

ity, that a simple licensee has no such interest as to make him either a necessary or proper party to a bill filed to restrain the infringement of a patent right.

It is urged, if the law be as stated, that it may be gathered from the bill that the license in question was an exclusive one. It suffices to say that a careful consideration of the averments of the complaint precludes any such construction. The complaint fails to show that the parties joined as plaintiffs with the patentee have any exclusive interest in the monopoly. It is insisted, inasmuch as it is alleged in the bill that the respondent has been granted by the complainants a license to manufacture lime glass chimneys, that it is estopped to say that they may not maintain a joint bill against it for manufacturing lead glass chimneys without a license. The respondent, if estopped at all, cannot be estopped beyond its license. It may be that Dithridge & Co. have acquired such an exclusive right in the patented invention, so far as relates to the manufacture of lime glass chimneys, that the patentee could not grant to the respondent a license to manufacture that sort of glass chimneys without his licensees joining in it. This concession, however, would by no means prove that Dithridge & Co. had an exclusive license for the manufacture of lead glass chimneys. Dithridge & Co. are not shown by the bill to have acquired, either by assignment or license, any exclusive right to practice the invention in the manufacture of lead glass chimneys. I have carefully examined all the cases cited by complainants' counsel, and I find none which lend support to the complaint. The complaint being a joint one by two parties, one of whom has no interest, it follows that the demurrer must be sustained. When two or more plaintiffs unite in bringing a joint action, and the facts stated do not show a joint cause of action in them, a demurrer will lie upon the ground that the complaint does not state facts sufficient to constitute a cause of action. *Harris v. Harris*, 61 Ind. 117, on page 129. The bill may be amended, if counsel is so advised, within 20 days, upon payment of all costs, to and including the filing of the amended bill; otherwise, at the expiration of 20 days, the bill shall stand dismissed, with costs, but without prejudice.

AMERICAN HEAT INSULATING Co., Limited, *et al.* v. A. JOHNSTON & Co., Limited.

(Circuit Court of Appeals, Third Circuit. October 20, 1892.)

No. 8.

PATENTS FOR INVENTIONS—REISSUE—ENLARGEMENT OF CLAIMS.

Letters patent No. 171,425, issued December 21, 1875, to John C. Reed, for a non-conducting covering for "boilers, steam, water, and other pipes," claimed a covering composed of layers or wrappings of paper saturated with adhesive material, and compressed while being formed into tubular sections "of a thickness of one half inch or more," substantially as described. A reissue of the patent—No. 8,752, granted August 10, 1879—omitted from the claims the quoted words. *Held*, that this was an enlargement of the claim, rendering the reissue invalid, and that this effect could not be avoided on the theory that a covering of less than half an inch

would not constitute the "thorough nonconductor" of the specifications; for, while a less thickness might not be sufficient for boilers and steam pipes, it manifestly would be for "water and other pipes." 48 Fed. Rep. 446, reversed.

Appeal from the Circuit Court of the United States for the Western District of Pennsylvania.

In Equity. Bill by A. Johnston & Co., Limited, against the American Heat Insulating Company, Limited, and others, for infringement of reissued letters patent No. 8,752, granted August 10, 1879, to John C. Reed, upon original patent No. 171,425, issued to him December 21, 1875. The circuit court sustained the reissue, and entered a decree in favor of complainant. 48 Fed. Rep. 446. Defendant appealed. Reversed.

William L. Pierce, for appellants.

James I. Kay, (*W. Bakewell*, on the brief,) for appellee.

Before DALLAS, Circuit Judge, and BUTLER and GREEN, District Judges.

BUTLER, District Judge. The plaintiff sues as assignee of reissued letters patent No. 8,752, dated August 10, 1879, issued to John C. Reed, to recover for infringement. The invention is an improvement in nonconducting covers for steam boilers, steam, water, and other pipes. The specifications say: "The invention relates to that class of articles known as 'boiler coverings,' or 'nonconducting coverings for boilers, steam, water, and other pipes.'" After describing the coverings, and the process of manufacturing them, the claims are stated as follows:

"(1) A nonconducting covering for boilers, pipes, and other surfaces, composed of layers or wrappings of paper saturated or coated with suitable adhesive material, and compressed while being formed into tubular sections, substantially as described. (2) As a new article of manufacture, a nonconducting covering for boilers, pipes, and other surfaces, composed of layers or wrappings of paper, saturated or coated with suitable adhesive materials, and compressed while being formed into tubular sections divided longitudinally, so as to be placed around the pipes or other surfaces to be covered, substantially as set forth."

The original specifications and patent—issued December 21, 1875—stated the invention as follows:

"My invention relates to that class of articles known as 'boiler coverings,' or 'nonconducting coverings for boilers, steam, water, and other pipes,' and it consists in a nonconducting covering, composed of layers or wrappings of paper, preferably roofing paper, saturated with adhesive material, and compressed while being formed into tubular sections of *one half inch or more in thickness.*"

The claim was for "a new article of manufacture; a nonconducting covering, composed of layers or wrappings of paper saturated with adhesive material, and compressed while being formed into tubular sections of a thickness of *one half inch or more*, substantially as shown and described." A fuller statement of the facts is unnecessary to an understanding of our views of the case.

