

their claim to the Thomas Finch patent. But, judging from the tenor of their letters to him, the chief topic in conversations and correspondence was the unfair conduct of Latimer Finch. The claim of ownership of the Thomas Finch patent would appear not to have been asserted. I am not satisfied that Johnson had notice of the claims of the American Company prior to his purchase. But, even if he did have such notice, I do not see how it would affect the title of complainant, provided the Finch Company and Cavanaugh got a good title. I have stated the facts for the purpose of showing the course of conduct of the American Company.

In view of all the facts, I think the American Company has been guilty of such inexcusable laches in the assertion of its alleged rights that it is not entitled to relief. *Marsh v. Whitmore*, 21 Wall. 178; *Speidel v. Henrici*, 120 U. S. 377, 7 Sup. Ct. Rep. 610.

Finally, the defendants claim that, even if the American Company is not equitably entitled to the patent, it has an irrevocable license to make and use the patented article under the agreement of February, 1881, and by reason of the sale of the press. The first claim would seem to be disposed of by the opinion of Judge Brown in *American Solid Leather Button Co. v. Empire State Nail Co.*, 47 Fed. Rep. 741. Besides, the agreement of February, 1881, did not refer to licenses, and, as is forcibly urged by counsel for complainant, if the effect to be given to this agreement is that it is to be treated as a license, then an agreement to assign has greater effect than an assignment; and while the latter, if unrecorded, is void, and of no effect, the former, if unrecorded, is valid, and of some effect, namely, to operate as a license. *Gibson v. Cook*, 2 Batchf. 151. Whatever effect the fact that Thomas Finch sold a button machine, which was afterwards transferred to the representatives of the American Company, might have upon the question of the license to use that machine as against said company, it has no relevancy to this case. It is not claimed that the buttons sold by defendants were made on said machine. In fact the evidence shows that it got broken, and cannot now be found.

Let there be a decree for an injunction and an accounting.

GOEBEL v. AMERICAN RAILWAY SUPPLY CO. et al.

SAME v. GOLDMANN.

(Circuit Court, S. D. New York. May 13, 1893.)

1. PATENTS FOR INVENTIONS—INFRINGEMENT—DEMURRER.

While the objection of want of patentable novelty may be raised by demurrer to a bill for infringement of a patent, the question must be determined in favor of the patent, unless the court can see from an examination of the patent itself, and the consideration of those facts alone of which it will take judicial notice, that it does not involve invention.

2. SAME—VALIDITY—HATS AND CAPS.

The claim of letters patent No. 345,965, issued to John C. Goebel, July 20, 1886, for improvements in hats or caps, was for, "in a hat or cap

having a flexible tip, the body or skeleton of the side crown, formed of wire cloth, the ends of which are connected by angular seams." It is also stated that the essential feature of the device "is not only the use of wire cloth," hair cloth having been theretofore used for the purpose, "but also the peculiar cutting of the wire cloth to have its wires in a diagonal line to the edges of the cloth, as else the desired elastic expansion and contraction of the side crown for stretching the tip will not be obtained, and that otherwise the shape of such wire-cloth body cannot be made conical." *Held*, that the patent cannot be held void on demurrer to a bill for its infringement.

3. SAME—INFRINGEMENT—PLEADING—DEMURRER.

The omission, from a bill for infringing a patent, of the averment that the invention had not been patented or described in any printed publication before the date of said invention, is a defect in form which is demurrable.

4. SAME—PRAYER FOR PROCESS.

The omission from the prayer for process of subpoena of the names of some of the defendants named in the introductory part of the bill is a violation of equity rule 23, and is a fatal defect.

In Equity. Suits by John C. Goebel against the American Railway Supply Company and others, and against Philipp Goldmann, for the infringement of complainant's patent. On demurrers to bill. Demurrers sustained in part, and overruled in part.

Thos. F. Byrne, for plaintiff.

Wm. C. Hauff, for defendants.

TOWNSEND, District Judge. These are bills in equity for the alleged infringement of letters patent No. 345,965, issued to complainant July 20, 1886, for improvements in hats and caps. The defendants demur to both bills. The demurrers are the same in each case, with a single exception, which will be separately considered.

The first four grounds of demurrer assigned are that the patent is void on its face for want of patentable novelty, and because the claim does not comprise a combination. That this objection may properly be raised by demurrer is well settled. *Brown v. Piper*, 91 U. S. 43; *Blessing v. Copper Works*, 34 Fed. Rep. 753; *Fougeres v. Murbarger*, 44 Fed. Rep. 292; *Bottle Seal Co. v. De La Vergne Bottle & Seal Co.*, 47 Fed. Rep. 61.

The claim of the patent in suit is as follows:

"In a cap or hat having a flexible tip, the body or skeleton of the side crown formed of wire cloth, the ends of which are connected by angular seams, as set forth."

