

In Equity.

Wood & Boyd, for complainants.

Stem & Peck and *L. Hill*, for defendants.

Before MATTHEWS, Justice, and SAGE, J.

SAGE, J. Letters patent No. 250,934, for an improvement in roller-mills for crushing or grinding grain, middlings, and other material, were issued December 13, 1881, and reissued (No. 10,139) June 22, 1882, to the complainant Odell, who, (with the Stillwell & Bierce Manufacturing Company, his licensees,) sues for infringement. The object of the invention is stated in the specification to be to adjust the outer crushing or grinding rolls to or from the inner ones, and simultaneously to open or close the spouts or channels which control the discharge of grain from the hopper to the feed rolls.

The first claim in the reissued letters patent is as follows:

"In a roller-mill, the combination of the hopper-gate mechanism on both sides of the machine with a through shaft, lever mechanism connecting the parts to operate the gates simultaneously, and a single hand-lever, substantially as and for the purpose described."

The drawings show a double mill. The hopper is divided by a partition. Under each side of the hopper is a set of rolls to which the grain is delivered by means of a feed-spout. Gates or slides, moving vertically inside the hopper, open and close the aperture leading to the feed-spouts. These gates are connected by rods with a through shaft, J, located above the center of the space between the two sets of rolls, and parallel with them, and connected also with a single hand-lever, K. By the movement of this lever to or from the operator the gates are closed and opened.

Claim 2 is as follows:

"In a roller-mill, the combination with the adjustable rolls and journals of transverse shaft, *h*, through shaft, J, link mechanism connecting said shafts, and a single hand-lever, K, connected with the through shaft, for simultaneously adjusting both sets of rolls by a single-lever movement, substantially as described."

The outer grinding rolls are journaled in vibrating arms, so connected on each side of the mill, by transverse horizontal shafts, with the hand-lever, K, that by the movement of that lever the rolls are thrown apart, (or spread,) or brought into contact, (or set,) simultaneously with the opening or closing of the hopper gates. The transverse shafts are provided with coiled springs, which form a yielding bearing for the outer rolls, so that they may give from their grinding position and permit the passage of any hard foreign substance which would otherwise injure the rolls.

Claim 3 is not involved.

Claim 4 is as follows:

"In a roller-mill the combination, with the adjustable crushing rolls and the gates or slides which control the passage of grain from the hopper, of a single through shaft, J, a single hand-lever, K, and mechanism connecting the crushing rolls and the gates or slides with the through shaft and hand-

lever, substantially as described, whereby a single movement of the lever simultaneously adjusts the rolls and the gates or slides, as set forth."

The fifth and sixth claims do not differ from the fourth, excepting in form of statement.

The defenses relied upon will be considered in the order convenient for the purposes of this decision. It is argued that the reissued letters are invalid for the reason that the original letters were neither invalid nor inoperative, nor is the specification of the original letters defective. It is admitted that the specification of the reissue does not differ substantially from that of the original, nor do the claims, excepting that the first and second claims of the reissue do not appear in the original, and they are introduced in the reissue, as defendants contend, for no other purpose than to enlarge the patent. The invention, it is said, was set forth in the original patent "as being for the combination, substantially, of two sets of mechanism,—one for controlling the gates, and the other for controlling the rolls,—both sets to be operated simultaneously." From the language of the original patent relating to this part of the mechanism, counsel for defendants quote:

"My invention relates to means for simultaneously adjusting one set of the crushing or grinding rolls to or from the other, and by the same movement to open or close the spouts or channels which admit the grain from the hopper to the feed-rolls. This feature of my invention consists in the combination of a through shaft, pivoted cranks, links, racks, and pinions,—all of which will be more fully explained in the description of the accompanying drawings."

Here, they say, "is a clear statement that the invention consists, not of gate-controlling mechanism alone, nor of roll-controlling mechanism alone, but of a through shaft connected with the gate-controlling mechanism and the roll-controlling mechanism so as to operate both simultaneously by the same movement." It is urged, therefore, that there could have been no inadvertence, accident, or mistake in setting forth this feature of the invention in the original patent, and that the original claim covers fully what is set forth. The granting of a reissue is *prima facie* evidence of inadvertence, accident, or mistake, as the granting of original letters is *prima facie* evidence of invention. This evidence may be overcome. It is not conclusive. The action of the commissioner of patents is not *res adjudicata*. *Cook v. Ernst*, 2 O. G. 89. He is not an officer in whom, under the constitution, judicial power can be vested. *Grant v. Raymond*, 6 Pet. 242. If he were, the proceedings for procuring original letters and reissues are *ex parte*, and would not estop defendants, charged as infringers, upon questions affecting the validity of the patent. But the statutes, prescribing his powers and duties, vest in the commissioner of patents a discretion which in some matters is final, and in others subject to review. The authorities are not uniform; but the later cases, and some of not so recent date, are in harmony with the ruling

made by Chief Justice MARSHALL in *Grant v. Raymond*, that the correct performance of all those preliminaries on which the validity of an original patent or of a reissued patent depends, is always examinable in the court in which a suit for its violation is brought. *Burr v. Duryee*, 1 Wall. 571; *Rubber Co. v. Goodyear*, 9 Wall. 795; *Miller v. Brass Co.* 104 U. S. 350; *James v. Campbell*, Id. 371; *Clements v. Odorless Excav. App. Co.* 109 U. S. 649; S. C. 3 Sup. Ct. Rep. 525; *Turner & S. Manuf'g Co. v. Dover Stamping Co.* 111 U. S. 326; S. C. 4 Sup. Ct. Rep. 401.

