

apparent a lack of symmetry in the rates of duty, but the court cannot attempt to adjust into symmetry the various provisions of a statute which must include many details, by creating exceptions to a well-settled, and, on the whole, satisfactory, rule of interpretation of the statute relating to the revenue from imports. In accordance with this rule, the term "hemmed handkerchief" is a commercial term, and does not mean a handkerchief which has been cut from the piece, and has been in fact hemmed, but it means the article commercially known as a "hemmed handkerchief," which definition excludes the hemstitched article. Indeed, if the distinctions made in common speech are looked at, it is probable that the word "hemmed" would generally be regarded as indicating a different article from the one known as "hemstitched." The term appropriately describes a class of articles in which, by the commercial nomenclature, hemstitched handkerchiefs are not included, and resort must therefore be had to other statutory provisions to ascertain the proper duty upon the excluded articles. We agree with the opinion of the circuit court that the importation in suit should have been classified under section 324. The judgment is affirmed.

WALLACE, Circuit Judge, (*dissenting*.) I cannot agree with my Brother SHIPMAN in this case. I think that the handkerchiefs in controversy, being hemmed as well as ornamented, are "especially enumerated or provided for" by paragraph 325. It is unreasonable to suppose that congress intended to impose a higher duty upon cotton handkerchiefs having a plain, cheap hem than upon those having an ornamented and more expensive hem. I think that the term "hemmed handkerchiefs" is descriptive rather than denominative. It means the same thing as though it read "handkerchiefs hemmed," or "handkerchiefs having a hem." The case is somewhat analogous to *Binns v. Lawrence*, 12 How. 9. The importations are none the less hemmed handkerchiefs because they are also ornamented ones.

INDURATED FIBRE INDUSTRIES Co. *et al.* v. GRACE *et al.*

(Circuit Court, D. Massachusetts. July 28, 1892.)

No. 2,982.

1. PATENTS FOR INVENTIONS—JOINT INFRINGEMENT—PLEADING.

In a suit against two or more persons for infringing a patent, a general averment of infringement by defendants is a sufficient allegation of common infringement, without in terms averring a joint infringement.

2. SAME—PROPERT OF PATENT—DEMURRER.

In a bill for infringement, the propret by complainants of the letters patent does not make the recitals in the specifications as to the prior state of the art a part of the bill, in any technical or proper sense, so that the prior state of the art can be considered on demurrer.

3. SAME—DEMURRER—JUDICIAL NOTICE OF PRIOR ART.

On demurrer to a bill for infringement of letters patent No. 273,869, issued March 13, 1883, to the Underground Electric Cable Company, for an insulating underground cable conductor, consisting of a tube of compressed paper, the court cannot take judicial notice of the prior state of the art.

In Equity. Bill by the Indurated Fibre Industries Company and the Builders' Insulating Tube Company against James J. Grace, Charles S. Pinkham, and Eugene W. Godfrey, for infringement of let-

ters patent No. 273,869, issued March 13, 1883, to the Underground Electric Cable Company, as assignee by mesne assignments of William and Timothy G. McMahon, for certain improvements in underground cables. Heard on demurrer to the bill. Demurrer overruled.

The specifications thus describe the invention:

"Our invention relates to insulated conductors for conveying electrical currents for any of the purposes for which such currents are ordinarily used, and more especially to insulated underground conductors, although the improvements are of utility in, and applicable to, any relations or positions in which insulated conductors of electricity are desirable. In order to be commercially practicable, underground insulated conductors must be furnished with an insulating and protecting medium, economical in first cost, of high insulation, durable, and easy of application, to which ends many materials, combinations, and forms have been devised, the most common of which have been compositions, solid or presumably solid at ordinary temperatures, but plastic at high temperatures, so that they could be applied to the conductors in a plastic condition. Some of these possessed the merit of economy in first cost, but were found to lack durability, being affected by thermal and hygrometric changes, and hence proved in the end to be lacking in actual economy. Others proved comparatively durable, and not subject to any great change under such influences; but their prime cost, due to expensiveness of the materials used, especially where rubber and such materials entered into the composition, rendered them economically undesirable. In other instances the conductors are placed and kept separated from each other in tubes which are filled with an insulating liquid; but in such cases constant attention was required in order that the tubes be kept constantly full of the liquid under pressure, and leakage and evaporation prevented; hence such systems, so far as we know, have failed of general adoption. Moreover, where in compositions hydrocarbons—such as paraffine, asphalt, etc.—were used, the insulation itself was highly combustible, and proved in some instances a source of great danger.

