

And again, it must be born in mind that the policy of the state and the United States may be, and sometimes is, at variance on a given subject. In such case, the former may indirectly hinder or defeat the policy of the latter, if a trial in its courts for a crime growing out of an act which also constitutes a crime against the United States can be used as a bar to a prosecution of the offender in the national courts. For instance, the United States, under the fifteenth amendment, may punish any one who discriminates against the exercise of the elective franchise by another on account of color. *U. S. v. Reese*, 92 U. S. 217. But if the state may also declare such an act a crime, it may purposely affix a mere nominal punishment thereto, and thus give any one guilty of such an act an opportunity to seek refuge in its tribunals before the United States can reach him, and by a trial and acquittal therein, at the hands of a sympathizing jury, or the imposition of a mere nominal punishment, effectually prevent the United States from prosecuting the offender in its own courts, and inflicting such punishment upon him as may be necessary to vindicate its authority and maintain its policy in the premises.

Indeed, if a trial and acquittal or punishment in a state court, under such circumstances, is a bar to a prosecution in this court for the crime of which these defendants stand indicted herein, it is difficult to see why a pardon by the governor of the state would not have the same effect. In short, it is impossible that the United States can maintain its paramount authority over the subjects committed by the constitution to its jurisdiction, and at the same time allow a trial in a state court on a criminal charge growing out of an act that congress has defined to be a crime, to be a bar to a prosecution therefor in its own courts and according to its own laws.

The demurrers to the pleas are sustained, and the defendants are put to plead to the indictment, guilty or not guilty.

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### FLOWER and others v. CITY OF DETROIT and others.

(Circuit Court, E. D. Michigan. November 17, 1884.)

#### 1. PATENTS FOR INVENTIONS—REISSUE No. 6,990—CLAIM 1—VALIDITY.

The first claim in reissued patent No. 6,990, granted March 14, 1876, to Thomas R. Bailey, Jr., for an improvement in hydrants, is not only an expansion of the claim in the original patent, but an attempt to introduce an entirely new invention, neither claimed nor suggested in that patent, and is void for that reason and because of the laches in allowing a period of eight years to elapse before applying for a reissue.

#### 2. SAME—CLAIMS—REISSUE—LACHES.

The claim of a specific device or combination, and an omission to claim other devices or combinations, are in law a dedication to the public of that which is not claimed. The legal effect of a patent cannot be revoked unless the patentee, with all due diligence and speed, surrenders it and proves that

the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part. It will not do for him to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms.

3. SAME—CLAIM 3—CONSTRUCTION—ANTICIPATION—RACE & MATHEWS PATENT.

The third claim of reissue No. 6,990 must be construed as for a casing wherein the end play is confined by an overlapping flange, and, thus interpreted, is anticipated by the Race & Mathews patent of 1858.

In Equity.

This was a suit for the infringement of reissued letters patent No. 6,990, granted March 14, 1876, to Thomas R. Bailey, Jr., of Lockport, New York, for an improvement in hydrants. The bill, after averring in the usual form the granting of the original patent No. 75,344 to Bailey, dated March 10, 1868, set forth that in February, 1876, plaintiffs, being about to acquire an interest in the invention, "only by the aid of skillful solicitors learned in the law, and after careful examination of the letters patent, and the papers and model on file and deposit in the patent-office" with the application therefor, first learned that said letters patent were inoperative and invalid by reason of defective and insufficient specifications, and that such defect arose through a discrepancy between the drawing, forming part of the specification, and the model; that one of the distinguishing features of the invention consisted in a loose casing around the tube or upright part of the hydrant, connecting the same with the water-main or horizontal part thereof, fitting the same like a sleeve, resting, when in proper position, with its lower end upon the water-main, or flange thereof below, so as to slip up on the said tube, which feature was fully shown and properly exhibited in and by the said model, but was not shown in the drawing, for the reason that the drawing was made by the attorneys of Bailey from the model, with the said case accidentally out of its proper position, so that in the drawing the case is represented as not only resting upon the water-main or flange thereof below, but as coming up flush with the flange above it on the tube of the hydrant, and that while the model showed the said case as loose, because of its having an end play up and down on the hydrant, yet the drawing showed the case connecting the tube and water-main together as being confined at the top as well as at the bottom, so as not to be a loose case and as not to have such end play, and that on learning of this fact plaintiffs at once informed Bailey, who then first discovered the defect in his specification, and procured a reissue of the patent with the drawing, specifications, and claims changed to correspond with his actual invention. The bill further averred that this reissued patent was assigned to plaintiffs, and that defendants had been guilty of infringing the same by making use of a large number of hydrants containing this device. It was insisted upon the argument that defendants had infringed the first and third claims of the reissue, which read as follows:

"(1) In combination with a hydrant or fire-plug, a detached and surrounding casing, C, said casing adapted to have an independent up-and-down motion, sufficient to receive the entire movement imparted by the upheaval of the surrounding earth by freezing, without derangement or disturbance of the hydrant or plug proper, substantially as shown. (3) The combination of the hydrant or fire-plug pipe, A, supply pipe, B, valve, D, casing, C, and stuffing box, H, substantially as and for the purpose shown."