The complainant Odell testifies that when he first saw the original claims in the Patent-office Gazette, and before he received the patent, he was dissatisfied with them, and took immediate steps to procure a reissue. There is no other testimony on that subject. The language of the original patent does not exclude the possibility of inadvertent or accidental omission of claims. It is true that the claims in the original patent cover fully the construction described in the specification; but it does not follow that Odell might not, if he was the inventor, have claimed separately each of the patentable parts entering into the combination. Suppose he had first invented and patented the hopper-gate mechanism, and subsequently the roll-controlling mechanism, could he not then have patented that, and also taken out a patent for the combination of the two, although so connected to the through shaft that they must necessarily be operated simultaneously? In the combination covered by the claims in the original patent, there are, as was conceded on the hearing, two sets of mechanism, the one controlling the gates, the other the rolls. Either can be disconnected from the through shaft and the other operated singly. The patentee, it is said, does not wish to so operate them, and can not so operate them as they are combined in the patented improvement. True, but it frequently occurs that an inventor fails to perceive all or even the best uses to which his invention may be applied. Nevertheless, he is entitled to the benefit of all the uses to which it can be applied, no matter whether he or another conceived them. *Roberts v. Ryer*, 91 U. S. 157. In this case the defendants introduced evidence tending to prove that it is an advantage at times to control the rolls and the hopper-gate separately. That is a mere matter of opinion, which does not affect complainants' rights. The inventor is entitled also to a patent for his entire invention. He can not, as Mr. Justice BRADLEY says in *James v. Campbell*, 104 U. S. 378, "take a reissue for anything but the same invention described and claimed in the original patent." It is to be kept in mind, however, that enlarging the claim may be an entirely different thing from broadening the invention. He may, under proper circumstances, so enlarge his claim as to make it extend to the limits of his invention, but he is bound by those limits. He may not enlarge the invention.

If the inventor could not claim singly the parts of a combination capable of separate use, because he uses them in combination, or, to

state the proposition as counsel for defendants put it, because he does not desire the operation of any apart from the others, the result would be that each constituent of the combination would be free to the public. The mechanism for controlling the gates might be of great value operated separately, and the same might be true of the mechanism for controlling the rolls; but if the inventor is limited to a claim for the combination simply because, in his opinion, it adds to the value of each, and is an improvement to operate them simultaneously, it follows that he is compelled to abandon to the public a large part of the value of his invention. Such a construction is too narrow. We prefer the doctrine stated by Judge WOODRUFF in *Wheeler v. Reaper Co.* 10 Blatchf. 181, that he knew no rule "which forbids the inventor who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender and taking reissues for the distinct combination or separate devices." "If the devices covered by the reissues were in fact new and useful, and if they are shown in the original specification, drawings, or model, then the patentee is entitled to secure the exclusive use of each separately, by a reissue embracing each."

Miller v. Brass Co. 104 U. S. 350, and *James v. Campbell*, Id. 370, do not sustain the proposition made on behalf of the defendants that a reissued patent is void if the claims of the original patent are expanded. These cases, and others of later date, distinctly recognize that the claims of an original patent may be enlarged, by reissued letters, to include the entire invention, or, in separate claims, the distinct patentable features of the invention; provided—*First*, that there be no unreasonable delay in applying for the reissue; and, *second*, that between the date of the original patent and the date of the application for the reissue, rights which would be recognized in equity in favor of others shall not have intervened. The supreme court calls attention to the rule "that the claim for a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are in law a dedication to the public of that which is not claimed." The court says that this legal effect of the patent can not be revoked except by surrender and reissue on proof of inadvertence, accident, or mistake in framing the original specification or claim, without fraudulent or deceptive intention on the part of the patentee, and without laches or unnecessary delay. There is a suggestion in *Miller v. Brass Co.* of two years as the limit to the delay permissible, with a reference, by way of analogy, to the evidence of abandonment afforded by the inventor's consent to the public use of his invention for that length of time before his application for a patent; but there is no rule fixing a precise limit of time. The rule relating to abandonment is statutory, and therefore rigid, and to be applied according to its letter. The rule relating to reissues is equitable, and therefore flexible, and to be applied according to equity. What is a reasonable time is a question, when a reissue is attacked,

to be decided by the court upon the case presented; and, as we understand it, the supreme court has purposely avoided prescribing any rule which would interfere with the decision of each case upon the equities arising upon the facts of that case.

