

POTTER ET AL. V. MULLER.

[2 Fish. Pat. Cas. 465.]¹

Circuit Court, S. D. Ohio.

April, 1864.

INJUNCTION IN PATENT CAUSES—PRESUMPTION
IN FAVOR OF PATENT—LENGTH OF
POSSESSION.

1. Injunctions in patent cases are now granted without a previous trial at law, in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years without any successful impeachment of its validity.

[Cited in *White v. Heath*, 10 Fed. 293; *Dickerson v. De La Vergne Refrigerating Mach. Co.*, 35 Fed. 144.]

2. There is no fixed rule as to the length of time the possession and enjoyment of the right under a patent shall have continued. It must be sufficient to justify a presumption in favor of its validity.
3. The presumptions in favor of a patent, arising from the length of possession and enjoyment since its issue, are greatly strengthened by the fact that its validity has been affirmed and sustained by prior judicial decisions, either at law or in equity.
4. The first claim of A. B. Wilson's reissue 346 does not involve or require the agency of the needle to make it valid or effective. The invention of Wilson is not anticipated by a feed wheel armed with short metal points to hold the cloth, and which prevent it from being turned, so as to sew curved seams at the pleasure of the operator.
5. The rights emanating from and existing under a patent are as sacred and as well entitled to protection as any other species of property.
6. Although it is conceded that to justify the stringent remedy by injunction, the party seeking it should clearly establish his right, yet, when so established, it is not only a rightful, but often the only remedy which is available for him.

In equity. This was a motion [by Orlando B. Potter, Nathaniel Wheeler, and others] to dissolve a provisional injunction, granted to restrain the

defendant [Anton Muller] from infringing reissued letters patent Nos. 346 and 414, for “improvements in sewing machines,” issued to Allen B. Wilson, and more particularly set forth, in the report of *Potter v. Wilson* [Case No. 11,342]. The defendant claimed to be the first and original inventor of the improvements patented to Wilson, and denied infringement.

S. S. Fisher, for complainants.

George E. Pugh, for defendant.

LEAVITT, District Judge. This is an application to dissolve the preliminary injunction granted in this case. The injunction was allowed after due notice to the defendant, but without opposition on his part; and the only question on the pending motion is, whether it is a proper case for the allowance of the writ? If the court is now satisfied that the order for the writ ought not to have been made, the injunction will be dissolved; if otherwise, it will be perpetuated.

The complainants aver in their bill that they are the owners, by legal assignments, of the exclusive right and benefit of a patent granted to A. B. Wilson November 12, 1850, for an improvement in sewing machines, which was subsequently surrendered by the patentee, and on January 22, 1856, two new patents issued, marked or designated as reissues No. 345 and No. 346, and that on December 9, 1856 (reissue No. 345 having been surrendered), a third reissue, 414, was granted, which said reissued patents covered the invention set forth in the original patent.

The bill alleges an infringement of the reissued patents 346 and 414, by the manufacture and sale of a large number of machines, at the city of Cincinnati, embodying substantially the invention of Wilson, as secured to him by his patents. The bill is sworn to by the complainants, and is sustained by affidavits proving the identity of the machines made and sold by the defendant with the improvements covered by Wilson’s patents.

The defendant has filed an answer under oath, setting up in substance two grounds of defense: (1) That Wilson was not the original and first inventor of the improvements patented to him, and that his patent is therefore not valid; and (2) that the machines made and sold by the defendant do not infringe the invention patented to Wilson in 1850.

The present motion must be decided on the facts as they are before the court, without anticipating what may be the aspect of the case on the final hearing. And it is not, therefore, the duty of the court to notice any point made in the argument which has no application to the motion to dissolve the injunction.

The rule as to granting or continuing injunctions in patent right cases is now well settled by the modern usages of the courts of the United States. They are now granted without a previous trial at law in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain infringement. And there is no fixed rule as to the length of time the possession and enjoyment of the right under a patent shall have continued. It must be sufficient to justify a presumption in favor of its validity. In the present case, there can be no doubt of the fairness of such a presumption from the age of the patent. The original patent was issued in 1850, and nearly fourteen years had expired when this suit was commenced. Or, if dating back only to the reissues of 1856, the time of the possession and enjoyment of the rights under Wilson's patent includes nearly eight years.