"In view of these things, the object of our invention is to produce an insulated conductor wherein the insulating material shall be cheap in prime cost, durable, of high insulative capacity, easy of application, and, under ordinary circumstances, practically incombustible. To accomplish this we make the insulation of the conductors as an already-formed tube of paper completely encircling, protecting, and insulating the conductor.

"The insulating properties of paper were of course known before our invention. For instance, in some positions, for small spaces or for temporary uses, sheet paper has been wrapped around the conductor, and it has been suggested that paper pulp be coated upon the conductor; but, so far as we know, no means were suggested or shown of carrying this mere suggestion into practice. Paper has also been used incidentally, alternative with cloth or any other fabric, as a base upon which an asphalt composition was applied, and a tube then formed thereof, which served as a mandrel, upon which a cement pipe was cast. Beyond this, so far as we have been able to ascertain, no way has been devised or disclosed for utilizing the insulating properties of paper.

"In our invention tubes are formed, preferably from the pulp, and, when they are to be used in any peculiar situations, with any desired exterior configuration best fitting them for use in the peculiar situation. They are formed under great pressure, so as to render them hard in substance, firm, and homogeneous, and so formed they are practically incombustible, or at least not liable to combustion from any influence of the current.

"By these means we are enabled to utilize the high insulating properties of

paper, and to furnish an insulated conductor, cheap, durable, easy of manipulation and use, and of high insulative capacity. What we claim is—

“An insulated conductor for conveying electric currents, consisting of the combination of a metallic conductor and a formed pipe of paper only, substantially as set forth.”

The bill makes profert of the patent as follows: “And your orators bring here into court a duly-authenticated copy of said letters patent, and pray that the same may be taken as a part of this bill.” After setting out the various matters showing complainants’ right to maintain an action for infringement, the bill alleges that there is a large and growing demand for the apparatus claimed by said patent, which demand complainants have ample facilities for supplying,—

“Yet that the said defendants, well knowing the premises and the rights and privileges secured to your orators as aforesaid, by the said letters patent, but contriving to injure your orators, and to deprive them of the profits, benefits, and advantages which might, and otherwise would, have accrued to them from the said letters patent, have been, in said district of Massachusetts, and in the city of Boston, and elsewhere in these United States, and still are, unlawfully, wrongfully, and without permission of your orators, making, using, and vending to others to be used, wiring systems for electric installations in which paper tubes are used for the protection and insulation of the metallic conductors in the manner set forth and claimed in the aforesaid letters patent, and in violation and infringement of the aforesaid rights and privileges of your orators; and, although notified of said infringement, and requested to desist therefrom, they still continue so to do; and your orators further show that the defendants have derived and are still deriving from such construction, use, or sale large gains and profits, but to what amount your orators are ignorant, and cannot set forth; and they pray that the defendants may be required to make a disclosure of all such gains and profits, and of the amount of such infringing apparatus which they have thus wrongfully made, used, or sold.

“And your orators further pray that the said defendants may be compelled by a decree of this court to account for and pay over to your orators all such gains and profits as have accrued to or been received by them, or either of them, and all such gains and profits as your orators would have received but for the said unlawful acts of the said defendants, and the damages by said unlawful acts of the said defendants.

“And that the defendants, their clerks, attorneys, agents, servants, and workmen, may be perpetually enjoined and restrained by the decree and injunction of this court from directly or indirectly making, constructing, using, or vending to others to be used, any tubes formed of paper in combination with metallic conductors contained therein, or any apparatus containing or embodying the invention described and patented in said letters patent, and that they may be decreed to pay the costs of this suit, and that they may be also enjoined and restrained, as aforesaid, during the pendency of this suit, and that your orators may have such other and further relief as the equity of the case may require, and to this court may seem meet.”

