

cense; it being supposed that certain other digesters for which the predecessor of the West Virginia Company had already paid had been discontinued. For that reason the rate of license fee in this case is exceptional and may be disregarded.

Upon the whole record we conclude that 86 cents should be accepted as the lowest unit of charge. If, however, a mathematical calculation from any of the figures in the table will show that some lower unit was charged—disregarding the first eight, the International Paper Company and the West Virginia Company—that rate should be accepted as the unit for calculating the damages.

It is contended by defendant that the master disbelieved Russell, and held that his testimony, being uncorroborated, proved nothing. We do not so read the report. The master does find facts which are testified to only by the witness. But he did not find that there was any uniform rate, saying that had the complainant introduced the testimony of licensees and books of the company the evidence “would have been more convincing to the master.”

In the original suit a license to the High Falls Company in 1894 was put in evidence, which included a second patent owned by complainant and called the Jurishina patent. This was some time prior to defendant's infringement. The license to the International Paper Company was put in before the master. It is dated February 4, 1899, and includes the Jurishina patent “and also any other patent or patents relating to the lining digesters with cement tile or bricks that it may (hereafter) acquire.” It was granted, as we have seen, upon compromise of the claim that the International Company had succeeded to all William A. Russell's interests. From these two isolated instances apparently the Circuit Court inferred that the licenses granted by complainant “in nearly every instance, if not in all instances, covered and granted the right to use the processes and products described in both patents.” We think the inference is not warranted by the facts in proof. There is nothing in the testimony to show that the licenses generally included both patents. The master did not find that they did. He merely held that these two licenses which did include the Jurishina patent could not be taken into consideration towards showing the establishment of a fixed license fee.

We do not find sufficient in the evidence to support the contention of complainant that the damages should be trebled.

The decree is reversed with costs of this appeal and the cause remanded with instructions to find damages in favor of complainant on the basis of 86 cents (or such lower sum as the present record discloses), with interest from the date of commencement of the suit, and all costs of the accounting.

1075a. *TOPLIFF v. TOPLIFF*, 145 U. S. 156, 36 L. ed. 658, 12 Sup. Ct. 825.

4. Defendant also assigns as error the allowance by the master of damages for the infringement of the Augur patent prior to April 9, 1884, when the plaintiffs first took title to it. It appears from the record that the patentee assigned the patent to one Atwater, on February 4, 1873, subject to the condition that if he paid a certain note of \$2,000 and interest the assignment was to be void. This vested the real title in the assignee. *Waterman v. Mackenzie*, 138 U. S. 252, 11 Sup. Ct. 334. The assignment made no mention of past infringements. On April 9, 1883, Atwater assigned to Saladee all the interest which he had acquired, together with all claims and demands for the past use of such patents; and on April 9, 1884, Saladee made a similar assignment to the plaintiffs.

It is claimed in this connection—First, that the bill did not make the assignment of the claim for damages for prior infringements of the Augur patent a basis or ground of recovery, and asked no recovery therefor; and, second, that, if the plaintiffs were entitled to recover the damages which Atwater sustained by reason of the infringement of this patent prior to April 9, 1883, and those which Saladee sustained from April 9, 1883, to April 9, 1884, the date of the assignment to the plaintiffs, there was no evidence that either Atwater or Saladee suffered any damages by reason of the infringement, nor any evidence that they could have supplied the trade during those years.

It is sufficient to say in reply to this that no such exception was taken in the court below to the master's report, the only exception being that, in view of the Stringfellow and Surles patent, the master should have reported only nominal damages. It was held by this court, in *Story v. Livingston*, 13 Pet. (U. S.) 359, 366, that proper practice in chancery requires that no exceptions to a master's report be made which were not taken before the master, the object being to save time, and give him an opportunity to correct his errors or reconsider his opinion. A party neglecting to bring in objections can not afterwards except to the report, unless the court, upon motion, see reason to be dissatisfied with the report, and refer it to the master for review, with liberty to the party to take objection to it. And in *McMicken v. Perin*, 18 How. (U. S.) 507, it was held directly that this court will not review a master's report upon objections taken here for the first time. In affirmance of this principle, rule 21 (subdivision 2) requires that "when the error alleged is to a ruling upon the report of a master, the specification shall state the exception to the report, and the action of the court upon it." This presupposes that the particular exception relied upon was taken in the court below, and was passed upon by the court adversely to the

appellant. Proper practice requires that objections to a master's report shall be taken in that court, that any errors discovered therein may be rectified by the court itself, or by a reference to the master for a correction of his report, without putting parties to the delay and expense of an appeal to this court. It would be manifestly unjust if this court, after having affirmed the action of the court below in every other particular, should take up an error in a master's report, which was not called to its attention, and reverse the case upon that ground, when, if exception had been duly taken, the error could have been at once corrected. There is nothing in this case to indicate that this point was ever made before the master, nor is it noticed in the eight exceptions taken to his first report, which was set aside upon other grounds, or, as already observed, in the exception to his final report.

5. For the same reason—that no exceptions were taken at all by the plaintiffs to the master's report—we must decline to notice their first two assignments of error based upon the inadequacy of the damages awarded.

There is much force in the third assignment—that the court erred in overruling plaintiff's motion to increase the damages, and in refusing to give a decree for such increase. The master finds that for some years before the defendant began to manufacture he was the traveling sales agent of the plaintiffs; that, while so associated in the manufacture of carriage hardware and appliances, they establish a large trade in certain parts of the country, and that during this period the defendant, while traveling for the firm, became acquainted with their trade, and the location, extent of purchase, and solvency of their customers. His connection with the firm having terminated, defendant went to Cleveland, and in 1882 opened a rival establishment, and began the infringement of these patents. Before that time, plaintiffs were the exclusive manufacturers of these equalizers, and had equipped their establishment with sufficient machinery to enable them to supply the market; but they neither issued licenses nor established a royalty for the manufacture or use of their improvement. The defendant, knowing all their customers and plaintiffs' facilities for the manufacture of equalizers, made serious inroads upon their business, and sold almost exclusively to those who had formerly been customers of the plaintiffs. Under these circumstances we should not have disturbed the decree of the court below if it had seen fit to increase the damages; but, in view of the fact that the defendant carried on the business apparently without profit to himself, and that a decree passed against him for the sum of \$8,480.51 actual damages, we are not inclined to reverse it upon that ground. The allowance of an increase of damages under the

statute is a matter which rests somewhat in the discretion of the court, and we should not be inclined to disturb its finding upon this point, unless the evidence clearly demanded it.

The decree of the court below is therefore affirmed.

1076. WESTINGHOUSE ELECTRIC, ETC. CO. v. WAGNER ELECTRIC ETC., CO., 225 U. S. 604, 56 L. ed. 1224, 23 Sup. Ct. 691 (U. S. Supreme Court, 1912).* * *

Statement of the Case.

The current produced by an electric generator is of relatively low pressure, and for that reason it is impracticable to utilize it, for power purposes, more than five or six miles from the central station. It was found, however, that this pressure, or voltage, could be increased by the use of a transformer or converter, consisting of a metal core, through and around which are wound primary insulated wires leading from the generator. Secondary wires, also insulated, are wound through and around the same core, and carried thence to the point of application. The voltage is increased or decreased according as the secondary wires are wrapped around the core more or less frequently than the primary wires.

One of the consequences of thus transforming the current is the generation of heat. In small machines this is corrected by radiation, but in large ones the heat "ages" the iron, lessens the efficiency of the transformer and, in time, deteriorates the insulation around the wires. This latter result causes short circuits, makes it impracticable to take advantage of the increased voltage, and thus again restricts the area in which currents of more than 10 K. W. can be used for producing light and power. (112 Fed. 418.)

Many efforts were made to overcome this difficulty, but without success until July 12, 1887, when George Westinghouse, Jr., secured Patent 366,362 for an "electrical converter," which, his application stated was intended to prevent the converter becoming—

"overheated when employed for a long time in transforming currents of high electromotive force."

Extracts from the specifications and claims are copied in the margin.*

* "The core is preferably composed of thin plates of soft iron * * * separated individually or in pairs from each other by thin sheets of paper or other insulating material. * * * The plates are preferably constructed with two rectangular openings through which the wires pass. * * * Each group of—say five or six plates—is preferably separated from the succeeding group by air spaces. These may be produced by passing tubes,

which may be of soft iron or other metal, or of vulcanized fiber, along the lengths of the plates. It may be sufficient in other cases to block the group of plates apart at intervals instead of extending the tubes the entire length. Preferably also the primary and secondary coils are separated from each other in a similar manner.'

"Where the converter is to be used in the open air, the tube will permit a free circulation of air and thus aid in keeping the converter cool.

"It may be preferred in some instances to surround the converter with some oil, or paraffin or other suitable material, which will assist in preserving insulation and will not be injured by heating. This material when in a liquid form circulates through the tubes and intervening spaces of the coils and plates, and preserves the insulation, excludes the moisture, and cools the converter.

"The entire converter may be sealed into an inclosing case * * * which may or may not contain a non-conducting fluid or gas.

"I claim as my invention * * * 1. * * * 2. * * * ;
3. * * *

"4. The combination, substantially as described, of an electric converter constructed with open spaces in its core, an inclosing case, and a non-conducting fluid or gas in said case adapted to circulate through said spaces and about the converter.' "

Referring specially to the specifications and claim 4, which is here involved, and speaking generally rather than technically, it will be seen that the transformer consisted of a core, composed of groups of thin metal plates, so plugged apart as to leave (a) open spaces in the core. The primary and secondary wires were wound through rectangular openings near the ends of these plates. The entire apparatus was then placed in a case filled with non-conducting oil, which, when heated, circulated in and around the transformer, being cooled by contact with the exterior surface of the inclosing box or receptacle. This invention proved to be of immense value and made it possible (112 Fed. 418, 422; 117 Fed. 498) to transmit and apply powerful currents so as to produce power and light at a great distance from the generating plant. The patent was utilized by the Union Carbide Co., and on May 10, 1900, the Westinghouse Electric & Manufacturing Company as assignee of George Westinghouse sued that company as infringing claim 4. The transformers which the Carbide Company was using had been sold by the Wagner Company. As venter and warrantor the latter therefore defended and admits that the decree (112 Fed. 417) of November 11, 1901, sustaining the validity of claim 4, is, as to it, *res adjudicata*. That decree was affirmed April 29, 1902 (117 Fed. 495), and on June

24, 1902, the Westinghouse Company brought this suit (129 Fed. 604) against the Wagner Company, praying for damages and profits, and also for an injunction against further infringement.

It appeared that after the decree in the Carbide Case the Wagner Company had instructed its experts to build a transformer that would not infringe the Westinghouse patent. They thereupon devised one, referred to herein as Type M, which omitted the (a) open spaces in the core, but substituted (b) spaces between the coil, and (c) spaces between the coil and the core.

The court held that these Type M transformers eliminating spaces in the core were not an infringement of claim 4, and thereupon refused the injunction. (129 Fed. 604.) But the defendant in its answer admitted that it had infringed claim 4 by the manufacture of transformers, which, as it subsequently developed, contained openings (a) in the core, and also (b) openings between the coils, and (c) between the coil and core. The case was therefore referred to a master to state an account of damages and profits arising from the infringement of claim 4 prior to June 24, 1902.

On the hearing it appeared that the Wagner Company manufactured various electrical appliances that had been made in the same shop, by the same workmen and under the same general superintendence as that employed in making the transformers. No account had been kept which would show the cost of labor and shop expenses attributable to these transformers. Nor was there anything on the books indicating what, if any, profit had been realized from their sales.

The gross receipts of \$2,314,744.75 were mingled. The books only showed a gross profit of about eight per cent., but it appeared that the plant had grown and the business had extended during the period covered by the accounting. There was testimony that the company had the general policy of fixing prices at a figure which would net twenty-five per cent. The master made an elaborate analysis of the data as to flat cost of labor and material, shop expenses and commissions applicable to the transformers. From this data and the policy of the company he ultimately reached the conclusion that the company had made a profit of \$132,433 on the \$955,271.76 which the books showed had been received from the sale of several thousand infringing transformers. But at the close of the plaintiff's testimony the defendant demurred to the evidence on the ground that it failed to show that any profit had been made in the sale of the infringing transformers. The demurrer was overruled. The defendant then claimed that the infringing transformers contained elements of the patent which were not embraced in claim 4, for which alone this suit was proceeding, and that no profit due to those elements could be recovered in this case, unless the plain-

tiff apportioned the gains due solely to claim 4. It also offered evidence, including a heat test, tending to support its contention that a transformer containing only the elements covered by claim 4, was of little utility; that it operated mainly to reduce the heat in the core, when it was much more important to keep the coils cool; that the infringing transformers contained spaces (b) between the coils and (c) between coil and core which, it contended, were additions and non-infringing improvements, contributing to the profits, if any had been made.

In reply and to disprove the defendant's contention, the plaintiff relied among other things on the fact that upon the hearing of the application to enjoin the defendant from manufacturing transformers containing only (b) spaces between the coil and (c) between coil and core, the Wagner Company had contended that these grooves or channels had been used to avoid infringement, although they "crippled the coils" and actually "lessened the electrical efficiency of the transformers."

At the conclusion of the lengthy testimony, the substance of which is barely outlined above, the master found from the evidence and under the decision in 117 Fed. 498, binding on defendant, that claim 4 was an entirety, covering not only open spaces in the core, but the use of the oil in a closed receptacle for cooling the transformer; that all of the commercial value of those sold by the defendant was due to the use of claim 4, of plaintiff's patent and not to additions made by the defendant. He recommended that a decree should be entered against the defendant for \$132,433.35,

"being approximately twenty-five per cent. on the net amount of the sales of infringing transformers after deducting commissions and fixing the factory cost at forty per cent."

The defendant filed many exceptions, among others—
"that the complainant has not shown what was the profit made by defendant on its transformers due to the patented invention of claim 4, as distinguished and segregated from the other features contained in said transformers."

There were also numerous exceptions as to the master's method of stating the account. These and others were not specifically passed on because the circuit court and the circuit court of appeals (one judge dissenting) held (173 Fed. 361) that claim 4 was a limited detailed claim; that the additions made by the defendant were non-infringing and valuable improvements which contributed to the profits; that the burden of apportionment was upon plaintiff, and, having failed to separate the profits it was only entitled to a decree for nominal damages. The court (one judge dissenting) also affirmed the decree that Type M was not an infringement of claim 4.

Mr. Justice Lamar, after making the foregoing statement, delivered the opinion of the court.

The statute makes the decision of the circuit court of appeals final in patent cases, and the plaintiff's petition for the writ of certiorari herein was not granted for the purpose of re-examining the court's ruling that defendant's Type M transformer was not an infringement of claim 4 of the Westinghouse patent. The writ was issued in view of the holding that, though the master found that the defendant had made a profit of \$132,000 from the sale of infringing transformers, the plaintiff could yet only recover one dollar because it failed to separate the profits made by its patent from those made by the defendant's addition.

1. The question as to who has the burden of proof, in cases like this, is one of great practical importance and constantly arises in patent cases. There has been much controversy on the subject and a conflict in the decisions. The authorities cited in the briefs of the two litigants, and others bearing on the subject, have been examined, but we shall not undertake to separately review them, for they disagree not so much as to the rule as to its application. It will be sufficient for the present purposes to say that—

(a) Where the infringer has sold or used a patented article, the plaintiff is entitled to recover all of the profits.

(b) Where a patent, though using old elements, gives the entire value to the combination, the plaintiff is entitled to recover all the profits. (*Hurlbut v. Schillinger*, 130 U. S. 472.)

(c) Where profits are made by the use of an article patented as an entirety, the infringer is liable for all the profits—“unless he can show—and the burden is on him to show—that a portion of them is the result of some other thing used by him.” (*Elizabeth v. Pavement Company*, 97 U. S. 127.)

(d) But there are many cases in which the plaintiff's patent is only a part of the machine and creates only a part of the profits. His invention may have been used in combination with valuable improvements made, or other patents appropriated by the infringer, and each may have jointly, but unequally, contributed to the profits. In such case, if plaintiff's patent only created a part of the profits, he is only entitled to recover that part of the net gains. He must, therefore—

“give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a

marketable article, is properly and legally attributable to the patented feature." (Garretson v. Clark, 111 U. S. 121.)

The real controversy arises in applying this principle to those cases where it is impossible to separate the single profit into its component parts.

2. In considering the question presented by the record here, it is to be borne in mind that Congress has legislated (Rev. Stat. 4921) with a view of affording the patentee ample redress against the infringer. It not only makes the latter liable for damages—sometimes threefold damages—but for all profits derived from the use or sale of plaintiff's invention. The rule as to the burden of proof has, however, been so applied that this statutory right has been often nullified by those infringers who had ingenuity enough to smother the patent with improvements belonging to themselves or to third persons. In such cases the greater the wrong the greater the immunity; the greater the number of improvements the greater the difficulty of separating the profits. And if that difficulty could only be converted into an impossibility the defendant retained all of the gains, because the injured patentee could not separate what the guilty infringer had made impossible of separation.

Manifestly such consequences demonstrate that either the rule or its application is wrong. The rule is sound, for it but announces the general proposition that the plaintiff must prove its case and carry the burden imposed by law upon every person seeking to recover money or property from another. But the principle must not be pressed so far as to override others equally important in the administration of justice. It may serve to illustrate the rule and its limitations, if, at the risk of stating the obvious, we apply it to the various steps of this case.

The plaintiff proved its patent and that it had been infringed by the defendant in the manufacture of several thousand transformers which sold for \$955,000. The patent was itself evidence of the utility of claim 4, and the defendant was estopped from denying that it was of value. (Lehnbeuter v. Holthaus, 105 U. S. 94.) But no matter how great its presumptive or actual value it did not follow that the defendant had made a profit by the sale of the infringing transformers. And so, having sued for profits, the Westinghouse Company was under the burden of showing they had been made. This it did to the satisfaction of the master, who found that the defendant had netted \$132,000 from their sale.

The defendant then had the right either to disprove the plaintiff's case or to offer evidence in mitigation, or both. Accordingly it submitted evidence tending to show that the spaces added by the defendants were non-infringing and valuable improvements which had contributed to the making of the profits.

In reply the Westinghouse Company insisted that claim 4 was an entirety, covering a circulatory system in and around a transformer placed in an oil-filled receptacle; that it embraced the "intervening spaces in the coil" because at least a part of the coil was in the core; that if these spaces were held not to be infringements they had in fact, as employed by the defendant, added nothing to the profits, but on the contrary had crippled the coil and lessened the electrical efficiency of the transformer. (129 Fed. 607.) For that reason the plaintiff contended that it had shown that all the gains were "legally attributable to the patented feature." (Garretson v. Clark, 111 U. S. 121; Elizabeth v. Pavement Co., 97 U. S. 126, 7; Crosby Valve Co. v. Safety Valve Co., 141 U. S. 454; Keystone v. Adams, 151 U. S. 144-145.) This view was sustained by the master. But if it be assumed, as was found to be the fact by the court, that the spaces were non-infringing and valuable improvements, it may then have prima facie appeared that these changes had contributed to the profits. If so, the burden of apportionment was then logically on the plaintiff, since it was only entitled to recover such part of the commingled profits as was attributable to the use of its invention.

3. Lindley, L. J., said in *Siddell v. Vickers* (9 Rep. Pat. Cases, 162) that there—

"was no form of account more difficult to work out than an account of profits."

But that is no reason why the plaintiff should be denied its rights. The problem here, though different, was in many respects analogous to that presented in those cases in which it is necessary to separate the interstate from the intrastate earnings made by a railroad where the same track, rolling-stock, depots and labor are employed at the same time in making gross receipts. These commingled expenses must be apportioned between the two classes of earnings in order to determine whether the intrastate rate is confiscatory. The courts, "while recognizing the impossibility of reaching a conclusion that is mathematically exact,"

have, in addition to all the other evidence bearing on the question, received—

"the testimony of experts as to the relative cost of doing a local and through business." (*Chicago, etc., Co. v. Tompkins*, 176 U. S. 178.)

The converse is true. What is permissible in an effort to separate costs may also be done in a patent case where it is necessary to separate profits. (*Root v. Railway Co.*, 105 U. S. 198. See also *Rubber Co. v. Goodyear*, 9 Wall. 802.) In effect, this was attempted in the present case. Witnesses who had been in the employment of the defendant and who had kept the books,

purchased the material, superintended the construction and fixed the price of the transformers, were not able to show that profits had been made, and consequently were not able to show what part of the profits was attributable to the patent and what to the additions, if found to be non-infringing and valuable improvements.