We do not think that it is apparent in this case, as it was in *Miller v. Brass Co.* and in *James v. Campbell*, that there was no inadvertence, accident, or mistake in the framing of the specification and claims of the original patent. On the contrary, precisely such an inadvertent omission as it is claimed by the complainants was supplied by the introduction of the first and second claims of the reissue, might be made by an inventor in whose mind the combination was the thing of greatest value. Moreover, in this case, the delay was but a little more than four months, and there is no averment in the answer, nor is there any evidence, that between the date of the original and that of the reissue any rights of others intervened. In the late case of *Wooster v. Handy*, 21 FED. REP. 51, decided by Mr. Justice BLATCHFORD, July 22, 1884, he says:

"The rule laid down by the supreme court is that where it is sought merely to enlarge a claim there must be a clear mistake and inadvertence, and a speedy application for the correction, with no unreasonable delay; that in such a case a patentee cannot wait until other inventors have produced new forms of improvement and then apply for such an enlargement of his claim as to make it embrace those new forms; and that when it is apparent from a comparison of the two patents that the reissue is made to enlarge the scope of the patent, the court may decide whether the delay was unreasonable, and the reissue therefore void. This view has been repeatedly asserted and applied by the supreme court in numerous cases decided since those in 104 U. S."

Upon the authority of these cases it is clear that the claim of a patent may be enlarged by a reissue if the patentee move promptly and no rights of others have intervened, and we are of opinion that in this case the delay was not unreasonable. See *Dryfoos v. Wiese*, 26 O. G. 640; S. C. 19 FED. REP. 315.

We come now to the defense of want of novelty; and, first, it is necessary to fix the date of Odell's invention. The application for his original patent was filed July 7, 1881, but he has introduced in evidence drawings made by him in a memorandum book which, he claims, establish that his invention was of earlier date. The first of these drawings was made September 17, 1878, and shows the roll-controlling mechanism, substantially as in his patent; the second, made May 14, 1879, shows a transverse shaft (operated by a hand wheel) with mechanism for controlling the gates or slides within the hopper; the third drawing, made in June, 1879, shows a sectional view of the roll-controlling mechanism, indicating clearly the through shaft, the transverse shaft with coiled spring, the hand-lever, and the connecting parts; the fourth drawing, dated July, 1880, shows a through shaft, with the gate or slide-controlling mechanism, substantially as in the patent. It is settled that "an invention relating to machinery may be exhibited either in a drawing or in a model, so as

to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it." *Loom Co. v. Higgins*, 105 U. S. 594. But this rule is to be taken with proper qualifications. Drawings may carry date of invention back if reasonable diligence is shown. *Kneeland v. Sheriff*, 18 O. G. 242. Making drawings of an idea is not invention, and is of no effect unless followed up. *Draper v. Potemka Mills*, 13 O. G. 276. Merely making drawings is not such an embodiment of invention as will defeat a subsequent patent. *Ellithorp v. Robertson*, 4 Blatchf. 307. The reasons for this qualification of the rule are well stated in section 61, Walker on Patents.

Between the date of the last drawing made by Odell and his application for a patent there was an interval of a year. In the mean time the Daverio American patent, the Poole, the Poole & Miller, and the Gray patents were issued. All these are in evidence for the defendants. The drawings made by Odell cannot be recognized as giving priority to his invention as against those patents, whatever might be their effect upon the decision of the question of want of novelty if those patents had not been issued. So far as the complainants are concerned, the defendants are not precluded by Odell's drawings from using any mechanism covered by any of the patents issued between the dates of the drawings and the date of Odell's application for his original patent. We have nothing to do, in this cause, with the question whether they infringe the rights of other patentees. *Detroit Lubricator Manufg Co. v. Renchard*, 9 FED. REP., is in point. We quote from the opinion of Mr. Justice MATTHEWS, on page 297:

"The defendants exhibit a drawing made by J. V. Renchard, which bears date August 10, 1876, and which, it is testified by him, was made on that day, and by others, that he showed it to them about that time. This antedates Parshall's application, but it fails to supersede his patent, for the reason that it seems well established in evidence that Renchard did not at that time prosecute the matter beyond the mere drawing. The drawing seems to exhibit a perfect machine in all its parts, and sufficiently to show the combination forming the subject of the present controversy, particularly the metallic oil cup, the siphon tube carrying the condensed water into the glass indicator, and the two chambers, condensing and oil, and directly united. Nevertheless, it is clearly proven that the defendant did not, in fact, construct an indicator in this form, and reduce it to actual use, until after it had been successfully accomplished by Parshall, nor until after the date of his patent. This mere drawing cannot, therefore, be allowed to have the effect of depriving Parshall of his title of being the first and original inventor."