Bentley & Blodgett, for complainants.

Dyer & Seeley, for defendants.

POTNAM, Circuit Judge. One ground of demurrer assigned is that the bill is defective because it does not, in terms, allege a joint infringement, or at least set out sufficient facts from which a joint infringement can be gathered. Neither party has furnished me any decision of any

court, or any observation of any text writer, or referred me to approved forms, directly touching this proposition, unless Rob. Pat. § 1104, and *Shickle v. Foundry Co.*, 22 Fed. Rep. 105. What is said in *Robinson on Patents* rests entirely on *Shickle v. Foundry Co.*; and this case was an oral ruling, made apparently conversationally, without any citation of authorities or expression of well-considered reasons, and under such circumstances that the court may very likely have gathered from other parts of the bill that, *prima facie*, the defendants were in fact several infringers. This case is not sufficient to satisfy me that for this matter there is any special rule applicable to bills for infringement of patents not found elsewhere. The cases and text-books are full of expressions that, in bills of this nature, a general allegation of infringement is sufficient, thus conforming to the common practice in other suits, and giving the impression that there is no special rule to be observed by patentees in framing pleadings at law or in equity.

In actions at common law, whether on torts or in contract, in bills in equity for waste or nuisance, and even in pleadings of so high a character as indictments for murder and piracy, a general allegation charging those named as defendants, or those indicted, without the interpolation of the word "jointly" or its equivalent, is sufficient; and I can see no reason why it is not sufficient in bills like this, in which the common act does not in law necessarily involve a conspiracy, but, as with ordinary torts, is proven by showing common wrongdoing, without alleging or especially proving a common intent. The rules of the supreme court have stricken from bills in equity the common confederacy clause, but for all ordinary bills this was long since recognized as of no intrinsic value, and its omission can hardly require the interposition of new allegations. I know of no more approved forms than those given in Curtis' "Equity Precedents," where I find the frame of a bill in behalf of the owners of a patent against two defendants. This nowhere alleges that defendants jointly infringed, nor does it contain an equivalent therefor. It is true that the form uses the common confederacy clause, in the following words, namely, "that the said defendants have confederated to use the said improvement;" but the portions which properly constitute the statement of the infringement conform literally to the bill in the case at bar. In the absence of any sufficient authority shown to me to the contrary, I shall apply the rule of pleading usual everywhere else, and hold that the bill sufficiently alleges a common infringement.

The principal ground of the defendants' demurrer is that the patent sued on appears on its face void for want of invention. This proposition was stated at the oral argument to have reference to the state of the art; but it was not claimed that, independently of what is set out in the specifications, the court could take judicial knowledge thereof. Reference was made especially to those portions which state that, prior to the alleged invention sought to be covered by the patent, the insulating properties of paper were known, and also that, in some positions for small spaces or for temporary uses, sheet paper had been wrapped about the conductor, and that it had been suggested that paper pulp be coated

upon the latter. It may be that other portions of the specifications, more or less relevant, were referred to on this point.

