of the trial court upon the question of jurisdiction, was made by such court during the term at which the decree was rendered, and that no such certificate has since or ever been made.

As the appeal was taken directly to this Court, it must appear under the fifth section of the Court of Appeals act, either that the question of jurisdiction was certified to this Court, or that the decree appealed from shows upon its face that the sole question decided was one of jurisdiction. Plaintiff evidently supposed that the case was a proper one to carry to the court of appeals, but its appeal having been there dismissed, it took this appeal May 27, 1901, from the original decree of the circuit court made November 5, 1900. This decree, after reciting—

“that said suit does not really substantially involve a dispute or controversy properly within the jurisdiction of this court, and that this court should not further exercise jurisdiction, it is therefore ordered and decreed that said suit be and the same is hereby dismissed for want of jurisdiction.”

An appeal was taken from this decree, and the order allowing the appeal states that the appeal was allowed—  
“from the final order and decree dismissing said suit for want of jurisdiction.”

This is clearly a sufficient certificate of the circuit court that the jurisdiction of that court was in issue, and the only question to be considered by us relates to the jurisdiction of that court.

(Shields v. Coleman, 157 U. S. 168; *In re* Lehigh Mining Co., 156 U. S. 322; Huntington v. Laidley, 176 U. S. 668.)

The case, being thus in proper condition for appeal, such appeal could be taken at any time within two years. (Allen v. Southern Pacific R. R. Co., 173 U. S. 479; Holt v. Indiana Manfg. Co., 176 U. S. 68.)

2. The most important question is whether this is a suit under the patent laws of the United States within the meaning of Revised Statutes sec. 629, sub. 9, which grants original jurisdiction to the circuit courts—

“of all suits at law or in equity arising under the patent or copyright laws of the United States.”

The rule is well settled that, if the suit be brought to enforce or set aside a contract, though such contract be connected with a patent, it is not a suit under the patent laws, and jurisdiction of the circuit court can only be maintained upon the ground of diversity of citizenship. But difficulties sometimes arise in determining whether the action be upon a contract or upon the patent. The first case involving this question was *Wilson v. Sandford*, 10 How. 99, in which a bill filed on the equity side of the circuit court by the assignee of a patentee, to set aside a contract in the nature of a license upon the ground that the licensee had not complied with the terms of the contract, was held not to be a case under the patent laws. The object of the bill was to have the license set aside and forfeited, and plaintiff's title reinvested in him. Such was also the case in *Brown v. Shannon*, 20 How. 55, which was a bill to enforce the specific execution of certain contracts respecting the use of the patent; and in *Albright v. Teas*, 22 O. G. 2069, 106 U. S. 613, which was a suit brought by the plaintiff for moneys alleged to be due under a contract whereby certain Letters Patent granted to him were transferred to the defendant. This was clearly a bill to recover royalties, and no question under the patent laws was involved. *Dale Tile Manfg. Co. v. Hyatt*, 43 O. G. 249, 125 U. S. 46, was an action in a State court by the owner of the patent upon an agreement by which such owner granted an exclusive license to make and sell the patented articles within a certain territory. Defendant expressly acknowledged the validity of the patent. This, we held to be, clearly within the jurisdiction of the State court. A like ruling was made in the next case of *Felix v. Scharnweber*, 43 O. G. 251, 125 U. S. 54. In the same line of cases are those of *Marsh v. Nichols*, 56 O. G. 259, 140 U. S. 344, to enforce the specific performance of a contract to transfer an interest in a patent to the plaintiff; *Wade v. Lawder*, 165 U. S. 624; and *Pratt v. Paris Light & Coke Co.*, 168 U. S. 255, which was an action

by patentees in a State court upon the common counts to recover of the defendant the stipulated price for manufacturing and setting up an apparatus for the manufacture of water-gas. Defendant pleaded that the plaintiff had agreed to save it harmless against any suit which might be brought against it for infringement, and to defend such suits at their own expense, and averred, among other things, that the patents were void and an infringement upon prior patents; that defendant had not kept plaintiffs harmless against such suits, but had refused to defend a certain suit brought against it, and that the defendant had rightfully rescinded the contract. It was held that the action was not one arising under the patent laws of the United States, and that to constitute such a cause the plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction or sustained by the opposite construction of those laws. That—

“section 711 does not deprive the State courts of the power to determine questions arising under the patent laws, but only of assuming jurisdiction of cases arising under those laws. There is a complete distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading—be it a bill, complaint or declaration—sets up a right under the patent laws as ground for a recovery. Of such the State courts have no jurisdiction. The latter may appear in the plea or answer or in the testimony. The determination of such question is not beyond the competency of the State tribunals.”

Now, as the bill in this case differs from an ordinary bill for infringement only in the fact that the suit is by a licensee against two defendants, one of whom is the licensor and owner of the patent, and the license is set forth only for the purpose of showing title, there would be no difficulty whatever in sustaining it, were it not for the question whether we are not also bound to consider the averments of the answer. We think this difficulty is practically settled by a reference to section 5 of the Jurisdictional Statute of 1875, 18 Stat. 470, 472, which provides—

“that if, in any suit commenced in a circuit court, \* \* \* it shall appear to the satisfaction of the said circuit court, at any time after such suit has been brought, \* \* \* that such suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of said circuit court, \* \* \* the said circuit court shall proceed no further therein, but shall dismiss the suit, etc.”

While it seems reasonable to say that a jurisdiction once acquired by the filing of a proper bill ought not to be taken away by any subsequent pleading, the statute is peremptory in this particular, and requires the court to dismiss the case whenever at any time it shall appear that its jurisdiction has been improperly invoked. We are by no means without authority upon this question. In *Robinson v. Anderson*, 121 U. S. 522, it was held that when it appeared, after all the pleadings were filed, that the averments in the declaration which alone gave the court jurisdiction, were immaterial and made for the purpose of creating a case cognizable by the court, it was the duty of the circuit court to dismiss the bill for want of jurisdiction. Said the Chief Justice:

“Even if the complaint, standing by itself, made out a case of jurisdiction, which we do not decide, it was taken away as soon as the answers were in, because if there was jurisdiction at all it was by reason of the averments in the complaint as to what the defenses against the title of the plaintiffs would be, and these were of no avail as soon as the answers were filed and it was made to appear that no such defenses were relied on.”

In *Williams v. Nottawa*, 104 U. S. 209, this Court went so far as to dismiss a case in which judgment had been rendered for the plaintiff in the circuit court, because it appeared from the testimony of the plaintiff that certain bonds were put in his hands for collection in which he had no real interest. It was held that it was the duty of the circuit court on its own motion, as soon as the evidence was in and the collusive character of the case shown, to stop all further proceedings and dismiss the suit, the Chief Justice further remarking that this proviso of the act of 1875 was a salutary one, and that it was the duty of the circuit courts to exercise their power under it in proper cases. See also *Wetmore v. Rymer*, 169 U. S. 115; *Morris v. Gilmer*, 129 U. S. 315; *Lake County Commissioners v. Dudley*, 173 U. S. 243.

Is there anything in the answer to show that the court was bound to dismiss the bill for want of jurisdiction?

The bill makes the usual allegations of a bill for infringement, and puts in issue (1) the title of the plaintiff, which in this case was a license from one of the defendants, fully set forth in the margin;<sup>1</sup> (2) the validity of the patent; and (3)

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<sup>1</sup>License and agreement.—This agreement, made this 11th day of March, 1893, by and between Charles P. Allen, of Denver, Colo., party of the first part, and the Excelsior Redwood Company, a corporation duly organized and existing under and by virtue of the laws of the State of California, and having its principal place of business in the city and county of San Francisco in said State, party of the second part:

Witnesseth: That, whereas, the party of the first part is the owner and holder, for, to and in the States and Territories hereinafter mentioned, of the whole right, title and interest in and to Letters Patent of the United States, No. 359,590, dated March 22, 1887, for "wooden pipe."

And, whereas, the party of the second part is desirous of obtaining for, to and within the said States and Territories hereinafter mentioned an exclusive right, license and privilege to manufacture and sell wooden pipe under and in accordance with said Letters Patent:

Now, therefore, the parties have agreed as follows: The party of the first part hereby grants, subject to the conditions hereinafter stated, unto the party of the second part, its successors and assigns, the exclusive right, license and privilege, within the States of Northern California, Oregon, Washington, Nevada, Montana and Idaho, and Territories of Arizona and Utah, of manufacturing and selling wooden pipe under and in accordance with the said Letters Patent, to the full end of the term of said Letters Patent.

The party of the second part agrees to pay unto the party of the first part, as a license fee or royalty under this license and agreement, the following sums, to-wit: One dollar (\$1.00) on every one thousand feet, board measure, of lumber employed in the manufacture of said pipe and two and one-half per-cent. ( $2\frac{1}{2}\%$ ) on the cost at factory of all steel and iron used in said manufacture.

The said license or royalty is to be paid by the said party of the second part to the said party of the first part upon the final payment to the party of the second part of the contract-price on each and every contract taken by said party of the second part, involving the manufacture and sale of said patented wooden pipe. The right, license and privilege hereby granted is not transferable or assignable, either in whole or part, by the party of the second part, without the consent of the party of the first part. It is agreed that in case the party of the second part shall fail to use the above-described patent in any pipe constructed by them, of twelve (12) inches diameter and upward, or from any cause the said party of the second part shall cease the manufacture of wooden pipe, then and in that event all rights and privileges granted by this agreement and license to the said party of the second part shall at once be revoked.

It is understood and agreed that this agreement is binding upon the heirs, legal representatives and assigns of the party of the first part, and upon the successors and assigns of the party of the second part.

the infringement. The answer raises no issue as to the validity of the patent, or as to the acts charging infringement. It admits the license, but denies that it is a subsisting one, and pleads abandonment of the same by plaintiff, a forfeiture of all rights thereunder by failure to comply with its terms and conditions, and by acts of gross bad faith toward the patentee by seeking to defeat the patent, and a revocation of the license by Allen. It will be observed that the answer raises no question of the construction of the license, but merely of its existence—that is, of the title of the plaintiff to sue. Before deciding that these allegations oust the jurisdiction of the court it must at least appear that the plaintiff has another remedy by an action in a State court. But what remedy has it? All the agreements and conditions of the license are such as are made by the plaintiff's

assignor, the Excelsior Redwood Company. This company, the party of the second part, agrees first, to pay a license fee or royalty, the time of payment being fixed in a subsequent sentence; second, that it will neither transfer nor assign the license without the consent of the patentee (it was admitted that the patentee consented to the assignment to plaintiff); third, that in case the licensee should fail to use the patent in any pipe constructed by them, or from any cause it should cease to manufacture a wooden pipe, the license shall be at once revoked. The only clause in the license in which the patentee appears as promisor is that wherein—

“he hereby grants, subject to the conditions hereinafter stated, unto the party of the second part, its successors and assigns, the exclusive right, license and privilege within”—  
certain States—

“of manufacturing and selling wooden pipe under and in accordance with the said Letters Patent to the full end of the term of said Letters Patent.”

Now, it may be freely conceded that, if the licensee had failed to observe any one of the three conditions of the license, the licensor would have been obliged to resort to the State courts either to recover the royalties, or to procure a revocation of the license. Such suit would not involve any question under the patent law.

But the same does not hold good with respect to the licensee. There were practically but two ways in which the patentee could impair the grant he made to the licensee, and those were by a revocation of the license by a bill in equity, or by treating it as abandoned and revoked, and granting a license to another party. He elected the latter remedy, and made a contract with the Pacific Bridge Company to make and sell wooden pipe within the same territory. A suit in a State court would either be inadequate or would involve questions under the patent law. If the licensee sued at law he would be obliged to establish the fact that the patent had been infringed, which the patentee might have denied, and in any case could only recover damages for past infringements. If he sued in equity, he could only pray an injunction against future infringements; but this is exactly what he prays in this case, and thereby raises a question under the patent laws. In either case the patentee could defeat the action by showing that he did not infringe—in either case the defendant could so frame his answer as to put in issue the title, the validity or the infringement of the patent.

The natural and practically the only remedy, as it seems to us, was for the plaintiff to assert his title under the license



and to prosecute the defendants as infringers. In doing this he does what every plaintiff is bound to do, namely, set forth his title either as patentee, assignee or licensee, and thereby put that title in issue. The defendant is at liberty in such a case to deny the title of the plaintiff by declaring that the license no longer exists, but in our opinion this does not make it a suit upon the license or contract, but it still remains a suit for the infringement of a patent, the only question being as to the validity of plaintiff's title. There can be no doubt whatever that if the plaintiff sued some third person for an infringement of his patent, the defendant might attack the validity of his license in the same way, but it would not oust the jurisdiction of the court. Why should it do so in this case?

Much reliance is placed upon the case of *Hartell v. Tilghman*, 99 U. S. 547, which was a bill by a patentee against one with whom he had made a contract in the nature of a license, alleging that defendants, after paying the royalty for several months, refused to do certain other things which he charged to have been a part of the contract, and thereupon he forbade them further to use his patented process, and charged them as infringers. Defendants pleaded the contract as they understood it, and the tender of all that was due plaintiff under it, and their readiness to perform it.

Plaintiff's case was that there was a verbal agreement that he should prepare and put up his patented mechanism in defendants' workshop, and that after this was done defendants should take a license for the use of the invention. The machinery was put up, but defendants refused to sign the license apparently upon the ground that the patentee claimed the right to visit the works of the defendants, and inspect their books with a view to ascertaining the amount of work done. The dispute was as to the terms of the agreement, defendants insisting that they had never proposed to accept the license with the conditions mentioned. It was held that the patentee could not sue the defendants for an infringement, and in answer to the objection that he had no other remedy Mr. Justice Miller observed that he could establish his royalty once every year, and sue at law and recover every month or every year for what was due, and that, if he desired to assert his right of examining the works of the defendants, he could in a proper case compel them to submit to the examination. The case is the converse of the one under consideration, inasmuch as it was a suit by the patentee against the licensee for a violation of his contract, and, as the Court observed, the plaintiff might have brought suit for royalties. As already said, the patentee might have

done the same in this case, if he had sought to enforce his contract.

