

15 How. 62. But a patent for a process or a product is a different thing from a patent for a principle, as explained by Mr. Justice BRADLEY in *Tilghman v. Proctor*, *ubi supra*, in commenting on *O'Reilly v. Morse*. A manufacture or product, if new, may be claimed irrespective of the mode of making it.

In *Cohn v. U. S. Corset Co.* 93 U. S. 366, a patent for a corset having certain features, and which did not describe any process of making it, was defeated by a prior description of the corset. In the present case the patent describes the product, and the mode of making it, and claims it. The text of the specification sets forth as one of the inventions deposits of nickel having certain characteristics, which are defined, and it states that they were never produced before.

There must be a decree for the plaintiff as to claims 1 and 4, for an account and an injunction, as prayed in the bill, with costs.

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DUNBAR and others v. WHITE and others.\*

(Circuit Court, E. D. Louisiana. March, 1882.)

1. PATENT LAW—REISSUED PATENTS.

A reissued patent which enlarges an original patent, *i. e.*, which makes the invention patented other and more inclusive than the original letters patent, is void as against intervening rights and the public as well.

2. SAME.

The object of the law on the subject of patents is to advance the interests of the public by securing certain exclusive rights to patentees, and among these rights is that of changing, by a surrender and reissue, the language, where the idea remains the same.

*Albert H. Leonard* and *J. W. Gurley*, for complainants.

*Joseph P. Hornor* and *Francis W. Baker*, for defendants.

BILLINGS, J. The case has been heard, and is submitted for a final decree upon bill, answer, exhibits, and depositions. The bill is to protect the rights of a patentee, and is for an injunction and account. Upon the hearing for a preliminary injunction, I directed that defendants should be required to keep an account of all their transactions which should be had, which could be included within the rights granted to complainants. This decree in effect maintained the validity of the complainants' claim.

\* Reversed. See 7 Sup. Ct. Rep. 72.

Reported by Joseph P. Hornor, Esq., of the New Orleans bar.

The sole question in the case is this: In a case where the plaintiff's right to recover against the defendant would have been perfect under an original patent, can a surrender and a reissue invalidate that right? Complainants' original patent was granted June 20, 1876. Defendants' patent was issued April 6, 1880. Complainants' reissued patent bears date December 6, 1881. The legal propositions which affect this case were, as it seemed to me at the prior hearing, and as it seems to me after the present hearing, the following:

1. A reissued patent which enlarges an original patent, *i. e.*, which makes the invention patented other and more inclusive than the original letters patent, is void as against intervening rights and the public as well.

2. Where a patentee in his original claim and specifications describes his invention in part by specifying a material to be used, but declares that the sole utility or availability of that material in connection with his device is that it has two properties; and in his reissued patent, in his claim and specifications, in the description of his invention, substitutes for his former specification of a material to be used as a part of his device, a description of materials which may be used by specifying only those which have the two properties in which he had formerly declared the utility or availability of the material which he then named consisted, there is no enlargement of the thing patented, and the reissued patent is, therefore, valid.

3. Where, as in this case, the original claim and specifications were for a textile fabric as an envelope for the shrimp, in connection with other things, and it was declared that the sole object of its use was to prevent contact (that is, to secure separation) without discoloration; and in the reissued patent, in the claim and specifications, it is declared that any enveloping material may be used which will separate and not discolor,—the change is only that of substituting the description of a thing by naming it, with the addition of its essential quality,—the description of the thing by naming its qualities.

4. The object of the law on the subject of patents is to advance the interests of the public by securing certain exclusive rights to patentees, and among these rights is that of changing, by a surrender and reissue, the language where the idea remains the same.

5. Let there be an account taken before the master of the sales of the defendants in violation of complainants' patent, and a report thereon, and let the injunction be made perpetual during the continuance of complainants' patent.

## REAY, Ex'r, etc., v. RAU.

(Circuit Court, S. D. New York. March 14, 1883.)

## PATENTS FOR INVENTIONS—INFRINGEMENT—EVIDENCE OF.

Where defendant was called by plaintiff in rebuttal of his own testimony, and it was insisted that defendant, by one answer in regard to a date, established an infringement which had not been the subject of previous testimony, and that this answer was to overthrow his uniform denial of the infringement, and of the infringing device having been made during the life of the patent, without the knowledge and permission of the patentee, *held*, that such testimony is not sufficient to make out a case of infringement.

*Arthur v. Bricsen*, for plaintiff.

*Edward Fitch*, for defendant.

SHIPMAN, J. This is a bill in equity praying for an injunction and an account, and is founded upon the alleged infringement by the defendant of reissued letters patent No. 2,529, dated March 26, 1867, and of original letters patent No. 41,395, dated January 26, 1864; each of said patents being for improvements in envelope machines, and each having been issued to George H. Reay, the plaintiff's testator, as inventor. The original of the reissued letters patent was issued August 25, 1863. The bill was filed October 11, 1880, after the expiration of No. 2,529, and shortly prior to the expiration of No. 41,395. The bill does not allege that the defendant has for sale, or was using or was intending to use or to sell, any infringing machines which were made during the term of the patent No. 2,529, in infringement of it. If such an allegation had been made, it would have been untrue. When the bill was filed, the defendant, who is a manufacturer of this class of iron work, had no patented machines on hand. When the patent expired he had one machine in stock, which he had made in accordance with the understanding, and the usual course of business between the patentee and himself, that he should keep machines in stock, so that orders might be promptly filled.

The facts of this case do not bring it within the decision of Judge WHEELER in *Diamond Rock Boring Co. v. Sheldon*, 1 FED. REP. 870, but are within his decision in *Diamond Rock Boring Co. v. Rutland Marble Co.* 2 FED. REP. 355. There are in this branch of the case no allegations upon which to base a prayer for an injunction against the defendant's use or sale of machines. There is, therefore, no occasion to inquire whether the first-named decision is inconsistent with the subsequent opinion of the supreme court in *Root v. Ry. Co.* 105 U. S. 189.