The defendants urge that the specification and claim show the patent to be for a mere substitution of one well-known material for another, and a connection such as would be made by any skilled operator. The question of patentable novelty, when raised by demurrer, must be determined in favor of the patent, unless the court can see from an examination of the patent itself, and a consideration of those facts alone of which the court will take judicial notice, that the patent does not describe such an advance in the art to which it relates as to constitute invention. *Bottle Seal Co. v. De La Vergne Bottle & Seal Co.*, supra; *Engraving Co. v. Hoke*, 30

Fed. Rep. 444; *Dick v. Supply Co.*, 25 Fed. Rep. 105. In the present case, the patentee does not claim merely the substitution of one material for another. He admits that hair cloth has been used for the crown lining in hats and caps. But he says, further:

"The essential feature of my device, therefore, is not only the use of wire cloth, but also the peculiar cutting of the wire cloth, to have its wires on a diagonal line to the edges of the cloth, as else the desired elastic expansion and contraction of the side crown for stretching the tip will not be obtained, and that otherwise the shape of such wire-cloth body cannot be made conical."

The patentee claims that by the substitution of the new material, so cut that the woven wires are on diagonal lines relative to the band and tip, and are connected by angular seams, certain new and useful results are produced. He further claims that these results are produced by the combination of coacting and co-operating elements.

An examination of the patent, and a consideration of the alleged invention, seem to show that the presumption of patentable novelty arising from the grant of the patent has not been rebutted. The patentee is entitled to the benefit of any doubt which may exist in the mind of the court. Whether, in view of the state of the art, there was any invention, whether the alleged invention consists merely in the substitution of one material for another, and whether, as is strenuously maintained by complainant, its practical utility can be shown by the fact that it has displaced other modes of manufacture, are questions of fact which cannot be disposed of upon this hearing. The first, second, third, fourth, and sixth grounds of demurrer are overruled.

The fifth ground of demurrer assigned is that the complaint does not aver that the invention had not been patented or described in any printed publication before the date of said invention. The omission of this averment is a defect in form which is demurrable. *Coop v. Institute*, 47 Fed. Rep. 899; *Overman Wheel Co. v. Elliott Hickory Cycle Co.*, 49 Fed. Rep. 859.

The seventh ground of demurrer assigned in the case of *Goebel v. American Railway Supply Co. et al.* is that the prayer for process of subpoena does not contain the names of all the defendants named in the introductory part of the bill. This omission is in violation of rule 23, U. S. Eq. Prac., and is a fatal defect. *City of Carlsbad v. Tibbetts*, 51 Fed. Rep. 852.

The fifth ground of demurrer in each case, and the seventh ground of demurrer in *Goebel v. American Railway Supply Co.*, are sustained, with leave to amend in 15 days in both cases, upon payment of costs in *Goebel v. American Railway Supply Co.*

GOEBEL v. AMERICAN RAILWAY SUPPLY CO. et al.

SAME v. GOLDMANN.

(Circuit Court, S. D. New York. May 13, 1893.)

PATENTS FOR INVENTIONS—INFRINGEMENT—PRELIMINARY INJUNCTION.

Letters patent No. 345,965, issued to John C. Goebel July 20, 1886, for an improvement in hats or caps, claimed "in a hat or cap having a flexible tip, the body or skeleton of the side crown, formed of wire cloth, the ends of which are connected by an angular seam." In a suit for infringing this patent defendants produced affidavits that this mode of making hats and caps had been known and used during several years before the date of the patent; and a British patent, granted in 1864, showed metal threads or wires cut obliquely into strips similar to those claimed in the patent. *Held*, that a preliminary injunction would not be granted.

In Equity. On motion for preliminary injunction. Demurrers to the bills were heretofore passed upon. See 55 Fed. Rep. 825.

Thos. F. Byrne, for plaintiff.

Wm. C. Hauff, for defendants.

TOWNSEND, District Judge. These are applications for preliminary injunctions to restrain the alleged infringement of letters patent No. 345,965, granted to complainant July 20, 1886, for an improvement in hats or caps. The defendants have already demurred to the complaints on the ground that the patent in suit is void on its face for want of patentable novelty, and because it does not claim a combination, and said demurrers have been overruled. The claim of said patent is as follows:

"In a cap or hat having a flexible tip, the body or skeleton of the side crown, formed of wire cloth, the ends of which are connected by angular seam, A, as set forth."

The patents and affidavits introduced by defendants as to the state of the art show that complainant's patent is not for a primary or important invention. It is claimed in the affidavits that this mode of making caps was publicly known and used by various persons during several years prior to the date of said patent. The British patent No. 309, of the year 1864, granted to R. A. Brooman, for bonnets and caps, shows metal threads or wires cut obliquely into strips, similar to those claimed in the patent in suit. It does not seem necessary to discuss the various defenses presented on the preliminary hearing, further than to say that they have raised such a doubt in my mind as to the validity of the patent that I think a preliminary injunction should not be granted. The applications are denied.