Much more nearly analogous to the case under consideration and practically upon all fours with it is that of *Littlefield v. Perry*, 7 O. G. 964, 21 Wall. 205. This was a suit by an assignee against the patentee, who had made a conveyance to the plaintiff of his patent with all improvements thereon, within certain States, for which plaintiff had agreed to pay royalty upon all articles sold, with a clause of forfeiture in case of non-payment or neglect after due notice, to make and sell the patented articles to the extent of a reasonable demand therefor. There was by a supplementary document an agreement reserving to the patentee the right to apply the principle of his invention to one special purpose. It was held that whether the plaintiff was an assignee or a licensee, he had a right to maintain a suit for infringement in his own name in a Federal court against the patentee. Said the Chief Justice:

“They [the plaintiffs] certainly had the exclusive right to the use of the patent for certain purposes within their territory. They thus held a right under the patent. The claim is that this right has been infringed. To determine the suit, therefore, it is necessary to inquire whether there has been an infringement, and that involves a construction of the patents, \* \* \* such a suit may involve the construction of a contract as well as of a patent, but that will not oust the court of its jurisdiction. If a patent is involved, it carries with it the whole case.”

Upon the subject of a licensee suing his own patentee the Chief Justice observed:

“A mere licensee cannot sue strangers who infringe. In such cases redress is obtained through or in the name of the patentee or his assignee. Here, however, the patentee is the infringer, and, as he can not sue himself, the licensee is powerless, so far as the courts of the United States are concerned, unless he can sue in his own name. A court of equity looks to the substance rather than form. When it has jurisdiction of parties it grants the appropriate relief without regard to whether they come as plaintiff or defendant. In this case the person who should have protected the plaintiff against all infringements has become himself the infringer.”

*White v. Rankin*, 59 O. G. 1606, 144 U. S. 628, was a bill by a patentee for infringement, to which there was answer setting up an agreement between the plaintiff and one of the defendants to assign to him an interest in the patent on certain condition, which it was alleged were performed, and certain other matters which it was alleged gave the defendants the right to make use and sell the patented invention. The case was tried upon

a stipulation admitting that defendants had made and sold the patented inventions, and that a certain written agreement between the plaintiff and one of the defendants had been made as above stated. The circuit court entered a decree dismissing the bill, which was reversed by this Court.

“It [the court] appears [said Mr. Justice Blatchford] to have dismissed the bill on the simple ground that the defendant set up a contract of license from White. The bill being purely a bill for infringement, founded upon patents, what was set up by the defendants was set up as a defense and as showing the lawful right in them to do what they had done, and as a ground for the dismissal of the bill because they had not infringed the patents.”

The decree was not one upon the facts of the case, but was simply a decree that the court had no jurisdiction to try the case. The subject-matter of the action, as set forth in the bill, gave the court jurisdiction, and exclusive jurisdiction, to try it. All of the parties to the suit were citizens of California, and if jurisdiction did not exist under the patent laws it did not exist at all.

“The circuit court found nothing as to the existence or validity of the contract, decree or deed mentioned in the stipulation. The stipulation provides that at the hearing the contract, complaint, answer, decree and deed set forth in the stipulation may be offered in evidence, subject to such objections as might be urged against the originals thereof. The stipulation further states that the defendants do not admit that anything is due to the plaintiff from Thompson, and that they do admit that nothing had been paid by Thompson to the plaintiff under the decree of the State court of August 26, 1884, and since the making thereof. All these matters and questions ought to have been adjudicated by the circuit court before it could find ground to determine whether or not it should dismiss the bill. Until it had so adjudicated those questions the decision in the case of *Hartell v. Tilghman* could not apply.”

The cases in the circuit courts and courts of appeal are too numerous to be analyzed, or even cited. One of the most recent and satisfactory is that of the *Atherton Machine Co. v. Atwood-Morrison Co.*, 102 Fed. 949, in which it was broadly held that a suit in which the relief sought is an injunction and a recovery of damages for the infringement of a patent is one arising under the patent laws of the United States, although it incidentally involves a determination of the question of the ownership of the patent, which was claimed by both complainant and defendant under separate assignments from the patentee. All the cases cited herein are reviewed and the jurisdiction sustained.

The difficulty with the defendant's position in the case under consideration is that it apparently leaves the plaintiff without an adequate remedy. Defendant has broken no express covenant of the contract, since it has made no covenant. It has simply ignored the existence of the contract and granted a license to another party. It is difficult to see what remedy is available to the plaintiff in a State court that would not involve the right of the defendant to use the patent. In other words, it would be an ordinary suit for infringement in which the federal courts would alone have jurisdiction. Whether it sued at law or in equity, its damages would be such as are usual in cases of infringement, and the only injunction it could obtain would be against the further use of the invention.

In any suit that could be brought the title of the plaintiff to sue must be put in issue, and, that being the title to the patent, is put in issue in every suit for infringement. We held in *Pratt v. Paris Light & Coke Co.*, 168 U. S. 255, with respect to an action in a State court, which involved the question whether the patents were void and an infringement upon prior patents, that this did not necessarily oust the State court of its jurisdiction; and by parity of reasoning we hold in this case that the mere fact that the suit may involve the existence of the license does not oust the court of jurisdiction of a suit for the infringement of a patent.

While we do not intend to allow the jurisdiction of the federal courts to be invoked primarily for the determination of the respective rights of parties to a contract concerning patents, yet when the bill is an ordinary one for an infringement and the answer puts in issue the title of the plaintiff to sue, we think the jurisdiction is not ousted by the mere allegation that the license has been revoked and that the court is at liberty to go on and determine that fact. We regard this question as conclusively settled in *Perry v. Littlefield*, 21 Wall. 205, and *White v. Rankin*, 144 U. S. 628, and have no disposition to disturb it.

The decree of the circuit court is, therefore, reversed, and the case remanded to that court for further proceedings consistent with this opinion.

Mr. Justice Gray did not sit in this case or participate in the decision.

919. UNITED STATES v. AMERICAN BELL TELEPHONE CO., 159 U. S. 548, 40 L. ed. 255 (1895).\* \* \*

Mr. Chief Justice Fuller delivered the opinion of the court. This is a suit by the United States to cancel a patent for an invention granted to the American Bell Telephone Company, as assignee of the inventor, Emile Berliner. On a hearing in

the circuit court there was a finding and decree for the complainant. 69 O. G. 1778, 65 Fed. 86. The cause having been taken to the circuit court of appeals for the first circuit, the decree of the circuit court was reversed, and it was ordered that the bill be dismissed. (71 O. G. 1903, 68 Fed. 542.) From this decree an appeal was taken by the United States to this court, which appellees now move to dismiss—

“for want of jurisdiction in this court to entertain it under the circuit court of appeals act of March 3, 1891, c. 517, 26 Stat. 828, for the reason that the case is a case arising under the patent laws.”

The Supreme Court has appellate jurisdiction, under the constitution, in all cases to which the judicial power extends, (other than those in respect of which it has original jurisdiction,) “with such exceptions and under such regulations as the Congress shall make.”

It was early held that in the passage of the judiciary act of 1789, Congress was executing the power of making exceptions to the exercise of appellate jurisdiction, and that the affirmative description of the cases to which the appellate power extended was to be understood as implying a negative on the exercise of such appellate power as was not comprehended within it, but that as this restriction rested on implication founded on the manifest intent of the legislature, it could be sustained only when that manifest intent appeared. *Durousseau v. United States*, 6 Cranch, 307.

Where the appellate jurisdiction is described in general terms so as to comprehend the particular case, no presumption can be indulged of an intention to oust or to restrict such jurisdiction; and any statute claimed to have that effect must be examined in the light of the objects of the enactment, the purposes it is to serve and the mischiefs it is to remedy, bearing in mind the rule that the operation of such a statute must be restrained within narrower limits than its words import, if the court is satisfied that the literal meaning of its language would extend to cases which the legislature never intended to include in it. (*Petri v. Commercial National Bank of Chicago*, 142 U. S. 644, 650; *Brewer's Lessee v. Blougher*, 14 Pet. 178; *Reiche v. Smythe*, 13 Wall. 162, 164; *Market Company v. Hoffman*, 101 U. S. 112.)

We inquire then whether the appellate jurisdiction of this court over controversies to which the United States are parties has been circumscribed by Congress in respect to the right of appeal.

By § 629 of the Revised Statutes, original jurisdiction was conferred upon the circuit courts (with a limitation as to the

value of the matter in dispute) of all suits in equity and all suits at common law where the United States are petitioners or plaintiffs; all suits at law or in equity, arising under any act providing for revenue from imports or tonnage; all causes arising under any law providing internal revenue; all causes arising under the postal laws; and all suits at law or in equity arising under the patent or copyright laws of the United States. By the fifth paragraph of § 711, the jurisdiction of the courts of the United States of all cases—

“arising under the patent right or copyright laws of the United States—”

was declared to be exclusive.

By the act of March 3, 1875, 18 Stat. 470, it was provided:

“The circuit courts of the United States shall have original cognizance, concurrent with the courts of the several States, of all suits of a civil nature at common law or in equity, where the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars, and arising under the constitution or laws of the United States, or treaties made, or which shall be made, under their authority, or in which the United States are plaintiffs or petitioners;”

and this was repeated in substance, the differences being immaterial here, in the acts of March 3, 1887, 24 Stat. 552, and August 13, 1888, 25 Stat. 433.

And this court had appellate jurisdiction over all final judgments and decrees of any circuit court, or of any district court acting as a circuit court, in civil actions where the matter in dispute exceeded the sum or value of five thousand dollars. (Rev. Stat., §§ 690, 691, 692, 18 Stat. 315.)

The primary object of the act of March 3, 1891, (c. 517), as stated in *American Construction Company v. Jacksonville Railway Company*, 148 U. S. 372, 382—

“well known as a matter of public history, manifest on the face of the act, and judicially declared in the leading cases under it, was to relieve this court of the over-burden of cases and controversies, arising from the rapid growth of the country, and the steady increase of litigation; and, for the accomplishment of this object, to transfer a large part of its appellate jurisdiction to the circuit courts of appeals thereby established in each judicial circuit, and to distribute between this court and those, according to the scheme of the act, the entire appellate jurisdiction from the circuit and district courts of the United States.”

By § 5 of this act, appeals or writs of error may be taken from the circuit court directly to this court in six specified class-

es of cases: where the jurisdiction of the court below is in issue; in prize causes; in cases of convictions of capital or otherwise infamous crimes; in cases involving the construction or application of the Constitution of the United States; in cases in which the constitutionality of any law of the United States, or the validity or construction of any treaty made under its authority, is drawn in question; in cases where the constitution or law of a State is claimed to be in contravention of the constitution of the United States. Cases in which the United States are plaintiffs or petitioners are not enumerated as falling within either of these classes, nor are cases involving merely the construction of a law of the United States, those ordinarily arising under the heads of jurisdiction in respect of subjects-matter treated of in the sixth section.

By the sixth section, it is provided that the circuit courts of appeals shall have appellate jurisdiction—

“in all cases other than those provided for in the preceding section of this act, unless otherwise provided by law.”

The courts of appeals, therefore, have appellate jurisdiction of all cases in which original jurisdiction is conferred on the circuit courts by reason of the United States being plaintiffs or petitioners. It is further provided by that section that—

“the judgments or decrees of the circuit courts of appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy, being aliens and citizens of the United States or citizens of different States; also in all cases arising under the patent laws, under the revenue laws, and under the criminal laws and in admiralty cases.”

And the last paragraph of the section provides that—  
“in all cases not hereinbefore, in this section, made final, there shall be of right an appeal or writ of error or review of the case by the Supreme Court of the United States where the matter in controversy shall exceed one thousand dollars besides costs.”

Judgments or decrees in cases in which the ground of jurisdiction of the circuit court is that the United States are plaintiffs or petitioners are not made final in terms, and such cases would fall within the last paragraph, unless restricted by the previous enumeration. And the contention is that the words “cases arising under the patent laws,” must be held to operate as such restriction, and to render the judgments and decrees of the circuit courts of appeals final, notwithstanding the existence of another distinct ground of jurisdiction in the circuit court, and that there would consequently be a right of appeal from a

decree of a circuit court of appeals dismissing a bill by the United States to cancel a patent for land, but none where the bill is one to repeal an invention patent.

In *United States v. Telephone Company*, 45 O. G. 1311, 128 U. S. 315, 359, we said:

"In the present case the United States are plaintiffs, and the bill asserts that the suit is one of a civil nature, and of equitable cognizance, and manifestly, if it presents a good cause of action, it arises under the laws and constitution of the United States. It is therefore, within the language of both of the constitution and of the statute conferring jurisdiction on the circuit courts."

Two grounds to support the jurisdiction were thus indicated, but the question there was whether the judicial power of the United States under the constitution extended to a suit by the United States to repeal a patent, and in that view it was held that such a suit was a case arising under the laws of the United States, as had been previously adjudged many times by the court. In the language of appellee's counsel—

"the judgments in the great contests reported in *Cranch* and *Wheaton* established that these words embraced, and therefore carried the judicial power to, every case wherein the existence or extent of a right purporting to be given by federal authority and claimed by either party, became an essential ingredient."

Nevertheless, in respect of removals of suits from the State courts to the circuit courts under the acts of March 3, 1887, and August 13, 1888, we held, upon what was deemed the true construction of the statutes, that the right of removal was limited to cases in which it appeared from the plaintiff's statement of his own claim that his cause of action was one arising under the constitution or laws of the United States. *Tennessee v. Bank*, 152 U. S. 454; *Chappell v. Waterworth*, 155 U. S. 102.

In *Colorado Mining Company v. Turck*, 150 U. S. 138, it was ruled that when the original jurisdiction of a circuit court is invoked upon the sole ground that the determination of the question depends upon some question of a federal nature, it must appear, at the outset, from the pleadings, that the suit is one of that character of which the circuit court could properly take cognizance at the time its jurisdiction was invoked; and that where the jurisdiction was invoked solely on the ground of diverse citizenship, the judgment of the circuit court of appeals was final, although another ground for jurisdiction in the circuit court might be developed in the course of subsequent proceedings in the case. How the case might be if the plaintiff had invoked jurisdiction on two distinct grounds, one of them being independent of diverse citizenship, was not determined.



Nor is it necessary to pass upon that question in this instance for the motion may be disposed of upon the inquiry whether it was manifestly the intention of Congress to include such a case as that before us in the words "arising under the patent laws." Now, actions at law for infringement, and suit in equity for infringement, for interference and to obtain patents, are suits which clearly arise under the patent laws, being brought for the purpose of vindicating rights created by those laws, and coming strictly within the avowed purpose of the act, to relieve this court of that burden of litigation which operated to impede the disposition of cases of peculiar gravity and general importance.