The Daverio patent, issued in England, December 23, 1879, (to Simons,) and in this country, December 14, 1880, and the Gray patents, dated December 21, 1880, application filed February 16, 1880, are offered to anticipate the first claim in complainant's patent. In the Daverio patent a through shaft is shown, with mechanism for operating the two hopper gates or slides simultaneously from either side

of the machine. In the Gray patent is shown a through shaft with a lever or handle at each end, and mechanism for simultaneously closing or opening both gates or slides. In each of these patents the shaft is a transverse shaft, but the direction of the shaft is of no consequence in considering the first claim of complainant's reissued patent, which is "the combination of the hopper-gate mechanism on both sides of the machine with a through shaft, lever mechanism connecting the parts to operate the gates simultaneously, and a single hand-lever, substantially as and for the purpose described." The position of the shaft parallel with the rolls is important only when, by combination, the gate or slide-controlling mechanism and the roll-controlling mechanism are to be operated simultaneously by the movement of the hand-lever. But Odell chose to make a separate claim for the mechanism controlling the gates, and as a separate claim it must be construed independently of the claims for the combination of the gate-controlling and of the roll-controlling mechanism. Our conclusion is that the first claim of the reissue is invalid for want of novelty.

In anticipation of the second claim the defendants set up the Poole patent, No. 238,000, dated February 22, 1881; the Poole & Miller patent, No. 238,001, dated February 22, 1881; and the Gray patents, No. 235,761, dated December 21, 1880, and No. 238,677, dated March 8, 1881.

The Mechwart patent, dated December 20, 1881, application filed April 22, 1880, more than a year prior to Odell's original patent, has the outer rolls journaled upon movable arms, or levers, as they are termed in the specification, connected to weights, which, by gravity, keep the rolls together. These weights are raised, and the outer rolls released from contact with the inner, by a hand-lever operating upon them by means of a through shaft, and cranks, and chains at each side of the machine. The mill is provided with a separate device for shutting off the supply of grain from the hopper. Whether the mechanism in this mill for controlling the rolls anticipates Odell's second claim in his reissued letters depends upon whether the weights and connecting parts are the equivalent of the transverse shafts and the coiled springs of the Odell mill. It is in testimony, and such we find to be the fact, that the coiled springs form a yielding bearing for the outer rolls, permitting them to give and allow the passage of obstructions caught between the rolls. This is a great advantage, and one of the most valuable features of the roll-controlling mechanism of the Odell mill. The shaft is so constructed that the spring is not acted upon when the shaft, and by it and its connections the outer rolls, are moved by the hand-lever. When the rolls are set, the shaft holds them rigidly in position against everything but a hard, foreign substance passing between them. Then, and then only, the coiled spring is brought into play, and the outer roll recedes against the constantly increasing pressure of the spring, and suffers the obstruction to pass. The spring then instantly forces the outer roll back

into grinding position. The weights and connected mechanism of the Mechwart mill do not form a yielding bearing. In the specification of the Mechwart patent it is stated that "in case of any obstruction getting into the mill the pressure is thrown off instantly by turning the handle, *m*, [corresponding to the hand-lever in the Odell mill,] and revolving shaft, *o*, [a through shaft parallel with the rolls,] and its cranks at each side of the machine to raise the weights, *h*, by the chains, *t*, that connect the weights and cranks." The inventor—and we must presume that he knew his own mill—did not understand that the weights formed a yielding bearing, acting automatically, as do the coiled springs, but did understand that the weights must be raised by the operator. Even if the weights and connected mechanism form a yielding bearing, their action must be sluggish and uncertain compared with that of the coiled springs. The difference is that between a dead weight and an elastic force, in a place where the elastic force is essential. The Mechwart mill, therefore, does not anticipate the second claim of the complainant's reissued patent.

Neither the Poole nor the Poole & Miller patent has the yielding bearing. In the Poole patent, when the rolls are set, they are so firmly held in position that something must break before an unyielding foreign substance can pass between the rolls. In the Poole & Miller patent a toggle-joint is used. The inner rolls are movable, being journaled in boxes which slide backward and forward in frames to which they are fitted. When the toggle is straightened (or extended) these rolls are forced into grinding position, and there inflexibly held, until, by movement of a hand-lever, the toggle is thrown into a zig-zag position, and then the rolls are forced apart by coiled springs, which have no other office. The Gray patent, No. 235,761, relates exclusively to mechanism for controlling the hopper gates or slides. These patents do not anticipate claim 2 of complainants' reissue. In the Gray patent, No. 238,677 there are two through shafts, each parallel with the set of rolls over which it is placed, and connected, by eccentrics and transverse shafts, to movable arms, in the upper ends of which the outer rolls are mounted. The transverse shafts are provided with coiled springs, forming yielding bearings, substantially as in complainants' patent. The ends of the through shafts are provided with crank-arms pivoted to a connecting horizontal rod, serving as a hand-lever, by moving which from either side of the machine all the eccentrics are moved simultaneously, and the outer rolls thrown instantly into or out of operative position. All the parts of this combination are old. The claim is limited to the combination of the movable arms, the transverse shafts, the eccentrics, and the horizontal rod, by moving which the rolls are thrown apart or together, and, in our opinion, does not interfere with claim 2 of complainants' reissue, which is limited to a single through shaft and a hand-lever rotating it to operate the four transverse shafts simultaneously, and, by moving the pivoted journal arms, carrying the mov-

able rolls to spread or set the rolls. It follows that the second claim of complainants' reissued patent is sustained.