4. Having, by books and other data, proved to the satisfaction of the master the existence of profits, the plaintiff had carried the burden imposed by law, and established every element necessary to entitle it to a decree, except one. As to that, the act of the defendant had made it not merely difficult but impossible to carry the burden of apportionment. But plaintiff offered evidence tending to establish a legal equivalent. It had proved the existence of a fact which, whether treated as a rule of evidence or as a matter of substantive law, would entitle it to a decree for all the profits. The method was different from that mentioned in the second branch of the rule in the *Garretson Case*, 111 U. S. 121, but the plaintiff had now presented proof to demonstrate its right to the whole of the fund because of the fact that the defendant had inextricably commingled and confused the parts composing it. This result would not be in conflict with the principle which in the first instance imposed the burden of proof on the plaintiff, but merely gave legal effect to a new fact which as a matter of law entitled the patentee to a particular judgment. It presented a case where the court was called on to determine the liability of a trustee *ex maleficio*, who had confused his own gains with those which belonged to the plaintiff. One party or the other must suffer. The inseparable profit must be given to the patentee or infringer. The loss had to fall on the innocent or the guilty. In such an alternative the law places the loss on the wrongdoer.

5. It is said, however, that the rule does not apply to patent cases. Why it should be limited does not appear. It is admitted that an injunction may be granted against selling infringing devices, even though the result will be to prevent the defendant from using valuable appliances confused with the patented device. And Lord Eldon treated this conceded right to enjoin as an application of the rule relating to the confusion of goods. He therefore restrained the publication of a book, a large portion of which was original, because copyright matter was incorporated therein, saying in *Mawman v. Tegg*, 2 Russ. 390:

“As to the hard consequences which would follow from granting an injunction, when a very large portion of the work is unquestionably original, I can only say that if the parts which have been copied cannot be separated from those which are original, without destroying the use and value of the original matter,

he who has made an improper use of that which did not belong to him must suffer the consequences of so doing."

This case was cited and approved in *Callaghan v. Myers*, 128 U. S. 658, where the infringer who had blended his own with copyright matter, in a volume which sold for a profit, was made to—

"abide the consequences on the same principle that he who has wrongfully produced a confusion of goods must alone suffer."

In one of these cases the original matter was less, and in the other more, than that unlawfully appropriated. In both, as in patent cases, the infringer was a "trustee for the plaintiff in respect of profits." (*Root v. Railway Co.*, 105 U. S. 214.) And the liability is not lessened because the confusion is due to a wrongful appropriation by a trustee *de son tort* instead of carelessness of a trustee lawfully appointed. Nor is it limited to those cases where the patented device is shown to have preponderated in the creation of the profits. The owner of a small part of the fund is as much entitled to the protection of the law as the owner of a larger share. The rule, however, is not intended to penalize the infringer, nor to give the patentee profits to which he is clearly not entitled. So that where, by general evidence, expert testimony or otherwise, it is shown that his patent is of relatively small value, it will often be possible to prove that, at the utmost, it could not have contributed to more than a given amount of the profits. (*Lupton v. White*, 15 Vesey Jr., 432-440.) In such cases, except possibly against one who had concealed or destroyed evidence or been guilty of gross wrong, the plaintiff's recovery cannot exceed the amount thus proved, even though it be impossible otherwise more precisely to apportion the profits.

6. But when a case of confusion does appear—when it is impossible to make a mathematical or approximate apportionment—then from the very necessity of the case one party or the other must secure the entire fund. It must be kept by the infringer, or it must be awarded, by law, to the patentee. On established principles of equity, and on the plainest principles of justice, the guilty trustee cannot take advantage of his own wrong. The fact that he may lose something of his own is a misfortune which he has brought upon himself; and if, as argued, the fund may have been made by the use of other patents also, for which he may be liable in another case, it is again a misfortune which he has brought upon himself and an instance of a double wrong causing double liability. He cannot appeal to a court of conscience to cast the loss upon an innocent patentee and by judicial decree repeal the provision of Revised Statutes 4921, which declares that in case of infringement the complainant shall be entitled to recover the "profits to be accounted for by the defendant."

This conclusion is said to be in conflict with the Garretson and other decisions which, it is claimed, justify the conclusion that the defendant is entitled to retain all of the profits even where the patentee is unable to make an apportionment. (Warren v. Keep, 155 U. S. 265.) An analysis of the fact of those cases will show that they do not sustain so extreme a doctrine. For they deal with instances where the plaintiff apparently relied on the theory that the burden was on the defendant, and for that, or other reasons, made no attempt whatever to separate the profits. None of the cases cited discuss the rights of the patentee who has exhausted all available means of apportionment, who has resorted to the books and employes of the defendant, and by them, or expert testimony proved, that it was impossible to make a separation of the profits. This distinction, between difficulty and impossibility, is involved in the ruling by the Circuit Court of Appeals of the Sixth Circuit in Brennan & Co. v. Dowagiac Mfg. Co., 162 Fed. 476, where the Garretson Case was distinguished and the court said:

“In the present case the infringer’s conduct has been such as to preclude the belief that it had derived no advantage from the use of plaintiff’s invention. * * * In these circumstances, on whom is the burden of loss to fall? We think the law answers this question by declaring that it shall rest upon the wrongdoer, who has so confused his own with that of another that neither can be distinguished. It is a bitter response for the court to say to the innocent party, “You have failed to make the necessary proof to enable us to decide how much of these profits are your own;” for the party knows, and the court must see, that such a requirement is impossible to be complied with. The proper remedy to be applied in such cases is that stated by Chancellor Kent in Hart v. Ten Eyck, 2 Johns. 62, 108, where he said: ‘The rule of law and equity is strict and severe in such cases. * * * All the inconvenience of the confusion is thrown upon the party who produces it, and it is for him to distinguish his own property or lose it.’”

It may be argued that, in its last analysis, this is but another way of saying that the burden of proof is on the defendant. And so doubt such, in the end, will be the practical result in many cases. But such burden is not imposed by law; nor is it so shifted until after the plaintiff has proved the existence of profits attributable to his invention and demonstrated that they are impossible of accurate or approximate apportionment. If then the burden of separation is cast on the defendant it is one which justly should be borne by him, as he wrought the confusion.

7. This conclusion would apparently result in a decree in favor of the appellant. But such an order, under the peculiar facts of this case, would operate to deprive the defendant of

the right to a ruling on the exceptions filed to the report. The master held that the entire commercial value of the transformer was due to the invention covered by claim 4, and that therefore all the profits belonged to the Westinghouse Company. The court, on the other hand, found that the defendant's additions were not infringements and had contributed to the profits, and that because of the failure to make a separation the plaintiff was entitled only to nominal damages. For this reason it did not specifically pass on defendant's exceptions. Other questions of law and fact involved in the accounting were not considered. Neither the court nor the master discussed the question of apportionment and the record does not afford satisfactory data for entering a final decree. This no doubt arises from the fact that both parties relied so entirely upon their theory that the burden was on the other, that facts were not proved which might otherwise have been established. The decree is therefore reversed and the case remanded, with power to hear and determine motions to amend the pleadings and with directions that the case be recommitted to a master for a new hearing on all the questions involved in the original reference, and, on evidence already submitted and such additional testimony as may be offered, for further proceedings not inconsistent with this opinion.

Reversed.

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

1077. *ECLIPSE BICYCLE CO. v. FARROW*, 199 U. S. 581, 50 L. ed. 317, 26 Sup. Ct. 150.

The ground on which the account was ordered was that the contract required it, notwithstanding all the difference which the auditor found. We could not come to that conclusion unless we at least were satisfied that it was inconsistent with due business diligence in pushing Farrow for the defendant to take up with E 10. The witnesses pointed out important superiorities in the latter, which we need not repeat, in the way of avoiding clogging by mud or ice, in applicability to a chainless machine, in more immediate and certain operation, and in requiring a less continued exercise of force. On these points they were not contradicted. If, as we think, E 10 did not embody Farrow's invention, and if the company reasonably and honestly thought it a better thing, it had a right to do what it did. We can not say that it was not warranted in its preference of E 10, or that it was not honest in its choice. It follows that, with regard to this, the decree must be reversed.

1078. STANDARD ELEVATOR CO. v. CRANE ELEVATOR CO., 76 Fed. 767, 22 C. C. A. 549.

In a patent case there can be no right to an accounting unless the infringement be made out; but the infringement may be found and the injunction awarded in favor of a complainant who, upon the proofs, has no right to an accounting. Upon the issue whether or not the complainant is entitled to the accounting, it may not appear that the defendant used or sold the patented device, but merely that he made it; or it may otherwise appear that there were, in fact, no profits, or that an account had already been stated, conditionally or otherwise, by the parties themselves, and that for want of notice, as provided in sec. 4900 of the Revised Statutes of the United States, no damages could be recovered. In such event there could be no award of an accounting in the decree, although the perpetual injunction would be awarded. *Whittemore v. Cutter*, Fed. Cas. No. 17,601; *Elizabeth v. Pavement Co.*, 97 U. S. 127, 144. In a patent case on the equity side the primary and essential contention relates to the ownership of the patent by complainant, the validity of the claims, and the infringement. The final adjudication in favor of complainant on this contention is a perpetual injunction.

1079. MURRAY v. ORR, ETC., HARDWARE CO., 153 Fed. 369, 82 C. C. A. 445.

When the order of reference was made, the only infringement established by the decree was defendant's sale of Columbia ladders. We think it is better and cleaner-cut practice to require a complainant to set up alleged new infringements in a supplemental bill. Thereupon, if it should be found that the additional types contain only colorable departures from the adjudged infringing type, the decree for an injunction and an accounting and the order of reference could be extended to cover them specifically; or, if the changes should appear to be so radical that the pending suit ought not to be cumbered and delayed by practically a new issue, the supplemental bill could be dismissed with leave to the complainant to begin an independent suit.

* * *

It was not open to defendant on the question of additional infringements to refer to the prior art to limit the scope of the invention to less than we had found it to be in determining the infringement of the Columbia ladder. As the changes from the Columbia type are only colorable, the part of the decree that is questioned on this appeal must be reversed.

1080. *SAYRE v. SCOTT*, 55 Fed. 971, 5 C. C. A. 366.

The master's report was based altogether upon the profits actually realized by the defendant from his sales of infringing machines. The defendant was charged with the amount received by him from sales, as stated by himself. * * * Besides a credit for the cost of manufacture, as found by the master, and a credit for advertising, the defendant was allowed for freight and cartage, and discounts to purchasers. We think the master was right in disallowing the lumping sum which the defendant claimed for "clerk hire, selling expenses, rent, and insurance." That was a mere estimate, unsupported by evidence. * * * We do not see upon what principle the defendant is entitled to an allowance for the sum he paid for the Cottrell patents, and the cost of his patterns. They remain his property. These credits were properly disallowed.

1081. *MICHIGAN, ETC. R. CO. v. TURRILL*, 110 U. S. 301, 28 L. ed. 154, 4 Sup. Ct. 5.

In making up the decree, interest was added from the date of the master's report on the balances found due after the ascertained deductions had been made, and this is assigned for error. As a general rule, a patentee is not entitled to interest on profits made by an infringer. The reason is that profits are regarded in the light of liquidated damages. *Parks v. Booth*, 102 U. S. 106. But in many of the cases it is said that circumstances may arise in which it would be proper to add interest. *Mowry v. Whitney*, 14 Wall. 653; *Littlefield v. Perry*, 21 Wall. 230. Here, as has been seen, in effect, the original decrees rendered in July, 1874, were affirmed in 1876, to the extent of the present recoveries. The cases were only sent back to ascertain how much should be deducted from those decrees for errors in the accounts as then stated. If the decrees had been entered originally for the present amounts, the patentee would have been entitled to interest from 1874. This was settled in *R. R. Co. v. Turrill*, 101 U. S. 836 * * * Under these circumstances, it seems to us not at all inequitable to allow interest on the corrected amounts from the date of the master's report.

1082. *BOESCH v. GRAFF*, 133 U. S. 697, 33 L. ed. 787, 10 Sup. Ct. 378.

The report of a master is merely advisory to the court, which it may accept and act upon in whole or in part, according to its own judgment as to the weight of the evidence. * * * Yet, in dealing with exceptions to such reports, "the conclusions of the master, depending upon the weighing of conflicting testimony, have every reasonable presumption in their favor and are

not to be set aside or modified unless there clearly appears to have been error or mistake on his part."

1083. ELIZABETH v. AMERICAN PAVEMENT CO., 97 U. S. 126, 24 L. ed. 1000.

It is also clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although, from other causes, the general business of the defendant, in which the invention is employed, may not have resulted in profits; as where it is shown that the use of his invention produced definite saving in the process of a manufacture. * * * On the contrary, though the defendant's general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered.

1084. COUPE v. ROYER, 155 U. S. 565, 39 L. ed. 263, 15 Sup. Ct. 199.

But even in equity the profits which the complainant seeks to recover must be shown to have been actually received by the defendant; * * * in other words, the fruits of the advantage which he derived from the use of that invention over what he would have had in using other means then open to the public and adequate to enable him to obtain an equally beneficial result.

1085. BRENNAN & CO. v. DOWAGIAC MFG. CO., 162 Fed. 472, 89 C. C. A. 392.

A patentee may withhold the exploiting of his patent in a particular territory, or he may not be able at the time to extend his business therein. But this gives no right to the infringer to invade the territory and anticipate the sales which the patentee might have when he should desire and be able to carry his invention there for a profit which is legitimately his own. But this, while it might be an answer to the suggestion made by the master, is not relevant to such a proceeding as this. The fact that the owner of a patent does not exercise his right or cannot at the time do so to the full, gives no license to another, and the latter is liable for infringement, to the same extent as if the owner were exercising his right to the utmost. The owner has the same right as he has to any other property, which he may put to use or not as he chooses; and in such case the rule always is that, if a stranger without right seizes and uses it, he is bound to pay for such use, and it is no answer for him to say that the owner was doing nothing with it. If it be true, as has often been declared, that the exclusive right of a patentee is property, for the protection of which the public faith is

pledged, it should have the same immunity from invasion, and its violation should be attended with the same consequences as in the case of other species of property.

1086. *ORR, ETC., HARDWARE CO. v. MURRAY*, 163 Fed. 54, 89 C. C. A. 492.

Two rules governing the question of profits as between patentee and infringer are laid down by the Supreme Court. The first of these rules (*Elizabeth v. American Pavement Company*, 97 U. S. 126, 24 L. ed. 1000) is as follows: Where profits are made by an infringer, by the use of an article patented as an entirety, the infringer is responsible to the patentee for the whole of such profits, unless he can show—and the burden is on the infringer to show it—that a portion of such profits is the result of some other thing used by him. And the second rule (*Garretson v. Clark et al.*, 111 U. S. 120, 28 L. ed. 371) is as follows: That where the patent is for an improvement, and not for an entirely new article or product, the burden is on the patentee to show what portion of the infringer's profits is due to the particular patented feature.

Inasmuch as appellant offered no proof, other than the patent itself, tending to show that the profits made by it upon the ladders sold by it were the result of anything else than the use of the ladder patented as an entirety, and inasmuch as no proof was offered by appellee, other than the patent itself, tending to separate or apportion the profits made by the appellant, by the use of the patent in question, from such profits as might have been due to other features, neither party has attempted to take these cases out of the rule contended for by his adversary—leaving it as the determinative question in these cases whether (the patent only being before us) the rule laid down in the *Nicholson Case*, or the rule laid down in the *Garretson Case*, is applicable to the case before us, as the patent has already been upheld and construed by this court.

The new thought in the art of ladder building, embodied in the *Murray* patent, was the utilizing of the man's weight to adjust the center of gravity. It was a unitary thought, to carry out which the elements already named were only agents; and a unitary thought, though thus carried, makes the ladder thus built a new article within the meaning of the *Nicholson case*.

1087. *WALES v. WATERBURY MFG. CO.*, 101 Fed. 126, 41 C. C. A. 250.

An infringer is a trustee *ex maleficio* for the owner of the exclusive rights protected by the patent; and a trustee who has confused the profits made by the use of the trust property with those made from his own property, and commingled them so

that they cannot be segregated, must account for the whole.
* * * On the other hand, such a rule would work unjustly in many cases—as where the patented feature is of an insignificant part of the machine or article; and it is probably because of its manifest inequity in such cases that the courts have placed upon the complainant the burden of proof.

[See, however, Nos. 1076 and 1087, for example.]

1088. BAKER v. CRANE CO., 138 Fed. 60, 70 C. C. A. 486.

How much of the 28½ cents, the difference between the cost and selling price of defendant's new appliance, was due to the improvement covered by claim 1? The record fails to show. This was necessary.

1089. MAST & CO. v. SUPERIOR DRILL CO., 154 Fed. 45, 83 C. C. A. 157.

The court abruptly departed from the orderly course of procedure. The decree did not rest upon any finding by the master, notwithstanding the court overruled all exceptions to it. Nor is it supported by any evidence to be found in the record. It was for an arbitrary sum quite distinct from either of the results which the evidence had any tendency to prove, and the court was not at liberty to pronounce a decree at discretion.

1090. ROBERTSON v. BLAKE, 94 U. S. 728, 24 L. ed. 245.

No license fee charged by the complainant is shown. The burden of proof rests upon him. Damages must be proved; they are not to be presumed.

1091. SEYMOUR v. McCORMICK, 16 How. (U. S.) 480, 14 L. ed. 1024.

But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. And where the profit of the patentee consists neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply.

1092. HOLMES v. TRUMAN, 67 Fed. 542, 14 C. C. A. 517.

It would be impossible in the case of a patent such as this to introduce testimony to separate the value of the patented from the unpatented parts. The plaintiff's invention practically introduced a new cart—a cart for which a demand at once arose. There is no evidence that at any time carts were constructed after the manner of the plaintiff's but with the patented feature

omitted. There would be no demand for such a cart. It was impossible, therefore, to compare the value of the patented cart with a cart which did not contain the invention. There was in the case the admission of the defendants that they had constructed 150 carts in the year 1893. The testimony of the plaintiffs was that, by reason of the competition of infringers, the price of their cart, which was originally \$35, had been reduced to \$22.50. The measure of their damages was their entire loss.

1093. CLARK v. WOOSTER, 119 U. S. 322, 30 L. ed. 392, 7 Sup Ct. 217.

Established license fees are the best measure of damages that can be used. There may be damages beyond this, such as the expense and trouble the plaintiff has been put to by the defendant, and any special inconvenience he has suffered from the wrongful acts of the defendant; but these are more properly the subjects of allowance by the court under the authority given to it to increase the damages.

1094. HUNT, ETC. FRUIT PACKING CO. v. CASSIDY, 53 Fed. 257, 3 C. C. A. 525.

A license fee, when established and agreed to by the public, is only a means of estimating the market value of a patented machine or device of which the patentee had been deprived by infringement.

* * *

The proof of a license fee for two improvements in fruit dryers is not competent to show the damages sustained by an infringement of one of these improvements.

1095. NATIONAL, ETC. PAPER CO. v. ELSAS, 86 Fed. 917, 30 C. C. A. 487.

They were perfectly indifferent to the claimed rights of any one else, and purchased infringing goods from the Dayton Company on March 26, 1892, a month after the issuance of a preliminary injunction against them, and nearly 1½ months after the date of Judge Lacombe's opinion. While the master cautiously does not find a removal of their books and papers to evade the accounting, it appears that they did not exert themselves to produce them. They were passive instruments in the hands of the real defendants, and permitted all the difficulties which the master has detailed to be interposed. The doubling of the small amount of damages which the master was able to find, was a proper exercise of power of the circuit court.

1096. PARKS v. BOOTH, 102 U. S. 96, 26 L. ed. 54.

Interest on the profits decreed to the complainant should not have been allowed, as was decided by this court many years ago, the better opinion being that profits in such a case are to be regarded in the light of unliquidated damages, which usually do not draw interest without the special order of the court.

1097. MARSH v. SEYMOUR, 97 U. S. 348, 24 L. ed. 963.

Damages of a compensatory character may be allowed to a complainant in an equity suit, where it appears that the business of the infringer was so improvidently conducted that it did not yield any substantial profits.

1098. TUTTLE v. CLAFLIN, 76 Fed. 227, 22 C. C. A. 138.

We have been in doubt as to the proper disposition of the case—whether it should be sent to a master for rehearing, or whether this court should ascertain from the record the proper amount. *Manufacturing Co. v. Cowling*, 105 U. S. 253. This case had now been in court for eighteen years. It survived two masters, and was before a master for more than nine years. The lapse of time undoubtedly arose from a variety of circumstances, and we are not aware that it is attributable to the counsel in the case; but the delays which are incident to an accounting are well known, and we hesitate exceedingly to compel an additional expenditure of time. The manufacture of plait in any large amount has now ceased, and it is very likely that further testimony would result only in estimates not the result of experience. We have therefore concluded to ascertain from the record a more satisfactory amount of profits, and conclude that a reasonable allowance will be the sum of \$40,000.

PART XX.

COSTS AND CONTEMPT.

STATUTES.

1099. COSTS NOT RECOVERABLE IN CERTAIN SUITS FOR INFRINGEMENT OF PATENT UNLESS DISCLAIMER ENTERED, ETC.

Sec. 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought. [See §§ 4917, 4922.]