The validity of the reissue is attacked on the allegation that its claims are broader than that of the original. Judged in the light of its terms

alone, this allegation is certainly true. The limitation respecting thickness of the coverings, contained in the original, is omitted. The complainant contends, however, that in the light of the proofs the claims in each are, in effect, the same; because, as he asserts, a covering of less than half an inch would not constitute "a thorough nonconductor," such as the specifications describe; and consequently that the restrictive language of the original patent was inoperative, in construing its claims. This view the circuit court adopted. Is it sound? It seems clear that the patentee did not think so when he took either of the patents. When applying for the original he objected to the limitation, as the proofs show, but was required by the office to insert it; and his object in taking the reissue seems mainly to have been to get rid of it. It cannot well be doubted that if a covering below the limit had been manufactured and used, subsequently to the reissue, he would have objected to it as an infringement. If for no other purpose than to avoid uncertainty, the office acted wisely in requiring a definite statement of the thickness of coverings sought to be embraced. The language, "a thorough nonconductor," employed in the specifications, is indefinite. What is or is not such a conductor is matter of individual judgment, about which experts will disagree. If a bare half inch is such, it would be difficult to affirm that a trifle less is not. As much would depend upon the fineness and firmness of the texture and solidity of the covering as upon the difference in thickness. The terms of the original claim, as amended, left nothing to doubt. The patentee's rejection of them subsequently, seems to be an emphatic declaration that the language is important, and that he will not be so limited. His present attitude does not, therefore, commend itself very strongly to favorable consideration. The court says:

"If we were shut up to a comparison of what appears on the face of the original patent and the face of the reissue, it might seem that the omission from the latter of the words, 'of a thickness of one half inch or more,' was a material change, and one prejudicial to the public; but the proofs bring us to a different conclusion. It is shown that a covering of less thickness than half an inch would lack the necessary nonconducting property. A half inch covering is too thin to retain the heat, and prevent radiation."

We have carefully looked through the proofs, and cannot so understand them. They probably show that a less thickness would be insufficient for *boilers*, and *steam pipes*—to which doubtless the coverings are most commonly applied. The reissue, however, plainly embraces coverings for hot water, hot air, gas, and all other pipes to which their use may be beneficially applied; and we do not find any evidence to justify the conclusion that a thickness of less than half an inch is insufficient for such purposes. Manifestly, we think, the thinner coverings are sufficient for such uses. If not, the burden was on the complainant to prove it. We attach no importance to the complainant's suggestion that coverings of less than half an inch, could not be "conveniently packed for transportation," as described in the specifications. The decree of the circuit court must therefore be reversed and the case remanded with directions to dismiss the bill.

UNITED STATES v. 250 KEGS OF NAILS.

(District Court, S. D. California. September 26, 1892.)

SHIPPING—TRADE BETWEEN AMERICAN PORTS—FOREIGN VESSELS.

Act March 1, 1817, § 4, (now Rev. St. § 4347,) prohibits, under pain of forfeiture, the transportation of merchandise from one American port to another in foreign vessels. Act July 18, 1866, (now Rev. St. § 3110,) declares that, if any merchandise "shall at any port of the United States, on the northern, northeastern, or northwestern frontiers thereof," be laden on a foreign vessel, and taken to a foreign port, and thence reshipped to any other "port of the United States on said frontiers," with intent to evade the provisions of the fourth section of the act of 1817, such merchandise shall be seized and forfeited. *Held*, that while it is a palpable evasion of the act of 1817 to ship goods from New York to Antwerp in a foreign vessel, and thence reship them in another foreign vessel to San Francisco, such transshipment is not within the prohibition of either act, when the two are construed together.

Libel to Enforce a Forfeiture of Merchandise.

M. T. Allen, U. S. Atty.

Andrus & Frank, Page & Eells, and *J. H. Shankland*, for claimant.

Ross, District Judge. This is an action by the United States to enforce an alleged forfeiture of certain merchandise on the ground that it was transported from one port of the United States to another port therein, in foreign bottoms. The answer of the owner of the property proceeded against admits the bringing of it into the port of Redondo, in this judicial district, as alleged in the libel, and sets up as a defense that the merchandise was wholly of the produce and manufacture of the United States, and was shipped from New York in the Belgian ship *Waesland*, consigned to a commercial house at Antwerp; that it was there discharged and landed; that subsequently it was shipped on the British ship *Kirkcudbrightshire*, consigned to the respondent at San Francisco, Cal., and brought to San Francisco, where it was entered as a manufacture of the United States, which had been exported and returned to this country; that, prior to the departure of the ship *Waesland* from the port of New York, the respondent procured from the collector of customs and naval officer at that port a certificate of the exportation of the merchandise from that port, and that the consignees thereof at Antwerp, prior to the departure of the ship *Kirkcudbrightshire*, procured from the consul of the United States at that port a certificate that the said merchandise, bound by the said ship *Kirkcudbrightshire* to the port of Redondo, consisted of articles of the manufacture of the United States which had not been advanced in value or improved in condition by any process of manufacture or other means. The answer further avers that, at the time the merchandise in question was shipped from New York, the respondent intended to export the same to a foreign country, and thereafter to cause the same to be returned to the United States; that the merchandise was at all times the manufacture of the United States; and that it was, by the respondent and his agents, returned to the United States after having been exported, without having been advanced in value or improved in condition by any process of man-