

ent and in one instance as early as 1859. No reason is perceived why the court should not credit these witnesses. If we were dealing with a complicated machine or an abstruse and difficult process there would be reason to say that persons unskilled in the art might easily be mistaken in describing minute details. But here we have to do with the simplest possible contrivance,—an ordinary spool with some threads of yarn run through it. A person of average intelligence who had actually made balls of yarn by this method could hardly be mistaken about the use of the spool. There is nothing improbable in the story of these witnesses. No motive for perjury is suggested and no discrepancies which discredit the testimony upon the principal points are pointed out.

It does not avail the complainant to prove that the Shaefer, Warner and Burt methods do not anticipate the claim in controversy. It is thought that, upon the construction of the claim contended for by the complainant, it is anticipated by the Burt and Warner prior uses, but concede that it is not; it is certainly void for lack of invention. If the witnesses referred to, used a tube at all for the purpose of condensing the yarn and then tied and cut the yarn between the bindings, whether the tube was the hole through a spool or through an upright board, no room was left for invention by the substitution of the tube of the patent. If a spool were used in the manner described by the witnesses it is the end of complainant's patent. That it was so used there can be no reasonable doubt.

It is unnecessary to consider the question of infringement. It may, however, be said that in view of what was and was not known prior to the patent, and in view of the construction which in any event must be given the claim, it seems at least exceedingly doubtful whether the method adopted by the defendants of clamping a metallic button back onto the end of the mass of yarn and then cutting the yarn to form a tuft, is the method described in the claim. The bill is dismissed.

STEARNS v. BEARD.

(Circuit Court, N. D. New York. May 11, 1891.)

PATENTS FOR INVENTIONS—NOVELTY.

Letters patent No. 16,031, issued April 7, 1885, to Edward C. Stearns, for a design for the casing of a hay-fork pulley, consisting of side plates having a ring and hubs, central ribs, laterally projecting ears, and marginal beads, are not void for want of patentable novelty.

In Equity.

Hey & Wilkinson, for complainant.

Smith & Dennison, for defendant.

COXE, J. This is an equity action of infringement, based upon letters patent No. 16,031, granted to the complainant April 7, 1885, for a design for the casing of a hay-fork pulley. The claim is as follows:

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"The design for the casing of a hay-fork pulley, consisting of side plates, *c*, having a ring, *b*, and hubs, *d*, central ribs, *e*, laterally-projecting ears, *f*, and marginal beads, *g*, substantially as shown and described."

The defense is lack of patentable novelty. Infringement is conclusively proved. Pulley-casings, of course, were old. A pulley cannot operate without the casing. The record shows many different forms of casing, each, in general conformation, bearing a resemblance to every other. Necessarily this must be so. A new design for a pulley-case will resemble old pulley-cases just as a new design for a watch-case will resemble old watch-cases. If patents for designs are to be subjected to the test insisted upon by the defendant very few could survive the ordeal. In almost every instance these designs are made up of new combinations of old figures, forms, and structures taken from nature or art. In such cases it is not sufficient for the infringer to show that every line or curve or conformation, considered separately, is old; he must show that the design itself is old. He must prove that some one prior to the patentee had produced a similar design, a design which left a similar impression upon the eye. If a person by the exercise of his own inventive faculties produces a new design for a manufacture which possesses beauty and symmetry, and leaves a novel and pleasing impression upon the eye, if it creates for articles which embody it a popular demand, and thus secures to its originator a certain advantage over his competitors in trade, such a design is entitled to protection. *Perry v. Starrett*, 3 Ban. & A. 485; *Simpson v. Davis*, 12 Fed. Rep. 144; *Eclipse Co. v. Adkins*, 44 Fed. Rep. 280; *Miller v. Smith*, 5 Fed. Rep. 359; *Kraus v. Fitzpatrick*, 34 Fed. Rep. 39; Walk. Pat. § 64. Tested by this rule it is thought that the patent must be sustained. The design of the complainant has many points which clearly distinguish it from the exhibit which is said to resemble it most closely. It created a demand for complainant's pulleys, and made them popular with the trade. The defendant could have chosen any of the casings introduced in evidence with perfect propriety and safety. He could have invented a casing of his own; he had the prior art and the whole material universe from which to select a design. This he did not do. What he did do was to appropriate the complainant's design down to the most minute particulars. He did this intentionally, with full knowledge of what the complainant had done, and the presumption from his acts and language is well-nigh conclusive that he did it with the deliberate purpose of securing to himself the benefits of the complainant's labor. It is unnecessary to characterize his acts further than to say that they certainly do not commend him to the favorable consideration of a court of equity. The patent is simple and the controversy comparatively trivial, but the complainant having originated a meritorious and popular design is entitled to protection. There should be a decree for the complainant.

RICE v. BOSS.

(Circuit Court, N. D. New York. May 11, 1891.)

PATENTS FOR INVENTIONS—LICENSE.

A conveyance by a patentee of the right "to use and manufacture and sell rights to use" the patented article in a certain county is a mere license, not entitling the grantee to sue for infringement in his own name, since it does not convey the right to sell the patented article.

In Equity.

George B. Selden, for complainant.

S. D. Bentley, for defendant.

COXE, J. This is an action in equity, founded upon letters patent No. 172,608, granted to John W. Cassidy, January 25, 1876, for an improved fruit-drying apparatus. On the 4th of March, 1881, the patentee conveyed to the complainant the right, under the patent, for the county of Wayne in this state, "to use and manufacture and sell rights to use in said county, and in no other place or places." The defendant insists that this instrument is not a territorial assignment, but a license merely, and that the complainant has no standing to maintain this suit alone. The patent granted to Cassidy "the exclusive right to make, use and vend the said invention throughout the United States and the territories thereof." Unless the complainant possesses the same right for the county of Wayne, viz.: "The exclusive right to make, use and vend the invention," it is entirely clear that he cannot maintain the action in his own name. In the case of *Waterman v. Mackenzie*, 11 Sup. Ct. Rep. 334, the supreme court say:

"The patentee or his assigns may, by instrument in writing, assign, grant and convey, either, (1) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or, (2) an undivided part or share of that exclusive right; or, (3) the exclusive right under the patent within and throughout a specified part of the United States. * * * Any assignment or transfer, short of one of these, is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for an infringement. * * * The grant of an exclusive right under the patent within a certain district, which does not include the right to make, and the right to use, and the right to sell, is not a grant of a title in the whole patent-right within the district, and is therefore only a license."

In *Mitchell v. Hawley*, 16 Wall. 544, the conveyance was very similar to the one at bar. The language was as follows:

"The exclusive right to make and use, and to license to others the right to use the said machines in the said states of Massachusetts and New Hampshire, and in no other place or places."

The supreme court regarded this as a license only.

In *Gayler v. Wilder*, 10 How. 477, the agreement granted "the exclusive right to make and vend the Salamander safe in the city, county and state of New York," but it reserved to the grantor the right to manufact-