It was urged upon the hearing that the entire reissued patent must be held to be invalid if claims 1 or 2, or both, were found to be invalid. That does not follow. We are satisfied from the testimony that claim 1, which we hold to be invalid, was made in good faith in the honest belief that Odell was the original inventor of the combination covered by that claim. Where it appears that claims in a reissued patent were made to broaden the invention, and thereby to cover intermediate inventions or improvements, the fraud may so vitiate all the claims in the reissued patent that all will be held to be void. But one claim in a reissue may be void without necessarily invalidating the other claims. *Packing Co. Cases*, 105 U. S. 566; *Gage v. Herring*, 107 U. S. 646; S. C. 2 Sup. Ct. Rep. 819. The invalidity of a claim in a reissued patent does not impair the validity of a claim reproduced from the original patent in the reissued patent. *Schillinger v. Greenway Brewing Co.* 20 O. G. 495; *Letter v. Newhall*, 25 O. G. 502.

The fourth, fifth, and sixth claims of complainants' reissued patent are substantially reproductions of claims in the original patent. The fifth and sixth claims differ only in form from the fourth, and we therefore, and in accordance with a stipulation filed by counsel, consider only the fourth. The defendants rely upon the Wegman patent, April 7, 1883, application filed February 10, 1883, patented in England in 1879, to anticipate the fourth claim. We are of opinion that the English patent does not show in the drawings nor describe in the specification simultaneous operation of the roll-controlling and of the feed-controlling mechanism. The American patent, of date later than complainants' patent, can not be brought in to supply the deficiencies of the English patent. We therefore hold that the Wegman patent does not anticipate the fourth claim of complainants' reissued patent, which is sustained. There is no evidence that prior to Odell's invention the combination of mechanism for simultaneously controlling the gates and the rolls was known or used, and there is no doubt in our minds that it is a valuable and patentable improvement. *Loom Co. v. Higgins*, 105 U. S. 591.

The remaining question is whether the defendants are infringers of the second and fourth claims of the complainants' reissued patent. The defendants' mill—that which they were manufacturing when this suit was brought—is so constructed that, by means of a sleeve on the through shaft and an arm connected to the outside lever, journaled on this shaft, the gates or slides controlling the feed discharge may be moved without moving the rolls; and by moving the inside lever, which is attached to the through shaft, the roll-controlling mechanism is operated. Both levers may be grasped at the same time and moved together, and thus simultaneously adjust the rolls and the gates or slides. This mechanism is substantially al-

most identically, that of the complainants' mill, including the transverse shafts with the coiled springs, forming yielding bearings.

Prior to the bringing of this suit, and up to March, 1883, defendants manufactured another mill shown in the Livingston patent, No. 284,135, in which a single lever served to operate the through shaft and simultaneously move both sets of mechanism. An interference between Livingston, defendants' assignor, and Odell was decided in favor of Odell, March 31, 1883, and since that date the defendants have not manufactured nor sold that mill. The bill in this cause was filed June 6, 1883. If the complaint were only on account of the manufacture and sale of that mill, the case would not be one for injunction. The remedy at law would be complete. It is true, as urged by counsel for complainants, that it has been held that stopping infringement will not prevent an injunction. But the cases have been where the manufacture was stopped at or after the bringing of the suit, or the indications were that the defendants, having once been wrong-doers, were likely to be so again as soon as released from court. If a defendant has, before suit brought, abandoned the manufacture and sale of the infringing machine, and the court is satisfied that the abandonment was in good faith and final, the injunction ought to be refused, upon the principles of equity applicable to injunction. However, as we find that the defendants in this case are infringers, we think it well to retain the whole case under our control, and the injunction and order for an account may be made to apply to the manufacture and sale of both mills.

But the complainants must first file a disclaimer of the first claim of their reissued patent, and this decree must be without costs. See sections 4917, 4922, Rev. St. U. S., and *Gage v. Herring*, 107 U. S. 646; S. C. 2 Sup. Ct. Rep. 819.

Mr. Justice MATTHEWS stated that he concurred in the conclusion and in the reasoning of Judge SAGE's opinion.

McMILLIN and others v. ST. LOUIS & VICKSBURGH ANCHOR LINE.¹

(Circuit Court, E. D. Missouri. November 1, 1884.)

PATENTS—USE OF STEAM TO OPERATE CAPSTANS.

The invention covered by letters patent No. 63,917, granted to John S. McMillin, April 16, 1867, is the use of the freight-hoister or nigger-engine of a vessel, by means of the shafting and gearing described in said patent, to rotate the capstan; and said patent does not extend to the use of an auxiliary engine in the manner described, unless such engine may also be used as a hoisting engine.

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

In Equity.

Paul Bakewell, for complainants.

Given Campbell and Parkinson & Parkinson, for defendant.

TREAT, J. This and six other cases have been submitted to the court on substantially the same question. Anticipations are alleged with respect to the Charles Belden and the Constitution, it being alleged that, in both these steamers, freight-hoisters or nigger-engines had been used to rotate the capstans. The presumption is in favor of the validity of the patent, which presumption must be overcome by clear and positive testimony. Under some conditions of the cases submitted, it might be doubtful whether that repelling testimony was adequate according to the rule stated. The first inquiry exacts the definition of the patent itself. What did it include? Its language is as follows:

"The nature of my invention consists in connecting the capstan with the freight-hoisting engine, or other engines of steam-boats and crafts, by means of shafts and cog-wheels, so as to operate the capstan by steam-power, instead of hand-power, as has been generally used heretofore."