1100. SUIT FOR INFRINGEMENT WHERE SPECIFICATION IS TOO BROAD.

Sec. 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See §§ 973, 4917.]

1101. CHRISTENSEN v. WESTINGHOUSE, 135 Fed. 774, 68 C. C. A. 476. (1905, Second Circuit).* * *

Before Wallace, Townsend, and Coxe, Circuit Judges.

Wallace, Circuit Judge:

These cases are before us on writs of error to review two proceedings in contempt, in each of which the order of the court below adjudged the defendant, in an equity suit brought to restrain the infringement of a patent, guilty of contempt for violation of an interlocutory injunction restraining such infringement. The two cases may be considered together conveniently.

The order in the first proceeding fined the defendant \$1,000, and directed one-half of the fine to be paid to the clerk of the court for the use of the United States, and one-half to the complainant in the suit. The order in the second proceeding fined the defendant \$4,000, and directed one-half of the fine to be paid to the clerk of the court for the use of the United States, and one-half to be paid to the complainant.

The injunction was granted October 18, 1901, and restrained the defendant from making or selling certain automatic air-brake apparatus particularly described therein. The defendant's principal place of business was in Milwaukee, Wis., but it had an office and a managing agent at New York City. A copy of the injunction was duly served upon its solicitors in the cause by the complainant's solicitors, October 21, 1901. October 28, 1901, the solicitors for the complainant sent a copy of the injunction to the defendant, inclosed in a registered letter properly addressed to the defendant at Milwaukee, and mailed at the city of New York, with postage prepaid. In July, 1902, the complainant, having been informed that the defendant had sold certain valves which were an infringement of the injunction to the Boston & Maine Railroad Company, called the attention of the defendant to the fact, and sent a representative to Concord, N. H., to investigate. One of the valves found there which had been sold by the defendant was submitted to experts, and pronounced to be an infringement of the patent. In December, 1902, a notice of an application for an attachment for the violation of the injunction, together with a copy of the moving papers, was served upon the defendant's solicitors by the complainant's solicitors. These papers were transmitted by the latter to the counsel of the defendant at Milwaukee, and their contents were communicated by him to the manager of the defendant there. The defendant appeared upon the hearing of the application and filed various objection to the proceedings. The court found that the defendant had sold four of the infringing valves on or about July 21, 1902. The affidavits introduced by the defendant in opposition to the application set forth, among other things, in sub-

stance, that the infringing devices had not been constructed according to the directions given to its workmen, that its workmen were five or six hundred in number at its Milwaukee shops, and that the four valves had "slipped through the shop" inadvertently. In deciding the motion, the court in its opinion said:

"The defendant, upon the record here presented, must be acquitted of any deliberate violation of the order of the court, its officers having given instructions not to make or sell such structures. Nevertheless, it is thought that an enjoined defendant should take such steps as will enforce obedience to its instructions on the part of its employes. This motion might have been avoided had proper attention been given to the notification served upon the defendant last summer that infringing valves had been found which had been sold by its employes since injunction."

The order imposing the fine was entered January 10, 1903.

In July, 1903, the complainant learned from information derived from the American Car & Foundry Company that the defendant had sold to that company, upon an order given July 26, 1902, equipments embracing the infringing valves for between 25 and 30 cars, which were delivered to that company on the 28th of August, 1902, and by it shipped to the Denver & Northwestern Railway Company in April, 1903. Thereafter notice of a second application for an attachment for this violation of the injunction, together with copies of the affidavits upon which the application was based, was served by the complainant's solicitors upon the defendant's solicitors. When this motion came up for hearing, the defendant's solicitors appeared, and objected that such service was unauthorized. Thereupon the court made an order directing the complainant's solicitors to serve notice of the application for an attachment, and a copy of the affidavits to be used thereon, upon the defendant by registered mail. Pursuant to this order, the notice and a copy of the affidavits were duly mailed to the complainant's solicitors by depositing the same in the postoffice at the city of New York, May 21, 1904, in a registered letter properly addressed to the defendant, with the postage thereon prepaid. This letter was indorsed with the names of the complainant's solicitors. On May 26 the letter was returned to the complainant's solicitors by the postmaster with the official indorsement "Refused." At the time and place of hearing mentioned in the notice, the defendant's solicitors appeared, and filed an objection as follows:

"The undersigned, solicitors of defendant in the above-entitled suit, respectfully represent to the court that they are not authorized to accept service of process or other papers in criminal contempt proceedings against the defendant, or to waive any rights which the defendant may have had in such proceedings, and object that the complainant has not duly served its motion

for attachment in the pending proceeding upon the defendant, and that the court has no jurisdiction to entertain the pending proceeding because, among other reasons, the defendant has not been brought into court."

The affidavits used upon the hearing contained a recital of the previous proceedings and copies of the moving and answering affidavits used thereon, besides additional affidavits setting forth the facts in regard to the further infringement, and to the service of the motion for an attachment, which have been referred to. In deciding the motion, the court in its opinion, among other things, said:

"This is the second violation of the same injunction, and defendant does not offer even the excuse of inadvertency which it presented before."

The assignments of error in each of the proceedings assert that the court erred in deciding that the injunction was duly served on the defendant, in deciding that the defendant had infringed the injunction, in deciding that proper notice to the defendant of the motion for attachment had been given, and assert that the court imposed an excessive fine. Various other errors were assigned, but, as they have not been argued, it is unnecessary to refer to them.

The service of a copy of an injunction upon the solicitors for the defendant in an equity suit ordinarily affords sufficient notice to the defendant, and should be deemed equivalent to actual notice to the defendant of the contents. It is the duty of the solicitor promptly to inform his client of the contents of the document, and that the presumption is that he has done so. If it should appear that he has not done so, the court would doubtless acquit the defendant of any intentional misconduct in a proceeding to punish him for violating the order. In this case there was the additional presumption that a letter properly addressed and mailed reached its destination at the proper time and was duly received by the person to whom it was addressed. This is a presumption of fact resting upon the consideration that the post office is a public agent charged with the duty of transmitting letters, and that what ordinarily results from the transmission of a letter through the post office probably resulted in the given case; it is deduced from the known course of business, and the presumption that the officers of the postal system have discharged their duty. *Rosenthal v. Walker*, 111 U. S. 185, 4 Sup. Ct. 382, 28 L. ed. 395; *Kimberly v. Arms*, 129 U. S. 512, 9 Sup. Ct. 355, 32 L. ed. 764; *Henderson v. Carbondale Coal & Coke Co.*, 140 U. S. 26, 11 Sup. Ct. 691, 35 L. ed. 332; *Schutz v. Jordan*, 141 U. S. 213, 11 Sup. Ct. 906, 35 L. ed. 705. According to the modern practice, actual service of an injunction upon the person sought to be restrained is not requisite to lay the foundation of a pro-

ceeding against him for contempt. The authorities are collected in *Rapalje on Contempt*, § 46, where the author, after referring to some conflict in the cases, uses this language:

“The weight of authority, however, and in our judgment the better opinion, is that a defendant against whom an injunction is issued, who has actual notice thereof, will be bound thereby, although the same is not served upon him.”

In *re Lennon*, 166 U. S. 548, 554, 17 Sup. Ct. 658, 41 L. ed. 1110, the court said:

“To render a person amenable to an injunction, it is neither necessary that he should have been a party to the suit in which the injunction was issued, nor to have been actually served with a copy of it, so long as he appears to have had actual notice.”

In deciding that the defendant had violated the injunction, the court necessarily passed upon the questions whether the defendant had sold the valves, and whether the valves were an infringement of the complainant's patent. Upon writ of error the court can not review questions of fact. Its review is confined to questions of law only. This is the rule when contempt proceedings are under review. In *re Debs*, 154 U. S. 564, 15 Sup. Ct. 900, 39 L. ed. 1092; *Besette v. Conkey Co.*, 194 U. S. 334, 24 Sup. Ct. 665, 48 L. ed. 997.

The affidavits did not contain any positive statements of the sale of the valves by the defendant, but the statements were founded upon information derived from the parties in whose possession the valves were found. The defendant did not deny making the sales. There was certainly sufficient evidence to justify the court in finding that the valves were infringing valves, and this court can not enter upon an inquiry as to its weight or conclusiveness.

The question whether notice of the motion for an attachment had been properly given to the defendant was not raised by the objections taken in the first proceeding, and need not be considered. In *Matter of Nichols*, 54 N. Y. 62. In the second proceeding, however, the objection was raised. It may be conceded that generally the rule obtains that, before a party will be punished for contempt, it must appear that he has been personally served with notice of the application. The precedents, however, are not unanimous. In *Encyclopaedia of Pleading & Practice*, vol. 4, p. 783, the text states the rule as follows:

“While, from the character of contempt proceedings, the order to show cause is the most natural and ordinary process of reaching the offender, and most in vogue under American practice, nevertheless the court will issue an attachment without an order nisi where one is present in court, and, with full knowledge of an order passed, is guilty of disobedience; or against an officer of

the court failing to comply with its mandates, such officer being presumed to be always before the court."

In *Zimmerman v. Zimmerman*, 14 N. Y. Supp. 444, the Supreme Court of New York held that service on the attorney of the party was sufficient. In *Petrie v. The People*, 40 Ill. 334, 344, it was objected that the defendant had not been served with any notice of the application prior to the issuance of the attachment, and it was held that as the defendant was fully aware of the order which he was charged with having violated, and knew he was in default under it, and subject to attachment for contempt for non-compliance, service was unnecessary. In *Eureka Lake Co. v. Yuba County*, 116 U. S. 410, 6 Sup. Ct. 429, 29 L. ed. 671, it was decided that when a court, having acquired jurisdiction of a cause and the parties to it, issues an order upon one of the parties to show cause why he should not be punished for contempt in disobeying a temporary restraining order of injunction made in the cause, and he conceals himself to evade service of a process, the court may, on proper return of the facts, direct service of the order to show cause to be made on his attorney of record, and, after due service thereof, may proceed to hear the order to show cause, and to adjudicate the same. The court in its opinion said:

"To deny the power of calling on a concealed corporation through its chosen attorney of record in a suit to appear and answer to a charge of contempt for disobeying the orders of the court duly entered in that suit, would be to deny it the power of vindicating its authority and enforcing obedience to its lawful commands against a party personally subject to its jurisdiction."

These authorities show that it is not indispensable that the party proceeded against be actually served with notice of the application for the attachment. In the present case the presumption that its solicitors gave it prompt notice of the application of which they had been notified has as much force as the presumption that they gave the defendant notice of the injunction; and the presumption also obtains, from the proper mailing of notice of the application to the defendant, that it had an opportunity to acquaint itself of the contents. If the defendant chose to refuse to receive the registered letter which had been sent to it, it was in no better position to raise the objection which has been urged than a party would be who had concealed himself to avoid service. As a matter of fact, it can not be doubted that the defendant had a sufficient opportunity to appear and controvert the charge of contempt. Instead of doing this, it contented itself with opposing the application upon purely technical grounds. We think the objection was not well taken, and the assignment of error is not valid.

The contention of the defendant that the fines were excessive

involves a review of the judicial discretion exercised by the court below, and the rule is that decisions of that character will not be reversed unless it is manifest that they have proceeded upon wrong principles or that the discretion has been abused. Proceedings of contempt are of two classes: Those prosecuted to preserve the power and vindicate the dignity of the courts by punishing the contemnor, and those prosecuted to compel observance and redress the violation of orders or decrees made in behalf of a party to an action pending before the court. The former are punitive and essentially criminal in their nature, and the government, the courts, and the people are interested in their prosecution. The latter are civil, remedial, and coercive in their nature, and the parties chiefly interested in their conduct and prosecution are the individuals whose private rights and remedies they are necessary to redress. The intentional violation of an injunction by a party to the cause is an act in defiance of the authority of the court and in derogation of the rights of the adverse party, and a prosecution for contempt in such case may partake of both a punitive and a remedial character. The proceeding is not one to enforce the criminal laws, but is one of a quasi criminal nature. If the adjudication imposes a fine on the contemnor in favor of the government, it is a criminal judgment; if it imposes a fine in favor of the adverse party, in reparation of the loss which has been occasioned him by the act of the contemnor, it is a civil judgment. If the fines in the present case had been imposed solely in favor of the government, the question whether they were reasonable or excessive in amount would be so largely one of the discretion of the court below that we should not feel justified in disturbing them. Different judges and different tribunals may well reach different views in deciding, upon the same state of facts, whether a given penalty is an adequate, or a moderate, or an excessive punishment for an offense, and, because the correct measure of the punishment can not be ascertained by any fixed criterion, a reviewing tribunal should interfere only in an extreme case. *Rogers Manufacturing Co. v. Rogers*, 38 Conn. 121; *The People v. Delvecchio*, 18 N. Y. 352; *Myers v. The State*, 46 Ohio 473, 22 N. E. 43, 15 Am. St. 638. The defendant was a large manufacturing corporation. It had infringed a patent of sufficient importance to induce it to contest its liability in an expensive litigation, and, when defeated in the circuit court, to prosecute an appeal to the circuit court of appeals, where it was again defeated. Its officers were presumably men of sufficient intelligence and business experience to appreciate their obligations to respect and observe the mandate of the court, and to apprehend the probable consequences of neglect or evasion or contumacy. In the first proceeding the violation of the injunction may not have been willful in the sense that it was a delib-

erate act; but upon what consideration can this court say, in view of the fact that the defendant had failed to exert proper supervision over those in its employ, that the fine was excessive? In the second proceeding the court below was certainly not without justification in considering that the violation of the injunction had not been inadvertent. It was not such a trivial violation as would have been likely to be accidental. The silence of the defendant, and its attitude in meeting the charges against it by merely technical objections, were quite properly taken into consideration in fixing the amount of the fine and in disciplining it for its contumacy.

We entertain some doubt whether we are at liberty to review that part of the orders by which half of the fine imposed upon the defendant was awarded to the complainant. Although the orders do not in terms recite that this half of the fine was awarded as a compensation to the complainant for the loss and expense to which it had been put in obtaining evidence and prosecuting the contempt proceedings, we assume that this was the meaning of the orders. If the whole fine had been awarded to the complainant, the orders could not have been reviewed on writ of error, and could only be reviewed upon an appeal from the final decision in the cause. It was held by the Supreme Court (*Re Christensen*, 194 U. S. 458, 24 Sup. Ct. 729, 48 L. ed. 1072) that because the fine (in the first proceeding) was imposed in part in vindication of the authority of the court, this feature of the judgment dominated the proceedings, and fixed its character as one which was reviewable by this court upon a writ of error as a final decision in a proceeding of a criminal nature. The court did not suggest that the part which was not punitive could be re-examined, and the question was not before the court. Nevertheless we derive the impression from the opinion that it was not the meaning of the court that there should be a partial review only, and that the court regarded the whole proceeding as open to review, because it was one which was to be regarded as having for its primary though not its sole purpose the vindication of the authority of the court.

This court had occasion to consider the propriety of such an order in *Cary Manufacturing Co. v. Acme Flexible Clasp Co.*, 108 Fed. 873, 48 C. C. A. 118. In that case we said:

“The power of the circuit court to direct the payment of part or all of the fine to the complainant in an application for contempt, as a compensation for his time and outlay in prosecuting the application, has been recognized often in the circuit courts, especially in this circuit, and in practice is a power which ought to be exercised when the expense and trouble to which the complainant has been subjected justified its exercise.”

Some of the adjudged cases in which the practice has been

sanctioned are cited in the opinion in that case. There are cases in which the court upon the hearing may be able, from the depositions and from the character of the proceeding, to award the complaining party a sum which will not exceed a fair indemnity, and in which it may be proper to do so without incurring the expense of a reference to a master or the taking of further proof. In *Macaulay v. White Sewing Machine Co.* (C. C.) 9 Fed. 698, Judge Blatchford directed the defendant to pay a fine of \$250, "to go to the plaintiff towards his expenses and counsel fees about this motion." In *re North Bloomfield Gravel Mining Company* (C. C.) 27 Fed. 795, Sawyer, C. J., in imposing a fine of \$1,500, directed that the whole be paid to the complainant, "as a compensation, in part for the large expenses that must have been incurred in procuring evidence and prosecuting this proceeding for contempt." In *Ready Roofing Co. v. Taylor*, 15 Blatchf. 94, Fed. Cas. No. 11,613, the order adjudging the defendant guilty of contempt directed an account to be taken by a master of the damages caused by the act of the defendants, and then fined them in that amount, together with the costs of the proceeding. In *Doubleday v. Sherman*, 8 Blatchf. 45, Fed. Cas. No. 4,020, the defendant was fined in the sum of \$3,703, part of the amount being the taxed cost of the proceeding, and the balance for solicitors' and counsel's fees and disbursements, which had been ascertained upon a reference. In *Searls v. Worden* (C. C.) 13 Fed. 716, the court awarded the proved expenses of the complainant, but refused to allow a counsel fee which had been charged of \$1,000, Judge Brown (now Mr. Justice Brown) saying, "I am not disposed, however, to impose upon the defendants the burden of paying the fees of complainant's counsel, brought here from a distance to press this motion." In *re Tift* (D. C.) 11 Fed. 463, the court allowed the complaining party \$1,000 "in reimbursement of the expenses and trouble" of the contempt proceeding. In *Wells, Fargo & Co. v. Oregon Railway & Navigation Co.* (C. C.) 19 Fed. 20, the court ordered a reference to a master to ascertain what loss, expense, or injury the plaintiff had sustained by reason of the misconduct of the defendant, "with a view of enabling the court to impose by way of punishment a corresponding penalty on the defendant for the benefit of the plaintiff." In *Indianapolis Water Co. v. American Straw Board Co.* (C. C.) 75 Fed. 972, the court ordered the fine to be paid to the clerk for the use of the complainant, and fixed the amount at \$250, "as a moderate allowance for solicitor's fees," together with taxable costs.

It will thus be seen that the practice has not been uniform, and that in some of the adjudged cases the award, like that in the present case, was for a round sum, not based upon any proved items of loss or expense, but apparently intended to cover prob-

able loss and expenses. It is obvious that a fine exceeding the indemnity to which the complainant is entitled is purely punitive, and, notwithstanding the foregoing precedents to the contrary, we think that when it is imposed by way of indemnity to the aggrieved party it should not exceed his actual loss incurred by the violation of the injunction, including the expenses of the proceedings necessitated in presenting the offense for the judgment of the court. We are also of the opinion that when the fine is not limited to the taxable costs it should not exceed in amount the loss and expenses established by the evidence before the court. Unless it is based upon evidence showing the amount of the loss and expenses, the amount must necessarily be arrived at by conjecture, and in this sense it would be merely an arbitrary decision. Another reason why it should be based upon evidence is that otherwise the question of its reasonableness can not be re-examined upon an appeal from a final decree in the cause, and the appellate court would have to treat the fine as a purely arbitrary one, or deny to the appellant his right of review.

The orders under review did not proceed upon any estimate of the actual loss or expenses which the complainant had incurred made from the evidence before the court, and for this reason we think they were erroneous. It may be that the sum directed to be paid to the complainant in the first proceeding was not excessive in amount, but whether it was or was not, and how much of it was intended to cover the expenses of the proceeding, and how much the loss directly suffered by the violation of the injunction, can only be conjectured. The amount directed to be paid to the complainant in the second proceeding is so large that it is difficult to believe that it was not excessive. It follows that, although so much of the orders as directs the payment of half of the fine to the clerk for the use of the United States should be affirmed, that part which directs the payment of half to the complainant should be reversed, with instructions to the court below to take evidence and order payment to the complainant of such sum only as may be found to be a sufficient indemnity.

The orders are accordingly affirmed in part and reversed in part, with instructions to the circuit court to proceed conformably to this opinion.

1102. IN RE CHRISTENSEN ENGINEERING COMPANY 194, U. S. 458, 48 L. ed. 1072 (1904).* * *

Mr. Chief Justice Fuller delivered the opinion of the court:

The examination in *Bessette v. W. B. Conkey Co.*, just decided, 194 U. S. 324, of the right of review in contempt cases, precludes the necessity of extended discussion.

In that case *Bessette* was not a party to the suit, and the con-

trover had been settled by a final decree, from which, so far as appeared, no appeal had been taken. He was found guilty of contempt of court, and a fine of \$250 imposed, payable to the United States, with costs.

In this case the Christensen Engineering Company was a party. The contempt was disobedience of preliminary injunction, and the judgment in contempt was intermediate the preliminary injunction and the decree making it permanent. The fine was payable, one-half to the United States, and the other half to the complainant.

The distinction between a proceeding in which a fine is imposed by way of compensation to the party injured by the disobedience, and where it is by way of punishment for an act done in contempt of the power and authority of the court, is pointed out in *Bessette's Case*, and disclosed by some of the cases referred to in the opinion.

