

tent myself with simply announcing my conclusion that neither of these defenses is well taken.

The third claim of letters patent No. 198,432 is as follows:

(3) "In a coal and ore separator the hinged gate-board, *b*, with its regulating arms, *cc*, in combination with the chute, *J*, as described, and for the purpose set forth."

The claim relates to means for regulating the proper supply of material to the sieve. The only defense here insisted on is a want of novelty, and, to sustain it, reliance is placed altogether on a previous patent to George Lander, which shows in a coal-washing machine a sliding gate. But Lander's patent exhibits nothing which performs the function, or anything like thereunto, of the plaintiff's regulating arms, *cc*. Furthermore, it appears from the evidence that the plaintiff's device is less complicated, and lets the material out more readily than Lander's. Upon the whole, I am not satisfied that the defendants have successfully made out this defense.

Finally, the defendants contend that this suit cannot be maintained under the provisions of section 4922, Rev. St., for want of a disclaimer by the plaintiff of certain claims, (other than those already discussed,) embracing things, it is alleged, of which he was not the original and first inventor. But no proof has been taken to show that the claims referred to are bad for the reason suggested, or for any reason, and the case is not in a condition for an adjudication in respect to those claims. The only infringement complained of is of the four claims considered in this opinion, and to them alone was the evidence directed. Moreover, it is settled that a disclaimer need not be filed until the court has passed upon the contested claims. *O'Reilly v. Morse*, 15 How. 62; *Seymour v. McCormick*, 19 How. 96.

Let a decree be drawn in favor of the plaintiff.

EVEREST v. BUFFALO LUBRICATING OIL Co., (Limited.

(Circuit Court, N. D. New York. July 16, 1884.)

1. PATENT—PROCESS.

The process of determining the grade of lubricating oils by a fire-test.

2. SAME—PRIOR USE—APPARATUS.

Previous patent for an apparatus to test coal oils cannot be regarded as an anticipation of the patent in suit.

3. SAME—EVIDENCE REQUIRED.

Proof of prior use must not be vague and indefinite. It is necessary that it be of that high character that convinces the court beyond a reasonable doubt.

In Equity.

George B. Selden and *T. Outerbridge*, for complainant.

James A. Allen and *Corlett & Hatch*, for defendant.

COXE, J. The complainant is the inventor of an "improvement in the process of determining the grade of lubricating oils." Letters patent were issued to him, dated March 7, 1876, numbered 174,506. The application was filed January 6, 1876. The complainant is also the owner of a patent for "improvements in the distillation of oils," but the consideration of this patent was on the argument withdrawn from the attention of the court.

The invention in question consists in applying a fire-test to samples of lubricating oil taken from the still during the process of manufacture, and determining the grade of reduced oil by such test.

The claim is in these words:

"The process of determining the grade of lubricating oils, which consists in applying the fire-test thereto during their manufacture, substantially as set forth."

The defenses interposed are: *First*, want of invention; *second*, prior use; *third*, description in prior letters patent; *fourth*, non-infringement.

Although the specification is awkwardly drawn, there are, it is thought, no fatal discrepancies between the claim and the other statements regarding the invention. Construing the claim to refer only to the process of determining the grade of lubricating oils by applying the fire-test during their manufacture, the conclusion is reached, not however without some hesitation, that the patentee has made an advance which rises to the dignity of invention, not invention of a high grade, certainly, but still sufficient to sustain the patent.

The evidence of prior use is vague and indefinite. It is not of that high character which convinces the court beyond a reasonable doubt. Proof which does this is always necessary.

It is argued that the patented process is described and claimed in letters patent issued to Smith and Jones, No. 35,184, May 6, 1862, for "an apparatus for testing coal oils." This patent cannot be regarded as an anticipation. It is for a method, and an apparatus which is minutely described in the specification and drawings. It is not simply a process patent. Complainant does not attempt to secure any particular mechanism. He expressly states that a chemist's sand bath with a porcelain cup heated by a Bunsen burner or a plain iron dish placed over a charcoal fire in a tinker's pot may be used. It is clear that he wishes to disclaim the use of particular apparatuses and to include them all. Although Smith and Jones use a wick and tube, it is not disputed that their invention could be successfully adopted by complainant. Indeed, if the view here taken is correct, he might have added the Smith and Jones apparatus to the others described by him in the specification. It cannot be said that the Smith and Jones patent, or any of the state statutes referred to, describes the process of fixing the grade of lubricating petroleum

oil by a fire-test while in the process of manufacture. Infringement by the defendant is sufficiently proved.

There should be a decree for the complainant, but, as he has been defeated as to one of the patents declared on, it should be without costs.

VACUUM OIL Co. v. BUFFALO LUBRICATING OIL Co., (Limited.)

(Circuit Court, N. D. New York. July 16, 1884.)

PATENT PROCESS FOR OIL—REISSUE—UNLAWFUL CLAIM.

The claim of the reissue of a patent for making an oil product by the use of steam, in vacuo, cannot be unlawfully broadened so as to include the oil product, no matter by what process produced.

In Equity.

George B. Selden and T. Outerbridge, for complainant.

James A. Allen and Corlett & Hatch, for defendant.

COXE, J. This is an equity action founded upon reissued letters patent No. 7,321, granted to the complainant, as assignee, on the twenty-sixth of September, 1876. The application was filed January 29, 1876. The original patent, No. 58,020, was issued to M. P. Ewing, September 11, 1866.

Of the various defenses interposed but one will be examined, viz., that the reissue is void for the reason that the claim is improperly expanded. The claims are as follows:

ORIGINAL.

As a new manufacture, an oil-product, as above described, when produced from crude petroleum by the evaporation therefrom of the lighter hydrocarbons in vacuo by the use of steam or its equivalent, to prevent burning, substantially as herein set forth.

REISSUE.

An unburned, residual, heavy hydrocarbon-oil, substantially as described.

It will be observed that in the reissue the product alone is claimed, all reference to the manner in which it is produced is omitted. The original limited the invention to a heavy residual oil produced from crude petroleum by the evaporation therefrom of the lighter hydrocarbons in vacuo by the use of steam or its equivalent. The attempt in the reissue is to claim the oil product, no matter by what process produced; to sweep into complainant's net every new method of producing the desired result, and every improvement upon the old method, which had been discovered during an interval of nearly 10 years, or which may be discovered in the future. It is suggested that the claim should be read in connection with the description, and if so read the precise manner of manufacture described in the original