UNDERWOOD v. WARREN and another.[1]

(*Circuit Court, E. D. Missouri.* September 17, 1884.)

PATENTS—ESTOPPEL.

A patentee is estopped, as against an assignee, to claim, in a suit for an infringement, that the patent assigned is invalid.

In Equity. Exceptions to parts of answer.

This is a suit for the infringement of a patent on an improvement on railroad-track drills, invented by the complainant. The bill alleges, in substance, that the patent claimed to have been infringed was issued to the complainant, and Andrew Warren and Perrin G. March, the defendants, while they were doing business together as partners; that their partnership was subsequently dissolved, and that upon its dissolution Warren and March assigned their interests in said patent to complainant for a valuable consideration, and that he then became, and still remains, its sole owner, and that since said assignments were made to complainant the defendants have manufactured and sold infringing machines, and still continue to do so.

The answer alleges, in substance, that complainant's patent is invalid. To this the complainant excepts, and raises the point that the defendants are estopped to deny the validitv of said patent.

G. M. Stewart, for complainant.

Parkinson & Parkinson, for defendants.

TREAT, J. The bill alleges that the Underwood patent was issued to Underwood, Warren, and March, each one-third interest. It also avers sundry transactions between the respective parties, whereby said Warren and March conveyed all their interest therein to plaintiff for full consideration. This court, at its last term, examined at length all of the points substantially involved,[2] and held that the respective parties defendant were estopped from disputing the validity of plaintiff's right.

The exceptions, without resort to verbal criticism, are directed to the question of estoppel, and, under the allegations of the bill and answer with respect thereto, the ruling of this court, in the light of authorities there cited, must prevail, and the exceptions be sustained.

[1] Reported by Benj. F. Rex, Esq., of the St. Louis bar.

[2] See *Rumsey* v. *Buck*, 20 FED. REP. 697.

McLaughlin *v.* People's Railway Co. and another.[1]

(*Circuit Court, E. D. Missouri.* September 19, 1884.)

PATENT—SUIT FOR INFRINGEMENT—LACHES—DEMURRER.

Bill for infringement of patent, alleging unauthorized construction and use of patented invention by defendant for 13 years, and making no excuse for complainant's failure to assert his rights during that period, *held* demurrable.

In Equity. Demurrer to bill for infringement of a patent.

Jones & Delano, with *F. X. McCabe*, for complainant.

Paul Bakewell, for People's Railway Company.

BREWER, J. The bill charges that letters patent for a street-car gate were issued to the complainant and one J. F. Madison on August 3, 1869; that neither of said patentees ever licensed or granted to defendant the People's Railway Company, or any one else, the right or privilege to make or use said gate, and that said defendant railway company is now, and has been for 13 years last past, using and constructing such patented street-car gates upon its street cars. The prayer is for injunction and accounting. The single question which I deem necessary to consider is whether there has been such laches on the part of complainant as will prevent a court of equity from taking cognizance of this suit. The bill shows no excuse for his delay; neither ignorance of the conduct of the defendant, nor inability on the complainant's part to assert his rights. It is left upon the naked assertion that the patent, existing for now over 15 years, the defendant has for 13 years been infringing thereon.

Under these circumstances, whatever action at law he may have for damages, I think his own laches such as prevents a court of equity from interfering by injunction. That the general principles of equity jurisprudence control in patent cases cannot be doubted. Rev. St. § 629, par. 9; also, section 4921, which last section contains these words:

"The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions *according to the course and principles of courts of equity*, to prevent the violation of any rights secured by a patent, upon such terms as the court may deem reasonable."

Now, generally speaking, the laches of complainant is sufficient ground for non-interference on the part of a court of equity. Nearly all the life-time of this patent the complainant has remained silent, by his silence consenting to, or at least acquiescing in, the acts of the defendant. To interfere now by injunction would seem manifestly inequitable. That this question of laches can be raised by demurrer, and that it is a good defense to a bill in equity, is abundantly sustained by the authorities. In Walk. Pat. § 597, it is said:

"The defense of laches can be made in a demurrer, or in an answer, or in an argument on the hearing, without any pleading to support it. But a

[1] Reported by Benj. F. Rex, Esq., of the St. Louis bar.