In *New Orleans v. New York Mail S. S. Co.*, 20 Wall. 387, 22 L. ed. 354, the act in contempt was by one not then a party to the suit. No order was entered against him until the final decree in the case, and then he was punished for the act of disobedience, purely as an act of a criminal nature, and without compensation to the plaintiff in whose favor the injunction was originally ordered. No review under the then existing law was allowable. In *Hayes v. Fischer*, 102 U. S. 121, 26 L. ed. 95, the contempt proceeding was remedial and compensatory, and the entire amount of the fine was ordered paid to the plaintiff in reimbursement. It was held that, if the remedial feature was alone to be considered, and the proceeding regarded as a part of the suit, it could not be brought to this court by writ of error, but could only be corrected on appeal from the final decree; if to be regarded as a criminal action, then it was one of which this court had no jurisdiction, either by writ of error or appeal. In *Ex parte Debs*, 159 U. S. 251, 15 Sup. Ct. 1039, there was nothing of a remedial or compensatory nature. No fine was imposed, but only a sentence of imprisonment. This court had no jurisdiction of a writ of error in such a case. And see *O'Neal v. United States*, 190 U. S. 36, 47 L. ed. 945, 23 Sup. Ct. 776. In *Worden v. Searls*, 121 U. S. 14, 30 L. ed. 853, 7 Sup. Ct. 814, the proceeding was remedial and compensatory, in that for violations of a preliminary injunction the defendants were ordered to pay the plaintiff \$250 "as a fine for said violation," by one order, and, by another order, to pay a fine of \$1,182 to the clerk, to be paid over by him to the plaintiff for "damages and costs," the \$1,182 being made up of \$682 profits made by the infringement, and \$500 expenses of plaintiff in the contempt proceedings. These interlocutory orders were reviewed by this court on appeal from the final decree, and as that decree was reversed, the orders were also set aside, this

being done "without prejudice to the power and right of the circuit court to punish the contempt referred to in those orders, by a proper proceeding." It was also said "that, though the proceedings were nominally those of contempt, they were really proceedings to award damages to the plaintiff, and to reimburse to him his expenses."

These authorities show that when an order imposing a fine for violation of an injunction is substantially one to reimburse the party injured by the disobedience, although called one in a contempt proceeding, it is to be regarded as merely an interlocutory order, and to be reviewed only on appeal from the final decree.

In the present case, however, the fine payable to the United States was clearly punitive and in vindication of the authority of the court, and we think, as such, it dominates the proceeding, and fixes its character. Considered in that aspect, the writ of error was justified, and the circuit court of appeals should have taken jurisdiction.

Petitioner entitled to mandamus.

1103. BULLOCK ELECTRIC & MFG. CO. v. WESTINGHOUSE, 129 Fed. 105, 63 C. C. A. 607 (1904, Sixth Circuit).* * *

Before Lurton, Severens, and Richards, Circuit Judges.

Lurton, Circuit Judge, after making the foregoing statement of the case, delivered the opinion of the court.

1. The willful violation of an injunction by a party to the cause is a contempt of court constituting a specific criminal offense. *Ex parte Kearney*, 7 Wheat. 38, 42, 5 L. ed. 391; *Crosby Case*, 3 Wilson, 188; *New Orleans v. Steamship Co.*, 20 Wall. 387, 392, 22 L. ed. 354; *Hayes v. Fischer*, 102 U. S. 121, 26 L. ed. 95; 4 Ency. Pl. & Pr. 766 et seq.

It is immaterial to consider the distinction sometimes noticed between criminal and civil contempts, inasmuch as both kinds involve the vindication of the authority of the court, whether the remedy incidentally inure to the benefit of a party or not. *Cyclo. Law & Proc.* 6 et seq.

The proceeding to punish for a contempt is in its nature a criminal proceeding, whether the result be partially remediable or not, and the same rules prevail which govern in the trial of indictments, the defendant being entitled to the benefit of any reasonable doubt. *Accumulator Co. v. Consolidated Electric Co.* (C. C.) 53 Fed. 793; *In re Acker* (C. C.) 66 Fed. 291; *Harwell v. State*, 10 Lea 544; 4 Ency. Pl. & Pr. 768 et seq.; *U. S. v. Jose* (C. C.) 63 Fed. 951.

Although the contempt consists in the violation of an injunction granted by a court of equity, the proceeding for its punish-

ment "is a new and distinct proceeding, and is quite independent of the equities of the case on which the decree is founded," and "an appeal is not an appropriate remedy for obtaining a review." *City of Frankfort v. Deposit Bank of Frankfort* (decided at February session of this court) 127 Fed. 812; *New Orleans v. Steamship Co.*, 20 Wall. 387, 392, 22 L. ed. 354; *In re Chetwood*, 165 U. S. 443, 17 Sup. Ct. 385, 41 L. ed 782.

Is it reviewable by a writ of error? A contempt proceeding is classified as a misdemeanor and not as a felony. *In re Acker* upon writ of error by virtue of the broad appellate powers conferred by the act of March 3, 1891, c. 517, 26 Stat. 826 (U. S. Comp. St. 1901, p. 547), establishing circuit court of appeal, and defining and regulating the appellate powers of United States courts. If, therefore, the imposition of the fine complained of "was a judgment in a criminal case" as it is defined to be in *New Orleans v. Steamship Co.*, 20 Wall. 387, 392, 22 L. ed. 354, it was a judgment in a misdemeanor case; for contempts are universally classified as misdemeanors, and not felonies. *In re Acker* (C. C.) 66 Fed. 291. If a judgment in a misdemeanor case, it is reviewable upon writ of error by this court. This conclusion was reached by the circuit court of appeals for the second circuit in *Gould v. Sessions*, 67 Fed. 163, 14 C. C. A. 366. But in *Nassau Electric R. Co. v. Sprague Electric Co.*, 95 Fed. 415, 37 C. C. A. 146, and *Christensen Engineering Co. v. Westinghouse Air Brake Company* (decided Feb. 15, 1904) 129 Fed. 96, writs of error were dismissed upon the authority of *In re Debs*, 158 U. S. 564, 573, 15 Sup. Ct. 900, 39 L. ed. 1092.

In the statement of the *Debs* Case, at page 573, 158 U. S., and page 903, 15 Sup. Ct., 39 L. ed. 1092, it is stated that the defendants in that case had "applied to this court for a writ of error, and also one of habeas corpus. The former was denied, on the ground that the order of the circuit court was not a final judgment or decree." The only report of the decision on the writ of error is found in 159 U. S. 251, 15 Sup. Ct. 1039, where the statement is, "Petition denied."

The supreme court had no jurisdiction in respect of writs of error in misdemeanor cases, and the writ of error upon this ground was necessarily denied. The reporter's statement that it was denied because the order "was not a final judgment or decree" is doubtless an error. Certainly we do not feel justified in departing from the well-settled doctrine, so often enunciated in former cases, in respect of the distinctness of a judgment imposing a fine for a contempt from the case in which the disobeyed order was made, upon so slender an authority. If the judgment, as in this case, was in fact unconditional and absolute, so that nothing remained but to execute it, it was in every sense a final judgment.

The claim that a defendant in such circumstances must await the final result of the cause in which the injunction was granted before he can have the judgment inflicting fine or imprisonment reviewed upon the theory that the judgment is not final is absolutely unsupportable. If it be an independent and distinct proceeding from the residue of the case, it will be no more final after that case has reached a final decree than when the fine was imposed. To say that he may pay his fine or endure his imprisonment and review the legality of the matter at some indefinite time in the future is to deny, in effect, the right of review at all. The motion to dismiss the writ is denied.

Was the defendant, on the conceded facts of the case, guilty of contempt as matter of law? Upon this writ of error no question as to whether the injunction was rightly or wrongly, providently or improvidently, issued can arise. The court confessedly had jurisdiction of the parties and of the subject-matter, and the bill of exceptions recites that the temporary injunction was issued upon bill, answer, exhibit, affidavits, "and upon the agreement of the defendant."

Neither is the result to turn upon any question of conflicting fact, for it is not the province of a reviewing tribunal to weigh the facts upon a writ of error. * * *

[See No. 1101.]

[In the case of *Solar Light Company v. Rubin*, Judge Lacombe is unofficially reported to have made the statement in the United States Circuit Court for the southern district of New York, from the bench, at a hearing of a contempt motion on October 6, 1911, substantially as follows:

"The *Gompers* case, (221 U. S. 492) held this:

"In a case of an order of the circuit court directing a man to do something, the court, on an application to punish for contempt may imprison him until he obeys the order.

"If the court orders a man not to do something and he disobeys the order of the court, on an application to punish for contempt can not imprison the man for that contempt nor punish by a fine for the benefit of the United States. The utmost measure of the fine it may impose is the exact amount of money the complainant can show he has lost by the specific act of which he complains.

"Nevertheless, if the papers show the order of the court has been disobeyed and the matter is flagrant enough the matter may be brought to the attention of the district attorney for criminal action.

"Of course I realize that this puts an almost impossible burden on the complainant.

“Counsel: Then do I understand your honor to mean that this court is practically powerless to enforce its decrees?”

“The Court: Unless the actual money loss can be shown it would seem so.”

In the case of *Victor Talking Machine Company v. Spiegel*, the same judge, on motion to punish for contempt, filed a short opinion as follows:

“Lacombe, C. J.

“Disobedience of an injunction forbidding the further sale of infringing machines is undoubtedly shown and were it not for the decision of the supreme court in the *Gompers* case, 221 U. S. 492, I should be inclined to inflict some fine proportioned to the gravity of the offense. But that decision seems to hold that the fine to be inflicted in a civil application to punish for contempt can be only one calculated to make the complainant whole for such loss or damage as it has sustained by reason of the forbidden sale. There is nothing in the papers to show the extent of such loss or damage and the motion must therefore be denied.”

Under the old rulings of the court, prior to the decision in the *Gompers* case, it was not necessary that the papers should show the extent of the loss or damage such as referred to in the last mentioned case.

In another case of *Victor Talking Machine Company et al. v. Louis Greenberg*, in the same court a like disposition was made of the motion to punish for contempt.]

[Pending legislation in the 62d Congress if resulting in the passage of the “injunction act” will not, it is thought, alter the situation in patent causes.]

1104. KREPLIK v. COUCH PATENTS CO. 190 Fed. 565, 111 C. C. A. 381 (1911, First Circuit, Patent No. 712,718).

Before Aldrich, Brown and Hale, District Judges.

Hale, J.:

The defendant says that, having adjudged him guilty of contempt, the circuit court had no jurisdiction to order him to pay a fine for use of the petitioner; but that its action was in excess of its jurisdiction, and void.

Let us look at the precise action which is brought before us. The final decree shows that the circuit court did three distinct things: First, the court found that the defendant, Samuel Kreplik, had violated the injunction of the court; second, the court ordered Samuel Kreplik to pay a fine of \$500 to the clerk of the court for the use of the petitioner within ten days from the date of the decree; third, the court ordered Samuel Kreplik to be im-

prisoned for ten days. The court further provided for necessary process to enforce its order.

It appears, then, that the circuit court provided compensation to the petitioner for the losses it had suffered by reason of Krep-lik's act of contempt. This court is not called upon to pass upon the question whether or not the compensation so awarded is excessive. Questions as to the amount of compensation to the petitioner are not properly raised. While the defendant assigned as error that the circuit court imposed a fine in the absence of evidence showing the expenses incurred by the petitioner, he did not rely upon such assignment in his exceptions. He did not make them a part of his exceptions. Thus the question of the reasonableness of compensation is not before us. In *Merchants' Stock & Grain Company v. Chicago Board of Trade*, 187 Fed. 398, 109 C. C. A. 230, the circuit court of the eighth circuit has recently considered the question in relation to what matters may be passed upon under a writ of error, and what questions may be reviewed only by appeal.

The courts of the United States recognize that the process of contempt has two distinct aspects—one criminal to punish disobedience; and the other remedial and civil to enforce a decree of the court, and to compensate private persons. In *Re Christensen Engineering Co.*, 194 U. S. 458, 24 Sup. Ct. 729, 48 L. ed. 1072, it was held by the supreme court that, where the fine for violation of an injunction is to reimburse the party injured by the disobedience, it has not a punitive character; but, where the fine is payable to the United States, it is clearly punitive and in vindication of the authority of the court. *Bessette v. Conkey*, 194 U. S. 324, 24 Sup. Ct. 665, 48 L. ed. 997. In *Gompers v. Bucks Stove & Range Co.*, 221 U. S. 418, 31 Sup. Ct. 492, 55 L. ed. 797, the supreme court has lately passed upon this question. The court clearly draws the vital distinction between proceedings for civil contempt, which are between the original parties, and proceedings at law for criminal contempt, which are between the public and the defendant. The court holds that the proper remedial relief for a disobedience of an injunction in the equity cause before it would have been to have imposed a fine for the use of the complainant, measured in some degree by the pecuniary injury caused by the act of disobedience.

The two aspects of contempt proceedings have often been before the circuit court in this circuit, where it has been clearly recognized that in an equity cause a fine for contempt imposed for the use of the petitioner is not a punitive fine, but merely indemnity to the petitioner for the loss occasioned to him by the offensive acts of the defendant. In the case at bar the circuit court, under the third paragraph of its decree, gave suitable compensation to petitioner; and, while the compensation is spoken of

as a fine, it clearly is not such a fine as can be held to be punitive within the meaning of the law.

We have now considered only the question whether the circuit court could properly, under the circumstances of the case, impose a fine upon the defendant for the use of the petitioner, without regard to the form of proceeding. We shall later in this opinion consider the question whether the circuit court could properly pass upon the punitive and remedial elements in one and the same proceeding.

We have no doubt that the action of the circuit court in giving its remedial relief was free from error. The action of the circuit court in giving compensation to the petitioner was in our opinion lawful in accordance with the practice of the court in this circuit, and with the rule of the supreme court.

3. Did the circuit court err in ordering the defendant to be imprisoned for ten days?

In the *Gompers* case the supreme court has exhaustively considered the whole subject of contempt. The court there points out that contempts are neither wholly civil nor altogether criminal; and that it is not always easy to classify a particular act as belonging to either of these two classes. The court there had to determine whether the case before it was one of criminal contempt; and it was compelled to give a critical examination to the pleadings, the procedure, the attitude of the parties to the case, and to all the special facts in the proceeding. The case arose upon an appeal which presented everything in the record. The court found that it was a case of purely civil contempt; but that the court below had undertaken to proceed as in a criminal case, had found guilt, and imposed sentence, without having made it clear to the defendants that they were being tried upon a criminal charge, that the defendants had been forced to testify without knowing that they were being heard upon a charge and not upon a suit. From the special circumstances of the case the court clearly showed that the defendants were not given the protection to which respondents are entitled in a case where guilt or innocence are brought in question, and where the liberty of the citizen is involved. The court showed that both parties to the controversy treated the proceeding as purely and solely civil, and not involving a criminal charge. The court clearly pointed out that in a case of doubt the mutual understanding of the parties is of controlling force, and often determines the question of whether the civil or the criminal element dominates the proceeding.

The case at bar comes before us upon a writ of error, and presents only such questions as arise under the exceptions and are stated in the assignment of errors. This contempt proceeding was distinct and separate from the original equity cause. It

arose upon a petition for contempt in which the petitioners stated facts sufficient to bring before the court both the civil and criminal elements of contempt, and in which the aid of the court was invoked, both to compensate the complainant and also to vindicate its authority. The case clearly shows that the defendant had a fair and full trial on the question of criminal contempt. At the special request of the defendant himself, the circuit court ruled that:

"This proceeding is a criminal proceeding, reviewable in error; and the rule of evidence as to the proof of the offense beyond a reasonable doubt, including the element of criminal contempt, is applicable."

This ruling gave the defendant the clear, specific safeguard of a trial upon a criminal charge. There was a common understanding of all parties that he was having such trial. He has had his day in court at a hearing in which the criminal element dominated the proceeding; and he himself admits that he has been tried and sentenced upon a criminal proceeding, where the rule of evidence as to the proof of the offense beyond a reasonable doubt was made to apply. It is not, then, necessary to critically consider the forms of the proceeding, to find out that the defendant had the proper protection to which he was entitled in a case where a criminal charge was made against him. It is true that in the case at bar many of the different forms were present which in the Gompers case induced the supreme court to hold that proceeding to be solely a civil one; but the court was providing for the ample protection of the citizen where a criminal charge is made against him. It was not undertaking to enumerate the different things which must be present in order to make a criminal proceeding. The case now before us was, in its dominant element, confessedly and unquestionably a criminal proceeding. We are not obliged to examine the mere forms, to find its character.

In our opinion the sentence of ten days imprisonment was properly and lawfully imposed.

4. Was it error for the circuit court to pass upon both the punitive and remedial elements in one proceeding?

The circuit court imposed a punitive sentence. By its ruling it allowed the criminal element to dominate the proceeding. It also made an award of compensation for the complainant. Of this latter action the defendant complains, and says that it was error for the court to take such action. We have already discussed the award of compensation, standing by itself, and have found it to be free from error. It is our duty now to briefly consider the question presented by the circuit court having taken action upon both the punitive and civil aspects of the case in one proceeding,

although there may be doubt whether this question fairly arises upon this writ of error.

In discussing the action of the court upon the criminal side we have found that the mutual understanding of the parties was of great and, perhaps, determining force. Here again, upon the remedial side, the understanding of the parties is of great moment. The record shows that, while the defendant requested the court to rule that the case was a criminal one, the defendant also requested rulings which pertained simply and only to the civil side of the case. It appears then that both parties assumed that, while the civil rights of the parties were involved, the court was asked to proceed further to vindicate its authority. The circuit court made its two awards, its compensatory award and its punitive award, in one proceeding. In doing so it followed the practice of the courts in this circuit and in other circuits. This practice had no less a sanction than that of Judge John Lowell, and of Judge Nelson in *Hendryx v. Fitzpatrick* (C. C.) 19 Fed. 810, 813, where the court in this circuit held that the process of contempt had two distinct functions, one criminal to punish disobedience, and the other civil and remedial; that in patent causes the practice has been to combine the two under a proper proceeding, and to order punishment if it is thought proper, and to indemnify the plaintiff if it is thought proper, or to do both if justice requires; that in patent causes it has been usual to embrace the public and the private remedy in one proceeding. This has been held to be the proper practice by Mr. Justice Miller in *Re Chiles*, 22 Wall. 157, 168, 22 L. ed. 819.

In the *Gompers* case the court has nowhere said that this practice of the several circuits in patent causes is improper or illegal. Under the principles announced in that case, it must, of course, appear in a cause in equity that, before imposing a sentence for criminal contempt, the court distinctly gave the defendant his day in court and allowed him a full and fair hearing upon a criminal charge. In that case the supreme court recognizes that the practice with reference to contempt proceedings has been unsettled. It does not condemn the practice of the circuit court in the several circuits in equity causes in passing upon the punitive and civil aspect of the case in one proceeding. It does, however, hold with great force and clearness that a citizen should not be compelled to face a criminal charge without being fully advised that he is facing such charge. We do not find that the supreme court has ever said that any particular form of proceeding is required, providing the defendant is left in no doubt as to what charge is made against him. In the *Gompers* case the court further points out that, in United States Revised Statutes, § 725 (U. S. Comp. St. 1901, p. 583), Congress has declared the power which already inhered in courts to punish contempts of their au-

thority. It seems clear that by that statute the Congress did not undertake to limit the courts in the rights which they already possessed, to act promptly and independently in any competent proceeding for the purpose of enforcing their judgments and punishing disobedience. The supreme court has long since taken the view that such statutes as the one in question are legislative assertions of this right of courts; that this right is incidental to the grant of judicial power, and could have been exercised without the aid of the statute; that such legislative grant of power can be considered either as an instance of abundant caution or a legislative declaration that the power of punishing for contempt shall not extend beyond its acknowledged limits of fine and imprisonment. *Anderson v. Dunn*, 6 Wheat. 204, 227, 5 L. ed. 242; *Bessette v. Conkey*, 194 U. S. 327, 24 Sup. Ct. 665, 48 L. ed. 997. In *Re Christensen Engineering Co.*, 194 U. S. 458, 24 Sup. Ct. 729, 48 L. ed. 1072, the supreme court further said that, where a court is proceeding in vindication of its authority, this element dominates the proceeding, and is reviewable by the circuit court of appeals on writ of error. It is clear, then, that in a proceeding where both the remedial and punitive elements are brought before the court the criminal element must control. But in saying that the criminal element dominates the proceeding the supreme court does not say that such domination excludes the remedial element from being considered, or prevents a judge in a case like the one before us from vindicating the court's authority by punitive action, and at the same time applying remedial relief.

In the case at bar the circuit court gave the defendant a full hearing upon all the civil and remedial aspects of the case at the same time that it gave him a trial upon the charge for criminal contempt. The defendant fully understood that he was being tried upon the remedial aspects of the case as well as upon a criminal charge. He asked for rulings touching both aspects of the cause. There was no necessity for the circuit court to delay the administration of justice by dividing the two elements, and insisting upon separate proceedings in each element. If there had been such necessity, the court might have proceeded with the remedial side of the case, and have then granted a motion to show cause at a further hearing why the defendant should not be tried upon the charge for criminal contempt. But in the proceeding before it the circuit court found that, upon a proper petition, upon ample notice, and with a full understanding, the parties might properly be heard upon both elements, and it allowed the criminal element to dominate the proceeding. Under the principles of the *Gompers* case, and under the prevailing practice of this circuit, we find no error in the action of the circuit court.