It was also claimed that, by making profert of the letters patent, these specifications were made a part of the bill. This is undoubtedly correct. Nevertheless, they were not thus made a part of it more effectually, or for any different purpose, than if set out in the bill at length. A bill in equity does not necessarily make all the statements of fact contained in a contract or letters patent, or other instrument, proper parts of its pleadings, either by referring to them, or by annexing as an exhibit, or by making profert, or by reciting the tenor at length. With reference to letters patent, the claim or claims become, of course, a fundamental portion of the allegations of the bill, so far as any of them—in case there are more than one—are relied on by the complainant. So everything in the specifications which must be resorted to by the court in construing the claims might be considered as part of the complainants' pleadings. But all portions which merely set out the state of the art are, like recitals of facts in contracts or other instruments, more or less conclusive on the party who sets them up, yet in the eyes of the law explainable, and not absolutely presumed to have been so alleged as to become the subject of demurrer. Especially must this be so with specifications in patents, in which many statements are necessarily complex, relate to unfamiliar topics, and are not easily understood without extrinsic evidence. It is true that, so far as the specifications contain any representations which, if erroneous, may be presumed to have misled the patent office to the detriment of the public, the patentee may be estopped. On the other hand, I do not understand the law has gone so far as to forfeit a valuable patent because the patentee has inaptly, or somewhat inaccurately, described the state of the art, or that it conclusively prohibits him from showing such inaptitude or inaccuracy, if it also appears that the public has not been prejudiced thereby; and in the case at bar, where the state of the art has been set out, not so positively or categorically as the respondents seem to assume, but somewhat confusedly and with qualifications, I should be unwilling to hold on a demurrer that there was no possibility that the complainants might introduce evidence placing their alleged invention in a more favorable position than the respondents assign for it.

I am not aware that in this circuit the practice of demurring on the ground of the want of invention has obtained a footing. The mischief of permitting it unnecessarily is well pointed out by the reference of Judge BLODGETT to the crop of demurrers which one of his decisions occasioned in the northern district of Illinois. *Manufacturing Co. v. Adkins*, 36 Fed. Rep. 554. I am not able to ascertain that the practice of this character which exists in some of the districts has ever had the direct approval of the supreme court. The expressions in *Brown v. Piper*, 91 U. S. 37, frequently referred to, do not seem to go to that extent; as in that case there were a bill, answer and proofs, so that the complainant had had full opportunity, and all possible facts were before the court. On such a record the court might with safety say that there was nothing on the face of the patent itself which could require its attention. In *New*

York Belting Co. v. New Jersey Rubber Co., 137 U. S. 445, 11 Sup. Ct. Rep. 193, where the subject-matter was that of a design, the court overruled the demurrer on the merits, without either expressly condemning or approving the practice on this point. It is true, nevertheless, that in several districts this practice is sustained; and it is also approved by Rob. Pat. § 1110, and by Mr. Gould's notes to Story, Eq. Pl. (10th Ed.) § 452. In *Blessing v. Steam Copper Works*, 34 Fed. Rep. 753, Judge SHIPMAN uses the following language: "To decide, in advance of an opportunity to give evidence, that no evidence can possibly be given upon the question of invention which would permit the case to be submitted to the jury, seems to me to be ill-advised, except in an unusual case." This would seem especially so if the questions, not only of value and usefulness, but of novelty, are to be in any degree determined by what transpires subsequent to the issue of the patent, as was suggested in *Magowan v. Belting Co.*, 141 U. S. 332-343, 12 Sup. Ct. Rep. 71, and *The Barbed Wire Patent*, (*Washburn & M. Manuf'g Co. v. Beat 'Em All Barbed Wire Co.*) 143 U. S. 275, 12 Sup. Ct. Rep. 443; even with such qualifications as appear in *McClain v. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. Rep. 76, and *Adams v. Stamping Co.*, 141 U. S. 539, 12 Sup. Ct. Rep. 66.

However, without undertaking to settle whether in any case a demurrer can be allowed for want of invention appearing on the face of the patent, or whether, in this particular case, the state of the art would be, with the aid of the recitals in the specifications, a matter of judicial knowledge, I hold that the recitals relied on by the respondents are not made by the profert a part of the complainants' allegations, in any technical or proper sense, so that they can be considered on demurrer, and that, aside from such recitals, the court cannot take cognizance of the state of the art to which this particular patent relates. I am aware that in *Fougeres v. Murbarger*, 44 Fed. Rep. 292, and in *Studebaker Bros. Manuf'g Co. v. Illinois Iron & Bolt Co.*, 42 Fed. Rep. 52, in each of which cases the demurrer was sustained, the court read into the bill statements of facts found in the specifications; but I do not perceive that the propriety of doing so was considered, and the practice seems so clearly violative of fundamental principles of correct pleading that I am compelled to follow my own conclusions. I believe that of all the cases properly in point which have been cited in the briefs, or otherwise found, the demurrer was sustained in only three.

