

HOLT AND OTHERS V. KEELER AND ANOTHER.

*Circuit Court, D. New York.* August 1, 1882.

PATENT—VALIDITY OF REISSUE.

In the descriptive matter in the specification in the original patent for an improvement in making wheels, granted January 23, 1866, it was said that “the type wheel is provided with yielding rims or flanges, made of India rubber or other elastic material, so that the types can be depressed on the surface to be marked with the requisite force to produce the desired impression. This type wheel is provided with projecting flanges, *b*, made of India rubber or other soft and elastic material, so that by pressing the wheel down upon the surface to be marked the types are brought into contact with said surface with the requisite force to produce the desired impression;” and claim No. 2 was as follows: “(2) The yielding flanges, *b*, on type wheel, *A*, constructing and operating substantially as and for the purpose described.” October 26, 1875, a reissue was granted, and in the specification the descriptive matter was altered to the following: “The type wheel is provided with rims or flanges, preferably made of India rubber or other elastic material, so that the types can be depressed on the subject to be marked with the requisite force to produce the desired impression. The rims or flanges seem to keep the surface of the type in a plane parallel with the surface to be marked, which is otherwise often difficult, owing to the different lengths of lines of type, or the position of the type at the side of the surface of the type wheel. This type wheel is provided with projecting flanges, *b*.” The claims of the reissue were these: “(2) The combination with a handle of a type wheel provided with flanges for keeping the plane of the type provided with the surface of the article to be marked; (3) a type wheel provided with yielding flanges, constructed and operating substantially as and for the purpose described.” The wheels used by the defendants would not have infringed claim 2 or 3 of the original patent, but would infringe claim No. 2 of the reissue, because they have a handle and rigid flanges which keep the plane of the type parallel with the surface of the article to be marked. *Held*, that if there was any error in the original patent in not setting forth and claiming rigid flanges, or in stating that the flanges were to be elastic, and were to be so arranged that the types were

to be out of contact with the surface to be marked until by the yielding of the flanges through pressing down the wheel the types were to be brought in contact with such surface, the error was a plain one, apparent at once to the patentee, and as capable of being promptly corrected then as by a reissue after a lapse of more than nine years, during which the manufacture of wheels substantially the same as those of the defendants had been entered upon, there being no infringement of any claim of the original patent in respect to flanges, and that claim No. 2 of the reissue could not be upheld as covering any flanges but such as were shown in the original patent, consequently the bill must be dismissed, with costs.

*George W. Hey*, for plaintiffs.

*James A. Allen*, for defendants.

BLATCHFORD, Justice. This is a suit in equity brought on reissue of letters patent No. 6,714, granted to Horace Holt, one of the

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plaintiffs, October 26, 1875, for an "improvement in marking wheels;" the original patent, No. 52,169, having been granted to him January 23, 1866. As questions concerning the validity of the reissue are raised, it will be useful to place the two specifications side by side. The left-hand one is the specification of the original patent, and the right-hand one is that of the reissue. In each the parts which are not found in the other are in italics:

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"Figure 1 represents a side elevation of this invention. Figure 2 is a sectional plan or top view of the same. Similar letters of reference indicate like parts. This invention consists in a revolving type wheel, arranged in a suitable revolving type wheel, handle, in combination with arranged in a suitable ink roller, in such a handle in combination manner that, by carrying said

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with an ink roller, in such type wheel over the cover of a manner that, by carrying a box, or over any other said type wheel over the surface, the types on said cover of a box, or over wheel produce an any other surface, the impression, and the marking types on said wheel of a box or other article can produce an impression, be effected neatly and and the marking of a box distinctly, with little loss of or other article can be time. The ink roller shown effected neatly and *in the drawings* is composed distinctly, with little loss of a hollow cylindrical of time. The ink roller reservoir, perforated with is composed of a hollow small holes, and surrounded cylindrical reservoir, by a strip of cloth or other perforated with small absorbent material, so that holes, and surrounded by the same is capable of a strip of cloth or other holding a supply of ink for a absorbent material, so large number of impressions. that the same is capable The type wheel is provided of holding a supply of ink with rims or flanges, for a large number of *preferably* made of India impressions. The type rubber or other elastic wheel is provided with material, so that the types *yielding* rims or flanges can be depressed on the made of India rubber or surface to be marked with other elastic material, so the requisite force to that the types can be produce the desired depressed on the surface impression. *The rims or to be marked with the flanges serve to keep the requisite force to produce surface of the types in a the desired impression, plane parallel with the and a coiled or other surface to be marked, which spring is applied to said is otherwise often difficult, type wheel in such a owing to the different lengths manner that it carries the of lines of type, or the same back, after position of the type at the side of the surface of the*