The judgment of the circuit court is affirmed.

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

1105. *IN RE STEINER ET AL.*, 95 Fed. 299 (1912, C. C. N. Y.).

Lacombe, J:

On Reargument.

Upon consideration of the arguments presented at the rehearing, I am satisfied that there was error in the decision filed February 2, 1912, holding that the various acts complained of were not committed in the presence of the court, or so near thereto as to obstruct the administration of justice. The opinions cited—*Ex parte Savin*, 131 U. S. 267, 9 Sup. Ct. 699, 33 L. ed. 150, and *Kirk v. U. S.*, 163 U. S. 49, 16 Sup. Ct. 911, 41 L. ed. 66—are persuasive to a contrary conclusion. There is no essential difference between “obstructing the administration of justice,” by tampering with a juror or a witness, or by preparing, verifying, and securing the presentation of a false affidavit, intended to influence the action of a court.

The former order of dismissal, if it has been actually entered, is therefore vacated and set aside, and the motion to dismiss the proceedings is denied.

The cause will be taken up for hearing on Monday, May 27th, at 10:30 a. m. As there may be conflicting testimony, which will present a question of fact as to what was or was not in fact done, there will be a jury in attendance, to whom there may be submitted such concrete questions of fact as may at the time seem desirable. This does not mean that the whole case will be tried by the jury. The trial is one for the court, but the court is willing to have a jury decide which of two or more opposing witnesses is truthfully stating the facts.

Since a panel is specially called for this date (May 27th), counsel for both sides must be prepared to go on when the case is called.

1106. *BULLOCK, ETC., MFG. CO. v. WESTINGHOUSE, ETC., MFG. CO.*, 129 Fed. 105, 63 C. C. A. 607.

The willful violation of an injunction by a party to the cause is a contempt of court constituting a specific criminal offense. *Ex parte Kearney*, 7 Wheat. 38, 42, 5 L. ed. 391; *Crosby case*, 3 Wilson, 188; *New Orleans v. Steamship*, 20 Wall. 387, 392, 22 L. ed. 354; *Hayes v. Fisher*, 102 U. S. 121, 26 L. ed. 95; 4 *Ency. Pl. & Pr.* 766 et seq. It is immaterial to consider the distinction sometimes noticed between criminal and civil contempts, inasmuch as both kinds involve the vindication of the authority of the court, whether the remedy incidentally inure to the benefit of a party or not. *Cyclo. Law & Proc.* 6 et seq.

The proceeding to punish for a contempt is in its nature a criminal proceeding, whether the result be partially remediable or not, and the same rules prevail which govern in the trial of indictments, the defendant being entitled to the benefits of any reasonable doubt. *Accumulator Co. v. Consolidated Electric Co.*, (C. C.) 53 Fed. 793; *In re Acker*, (C. C.) 66 Fed. 291; *Harwell v. State*, 10 Lea 544; 4 *Ency. Pl. & Pr.* 768 et seq.; *U. S. v. Jose*, (C. C.) 63 Fed. 951.

* * *

A contempt proceeding is classified as a misdemeanor and not as a felony. *In re Acker*, (C. C.) 66 Fed. 291. Misdemeanors are reviewable by this court upon writ of error by virtue of the broad appellate powers conferred by the act of March 3, 1891, c. 517, 26 Stat. 826, * * * establishing Circuit Courts of Appeal, and defining and regulating the appellate powers of United States courts. If, therefore, the imposition of the fine complained of "was a judgment in a criminal case," as it is defined to be in *New Orleans v. Steamship Co.*, 20 Wall. 387, 392, 22 L. Ed. 354, it was a judgment in a misdemeanor case; for contempts are universally classified as misdemeanors, and not felonies. *In re Acker*, (C. C.) 66 Fed. 291. If a judgment in a misdemeanor case, it is reviewable upon writ of error to this court. This conclusion was reached in the Second Circuit in *Gould v. Sessions*, 67 Fed. 163. But in *Nassau v. Sprague*, 95 Fed. 415, and *Christensen v. Westinghouse*, 129 Fed. 96, writs of error were dismissed upon the authority of *In re Debs*, 158 U. S. 564, 573, 15 Sup. Ct. 900, 39 L. ed. 1092.

[See for full statement No. 1103.]

1107. DUBOIS v. KIRK, 158 U. S. 58, 39 L. ed. 895, 15 Sup. Ct. 729.

This court has held in several cases that an appeal does not lie from a decree for costs; and if an appeal be taken from a decree upon the merits, and such decree be affirmed with respect to the merits, it will not be reversed upon the question of costs.

1108. JOHNSON v. FOOS MFG. CO., 141 Fed. 73, 72 C. C. A. 105.

If the mandate of this court requires the trial court to enter a decree sustaining some parts of the patent and finding infringement, the statute will then have application and the patentee will not be allowed his costs because he had entered his disclaimer before starting his suit and had put the defendant and the public to the disadvantage incident to his having asserted certain parts of his patent without right. We are not satisfied that either section [R. S. 973 and 4922] applies to a decree of this court where the decree of the court below is found erroneous, and that court is directed to enter a decree sustaining some of the claims

of the patent in suit. If that court had rendered the proper decree, the patentee would not have been compelled to come here to obtain that measure of relief to which it is found he was entitled. It would be a harsh rule that would not allow him to recover the costs of his appeal from an erroneous decree so far as relief was denied upon the claim of his patents which were good because success had not attended the whole of his contention.

1109. ECAUBERT v. APPLETON, 67 Fed. 917, 15 C. C. A. 73.

There was, however, so much irrelevant matter introduced into the case as to make it inequitable that the defendant should pay the costs in this court, and he should not be compelled to pay the costs in the circuit court which were caused by this class of evidence.

1110. LEE INJECTOR MFG. CO. v. PENBERTHY INJECTOR CO., 109 Fed. 964, 48 C. C. A. 760.

That \$20.90 paid by appellate to the commissioner of patents for copies of patents for insertion in the printed record be taxed as costs of appeal. This is allowed. It is part of the cost of printing the record, and therefore taxable here.

1111. SIZER v. MANY, 16 How. (U. S.) 98, 14 L. ed. 861.

The costs are, perhaps, never in fact, taxed, until after the judgment is rendered; and in many cases, can not be taxed until afterward. And where this is the case the amount ascertained is usually, under the direction of the court, entered nunc pro tunc as a part of the original judgment. And this mode of proceeding is necessary for the purposes of justice, in order to afford the necessary time to examine and decide upon the several items of costs, to which the successful party is lawfully entitled.

1112. BRUSH ELECTRIC CO. v. CALIFORNIA ELEC. LIGHT CO., 52 Fed. 945, 3 C. C. A. 368.

The Brush Company would undoubtedly have the right to be protected from any costs that might be adjudged against it, or incurred in the management of the suit in question. The court, upon proper motion, would without doubt compel this protection. The usual practice is in such cases, to require a sufficient bond of indemnity. Under such conditions there would be an implied contract on the part of the Brush Company to permit the use of its name by the California Company.

1113. JOHNSON v. FOOS MFG. CO., 141 Fed. 73, 72 C. C. A. 105.

In equity cases this court directs the imposition of costs according to the circumstances, and apportions them or denies cost altogether by no iron-clad rule. Indeed, such a rule could not be well prepared, and would more often than otherwise lead to injustice.

1114. MOTION PICTURE PATENTS CO. v. YANKEE FILM CO., 192 Fed. 134 (District Court, S. D. New York, 1912).

These cases, therefore, in my judgment, furnish an opportunity for applying section 982 Rev. Stat. U. S. (U. S. Comp. St. 1901, p. 706), if in that enactment the word "costs" is to be construed as including expenses. While without authority on this point, I think the statute should be so construed, for it does not speak of multiplying causes, but of multiplying "proceedings in any cause." Under the present statute regarding fees and costs, it is difficult to perceive how costs *eo nomine* can be multiplied "in any cause"; but expenses and taxable disbursements can be so multiplied with ease.

In this case I think such multiplication took place, and occurred unreasonably and vexatiously, by reason of the taking of testimony after petition for reissue filed. The amount of annoyance and expenses caused thereby (so far as shown by these papers) does not warrant any such allowance or measurement as is asked for by defendants.

The bills will be dismissed, and the excess of costs (i. e., expenses) in each case fixed at \$150.

1115. CHEATHAM ELECTRIC SWITCHING DEVICE CO. v. TRANSIT DEVELOPMENT CO. ET AL., 197 Fed. 563. (District Court, E. D. New York, 1912).

It would seem that the delay in removing the original trolley pans, in the place of merely disconnecting the wires operating the same, was not such a contempt as should be punished, beyond the expense of ascertaining whether the defendants had complied with the orders of the court. And in the same way, the failure on the part of one defendant to avoid the use of similar structures upon the other systems, can not be justified, but it is nevertheless somewhat excusable, inasmuch as it was remedied as soon as pointed out.

The complainant, however, having been put to the expense of bringing the matter to the attention of the defendants, and while admitting their good faith, being compelled to bring, at the cost of his own time and effort, the defendants to a realization of the facts, should not be left entirely without a remedy. The legal

expense connected with the first application has been stated under oath to be \$75, and the witness Cheatham was shown by the affidavits to have devoted considerable time to an inspection of the devices necessary to making said motion.

It would seem that a denial of the motion to punish the defendants for contempt, upon the payment of \$50 by the Nassau Electric Railroad Company, and \$100 by the Transit Development Company, to the complainant, would be equitable under the circumstances.

SUPPLEMENTARY NOTES

These notes are intended primarily to bring various topics up to the date of issuance of this publication. A few of the notes under "Interference" are in the nature of further explanation. Occasionally some of the notes are repeated under subordinate topics.

The notes are appropriately referenced in the Index.

ACCOUNTING, PROFITS AND DAMAGES.

Damages from Unfair Competition in Patent Litigation.

Ludwigs v. Payson Mfg. Co. and vice versa, 206 Fed. 60, 65, (C. C. A. Seventh Circuit).

"Counsel for Ludwigs cite several cases in support of their contention that under no circumstances can damages from unfair competition be lawfully included in patent litigation between citizens of the same state. Illinois Watch-Case Co. v. Elgin National Watch Co., 94 Fed. 667, 35 C. C. A. 237; Keasby & Mattison Co. v. Philip Carey Mfg. Co. (C. C.) 113 Fed. 432; King v. Inlander (C. C.) 133 Fed. 416; Cushman v. Atlantis Fountain Pen Co. (C. C.) 164 Fed. 94; Mecky v. Grabowski (C. C.) 177 Fed. 591; Johnston v. Brass Goods Mfg. Co. (D. C.) 201 Fed. 368.

* * * Under such circumstances (whether the compactness for cheapness of manufacture and the ornamental form are within the protection of the claims or not) a federal court of equity in granting relief for the infringement of the mechanism ought not to remit the complainant to another forum to mete out the damages which necessarily appear in proving the infringement and which, though in one aspect arising from fraud in trade, in a fairer aspect are aggravations of the infringement. Globe-Wernicke Co. v. Fred Macey Co. (C. C. A., 6th Circuit) 119 Fed. 696, 56 C. C. A. 304; Adam v. Folger (C. C. A., 7th Circuit) 120 Fed. 260, 56 C. C. A. 540; Woods Sons Co. v. Valley Iron Works (C. C.) 166 Fed. 770; Onondaga Indian Wigwam Co. v. Ka-Noo-No Indian Mfg. Co. (C. C.) 182 Fed. 832; Ross v. Geer Co. (C. C.) 188 Fed. 731; Saxlehner v. Eisner & Mendelsohn Co., 179 U. S. 19, 21 Sup. Ct. 7, 45 L. Ed. 60; Siler v. Louisville, etc., R. Co., 213 U. S. 175, 29 Sup. Ct. 451, 53 L. Ed. 753."

Total Profits.

Van Brunt v. LaCross Plow Co., 208 Fed. 281, (Wis.). Discussion of rule permitting recovery of entire profits.

Profits, Measure of.

Dunn Mfg. Co. v. Standard Computing Scale Co., 204 Fed. 617, (C. C. A., Sixth Circuit). The infringing article comprised the features of a patent and a patented improvement on which the defendant paid royalties. Held, that it did not follow that such payment constituted a segregation of profits attributable to the use of the improvement so as to leave all of the remaining profits necessarily attributable to the invention infringed. See this case for citations, illustrations and distinctions.

Profits, Measure of—Trustee.

Carborundum Co. v. Electric Smelting Co. and vice versa. 203 Fed. 976, 981, 982, (C. C. A., Third Circuit). Rule of trustee *ex maleficio* applied.

“A valid process patent, though for a process only, confers on the patentee a right to exclude all others from using such process for the attainment of its object. Others may secure the desired result, if they can, by the employment of a different process, if open to them, but they can not without the leave or license of the patent owner use the patented process with impunity. And on an accounting for profits, and not for damages, in a case of infringement, where profits to the infringer are impossible save through his infringement, he must be treated as a trustee *ex maleficio* and can withhold none of his gains from the patentee. The fact that in such a case the patent is not for the product, but only for the process, is wholly immaterial; for the infringer will not be permitted by a court of equity to take advantage of his own wrong, but will be held accountable as a trustee of the profits.

“It is well settled that, in the case of mechanical inventions, where the infringed patent covers a mere improvement upon mechanism before known and open to the defendant to use, the complainant can recover only the excess of such profits as have been realized through the use of the improvement over what the defendant might have made by the use of such mechanism without such improvement. But it is equally well settled, that where the entire commercial value of the mechanism arises from the patented improvement the owner of the patent will be entitled to recover from the infringer the total profits derived from the manufacture, use or sale of such mechanism. Crosby Valve

Co. v. Safety Valve Co., 141 U. S. 441, 12 Sup. Ct. 49, 35 L. Ed. 809; Westinghouse Co. v. Wagner Mfg. Co., 225 U. S. 604, 32 Sup. Ct. 691, 56 L. Ed. 1222; Manufacturing Co. v. Cowing, 105 U. S. 253, 26 L. Ed. 987; Hurlbut v. Schillinger, 130 U. S. 456, 9 Sup. Ct. 584, 32 L. Ed. 1011; Maimin v. Union Special Mach. Co., 187 Fed. 123, 109 C. C. A. 41; Wales v. Waterbury Mfg. Co., 101 Fed. 126, 41 C. C. A. 250. Manufacturing Co. v. Cowing, *supra*, is strongly analogous to the present case. There the court said:

“If the improvement is required to adapt the machine to a particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has by his infringement secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that market.’”

Trustee.

In re Beckwith, 203 Fed. 45 (C. C. A., Seventh Circuit). Application of rule of trustee *ex maleficio* with citations.

Master—Power Of.

L. S. Starrett Co. v. Brown & Sharpe Mfg. Co., 208 Fed. 887 (C. C. A., First Circuit). The question whether or not the patent is infringed by another structure as made by the defendant after the bringing of the suit and not passed upon by the court, but in respect to which evidence was produced, may be presented to and ruled on by the master.

ACQUISITION OF TITLE—TITLE, GRANT, INHERITANCE, ASSIGNMENT.

Assignment—When Effective.

National Electric Signalling Co. v. Telefunken Wireless Co., 208 Fed. 679 (C. C. A., Third). An assignment of a patent passes title at the date of the execution and delivery, though acknowledged by the assignor at a later date.

Assignment—Acknowledgment—Certified Copies as Evidence.

Toledo Computing Scale Co. v. Computing Scale Co., 208 Fed. 410 (C. C. A., Seventh).

“In regard to the acknowledgment of a corporation’s conveyance, the Massachusetts statutes (Rev. Laws Mass. 1902, c. 127, §§ 7 and 18) required (what is commonly called for in all jurisdictions with which we are familiar) that the notary’s certificate should show that the persons who signed as officers were

personally known to the notary, that on oath they stated they were such officers and were authorized by the board of directors to execute the instrument, and that the corporation either had no seal or that its genuine seal was affixed to the instrument, and that they thereupon acknowledged said instrument to be the free act and deed of the corporation. Execution of the instruments here in question was not proven by testimony. Certified copies of assignments of patents, not duly acknowledged, are not proof of execution. *Paine v. Trask* (C. C.), 56 Fed. 233; *New York v. Cable Ry. Co.*, 60 Fed. 1016, 9 C. C. A. 336; *National Co. v. Navy Co.* (C. C.), 99 Fed. 89. As the acknowledgments of these assignments are insufficient in every respect to constitute good corporate acknowledgments, the record is barren of proof of execution."

See for numerous citations.

Assignment—Partnership.

Fishel Nessler Co. v. Fishel & Co. et al., 204 Fed. 790 (C. C. A., Second). The patentee had assigned his patent to himself and another as partners. Held, estopped to deny valid when sued for infringement by assignee of his partner's interest, whether assignment voluntary or by trustee in bankruptcy.

Assignment—Delivery of Patent.

In *Paine v. Parkhurst*, 205 Fed. 740 (C. C. A., Sixth), it was held that where a contract for the sale of a patent stipulated that the seller of the patent should forward the "original patent papers" together with an assignment, to a bank to be delivered to the purchaser after an examination and upon payment of the price, the delivery of the original letters-patent was a condition precedent necessary to complete the purchase.

(See quotation in note under "Letters-Patent," etc.)

Assignee, Suit By.

Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (C. C. A., Second Circuit). Patentee cannot defend against suit brought by his assignee on the ground that he was induced to part with the patent by unfair representations.

ACTIONS AT LAW.

Directing a Verdict.

Evans v. Southern Pac. Co., 202 Fed. 160 (C. C. A., Ninth Circuit). Where it is clear to the court from undisputed facts

that the plaintiff cannot recover it is its duty to direct a verdict for defendant; but where different minds might reach different conclusions or make different inferences the question is for the jury.

Sec. 721, R. S. U. S.—State Laws.

Old Dominion Co. v. Lewiston et al., 202 Fed. 178 (C. C. A., Second Circuit). All inferior federal courts must follow the law as defined by the Supreme Court of the United States, even if in any case the decision be in conflict with the rules of the Supreme Court of the state on the same facts.

State Laws and Federal Courts.

Harrison et al. v. Foley, 206 Fed. 57 (C. C. A., Eighth Circuit).

"The doctrine of the law of the case in its customary sense does not run from state to federal jurisdiction (*Gardner v. Railroad*, 150 U. S. 349, 14 Sup. Ct. 140, 37 L. Ed. 1107), or conversely. Its application is generally to a second appeal in the same appellate court (*Guarantee Co. v. Insurance Co.*, 59 C. C. A. 376, 124 Fed. 170; *Mutual Reserve Fund Life Ass'n v. Ferrenbach*, 75 C. C. A. 304, 144 Fed. 342, 7 L. R. A. [N. S.] 1163; *Great Northern Ry. Co. v. Western Union Tel. Co.*, 98 C. C. A. 193, 174 Fed. 321), and of course to the courts inferior to that which first ruled."

AMENDMENT, CORRECTION, REPEAL, EXTENSION.

Reissue—Broadened.

Toledo Computing Scale Co. v. Computing Scale Co., 208 Fed. 410 (C. C. A., Seventh Circuit). Example of reissue sustained where the principal part of the invention had been practically missed in the patent by presenting it in a combination claim with particularly described weighing mechanism.

CONTEMPT.

In General—Compensatory Fines.

Morehouse et al. v. Giant Powder Co. et al., 206 Fed. 24 (C. C. A., Ninth Circuit). General discussion of contempt with a special reference to Judicial Code; citation of authorities. A district court has power to punish as a contempt disobedience of an order made previous to the enactment of the Judicial Code.

A compensatory or punitive fine as incident to a decree, essentially civil and remedial. No prescribed form; sufficient if papers clearly apprise the defendant of the nature of the charge.

COSTS.

Affirmed on Merits, Not Reversed on Costs.

Superior Hay Stacker Mfg. Co. v. Dain Mfg. Co., 208 Fed. 549 (C. C. A., Eighth Circuit). Where decree in infringement suit which also awards costs to complainant is affirmed on the merits it will not be reversed as to costs. Citing *Du Bois v. Kirk*, 158 U. S. 58, 67; 39 L. Ed. 895.

COURTS, CAUSES—PRACTICE AND PROCEDURE.

Jurisdiction.

