

against the consequences of contradiction, the evidence previously given must have been self-criminating, and obtained through the power of compulsion. So it follows that a witness who willingly gives evidence which does not in itself tend to self-crimination, but to fix the crime upon another, will not, upon subsequent proceedings in which he is a party, be exempt from the common-law rules as to contradictions and other methods of testing the credibility of witnesses and parties.

It often happens that justice is promoted by showing that a witness or a party has made inconsistent and contradictory statements, charging guilt upon others. If this case were to be tried again, and the respondent should give evidence different from the exculpatory evidence voluntarily given in his own behalf upon the last trial, it would at least be anomalous if such inconsistency could not be shown upon the question of credit. Or suppose, A. being on trial, John should testify that he saw B. commit the crime, and upon a second trial of the same case he should say that it was C., could it not be shown that the witness had made inconsistent and contradictory statements, to the end that the value of his testimony should be known? A construction of the statute in question which would shield a witness or a party from the consequences of such tests would at once destroy common and well-understood rules of evidence, long ago established for the better administration of justice. None of the cases cited by counsel are quite in point; yet it may be observed that *U. S. v. McCarthy*, 18 Fed. Rep. 87, and *In re Counselman*, 44 Fed. Rep. 268, on which counsel for the respondent chiefly rely, involve the self-criminating and compulsory elements, while *U. S. v. Brown*, 1 Sawy. 531, 536, and *State v. Broughton*, 7 Ired. 96, in reasoning, sustain the view which is here taken. If I am wrong in the construction placed upon the statute, the respondent has a speedy remedy by writ of error. The exceptions are overruled, and the motion for a new trial is denied.

NEW YORK BELTING & PACKING CO. v. NEW JERSEY CAR-SPRING & RUBBER CO.

(Circuit Court, S. D. New York. May 25, 1891.)

INFRINGEMENT OF PATENT—ASSIGNMENT PENDENTE LITE—JOINER OF ASSIGNEE.

Where the owner of a patent makes an assignment pending a suit by him to restrain an infringement, and for damages, but expressly reserves past damages, and there is no proof or claim of infringement subsequent thereto, the assignee cannot maintain a suit against the defendant, and should not therefore be joined as complainant.

In Equity.

The New York Belting & Packing Company, a Connecticut corporation, brought this suit against the New Jersey Car-Spring & Rubber Company in the year 1887, for infringement of a patent. In June, 1890,

the original complainant assigned all its right in the patent under which this suit was brought to an English corporation, called the "New York Belting & Packing Co., Limited." The English corporation moves for leave to file a supplemental bill, in view of the assignment to it of the patent in suit in June, 1890. The defendant's objection is principally based upon the grounds that the assignment of the patent in suit does not carry back damages; that the assignment of the patent in suit gives the English corporation all title to damages and profits after June, 1890, but nothing before; that the suit is for infringement occurring before March, 1887, and that hence the Connecticut corporation, if entitled to damages under the original bill, has not parted with its right thereto; that the English corporation, if it wants to come in as party complainant, must allege infringement of its right after date of purchase, but such allegation would be a new cause of action, and not a proper subject for supplemental bill, in view of *Kennedy v. Bank*, 8 How. 610; and that the Connecticut corporation, having sold its patent prior to the hearing, has lost its right to an injunction, in view of *Boomer v. Press Co.*, 13 Blatchf. 113; *Wheeler v. McCormick*, 11 Blatchf. 334, 345; *Electrical Accumulator Co. v. Brush Electric Co.*, 44 Fed. Rep. 605; and *Brewer v. Dodge*, 28 Mich. 359. Motion denied.

Wm. H. L. Lee, for complainant.

Arthur v. Briesen, for defendant.

LACOMBE, Circuit Judge. No doubt this court, having obtained jurisdiction of this suit, brought by the Connecticut corporation for an injunction and damages for past infringements, would retain the case, and decree for the damages, although, by assignment *pendente lite*, reserving back damages prior to June, 1890, the present complainant may have lost all right to an injunction. Whether the English corporation should be joined as complainant seems to depend upon the question whether it could itself maintain a suit against the defendant. Its title to the patent dates only from June, 1890. It has no claim for damages for infringements prior to that time, which were expressly reserved to the assignor. There is no proof, nor any claim, even, of infringements subsequent to that time. The only proof or claim of infringement is as to acts done three years before the assignee became the owner of the patent, and not continued since. Upon such averments, the English corporation could not maintain a bill for injunction, and therefore it should not be made a complainant.

HOKE ENGRAVING PLATE CO. v. SCHRAUBSTADTER.

(Circuit Court, E. D. Missouri, E. D. September 21, 1891.)

1. PATENTS FOR INVENTIONS—PATENTABILITY—ENGRAVING PLATES.

Claims 3, 5, 6, and 7 of letters patent No. 338,361, issued August 21, 1888, to Joseph W. Hoke, for engraving plates, are valid.

