

transformation into a square box—were equally possessed by the Wittkorn bags.

It is true that the Deering bag is now a commercial success, millions being used annually, but this is due to the fact that they are made by machinery and are sold at an almost nominal price. Deering had nothing to do with this; the credit belongs to the inventors of the labor saving machines. Deering simply folded paper into a convenient bag. So did Wittkorn. Deering's bag would collapse for transportation and storage and open by a "flip through the air." So would Wittkorn's. If machinery had been invented for the latter it is probable that Deering's bag would no longer have been made by hand. If no machinery had been invented at all it is probable that both would have had a limited local success. The Wittkorn bag, like No. 5, for instance, certainly possesses some merits over the Deering bag which are obvious to the ordinary beholder, but for practical purposes the two are so nearly alike that it is like splitting hairs to attempt to distinguish them. That something magical lurks in the folds of the Deering structure or in the order of their production, that it required the effort of an inspired genius to fold the well-known satchel bottom on the old Wittkorn bags is an argument which surely does not satisfy the judgment, it appeals rather to one who has "listened with credulity to the whispers of fancy." The attempt to avoid the overwhelming force of the Wittkorn exhibits has been able and ingenious, but the conclusion cannot be resisted that the differences between the Wittkorn and Deering methods depend upon such a refinement of reasoning and are of a character so unsubstantial that invention cannot be predicated of them.

The proposition that there is nothing to show that the Wittkorn evidence was newly discovered, cannot, I think, be maintained on the pleadings and proofs. Even were it a question of proof only the testimony has convinced me that the evidence was discovered after the final hearing not only, but that it could not by the exercise of ordinary diligence have been discovered sooner.

It follows that the former decree must be vacated and the complainants' bill dismissed, but without costs.

POHL et al. v. HEYMAN.

SAME v. F. & M. SCHAEFER BREWING CO.

(Circuit Court, S. D. New York. November 20, 1893.)

PATENTS FOR INVENTIONS—EXPIRATION—LAPSE OF FOREIGN PATENT.

The lapsing of an Austrian patent before its full term of 15 years, because of failure to pay the annual tax, does not cause a United States patent for the same invention to expire at that time. *Pohl v. Brewing Co.*, 10 Sup. Ct. Rep. 577, 134 U. S. 381, followed.

In Equity. These were two suits brought by Cari Pohl and Charles Zoller against Nathan H. Heyman and the F. & M. Schaefer Brewing Company for infringement of a patent. Heard on pleas to the jurisdiction. Pleas overruled.

Joseph M. Deuel, for complainants.
Witter & Kenyon, for defendants.

TOWNSEND, District Judge. These are two suits for infringement of letters patent of the United States, No. 213,447, granted March 18, 1879, to Carl Pohl. Defendants plead to the jurisdiction of the court, alleging that the patentee obtained an Austro-Hungarian patent for the same invention on April 19, 1877, for one year, which was prolonged for another term of one year, or until April 19, 1879, when complainants' term expired; that on August 13, 1879, judgment to that effect was duly rendered in the registry of patents in the imperial royal ministry of commerce at Vienna; and that, by reason thereof, said United States patent expired April 19, 1879. It was stipulated that Carpmael's Patent Laws of the World, and a copy of the order of the imperial royal ministry of commerce, and a copy of the letters patent in suit, should be considered as duly proved in the case.

Counsel for the defendants, in his brief, says that the question raised by this plea is whether or not the law of Gramme Electrical Co. v. Arnoux & H. Electric Co., 21 Blatchf. 450, 17 Fed. Rep. 838, is still the law of this circuit. He claims that that case has never been overruled, and that the only decision to the contrary is contained in an obiter dictum in Roller-Mill Co. v. Walker, 43 Fed. Rep. 575. The precise point raised here was raised in said cases. In the latter case the court rendered a decision, on other grounds, for the defendants, and afterwards wrote a further opinion, ruling the point in question for the plaintiffs, in order that it might be taken to the supreme court of the United States. The decision of the supreme court, on the appeal, was put upon other grounds, and no reference was therein made to this particular question. The question, therefore, has been considered, and will be discussed, independently of the opinion in Roller-Mill Co. v. Walker, although such independent consideration has led to the same result.

The order referred to, of the imperial royal ministry of commerce, states that "the longest duration of all privileges granted, without any distinction, is fixed at fifteen years, which longest duration runs uninterruptedly, in so far as the patentee fulfills the conditions mentioned, and that the original duration of fifteen years is due, without any exception, to each Austrian patent which has been granted according to the imperial patent of the 15th August, 1852;" also, in substance, that the patentee need only pay in advance for one year, and that reference to one or more years in a patent has the exclusive purpose to designate that the patent annuity has been paid in advance for one or more years; that the patent is really granted for 15 years, and such payment only prevents its termination before the expiration of the term by reason of the failure to pay the tax; that, to avoid erroneous interpretations in foreign countries, a new form of Austrian patents was adopted in July, 1884, which removes any doubt as to what was the duration of the Austrian patent.