Barker v. Eastman, 206 Fed. 865 (C. C. A., First Circuit). "Inasmuch as the claim is made that certain proceedings subsequent to the filing of the bill here gave the Circuit Court jurisdiction, all we need say in reference to that is that the general principle stated in *Railway Company v. Lewis*, 173 U. S. 457, 19 Sup. Ct. 451, 43 L. Ed. 766, is thoroughly settled that, if it does not appear at the outset that a suit is one of which the Circuit Court, at the time its jurisdiction was invoked, could properly take cognizance, the suit must be dismissed; and lack of jurisdiction cannot be supplied by anything set up by way of defense. This is reaffirmed in *Omaha Electric & Power Company v. Omaha*, 230 U. S. 123, 33 Sup. Ct. 974, 57 L. Ed. 1419. This does not, of course, bar amending a bill or other proceedings in such a way as to show jurisdiction, if in fact the court had jurisdiction."

The court then proceeds to discuss *Payne v. Hook*, 7 Wall. 425, 19 L. Ed. 260, and cites cases limiting or qualifying that case or some expressions of it, these with reference to the necessity of jurisdiction being shown by the bill.

* * * * *

Camp et al. v. Bonsal et al., 203 Fed. 913 (C. C. A., Fourth Circuit). The Act of Congress providing that where the suit is based on diversity of citizenship it shall be brought only in the district of the residence of either the plaintiff or the defendant is subject to exceptions as, for example, in § 8, Act of March 3, 1875, ch. 137, 18 Stat. 472; Judicial Code (Act of March 3, 1911, ch. 231, 36 Stat. 1087.)

* * * * *

American Malting Co. v. Keitel, 209 Fed. 351 (C. C. A., Sec-

ond Circuit). Equity has jurisdiction to restrain one who induces another to break a contract.

* * * * *

Chadeloid Chemical Co. v. Johnson et al., 203 Fed. 993 (C. C. A., Seventh Circuit). Where a contract required licensee to make stated reports, pay royalties, submit his books to inspection, etc., no remedy by suit in equity for infringement.

Jurisdiction—Usage of State Courts.

Foster Milburn Co. v. Chinn, 202 Fed. 175, 177 (C. C. A., Second Circuit).

"It is certainly the general rule of the federal courts that an objection once taken to the jurisdiction is not waived by the defendant's subsequently answering and taking part in the trial. Harkness v. Hyde, 98 U. S. 476, 25 L. Ed. 237. It is also true that the defendant may attack a judgment of the court of another state for lack of jurisdiction, either appearing on the face of the record or proved by testimony. Thompson v. Whitman, 18 Wall. 457, 21 L. Ed. 897. It is, however, the law of the state of Kentucky that though the defendant appear specially to object to the jurisdiction of the court, if he thereafter appeal to a higher court from any judgment recovered against him in the action, he ipso facto waives his objection and transforms his special into a general appearance. It is not necessary for us to determine whether the service of process upon Monroe, as managing agent, was good or bad. We are obliged under section 905, U. S. Rev. St. (U. S. Comp. St. 1901, p. 677), to give full faith and credit to the judgment; that is to say, the same faith and credit it would have 'by law or usage' in the state of Kentucky. So doing, we must treat the defendant as having appeared generally. The trial judge was right in holding that a usage established by the decision of the highest courts of Kentucky is to be given the same effect as if established by statute. In the latter case the Supreme Court has held that such a rule is binding in a suit upon a judgment in the courts of another state. York v. Texas, 137 U. S. 15, 11 Sup. Ct. 9, 34 L. Ed. 604."

Jurisdiction—State and Federal Courts.

Harrison et al. v. Foley, 206 Fed. 57 (C. C. A., Eighth Circuit).

"The doctrine of the law of the case in its customary sense does not run from state to federal jurisdiction (Gardner v. Railroad, 150 U. S. 349, 14 Sup. Ct. 140, 37 L. Ed. 1107), or conversely. Its application is generally to a second appeal in the same appellate court (Guarantee Co. v. Insurance Co., 59 C. C. A. 70, 124 Fed. 170; Mutual Reserve Fund Life Ass'n v. Fer-

renbach, 75 C. C. A. 304, 144 Fed. 342, 7 L. R. A. [N. S.] 1163; Great Northern Ry. Co. v. Western Union Tel. Co., 98 C. C. A. 193, 174 Fed. 321), and of course to the courts inferior to that which first ruled."

Jurisdiction—Mandamus—Master's Summons.

In re Beckwith, 203 Fed. 45 (C. C. A., Seventh Circuit). Circuit Court of Appeals has jurisdiction of petition for mandamus to compel trial court to overrule objection to master's summons requiring the defendant to render a sworn statement of account in accordance with Equity Rule 63.

Jurisdiction—Libel, etc.

American Malting Co. v. Keitel, 209 Fed. 351 (C. C. A., Second Circuit). In the absence of statute and of acts of conspiracy, intimidation, or coercion, the equity courts have no jurisdiction to restrain the future publication and issuance of libelous circulars, though the false statement may injure complainant in his business or as to his property. The court discusses the question at length, citing numerous authorities, and then refers to numerous other cases which have restrained libels saying, however, that in those cases the conspiracies or the intimidation or coercion of the complainant or his customers had been alleged.

Power of Appellate Court to Decide all Questions.

Smith v. Farbenfabriken, 203 Fed. 476, 478 (C. C. A., Sixth Circuit).

* * * "yet the lower court did in fact decide an independent question of general law as also the question of jurisdiction. The assignments of error are addressed to both questions; as to the former, challenging the validity of the order granting a preliminary injunction 'upon the showing made in the bill of complaint and affidavits made in support thereof.' It is settled that in such a case this court has power to hear and decide all the questions. Olds v. Herman H. Hettler Lumber Co., 195 Fed. 9, 11, 115 C. C. A. 91 (C. C. A. 6th Cir.); A. J. Phillips Co. v. Grand Trunk Western Ry. Co., 195 Fed. 12, 15, 115 C. C. A. 94 (C. C. A. 6th Cir.)."

Supreme Court and Inferior Courts.

Old Dominion Co. v. Lewiston et al., 202 Fed. 178 (C. C. A., Second Circuit). All inferior federal courts must follow the law as defined by the Supreme Court of the United States, even if in

any case the decision be in conflict with the rules of the Supreme Court of the state on the same facts.

Prior Litigation—Effect of.

Doelger v. German-American Filter Co., 204 Fed. 274 (C. C. A., Second Circuit). Example of elaborate litigation upon a patent. Held that where a patent has been the subject of such extensive and persistent litigation and uniformly sustained a court should, unless clearly convinced to the contrary, follow such previous favorable decisions.

Comity.

Hurd et al. v. James Gould Co., 203 Fed. 998 (C. C. A., Second Circuit). The court in one circuit not obliged to stretch the doctrine of comity so far as to prevent prior licensee in another circuit from bringing suit because the owners have been enjoined in the other circuit from bringing suit.

Receivers.

National Electric Signalling Co. v. Telefunken Wireless Co., 208 Fed. 679 (C. C. A., Third Circuit). Receivers for corporation properly empowered may intervene in infringement suit.

Appeal and Error—Bill of Exceptions.

Robertson v. Cockrell, 209 Fed. 843 (C. C. A., Fifth Circuit).

"Per Curiam. The judgment is affirmed, for want of bill of exceptions seasonably allowed, upon the authority of *Muller v. Ehlers*, 91 U. S. 249, 23 L. Ed. 319; *Jones v. Grover & Baker Sewing Machine Co.*, 131 U. S. cl., appendix, 24 L. Ed. 925; *Michigan Insurance Bank v. Eldred*, 143 U. S. 293, 12 Sup. Ct. 450, 36 L. Ed. 162; *Glaspell v. Northern Pacific*, 144 U. S. 211, 12 Sup. Ct. 593, 36 L. Ed. 409; *Hume v. Bowie*, 148 U. S. 245, 13 Sup. Ct. 582, 37 L. Ed. 438; *United States v. Jones*, 149 U. S. 263, 13 Sup. Ct. 840, 37 L. Ed. 726; *Morse v. Anderson*, 150 U. S. 156, 14 Sup. Ct. 43, 37 L. Ed. 1037."

Bill of Exceptions—Objections.

Pittsburgh, etc., Ry. Co. v. Ginn, 208 Fed. 989 (C. C. A., Sixth Circuit). Rule 10 of the Circuit Court of Appeals for the Sixth Circuit, (202 Fed. vii, 118 C. C. A. ix), requiring generally a narrative form of statement of testimony in bill of exceptions should be subject of objection by defendant in error, if so advised, and

if the bill is allowed in that form the records shall show the judge's directions therefor.

Defenses—Assignee.

Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (C. C. A., Second Circuit). Patentee cannot defend against suit brought by his assignee on the ground that he was induced to part with the patent by unfair representations.

Rehearing and Reopening.

The familiar principles, of course, govern in the average case. They are, for example, presented in patent cases in *Brill v. North Jersey Street Ry. Co.*, 125 Fed. 526, (N. J.); *Banzl v. Battle Island Paper & Pulp Co. et al.*, 132 Fed. 607, (N. Y.); *Reece Folding Machine Co. v. Fenwick et al.*, 140 Fed. 287, 72 C. C. A. 39; *Lord v. Staples & Hanford Co.*, 148 Fed. 19, 78 C. C. A. 493; *Cameron Septic Tank Co. v. Village of Saratoga Springs*, 159 Fed. 453, 464, 86 C. C. A. 483; *Combustion Utilities Corporation v. Worcester Gas Light Co.*, 190 Fed. 155, 164 (Mass.); *Money-Weight Scale Co. v. Toledo Computing Scale Co.*, 199 Fed. 905, (C. C. A., Seventh).

It should be observed that under the Rules of Equity (69) a rehearing may not be granted after the passing of the term at which the decree was rendered, unless by special leave granted during the term. In cases where no appeal or petition lies a rehearing may be asked at any time before the end of the next term of court.

There have been a number of cases in which rehearings have been granted or the case reopened under circumstances which at first blush might have appeared opposed to the general rule.

For example, in *John R. Williams Co. et al. v. Miller et al.*, 108 Fed. 967, (N. Y.), the case was reopened to admit a newly discovered British patent after an interlocutory decree, the defendant amending his answer and both parties being allowed to file evidence relating to the patent.

In *Thomson-Houston Electric Co. v. Nassau Electric R. Co.*, 110 Fed. 646, (N. Y.), the defendant was before the entry of the decree permitted to introduce a newly discovered Austrian patent upon such terms as to costs and expenses as placed the complainants in the same position as they would have been at the time the patent should have been entered as a defense.

In *Sample v. American Soda Fountain Co.*, 134 Fed. 402, (Pa.), the Circuit Court granted a rehearing after dismissal of the bill by the Court of Appeals, a disclaimer having been filed after the decision of the Circuit Court of Appeals but before the

decree. This was, however, reversed in *American Soda Fountain Co. v. Sample*, 136 Fed. 857, 70 C. C. A. 415. The Circuit Court should have had leave to reopen from the Circuit Court of Appeals.

In *New York Phonograph Co. v. Edison*, 136 Fed. 600, (N. Y.), the complainant was granted a rehearing to introduce additional proofs though not newly discovered where the court was of the opinion that the complainant had not been afforded all the relief to which he was entitled.

In *Western Electrical Instrument Co. v. Empire Co.*, 167 Fed. 687, (N. Y.), the case was reopened and a retrial granted to determine the question of the liability of the individual defendants on newly discovered evidence.

INFRINGEMENT.

Generally—Omitting Parts.

Stebler v. Riverside Heights Orange Growers' Assn. et al., 205 Fed. 735, 739 (C. C. A., Ninth Circuit). "One who appropriates another's patented invention, even though he may add thereto another element to perform an additional function, is guilty of infringement. *Powell v. Leicester Mills Co.*, 108 Fed. 386, 47 C. C. A. 416; *Letson v. Alaska Packers' Assn.*, 130 Fed. 129, 64 C. C. A. 463; *American Can Co. v. Hickmott Co.*, 142 Fed. 141, 146, 73 C. C. A. 359; *Columbia Wire Co. v. Kokomo Co.*, 143 Fed. 116, 74 C. C. A. 310; *Comptograph Co. v. Mechanical Acct. Co.*, 145 Fed. 331, 337, 76 C. C. A. 205; *Corrington v. Westinghouse Co. (C. C.)* 173 Fed. 69, 81; *Weston Elec. Inst. Co. v. Whitney Co. (C. C.)*, 131 Fed. 280; *Diamond Match Co. v. Ruby Match Co. (C. C.)*, 127 Fed. 341; *Benjamin Elec. Co. v. Dale Co.*, 158 Fed. 617, 85 C. C. A. 439; *O'Leary v. Utica & Mohawk Co. (C. C.)*, 139 Fed. 330; *L. J. Mueller Co. v. Groeschel (C. C.)*, 166 Fed. 917; *Long v. Noye Mfg. Co. (C. C.)*, 192 Fed. 570. In *Cimiotti Unhairing Co. v. American Unhairing Mach. Co.*, 115 Fed. 498, 504, 53 C. C. A. 230, 236, the Circuit Court of Appeals of the Second Circuit uses the following language: "The mere fact that there is an addition, or the mere fact that there is an omission, does not enable you to take the substance of the plaintiff's patent. The question is, not whether the addition is material, or whether the omission is material, but whether what has been taken is the substance of the invention."

Contributory.

American Malting Co. v. Keitel, 209 Fed. 351 (C. C. A., Second Circuit). Equity has jurisdiction to restrain one who induces another to break a contract.

Defendant's Patent.

Murray v. Detroit Wire Spring Co., 206 Fed. 465 (C. C. A., Sixth Circuit).

"The fact that defendant's structure is covered by a patent later than complainant's we lay out of consideration, for the reasons stated in Herman v. Youngstown Co., 191 Fed. 579, 112 C. C. A. 185. See, also, Ries v. Barth (C. C. A. 7), 136 Fed. 850, 854, 69 C. C. A. 528, and Ryder v. Schlichter (C. C. A. 3), 126 Fed. 487, 490, 61 C. C. A. 469."

Impairment.

O'Brien-Worthen Co. v. Stempel, 209 Fed. 847 (C. C. A., Eighth Circuit).

"We think O'Brien's structure comes within the settled rule that infringement is not avoided by impairment in degree so long as the distinguishing function is retained (Penfield v. Chambers [C. C. A. 6], 92 Fed. 630, 653, 34 C. C. A. 579; King v. Hubbard [C. C. A. 6], 97 Fed. 795, 803, 38 C. C. A. 423), and within the principle that infringement is not avoided by adding elements to the complete structure of the patent claim."

Contributory.

"The defendant is not manufacturing the complete spring seat with the frame, but the exhibit, 'Defendant's Manufacture No. 1,' is clearly intended for attachment to a frame, and can have no other use. Under the familiar rule of contributory infringement (Thomson-Houston Co. v. Ohio Co. [C. C. A. 6], 80 Fed. 712, 26 C. C. A. 107), it infringes claims 1, 2, and 3. Exhibit, 'Defendant's Manufacture No. 2,' embodies a frame and infringes claim 5."

Libel—Circulars.

American Malting Co. v. Keitel, 209 Fed. 351 (C. C. A., Second Circuit). In the absence of statute and of acts of conspiracy, intimidation, or coercion, the equity courts have no jurisdiction to restrain the future publication and issuance of libelous circulars, though the false statement may injure complainant in his business or as to his property. The court discusses the question at length, citing numerous authorities, and then refers to numerous other cases which have restrained libels saying, however, that in those cases the conspiracies or the intimidation or coercion of the complainant or his customers had been alleged.

Libel and Slander—Circulars.

American Malting Co. v. Keitel, 209 Fed. 351 (C. C. A., Second Circuit). Defendant required to make clear in any circulars issued that the aspersions were not directed against the complainant. Held that equity had no jurisdiction in the absence of statute to restrain the publication and issuance of such circulars even where injury could be shown unless there could also be shown to have been conspiracy, intimidation or coercion.

INJUNCTIONS.**Power of Court to Decide All Questions.**

Smith v. Farbenfabriken, 203 Fed. 476, 478 (C. C. A., Sixth Circuit).

* * * "yet the lower court did in fact decide an independent question of general law as also the question of jurisdiction. The assignments of error are addressed to both questions; as to the former, challenging the validity of the order granting a preliminary injunction 'upon the showing made in the bill of complaint and affidavits made in support thereof.' It is settled that in such a case this court has power to hear and decide all the questions. *Olds v. Herman H. Hettler Lumber Co.*, 195 Fed. 9, 11, 115 C. C. A. 91 (C. C. A., 6th Cir.); *A. J. Phillips Co. v. Grand Trunk Western Ry. Co.*, 195 Fed. 12, 15, 115 C. C. A. (C. C. A., 6th Cir.)."

INTERFERENCES.**Preliminary Statement.**

While a party will be confined to the dates and allegations of his preliminary statement, satisfactory proof of a date earlier than that alleged in the preliminary statement will be taken as establishing the date so alleged in the statement.

Preliminary Statement—Amendment.

The amendment of the preliminary statement—In general and miscellaneous. *Foster v. Bent*, 77 O. G. 1781; *Borg v. Strauss*, 130 O. G. 2719; *Ridgway v. Filyou*, 137 O. G. 979; *Dixon v. McElroy*, 127 O. G. 2393; *Parker v. Appert*, 8 App. D. C. 270, 75 O. G. 1201; *Stevens v. Seher*, 11 App. D. C. 245, 81 O. G. 1932; *Cross v. Phillips*, 14 App. D. C. 228, 87 O. G. 1399.

Delay in seeking amendment. *Floyd v. Rohlfing*, 133 O. G. 992; *Mills v. Torrance*, 98 O. G. 416; *Kent v. Wilson & Co.*, 137 O. G. 1943.

Additional Claims Under Rule 109.

A party may by motion under Rule 109 seek the addition to the issue of such counts other than those originally included as may, in his opinion, be necessary to a proper definition of the inventions which are common to the applications of the various parties. This is an important matter as priority is now awarded strictly upon the subject-matter defined by the counts and as an unsuccessful party may not after the interference advance any claims which might have been advanced for contest in the interference. Under the present practice an adverse judgment upon a narrow issue will cause the loss of a broad claim by one who might have prevailed with regard thereto had the same been included in the issue. The necessity for carefully securing the issue for immaterial limitations before the time for motions under Rule 107 expires is thus apparent.

Failure to Claim Under Rule 109.

Failure to advance claims under Rule 109. *In re Marconi*, 38 App. D. C. 286, 179 O. G. 577; *Ex parte Temple & Goodrum*, 176 O. G. 526; *Ex parte Sutton, Steele & Steele*, 121 O. G. 1012; *Horine v. Wende*, 29 App. D. C. 415, 129 O. G. 2858; *Carroll v. Hallwood*, 31 App. D. C. 165, 135 O. G. 896; *Blackford v. Wilder*, 28 App. D. C. 535, 127 O. G. 1255.

Motions to Dissolve.

Motions for dissolution. The distinction between the various grounds of dissolution and the necessity for observing the same. *Klepetko v. Becker*, 120 O. G. 658; *Kaczander v. Hodges*, 118 O. G. 836; *Owens v. Richardson*, 111 O. G. 1037; *Woodward v. Newton*, 86 O. G. 490.

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Motions for dissolution. Must be definite—In general. *Vreeland v. Fessenden & Co.*, 119 O. G. 1259; *Klepetko v. Becker*, 120 O. G. 658; *Pym v. Hadaway*, 123 O. G. 1284; *Lizatte v. Newberth*, 124 O. G. 1842; *Murphy v. Borland*, 132 O. G. 231. In cases of informality and irregularity. *Berrye & Co. v. Hildreth*, 122 O. G. 1722; *Daggett v. Kaufmann*, 127 O. G. 2817; *Joseph v. Kennedy*, 144 O. G. 1089; *Latterhand v. Cornwall*, 148 O. G. 1344.

In cases of different meanings and non-interference in fact. *Booth & Co. v. Harman & Co.*, 123 O. G. 319; *Lizatte v. Newberth*, 124 O. G. 1842; *Baetz v. Kukkuck*, 148 O. G. 1343.

In cases of lack of right to make claims. *Dunker v. Reist*, 119 O. G. 1925; *Latour v. Lundell*, 122 O. G. 1046; *Lizatte v. Newberth*, 124 O. G. 1842; *Baetz v. Kukkuck*, 148 O. G. 1343; *Latterhand v. Cornwall*, 148 O. G. 1344.

In cases of anticipation, aggregation, etc. *Hayne v. DeVilliss*, 125 O. G. 667; *McCanna v. Morris*, 128 O. G. 1292; *Phillips v. Scott*, 130 O. G. 1312; *Thullen v. Townsend*, 130 O. G. 1312; *Papendell v. Bunnell & Co.*, 131 O. G. 361; *Joseph v. Kennedy*, 144 O. G. 1089.

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Patentee may not move to dissolve on ground that issue is not patentable. *Mason v. Hutchinson*, 201 O. G. 569, overruling *Baltzley v. Seeberger*, 115 O. G. 1329.

Appeals on Motions.

Appeals interlocutory from decisions on motions are the creations of Rule 124 and not of the statutes relating to appeals in the Patent Office. *U. S. ex rel. Lowry v. Allen, Comm'r*, 203 U. S. 476, 51 L. Ed. 281, 27 Sup. Ct. 141, 125 O. G. 2365.