We are of opinion that it is reasonable to assume that the attention of Congress was directed to this class of cases, and that the language was used as applicable only to them; and that there is nothing in the objects sought to be attained and the mischiefs sought to be remedied by the act which furnishes foundation for the belief that Congress manifestly intended to place a limitation on the appellate jurisdiction of this court in a case such as this.

Moreover, in those cases, the subject-matter is everything in respect of jurisdiction, and the character of the parties nothing; while here, the character in which the plaintiffs sue and the nature of the case are inseparably blended.

In instituting this suit, the government appeared on behalf of the public, and, as it were, in the exercise of the beneficent function of superintending authority over the public interests, and the rule of construction in such cases is properly regarded as affected by considerations of public policy. It is upon the principle of public policy that the United States have been held not bound by statutes of limitation unless Congress has clearly manifested that they should be so bound. (*United States v. Railway Company*, 118 U. S. 120, 125; *Stanley v. Schwalby*, 147 U. S. 508) and the same rule is applicable to the exercise of the prerogative of *parens patriae* inherent in the supreme power of every State, in respect of which it was observed by Mr. Justice Strong in *Savings Bank v. United States*, 19 Wall. 227, 237, that so much of the royal prerogative as belonged to the King in his position as universal trustee enters as much into the principles of our state as it does into the principles of the British government. Hence it was held in *United States v. Beebe*, 127 U. S. 338, that the United States are not bound by any statute of limitations, nor barred by laches of their officers, in a suit brought by them, as sovereign, to enforce a public right or to assert a public interest.

In *United States v. Telephone Company*, *supra*, it was decided that where a patent for a grant of any kind issued by the

United States has been obtained by fraud, by mistake or by accident, a suit by the United States against the patentee is the proper remedy for relief, and that in this country, where there is no kingly prerogative but where patents for land and inventions are issued by the authority of the government, and by officers appointed for that purpose who may have been imposed upon by fraud or deceit, or may have erred as to their power, or made mistakes in the instrument itself, the appropriate remedy is by proceedings by the United States against the patentee.

We can not impute to Congress the intention of narrowing the appellate jurisdiction of this court in a suit brought by the United States as a sovereign in respect of alleged miscarriage in the exercise of one of its functions as such; deeply concerning the public interests; and not falling within the reason of the limitations of the act.

Motion denied.

Mr. Justice Gray took no part in the consideration and disposition of this motion. [Compare Judicial Code.]

920. NEIDICH v. FOSBENNER, 108 Fed. 266 (C. C. N. Y.)

Coxe, District Judge: \* \* \*

The bill alleges the infringement of letters-patent No. 640,013, for a new and useful improvement in methods of assimilating printed and typewritten work. The defendants demur on the ground that the patent on its face is void for want of patentable novelty. Unless the court is satisfied that by no possibility can the complainant succeed the suit should not be dismissed in this summary manner. It is true that, upon the face of the patent, there is plausibility in the argument that the method covered by the claims involves only simple changes in the printer's art within the knowledge of every skilled workman. But it is also true that the complainant may be able to produce testimony which will convince the court that invention is involved. That this may be done is enough. The demurrer must be overruled upon the following authorities: *New York Belting & Packing Co. v. New Jersey Car-Spring & Rubber Co.*, 137 U. S. 445, 11 Sup. Ct. 193, 34 L. ed. 741; *Ballou v. Edward A. Potter & Co.*, (C. C.) 88 Fed. 786; *Electric Vehicle Co. v. Winton Motor-Carriage Co.*, (C. C.) 104 Fed. 814; *Industries Co. v. Grace*, (C. C.) 52 Fed. 124; *Beer v. Walbridge*, 40 C. C. A. 496, 100 Fed. 465; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 18 C. C. A. 662, 72 Fed. 508; *Bottle Seal Co. v. De La Vergne Bottle & Seal Co.*, (C. C.) 47 Fed. 59; *Krick v. Jansen*, (C. C.) 52 Fed. 823; *Lalance & Grosjean Mfg. Co. v. Mosheim*, (C. C.) 48 Fed. 452; *Lyons v. Drucker*, (C. C. A.) 106 Fed. 416.

The demurrer is overruled. The defendant may answer within 30 days upon paying the costs of the demurrer.

[Compare here and in following Equity Rules promulgated November 4, 1912.]

921. *PAINÉ v. TRASK*, 56 Fed. 233, 5 C. C. A. 497 (1893, First Circuit).\* \* \*

Before Putnam, Circuit Judge, and Nelson and Webb, District Judges.

Putnam, Circuit Judge:

This is a bill in equity, brought by the appellant to protect a patent for an alleged improved automatic regulator for hot-air furnaces. With other defenses is that of an alleged assignment from the complainant to the American Automatic Furnace Regulator Company, said to bear date and to have been recorded in the patent office before this bill was filed. The bill alleges that the complainant was sole owner of the patent from the time of its issue to the time of the filing of the bill. The answer does not specifically meet this allegation; but it closes with a general denial. If this is not sufficient, the only remedy, according to the practice of the federal courts, was by exceptions under the sixty-first equity rule; and so the lack of a sufficient denial of any allegation in the bill did not relieve the complainant from proving the truth of it. Moreover, in this case the parties have fully gone into the matter of title, and waived any possible question of pleading.

The defendant, now the appellee, did not put in evidence the original alleged assignment, nor sufficiently account for his omission to do so. In lieu thereof he put in a duly-certified copy of the patent-office record of the alleged assignment, and this without objection from the complainant, and without any motion to strike it out. At the hearing in this court the appellee claimed that this certified copy has probative force of itself, and makes out a prima facie case of an assignment. He cited, as sustaining this proposition, *Lee v. Blandy*, 1 Bond 361; also found in 2 Fish. Pat. Cas. 89. He might also have cited *Brooks v. Jenkins*, 3 McLean, 432; *Parker v. Haworth*, 4 McLean 370; *Dederick v. Agricultural Co.*, 26 Fed. 763; and *Rob. Pat. § 1040*. *Walker on Patents* (2d Ed., § 495), referring to these decisions, says that they have been generally acquiesced in for more than 20 years, and that few rules of patent law have been more frequently made the basis of action by counsel and by courts than the one which they apparently sustain. The author, however, adds: "But it hardly seems justified by the statute upon which it is based, and may even yet be overthrown by the supreme court."

It will be seen that this rule originated with Judge McLean; and it will also be found that, in the two earlier cases decided by him, he referred to the fact that the statute of 1836 (chapter 357), the then existing patent code, directed (§ 11) that every assignment should be recorded. The terms of the existing statute make no requirement, but leave it to the assignee to record the assignment or not, for protection of his interests, at his option.

Campbell v. Gaslight Co., 119 U. S. 445, 7 Sup. Ct. 278, recognizes the ordinary rules of evidence of the common law in connection with an analogous statute relating to the records of the general land office. The case turned on § 891 of the Revised Statutes, which provides that authenticated copies of records of the general land office shall be "evidence equally with the originals thereof" being by its letter much more favorable to the position of the appellee than anything in any statute touching copies from the patent-office records; yet the supreme court held that the words "evidence equally" were not intended to mean that in all cases a copy should have the same probative force as the original instrument, but that "it should be regarded as of the same class in the grades of evidence as to written and parol and primary and secondary."

Rev. Stat., § 892, which provides for certified copies from the patent office, relates only to records, books, papers, or drawings "belonging to" that office, and letters-patent. If the law required the original assignments to remain on file, and that certified copies should be given of them, a different principle would be involved; but the only thing in this case "belonging to" the patent office is the record, which is itself only secondary evidence. No provision is made for authentication of the genuineness of the instrument to be recorded, as frequent in laws providing for registry, but a forged assignment may be recorded equally with a genuine one. Neither is there any method given by the law, by which any person prejudiced by the registry in the patent office of a spurious instrument, can purge the records. Neither does this registry have the moral protection presumably given to local county and township records through local publicity and notoriety. The proposition made by the appellee, is independent of the support which sometimes comes from the fact that one party or the other to an instrument has continued openly to act under it, or from the credibility given to ancient papers and records; but it states a universal, unqualified claim with reference to all copies of alleged assignments certified from the patent-office records.

It is not, however, necessary that we should determine this point, and we refer to it only for the purpose of making it under-

stood that we can not acquiesce in it without further consideration. The copy was introduced by the defendant into the record, and read by him in the court below without objection, and was connected by him with parol evidence which satisfies this court sufficiently that, on the whole case, he has proven that the complainant made the assignment in question to a veritable person, or corporation, before this suit was commenced. The appellant objects in this court to this copy, because he says proper foundation was not laid for the introduction of secondary evidence, and also for want of proof by the apparent attesting witnesses. The latter objection would not be operative in any court, as an attesting witness is not required for proof of copies. The first objection would have merited attention, if seasonably taken. The rules governing this class of evidence in equity and the practice concerning it, except where there is an order permitting proof of exhibits at the hearing, is well shown in *Wood v. Strickland*, 2 Mer. 461; but these objections were not urged in the court below, and by well-settled principles of practice applicable to appellate courts they can not be raised here in the first instance. *Wasatch Min. Co. v. Crescent Min. Co.*, 148 U. S. 293, 13 Sup. Ct. 600; Rules of the Supreme Court No. 13, 3 Supt. Ct. x.

As this alleged assignment involves only a pure question of fact, which is not of general interest, and not likely to present itself in any other case, and as many of the elements of the proofs on this point are given in the opinion of the learned judge who heard the cause in the circuit court, it is enough for us to state our conclusion.

It appears that at the time the assignment was made the complainant did not have a title, but he acquired it before the filing of the bill in this case. The appellee claims that this operated to support the assignment, and to give it the same effect as though the complainant had had a title when it was made; and this position was not contested by the latter. Therefore we have not found it necessary to consider whether the circumstances of the case are such as to justify the application of the rule invoked in this respect. See *U. S. v. California & O. Land Co.*, 148 U. S. 31, 13 Sup. Ct. 458.

The case contains a suggestion that complainant retained some equitable or joint interest, notwithstanding his assignment was absolute on its face; but we have in the record no proper proofs nor sufficient parties to enable us to take cognizance thereof.

Decree of the circuit court affirmed.

[Compare Nos. 739 and 740.]

922. EDISON ELECTRIC LIGHT CO. v. SAWYER-MAN ELECTRIC CO.,  
53 Fed. 592, 3 C. C. A. 605 (1892, Second Circuit).\* \* \*

The question whether there has been any laches in asserting the patent was considered by the circuit court of appeals upon the appeal from the decree of the circuit court, and that court declared that no case was shown to authorize the refusal of an injunction on any theory of laches or equitable estoppel by reason of undue delay in bringing suit, or acquiescence in known infringement. If the owners of the patent proceeded with due diligence as respects the United States Lighting Company, no other infringers of the patent can be heard to complain with reason that suit was not brought against them upon the patent previous to the adjudication of its validity in the circuit court. It is a matter of notoriety that that litigation was a very expensive and arduous one; and its progress must have been familiar to all those who were extensively interested in having the patent defeated. As regards the present defendant, there are no new facts of importance bearing upon the question of laches to distinguish the case from that shown in the former suit. We see no reason for changing the opinion expressed by this court in the former case, and do not deem it necessary, because the same defense has again been urged upon substantially the same state of facts, to add anything to that opinion. Every one of the manufacturing corporations, the competitors of the Edison Companies, commenced their operations with a knowledge of the existence of the patent in suit. They were controlled by business men of intelligence and experience. Their promoters and managers may have believed, and probably did, that the patent could not be successfully maintained; but they entered upon the business with an understanding of its risks, and of the consequences which would befall them as infringers, if the patent should be sustained. None of them can now be justly heard to say that an injunction which is essential, if not indispensable, to the protection of the owners of the patent and their licensees ought not to be granted because of the great pecuniary loss which may result. If, in consequence of being deprived of the use of the lamps, their investments in other electric apparatus will be greatly depreciated, they must take the consequences.

The users who have supplied themselves with electric lighting plants from the infringers, which required for their operation lamps of the patent, are of course infringers; but those who did so before the decision of the circuit court sustaining the patent, and at a time when judicial decisions in foreign countries interpreting the patent were in conflict, and who are now willing to accept their lamps from the complainants upon

reasonable terms, have much stronger equities than the manufacturing infringers. These equities the court will not disregard; but what would be reasonable terms, if an application were made to the court on behalf of these users, is a question which can only be determined in each case upon its particular circumstances. As to those users, however, who have acquired these plants subsequent to the decision of the circuit court, if they are deprived of the use of the lamps, and as a consequence the value of their plants may be greatly impaired, they must accept the result as a consequence of their own imprudence.

We are not disposed to investigate upon the present case the character of the combination which has been formed under the name of the "General Electric Company." Whether that combination is intended to fetter competition, and is illegal as one in restraint of trade, is a question which we should not undertake to decide upon the evidence before us and in a suit to which it is not a party. The present complainants are entitled by the patent laws to a monopoly, for the term of the patent, of the manufacture and sale of the lamps made under it. The right to this monopoly is the very foundation of the patent system. They do not lose that right merely because they may have joined in a combination with others, holding other patents securing similar monopolies, which combination may, when judicially examined in a proper forum, be held to be unlawful. We do not feel justified in assuming upon the facts before us in the present suit that the use which the complainants propose to make of the injunction—an injunction which seems necessary to secure their monopoly and make their patent fruitful—will be such as to promote any other monopoly. When it shall be made to appear that some one, to whom in fairness and good conscience these complainants should sell their lamps, has been arbitrarily refused them, save upon oppressive and unreasonable terms, it will be time to consider whether the complainants should be allowed to continue in possession of the injunction.

The alleged estoppel seems to be farfetched and shadowy. The history which has been given shows that, before the Sawyer-Man Company was organized, litigation upon the patent in suit and upon the Sawyer-Man patents had commenced; that in 1887 the stock in the Sawyer-Man Company owned by the Thomson-Houston Company was sold to the Consolidated Company, a party to the suits; and that subsequently, in 1888, the Westinghouse Company, an actual party to the litigation, bought that portion of the stock from the Consolidated Company which had been owned by the Thomson-Houston Company. The estoppel lacks the elements which ordinarily create an estoppel in pais, namely, an injury or a harm to one person,

resulting from a reliance upon the acts, conduct, or declarations of another, in which there was an element of bad faith or willful neglect of duty. The history of the connection of the Thomson-Houston Company from 1886 to 1888 with the Consolidated Company, and with the Sawyer-Man Company, the defendant, shows that all these companies knew of the existence of the litigations in which the life of the present patent and of the Sawyer-Man patent was at stake. There can be no charge of concealment or constructive fraud. When the sale and the agreement of 1888 were made, there was no implied obligation upon the Thomson-Houston Company to remain in alliance with the Westinghouse system. The contingency that it might enter upon the manufacture of competing lamps was contemplated. Its union with the Edison interests has neither hastened nor facilitated the application for the present injunction. We perceive no adequate reason from the facts why the complainants should not obtain the ordinary results which attend a complainant's success in a suit in equity for the infringement of a patent.