The defenses were as follows:

*First*, that the reissue was not for the same invention as the original patent; *second*, that the reissue was not taken until eight years after the original patent, and was procured with new and enlarged claims for the purpose of covering structures which had meantime been put into extensive use by these defendants and others, and which had not been embraced by any claims of the original patent; *third* and *fourth*, that the first claim of the reissue, which is the only one plaintiffs could claim as infringed, was substantially the same as the claim of another patent already held by the supreme court of the United States to have been anticipated by other devices; *fifth*, that defendants had used their hydrants for upwards of 11 years before suit was brought, and, during at least 9 years of this time, such use was fully known by the plaintiffs, who did nothing, meanwhile, to enforce their alleged rights, and who, therefore, by reason of laches, could now have no standing in a court of equity.

*E. J. Hill*, for plaintiffs.

*H. M. Duffield*, City Counselor, and *George L. Roberts*, for defendants.

**BROWN, J.** The most important question in this case relates to the validity of the reissue. This is claimed, in the first defense, to be invalid as matter of law upon a comparison of the original and reissued patents. By the second defense it is insisted that it is also invalid as a matter of fact,—in other words, that in procuring the reissue the patentee was guilty of laches; that there was no such mistake, accident, or inadvertence as authorized the commissioner to take cognizance of the case; and that the reissue had not been procured *bona fide* to correct any such inadvertence or mistake, but for the purpose of covering the device of Race & Mathews, which in the mean time had been put into extensive use by the defendants and others throughout the country.

It is clear that under the earlier decisions of the supreme court the second defense would be unavailing, since it had been uniformly held up to 1874 that the determination of the commissioner as to the question of inadvertence, accident, or mistake was conclusive, and that the jurisdiction of the court was limited to a comparison between the original and the reissued patents, and to the ascertainment whether there was a fatal variance between the two. The law upon this subject was thus summarized by Mr. Justice CLIFFORD in *Seymour v. Osborne*, 11 Wall. 516:

"Where the commissioner accepts a surrender of an original patent, and grants a new patent, his decision in the premises in a suit for infringement is final and conclusive, and is not re-examinable in such suit in the circuit court unless it is apparent upon the face of the patent that he has exceeded

his authority; that there is such repugnancy between the old and the new patent that it must be held, as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent."

This limitation upon the power of the court was substantially reasserted in *Russell v. Dodge*, 93 U. S. 460-464, and in *Ball v. Langles*, 102 U. S. 128.

In the case of *Kells v. McKenzie*, 9 FED. REP. 284, decided in 1881, we had occasion to examine all the cases up to that time, and then came to the conclusion that there was nothing in the statute or in the opinions of the supreme court to indicate that we were at liberty to review the action of the commissioner in this particular. Such, too, I understand to be the general principle of law, applicable not only to judgments of courts of competent jurisdiction, but to the determinations of all officers acting judicially. *Hancock Inspirator v. Jenks*, 21 FED. REP. 911. Whether, under the later opinions of the supreme court, this doctrine is modified to the extent of permitting us to institute an inquiry into the action of the commissioner, and to determine whether there was such accident, inadvertence, or mistake as authorized him to grant a reissue, it is unnecessary to decide, since it is clear to my mind that the first claim of this reissue cannot be supported upon any theory of the law.

In the case of *Kells v. McKenzie*, above referred to, we followed what seemed to be the tenor of the most recent decisions of the supreme court, and held that the validity of a reissued patent did not depend wholly upon the fact that the new features attempted to be secured thereby were suggested in the models, drawings, or specifications of the original, and hence that where a patentee, in his specifications, claimed as his invention a particular part of the machine, and his claims were all limited to that part, a reissue embracing other and distinct portions of the machine was not for the same invention, and was *pro tanto* void, although the designs accompanying the original patent showed all the features contained in the reissue. Subsequent cases in the supreme court indicate that the right to a reissue should be still further restricted; but the rule adopted in that case is quite a sufficient guide to us for the determination of this. In this connection, then, it becomes important to consider of what invention Bailey was endeavoring to secure the monopoly when he applied for his original patent. In his specifications he declares that his invention "relates to a new and improved method of constructing fire-plugs or hydrants; and the invention consists in operating a cylinder valve in a suitable case, and in the arrangement and combination of parts connected therewith, as hereinafter described." Words could hardly be chosen to indicate more clearly that his invention was that of a cylinder valve in a case fitted to receive it, and in the arrangement and combination of other parts of the hydrant connected therewith. The mere operation of a valve would not be patentable unless the