Disclosure Need Not Include Old Elements of Issue.

Barber v. Spalckhaver, — App. D. C. —, 201 O. G. 268. It is not essential that a disclosure of an invention should be of all the elements of the issue, but that the essential feature of invention be disclosed. In this case some of the elements of the issue were not shown in the disclosure sketches and the witnesses did not remember after the lapse of six years the precise time when these familiar elements were "disclosed" by the inventor.

Conception—Conduct.

Courses of conduct tending to support or to negative an assertion that an invention had been conceived at a certain time are exemplified in *Silverman v. Hendrickson*, 19 App. D. C. 391, 99 O. G. 1171; *Hope v. Voight*, 25 App. D. C. 22, 115 O. G. 1585; *Laas Co. v. Scott*, 26 App. D. C. 354, 122 O. G. 353; *Blackman v. Alexander*, 113 O. G. 1703; *Barrett v. Harker*, 112 O. G. 729.

Conception.

Caveat, an amendment to an application, and an abandoned application may be used as evidence of conception. *Young v. Struble*, 34 App. D. C. 218, 152 O. G. 1223; *Mergenthaler v. Scudder*, 11 App. D. C. 264, 81 O. G. 1417; *Carty v. Kellogg*, 7 App. D. C. 542, 74 O. G. 657; *Hien v. Pungs*, 68 O. G. 657.

Reduction to Practice.

Evidence of reduction to practice must go to all of the elements of the counts. *Robinson v. Seelinger*, 25 App. D. C.

237, 116 O. G. 1735; *Blackford v. Wilder*, 21 App. D. C. 1, 104 O. G. 578; *Sherwood v. Drewsen*, 29 App. D. C. 161, 130 O. G. 657.

Reduction to Practice Abroad.

Westinghouse Mach. Co. et al. v. General Electric Co., et al., 207 Fed. 75 (C. C. A., Second Circuit). Held that a reduction to practice abroad has no effect upon the question of priority between two parties, following *De Kando v. Armstrong*, 37 App. D. C. 314, 169 O. G. 1185. The court thought that if § 4886 R. S. U. S. stood alone such production of the machine would be a basis for prior knowledge provided the persons who knew the machine are in this country. The court then concludes: "But the Patent Law is contained in many sections, and they must be construed together to get at the precise code which they set forth. Section 4886 states generally the conditions which must exist in order to entitle an inventor to the grant of a patent. Section 4923 deals specifically with the effect of knowledge and use in a foreign country, and it makes no distinction whether such use is made or such knowledge is acquired by persons who, after using the thing or acquiring the knowledge, remain abroad or come here. This section (4923) provides that the patent taken out by an applicant for the same thing here shall not be void on account of such knowledge or use unless the invention had been patented or described in a printed publication. As we construe this section, reduction to practice in a foreign country can never operate to destroy a patent applied for here, however widely known such reduction to practice may be, either among foreigners or among persons living here, unless the invention be patented or described in a printed publication. To that extent section 4923 qualifies the language of section 4886, which without such qualification might well lead to a different result."

Tests—Inferentially Unsuccessful.

Conduct and circumstances, such as inaction of inventor, pushing other inventions, scrapping the machine, as evidence that an alleged successful test was not one in fact. *Warner v. Smith*, 13 App. D. C. 111, 84 O. G. 311; *Gordon v. Wentworth*, 31 App. D. C. 150, 135 O. G. 1125; *Riechenbach v. Kelley*, 17 App. D. C. 333, 94 O. G. 1185; *Quist v. Ostrom*, 23 App. D. C. 69, 108 O. G. 2147; *Trissel v. Thomas*, 23 App. D. C. 219, 109 O. G. 809; *Bourn v. Hill*, 27 App. D. C. 291, 123 O. G. 1284; *Eastman v. Houston*, 18 App. D. C. 135, 95 O. G. 2064; *Fefel v. Stocker*, 17 App. D. C. 317, 94 O. G. 433; *Ocuppaugh v. Norton*, 24 App. D. C. 296, 115 O. G. 185; *Beals v. Finkenbiner*, 12 App. D. C. 23, 82 O. G. 598.

Inferences Against Claim to Inventorship.

Effect of prior conduct, delay, statements and other circumstances in opposition to a subsequent claim to inventorship generally. *Gibbons v. Peller*, 28 App. D. C. 530, 127 O. G. 3643; *Furman v. Dean*, 24 App. D. C. 277, 114 O. G. 1552; *Lloyd v. Antisdell*, 17 App. D. C. 490, 95 O. G. 1645; *Sachs v. Hundhausen*, 21 App. D. C. 511, 105 O. G. 1534; *Locke v. Boch*, 17 App. D. C. 75, 93 O. G. 1722; *Nielson v. Bradshaw*, 16 App. D. C. 92, 91 O. G. 644; *Tyler v. Kelch*, 19 App. D. C. 180, 98 O. G. 1282; *Standard Co. v. Peters Co.*, 77 Fed. 630, 23 C. C. A. 367; *Tyler v. St. Amand*, 17 App. D. C. 464, 94 O. G. 1969; *Scott v. Scott*, 18 App. D. C. 420, 96 O. G. 1650; *Slaughter v. Halle*, 21 App. D. C. 19, 102 O. G. 469; *Columbus v. Standard*, 148 Fed. 622, 78 C. C. A. 394; *Kelly v. Flynn*, 16 App. D. C. 573, 92 O. G. 1237; *Pickles v. Aglar*, 13 App. D. C. 556, 86 O. G. 346.

Diligence.

Though the proposition has been stated generally under this topic and elsewhere, special emphasis should be placed upon the rule that he who was the first to conceive must have been exercising diligence when his rival entered the field.

* * * * *

The lack of diligence of the first to conceive and the last to reduce to practice prior to his opponent's entry into the field is immaterial, providing that he was diligent at the moment when his opponent entered the field. He must have continued diligent until he reduced to practice or filed his application.

* * * * *

The first to conceive and last to reduce cannot excuse his own lack of diligence by pointing to any lack of diligence upon the part of his opponent. There is no race of diligence; the lack of diligence of the first to reduce to practice before his reduction to practice is entirely immaterial. The lack of diligence upon the part of the first to conceive and last to reduce to practice may often be emphasized, however, by comparing his conduct with that of the first to reduce in those cases when the latter was diligent.

A party may not excuse his lack of diligence on grounds such as sickness or poverty if he was not exercising diligence when these excuses began to operate. Nor may a first conceiver hold the field indefinitely upon the strength of a continuing excuse for lack of diligence no matter how compelling the same may be.

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When the necessity for diligence begins. *Funk v. Haines & Matteson*, 20 App. D. C. 285, 100 O. G. 1764; *Miehle v. Read*, 18

App. D. C. 128, 96 O. G. 426; Seeberger v. Dodge, 24 App. D. C. 476, 114 O. G. 2382; Christie v. Seybold, 55 Fed. 69, 5 C. C. A. 33; Paul v. Johnson, 23 App. D. C. 187, 109 O. G. 807; Yates v. Huson, 8 App. D. C. 93, 740 O. G. 1732.

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Diligence of first to reduce to practice, comparisons of conduct; "race of diligence." Christie v. Seybold, 55 Fed. 69, 5 C. C. A. 33; Paul v. Johnson, 23 App. D. C. 187, 109 O. G. 807; Nelson v. Faucette, 33 App. D. C. 217, 143 O. G. 1348; Hammond v. Basch, 24 App. D. C. 469, 115 O. G. 806.

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Commercial activity and business considerations as diligence or as excuses for lack of diligence. Turnbull v. Curtiss, 27 App. D. C. 567, 123 O. G. 2313; Seeberger v. Dodge, 24 App. D. C. 476, 114 O. G. 2382; Nelson v. Faucette, 33 App. D. C. 217, 143 O. G. 1348; McCormick v. Cleal, 80 O. G. 1614; Kasson v. Hetherington, 88 O. G. 1157.

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Patterson v. United States, 202 Fed. 208, (C. C. A., Ninth Circuit). Where one was prosecuted for perjury in his oath to an application it was held immaterial that a prior inventor had not been diligent in reducing to practice and filing application.

Work on Other Inventions.

Work upon other inventions or the filing of applications on other inventions as evidence that a delay was unnecessary. Paul v. Johnson, 23 App. D. C. 187, 109 O. G. 807; Turnbull v. Curtiss, 120 O. G. 2442; Robinson v. Copeland, 24 App. D. C. 68, 112 O. G. 501; Williams v. Liberman, 107 O. G. 832; Parker v. Lewis, 28 App. D. C. 1, 123 O. G. 2314.

Necessary work upon related inventions as an excuse for delay. Lotterhand v. Hansen, 23 App. D. C. 372, 110 O. G. 861; Christensen v. Ellis, 17 App. D. C. 498, 94 O. G. 2561; Stapleton v. Kenney, 18 App. D. C. 394, 96 O. G. 1432; McCormick v. Cleal, 12 App. D. C. 335, 83 O. G. 1514.

Sickness, Poverty, Etc.

That sickness and poverty as an excuse for lack of diligence must extend back to a period of activity. Paul v. Johnson, 106 O. G. 213.

Inability to reduce to practice because of lack of funds, etc., should lead to the filing of an application. Wyman v. Donnelly, 21 App. D. C. 81, 104 O. G. 310; Seeberger v. Dodge, 24 App. D. C. 476, 114 O. G. 2382.

Silence Under Accusation.

The failure of a party to deny a charge that he derived the invention from his opponent. *Winslow v. Austin*, 14 App. D. C. 137, 86 O. G. 2171; *Kempshall v. Royce*, 29 App. D. C. 181, 129 O. G. 3162.

Loose Statement or Testimony.

Discrediting effect of looseness in the preliminary statement or of departure in the testimony from the averment of the preliminary statement. *Tripler v. Linde*, 21 App. D. C. 32, 102 O. G. 1297; *Flora v. Powrie*, 106 O. G. 2288; *Shaffer v. Dolan*, 23 App. D. C. 79, 108 O. G. 2146; *Croskey v. Atterbury*, 9 App. D. C. 207, 76 O. G. 163; *Herman v. Fullman*, 23 App. D. C. 259, 109 O. G. 1888; *Blackman v. Alexander*, 113 O. G. 1703.

Failure to Adopt Suggested Claims.

Failure to duly adopt claims suggested for purposes of interference under Rule 96. *Ex parte Schulze*, 114 O. G. 1550; *Ex parte Card & Card*, 112 O. G. 499; *Ex parte Hellmund*, 141 O. G. 565; *Ex parte Post*, 112 O. G. 1214.

Third Party.

Proofs of invention by one not a party. *Pope v. McKenzie*, 38 App. D. C. 111, 176 O. G. 1072; *Foster v. Antisdell*, 14 App. D. C. 592, 103 O. G. 1683; *Robinson v. McCormick*, 128 O. G. 3289; *Hunter v. Stikeman*, 13 App. D. C. 214, 85 O. G. 610; *Prindle v. Brown*, 24 App. D. C. 114, 112 O. G. 957.

Rule 130.

Rule 130 does not refer to anticipation or to bars of public use, publication patent or to different meanings of counts. *Dixon v. Graves*, 127 O. G. 1993; *Weis v. Mack*, 185 O. G. 830; *Hopkins v. Kleal*, 180 O. G. 1393.

Rule 130, seeking hearings and an opportunity to take testimony notwithstanding an order to show cause, under rule 114. *Lowry v. Spoon*, 122 O. G. 2687; *Brown v. Stroud*, 122 O. G. 2688; *Pym v. Hadaway*, 125 O. G. 1702; *Clement v. Brown & Co.*, 125 O. G. 992; *Kinsman v. Strohm*, 125 O. G. 1699; *Weintraut v. Hewitt & Co.*, 126 O. G. 2589; *Pym v. Hadaway*, 129 O. G. 480; *Martin v. Goodriem & Co.*, 134 O. G. 1297; *Weintraut v. Hewitt & Co.*, 178 O. G. 889.

Right to Make the Claim—Rule 130.

Under the provisions of Rule 130 were taken up ancillary matters. It should be understood that a finding that a party has a right to the patent sought operates in denial of his opponent's right to a patent. It may not be urged under Rule 130 that the issue is anticipated in the case of one or both parties, or that it has different meanings or that a party has lost the right to claim it by a two years' public use, or by patent or publication, prior to his application.

Second Interference—Res Adjudicata.

Proceedings regarding a party's application prior to the one directly involved in interference which prior application is alleged to disclose the invention in issue. *Blackmore v. Hall*, 118 O. G. 2538; *Rauler Co. v. Adams*, 114 O. G. 1827; *Struble v. Young*, 121 O. G. 339; *Robinson v. Seelinger*, 25 App. D. C. 237, 116 O. G. 1736.

Bill in Equity—Action of Office Reversed—Joint Application as Evidence—Construction of Issue.

General Electric Co. v. Steinberger, 208 Fed. 699 (N. Y.). Bill in equity under § 4915 R. S. U. S. Decisions of preceding tribunals in granting patent should not be disturbed unless shown to be unmistakably erroneous. Action of Patent Office reversed on ground that unsuccessful applicant in Patent Office was first to produce the limited invention of the issue. A joint applicant who later files a sole application may refer to the joint application as evidence of conception of the invention by himself. Claims in issue may be construed by the court but not altered so as to interfere with an action under § 4918. "But the claims of the patent must be read in the light of the disclosures of the patent when tested by the prior art and cannot be interpreted so broadly as to protect the old devices of corrugations alone. The original claim 15 of the Steinberger patent was in language broad enough to cover mere corrugations. This was rejected by the Patent Office as "inaccurate" and "not presenting patentable matter." This action was acquiesced in by Steinberger and was correct. The present claims, therefore, cannot be read so broadly as to cover and to be held as having allowed this unpatentable structure. *Condit Electrical Mfg. Co. v. Westinghouse Electric & Mfg. Co.*, 200 Fed. 144, 118 C. C. A. 474; *Cotto-Waxo Chemical Co. v. Perolin Co. of America*, 185 Fed. 267, 107 C. C. A. 373; *Simplex Electric Heating Co. v. Leonard*, 200 Fed. 581."

Bill in Equity—As Stay on Infringement Suit.

Steinberger v. General Electric Co., 207 Fed. 114 (N. Y.). Suit in equity had been brought under § 4915 R. S. U. S. to determine priority. A subsequent suit for infringement by the party who had been the successful applicant previous to the bill in equity stayed a reasonable time to await the determination of the issue of priority under the bill in equity.

Bill in Equity.

Thoma et al. v. Perri, 205 Fed. 632 (Mass.). Bill in equity under § 4915 R. S. U. S., may be maintained against rival applicant though he has assigned his rights under the application; and suit may be maintained in any district where valid service can be had on the defendant without regard to his special residence.

LETTERS PATENT AND THEIR CONSTRUCTION AND SCOPE.**As Property—Entitled to Possession.**

Paine v. Parkhurst, 205 Fed. 740-743 (C. C. A., Sixth Circuit).

"In view of the fact that a record of the patent is preserved in the Patent Office, and that all its assignments are there recorded, the possession of the original letters may be comparatively unimportant; nevertheless, they are not valueless, but of intrinsic and substantial worth. The procurement of a copy of them would be attended with some inconvenience and expense. They are, like a title deed, a personal chattel. They are the evidence of their owner's exclusive right to the use of the invention and create a property interest in such invention. *Marsh v. Nichols, Shepard & Co.*, 128 U. S. 605, 612, 9 Sup. Ct. 168, 32 L. Ed. 538. The rule is well settled that the person to whom title deeds belong may, on account of their value, maintain an action for their recovery (*Wilson v. Rybolt*, 17 Ind. 391, 79 Am. Dec. 486; *Warvelle on Vendors*, § 51; *Snoddy v. Finch*, 9 Rich. Eq. [S. C.] 355, 70 Am. Dec. 216); and the owner of a patent may doubtless avail himself of the same rule to obtain possession of the original patent papers."

Substantially as Described.

Superior Hay Stacker Mfg. Co. v. Dain Mfg. Co., 208 Fed. 549 (C. C. A., Eighth Circuit). The words "substantially as described" do not necessarily limit.

Construction—Reading in Limitations.

Wm. B. Scaife & Sons Co. v. Falls City Woolen Mills, 209 Fed. 210 (C. C. A., Sixth Circuit). Two phases of construction—Reading limitation into claims. The courts will read in limitations to give a narrow construction to sustain the patent, but will not do so when the claim is intended to be broad, and for the mere arbitrary purpose of saving a claim. When it is clear to the court that a claim had for its dominant purpose to cover one particular feature the courts should not construe it as specific also for the other elements. Where a claim is ambiguous a given element should be implied if its presence is necessary to distinguish the claim from the prior art and from the other claims of the patent. If, however, it cannot operate to such purpose it should not operate as a limitation. And a statement by the solicitor that the claim was limited to the "exact form" was held not an estoppel.

See this case also for numerous citations on points of construction, patentability, etc.

Construction—Generally.

O'Brien-Worthen Co. v. Stempel, 209 Fed. 849 (C. C. A., Eighth Circuit).

"The specification and claims of a patent constitute a contract between the United States and the patentee, and they are to be read and construed together in the same way and by the same rules by which other contracts are interpreted. The specification which forms a part of the same petition or application as the claims must be read and interpreted with them, not for the purpose of limiting, or of contracting, or of expanding, the latter, but for the purpose of ascertaining from the entire agreement, of which each is a part, the actual intention of the parties. Century Electric Co. v. Westinghouse Mfg. Co., 191 Fed. 350, 354, 112 C. C. A. 8, 12; Seymour v. Osborne, 11 Wall. 516, 547, 20 L. Ed. 33; National Hollow Brake Beam Co. v. Interchangeable B. B. Co., 106 Fed. 693, 701, 45 C. C. A. 544, 552; O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, 344, 72 C. C. A. 304, 308; Loudon Machinery Co. v. Janesville Hay Tool Co., 148 Fed. 686, 690, 78 C. C. A. 548, 552; Electric Machine Co. v. Morris (C. C.), 156 Fed. 972, 974; Lewis Blind Stitch Machine Co. v. Premium Mfg. Co., 163 Fed. 950, 955, 90 C. C. A. 310, 315; Fullerton Walnut Growers' Ass'n v. Anderson-Barngrover Mfg. Co., 166 Fed. 443, 461, 92 C. C. A. 295, 313."

Estoppel By Acquiescence in Rejection and Amendment.

O'Brien-Worthen Co. v. Stempel, 209 Fed. 849 (C. C. A., Eighth Circuit).

"It is an indisputable principle of the law of patent that, if a patentee acquiesces in the rejection of his claims on references cited in the Patent Office and accepts a patent on an amended or substituted claim, he is thereby estopped from maintaining that the amended or substituted claim covers the combinations or devices shown in the references and from successfully claiming that the substituted claim has the breadth of the claims that were rejected. But he is not estopped from claiming and securing by his amended claim every known and useful improvement which he has invented and which is not disclosed by the references. National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. 693, 714, 45 C. C. A. 544, 565, and the cases there cited; J. L. Owens Co. v. Twin City Separator Co., 168 Fed. 259, 268, 93 C. C. A. 561, 570; Brill v. St. Louis Car Co., 90 Fed. 666, 668, 33 C. C. A. 213, 215; Hubbell v. United States, 179 U. S. 77, 83, 84, 21 Sup. Ct. 24, 45 L. Ed. 95."

Pioneer.

National Electric Signalling Co. v. Telefunken Wireless Co., 208 Fed. 679 (C. C. A., Third Circuit). Patents No. 918,306 and 918,307, the first for a method of wireless signalling, the second for apparatus for practicing the method held to be pioneer and valid and infringed.

Words, Terms and Phrases.

For "liberal" interpretation of words "end to end" see Stebler v. Riverside Heights Orange Growers' Assn., 205 Fed. 735 (C. C. A., Ninth Circuit).

LICENSES, CONTRACTS AND RESTRICTIONS.**Remedies Under Contracts.**

Chadeloid Chemical Co. v. Johnson et al., 203 Fed. 993 (C. C. A., Seventh Circuit). Where a contract required licensee to make stated reports, pay royalties, submit his books to inspection, etc., no remedy by suit in equity for infringement.

Price Restrictions.

Kellog Toasted Corn Flakes Co. v. Buck, 208 Fed. 383 (Cal.).
"The recent case of Bauer & Cie v. O'Donnell, 229 U. S. 1, 33

Sup. Ct. 616, 57 L. Ed. —, decided May 26, 1913, which is the latest one called to my attention, construes the former case thus:

“The question, therefore, now before this court for judicial determination, is: May a patentee by notice limit the price at which future retail sales of the patented article may be made, such article being in the hands of a retailer by purchase from a jobber, who has paid to the agent of the patentee the full price asked for the article sold? The object of the notice is said to be to effectually maintain prices and to prevent ruinous competition by the cutting of prices in sales of the patented article. That such purpose could not be accomplished by agreements concerning articles not protected by the patent monopoly was settled by this court in the case of *Dr. Miles Medical Co. v. John D. Park & Sons Co.*, 220 U. S. 373 [31 Sup. Ct. 376, 55 L. Ed. 502], in which it was held that an attempt to thus fix the price of an article of general use would be against public policy and void.’ ”

Licensee—Right to Pursue Remedy.