The injunction order appealed from should be modified so as to cover only lamps made in infringement of the second claim of the patent, the other claims not having been infringed, according to the adjudication of the circuit court or of this court. It should also contain a provision reserving the right to the defendant to move hereafter for the vacation, suspension, or modification of the injunction upon proof of specific instances of refusal on the part of the complainants, or either of them, to supply the lamps of the patent upon terms reasonable, under the circumstances of the particular case, to the owners of electric lighting plants which were installed before the rendition of the interlocutory decree of the circuit court sustaining the validity of the patent.

923. TAYLOR v. SAWYER, 75 Fed. 301, 22 C. C. A. 203 (1896. Third Circuit).\* \* \*

Wales, J.:

In *Kittle v. Hall*, 39 O. G. 707, 29 Fed. 508, it was held that while long acquiescence might defeat a bill for infringement no precedent had been discovered for the dismissal of a bill for so short a period as seven years, and that the defendants had not been misled, but knew of the plaintiff's rights. In *McLean v. Fleming*, 13 O. G. 913, 96 U. S. 245, the Court said:

"Equity courts will not, in general, refuse an injunction on account of delay in seeking relief, where the proof of infringement is clear, even though the delay may be such as to preclude the party from any right to an account for past profits."

To the same effect are the cases of *Menendez v. Holt*, 46 O.



G. 961, 128 U. S. 514, 9 Sup. Ct. 143; Price v. Steel Co., 46 Fed. 107; New York Grape-Sugar Co. v. Buffalo Grape-Sugar Co., 18 Fed. 638; Gilmore v. Anderson, 38 Fed. 846; Brush Electric Co. v. Electric Imp. Co., 45 Fed. 241. In the last-cited case the court remarked that the doctrine of laches is generally applicable to preliminary injunctions only. In Menendez v. Holt, supra, the Court, in discussing the question of laches, said:

"Mere delay or acquiescence can not defeat the remedy by injunction in support of the legal right, unless it has been continued so long, and under such circumstances, as to defeat the right itself. Hence, upon an application to stay waste, relief will not be refused on the ground that, as the defendant had been allowed to cut down half the trees upon the complainant's land, he had acquired by that negligence the right to cut down the remainder [citing Attorney General v. Eastlake, 11 Hare, 205]. \* \* \* Acquiescence, to avail, must be such as to create a new right in the defendant. Where consent by the owner \* \* \* is to be inferred from his knowledge and silence merely, it lasts no longer than the silence from which it springs. It is in reality no more than a revocable license."

The defendant asserts that the complainants are not entitled to an accounting for profits; but the decree of the circuit court orders an accounting only from the date of the defendant's incorporation, from and after which time there were no laches, as complainants had already begun their suit against the Morrison Company. This was sufficient notice to the defendant that the validity of the patent was in litigation, and thus takes away the excuse of ignorance for continuing the infringement. There is no proof of non-user or abandonment by the complainants nor of any act or omission of theirs which could have induced the defendant to believe that it would not be held liable for manufacturing and selling the infringing articles. The evidence falls far short of proving an estoppel or of proving such delay or acquiescence on the part of the complainants as should defeat the present suit. \* \* \* [For this line of cases see also Parts XV, XVII; and for this case more fully see No. 1034.]

**924. TRANSIT DEVELOPMENT CO. v. CHEATHAM ELECTRIC SWITCHING DEVICE CO.,** 194 Fed. 963 (C. C. A.) (1912, Second Circuit, Patent Nos. 612,702 and 917,541).

Before Lacombe, Coxe and Ward, Circuit Judges.  
Lacombe, J.:

\* \* \*

There was such a conflict of testimony (including the experts) touching the main issues as made it the duty of the trial judge to submit to the jury the two fundamental questions of

fact: "Was there invention?" "Was there infringement?" As we pointed out recently in *Heide v. Panoulis*, 188 Fed. 915, 110 C. C. A. 656, when questions of fact are disposed of by the trier of the facts in an equity suit, his decision may be reviewed on appeal. When disposed of by the verdict of a jury, properly instructed, its decisions on those points are not reviewable by the appellate court. The case at bar is like that considered by the Supreme Court in *Bischoff v. Wethered*, 76 U. S. 812, 19 L. ed. 829, where the record contained "much more than a few certified copies of issued patents," which the court would be entirely competent to construe for itself. The only question, therefore, for this court to determine, touching invention and infringement, is whether there was error in the instructions given to the jury or in some refusal to charge as requested by defendants.

\* \* \*

The question of pioneership depends, of course, upon the prior state of the art and the skill of the calling, matters of fact about which there was a conflict of testimony; so the court left it to the jury to decide whether or not the first patent was a pioneer. He gave them proper instructions on that point; which were not excepted to. Their conclusion on such point is final. Upon conflicting proof it is a question for the jury to pass upon whether a patented invention is of a primary character and the patent a "pioneer patent." *Royer v. Schultz Belting Company*, 135 U. S. 319, 10 Sup. Ct. 833, 34 L. ed. 214.

925. *EX PARTE NATIONAL ENAMELING CO.*, 201 U. S. 156, 50 L. ed. 707 (1906).

Statement of the Case.

In March, 1903, the petitioners filed their bill in the circuit court of the United States for the Southern District of New York against the New England Enameling Company, to restrain the further infringement by that company of letters-patent of the United States, No. 527,361, for improvements in enameling metal ware, and to recover damages for past infringement. After answer and proofs the case came on for hearing, and on July 8, 1905, a decree was entered, reciting that nine of the twelve claims in the patent were good and valid, that three were invalid and void by reason of the fact that the patentee was not the original or first inventor or discoverer, that five of the nine valid claims had been infringed by the defendant, but the remaining four had not been. As to the claims held invalid and those found to have been not infringed, it was ordered that the bill of complaint be dismissed. As to the remaining five claims, those held to be infringed, it was ordered that the plain-

tiffs recover the gains, profits, savings and advantages which the defendant had derived by reason of the infringement, and that the case be referred to a master to report the amount thereof, and also that an injunction issue against further infringement. On August 1, 1905, the defendant appealed from said decree to the court of appeals and filed its assignment of errors. On August 8 the plaintiffs also appealed to the circuit court of appeals and assigned as errors the rulings in the decree adverse to them. On January 3, 1906, this cross-appeal of the plaintiffs was dismissed by the court of appeals, on the ground that it had no jurisdiction thereof. Thereupon the plaintiffs filed in this court, this petition for a writ of mandamus commanding the judges of the circuit court of appeals to take jurisdiction of said cross-appeal, and to dispose of it simultaneously with the appeal of the defendant. \* \* \*

Mr. Justice Brewer delivered the opinion of the court.

The decree entered by the circuit court was interlocutory and not final. (*Barnard v. Gibson*, 7 How. 650; *Humiston v. Stainthorp*, 2 Wall. 106, and cases cited in note; *Estey v. Burdett*, 109 U. S. 633, 637; *McGourkey v. Toledo & Ohio Railway Company*, 146 U. S. 536, [in this case is a full discussion of the differences between an interlocutory and a final decree]; *Hohorst v. Hamburg-American Packet Company*, 148 U. S. 262; *Smith v. Vulcan Iron Works*, 165 U. S. 518.)

Plaintiffs brought one suit upon a single patent. The findings of the circuit court that three of the twelve claims were invalid and that the remaining nine were valid, but that four of them had not been infringed by the defendant, did not break this one suit into twelve. They were a guide to the master in his ascertainment of the damages and indicated the scope of the final decree.

In the federal courts no appeal can, as a general rule, be taken, except from a final decree. As said by Mr. Chief Justice Taney in *Forgay v. Conrad*, 6 How. 201, 205:

“In this respect the practice of the United States chancery courts differs from the English practice. For appeals to the House of Lords may be taken from an interlocutory order of the chancellor, which decides a right of property in dispute. \* \* \* But the case is otherwise in the courts of the United States, where the right of appeal is by law limited to final decrees. (See also *McLish v. Roff*, 141 U. S. 661, 665.)”

In the latter case this was held persuasive against extending the right of review given by § 5 of the circuit court of appeals Act of March 3, 1891 (26 U. S. Stat., 826), to other cases than those in which there was a final judgment or decree, al-

though the word "final" is omitted in some of the clauses of the section.

By § 7 of that act, however, an appeal was provided from certain interlocutory orders or decrees. That section has been twice amended. (28 U. S. Stat. 666; 31 U. S. Stat. 660.) As it now stands it reads:

"§ 7. That where, upon a hearing in equity in a district court or in a circuit court, or by a judge thereof in vacation, an injunction shall be granted or continued or a receiver appointed, by an interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this act to the circuit court of appeals, an appeal may be taken from such interlocutory order or decree granting or continuing such injunction or appointing such receiver to the circuit court of appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided, further, that the court below may in its discretion require as a condition of the appeal an additional bond."

It will be noticed that the appeal is allowed from an interlocutory order or decree granting or continuing an injunction, that it must be taken within thirty days, that it is given precedence in the appellate court, that the other proceedings in the lower court are not to be stayed, and that the lower court may require an additional bond. Obviously that which is contemplated is a review of the interlocutory order, and of that only. It was not intended that the cause as a whole should be transferred to the appellate court prior to the final decree. The case, except for the hearing on the appeal from the interlocutory order, is to proceed in the lower court as though no such appeal had been taken, unless otherwise specially ordered. It may be true, as alleged by petitioners, that—

"it is of the utmost importance to all of the parties in said cause that there shall be the speediest possible adjudication by the United States circuit court of appeals as to the validity of all of the claims of the aforesaid letters-patent which are the subject-matter thereof."

But it was not intended by this section to give to patent or other cases in which interlocutory decrees or orders were made any precedence. It is generally true that it is of importance to litigants that their cases be disposed of promptly, but other cases have the same right to early hearing. And the purpose of Congress in this legislation was that there be an immediate review

of the interlocutory proceedings and not an advancement generally over other litigation.

Petitioners rely mainly on *Smith v. Vulcan Iron Works*, 165 U. S. 518. In that case it was held that when an appeal is taken from an interlocutory order granting or continuing an injunction, the whole of the order is taken up, and the appellate court may (if upon an examination of the record as thus presented it is satisfied that the bill is entirely destitute of equity) direct a dismissal, and is not limited to a mere reversal of the order granting or continuing the injunction. Take an ordinary patent case. If an injunction is granted by an interlocutory order and the order is taken on appeal to the circuit court of appeals, and that court is of opinion that the patent is on its face absolutely void, it would be a waste of time and an unnecessary continuance of litigation to simply enter an order setting aside the injunction and remanding the case for further proceedings. The direct and obvious way is to order a dismissal of the case, and thus end the litigation. And such is the scope of the opinion in that case. After noticing the general rule that appeals will not lie until after final decree, and that an order or decree in a patent case granting an injunction and sending the cause to a master for accounting is interlocutory only, and therefore not reviewable on appeal before the final decree in the case, it referred to the provision of § 7, and said, (p. 525):

“The manifest intent of this provision, read in the light of the previous practice in the courts of the United States, contrasted with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been, not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the progress of the cause might seriously affect his interests; but also to save both parties from the expense of further litigation, should the appellate court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it.”

But nowhere in the opinion is it intimated that the plaintiff was entitled to take any cross-appeal or to obtain a final decree in the appellate court. This view of the scope of § 7 was reaffirmed in *Mast, Foos & Co. v. Stover Manufacturing Company*, 177 U. S. 485, 494, 495.

It is suggested that, as to the claims held to be invalid and those held to be valid but not infringed, the bill was dismissed; that thus, in fact, a final decree was entered which entitled the plaintiff to an appeal. *Forgay v. Conrad*, *supra*, and *Hill v. Chicago & Evanston Railroad Company*, 140 U. S. 52, are cited as authorities. In both these cases there were several defendants and the decrees were adjudged final only in respect to cer-

tain of the defendants. In the first the circuit court passed a decree declaring sundry deeds to be fraudulent and void and directing the lands and slaves therein mentioned to be delivered up to the complainant, and also directing one of the defendants named in the decree to pay him \$11,000, and "that the complainant do have execution for the several matters aforesaid in conformity with law and the practice described by the Supreme Court of the United States." The court refused to dismiss the appeal, holding that, while the decree was not final in the strict technical sense of the term, yet in view of the effect of the orders entered and the fact that unless review was granted at once there might be irreparable injury, the decree must be regarded as final to that extent. At the same time it criticised the terms of the decree, said that the final orders should have been delayed until the master's report was received, and added, after its comments upon the procedure below (p. 206):

"These remarks are not made for the purpose of censuring the learned judge by whom this decree was pronounced, but in order to call the attention of the circuit courts to an inconvenient practice into which some of them have sometimes fallen, and which is regarded by this court as altogether inconsistent with the objects and policy of the act of Congress in relation to appeals, and at the same time needlessly burdensome and expensive to the parties concerned, and calculated, by successive appeals, to produce great and unreasonable delays in suits in chancery. For it may well happen that, when the accounts are taken and reported by the master, this case may again come here upon exceptions to his report, allowed or disallowed by the circuit court, and thus two appeals made necessary, when the matters in dispute could more conveniently and speedily, and with less expense have been decided in one."

In the subsequent case of *Beebe v. Russell*, 19 How. 283, in which the rule in reference to the finality of decrees was further considered, it was said, in explanation of the decision in the *Forgay Case*, (p. 287):

"In *Forgay's Case*, it [the question] was made upon the decree given by the court below, and it was adjudged by this court to be final to give this court jurisdiction of it. But it was so, upon the ground that the whole merits of the controversy between the parties had been determined, that execution had been awarded, and that the case had been referred to the master merely for the purpose of adjusting the accounts. The fact is, the order of the court in that case for referring it to a master was peculiar, making it doubtful, if it could in any way control or qualify the antecedent decree of the court upon the whole merits of the controversy, or modify it in any way, except upon a petition for a rehearing."

