INGELS v. MAST.

Case No. 7,034.

{2 Ban. & A. 24; 1 Flip. 424; 7 O. G. 836; 2 Cent. Law J. 349; 9 Pac. Law Rep. 189.}[1]

Circuit Court, S. D. Ohio. Feb., 1875.

PATENT LAW—MEASURE OF DAMAGES FOR INFRINGEMENT—IMPROVEMENT.

Where the complainant's invention consisted of a combination of certain old elements to which some new features were added, the master reported the damages, based upon a license fee on the whole combination. *Held,* that the complainant was entitled only to the value of the improvements which he had added.

{Hearing on exceptions to master's report. The opinion of the court on the question of

infringement is reported in {Case No. 7,033}. The court there held that complainant's patent was for a combination of four elements, a seed cup for grain drills having a concave hopper; a seed wheel turning therein, with projecting cogs, to draw forward the grain; an elevated delivery orifice, so as to make the drill force feed; and cheeks or bosses between which the wheel turned. It held that the Strayer patent, earlier in date than that on which the suit is brought, showed all these except the last, to-wit, the cheeks. The master reported damages to the amount of nearly $20,000, on a basis of a license fee, for the whole combination covered by the patent in suit, and others. There was other testimony in the record as to the value of the whole combination. To this report exceptions were filed. On the hearing, complainant contended {under the decision of Judge Grier, in Livingston v. Jones {Case No. 8,414}, and other decisions},[2] that he was entitled to the profit on the entire combination, while respondent claimed that under the rule finally settled in Whitney v. Mowry {14 Wall. (81 U. S.) 620}, complainant could recover only for the additional profit that he had made by using the whole combination, over what he might have made by using all except the cheeks {the only thing Ingels added to the combination of Strayer}.[2] And as complainant had rested his case, without apportioning the profits, he was entitled to recover nominal damages only. Respondent referred to Wayne v. Holmes {Case No. 17,303}; Ransom v. Mayor of New York {Id. 11,573}; Poppenhusen v. New York Gutta-Pereha Comb Co. {Id. 11,283}; {Goodyear v. Bishop {Id. 5,559}; Carter v. Baker {Id. 2,472}; Scwarzel v. Holenshade {Id. 12,506}; Graham v. Mason {Id. 5,672}; Curt. Pat. (4th Ed.) 458–461; City of New York v. Ransom, 23 How. {64 U. S.} 487; Jones v. Moorhead, 1 Wall. {68 U. S.} 155; Seymour v. McCormick, 16 How. {57 U. S.} 480; Mowry v. Whitney, 14 Wall. {81 U. S.} 620; Philp v. Nock, 17 Wall. {84 U. S.} 460; Whitmore v. Cutter {Case No. 17,601}; and Burdell v. Denig {Id. 2,142}.

{The court gave simply its conclusions.}[3]

Wood & Boyd, for complainant.

Hatch & Parkinson, for defendant.

Before EMMONS, Circuit Judge, and SWING, District Judge.

EMMONS, Circuit Judge. 1st—The testimony, when analyzed, does not show any certain basis upon which the finding of the master can rest. No one witness swears to any license fee which is applicable to the precise thing here used, and for which damage is claimed. There is no claim that the report of the master is warranted by any proof of profits.

2d—Subject to reconsideration when the master's further report comes in, it is suggested that the proper measure of damages is the difference between the value of the improvement used by the defendant, and any other like device which was open to him without royalty, or by payment of a less royalty. This is said notwithstanding the sugges-

tion in Judge Grier's decision in Livingston v. Jones {Case No. 8,414}, that there is no warrant for subdividing the elements in an improvement and giving the complainant the value only of that peculiar feature in it which he has added. He seems to argue that the portion of the device which is improved must be taken as a unit, and the complainant entitled to its whole value as improved. We rule for the present, on the contrary, that he is entitled only to the value of that which he has added, and that such a subdivision should be made (see Jones v. Moorhead, 1 Wall. {68 U. S.} 155), which, although not deciding the question of damages, modifies Judge Grier's doctrine of unity.

3d—The master will, however, make an additional report, upon the basis that the complainant is entitled to damages for all the profits which the defendant has made by the use of the improved cheeks described in the patent. This, as distinguished from the rule which would confine him to the difference of the value of the cheeks, and such as he might have used without royalty.

It will be recommitted to the master to make a further report in accordance with these views. Ordered accordingly.

{See Case No. 7,033.}

[1] {Reported by Hubert A. Banning, Esq., and Henry Arden, Esq., and by William Searcy Flippin, Esq., and here compiled and reprinted by permission. The syllabus and opinion are from 2 Ban. & A. 24, and the statement is from 1 Flip. 424.}

[2] {From 9 Pac. Law Rep. 189.}

[3] {From 1 Flip. 424.}