Hurd et al. v. James Goold Co., 203 Fed. 998 (C. C. A., Second Circuit). Hurd was sued as a licensee for a limited territory. Subsequent to his license the owner of the patent was enjoined in another circuit for bringing suit for its infringement.

“Complainant has joined with himself two corporations who hold the legal title to the patent. These corporations have been enjoined in the sixth circuit from maintaining suits for infringement. These injunctions, of course, bind the corporations against which they were issued; but we cannot see how they can operate to interfere with Hurd’s legal rights (assuming that the answers to the certified questions indicate that he has such right) or with the course which equity practice indicates he should follow in vindication of those rights. That practice authorizes him, as holder of an exclusive territorial license, to present his licensors as co-complainants, even against their will and in spite of their protests. Whether they may say, in response to his request, ‘we will not appear because we are dissatisfied with you, or because a court has told us we must not, is a matter of indifference to Hurd. Despite these objections, he has brought them in as co-complainants. Whether his doing so exposes them to punishment for contempt is a matter to be decided when it comes up; we have a definite opinion about that, but it is not for us now to express it. We think it strains the doctrine of comity beyond the breaking point to contend that, in order to uphold the hands of the enjoining court, we should deprive Hurd, over whom that court never had any jurisdiction, of the regular and orderly equitable procedure to maintain his legal rights, assuming that the

deliverance of the Supreme Court on the certified question may indicate that he has legal rights, which he can maintain against users of infringing tires in his territory."

Remedies.

Chadeloid Chemical Co. v. Johnson et al., 203 Fed. 993 (C. C. A., Seventh Circuit). Where a contract required licensee to make stated reports, pay royalties, submit his books to inspection, etc., no remedy for failure by suit in equity for infringement.

PATENTABILITY.

Invention—Slight Advance in an Art.

In the case of *Hartford v. Moore*, 181 Fed. 132, cited with approval by C. C. A., Third Circuit, in *Westen Mfg. Co. v. Hartford*, 194 Fed. 875. Reissue patent No. 12,437 (original, 695,508), for an automobile shock absorber, was sustained notwithstanding several closely approximating patents and notwithstanding the fact of the existence of a prior patent for use upon a motor car which, the court said, precisely answered all three of the claims in question. The court then proceeded: "Yet, in spite of this similarity, I do not consider that it is a valid anticipation, because some one must have selected it for the purpose, and, as I have already said, novelty of selection is oftentimes a sure sign of patentable invention."

The Second Circuit case was not appealed. For the further history of the patent, see also 158 Fed. 103, 172 Fed. 677 and 163 Fed. 948.

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In *Williams v. American String Wrapper Co.*, 86 Fed. 641 (C. C. A., Seventh Circuit), patent No. 558,244, for a newspaper wrapping with a tearing string secured thereto, was sustained over a prior patent for improvements in key opening metal cans having a detachable string terminating in a free tongue at one edge of the blank sheet of which the can is made. See also *Watson v. Stevens*, 51 Fed. 757 (C. C. A., First Circuit); *Justi v. Clark*, 108 Fed. 659 (C. C. A., Seventh Circuit); *Moore v. Schaw*, 118 Fed. 602; *Fries v. Leeming*, 131 Fed. 765. See also, *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 36 L. Ed. 968, herein reported and cited. Also further and as involving question of double use see *Aeolian Co. v. Halett & Davis Piano Co.*, 134 Fed. 872, and many cases cited in *Potts v. Creager* (p. 494 herein), and *Canda v. Michigan Malleable Iron Co.*, 124 Fed. 486 (C. C. A., Sixth Circuit).

Invention—Effect of Adoption by Defendant.

Elbs v. Rochester Egg-Carrier Co., 203 Fed. 705 (C. C. A., Second Circuit), patent No. 722,512. The claims in issue were as follows:

“An egg-carrier consisting of a case provided with partitions forming egg-receiving pockets, a removable cover formed with a flange interposed between the walls of the case and ends of the upper portions of the partitions, and means adjustably connected to the case for engaging and releasing said cover as set forth.”

“In an egg-carrier, the combination of a case provided with partitions having the upper portions of their end edges clear from the interior of the case, and a tray-shaped cover disposed inverted in the case and having its flanges passing across the clear portions of the ends of the partitions as set forth.”

The court in the opening of the opinion said: “The patentee has not made a generic invention but the record contains persuasive proof that he has made a distinct improvement upon the egg-carriers shown in the prior art. The persistent effort of the defendant, and those in cahoot with it, to use the Elbs carrier, or one embodying all its advantages, is inconsistent with the theory that the claims cover nothing of importance which is not found in the prior art.”

Invention—Article of Manufacture—Roof.

Riter-Conley Mfg. Co. v. Aiken et al., 203 Fed. 699 (C. C. A., Third Circuit). Patent No. 718,044 for a roof structure held valid. (On pages 703, 704 see definitions of article of manufacture.

International Convention.

Commercial Acetylene Co. et al. v. Schroeder et al., 203 Fed. 276 (C. C. A., Seventh Circuit). Effect of International Convention, article 4 bis, of December 14, 1900, as construed by Act of March 3, 1833.

“Complainants contend that this patent is protected by the treaty of 1902 (32 Stat. 1940), and the act of Congress of 1903 in relation thereto. The purpose of the act of 1903 was to lengthen the time after a foreign application before an application at Washington would be barred. It is not conceivable that Congress intended to make this statute retroactive. Any such construction is unwarranted by the words of the statute. *Malignani v. Hill-Wright Elec. Co.* (C. C.), 177 Fed. 430; *Malignani v. Jasper Marsh Cons. Elec. Co.* (C. C.), 180 Fed. 442.

So elaborately have all these questions been considered and

authorities cited by the trial court, no good purpose would be served by repeating them here. (D. C.), 197 Fed. 908."

Extensive Use—Commercial Success.

Stebler v. Riverside Heights Orange Growers' Assn. et al., 205 Fed. 735, 738 (C. C. A., Ninth Circuit).

"Neither the Bailey nor the Hutchins invention seems ever to have gone into practical use; and the Ish grader has been wholly or almost wholly, superseded by the plaintiff's machine—a fact to which great weight is to be given. *Morton v. Llewellyn*, 164 Fed. 693, 90 C. C. A. 514; *Wilkins Shoe B. Co. v. Webb* (C. C.), 89 Fed. 982; *Krementz v. Cottle Co.*, 148 U. S. 556, 13 Sup. Ct. 719, 37 L. Ed. 558; *Western Elec. Co. v. Chicago Co.* (C. C.), 14 Fed. 691; *Star Brass Co. v. Gen. Elec. Co.*, 111 Fed. 398, 49 C. C. A. 409; *Union Biscuit Co. v. Peters*, 125 Fed. 601, 60 C. C. A. 337; *St. Louis Flushing M. Co. v. American Co.*, 156 Fed. 574, 577 84 C. C. A. 340; *Robbins v. Dueber Watch Case Co.* (C. C.), 71 Fed. 186. It is accordingly held that the defense of anticipation is not sustained."

Combination—Aggregation—Judicial Knowledge.

Krell Auto Grand Piano Co. v. Story & Clark Co., 207 Fed. 946 (C. C. A., Seventh Circuit). Patent No. 825,784 held not void on its face neither for lack of patentability nor as an aggregation of old elements. The court elaborately reviews the question of aggregation and decides that a patent for a mechanism consisting of two or more elements is not necessarily invalid as an aggregation because there is no direct co-action between the elements where such co-action comes to produce a unitary result through the medium of the operator or the operating force. Numerous authorities in the above case on judicial knowledge and necessity ordinarily of a hearing to determine aggregation.

Invention—Combination—Aggregation (Definition)—Extensive Use—Adoption by Defendant.

H. J. Heinz v. Cohn, 207 Fed. 547 (C. C. A., Ninth Circuit) Patent No. 835,850, for a one-piece envelope with a window in the face rendered transparent by the application of an oily preparation and having a colored border to conceal irregularity of outline and patent No. 824,908 for such an envelope with the addition of an advertising device, held not anticipated, disclosing patentable novelty and invention, and infringed. Collection of definitions and authorities.

Invention—Double Use—Substitution of Material.

Archer v. Imperial Mach. Co., 207 Fed. 81. Patent No. 999,478, for a machine for peeling potatoes comprising a metal cylinder having a revolving metal disk for moving the potatoes and having its inner surface coated with a granulated abrading material. Held void for lack of invention over the prior art because the emery or similar material was merely a substitute for an equivalent roughened or striated surfaces. The court held that a change of material may evidence invention, but to do so must produce a result so much better than the old material as to be novel and unexpected. Judge Coxe dissenting.

Prior Use—Use Abroad—Prior Knowledge.

Westinghouse Mach. Co. et al. v. General Electric Co. et al., 207 Fed. 75 (C. C. A., Second Circuit). Held that a reduction to practice abroad has no effect upon the question of priority between two parties, following *De Kando v. Armstrong*, 37 App. D. C. 314, 169 O. G. 1185. The court thought that if § 4886 R. S. U. S. stood alone such production of the machine would be a basis for prior knowledge provided the persons who knew the machine are in this country. Sec. 4923 R. S. U. S., however, very specifically provides that no knowledge or use abroad shall be a bar but only a patent or printed publication.

Invention—Degree—Specification Definite.

Toledo Computing Scale Co. v. Computing Scale Co., 208 Fed. 410 (C. C. A., Seventh Circuit). The court opens the opinion thus: "In this record the greatest thing is the fact that Smith put in the hands of the world's vendors of commodities the first usable automatic computing scales. * * *

"Defendant insists, however, that making the drum lighter was merely a matter of degree. Of course the lessening of weight is a matter of degree; but it is not necessarily merely a matter of degree. If the change converts failure into success, something more than a matter of degree is involved. Unreliable automatic computing scales, in the practical art, are no scales at all. A reliable automatic scale was a new mechanism, a creation, just as in the aspirin case (*Kuehmsted v. Farbenfabriken of Elberfeld Co.*, 179 Fed. 701, 103 C. C. A. 243) this court held that the reduction of the amount of impurities in a compound theretofore known to chemists, whereby a deleterious substance was converted into a valuable medicine, was not merely a change of degree, but was a change of kind, producing a new article of commerce.

"A further insistence is made that the patent is void for indefiniteness, in this, that the degree of thinness of the aluminum frame and of the paper cylinder are not specified. In the quoted part of the specification Smith substantially told those skilled in the art to make the skeleton frame to the last degree of thinness that would support the cylinder, and to make the cylinder of the very thinnest paper they could then or thereafter find in the market, which would be stiff enough to retain its shape when attached to the frame. This, it seems to us, was very clear and definite instruction."

Invention—Slight Distinctions.

Barry et al. v. Harpoon Castor Mfg. Co., 209 Fed. 207 (C. C. A., Second Circuit) Patent No. 995,758, "domes of silence" sustained with interesting discussion of this as a meritorious invention though exceedingly simple and though following similar shapes and forms in other arts.

Anticipation—Drawing.

A. R. Mosler & Co. v. Lurie, 209 Fed. 364 (C. C. A., Second Circuit). The court in this case distinguished Consolidated Bunting Co. v. Metropolitan Brewing Co., 60 Fed. 93, 8 C. C. A. 485 (Second), from this case, placing this particular under another class as follows:

"With a deliverance of the Circuit Court of Appeals for the Seventh Circuit (Gray Telephone P. S. Co. v. Baird Mfg. Co., 174 Fed. 417, 98 C. C. A. 353), we fully concur. It reads as follows:

'A patent for a mechanical combination is not anticipated by a drawing in a prior patent which incidentally shows a similar arrangement which is not essential to the first invention, and was not designed, adapted, or used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second inventor.'

Invention Abroad or Foreign Use Not Anticipation.

Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (C. C. A., Second Circuit).

"As to the Schiodt patent we agree with Judge Holt that it cannot be considered as part of the prior art. Briefly the facts are these: Schiodt lived in England and made his invention there; it was not patented or published prior to date of the Locke-Dunn patent. Schiodt filed application with United States Pat-

ent Office May 3, 1905, Locke & Dunn's application was filed March 9, 1906, and patent issued to them July 21, 1908. Schiodt's patent was granted May 21, 1907. Under section 4923, U. S. Rev. St. (U. S. Comp. St. 1901, p. 3396), Locke & Dunn, original inventors, could not be defeated by knowledge of the invention in a foreign country, when not patented or published there. It makes no difference that the person in the foreign country having such knowledge was also an inventor. Appellant seeks to avoid the statute on the theory that the foreign inventor 'gave the American public a knowledge of his invention through the Patent Office' when he filed his application. But in reality by that act he gave the American public nothing. His application was confidential; the public could not see it or be informed of its contents until patent issued upon it. Before that date came Locke & Dunn with their application. Under these circumstances we do not see how the Schiodt patent can be considered 'prior art.' See our opinion in *Westinghouse M. Company v. General Electric Company* (C. C. A.), 207 Fed. 75, filed June 14, 1913. Even if it were in the prior art we concur with Judge Holt in the conclusion that it does not affect the claims of the patents in suit."

Double Use.

O'Brien-Worthen Co. v. Stempel, 209 Fed. 849 (C. C. A., Eighth Circuit).

"But the application of an old device to a new use is not always or generally even patentable. It is only when the new use is so recondite and remote from that to which the old device has been applied or for which it was conceived that its application to the new use would not occur to the mind of the ordinary mechanic skilled in the art, that there is invention in the conception of its application to the new use, and the old use fails to limit the claim of such an application. *Potts v. Creager*, 155 U. S. 597, 608, 16 Sup. Ct. 194, 39 L. Ed. 275; *Hobbs v. Beach*, 180 U. S. 383, 388, 390, 21 Sup. Ct. 409, 45 L. Ed. 586; *Adams Electric Ry. Co. v. Lindell Ry. Co.*, 77 Fed. 432, 447, 23 C. C. A. 233, 248."

Article of Manufacture.

Cincinnati Traction Co. v. Pope, 210 Fed. 443 (C. C. A., Sixth Circuit). Example of street railway transfer sustained as patentable article of manufacture with elaborate discussion and citations.

Effect of Prior Adjudications.

Doelger v. German-American Filter Co., 204 Fed. 274 (C. C. A., Second Circuit). Example of elaborate litigation upon a

patent. Held that where a patent has been the subject of such extensive and persistent litigation and uniformly sustained a court should, unless clearly convinced to the contrary, follow such previous favorable decisions.

SUITS IN EQUITY.

Rules.

For Equity Rules of Practice see 29 Sup. Ct. xxx; 57 L. Ed. 1633; 198 Fed. vii—xliii, 115 C. C. A. xix—xlii.

Demurrers and Motions to Dismiss Bill.

Elaborate arguments with citations are found in *American Fibre Co. v. Buckskin Fibre Co.*, 72 Fed. 508, 18 C. C. A. (Sixth Circuit). In this case the demurrer was overruled as in the cases of *Niedich v. Fosbener*, 108 Fed. 266 (N. Y.); *Standard v. Crane*, 76 Fed. 767, 22 C. C. A. 549; *Krell Auto Grand Piano Co. v. Story & Clark Co.*, 207 Fed. 946 (C. C. A.), and *Ferro Concrete Const. Co. v. Concrete Steel Co.*, 206 Fed. 666. Holding a patent invalid on its face upon demurrer and with authorities are *Richards v. Chase*, 158 U. S. 299, 39 L. Ed. 991; *Wells v. Scranton*, 153 Fed. 181, 82 C. C. A. 355; *Thomas v. St. Louis*, 149 Fed. 753, 79 C. C. A. 89; *Strom v. Weir*, 83 Fed. 170, 27 C. C. A. 502; *Brunswick v. Klumpp*, 131 Fed. 255, 65 C. C. A. 447; and *Fowler v. City of New York*, 121 Fed. 147, 58 C. C. A. 113.

In *Bronk v. Charles H. Scott Co.*, 211 Fed. 338, the Court of Appeals of the Second Circuit in the October term, 1913, affirmed a decree of the lower court dismissing the bill for want of infringement with an opinion giving reasons and citing authorities.

For annotated case, see *Caldwell v. Powell*, 19 C. C. A. 592, 73 Fed. 488 (Third Circuit) on design patent. There is also an excellent discussion pro and con in *Parsons v. Seelye*, 100 Fed. 452, 40 C. C. A. 484. For cases of demurrer sustained for want of infringement, see *Collins Mfg. Co. v. Capitol Mfg. Co.*, 42 Fed. 64 (Conn.), trademark case; *Gerard v. Diebold Co.*, 48 Fed. 380 (Texas), patent case; *Fernald v. Oneida Chuck Co.*, 167 Fed. 559 (N. Y.), patent case. See for comparison of various cases *Southern Plow Co. v. Atlanta*, 165 Fed. 214, C. C. A. That a prior patent not set out in the bill cannot be considered as part of the record on demurrer although it is set out in the laches agreement attached to the bill, see *Havans v. Ostrander & Co.*, 190 Fed. 199 (N. Y.).

Rules—Motion to Dismiss—Bill.

Wilson v. American Ice Co., 206 Fed. 736 (N. Y.). "This motion, being an alleged defense, in point of law, arising upon the face of the bill for insufficiency of fact, to constitute a valid cause of action, takes the place of a demurrer. Eq. Rule 29 (198 Fed. xxvi, 115 C. C. A. xxvi. It is elementary that a complainant in equity must allege with particularity every material fact necessary for him to prove to establish his right to the relief prayed. Story's Equity Pleading, § 241; Shipman's Equity Pleading, 320; Hageman v. Brown, 76 N. J. Eq. 126, 73 Atl. 862; Schuler v. So. Iron & Steel Co., 77 N. J. Eq. 60, 75 Atl. 552. Only the ultimate facts upon which the complainant asks relief, however, are necessary to be stated, and a short and simple statement of these, omitting mere statements of evidence, is sufficient. See Eq. Rule 25, par. 3 (198 Fed. xxv. 115 C. C. A. xxv)."

Rules—Answer, When Evidence.

Kirkpatrick v. McBride, 202 Fed. 144. Equity Rule 41. When answer under oath is not waived by the bill responsive averments in the answer under oath are evidence; and this rule is not affected by an opposite rule of a state statute covering special feature of evidence.

Rules, Set-Off or Counterclaim.

Terry Steam Turbine Co. v. Sturtevant Co., 204 Fed. 103 (Mass.). Application of Rule 30 Equity Practice on counterclaim; applies only to claim arising out of the transaction which is the subject of the suit. Therefore, the defendant in an infringement suit cannot set up as a counterclaim a cause of action for infringement by plaintiff of a different patent.

* * * * *

Marconi Co. v. National Electric Co., 206 Fed. 295 (N. Y.). Rule 30 Equity. Set-off or counterclaim may be in cause of action for infringement by the plaintiff of other patents relating to the same subject-matter as the one in suit, if independent suits in equity might be maintained thereon. See for definitions.

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Motion Picture Patents Co. v. Eclair Film Co., 208 Fed. 416 (N. J.). Rule 30, Equity Rules. Illegal demand may not be applied as set-off or counterclaim.

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Vacuum Cleaner Co. v. American Rotary Valve Co., 208 Fed. 419 (N. Y.). Under Equity Rule 30. Defendant set up in an-

swer a counterclaim for damages to his business by reason of circulation by the plaintiff of false statements.

* * * * *

McGill v. Sorensen, 209 Fed. 876 (N. Y.). Set-off and counterclaim. Defendant may plead a counterclaim for infringement under Rule 30 only where it is shown that an infringement was committed in the district and that the complainant has a regular and established place of business therein. Where suit is brought by an individual assignee of a patent the defendant may not counterclaim for infringement of another patent by a corporation of which the complainant is an officer unless it can be shown that the corporation is the real defendant in interest as complainant.

Rule, Transfer of Case.

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Rule, Immaterial Defects.

Medical Society of South Carolina v. Gilbreth, 208 Fed. 899 (S. Car.). Equity, Rule 19. Example of disregarding immaterial errors or defects.

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Example of application of new Equity, Rule 63, In re Beckwith, 203 Fed. 45 (C. C. A., Seventh Circuit).

Rule, Demurrer (Motion to Dismiss).

Crown Feature Film Co. v. Bettis Amusement Co., etc., 206 Fed. 362 (Ohio). Affidavits cannot be considered in support of a demurrer to a bill. (This presumably applicable also to motion to dismiss of same character as demurrer.)

Defenses—Assignee.

Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (C. C. A., Second Circuit). It is no defense for a patentee to urge against an assignee that he was induced to part with a patent by unfair representations.

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