In *Hill v. Chicago & Evanston Railroad Company*, supra, there had been an order of dismissal in favor of some of defendants, together with a reference to a master of a separable controversy between the plaintiff and other parties, and the court observed, (p. 54):

“But there was no adjudication as to the payment of the amount to be ascertained by the master; that remained unsettled. It was, however, a severable matter from the other subjects of controversy and did not affect their determination. The fact that it was not disposed of did not change the finality of the decree as to the defendants against whom the bill was dismissed; that amount, or to whom made payable, did not concern them. They were no longer parties to the suit for any purpose. The appeal from the subsequent decree did not reinstate them. All the merits of the controversy pending between them and the complainant were disposed of, and could not be again reopened, except on appeal from that decree. As to the other parties, it remained to ascertain the amount of one item and to determine as to its payment.”

But as held in *Hohorst v. Hamburg-American Packet Company*, supra, that rule does not apply to cases where the liability of the defendant is alleged to be joint; and, therefore, can not to a case in which there is but a single defendant.

The rule is discharged, and the application for a writ of mandamus is denied.

926. *MAST v. STOVER*, 177 U. S. 485, 44 L. ed. 856 (1900).\* \* \*

Mr. Justice Brown delivered the opinion of the court.

1. Plaintiff complains of the action of the circuit court of appeals in refusing to follow the opinion of the circuit court of appeals for the eighth circuit in a case of this same plaintiff against the Dempster Mill Manufacturing Company, 82 O. G. 297, 49 U. S. App. 508, and in reversing the order of the circuit court, which, upon the ground of comity, followed the judgment of that court with respect to the validity and scope of the patent. Its contention is, practically, that the circuit court of appeals should have been governed by the prior adjudication of that court, and, so far at least as concerned the interlocutory motion, should have accorded it the same force and dignity as is accorded to judgments of this court. Premising that these considerations can have no application in this court—whose duty it is to review the judgments of all inferior courts, and in case of conflict to decide between them—we think the plaintiff overstates somewhat the claims of comity.

Comity is not a rule of law, but one of practice, convenience, and expediency. It is something more than mere courtesy,

which implies only deference to the opinion of others, since it has a substantial value in securing uniformity of decision, and discouraging repeated litigation of the same question. But its obligation is not imperative. If it were, the indiscreet action of one court might become a precedent, increasing in weight with each successive adjudication, until the whole country was tied down to an unsound principle. Comity persuades; but it does not command. It declares not how a case shall be decided, but how it may with propriety be decided. It recognizes the fact that the primary duty of every court is to dispose of cases according to the law and the facts; in a word, to decide them right. In doing so, the judge is bound to determine them according to his own convictions. If he be clear in those convictions, he should follow them. It is only in cases where, in his own mind, there may be a doubt as to the soundness of his views that comity comes in play and suggests a uniformity of ruling to avoid confusion, until a higher court has settled the law. It demands of no one that he shall abdicate his individual judgment, but only that deference shall be paid to the judgments of other co-ordinate tribunals. Clearly it applies only to questions which have been actually decided, and which arose under the same facts.

The obligation to follow the decisions of other courts in patent cases of course increases in proportion to the number of courts which have passed upon the question, and the concordance of opinion may have been so general as to become a controlling authority. So, too, if a prior adjudication has followed a final hearing upon pleadings and proofs, especially after a protracted litigation, greater weight should be given to it than if it were made upon a motion for a preliminary injunction. These are substantially the views embodied in a number of well considered cases in the circuit courts and circuit courts of appeals. (*Macbeth v. Gillinder*, 54 Fed. 169; *Electric Manufacturing Co. v. Edison Electric Light Co.*, 61 Fed. 834; 18 U. S. App. 637; *Edison Electric Light Co. v. Beacon Vacuum Pump & Electrical Co.*, 54 Fed. 678, and cases cited; *Beach v. Hobbs*, 82 Fed. 916; 63 U. S. App. 626; see, also *Newall v. Wilson*, 2 De Gex. M. & G. 282.)

Comity, however, has no application to questions not considered by the prior court, or, in patent cases, to alleged anticipating devices which were not laid before that court. As to such the action of the court is purely original, though the fact that such anticipating devices were not called to the attention of the prior court is likely to open them to suspicion. It is scarcely necessary to say, however, that when the case reaches this court we should not reverse the action of the court below if



we thought it correct upon the merits, though we were of opinion it had not given sufficient weight to the doctrine of comity.  
\* \* \*

927. THE COLUMBUS WATCH CO. v. ROBBINS, 148 U. S. 266, 37 L. ed. 445 (1893).\* \* \*

Mr. Chief Justice Fuller delivered the opinion of the court:

The record in this case consists of the following certificate, signed on the 10th day of October, 1892, by the judges then holding the circuit court of appeals for the sixth circuit:

“This cause comes before this court by an appeal from the decree of the circuit court of the United States for the eastern division of the southern district of Ohio sustaining the letters-patent of the appellees and declaring that the appellants have infringed said letters-patent and directing the issue of a perpetual injunction and ordering the statement of an account of profits and damages.

“The transcript presented to this court shows that the appeal was taken immediately from said decree before accounting was had. Both parties desire that this court should give a full hearing on the merits of said decree, so far as relate to the validity of the patent and infringement, and should enter a final decree in this court thereon, the parties agreeing between themselves to suspend accounting until the decision of this court can be had. This court, however, can not find that they have, under the 7th section of the act creating United States circuit appellate courts, jurisdiction to grant such a hearing and enter such a final decree as is asked, because said decree of the circuit court is only an interlocutory decree and presents on appeal, under § 7, only the question whether the decree for an injunction, interlocutory in fact, however final in form, was improvidently granted in the legal discretion of the court and involves only incidentally the question of the validity of the patent and the infringement complained of. The circuit court of appeals for the fifth circuit under similar circumstances, after listening to adverse argument, in *Jones v. Munger, etc., Co.*, 50 Fed. 785, held that said § 7 gave jurisdiction to the court, on agreement of parties to render a final decree on the merits of the validity and infringement of the patent involved. As the judgment of this court differs from that of a co-ordinate court, the instruction of the supreme court is respectfully requested upon the question.

“It is therefore ordered that a copy hereof, certified under the seal of the court, be transmitted to the clerk of the Supreme court of the United States.”

By section sixth of the Judiciary Act of March 3, 1891, establishing circuit court of appeals, (26 Stat., 826, c. 517), it is provided that the judgments or decrees of those courts shall be final in certain enumerated classes of cases, and, among them, in all cases arising under the patent laws, but that, in such cases, the circuit court of appeals may certify to—

“the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision. And, thereupon, the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the circuit court of appeals in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.”

And it is also provided, in respect of cases in which the judgments and decrees of the circuit court of appeals are made final, that—

“it shall be competent for the supreme court to require, by certiorari or otherwise, any such case to be certified to the supreme court for its revision and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.”

Thus, in the interest of jurisprudence and uniformity of decision, the supervision of this court, by way of advice or direct revision, is secured. (In re Woods, Petitioner, 143 U. S. 202; Lau Ow Bew, Petitioner, 141 U. S. 583, 144 U. S. 47, 58.)

In order, however, to invoke the exercise of our jurisdiction in the instruction of the circuit courts of appeals as to the proper decision of questions or propositions of law arising in the classes of cases mentioned, it is necessary that such questions or propositions should be clearly and distinctly certified, and that the certificate should show that the instruction of this court as to their proper decision is desired.

It was long ago settled under the statutes authorizing questions upon which two judges of the circuit court were divided in opinion to be certified to this court, that each question so certified must be a distinct point or proposition of law, clearly stated, so that it could be definitely answered, (Perkins v. Hart, 11 Wheat. 237; Sadler v. Hoover, 7 How. 646; Jewell v. Knight, 123 U. S. 426, 432; Fire Ins. Assoc. v. Wickham, 128 U. S. 426); and that if it appeared upon the record that no division of opinion actually existed among the judges of the circuit court, this court would not consider a question as certified even though it were certified in form. (R. R. Company v. White, 101 U. S. 98;

Webster v. Cooper, 10 How. 54; Nesmith v. Sheldon, 6 How. 41.)

We regard the certificate before us as essentially defective. It does not specifically set forth the question or questions to be answered, and apart from that, it does not state that instruction is desired for the proper decision of such question or questions. On the contrary, it appears therefrom that the court had arrived at a conclusion, nothing doubting, (for reasons, we may remark, given in its opinion reported in 52 Fed. Rep. 337), but that, because the circuit court of appeals for another circuit had reached the opposite conclusion, under similar circumstances, the request for instruction is preferred.

While the fact that the circuit court of appeals for one circuit has rendered a different judgment from that of the circuit court of appeals for another, under the same conditions, might furnish ground for a certiorari on proper application, the assertion of the existence of such difference and of the wish that it might be determined by this court is not equivalent to the expression of a desire for instruction as to the proper decision of a specific question or questions requiring determination in the proper disposition of the particular case. The difference can only exist when the courts have actually reached contradictory results, but each must proceed to its own judgment, unless such grave doubts arise as to induce the conviction that this court should be resorted to for their solution in the manner provided for.

As in our judgment this certificate is not in compliance with the statute, we must decline to certify any opinion upon the matters involved, and direct the cause to be dismissed.

928. HOHORST v. THE HAMBURG-AMERICAN CO., 148 U. S. 262, 37 L. ed. 443 (1893).

Mr. Chief Justice Fuller delivered the opinion of the court:

This was a bill filed by Friedrich Hohorst, a citizen of the State of New York—

“against the Hamburg-American Packet Company, a corporation organized and existing under the laws of the Kingdom of Hanover, Empire of Germany, and doing business in the city of New York; Henry R. Kunhardt, Sr., Henry R. Kunhardt, Jr., George H. Diehl, citizens of the United States and residents of the State of New York, and Arend Behrens and William Koesler, citizens of the United States and residents of the State of New Jersey,”—

for infringement of patent, in the Circuit Court of the United States for the Southern District of New York, September 15, 1888. September 17, the subpoena was served on Henry R. Kun-

hardt, Sr., as a defendant, and as general agent of the Hamburg Company.

November 5, 1888, a general appearance for all the defendants was filed, and on December 18, 1888, a demurrer on behalf of the Packet Company, assigning as grounds that the causes of action against the several defendants were distinct and unconnected and hence that the bill was multifarious, and for want of equity. A motion was made by complainant, December 24, to amend, and on January 7, 1889, a motion by defendant to dismiss. On January 28, 1889, leave to amend was granted and the motion to dismiss denied, and, on February 2, 1889, the amendments were made. These consisted in the insertion of the word "jointly" in the allegation of the defendant's infringement, and also of the following allegation:

"Your orator further states that all of the defendants above named are inhabitants of the city and county of New York; that the defendant, the Hamburg American Packet Company, has its principal business office in this country, located in the city and county of New York; that the defendants Henry R. Kunhardt, Sr., Henry R. Kunhardt, Jr., George H. Diehl, Arend Behrens, and William Koester are and during the time of the infringements above set forth were co-partners under the firm name of Kunhardt & Co., and as such co-partners are and were the agents and managers of the business of the Hamburg American Packet Company in this country, and have their principal business office as such located in the city and county of New York, and that the said infringements were committed in the prosecution of such business and all the defendants have co-operated and participated in all the said acts and infringements."

On February 16, 1889, defendant Hamburg Company served notice of final hearing upon the bill of complaint and demurrer, and on February 21, a notice was given of a motion that the appearance entered on behalf of the Hamburg Company be changed from a general appearance into a special appearance, and the service of subpoena made upon that defendant be set aside, and the bill of complaint dismissed as against the company because of lack of jurisdiction of the court over its person.

In April, 1889, an order was granted that unless complainant withdrew his amended complaint as to the defendant company, and stipulated to go to trial as to said defendant on the original bill of complaint the notice of appearance should be, and was thereby amended into a special appearance, and the service of the subpoena set aside and the bill of complaint dismissed as against said company. (38 Fed. 273.)

On April 11, 1889, the notice of appearance was amended accordingly, subpoena set aside and the bill of complaint dismissed

as against the company; whereupon complainant appealed to this Court.

So far as appears from the record, the suit is still pending and undetermined as against the codefendants of the company. We are of opinion, therefore, that this appeal can not be maintained because the decree rendered in favor of the company was not a final decree.

In *United States v. Girault*, 11 How. 22, 32, which was a writ of error to review a judgment rendered by the Circuit Court of the United States in Mississippi in favor of some of the defendants only, in an action on a bond, leaving the suit undisposed of as against one defendant, this Court would not reverse the judgment according to the practice in Mississippi, but dismissed the writ of error; and Mr. Justice Nelson, delivering the opinion, said:

"The practice in this Court, in case the judgment or decree is not final, is to dismiss the writ of error or appeal for want of jurisdiction, and remand it to the court below to be further proceeded in."

*Metcalf's case*, 11 Coke 38, was cited, where it was held that a record of the common pleas could not be removed into the King's Bench before the whole matter was determined in the common pleas, as it was entire and could not be in both courts at the same time; and, also, *Pect v. McGraw*, 21 Wend. 667, wherein Mr. Justice Nelson, then Chief Justice of New York, declared that a case could not be sent up in fragments by a succession of writs of error.

Again in *Holcombe v. McKusick*, 20 How. 552, it was said:

"It is the settled principle of this court, and the same in the King's Bench in England, that the writ will not lie until the whole of the matters in controversy in the suit below are disposed of. The writ itself is conditional, and does not authorize the court below to send up the case, unless all the matters between the parties to the record have been determined."

The same rule is applicable to an appeal, in admiralty. (*Dayton v. United States*, 131 U. S. Appx., LXXX, and in equity; *Frow v. De la Vega*, 15 Wall. 552, 554.) In the latter case it was held that a final decree on the merits can not be made separately against one of several defendants upon a joint charge against all, where the case is still pending as to the others. It is true that there a default had been entered with a decree pro confesso against one of several defendants, and a final decree had been made absolute against him, whereupon the Court proceeded to try the issues made by the answers of the other defendants and dismissed complainant's bill; but this attitude of the case illustrated and required the application of the general rule.

In *Withenbury v. United States*, 5 Wall. 819, it was decided that where a decree in a prize cause disposed of the whole matter in dispute upon a claim filed by particular parties which was final as to them and their rights, and final also so far as the claimants and their rights were concerned as to the United States, it was final; while in *Montgomery v. Anderson*, 21 How. 386, where the district court of the United States sitting in admiralty decreed that a sum of money was due, but the amount to be paid was dependent upon other claims that might be established, it was held that such a decree was not final.