But the presumptions in favor of a patent, arising from the length of time which has 1171 elapsed since

its issue, are greatly strengthened by the fact that its validity has been affirmed and sustained by prior judicial decisions, either at law or in equity.

This principle bears on the present case with unusual force. It is not of frequent occurrence that a patent is sustained so strongly by the weight of judicial authority as that now under consideration. And I am greatly relieved from the labor of investigating and deciding some of the points involved in the present motion by the adjudications referred to. They affirm clearly that the improvements referred to, or inventions described, by Wilson, in the specifications and claims of his patent, are the proper subjects of a patent, and are set forth by him in accordance with the requirements of the statute. They also satisfactorily establish the novelty and originality of his inventions, so far, at least, as the attempt was made to invalidate his claim in this case.

The court has been favored with copies of the opinion of Mr. Justice Nelson, as delivered by him in the circuit court for the Southern district of New York, and also of Judges Smalley, of the district of Vermont, and Ingersoll, of the district of Connecticut. I have read these opinions with care, and have no hesitancy in adopting their conclusions, both as to the law and the facts investigated by them. In one of the cases, before Justice Nelson, assisted by Judge Smalley, there was a very protracted and laborious trial, with full argument on both sides by counsel of eminent ability. The learned judge, in that opinion, as also another involving substantially the same questions, fully affirms the validity of Wilson's patent, both as to the sufficiency of the specifications and the novelty and originality of his invention.

As to the date of Wilson's invention, the learned judge, from the evidence before him, comes to the conclusion that it was perfected in the mind of the inventor as early as November, 1848, and that his

first machine was completed in the month of April or May, 1849. The other judges referred to, in the cases before them, reach substantially the same result. They are fully sustained by the affidavit of Wilson, offered by complainants in resistance of the motion now before the court. Wilson is not a party to this suit, and the court is apprised of no reason why his affidavit is not entitled to entire credence. He states the facts connected with the date of his invention precisely as found by Judge Nelson, as above set forth; and in confirmation of these facts the affiant gives extracts from two periodicals published about the time his invention was perfected, in which it is referred to and minutely described. There is therefore no reason to doubt that as early as April or May, 1849, it was practically completed by the construction of a working machine, embodying the improvements covered by the patent of November 12, 1850, and the subsequent reissues.

The defendant, however, has set up in his answer that he was the inventor of an improvement in sewing machines substantially the same as that patented to Wilson. This claim is alleged for the purpose of impeaching the validity of Wilson's patent, as not being for a new and original invention. Without inquiring here whether there is any substantial identity between these inventions, it may be remarked that the proofs before the court clearly show Wilson's is prior in date to that claimed as the defendant's. The defendant swears, in his answer, that before he left Germany he had conceived the idea of an improvement in a sewing machine, in which the feeding apparatus was substantially the same as that patented to Wilson. But he admits that his invention was not perfected until after his arrival in this country. From his own showing, his first machine was made by him at Cincinnati, and was not completed until September or October, 1849. This was six months

after Wilson had completed a practical machine, embodying his improvement in the feeding device. If the two inventions were identical, it is apparent that Wilson's, being prior in time, can not be affected or invalidated by a discovery or invention of a later date.

But there is another answer to this attempt to impeach the novelty of the improvement patented to Wilson. The defendant has exhibited a mutilated and imperfect model of his machine, with some affidavits as to the time it was made, and the principle of its operation. Without professing to be an expert on the question of the identity of two mechanical structures, I can not hesitate in the conclusion that the defendant's machine does not embody literally or substantially the feeding device described in Wilson's specification as being his invention.

The main and distinguishing element of his invention is the mechanical device by which curved seams may be sewed. It is this that constitutes its great value, and has made its use indispensable on every practical sewing machine. On this subject, Judge Nelson, after noticing the objection to all prior feeding devices, says: "The object of the improvement in question was to remedy these defects by causing the cloth to be moved automatically under the needle, and the device so arranged as to admit of seams of any curvature." And Judge Ingersoll, in describing Wilson's improvement, says: "Surfaces as before used and applied, could not be used and applied to cloth so as to sew seams of any considerable curvature. By his (Wilson's) devices, the cloth, while held between the surfaces, can be turned and twisted so as to sew curved seams, it being grasped only in a small part of its surface by the feeding clamps."