2. SAME.

On an invention by which, with the use of silicate of soda or of potash, a soft coating is made to adhere to an engraving plate, a patent claiming a base-plate with a smooth, hard, upper surface, and a soft, friable coating of minute particles of powdered matter, loosely bonded together, and more strongly bonded to the base-plate by a soluble mineral bond, so that the particles of the coating next the base-plate adhere thereto more strongly than the particles above them adhere to them or to each other, is void as too general, since it would preclude an invention by which the same result might be reached by the use of some other mineral bond than silicate of soda or potash.

In Equity. Suit for an accounting and to enjoin infringement of letters patent No. 338,361, issued August 21, 1888, to Joseph W. Hoke. *Benjamin F. Rex*, for complainant.

Geo. H. Knight and Wm. M. Eccles, for defendant.

THAYER, J. In this case defendant admits infringement,—not infringement of certain specific claims, but infringement generally; therefore, the burden is on the defendant to show the invalidity of all the claims of the patent. He has not succeeded in doing so to my satisfaction. The third, fifth, sixth, and seventh claims, in my judgment, have not been successfully assailed, and are accordingly upheld. For reasons that were to some extent indicated at the trial, I have concluded that the first and second claims ought not to have been allowed. They are too broad,—broader, in fact, than the invention. They are so drawn as to cover all processes of making a certain kind of "engraving plate," whereas the inventor has only discovered and described one process. Furthermore, the new article of manufacture claimed is not new, except in the sense that the inventor has employed a new ingredient to form the soft, friable coating of the plate on which the engraving is done. The two claims in question are as follows:

"I claim—(1) as a new article of manufacture, an engraving plate having a base-plate with a smooth, hard, upper surface and a soft, friable coating of minute particles of powdered matter, loosely bonded together, and having those particles of the coating next the base-plate more strongly bonded to it than the particles above them are bonded either to them or to each other; (2) as a new article of manufacture, an engraving plate composed of a base-plate having a smooth, hard, upper surface, a soluble mineral bond, and a soft, friable coating of fine earthy particles, loosely bonded together, and more strongly bonded to the base-plate by said soluble mineral bond, so that the particles of the coating next the base-plate adhere thereto more strongly than the particles above them adhere to them or to each other, as and for the purposes described."

It will be observed that the patentee claims substantially every kind of engraving plate having a coating composed of minute particles of powdered earthy matter, the particles whereof have the property of adhering more strongly to the base-plate than they adhere to each other. In his specification, however, he only describes one way in which such a coat-

ing can be formed, and that is by mixing certain kinds of finely powdered earthy matter with water, and adding thereto, as a bond, a few drops of silicate of soda or silicate of potash. The pasty mixture is then spread over the surface of a smooth metal base-plate, and heated, and, as the inventor says, the particles of the coating thus formed have a stronger affinity for the base-plate than they have for each other. The stronger affinity for the base-plate, however, is confessedly due to the peculiar chemical qualities of silicate of soda or potash, which is used as a bond. The merit of the invention seems to consist in the discovery of the great advantages to be gained by using silicate of soda in making a coating for engraving plates, and also in discovering and pointing out in what proportions, and in what way, it may be used to produce the best results. It is true that the patentee says in his specification that he "was the first to discover the desirability of bonding the particles of the coating very loosely together, and more strongly to the base-plate than to each other;" but, even if that is so, he is not entitled to a monopoly of every method of attaining a given result, merely because he has discovered that such a result is desirable, and one mode of attaining it. Particularly is that the case when the product of the process is not distinctively new, but is merely superior to a product of the same general kind that was previously known. It may be that some person will hereafter succeed in concocting a coating for an engraving plate that will be much superior to complainant's by the use of an ingredient in place of silicate of soda or potash which will have the property of bonding the particles more strongly to the base-plate than to each other, and in that event no reason is perceived why such an inventor would not be entitled to a patent, or why he should pay tribute to the complainant. Prof. Morse discovered that electro-magnetism could be made to print intelligible characters at any distance, and he devised one practicable method of applying it to that use. He accordingly claimed the use of the galvanic current as a motive power to print intelligible characters at a distance, but the claim was held to be void. *Morse v. O'Reilly*, 15 How. 106. That case is very similar in principle to the one at bar. Mr. Hoke, having discovered, as he says, that silicate of soda, when employed to bond the coating of an engraving plate, has the chemical property of attaching the particles of the coating more strongly to the plate than to each other, and that that is a desirable result, accordingly draws his claims so as to cover the use of any other liquid or substance in making a coating that may hereafter be discovered to possess the same chemical quality.

I am satisfied that claims one and two are too broad, and cannot stand. It is not even probable that the patentee was the first to discover the desirability of bonding the particles of the coating more strongly to the base-plate than to each other. Indeed, it seems almost self-evident that every artist who has heretofore handled an engraving tool must have discovered how desirable it was that the engraving tool should cut through the coating easily, without causing the coating to flake from the base-plate. The necessity, not to say desirability, of the coating adhering closely and evenly to the plate, was a fact that must have made