There are cases in equity in which a decree, disposing of every ground of contention between the parties, except as to the ascertainment of an amount in a matter separable from the other subjects of controversy, and relating only to some of the defendants, may be treated as final, though retained for the determination of such severable matter. (*Hill v. Chicago & Evanston R. R. Co.*, 140 U. S. 52.) But this case presents no such aspect. Complainant insisted, by his amended bill, that the alleged liability was joint, and that "all the defendants have co-operated and participated in all the said acts and infringements."

In *Shaw v. Quincy Mining Co.*, 145 U. S. 444, a bill was filed against the mining company and others in the Circuit Court of the United States for the Southern District of New York, and service of subpoena was made upon the secretary of the company. The company appeared specially and moved for an order to set aside the service, which was granted, whereupon complainant applied to this Court by petition for writ of mandamus to the judges of the circuit court to command them to take jurisdiction against the company upon the bill. The ground on which our jurisdiction was invoked was the inadequacy of any other remedy, and it was argued that as the cause could proceed as to the other defendants, no final judgment could be entered upon the order of the circuit court and no appeal taken therefrom.

Under the circumstances this appeal must be dismissed for want of jurisdiction, and it is so ordered.

929. *WANAMAKER v. ENTERPRISE MFG. CO.*, 53 Fed. 791, 3 C. C. A. 672 (1893, Third Circuit).\* \* \*

Before Dallas, Circuit Judge, and Wales and Buffington, District Judges.

Dallas, J.:

This suit was for infringement of claims 1 and 2 of Patent No. 271,398, issued to John G. Baker upon January 30, 1883, for an "improvement in mechanism to cut up plastic or yielding substances." The circuit court decided that the second claim was

not infringed, and therefore the first claim is the only one for consideration here. The defenses were and are that the patent is invalid, and that, even if valid, it is not infringed. This claim had been twice before the Circuit Court for the District of Connecticut, by which its validity was considered—first on motion for preliminary injunction and afterward upon final hearing. On both occasions it was sustained. *Enterprise Mfg. Co. v. Sargent*, 28 Fed. 185, and 34 Fed. 134. The circuit court here was asked to consider the whole subject anew. This it declined to do; but, accepting the prior decision of the circuit court in Connecticut as determinate of the effect of the evidence upon which it had been based, confined its own investigation to the additional evidence introduced in this case. This was precisely accordant with well-settled and approved circuit court practice. *National Cash Register Co. v. American Cash Register Co.*, 53 Fed. 367, decided by this court at this term. That practice, however, is not applicable to this court; and we therefore have independently examined the entire record before us, irrespective of the decision of Judge Shipman, to which we have referred, and in review of the decree now appealed from. This examination has, nevertheless, fully satisfied us that (so far as presently material) both are right, and the two opinions, taken together, so amply sustain the conclusion reached by the court below in this case as to render it wholly unnecessary to add anything in its support.

The decree of the circuit court is affirmed, with costs.

930. *FRASCH v. MOORE*, 211 U. S. 1, 53 L. ed. 65 (1908).\* \* \*

Frasch applied for a patent for an invention of a new and useful improvement in the art of making salt by evaporation of brine. He expressed his alleged invention in six claims, three of which were for the process of removing incrustation of calcium sulfate from brine-heating surfaces, and three of them were for an apparatus for use in the process.

At the time when the application was filed, Rule 41 of the Patent Office did not permit the joinder of claims for process and claims for apparatus in one and the same application. The Examiner required division between the process and apparatus claims, and refused to act upon the merits. An appeal was taken to the examiners-in-chief, but the Examiner refused to forward it. A petition was then filed, asking the Commissioner of Patents to direct that the appeal be heard. The Commissioner held that the Examiner was right in refusing to forward the appeal. From that decision appeal was taken to the court of appeals of the District, which held that it did not have jurisdiction to entertain it. Frasch then filed a petition in this Court for a mandamus, directing the court of appeals to hear and determine the appeal.

which petition was dismissed. (Ex parte Frasch, 192 U. S. 566.)

But in the United States ex rel. Steinmetz v. Allen, 192 U. S. 543, it was held that Rule 41, as applied by the Commissioner, was invalid, and that the remedy for his action was by mandamus in the supreme court of the District to compel the Commissioner to act. Accordingly the proceedings in the present case were resumed in the patent office, and the applicant asked the commissioner to direct that the appeal theretofore taken to the examiners-in-chief be heard by them. The commissioner granted this petition. The primary examiner furnished the required statement and a supplementary statement of the grounds of his decision requiring division. The examiners-in-chief affirmed the decision of the primary examiner—

“requiring a division of these claims for an art and for an independent machine used to perform the art;”

one examiner-in-chief, dissenting, held that division should be required. On appeal to the commissioner, he affirmed the examiner-in-chief in part only; that is to say, he held that process claim No. 1 must be divided from the other process claims and the apparatus claims, but that process claims Nos. 2 and 3 and the apparatus claims Nos. 4, 5 and 6 might be joined in one application. Rehearing was denied, and an appeal was taken to the court of appeals for the District of Columbia, which affirmed the decision of the commissioner of patents, for reasons given at large in an opinion, and directed the clerk of the court to—  
“certify this opinion and proceedings in this court in the premises to the commissioner of patents, according to law.”

An appeal and a writ of error were allowed, the court stating through Mr. Chief Justice Shepard:

“We are inclined to the view that this case is not appealable to the Supreme Court of the United States, but as the question has never been directly decided, so far as we are advised, we will grant the petition in order that the question of the right to appeal in such a case may be directly presented for the determination of the court of last resort.”

The record was filed January 25, 1907, and on February 4, a petition for certiorari.

Mr. Chief Justice Fuller delivered the opinion of the court.

§ 8 of the act of February 9, 1893 (27 Stat., 434, 436, c. 74), provides:

“That any final judgment or decree of the said court of appeals may be re-examined and affirmed, reversed, or modified by the supreme court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the



same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the Supreme Court of the District of Columbia; and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of or an authority exercised under the United States."

The decision of the court of appeals sought to be reviewed in the present case is not final, but merely ended an interlocutory stage of the controversy and sent the applicant back to the patent office to conform to the meaning and effect of the rule on division of claims as construed by the commissioner of patents, and to pursue the application in the form required to allowance or rejection.

Section 780 of the Revised Statutes of the District of Columbia, reads thus:

The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the commissioner of patents, in accordance with the provisions of sections forty-nine hundred and eleven to forty-nine hundred and fifteen, inclusive of Chapter one, Title LX, of the Revised Statutes, "Patents, Trademarks, and Copyrights."

Section 9 of the "Act to establish a court of appeals for the District of Columbia, and for other purposes," approved February 9, 1893 (27 Stat. 434, 436, c. 74) is:

"§ 9. That the determination of appeals from the decision of the commissioner of patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the district of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the commissioner of patents in any interference case may appeal therefrom to said court of appeals."

Thus the special jurisdiction of the district supreme court in patent appeals was transferred to and vested in the court of appeals, and decisions in interference cases were also made appealable, which had not been previously the case. (Rev. Stat., § 4911.) The law applicable is § 4914, Revised Statutes, which provides:

"The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall

be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the patent office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question."

By § 4915 a remedy by bill in equity is given where a patent is refused, and reads as follows:

"§ 4915. Whenever a patent on application is refused, either by the commissioner of patents or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

The final decision referred to is obviously the judicial decision on the bill in equity, while in interference cases and in all others going up from the commissioner to the court of appeals there is no final judgment in the cause, but one interlocutory in its nature and binding only upon the commissioner "to govern the further proceedings in the case." The opinion or decision of the court reviewing the commissioner's decision is not final, because it does not preclude any person interested from contesting the validity of the patent in court, and if the decision of the commissioner grants the patent that is the end of the matter as between the government and the applicant; and if he refuses it and the court of appeals sustains him, that is merely a qualified finality, for, as we have seen, the decision of that court may be challenged generally and a refusal of patent may be reviewed and contested by bill as provided.

The appeal given to the court of appeals of the district from the decision of the commissioner is not, as Mr. Justice Matthews said in *Butterworth v. Hoe*, "the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one in the statutory proceeding under

the patent laws whereby that tribunal is interposed in aid of the patent office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of a patent thus awarded, is nevertheless conclusive upon the patent office itself; for, as the statute declares (Rev. Stat. 4914), 'it shall govern the further proceedings in the case.'" (112 U. S. 60.)

In *Rousseau v. Brown*, 21 D. C. App. 73, 80, 104 O. G. 1122, which was an appeal from the patent office in the matter of an interference between two applications, the court affirmed the decision of the commissioner of patents, ruling against one of the claims on the ground that priority of invention must be awarded to the other claimant, declined to allow a writ of error or appeal, and said, through Chief Justice Alvey:

"There is no final judgment of this court rendered in such cases, nor is there any such judgment required or authorized to be rendered, not even for costs of the appeal. This court is simply required in such cases, after hearing and deciding the points as presented, instead of entering judgment here, to return to the commissioner of patents a certificate of the proceedings and decision of this court, to be entered of record in the patent office, to govern the further proceedings in the case. But it is declared by the statute that no opinion of this court in any such case shall preclude any person interested from the right to contest the validity of any patent that may be granted by the commissioner of patents. (Rev. Stat. U. S., §§ 780, 4914.)

"There is no provision of any statute, within our knowledge, that authorizes a writ of error or an appeal to the Supreme Court of the United States in such case as the present. It would seem clear that the case is not within the purview of § 8 of the act of Congress of February 9, 1893, providing for the establishment of this court. That section only applies to cases where final judgments by this court have been entered, and not to decisions to be made and certified to the patent office, under the special directions of the statute."

We consider these observations as applicable to the present case, and the result is appeal and writ of error dismissed, and certiorari denied.

Mr. Justice White and Mr. Justice McKenna dissent.

[Followed and approved in *Johnson v. Mueser*, 212 U. S. 283, 53 L. ed. 514, 29 S. Ct. 390, 145 O. G. 767.

Compare the remarkable extension of this position to trademark cases in *Union Distilling Co. v. Schneider*, 29 App. D. C. 1, 129 O. G. 2503, 1907 C. D. 613, and *E. C. Atkins & Co. v. Moore*, Com. Pats., 212 U. S. 285, 53 L. ed. 515. See, however, Judicial Code, No. 914a, sec. 250, now abrogating such appeals.]

Mr. Justice Moody did not sit.

[The following under this heading are brief extracts to complete the discussion.]

931. MOORE v. MARSH, 74 U. S. 515, 19 L. ed. 37.

The grantee of territorial right, for a particular district, could not bring an action on the patent in his own name; but the act of Congress having made him a party interested in the patent, it is now equally well settled that he may sue in his own name for invasion of the patent in that territorial district, as no one else is injured by any such infringement.

\* \* \*

Where the patentee has assigned his whole interest, either before or after the patent has issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place; but where the assignment is of an undivided part of the patent, the action should be brought for every infringement committed subsequent to the assignment, in the joint names of the patentee and assignee, as representing the entire interest.

\* \* \*

Correct interpretation of the words "person or persons interested" is, that the words mean the person or persons interested in the patent at the time when the infringement was committed, which is the cause of action for which the damages may be recovered.

932. EXCELSIOR WOODEN PIPE CO. v. ALLEN, 104 Fed. 553, 44 C. C. A. 30.

Nor is a court of equity divested of its power to decree appropriate and final relief from the fact, if it be a fact, that the patentee has conspired with the defendant to infringe the rights of the licensee. \* \* \* The former practice of courts of chancery which required the dismissal of a bill in case of the joinder of complainants whose interests were antagonistic, has given place to a more equitable procedure, which recognizes the power of the court to so arrange the parties to the suit as their interests demand, to make a complainant a defendant, and to decree relief to all parties before it, whether they appear as complainants or defendants, so long as they are all the necessary parties to the controversy.

933. SIEMENS-HALSKE ELECTRIC CO. v. DUNCAN ELEC. MFG. CO., 143 Fed. 157, 73 C. C. A. 375.

The facts recited in the statement of the case satisfy us that the company is simply an incorporation of Duncan. Therefore,

the corporation should be enjoined, just as its officers, directors, and stockholders would be, if, as individuals and without resorting to the corporate form, they were aiding and abetting Duncan in the infringement.

**934. LIVINGSTON v. WOODWORTH**, 15 How. (U. S.) 546, 14 L. ed. 809.

It is true, as a rule of equity pleading, that none should be made parties either as complainants or defendants, who have no interest in the matters in controversy, or which can be affected by the decree. \* \* \* In cases where the want of interest applies, it is equally fatal when applicable to one of several plaintiffs as it is when applicable to one of several defendants. In the former case it is fatal to the whole suit; in the latter it is fatal, if taken in due time, only against the defendant improperly joined. Objection ought to be taken by demurrer, for if not so taken, and the court proceeds to a hearing on the merits it will be disregarded, at least if it does not materially affect the propriety of the decree. In the case before us the objection of misjoinder appears nowhere upon the pleadings, and is urged for the first time after final decree. As to this objection, therefore, it comes too late.

**935. ATHERTON MACH. CO. v. ATWOOD-MORRISON CO.**, 102 Fed. 949, 43 C. C. A. 72.

An averment of title in the complainant must necessarily be made, and is the necessary foundation for all rights asserted or litigated by the complainant. It is an averment without which complainant has no proper standing in court. It matters not whether the title be that of the patentee, derived directly from the grant made by the government, or that of an assignee of the patentee or the assignee of an assignee. In either case it is the statement of a *prima facie* qualification to institute the suit, and such title, whether direct to the patentee, or derivative from him by assignment or assignments, is the creature of the patent law, and not of the common law; and, whether admitted or attacked by the opposing party, the questions raised are raised under the patent laws, and are, therefore, within the meaning of the Revised Statutes of the United States, justiciable in the circuit court.

**936. HART, ETC., MFG. CO. v. ANCHOR ELECTRIC CO.**, 92 Fed. 657, 34 C. C. A. 606.

Some of the defendants further contend that, even if the defendant corporation should be enjoined in this case, no injunction should issue against the other defendants, its officers. En-

tirely apart from the question of the liability of an officer in a corporation, for damages caused by infringements committed by him, on behalf of the corporation, there can be no doubt that in a case like this the officers of the corporation may be enjoined from further infringement.