Then follows a description of the mechanical devices whereby said result can be effected, distinctly describing the hoisting engine and connecting shafts by the usual mechanical devices, whereby the said engine might be connected with or disconnected from the described gearing. The claim is in these words:

"Rotating a capstan placed on the deck of a boat by means of an auxiliary engine, when said engine and capstan are placed forward of the steam-boilers of said boat, substantially as hereinbefore described, and for the purposes set forth."

It is obvious that the invention was not to operate the capstan by the motive force of the main engine. Whence, then, was the motive power to be had and how applied? Evidently by utilizing an auxiliary engine so that the same might perform a double function as occasion required. The patent, therefore, should be limited, as intimated by Judge McKENNAN, to the specified combination, to-wit, the use of the freight-hoister or nigger-engine, by the said shafting and gearing described, to rotate the capstan; said engine and capstan being forward of the steam-boilers. That description evidently excludes the idea that the main engine was to be used. It also excludes the idea that a *separate* engine was to be used to operate the capstan. The thought of the inventor, on which his patent was granted, was not that every contrivance whereby to operate by steam the capstan was to be included in the terms of his patent, for, if so, his patent would have been too broad, and void; therefore it must be limited to the special mode of effecting the desired result. That mode is the utilizing of the freight-hoister or nigger-engine, by appropriate shafting and gearing, to rotate the capstan, and thus escape the futile attempt to utilize the main engine, and at the same time have said auxiliary engine effect, as might be required, the double purpose

stated. Of course, it was an essential requirement that the gearing should be so constructed as to be shipped or unshipped as the use of the capstan might be needed or otherwise.

The defendant's engines to operate capstans are not only separate from the main engines, but constructed as independent engines solely for rotating the capstan. The shafting and gearing, whereby the transmission of power is made from said independent engine to the capstans, may be substantially the same as described in plaintiffs' patent. But, whether so or not, there was nothing new in said mechanical devices, and the plaintiffs' demand did not extend beyond using ordinary contrivances to transmit motive force from the freight-hoister or nigger-engine to the capstan. Hence the patent does not exclude the right to use those mechanical devices in another way or under different circumstances.

The conclusion reached is this: That the rotating of capstans with motive force applied from independent engines, even though placed in front of the boiler, does not infringe plaintiff's patent, although the modes of transmitting the power are substantially by the same and well-known mechanical contrivances. Bill dismissed, with costs.

THE EDWIN H. WEBSTER.

(District Court, S. D. New York. October 26, 1884.)

1. COLLISION—PIERS AND SLIPS—LOOKOUT—SIGNALS—CHANGE OF COURSE IN TURNING.

The tug T., with the libelant's boat lashed upon her starboard side, was steaming up the North river after dark, near the slips, to avoid the strong ebb-tide. Farther up river the tug E. H. W., at the foot of Gansevoort street, was at the same time turning about near the end of the pier, by backing and filling, her head swinging southward towards the Jersey shore. As the T. approached, her two colored lights were visible to the E. H. W. The latter exposed her red light, and when first seen was apparently going across the river, but she was swinging downwards, and shortly after showed both lights, and attempted to go inside, crossing the T.'s bows, when a collision ensued. *Held*, that both were in fault,—the T. for navigating in the night-time so near to the piers and slips; the E. H. W. for not keeping a better lookout for vessels approaching her while she was executing her turn in the night-time, and for not giving timely signals of her various changes of course in doing so.

2. SAME—FIFTY-NINTH RULE.

Permission given to bring in the T. under the new fifty-ninth rule in admiralty, the delay being excused.

In Admiralty.

Owen & Gray, for libelants.

Beebe & Wilcox, for claimants.

BROWN, J. Upon the facts of this collision I must hold both the Webster and the Terror in fault. The Terror was in fault for running along up river so near to the ends of the slips for the purpose

of taking advantage of the slack water, instead of being out in the stream where there were no obstructions, and where she ought properly to have been. I have no question that she was less than 250 feet from the ends of the piers. In the night-time this was specially hazardous and unjustifiable. *The Monticello*, 15 FED. REP. 474; *McFarland v. Selby, etc. Co.* 17 FED. REP. 253.