By the terms of said Austro-Hungarian patent, there was granted to Carl Pohl an exclusive privilege for the term of one year, under all conditions and with all operations mentioned in the most high patent of August 15, 1852. The single question raised on the pleadings is whether the United States patent terminated with the expiration of the Austro-Hungarian patent, 32 days after the United States patent was issued. In *Bate Refrigerating Co. v. Hammond Co.*, 129 U. S. 151, 9 Sup. Ct. Rep. 225, it was held that when a foreign patent is granted for a short term, which the patentee as matter of right may have renewed by further payments, and such short term is renewed, the United States patent is not terminated by the expiration of the short term, but that the term of the foreign patent includes such renewals. In *Pohl v. Brewing Co.*, 134 U. S. 381, 10 Sup. Ct. Rep. 577, which was a suit on the patent now in question, defendant pleaded that a German patent granted to the complainants, of September 6, 1877, for 15 years, for the same invention, by reason of the failure of complainants to pay annuities and work the patent, became forfeited in 1880, and the term thereof expired. The court said:

"There is nothing in the statute which admits of the view that the duration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of issuing the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent by means of the operation of a condition subsequent, according to the foreign statute. In saying that 'every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent,' the statute manifestly assumes that the patent previously granted in a foreign country is one granted for a definite term; and its meaning is that the United States patent shall be so limited as to expire at the same time with such term of the foreign patent."

This seems to mean that the term of the United States patent shall be dependent upon something which is fixed and definite in the foreign patent and laws, and shall not be subject to be terminated by the occurrence or nonoccurrence of certain facts which would require extraneous proof. *Bate Refrigerating Co. v. Hammond Co.* establishes, I think, that the term of the Austro-Hungarian patent was 15 years at the time the United States patent was granted, and I think that *Pohl v. Brewing Co.* indicates that the term of the United States patent could not be shortened by failure to pay the tax on the Austro-Hungarian patent.

The difference between a patent for 15 years, liable to be terminated by the nonpayment of the annual tax, and a patent for 1 year, which will be continued for 15 years if the annual tax is paid, seems to me to be a difference of form, and not of substance.

Complainants insist that the construction of the Austrian patent laws which appears in the order of the imperial royal ministry of commerce in Vienna is binding upon this court. The defendants insist that the court is bound to examine into the foreign law itself, and to hold to the contrary of any exposition that is apart from facts. Even if defendants are right in this claim, after having carefully examined the foreign statute, I must hold that the

exposition of it given by the order of the minister of commerce is correct. It seems to me that Gramme Electrical Co. v. Arnoux & H. Electric Co., supra, has been overruled by Bate Refrigerating Co. v. Hammond Co. and Pohl v. Brewing Co., supra.

The pleas of the defendants are overruled, with costs.

BROWN FOLDING MACH. CO. et al. v. STONEMETZ PRINTERS' MACH. CO.

(Circuit Court of Appeals, Third Circuit. November 10, 1893.)

No. 27.

PATENTS FOR INVENTIONS—PRINTING PRESS AND FOLDING MACHINE—CARRYING MECHANISM.

Letters patent No. 343,677, granted June 15, 1886, to John A. Stonemetz for improvements in a mechanism for carrying sheets of paper from a printing press to a folding machine, said improved mechanism being so constructed that it may be folded when not in use upon the folding machine by means of holes in the carrying mechanism which engage with pins on the folding machine, are infringed, as to all the claims, by a device manufactured under letters patent No. 331,762, issued December 8, 1885, to R. T. Brown, for folding such a connecting mechanism upon the folding machine by means of hinges. 57 Fed. Rep. 601, affirmed.

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

In Equity. Bill by the Stonemetz Printers' Machinery Company against the Brown Folding Machine Company and others for infringement of letters patent, and for relief on the ground of interference. A demurrer to the bill was overruled. 46 Fed. Rep. 72. A cross bill was filed, and thereafter stricken from the record. *Id.* 851. There was a final decree for complainant as to infringement, but for defendants as to the interference. See 57 Fed. Rep. 601. Defendants appeal from so much of the decree as is against them. Affirmed.

James K. Hallock, for appellants.

J. C. Sturgeon, for appellee.

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

BUTLER, District Judge. The bill charges infringement of Stonemetz's patent No. 343,677, of June 15, 1886; and also an interference between this patent and two others issued to R. T. Brown (owned by the defendants) on July 14, 1885, and December 8, 1885, respectively, numbered 331,762, and 332,444. The circuit court having sustained the former charge and dismissed the latter, the defendants appealed, and assign as error so much of the decree as is against them.

The only question involved is one of fact: Was Stonemetz first to invent the device covered by his patent? While there is some contention that he was anticipated by others than Brown, the main reliance is on Brown. A careful examination of the evidence