Demurrer overruled, with costs for complainants to the time of filing respondents' answer; respondents to answer on or before rule day in October next.

ELECTRICAL ACCUMULATOR Co. *et al.* v. BRUSH ELECTRIC Co.

(Circuit Court of Appeals, Second Circuit. October 4, 1892.)

1. PATENTS FOR INVENTIONS—NOVELTY—CONSTRUCTION OF CLAIMS—SECONDARY BATTERIES.

Claims 1, 2, and 3 of letters patent No. 337,299, issued March 2, 1886, to Charles F. Brush, for an improvement in secondary batteries consisting in a plate or element having active or absorptive material primarily and mechanically applied thereto or combined therewith, cannot be invalidated on the theory that the term "secondary battery" was used therein in its older and looser sense, and included batteries which were sometimes primary and sometimes secondary according to the method of their use, for the distinction between primary and secondary batteries is definitely marked and recognized, and the Brush invention was professedly an improvement over the Plante battery, which was of the purely secondary class.

2. SAME—DEFINITIONS—"PRIMARY" AND "SECONDARY" BATTERIES.

A "secondary battery" is one which has no original power of developing a current, and is active only when rendered so by sending a current through it from an independent source of electrical energy, while a "primary battery" is one which is active in virtue of the materials of which it is made.

3. SAME—PRIORITY OF INVENTION—FOREIGN PATENTS.

The invention described in letters patent No. 252,002, issued January 3, 1882, to C. A. Faure, a citizen of France, for an improvement in secondary batteries, having been conceived by the patentee in France, and being covered by a French patent issued October 20, 1880, he cannot claim the invention in this country prior to the latter date, as against a citizen of the United States who, being an original inventor, subsequently received an American patent.

4. SAME—LIMITATION OF CLAIM—DISCLAIMER.

The owner of the Faure patent in this country having, as the result of certain litigation, filed a disclaimer limiting his invention to an electrode coated with a mechanically applied layer of lead, or like insoluble substance, placed upon the supporting plate in the form of a paste, paint, or cement, prior to immersion in the battery fluid, any further discussion of the question of priority of invention between Faure and Brush is now useless.

5. SAME—ANTICIPATION.

Brush's patent 337,299 was not anticipated by the patent of April 3, 1866, to George G. Fercival for secondary battery electrodes consisting of cells filled with coarse conducting powder, and divided by a porous partition; or by the patent of April 23, 1867, to Georges L. Leclanche, for a "polarization apparatus or electrical accumulator," consisting of two plates of graphite or unoxidizable metal buried in two flasks of powdered graphite moistened with a liquid which is a good conductor, such as potash water.

6. SAME—TWO PATENTS FOR SAME INVENTION.

The Brush patents Nos. 337,298 and 337,299 were issued on the same date, (March 2, 1886;) the difference between them was the difference between "an absorptive substance, or an absorptive substance adapted to be transformed into active material," on the one hand, and "active material, or material adapted to become active," on the other. *Held* that, in view of the admitted fact that all distinction between the two disappears the moment a battery so constructed is charged or discharged, there was no substantial difference, and the two patents were for the same invention.

7. SAME—PRIORITY—PRESUMPTIONS FROM PATENT NUMBERS.

These patents were issued on the same day to the same person, and the evidence showed that it would be impossible ever to ascertain which first received the official signature that rendered it a valid deed. *Held*, that the mere fact that one had an earlier number was no proof of priority, for it merely signified that the patent office followed the alphabetical order of Brush's contemporaneous applications, and hence that one could not be held an anticipation of the other.

8. SAME—ELECTION BY PATENTEE.

Under these circumstances the owner of both patents was entitled to elect upon which one he would rest his monopoly; but having elected to rely upon No. 337,299, it became improper that No. 337,298 should be left in a condition in which it could be assigned and sold, and a final decree should be framed, which, in connection with its finding of the validity of No. 337,299, should declare 337,298 inoperative, and prohibit its assignment or sale.