

## BECKER v. HASTINGS and another.

(Circuit Court, E. D. Pennsylvania. May 5, 1884.)

## PATENTS FOR INVENTIONS—CLAIMS—CONSTRUCTION—ENLARGING—REISSUE.

Where a patent does not cover all that the inventor intended, he must surrender it, and obtain a reissue; for, where the language of the claim is plain, the court cannot by construction enlarge it.

## In Equity.

Henry Baldwin, Jr., for complainant.

C. B. Collier, for respondent.

BUTLER, J. The patent in suit is for "an improvement in hernial trusses." The inventor's object was to devise and provide a more ready and perfect means for adjusting the pad to the rupture. Trusses capable of adjustment, on either side of the person, were in use before the date of the patent. The complainant sought simply to render this adjustment easier and more perfect. The patent contains a single claim, in the following language:

"In a hernial truss, provided with a swinging joint for connecting the hernial pad, A, to the body band, B, for the purpose of rendering the truss readily adjustable for either the right or the left side of the person, as desirable, the combination with the pad, A, of the rotary stem, *a*, and its ratchet-toothed cylinder, *a'*, and spring lever, 12, constructed and arranged substantially as set forth, for the purpose of enabling the wearer of the truss to readily adjust and secure the position of the pad, A, so as to bear against either the right or left side of the rupture, or directly against the front of the same, as the wearer may desire, substantially as described."

This language, in view of the prior state of the art, confines the patent to the rotary stem, *a*, its ratchet-toothed cylinder *a'*, and the spring lever, 12, in combination with the ordinary hernial pad, connected with the body-band by a swinging joint, as previously used. Whether it might have been made broader, in view of the invention described in the specifications and drawings, we need not consider. The language of the claim is plain. The court cannot enlarge it by construction. If it fails to cover all the patentee intended to secure, his remedy was through recourse to the statute providing for reissues. Does the respondent employ the combination described? While he uses the rotary stem, he does not use the ratchet-toothed cylinder, nor the spring lever, the object of which two last-named elements is to secure the pad against backward motion on the stem, while it is left free to forward adjustment.

The respondent's set-screw, which rigidly locks the rotary stem, does not operate in the same manner as the ratchet-toothed cylinder and spring lever, nor produce the same, nor a similar, result. In this respect the respondent's truss fails in what is claimed to be an important effect of the complainant's combination. The screw cannot, therefore, be regarded as an equivalent for the ratchet-toothed cylin-

der and spring lever. The fact that in certain of the respondent's trusses the screw is used to force the projecting spikes of a spring down into the rotary stem, or a cylinder upon it, instead of being screwed down directly into or upon the rotary stem or cylinder, as in others, to accomplish the locking process, is esteemed unimportant. The result in each case is the same, and the manner of accomplishing it similar. It is unnecessary to pursue the subject further. The bill must be dismissed, with costs.

MCKENNAN, J., concurs.

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SPAETH v. BARNEY.

(Circuit Court, D. Massachusetts. January 22, 1885.)

1. PATENTS FOR INVENTIONS—REISSUE—ALLEGATIONS.

It is not necessary, in a suit for infringement of a reissued patent, to aver specifically the ground on which the original patent was surrendered and a reissue obtained.

2. SAME — EFFECT OF REISSUE OF PATENT BY COMMISSIONER OF PATENTS — INFRINGEMENT.

Where the commissioner of patents accepts the surrender of an original patent and grants a new patent, his decision is final and conclusive, in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and new patent that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced in the original patent.

In Equity.

*Briesen & Steele*, for complainant.

*B. F. Thurston*, for defendant.

COLT, J. The demurrer to the bill is based on two grounds: *First*, that it does not allege, with sufficient certainty, that a proper cause existed for surrendering the original patent and taking out the reissue; and, *second*, that it does not allege facts necessary to show that the commissioner of patents had jurisdiction to entertain the application for the reissue. Section 4916 of the Revised Statutes provides as follows:

"Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee."

The bill alleges:—

"That said Charles T. Day, having for good and lawful cause, and with the consent and approbation of your orator, surrendered said letters patent

to the commissioner of patents, and having made due application therefor, and having in all things complied with the acts of congress in such case made and provided, did, on the eighteenth day of February, 1879, obtain new letters patent, being reissued letters patent, for the same invention, for the residue of said term, and which were marked 'Reissue No. 8,590,' and were issued in due form of law to your orator, as assignee, under the seal of the patent office of the United States, signed by the secretary of the interior, and countersigned by the commissioner of patents, and bearing date the day and year aforesaid, as by the last-mentioned reissued letters patent, ready here in court to be produced, will appear."