But the Webster cannot be excused. She was backing and filling while turning round with her head towards the Jersey shore. The colored lights of the Terror were visible for a considerable period. There was abundant time for them to have been seen on board the Webster, and for proper signals to have been given by the latter. The Webster, exposing her red light only when the Terror's lights were visible below her, ought to have considered that to stop her apparent course across the river and to turn about, or to suffer herself to be swung round by the tide in front of the Terror's course, was a very hazardous maneuver in the night-time, and one that called for special caution and timely signals on her part. Instead of this, none were given, except so late as to be of no use. And the necessary inference from the testimony on her part, also, is that no attention was paid by her to vessels coming up from below until the Webster's bow was already on a strong swing from the tide, and only a very short time before the collision. The pilot of the Terror, seeing the Webster's red light moving outward from the piers, naturally supposed she was intending to continue that course and to cross the river, but he had no right to rest upon that assumption as certain when so near to the slips. And the Webster, not intending to keep her course, should have signaled in time or else kept out of the way. I must hold her, therefore, wanting in that reasonable care and caution which these maneuvers at night required. The very common practice for tugs to keep in the slack water by the piers, though unjustifiable, prevents her claiming that she had no reason to anticipate that any boat might be coming up within the limits within which she was turning, so as to absolve her from any duty of watchfulness.

The Terror has not been made a party to the action, under a natural mistake of the claimants' counsel that she belonged to the libelants. If the libelants stipulate to accept half the damages, a decree may be entered to that effect, with costs; otherwise, the claimants will have liberty to bring in the Terror under the fifty-ninth rule in admiralty, (*The Hudson*, 15 FED. REP. 162,) and 10 days' stay of proceedings will be allowed for that purpose.

THE E. V. MUNDY, etc.

(Circuit Court, E. D. Michigan. 1884.)

ADMIRALTY JURISDICTION — NON-MARITIME CLAIMS — DISTRIBUTION OF SURPLUS FUNDS.

Where a vessel has been attached and sold under a libel, and there is a surplus fund after payment of the claim in the registry of the court, it has power to distribute such surplus fund to all those who can show a vested interest therein, in the order of their several priorities, no matter how their claims originated.

In Admiralty.

MATHEWS, Justice. This is an appeal in admiralty from a decree of the district court dismissing the libel of the appellants. It appears from the record that on December 24, 1883, the appellants, intervening for their interest under a libel theretofore filed by Knowlton to recover wages as a seaman, filed their libel asserting a lien against the vessel to the amount of \$750, alleged to be due for materials and labor used in its necessary repair while lying at the port of West Bay City. To this libel William H. Miller, the appellee, filed an answer, as claimant under a mortgage executed and delivered by the owner, June 4, 1883, to secure a debt of \$1,400. The vessel, having been attached under process issued upon the original libel of Knowlton, was sold, and the proceeds of sale having been applied to the payment of prior maritime liens, there remains in the registry a balance, which is the subject of this controversy.

The proof in the cause clearly established that the materials and labor advanced by the appellants were used, not in the repair, but in the original construction, of the tug. This variance is now insisted upon as fatal to the appeal. If the objection had been taken in the district court, the libelant would have been entitled to amend, so as to conform his pleadings to his proof, provided the case made upon the evidence entitled him to a decree; and the same rule, in furtherance of substantial justice, should be applied here. It becomes proper in that view to consider the case upon its merits.

It is admitted that there is no maritime lien for materials and labor used in the original construction of the vessel, and also that a lien is given therefor by a statute of Michigan. I think that the appellants are entitled to that statutory lien for the amount of their claim, and that under the laws of Michigan it is entitled to priority over that of the appellee as mortgagee. It is urged, however, that the libel of the appellants was rightly dismissed for want of jurisdiction in the district court, as a court of admiralty, to entertain it. If the appellants had filed a libel for such a cause as an original proceeding, and sought thereby to subject the vessel to the jurisdiction of the admiralty court, it is not denied but that it should have been dismissed for want of jurisdiction, on the ground that the contract

for construction is not maritime in its nature. But the libel was not so filed. On the contrary, it was filed as an intervention in a proceeding previously commenced, under which the district court had rightfully acquired jurisdiction over and possession of the vessel as a court of admiralty. The vessel has been sold; the proceeds have been appropriated to the payment of maritime liens; there is a surplus remaining in the registry; there are before the court two claimants, neither of whom have a claim originally enforceable in admiralty,—one claiming title by virtue of a lien given by the local law, and superior in equity and at law to that of the other, who claims from assignment from the owner by way of mortgage. The jurisdiction of the district court as an admiralty court, in one sense, may be said to be exhausted and at an end, but it is still in possession of a fund arising by the exercise of that jurisdiction. Is not the right and power of disposing of that fund necessarily incident to its jurisdiction as an admiralty court? It must do something with the fund; it is absurd to suppose that it cannot. What else can it do but ascertain to whom among several claimants it belongs, according to principles of equity, and award it accordingly; or, if this presents complications beyond the convenient extent of its powers, then to direct a litigation elsewhere between the parties, securing the fund to whomsoever shall ultimately appear to be entitled? Such was the principle announced and acted on in the case of *The Guiding Star*, 18 FED. REP. 263. A reconsideration of it in this case has not weakened my conviction as to its soundness. This principle is the sole foundation for the forty-third admiralty rule, and is explained and justified in the opinion of the supreme court in the case of *The Lottawanna*, 21 Wall. 558-582. It is there said:

“The court has power to distribute surplus proceeds to all those who can show vested interest therein, in the order of their several priorities, no matter how their claims originated. *Schucharát v. Babbidge*, 19 How. 239. The propriety of such a distribution in the admiralty has been questioned, on the ground that the court would thereby draw to itself equity jurisdiction. *The Neptune*, 3 Knapp, Privy Coun. 111. But it is a wholesome jurisdiction, very commonly exercised by nearly all superior courts, to distribute a fund rightfully in its possession to those who are legally entitled to it; and there is no sound reason why admiralty courts should not do the same. If a case should be so complicated as to require the interposition of a court of equity, the district court could refuse to act, and refer the parties to a more competent tribunal.”