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*type wheel.* It is also advantageous to use a coiled or other spring, *which, when* applied to said type wheel, is

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each impression, to the *arranged to carry* the same starting point, and back, after each impression, thereby the types are to the starting point, and brought in contact with thereby the types are brought the ink roller, and in contact with the ink roller, supplied with the and supplied with the requisite quantity of ink requisite quantity of ink for for the subsequent the subsequent impression, impression; and, and, furthermore, the type furthermore, the type wheel readjusts itself in the wheel readjusts itself in required position for starting. the required position for starting.

A represents a wheel A represents a wheel made of cast iron or of cast iron or other suitable other suitable material, material, and arranged so and arranged so that that the desired types can be desired types can be applied to or inserted in its applied to or inserted in periphery, either its periphery, either permanently, by means of a permanently, by means of strip of copper or other a strip of copper or other suitable material, or so that suitable material, or so said types can be changed at that said types can be pleasure. This type wheel is changed at pleasure. This mounted on an axle, *a*, which type wheel is mounted on has its bearings in a forked an axle, *a*, which has its handle, *B*, and it is provided bearings in a forked with projecting flanges, *b*. handle, *B*, and it is provided with projecting flanges, *b*, *made of India rubber, or other soft and*

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*elastic material, so that by pressing the wheel down upon the surface to be marked, the types are brought in contact with said surface with the requisite force to produce the desired impression.*

As the wheel revolves,As the wheel revolves, the the types on itstypes on Its circumference circumference come income in contact with the contact with the surfacesurface of the ink roller, C, of the ink roller, C,which is mounted on an axle, which is mounted on ane, having its bearings in the axle, e, having itsextreme ends of the forked bearings in the extremehandle, B. Suitable springs, ends of the forkedd, draw the ink roller handle, B. Suitabledraw the ink roller towards the typesprings, the ink roller can be wheel, and, byremoved from its seat. Each disconnecting saidend of the fork of the handle springs, the ink roller canhas two slots,— one long and be removed from its seat.the other short,—which form

*main and secondary bearings for the journals of the inking roller. When it is desired that the roller and Wheel should be in contact, the journals of the former should be in the long slots, as shown in the drawing, which represents the roller in its normal position; but as it is sometimes necessary that the marking wheel and*

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*roller should revolve independent of each other, as when distributing ink on the latter, or when it is being used on a separate flat form, or when either the wheel or the roller, or both, are being cleaned, then the journals of the latter should be placed in the short slots or secondary bearings.*

Said ink roller may be made solid, similar to ordinary printers' rollers; but *I have shown in the drawings* a hollow cylindrical reservoir, *e*, to which access can be had by removing one of its heads. This reservoir is perforated with a large number of small holes. *The roller is surrounded by a strip, f, of cloth or other absorbent material. By reservoir, if used, a large supply of ink can be carried in the roller, and the marking wheel produces a number of impressions before it is necessary to recharge the same. A spring, g, applied to the axle of the wheel, A, (see figure 1,) carries the same back until the stud, h, in the wheel, A, (see figure 1,) comes in contact with a pin, i, projecting from the inner surface of the forked*

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wheel, comes in contact handle. By this stud and pin with a pin, *i*, projecting the starting point of the from the inner surface of wheel is defined, and, by the the forked handle. By action of the spring, the this stud and pin the wheel is carried back to this starting point of the starting point after each wheel is defined, and, by operation. In moving back, the action of the spring, the types, being in contact the wheel is carried back with the ink roller, are to this starting point after supplied with the requisite each, operation. In quantity of ink for the moving back, the types, subsequent operation. It is being in contact with the obvious that the starting ink roller, are supplied point of the type wheel can with the requisite be determined by other quantity of ink for the means besides the stud, *h*, subsequent operation. It and pin, *i*. By this simple is obvious that the device a large number of starting point of the type boxes or other packages can wheel can be determined be marked neatly and by other means besides distinctly with great dispatch. the stud, *h*, and pin, *i*. By *I am aware that a patent was this simple device a large granted Edwin Crowley, number of boxes or other dated July 8, 1856, in which packages can be marked was shown a handle holding neatly and distinctly with a type wheel and several great dispatch. inking rollers,*

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I claim as new, and arranged with a distributing desire to secure by letters band. *This I do not claim;* patent: *but I claim as new, and desire to secure by letters patent:*

