

of their tobacco with adhesive substances by sweetening them with syrup, and intermixing with the leaves what is known as plug-scrap, which is highly charged with adhesive material. Their product, upon examination, is found to contain a greater quantity of adhesive material than the complainant's product as usually prepared according to the process of the patent. Whether the defendants have thus attempted a colorable evasion of the patented process, or whether in good faith they have believed themselves justified in adopting their substituted treatment, is not material. They have used an equivalent for the gum arabic of sufficient adhesive properties to impart the flaky characteristic to the product when dried. This is infringement.

The usual decree for an injunction and accounting is ordered.

BURDELL v. COMSTOCK.*

(Circuit Court, S. D. Ohio, W. D. March 5, 1883.)

1. DAMAGES FOR INFRINGEMENT OF PATENT—WHEN EQUITY HAS JURISDICTION.

The proper forum in which to sue for damages arising from infringement of a patent is a court of law, but chancery courts may take cognizance of such cases if they involve some element of equitable jurisdiction; and when such courts have once rightfully obtained jurisdiction they may proceed and decree full relief.

2. SAME—SUIT BROUGHT JUST BEFORE EXPIRATION OF PATENT—FRAUD ON EQUITY JURISDICTION.

Where, though a bill in equity, alleging infringement of a patent and praying for an injunction and an account, was filed only five days before the expiration of the patent and no effort was made to obtain an injunction, *held* that the prayer for an injunction was a mere pretext, and that the court never acquired jurisdiction of the case.

Gottfried v. Moerlein, 14 FED. REP. 170, distinguished.

3. DEFECT OF JURISDICTION—WHEN AVAILABLE.

A plain defect of jurisdiction may be insisted upon at the hearing.

In Equity.

Hoadly, Johnson & Colston, for complainant.

Perry & Jenney, for respondent.

BAXTER, J. The proper forum in which to sue for damages arising from an infringement of a patent is a court of law. *Root v. Railway Co.* 105 U. S. 189. But chancery courts may take cognizance of such cases if they involve some element of equitable jurisdiction.

*Reported by J. C. Harper, Esq., of the Cincinnati bar.

Owners of patents are entitled, as well to protection against future invasions of their rights, as to compensation for past injuries. Hence, parties desiring such relief must, from the necessities of their cases, invoke the aid of courts authorized to issue injunctions, and when jurisdiction is once rightfully obtained, the court may proceed and decree full relief. This principle was applied in the case of *Gottfried v. Moerlein*, 14 FED. REP. 170. The bill in that case was filed 16 months before the expiration of the patent sued on. Therein the complainant prayed for an injunction and an account. The prayer for an injunction, based on a statement of facts *prima facie* entitling the complainant to that relief, gave equitable jurisdiction. The defendant acquiesced in this view of the case. He took no exception to the jurisdiction, but answered and proceeded to take proof and prepare the case for trial. The patent expired in May, 1881, and the case was heard in November, 1882. Most of the evidence was taken after the patent had expired. When the case was called for hearing, the defendant moved to dismiss it for the want of jurisdiction. But the court thought that the jurisdiction acquired in the beginning was not ousted by the subsequent expiration of the patent, and disallowed the motion. I am satisfied with the decision and adhere to it. But this is a very different case. The bill herein was filed in November, 1864, just five days before the expiration of the patent sued on. It also prayed for an injunction and an account. But it is manifest that the prayer for an injunction was a mere pretext—"a device to transfer a plain jurisdiction to award damages from a court to which it properly belongs, to this court." *Betts v. Gallais*, L. R. 10 Eq. 392. The injunction prayed for was neither expected nor desired. No court would, under the facts stated, have granted it. If issued, it could only have operated for the few days intervening between the filing of the bill and the expiration of the patent. We have no hesitation in declaring that, upon these facts, this court *never had jurisdiction of the case*. The defendant, taking this view of the law, promptly demurred, alleging a want of jurisdiction. His demurrer was overruled. But this decision is not conclusive of the question. Objections to the jurisdiction are usually taken in the first instance, but a plain defect of jurisdiction may be insisted upon at the hearing. *Thompson v. Railroad Co.* 6 Wall. 137. Our opinion is that this court is without jurisdiction, and complainant's bill will, therefore, be dismissed, with costs.

BURDELL v. DENIG and others.*

(Circuit Court, S. D. Ohio, W. D. March 5, 1883.)

1. REPLICATION—NEW CAUSE OF ACTION

A replication cannot go behind the case made by the declaration and add another and different cause of action.

2. PATENTS—ACTION FOR DAMAGES FOR INFRINGEMENT—INSUFFICIENT REPLICATION TO PLEA OF AN ACCORD AND SATISFACTION.

In an action for damages for infringement of a patent, plaintiffs averred the construction and use by defendants of certain infringing machines from January 23, 1861, when plaintiffs acquired their joint title to the patent, until the commencement of the action, October 6, 1861. Defendants pleaded an accord and satisfaction with an authorized agent of plaintiffs, to which plaintiffs replied that on March 13, 1860, (nearly a year before plaintiffs acquired their joint title to the patent,) the defendants purchased the infringing machines from persons unknown to and with whom plaintiffs had no connection, and that defendants thereafter used said machines as alleged in the declaration. On demurrer such replication held to be bad.

Hoadly, Johnson & Colston and Pugh & Pugh, for complainants.

Perry & Jenney, for defendants.

BAXTER, J. This suit was commenced on the seventh of October, 1861. At a trial thereof had several years since, plaintiffs recovered a judgment for \$125. This judgment was reversed by the supreme court and the cause remanded to this court for a retrial. Upon its return the parties began to plead *de novo*. The case, as made by plaintiffs' amended declaration, is a claim for damages alleged to have been sustained by the plaintiffs by reason of an infringement of a patent, described in the pleadings, in consequence, as is averred, of the construction and use of seven sewing-machines, by defendants, from the twenty-third of January, 1861,—the date at which the plaintiffs acquired their first title to the invention alleged to have been infringed,—until the commencement of this suit in the following October,—a period of 8 months and 14 days. If the plaintiffs recover and obtain a fair assessment of damages, they would probably not recover enough to pay more than 10 per cent. of their attorney's fees for services in the prosecution of the suit. Nevertheless, they are American citizens, and have a constitutional right to litigate, if they want to, and, judging from the record, there is no just ground to doubt their desire to be heard.

Plaintiffs' amended declaration was filed January 7, 1881. The defendants pleaded thereto two special pleas, averring in substance

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