Now it is clear, from an inspection of the defendant's machine, that it is not adapted to make, and can not make, curved seams. It provides for a wheel, with a series of short 1172 metal points to hold

the cloth, and which necessarily prevent it from being turned so as to give a curvature to the seams. The cloth does not move over a flat table or surface, but over an arch or wheel, and can, therefore, only move in a straight direction, and can not be turned, at the pleasure of the operator, so as to produce a curved seam.

Without noticing further the want of identity between the two structures, it may be remarked that the defendant impliedly admits the defects of his invention by the fact that the machines made and sold by him and charged as an infringement of Wilson's patent, are not constructed upon the plan which he claims as his invention. This is conclusive to show that, in his opinion, his device for feeding was entirely defective, as not adapted to the making of curved seams.

Convinced beyond a doubt that the defendant has wholly failed to impeach Wilson's patent on the ground that the invention covered by it is not new and original, I will examine briefly the remaining question, whether the machines made and sold by the defendant, so far as relates to the feeding device, embody the principle of Wilson's invention, so as to constitute an infringement. Without attempting a minute comparison of the two machines, I will refer to the evidence before the court as to their identity, coming from experts upon whose statements and opinions I place more reliance than I should be justified in doing from a mere personal inspection of the structures. The testimony of this class of witnesses, when intelligent and otherwise reliable, is of great value in patent right controversies, involving questions of identity as between two machines. The complainant, in this case, has submitted the affidavits of two witnesses on the point which, for the purposes of the present inquiry, may be regarded as conclusive.

If, therefore, a comparison of the two structures left a doubt as to the identity of the feeding device, the oaths of the two witnesses referred to, uncontradicted as they are, would be quite sufficient to establish it.

It is insisted, in the argument of the defendant's counsel, that in Wilson's device for moving the cloth and holding it to its place in sewing, he describes and claims the use of the needle as a necessary agency, and that as the defendant, in the machines made and sold by him, does not use the needle for such purpose, he does not, therefore, infringe. The first remark to be made on this point is that the defendant's theory is in direct conflict with the oaths of the two witnesses referred to, who clearly prove the identity of the devices for moving and holding the cloth on the two machines. But it appears from the specification of Wilson's reissue 346, that he does not claim the use of the needle for the purpose before indicated. The first claim is described as "the method of causing the cloth or material, to be sewed in a sewing machine, to progress regularly, by the joint action of the surfaces between which it is clamped, and which act in conjunction, substantially in the manner and for the purpose herein specified." Now, it appears that the objection stated above was urged in the case heard by Judge Ingersoll. In the opinion of the learned judge (*Potter v. Holland* [Case No. 11,330]), he holds that "the instrumentality of the needle is not required to make the cloth progress or go forward;" and, again, he says: "The way in which the cloth is made to progress regularly by the instrumentality of the two feeding surfaces, without the aid of the needle, is pointed out in the specification."

Judge Nelson, in his opinion (*Potter v. Wilson* [Id. 11,342]), says: "Now, it is apparent that all the several claims rest upon and grow out of the main improvement of the feeding apparatus, consisting of two surfaces clasping the cloth and advancing it to

the needle by the intermittent motion of one of them, and so arranged as, at the same time, to admit of the turning of the cloth, and sewing seams of any practically useful curvature.”

It will be observed that neither of the two judges gives a construction to the specification as constituting a claim to the agency of the needle in holding or advancing the cloth, and it is obvious that if the defendant, in his machines, uses the needle in a way different from what it is used in the Wilson machine, it would not protect him from liability as an infringer, if he used the other and material parts of the invention.

But it can not be necessary that the court should enlarge upon the question before it. From the case made by the pleadings and proofs, I am satisfied the complainants have a valid patent, and that the defendant has infringed their exclusive rights under it. These rights, though emanating from and existing under a patent, are as sacred and as well entitled to protection as any other species of property. And although it is conceded that to justify the stringent remedy by injunction, the party seeking it should clearly establish his right, yet, when so established, it is not only a rightful, but often the only remedy which is available for him. Such seems to be the aspect of the present case, and the court can not release the defendant from the operation of the injunction that has been awarded.

The motion to dissolve the injunction is, therefore, overruled.

{For a hearing on a motion for an attachment, see Case No. 11,333. For other cases involving this patent, see note to *Potter v. Whitney*, Case No. 11,341.]

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