**937. SINGER MFG. CO. v. CRAMER, 109 Fed. 652, 48 C. C. A. 588.**

[The defendant company plead prior suit as estoppel on the ground that it sustained the expense of the former suit for its agent. Held:] The open dismissal of the Singer Company from that suit upon its own motion was significant of its withdrawal from the litigation, and of its purpose not to be bound by the judgment to be rendered therein.

**938. WESTERN ELECTRIC CO. v. NORTH ELECTRIC CO., 135 Fed. 79, 67 C. C. A. 553.**

With respect to the matter of infringement, the defendants North and Steele are not shown to have been individually guilty of any infringing act. There is therefore no excuse for joining them as parties, unless it be that they were officers of the offending corporation, and this is no excuse. It may be, however, that the complainant mistakenly supposed the officers were active participants in the infringement, and has been disappointed in its proofs. However this may be, the bill was properly dismissed as to them, and so far the decree of the circuit court will be affirmed, with costs of both courts to those defendants.

**939. DRAPER CO. v. AMERICAN LOOM CO., 161 Fed. 728, 88 C. C. A. 588.**

The bill prays, as usual, an injunction and an account against both the American Loom Company and the officer referred to. The circuit court dismissed the bill, and the complainant appealed to us. So far as the officer of the respondent corporation is concerned, the case is not brought within the rule established by us in *National Cash Register Co. v. Leland*, 94 Fed. 502, 509, 37 C. C. A. 372, et seq. Therefore, as to him, the final decree will provide that the bill be dismissed; and as he has been brought in as one against whom substantial relief is asked, he will recover his costs in the circuit court.

**940. CLARK v. WOOSTER, 119 U. S. 322, 30 L. ed. 392, 7 Sup. Ct. 217.**

[The bill was filed 15 days before the expiration of the patent.] The general allegations of the bill were sufficiently comprehensive to meet such a case. But even without that, if the case was one for equitable relief when the suit was instituted,

the mere fact that the ground for such relief expired by the expiration of the patent would not take away the jurisdiction and preclude the court from proceedings to grant the incidental relief which belongs to cases of that sort. This has often been done in patent causes, and a large number of cases may be cited to that effect; and there is nothing in the decision in *Root v. R. Co.*, 105 U. S. 189, to the contrary.

**941. BEEDLE v. BENNETT**, 122 U. S. 71, 30 L. ed. 1074, 7 Sup. Ct. 1090.

As the patent was in force at the time the bill was filed, and the complainants were entitled to a preliminary injunction at that time, the jurisdiction of the court is not defeated by the expiration of the patent by lapse of time before final decree. There is nothing in the case of *Root v. R. Co.*, 105 U. S. 189, to sustain the objection made by the appellant on this account. See, also, *Clark v. Wooster*, 119 U. S. 322, 325, and cases there cited.

**942. UNITED STATES MITIS CO. v. DETROIT STEEL, ETC., CO.**, 122 Fed. 863, 59 C. C. A. 589.

The bill was filed nearly three months before the expiration of the patent, and contained prayers for a preliminary and a perpetual injunction. The patent had yet a month to run after the defendant was required to answer under the rules. It was therefore clearly within the power of the court, when the suit was begun, not only, upon proper proof, to grant a preliminary injunction, but, either by a decree pro confesso, in case of default, or upon the bill and answer, if an answer should be filed within rules, to dispose of the case finally, by awarding a permanent injunction, before the expiration of the patent. The conditions at the time the bill was filed thus availing to give the court jurisdiction, both for the purpose of a preliminary injunction and of a permanent decree, during the life of the patent, such jurisdiction could not be defeated by subsequent happenings, whether due to the delay of the defendant or the contingencies of litigation.

**943. GRAY v. GRIMBERG**, 159 Fed. 138, 86 C. C. A. 328.

Complainant's counsel contends before this court, however, that the defendants, by filing a general appearance in the cause without objection to the jurisdiction of the court, waived their right to object to being sued in the eastern district of Pennsylvania, and hence that, as the action is within the general jurisdiction of the circuit court, the complainant, because of such waiver, may show in support of his bill acts of infringement

committed outside of such district. If that be admitted, however, as a general proposition, it does not relieve the complainant in this case of the burden of proving that the defendants have committed infringing acts within said district, since that was substantially the issue tendered by the bill, denied by the answer, and to the maintenance of which the proofs were directed.

**944. RICHARDSON v. OSBORNE, ETC., CO., 93 Fed. 828, 36 C. C. A. 610.**

This suit was brought about 2½ months before the expiration of the patent, and after the extensive and expensive manufacture of Appleby machines had progressed at an increasingly active rate, within the complainant's knowledge and observation for about 14 years. \* \* \* All the adjudged cases in regard to laches proceed upon the inequitable conduct of the complainant, and the inequity which would result if the stale claim was permitted to be enforced, and the judgments adverse to the complainant are founded upon the fact that the party to whom laches is imputed has all the time "knowledge of his rights, and an ample opportunity to establish them in the proper forum; that, by reason of his delay, the adverse party has good reason to believe that the alleged rights are worthless or have been abandoned; and that, because of the change in conditions or relations during this period of delay, it would be an injustice to the latter to permit him to now assert them." A further reference to the decided cases is unnecessary, as Judge Coxe has cited many of them in his opinion (82 Fed. 95).

**945. ATHERTON MACH. CO. v. ATWOOD-MORRISON CO., 102 Fed. 949, 43 C. C. A. 72.**

It, however, took another course that was clearly open to it to take, and that was to state the defense of this pretended assignment by way of anticipation in the bill, in order that it might make special answer thereto, and thus avoid the disadvantageous position in which it would be placed by the forty-fifth equity rule, by which special replications are prohibited. If the bill sets forth a case within the jurisdiction of the court, the jurisdiction can not be ousted by the anticipation and denial of possible defenses that may or may not be made. Even if the title of complainant, as set forth in the bill, were put in issue by plea or answer, the question would still be one arising under the patent laws of the United States. Such an issue would be incidental and collateral to the main purpose of the suit. In this case the patentee and original assignor is not a party to the suit, and the suit could not, therefore, be said to be upon the contract



with him. This is not a suit to enforce a contract or to avoid one, but is a claim of ownership under the laws of the United States, which is properly justiciable in the federal circuit courts.

**946. GAMEWELL FIRE ALARM TEL. CO. v. MUNICIPAL SIGNAL CO.,**  
61 Fed. 208, 9 C. C. A. 450.

Pending the appeal and before argument of the cause in this court, the letters-patent in suit expired, and with that expiration the interlocutory injunction appealed from terminated. There is, therefore, nothing remaining for a judgment of this court to act upon. In this condition of the cause the court will no further consider whether the injunction was or was not properly granted, but will dismiss the appeal.

**947. HUBBELL v. UNITED STATES,** 171 U. S. 203, 43 L. ed. 136, 18 Sup. Ct. 828.

As the prior action was between the same parties, and was based in part, at least, and principally, upon the same patent, it would appear that the judgment of the court dismissing the petition would operate as a complete estoppel to the present suit, unless the proceedings subsequent to the judgment in the former suit in some way deprived that judgment of its force and effect as *res judicata*.

\* \* \*

\*the patentee can not bring suit against an infringer upon a certain state of facts, and after a dismissal of his action, bring another suit against the same party upon the same state of facts, and recover upon a different theory. The judgment in the first action is a complete estoppel in favor of the successful party in the subsequent action upon the same state of facts.

**948. DUPLEX PRINTING PRESS CO. v. CAMPBELL PRINTING PRESS,**  
**ETC., CO.,** 69 Fed. 250, 16 C. C. A. 220. (Sixth Circuit).

It has been decided in this court, and in the courts of appeals of the second and seventh circuits, that an adjudication of another circuit court than that whose action is being considered, finding the validity of the patent and its infringement, is a sufficient ground, not only in the circuit court for an order granting a preliminary injunction, but also in the appellate court for affirming such an order.

**949. AMERICAN STOVE CO. v. CLEVELAND FOUNDRY CO.,** 158 Fed. 978, 86 C. C. A. 182.

The defendants in the cases before us are other persons than the defendant in the former case, and of course are not concluded

by the judgment in that case. But it must be expected that we should adhere to our former opinion upon a record substantially the same.

**950. NEW YORK FILTER CO. v. NIAGARA FALLS WATERWORKS CO.,**  
80 Fed. 924, 26 C. C. A. 252.

Under such circumstances, where a new defense is interposed, the evidence to support it must be so cogent and persuasive as to impress the court with the conviction that, if it had been presented and considered in the former case, it would probably have availed to a contrary conclusion.

**951. STANDARD ELEVATOR CO. v. CRANE ELEVATOR CO.,** 76 Fed. 767, 22 C. C. A. 549.

The general rule that a court of review may, whether the adjudication appealed from be interlocutory or final, direct the court of original jurisdiction to enter whatever decree ought to have been entered in the first instance, as in *LeGuen v. Gouverneur*, 1 Johns, Cas. 436; *Richmond v. Atwood*, 2 C. C. A. 596, 52 Fed. 10; *Bissell Carpet Sweeper Co. v. Goshen Sweeper Co.*, 19 C. C. A. 25, 72 Fed. 545; and *Green v. Mills*, 16 C. C. A. 516, 69 Fed. 852, the opinion in the last named case being by Chief Justice Fuller,—need not be dwelt on.

**952. THOMSON v. WOOSTER,** 114 U. S. 104, 29 L. ed. 105, 5 Sup. Ct. 788

The bill, we have seen, was taken *pro confesso*, and a decree *pro confesso* was regularly entered up. \* \* \* The defendants are concluded by that decree, so far at least as it is supported by the allegations of the bill, taking the same to be true. Being carefully based on these allegations, and not extending beyond them, it cannot now be questioned by the defendants unless it is shown to be erroneous by other statements contained in the bill itself. A confession of facts properly pleaded dispenses with proof of those facts, and is as effective for the purposes of the suit as if the facts were proved; and a decree *pro confesso* regards the statements of the bill as confessed.

**953. GRANT v. RAYMOND,** 6 Pet. (U. S.) 218, 8 L. ed. 376.

Courts did not, perhaps, at first distinguish clearly between a defense which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the Court to enter a judgment not only for the defendant in the particular case, but one which declared the patent to be void. This distinction is now well settled.

**954. WASHINGTON, ETC., PACKET CO. v. SICKLES, 65 U. S. 333, 16 L. ed. 650.**

This court described the rule in *Aspden v. Nixon*, 4 How. 467, in such cases to be, that a judgment or decree set up as a bar by plea, or relied on as evidence by way of estoppel, must have been made by a court of competent jurisdiction upon the same subject-matter, between the same parties for the same purpose.

**955. RUSSELL v. PLACE, 94 U. S. 606, 24 L. ed. 214.**

It is undoubtedly settled law that a judgment of a court of competent jurisdiction, upon a question directly involved in one suit, is conclusive as to that question in another suit between the same parties. But to this operation of the judgment it must appear, either upon the face of the record or be shown by extrinsic evidence, that the precise question was raised and determined in the former suit. If there be any uncertainty on this head in the record—as, for example: if it appear that several distinct matters may have been litigated, upon one or more of which the judgment may have passed, without indicating which of them was thus litigated, and upon which the judgment was rendered—the whole subject-matter of the action will be at large and open to a new contention, unless this uncertainty be removed by extrinsic evidence.

**956. CRAMER v. SINGER MFG. CO., 147 Fed. 917, 78 C. C. A. 53.**

The Supreme Court had ordered a new trial. The Supreme Court having thus held, upon a consideration of the written instruments themselves, that the Cramer invention was not of a pioneer character, and that the alleged infringing device is essentially different in construction from that of Cramer, there was nothing left for the court below to do on the last trial of the case but to follow the decision of the Supreme Court.

**957. KINLOCH TEL. CO. v. WESTERN ELECTRIC CO., 113 Fed. 659, 51 C. C. A. 369.**

Again, the court below has considered this question in the light of the state of the art, and of the conflicting testimony of the witnesses, and has decided that Seeley's combination was an invention. This conclusion is presumptively correct, and ought not to be reversed unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the facts by the circuit court.

958. **TORREY et al. v. HANCOCK**, 184 Fed. 61, 107 C. C. A. 79.

To avoid the defense that the latter was an anticipation of the invention of the patent, the complainant undertook to carry the Hardy invention back to May or June, 1894, and to connect Hardy with the box of the B-6 plow as its inventor. Without commenting upon the evidence produced for that purpose except to observe that Hardy himself, who was available to the complainant, was not called as a witness on this point, we content ourselves by saying that the proof is too contradictory, vague and general to satisfy our minds. The burden was on complainant to do so by satisfactory and convincing proof. *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 11 Sup. Ct. 846, 35 L. ed. 521; *Rogers v. Fitch*, 27 C. C. A. 23, 81 Fed. 959; *Brooks v. Sacks*, 26 C. C. A. 456, 81 Fed. 403; *Eastern Paper Bag Co. v. Continental Paper Bag Co.*, (C. C.) 142 Fed. 479; *Kraatz v. Tieman*, (C. C.) 79 Fed. 322, and cases cited.

Whether he knew it in fact or not he is conclusively presumed to have been entirely familiar with all the prior art as disclosed either by patents or prior devices; and the originality of his accomplishment must be determined in the light of this presumption. *Voigtmann v. Weis & Ridge Cornice Co.*, 78 C. C. A. 538, 148 Fed. 848, 851, and cases cited.

959. **THOMSON-HOUSTON ELECTRIC CO. v. OHIO BRASS CO.**, 80 Fed. 712, 26 C. C. A. 107.

Questions on appeals of this character are ordinarily to be treated in this court from the standpoint from which they were viewed by the circuit court, and the decision on the merits by a circuit court of another circuit, sustaining the patent, is therefore usually of controlling weight here, as it should be in the court below.

960. **BEACH v. HOBBS**, 92 Fed. 146, 34 C. C. A. 248.

Although the defendants in this case are not the same, or in privity with the defendants in the other cases, we think, as a general rule, and especially in patent cases, we should follow the decision of the circuit court of appeals, of another circuit upon final hearing with respect to the issues determined, if based upon substantially the same state of facts, unless it should clearly appear that there was manifest error.

961. **WESTINGHOUSE ELECTRIC, ETC., CO. v. STANLEY INSTRUMENT CO.**, 133 Fed. 167, 68 C. C. A. 523.