We think the allegations in the bill are sufficient. It is not necessary to aver, specifically, the ground on which the original patent was surrendered. The reissue of letters patent by the commissioner is *prima facie* evidence that such reissue is founded on sufficient cause, and is in accordance with law. It is also presumed that the commissioner acted within his authority under the statute, until the contrary is proved.

The authorities are numerous and conclusive to the effect that where the commissioner accepts the surrender of an original patent, and grants a new patent, his decision is final and conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and the new patent that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced in the original patent. *Seymour v. Osborne*, 11 Wall. 516, 543; *Allen v. Blunt*, 3 Story, 742; *Collar Co. v. Van Dusen*, 23 Wall. 530, 558; *Metropolitan Washing-mach. Co. v. Providence Tool Co.* 1 Holmes, 161; *Russell v. Dodge*, 93 U. S. 460; *Ball v. Langles*, 102 U. S. 128; *Smith v. Merriam*, 6 FED. REP. 713; *Selden v. Stockwell Gas-burner Co.* 9 FED. REP. 390; *Giant Powder Co. v. Safety Nitro-powder Co.* 19 FED. REP. 509; *Philadelphia & T. R. Co. v. Stimpson*, 14 Pet. 448; *Wilder v. McCormick*, 2 Blatchf. 31.

Demurrer overruled.

## PORTER NEEDLE CO. v. NATIONAL NEEDLE CO. and others.

(Circuit Court, D. Massachusetts. January 3, 1885.)

### PATENTS FOR INVENTIONS — USE OF PATENT AFTER EXPIRATION OF LICENSE — DAMAGES.

While ordinarily the amount of damages to be paid by a party who has continued to use a patented machine after the expiration of a license granted to him, would be what such party would have been willing to pay as a license fee for the use of the machines, where it appears that the machine embodies other patented devices, it should be shown what portion of the license fee was paid for the part covered by the patent in controversy, and this portion would be the proper measure of damages.

In Equity. Exceptions to master's report.

*T. W. Clarke*, for complainant.

*J. E. Abbott*, for defendants.

COLT, J. The court decided (*Porter Needle Co. v. National Needle Co.* 17 FED. REP. 536) that the contract of September 12, 1877, did not convey the right to use the infringing machines after July 1, 1880, and that the defendants since that date must pay for their use. The case was thereupon sent to a master. The present hearing was had upon certain exceptions taken by the defendants to the master's report. The master has reported as damages what he finds the defendant company would have been willing to pay as a license fee for the use of the machines. *McKeever v. U. S.* 23 O. G. 1525. If it was clear the patent in suit covered all the mechanism of value in the machine, we should approve of the master's finding; but it seems from the evidence that the machine embodies other patented devices. From all that appears, therefore, a part of the license fee charged for leased machines, upon which the master bases the damages found, was paid for the use of these other patents. The fact that there was no evidence introduced as to the value of any of the other inventions would not, of itself, warrant the conclusion that the license fee was paid solely for the use of the patent in suit. Damages must be actual, and must be proved. *Seymour v. McCormick*, 16 How. 480. The license fee paid being for the use of the whole machine, it should have been proved that the particular patent embraced all the mechanism of value in the machine. If the patent covers only a part of the mechanism, then it should appear what portion of the license fee was paid for its use, and what portion for the use of other inventions embodied in the machine. *Wooster v. Simonson*, 16 FED. REP. 680. The second and ninth exceptions are sustained. The remaining exceptions are overruled. The case is referred back to the master, with liberty to the complainant to reopen proofs on the question of damages.

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### WOOSTER *v.* HILL and others.

(Circuit Court, D. Vermont. January 9, 1885.)

1. EVIDENCE — WIFE AS WITNESS FOR HUSBAND — U. S. REV. ST. § 858 — REV. LAWS VT. §§ 1001, 1005.

A wife is not a competent witness for her husband, in cases where he is interested, under the statutes of the United States or of Vermont.

2. PATENTS FOR INVENTIONS—ANTICIPATION—WOOSTER CABINET CREAMERY.

Upon examination of the evidence, *held*, that Daniel B. Wooster is entitled to a patent on such part of his claims in his application for a patent as describe a cabinet creamery as an improvement upon the box creamery of Hill and Prentice, as shown in patent No. 207,738, granted to them September 3, 1878.

In Equity.

*S. C. Shurtleff*, for orator.