1. The combination of 1. The combination, with a the type wheel, A, inking frame and handle, of a *type roller, C, and ink wheel, provided with a stud-reservoir, e, all pin, for defining the starting*

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*constructed, arranged, and stopping points, and an and operating as inking roller, constructed and specified.*

*operating substantially as specified.*

2. *The yielding flanges, 2. The combination, with a b, on type wheel, A, handle, of a type wheel constructed and operating provided with flanges for substantially as and for keeping the plane of the type the purpose described. parallel with the surface of the article to be marked.*

3. *The spring, g, applied 3. A type wheel provided in combination with the with yielding flanges, type wheel, A, stud, b, constructed and operating and pin, it or theirs substantially as and for the equivalents, substantially purpose described.*

*as and for the purpose set forth.*

4. *A spring in combination with a type wheel and stop pin, or its equivalent, for retracting the type wheel to its starting point, substantially as and for the purpose set forth.*

5. *The combination of a type wheel with a combined inking roller and ink reservoir, constructed substantially as and for the purpose described.*

6. *The combination of a handle and type wheel with a spring, for attracting the type wheel to its starting point, substantially as described.*

7. *In combination with an inking roller and its usual*



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*bearings, secondary bearings so arranged that the roller may revolve independently of the wheel, substantially as set forth.*

The answer in this case alleges that the surrender of the original patent was not made on account of any defect or insufficiency of the specification, but with the fraudulent design of enlarging the claims, so as to embrace inventions not made by him prior to the time when the original patent was issued, and which are not embraced therein; that the reissue, in its description and claims, embraces matters claimed therein as the invention of Holt which were not invented by him prior to the issue of the original patent, and which are not

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described or alluded to therein, such enlargement of the claims of the reissue being produced substantially by the insertion of claims 1, 2, and 7, which embrace new matter not shown in the claims, specification model, or drawing of the original patent; and that the reissued patent is for a different invention from the original patent, and is void.

The only claims in the reissue which it is now contended have been infringed are claims 2 and 3. In the specification of the original patent, what is said about the flanges is this:

“The type wheel is provided with yielding rims or flanges, made of India rubber or other elastic material, so that the types can be depressed on the surface to be marked with the requisite force to produce the desired, impression. This type wheel is provided with projecting flanges; 6, made of India rubber or other soft and elastic material, so that, by pressing the wheel down upon the surface to be marked, the types are

brought in contact with said surface with the requisite force to produce the desired impression.”

The claim based on the above descriptive matter is claim 2 of the original, as follows:

“2. The yielding flanges 6, on type wheel A, constructing and operating substantially as and for the purpose described.”

The foregoing descriptive matter is altered in the specification of the reissue to the following:

“The type wheel is provided with rims or flanges, preferably made of India rubber or other elastic material, so that the types can be depressed on the subject to be marked with the requisite force to produce the desired impression. The rims or flanges serve to keep the surface of the types in a plane parallel with the surface to be marked, which is otherwise often difficult owing to the different lengths of lines of type, or the position of the type at the side of the surface of the type wheel. This type wheel is provided with projecting flanges, *b*.”

The claims of the reissue, based on the foregoing descriptive matter in it, are these:

“2. The combination, with a handle, of a type wheel provided with flanges, for keeping the plane, of the type parallel with the surface of the article to be marked. 3. A type wheel provided with yielding flanges, constructed and operating substantially as and for the purpose described.”

There is in; the original a distinct statement that, the flanges are made of India rubber, or other elastic, yielding material, and there is no suggestion that they can consistently with the ideas of the

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invention be made of any non-elastic, non-yielding material. They are also stated to be projecting flanges. This expression, with nothing more, would be satisfied by flanges projecting from and beyond the face of the type wheel, and would not necessarily mean that

the flanges should project to a distance beyond the line of the impression faces of the types. But the expression is, that they are projecting flanges made of elastic material “*so that*, by pressing the wheel down on the surface to be marked, the types are brought in contact with said Surface with the requisite force to produce the desired impression.” This clearly implies that until the wheel is pressed down on the surface to be marked, the types are out of contact with that surface, because they are raised above it by reason of the fact that the flanges project further from the face of the wheel than the types project from said face; and that, by reason of the fact that the flanges are elastic and yielding, the pressing down of the wheel will cause the flanges to be compressed and to yield, and will allow the types to come into contact with the surface to be marked. It is true that figure 2 of the drawings of the original patent shows the face of the type projecting from the wheel to a greater distance than the flanges project from it. But in figure 2 of the drawings of the reissue the face of the type does not appear to project from the wheel to a greater distance than the flanges project from it.