[Speaking of following decisions of circuit courts of appeals.]  
We have especially shown the propriety of this with regard

to decisions touching letters patent for inventions in *Beach v. Hobbs*, 92 Fed. 146, 147, 34 C. C. A. 248; *Hatch v. Electric, etc., Co.*, 100 Fed. 975. The Supreme Court laid down a like practical rule in *Hobbs v. Beach*, 180 U. S. 383. In the present case, however, while the Circuit Court might well have felt constrained to follow the result of the Circuit Court of Appeals for the Second Circuit, the body of prior judicial decisions is of such an inharmonious character that we may well make an independent investigation based on the evidence before us.

**962. ECAUBERT v. APPLETON**, 67 Fed. 917, 15 C. C. A. 73.

The equity rule, apart from statutory or code provisions, is not the same with respect to the effect of assignments *pendente lite* by plaintiff and by defendant. "An assignment by a defendant of his interest in a litigation does not necessarily defeat a suit. The assignee may, at his own election, come in by an appropriate application, and make himself a party, so as to assume the burden of the litigation in his own name, or he may act in the name of his assignor." *Ex parte Railroad Co.*, 95 U. S. 221. If a sole plaintiff, suing in his own right, assigns his whole interest to another, he is no longer able to prosecute the suit, because he is without interest in the litigation. *Story Eq. Pl.*, § 348; *Hoxie v. Carr*, 1 Sumn. 173; *Fed. Cas. No. 6802*; *Ross v. City of Fort Wayne*, 11 C. C. A. 288, 63 Fed. 466. But this does not mean that the bill must be dismissed. The effect of the assignment is stated by Judge Story not to be "necessarily a destruction of the suit, like an abatement at law, where a judgment *quod cassetur* is entered. It is merely an interruption to the suit, suspending its progress until the new parties are brought before the court, and if this is not done at a proper time the court will dismiss the suit."

**963. ILLINOIS CENT. R. R. CO. v. TURRILL**, 110 U. S. 301, 28 L. ed. 154, 4 Sup. Ct. 5.

Since the present appeals were taken, the patentee has died, and the appellants now suggest that the causes of action do not survive, and the suits cannot be further prosecuted in the name of the legal representatives of the decedent. As to this, it is sufficient, to say that what was called by Chief Justice Marshall, in *Gordon v. Ogden*, 3 Pet. 35, "the silent practice of the court," has always been the other way. It is every day practice to revive such suits, and the books are full of cases in which this has been silently done, no one apparently entertaining a doubt of its propriety.

964. **EVANS v. SUESS, ETC., GLASS CO.**, 83 Fed. 706, 28 C. C. A. 24.

An assignment of error which is predicated upon the opinion of the court or upon a reason given by the court for its ruling or decree, is not available \* \* \* It is something done by the court—a ruling, judgment, order or decree—and not a reason therefor, which may be assigned as error. A sufficient assignment in this case would have been simply that the court erred in dismissing the bill.

965. **WESSEL v. UNITED MATTRESS MACH. CO.**, 139 Fed. 11, 71 C. C. A. 423.

The first assignment is that “the court erred in not dismissing the bill of complaint,” and it is said it is too general. But if this be so, we think the error is plain, and that we may, in the exercise of our discretion, and ought to, notice it. This defense was distinctly raised by the answer, the issue is vital to the merits of the controversy, and the case cannot be rightly decided without adverting to it.

966. **MINNESOTA, ETC., PLOW CO., v. DOWAGIAC MFG. Co.**, 126 Fed. 746, 61 C. C. A. 352.

That decree allowed an injunction, and for that reason the defendants had a right to review it by appeal, and this court had jurisdiction to consider and determine upon that appeal what kind of a decree ought to be rendered. The complainant had no right to maintain a cross-appeal, because no injunction was granted against it, and the decree was not final.

967. **BISSELL CARPET-SWEEPER CO. v. GOSHEN SWEEPER CO.**, 72 Fed. 545, 19 C. C. A. 25.

The injunction decree appealed from was not a mere preliminary injunction granted in the exercise of the discretion of the circuit court. The case had been fully prepared by both parties. It came on regularly to be heard on the merits and was so heard. The court was obliged to decide, and did decide—First, that the complainant’s patent was valid and infringed. Upon this basis the court awarded, as it was bound to do, a perpetual injunction and an accounting. Under the rule of the supreme court as to an appealable final decree, this was not one, although the merits had been determined and nothing remained to be done except to ascertain the damages.

968. **STANDARD ELEVATOR CO. v. CRANE ELEVATOR CO.**, 76 Fed. 767, 22 C. C. A. 549.

The "interlocutory order or decree" made appealable by amended section 7 must be one wherein the court grants, continues, refuses, dissolves, or refuses to dissolve an injunction. The state of the record or progress of the cause must be such, when said appealable "interlocutory order or decree" is entered, that a "final decree" upon the matter with which said "interlocutory order or decree" has to do may yet be made. The contrast suggested by the words "interlocutory order or decree" and "final decree" as used in the first paragraph of amended section 7, is between a decree which is preliminary to a hearing on the merits, and hence discretionary in the court, and one which follows a hearing on the merits, and is hence final, conclusive, and as of right in the prevailing party; between a decree which is meant to preserve the subject-matter of the litigation, or prevent irreparable injury, till a hearing on the merits can be had, and a decree which follows the hearing on the merits, and ultimately determines the rights of the litigants. The "interlocutory order or decree" made appealable by amended section 7 must be one which leaves the cause pending on the issues in the court of original jurisdiction.

969. **RICHMOND v. ATWOOD**, 52 Fed. 10, 2 C. C. A. 596.

The record before us is complete. Everything is here for our consideration which was before the court below. We must go to the full merits, as shown by the record, in order to determine whether the interlocutory decree for a perpetual injunction is founded in error, and, if we determine the property right adversely to the complainant the injunction should be dissolved; and no sufficient reason has been suggested why the accounting—to which the complainant is not entitled, and, which would be an evasion of a right, and therefore, inequitable and improper, under our view of the case—should proceed.

970. **MARDEN v. CAMPBELL, ETC., MFG. CO.**, 67 Fed. 809, 15 C. C. A. 26.

The rule is one of equitable convenience that when the whole record touching the decree so far as it supports the injunction comes up before the court of appeals, or can come there, so that the court has before it everything in this respect which the circuit court had or which the court of appeals would have on an appeal from a final decree, the court will go fully into the merits of the appeal.

**971. LIBRARY BUREAU v. YAWMAN, ETC., MFG. CO.,** 147 Fed. 245, 77 C. C. A. 387.

The interlocutory decree held one of the claims of the patent valid and infringed, and the other claims invalid or not infringed, and the complainant appealed from so much thereof as related to the claims which were adjudged invalid or not infringed. Thereupon the respondent below, now the appellee, filed a motion to dismiss on the ground that the appeal was premature. The respondent below took an appeal from so much of the interlocutory decree as adjudged one of the claims valid and infringed. The motion to dismiss this appeal must be allowed on the authority of our decision in *Marden v. Campbell*, 67 Fed. 809; \* \* \* and also *Ex parte National Enameling*, 201 U. S. 156.

**972. DONALLAN v. TANNAGE PATENT CO.,** 79 Fed. 385, 24 C. C. A. 647.

Where, after a hearing, a cause is disposed of by the court on appeal, for some reason not touching the merits, it is now well settled that the judgment should usually show that it is without prejudice. So, on his own motion to dismiss, an appellant may sometimes show inadvertence or mistake or some other special reason which may entitle him to equitable consideration and a special order. But we have no suggestion of any such exceptional matter here. We have no judicial knowledge of anything except what we have stated, and that there has been no hearing by us on the merits. Whether, under our expressions in *Game-well Fire-Alarm Telegraph Co. v. Municipal Signal Co.*, 9 C. C. A. 450, 61 Fed. 208, and in *Marden v. Mfg. Co.*, 15 C. C. A. 26, 67 Fed. 809, the appellant is not, in any event, sure of all he desires to reserve, is for him to consider. As he moves to dismiss his appeal of his own volition, we have no occasion whatever to aid him, under the circumstances of the case, either by any special order, or by any expressions of opinion.

**973. CAMPBELL v. HAVERILL,** 155 U. S. 610, 39 L. ed. 280, 15 Sup. Ct. 217.

Where a party upon a trial excepts to a ruling of the court, but does not stand upon such exception, and acquiesces in the ruling and elects to proceed with the trial, he thereby waives his exception.

**974. AMERICAN SALES BOOK CO. v. BULLIVANT,** 117 Fed. 255, 54 C. C. A. 287.

Where the parties consent that the case be tried before a judge or referee, the only question presented by the writ of error



is whether there is any error of law in the judgment upon the facts as found by the judge or referee. The court's findings upon questions of fact are not subject to review in the appellate court if there is any legal evidence upon which such findings could be made.

**975. CONSOLIDATED CAR HEATING CO. v. WEST END ST. RY. CO.,**  
85 Fed. 662, 29 C. C. A. 386.

Orders, relating to the conduct of a trial and to amendments adjusting the parties to a controversy are generally treated as orders made in the exercise of discretion, and not subject to exception and review. In an equity case, however, where the appeal brings up questions of law and of fact, the court of review may doubtless examine to see whether the case, as presented is, either upon the law, the facts, or the pleadings, an inequitable case; and if, for any reason, it so appears, relief may and should be withheld.

**976. EXCELSIOR WOODEN PIPE CO. v. SEATTLE,** 117 Fed. 140, 55 C. C. A. 156.

And as a patentee may be joined as a co-complainant against his consent originally, no good reason is perceived why he may not be so retained for the protection of the rights of his licensee after judgment once rendered and the cause remanded for further proceedings. The patentee may be content with a decree against him; but when his co-complainant is not, and has the right of appeal, the doctrine of summons and severance may be invoked, and upon the refusal of the patentee to join in the appeal after being duly notified to do so, the appeal of his licensee may be allowed upon the entry of such refusal of record, the judgment remaining conclusive as to the party refusing.

**977. BOESCH v. GRAFF,** 133 U. S. 697, 33 L. ed, 787, 10 Sup. Ct, 378.

The refusal of the circuit court to grant a rehearing is not open to consideration in this court.

**978. ECAUBERT v. APPLETON,** 67 Fed. 917, 15 C. C. A. 73.

The fact of the assignment of the Hofmann patent pendente lite, and of all rights thereunder to any claims for profits or damages, was not known to the circuit court. The defendant definitely learned of this assignment on Nov. 28, 1894, and thereafter, and before the argument upon the appeal, moved this court to remand the case to the circuit court with directions to dismiss the bill, but without prejudice to the rights of the assignee to apply for leave to file an original bill in the nature of a sup-

plemental bill. This motion was properly denied. A peremptory dismissal of the bill, as will be seen hereafter, was not permissible; and furthermore, while Appleton and others were complainants, Ecaubert was seeking affirmative relief against them by his cross bill, and his right to relief, if any he had, could not be injuriously affected by the complainant's assignment. If the court should decree adversely to the validity of the Hofmann patent, its assignees would be bound by the decree, because, irrespective of the question whether they had become the actual parties, they, being assignees were charged with notice of the suit, and bound by its results. Thus, where a plaintiff—who, as owner of a patent, had brought suit for infringement and had assigned his interest in the patent *pendente lite*—asked the court to dismiss his bill, after an answer praying for affirmative relief, it was held that a possible right in the defendant to have a decree in his favor could not be defeated by such an assignment and by permission to dismiss the bill.

979. HEATON, ETC., BUTTON-FASTENER CO. v. SCHLOCHTERMEYER, 72 Fed. 520, 18 C. C. A. 674.

It will be observed that the learned judge in the court below was able to point out instances of similar devices within his personal observation of a kind necessarily within common knowledge. Herein is the distinction between this case and the *Fibre-Chamois Cases* (just decided) 72 Fed. 508, 516. [Patents Nos. 324,053 and 451,070 held void on demurrer.]

980. MILNER SEATING CO. v. YESBERA, 111 Fed. 386, 49 C. C. A. 397.

We think the court erred in holding upon demurrer that the patent was void upon its face. It may be admitted that the invention is one of narrow limitations, but we are not prepared to hold that in the circumstances, which may be susceptible of proof, the patent should be held void in the absence of any anticipation, and supported, as it is possible it may be, by evidence that it fulfills a useful purpose, and has been extensively adopted by the public in practical use, and further supported by the presumption of validity arising from the allowance of the patent by the patent office, the force of which presumption is augmented by the fact that there was a serious contest in the office. \* \* \* It is undoubtedly established law that the court may, in a clear case, dismiss upon demurrer, a bill. \* \* \* But this court has on former occasions in substance said that this ought only to be done when there is no room for thinking that any evidence could be adduced which would, if put into the case, alter the clear conviction of the court. [Compare Equity Rules of November 4, 1912.]

981. THOMAS v. ST. LOUIS, ETC., R. CO., 149 Fed. 753, 79 C. C. A. 89.

There is nothing new in this device. \* \* \* This is a matter of such common knowledge that the court below took judicial notice of it, and properly held the patent void on demurrer for lack of novelty. The fact that the action was one at law did not place the initial pleading beyond the reach of the demurrer.

982. POWDER v. POWDER, 98 U. S. 126, 25 L. ed. 77.

The main defense relied on by the counsel of the defense, on the demurrer is, that it is apparent that the reissued patents numbered 4818 and 4819 are not for the same invention as that which was described in the original letters patent numbered 50617 for a portion of which they purport to be reissues.

\* \* \*

Since, therefore, the reissues in question are not for the same invention for which the original patent was granted, it follows that they are void; and the bill must be dismissed so far as relates to the said reissued patents numbered respectively 4818 and 4819.

As nothing is shown, however, in the statements of the bill, which affects the validity of the third party sued on, the bill should not have been dismissed as a whole, but only as to the said reissues 4818 and 4819.

983. FOWLER v. NEW YORK, 121 Fed. 747, 58 C. C. A. 113.

There can no longer be a doubt that where, in an infringement suit, profert of the patent is made in language similar to that quoted, supra, the patent is regarded as a part of the bill and will be examined on demurrer.

984. AMERICAN CARAMEL CO. v. MILLS BROS., 162 Fed. 147.

Among the prayers of the bill was one that the infringing machines should be delivered up to be destroyed. \* \* \* This was an unusual prayer, \* \* \* although, of course, not an unwarranted one, if the circumstances called for it. \* \* \* It was only, however, by inadvertence that it was sanctioned here; and, application having been made to reform the mandate so as to exclude this relief, it will be recalled and corrected accordingly.

985. UNITED STATES v. HARVEY STEEL CO., 196 U. S. 310, 49 L. ed. 492.

A plea of that condition, to satisfy the words "in case it should at any time be judicially decided" that the patent was