

nated. There is, therefore, nothing remaining for a judgment of this court to act upon. In this condition of the cause the court will no further consider whether the injunction was or was not properly granted, but will dismiss the appeal.

Appeal dismissed; no costs on appeal to either party.

After the foregoing opinion was rendered, a petition for rehearing was filed, but was withdrawn by leave of the court. The court at the same time gave the parties leave to file briefs upon the form of the decree to be entered. Briefs were accordingly submitted, and, after considering the same, the following opinion was rendered:

(March 21, 1894.)

PER CURIAM. It is true that in *Richmond v. Atwood*, 2 C. C. A. 596, 52 Fed. 10, which came before this court on an appeal from an interlocutory decree granting an injunction, the whole case was examined and was disposed of on its merits. But that injunction, it is to be remembered, was granted by the court below upon a final hearing of the case on the full evidence, and this court, in support of its judgment, said: "We must go to the full merits, as shown by the record, in order to determine whether the interlocutory decree for a perpetual injunction is founded in error." It is only when the determination of the question whether the injunction was erroneous so requires us to look into the whole case on its merits that we shall feel disposed to follow the course pursued in *Richmond v. Atwood*. Assignments of error ought to be strictly confined to the subject brought before the appellate court, whether on appeal or by writ of error.

In the case now before us everything has been decided except the form of the decree to be entered. Upon that question the brief of the appellants suggests, if it does not contend, that we should pass upon all the matters in the assignment of errors. In the view of the court, the expiration of the patent ipso facto dissolved or terminated the injunction, and left nothing requiring the interposition of this court. The appeal has been accordingly dismissed. It would have been useless labor to consider the questions which would have required examination and determination after the removal of the subject to which they pertained. The dismissal of the appeal without a qualifying order leaves the case to proceed in the circuit court as if no appeal had ever been taken, and it is enough to enter a decree, "Appeal dismissed."

Mandate according to the decree of January 4, 1894, may issue forthwith.

GERARD v. DIEBOLD SAFE & LOCK CO.

(Circuit Court of Appeals, Fifth Circuit. April 10, 1894.)

No. 60.

1. CONSTRUCTION OF PATENTS—BURGLAR-PROOF SAFES.

It is the duty of the inventor to use language sufficiently plain and explicit to denote clearly what he asks for, and a patent which, following the language of the application, is granted for "an improvement in burglar-
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proof safes," cannot be construed to cover a locking device used in a jail cage. 4 C. C. A. 644, 54 Fed. 889, and 48 Fed. 380, reaffirmed.

2. SAME.

The Gerard patent No. 246,748, for "an improvement in burglar-proof safes," construed, and held not infringed.

This was a suit by Alonzo Gerard against the Diebold Safe & Lock Company for infringement of letters patent No. 246,748, granted September 6, 1881, to complainant for "an improvement in burglar-proof safes." The circuit court dismissed the bill on demurrer (48 Fed. 380), and complainant appealed. On February 20, 1893, this court affirmed the decree (4 C. C. A. 644, 54 Fed. 889), but a rehearing was granted.

Clarence Miller, for appellant.

George F. Ring, for appellee.

Before McCORMICK, Circuit Judge, and LOCKE, District Judge.

LOCKE, District Judge, delivered the opinion of the court.

This appeal has been once heard and decided (4 C. C. A. 644, 54 Fed. 889), and a rehearing granted. Upon such rehearing, and a careful consideration of the argument and examination of the authorities cited, we fail to find any reasons for changing our former conclusion. In every patent the language of the claim, specifications, and grant should be so clear, distinct, and positive as to leave no question of what was asked and granted, nor should it require a careful, nice, and labored investigation to ascertain whether one may not have trespassed upon the rights of the patentee. It is the duty of an inventor to use language sufficiently plain and explicit in his application to denote clearly what he asks for, and where he fails to do so, and the language of the grant follows that of the application, and is thereby misleading to the general public, he should gain no profit from such defective statement of that to which he considers he is entitled. When the language of both application and grant is so positively and directly declaratory of what was asked and granted as we find it in this case, we consider that it would be going beyond a safe rule to extend the operation and protection of the patent further. If appellant had originally made application for an "improvement in a locking device for safes, jails, and other similar structures," which he now insists upon claiming that his invention covers, the public would have had notice of his claim, but the language conveyed no such idea. In *White v. Dunbar*, 119 U. S. 47, 7 Sup. Ct. 72, Mr. Justice Bradley, speaking for the court, says:

"Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specifications, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim, but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as evasion of law, to construe it in a manner different from the plain import of its terms."

This we accept as the correct law by which we must be governed, and we consider that, if we should declare that a peculiarity in a locking device for a jail cage was an improvement in a burglar-proof safe, we should be construing the patent in a manner different from the plain import of its terms, and thereby doing an injustice to the public. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274; *Vance v. Campbell*, 1 Black, 427; *Burns v. Meyer*, 100 U. S. 671; *Railroad Co. v. Mellon*, 104 U. S. 112; *McClain v. Ortmayer*, 141 U. S. 419, 12 Sup. Ct. 76.

Ordered, that the former judgment of this court and the judgment of the court below be affirmed, with costs.

MARSHALL v. PACKARD et al

(Circuit Court of Appeals, First Circuit. March 27, 1894.)

No. 45.

PATENTS—NOVELTY AND INVENTION—LAWN-TENNIS SHOES.

The Marshall patent No. 340,135, for an improvement in shoes, more particularly designed for playing lawn tennis, and having an outer sole of rubber with projections thereon, is void for want of novelty and invention. 51 Fed. 755, affirmed.

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

This was a bill by Howard T. Marshall against Fred. Packard and others for infringement of letters patent No. 340,135, issued April 20, 1886, to complainant. The invention relates to boots and shoes "more particularly designed for use in playing lawn tennis, although capable of use for other purposes." The court below dismissed the bill (51 Fed. 755), and complainant appealed to this court.

The claims of the patent were as follows:

(1) A boot or shoe having an outer sole permanently secured to the upper and inner sole, and its outer or treading surface made of India rubber, or any of its compounds, and provided with independent projections integral with said rubber, and severally separated from each other, and with the surface of the sole exposed between and around them, substantially as described, and for the purpose specified. (2) A boot or shoe having an outer sole permanently secured to the upper and inner sole, and its outer or treading surface made of India rubber, or any of its compounds, and provided with independent projections integral with said rubber of conoidal, and in planes parallel with said outer surface of circular or substantially circular, form, and severally separated from each other, and with the surface of the sole exposed between and around them, substantially as described, and for the purpose specified.

James E. Maynadier, for appellant.

George R. Blodgett and Edward M. Bentley, for appellees.

Before COLT, Circuit Judge, and WEBB and CARPENTER, District Judges.

WEBB, District Judge. Among the errors assigned is that the circuit court, in disposing of this suit, held the claims of the patent to be for a shoe sole, instead of for a shoe with a peculiarly con-