It follows that the decree of the district court dismissing the appellants' libel was erroneous, and must be reversed, with costs. It is accordingly so ordered, and a decree will be rendered in favor of the appellants, appropriating the fund in the registry, so far as may be necessary, to the payment of their claim, and the balance, if any, to the appellees.

THE ACTIVE.

THE OCEAN WAVE.

(District Court, S. D. New York. October 25, 1884.)

COLLISION—TUG AND TOW—RUNNING NEAR TO PIERS BETWEEN OTHER VESSELS.

The tug A., with the barge O. W. in tow on a hawser, came down the East river against the tide about 200 feet from shore, and ran between two schooners, which were about 100 feet apart, the outer schooner being also about 100 feet farther up the river. The barge, after rounding past a projecting pier farther up stream, was obliged to port her helm to clear the upper schooner, and she was afterwards unable to stop her sheer in time to avoid running into the lower schooner. *Held*, upon the facts, that the tug was in fault for navigating so near the piers, and also for needlessly attempting to pass between the two schooners, and should pay the whole damage.

In Admiralty.

Benedict, Taft & Benedict, for libellant.

Alexander & Ash, for the Active.

Edgar Swain and J. A. Hyland, for the Ocean Wave.

BROWN, J. The steam-tug Active, having the barge Ocean Wave in tow upon a hawser of about 20 fathoms, in coming down the East river against the flood-tide, instead of proceeding near the middle of the stream, as required by law, was going near the New York shore for the purpose of availing herself of the slack water. Thus her course lay between two schooners, the J. W. Huston and the libellant's schooner, the Wm. Blakeley. The wind was north-west, and both schooners were engaged in heaving by windlass towards the New York shore, the Blakeley being about 100 feet nearer the shore than the Huston. The tug passed about midway between them, but the barge, in coming around the Twenty-sixth street pier, which was considerably longer than the one below, found it necessary to port her helm in order to avoid coming in contact with the bowsprit of the Huston. Before her sheer could be fully broken, though her helm was immediately starboarded on clearing the Huston, she ran upon the starboard quarter of the Blakeley, which was only about 100 feet below the Huston.

Having the whole middle part of the river clear, where she was bound by law to go, I must hold the tug in fault for proceeding as she did near the shore, and undertaking to thread the gauntlet of other vessels there lying in her way. She had no right to impose this hazard upon the tow. The available space between the two schooners is not estimated to be above 100 feet, and the fact that one was below the other, and that both were below the projection of the Twenty-sixth street pier, added to the difficulties of navigation imposed upon the barge. The primary fault being clearly in the tug in selecting such a channel, instead of pursuing her proper course in the middle of the river, only clear proof of neglect or of very unskill-

ful handling on the part of the barge could justly charge the latter with contributing to the collision. The evidence on this point against the barge is by no means clear or satisfactory. The time and space available for her maneuvering were both small, and almost approach the situation recognized as a situation *in extremis*, in which even erroneous handling at the moment is not deemed a fault, when the situation is brought about by the wrong of another. But it is not even clear from the testimony that the barge omitted anything she might have done, or did anything she ought not to have done, in first avoiding the Huston, though she afterwards came in contact with the Blakeley.

I must therefore charge the whole loss upon the Active, and allow a decree against her, with costs; while as to the Ocean Wave the libel should be dismissed, with costs.

THE OCEAN EXPRESS.

(District Court, S. D. New York. November 3, 1884.)

1. PILOTAGE—LIBEL FOR FEES—DUTY OF PILOT.

Upon a claim of fees for pilotage against a vessel which had left before the pilot arrived, *held*, that it was the duty of the pilot to be on hand at high water, and that, in his absence at that time, the vessel was justified in departing without him, and the libel was therefore dismissed.

2. ADMIRALTY PRACTICE—COSTS.

Costs disallowed where the libel is dismissed upon grounds not pleaded.

In Admiralty.

Beebe, Wilcox & Hobbs, for libelant.

Jas. K. Hill, Wing & Shoudy, for claimants.

BROWN, J. I think it was the duty of the pilot, the libelant, to be on hand at high water on the morning of February 15th, when the Ocean Express was to be piloted to sea. His own testimony, aside from his statement of the hour of the time to sail,—8 o'clock,—tends to confirm this view, which is sustained by the evidence of the captain and the draught of the vessel. The libelant's testimony would seem to indicate that he considerably mistook the hour of high water, which was, in fact, a little before six. The vessel, with her deep draught and in Newtown creek, was not bound to wait for him, and upon this ground I think the libel must be dismissed. But as this particular defense was not set up in the answer, the dismissal must be without costs.