Mr. Stark, an expert for the defendants, testifies that figure 2 of the drawings of the reissue shows the flanges to project more than the types, and that if they did not, the types could not be depressed in “the surface to be marked” to accomplish the result set forth in the specification. On the other hand, Mr. Robertson, an expert for the plaintiffs, testifies that he thinks the drawings of the reissue are intended to represent the types as on or about the same level as the flanges; that the word “depressed” in the connection in which it is used means that the types must be depressed into the surface of the material; and that this where hard types were used would necessitate the yielding of the flanges. It is very clear, however, that where hard types are used with elastic flanges,

in the Holt wheel the flanges must project to some extent beyond the faces of the types in order to be operative as elastic flanges, unless the hard types enter the material that is being marked. Nothing is said in the original specification as to the material of which the types are to be made, whether of hard metal or of elastic material, but it is shown that the model

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deposited by Holt in the patent office with his original application showed types of hard metal with elastic flanges. It must therefore be held that the original patent admitted of the use of hard types with elastic flanges. This being so, it follows that the elastic flanges must have been intended to project beyond the faces of hard types in order to be operative, and that such is the meaning of the language of the original specification. That that language was so understood at the time by the inventor is stated by him in his testimony. He says that when the original specification was submitted to him by his solicitor, he objected to that part of it which says, "that force is required to bring the printing surface down to a level or below the flexible bearers so that an impression could be taken, calling his attention to the fact that the bearers on the model were no higher than the face of the types." He says that the elastic flanges in the filed model projected so as to be on a line with the face of the metal types. Yet the specification was allowed to go out in that shape. The inventor does not seem to have used rigid flanges until after the original patent was issued, or to have had any idea when he obtained his original patent of using rigid flanges. One object in obtaining the reissue clearly was to procure a claim which should cover flanges, whether rigid or not, in connection with a handle, while retaining the claim to a type wheel with yielding flanges such as the original patent describes.

One form of the defendants' wheel has rigid flanges which do not project to a distance as far as the faces

of the types. In this form of wheel there is a border around the types, but it is a part of the types, and is inked and an impression taken from it, and it is not a flange in the sense of the Holt patent although it is elastic, the types being elastic and the flanges being rigid. In the other form of the defendants' wheel, called the Barnes and Allen wheel, the elastic border is omitted, the types being elastic and the flanges being rigid and not projecting as far as the face of the types. Neither of these forms of wheel would have infringed claim 2 of the original patent; nor does either of them infringe claim 3 of the reissue. They do infringe claim 2 of the reissue, as it stands, because they have a handle and rigid flanges which keep the plane of the type parallel with the surface of the article to be marked, if claim 2 can be construed as covering any flanges but such as were shown in the original patent.

The original patent was granted in January, 1866. The reissue was applied for in March, 1875, and granted in October, 1875. If

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there was any error in the original patent in not setting forth and claiming rigid flanges, or in stating that the flanges were to be elastic, and were to be so arranged that the types were to be out of contact with the surface to be marked until by the yielding of the flanges through pressing down the wheel the types would be brought in contact with such surface, the error was a plain one, apparent at once to the patentee, and as capable of being promptly corrected then as after a lapse of more than nine years. Meantime, the manufacture of wheels, substantially the same as those of the defendants, had been entered upon, there being no infringement of any claim of the original patent in respect to flanges. In view of all these facts, claim 2 of the reissue cannot be upheld as a claim covering rigid flanges such as the defendants use. The decisions to this effect are numerous. *Bell v. Langles*, 102 N.

Y. 128; *Manuf'g Co. v. Ladd*, Id. 408; *Manuf'g Co. v. Corbin*, 103 N. Y. 786; *Miller v. Brass Co.* 3 Morr. Trans. 419; *Bantz v. Frantz*, 4 Morr. Trans. 341; *Matthews v. Machine Co.* Id. 347; *Johnson v. Railroad Co.* Id. 931.

It appears that the inventor held the legal title to his patent for more than five years after it was issued, permitting the use of it by the Secombe Company for a royalty on each wheel. It does not appear that he was not at full liberty to apply for a reissue of it.

In addition to what has been said about the defendants' wheel with the elastic border, it may be said that it extends wholly around the types and does not compass the entire circumference of the wheel, and has the same operation which types in the same place would have, and its face is on the same plane with the faces of the types, and it is a part of the printing surface. In all these respects it differs from what is described in the original specification of Holt.

It follows from these views that the bill must be dismissed, with costs.

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