

PUTNAM, Circuit Judge. If the record in this case is to be opened, I agree with the conclusions of the majority of the court; but, as the patentees have never made any use of their alleged invention, nor attempted to do so, nor permitted its use by others, nor given an explanation of the nonuser, or any reason for it, I doubt whether the case submitted is not one of a mere legal right, and whether the complainant should not be left to its remedy at common law, if entitled to any relief at all.

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PAINE v. TRASK.

(Circuit Court, D. Massachusetts. August 11, 1892.)

No. 2403.

PATENTS FOR INVENTIONS—ASSIGNMENT—EVIDENCE.

In a suit for the infringement of a patent the defense was that complainant had no title, and defendant introduced an assignment thereof by him, duly recorded in the patent office. Complainant alleged that this was a forgery, and the surviving witness to the instrument testified that he had no recollection of signing it. Complainant admitted, however, that he had placed the sale of the patent in the hands of the alleged assignee; that, after a certain difficulty between them, such assignee had said to him that the signature to the assignment was genuine, as he could show by expert witnesses; and that one of the witnesses thereto said to him that he had seen him execute the assignment. Other witnesses testified that complainant had told him he had sold the patent. *Held*, that the evidence was not sufficient to show the assignment invalid, and the bill should be dismissed.

In Equity. Suit by George C. Paine against Henry D. Trask for the infringement of a patent. Bill dismissed. Affirmed in 56 Fed. Rep. 233.

Charles H. Drew, for complainant.  
John L. S. Roberts, for defendant.

COLT, Circuit Judge. This suit is brought for infringement of letters patent No. 182,769, dated October 3, 1876, granted to the complainant for a "new and improved regulator for hot-air furnaces." The first defense set up is the invalidity of complainant's title to the patent. The defendant introduces in evidence a copy of an assignment of the patent, dated October 21, 1879, made to the American Automatic Furnace Regulator Company. This assignment was witnessed by C. C. Dickerman and A. J. Kebler, and was recorded in the patent office, January 22, 1880. He also introduces in evidence a copy of a prior agreement under date of September 12, 1879, by which the complainant agreed to assign to the said Dickerman his patent and all improvements thereof, "the same to be absolutely assigned by said Dickerman or myself to an association or corporation for the manufacture of said articles." This agreement was recorded in the patent office, January 21, 1880. It further appears that in December, 1878, the complainant assigned all right in the patent for certain states and territories to his brother, Henry F.

Paine, which right, however, was on January 31, 1880, conveyed back to the complainant. The complainant denies that he ever executed any assignment except the one to his brother, and says that the agreement to assign to Dickerman and the assignment to the American Automatic Furnace Regulator Company are forgeries. Of the two witnesses to this last instrument Dickerman is dead, and Kebler swears that he has no recollection of signing the paper. It must be remembered, however, that a period of more than 10 years had elapsed between the time of Kebler's testimony and the date of the alleged assignment.

Upon an examination of the whole evidence, I have come to the conclusion that the complainant has failed to show that the assignment was invalid; or, in other words, he has failed to overcome by proper proof the presumption of its validity. The complainant met Dickerman some time before the date of the assignment, and he placed the sale of the patent in his hands. He admits having had many interviews with Dickerman on this subject, and that Dickerman drew several papers in relation thereto. He gave up his place of business on Haverhill street, Boston, and removed to Dickerman's office on Bromfield street. He subsequently quarreled with Dickerman over money matters. He admits that after his separation from Dickerman he met Kebler on the street, and that, in the course of the conversation, Kebler told him that he had made an assignment of the patent to Dickerman, and that he saw him do it. He also testifies to seeing Dickerman subsequent to the alleged assignment, and that Dickerman said that the signature to the assignment was genuine, and that he could get plenty of expert witnesses to testify to that effect. He admits that he had many verbal agreements with Dickerman respecting the sale of the patent, and that Dickerman offered the patent for sale to various persons in his presence. Thomas R. Fitch, employed to sell the patented regulator, testifies to an interview in which complainant stated, in answer to an inquiry for instructions about the business: "You must ask Mr. Dickerman. I am an employe myself." At this interview Dickerman introduced the complainant as the person from whom he had acquired the patent. Dickerman appears to have managed the business, and given all directions in connection therewith. The defendant, Trask, testifies that he had several interviews with the complainant, and that he told him that he had sold the patent to Dickerman. Alvin C. Norcross testifies that he was present at an interview with Dickerman and Paine, and that Dickerman offered to sell the patent for \$500, and that Dickerman was really the American Automatic Furnace Regulator Company.

It is clear to my mind that the facts and circumstances surrounding the dealings between the complainant and Dickerman point to the genuineness of the assignment. The complainant has not overcome this evidence by satisfactory proof, and I must therefore hold that he has failed to show title to the patent in himself, and consequently has no standing in court.

Bill dismissed, with costs.

PAINE v. TRASK.<sup>1</sup>

(Circuit Court of Appeals, First Circuit. April 11, 1893.)

No. 41.

**APPEAL—OBJECTIONS NOT RAISED BELOW—EVIDENCE.**

In a suit for the infringement of a patent, when the defense is that complainant had parted with all his interest therein by assignment before filing his bill, and a copy of the record of such assignment in the patent office is introduced in support thereof, while, perhaps, such copy, if standing alone and seasonably and properly objected to, would be inadmissible, yet the objection that no foundation was laid for the introduction of secondary evidence will not be considered on appeal when it was not raised below.

Appeal from the Circuit Court of the United States for the District of Massachusetts.

Suit by George C. Paine against Henry D. Trask for infringement of a patent. The bill was dismissed, (56 Fed. Rep. 231,) and complainant appeals. Affirmed.

Charles H. Drew, for appellant.

John L. S. Roberts, for appellee.

Before PUTNAM, Circuit Judge, and NELSON and WEBB, District Judges.

PUTNAM, Circuit Judge. This is a bill in equity, brought by the appellant to protect a patent for an alleged improved automatic regulator for hot-air furnaces. With other defenses is that of an alleged assignment from the complainant to the American Automatic Furnace Regulator Company, said to bear date and to have been recorded in the patent office before this bill was filed. The bill alleges that the complainant was sole owner of the patent from the time of its issue to the time of the filing of the bill. The answer does not specifically meet this allegation; but it closes with a general denial. If this is not sufficient to meet the requirements of complainant, the only remedy, according to the practice of the federal courts, is by exceptions under the sixty-first equity rule; and so the lack of a sufficient denial of any allegation in the bill did not relieve the complainant from proving the truth of it. Moreover, in this case the parties have fully gone into the matter of title, and waived any possible question of pleading.

The defendant, now the appellee, did not put in evidence the original alleged assignment, nor sufficiently account for his omission to do so. In lieu thereof he put in a duly-certified copy of the patent-office record of the alleged assignment, and this without objection from the complainant, and without any motion to strike it out. At the hearing in this court the appellee claimed that this certified copy has probative force of itself, and makes out a prima facie case of an assignment. He cited, as sustaining this proposition, *Lee v. Blandy*, 1 Bond, 361, also found in 2 Fish. Pat. Cas. 89. He might also have cited *Brooks v. Jenkins*, 3 McLean, 432; *Parker v. Haworth*, 4 McLean, 370; *Dederick v. Agricultural Co.*, 26 Fed.

<sup>1</sup>Rehearing pending.