

increased, they, by fusing, break the circuit, and thus operate to secure immunity from the danger which otherwise would arise from the passage of the abnormal current beyond the point of their insertion. In addition to the fusible strip, all automatic cut-offs comprise certain other requisite features in common; but it is not necessary to describe them.

Each of the claims involved in this case is for a combination of physical parts constituting an integral organism, and, of each of them, terminals provided with lateral supports are an essential element. As to whether the defendants' arrangement embodies this element, the experts broadly differ. Having considered their testimony with care, and having also closely examined and compared the respective devices for myself, I have reached the conclusion that that of the defendants is, at least as to the element especially mentioned, materially different in structure from that of the plaintiff; and, furthermore, I am convinced of the pertinency and soundness of the point made by the learned counsel for the defendants:

"That each terminal of each pair of terminals of the Shapleigh patent is an electrical device embodying lateral supports, and must necessarily so be, whereas but one terminal, at most, of each pair of defendants' terminals, is or need be an electrical terminal embodying lateral supports, and that, therefore, * * * defendants' device does not infringe the specific combination of the claims of complainant's patent."

Upon the ground that infringement of the plaintiff's patent by the defendants has not been shown, the bill is dismissed, with costs.

JOHNSON v. OLSEN.

(Circuit Court, D. Indiana. May 29, 1894.)

No. 8,782.

1. PATENTS—LIMITATION OF CLAIMS—REJECTION AND ACQUIESCENCE.

The principle that an inventor who acquiesces in the rejection of a claim is estopped from insisting upon such a construction of the claims allowed as would be equivalent to what was rejected, applies when the rejected claim is narrower, as well as when it is broader, than those allowed. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 14 Sup. Ct. 627, followed.

2. SAME—INVENTION—EXCELSIOR MACHINES.

The use of lugs to prevent lateral movement having been long known and practiced, their adaptation to an excelsior machine, to prevent lateral movement of the sliding plate, involves no invention.

3. SAME.

Wooden bearings for excelsior machines being old, there is no invention in placing the wood so that the grain will run vertically with the line of motion, instead of at right angles thereto.

4. SAME.

The Johnson patent No. 452,553, for improvements for excelsior machines, is void for want of novelty and invention.

This was a suit by Jesse B. Johnson against Olaf R. Olsen for infringement of a patent for improvements in excelsior machines.

V. H. Lockwood, for complainant.
Chester Bradford, for defendant.

BAKER, District Judge. This is a suit in equity for an injunction, and for the recovery of damages for the infringement of letters patent of the United States No. 452,553, issued May 19, 1891, to the complainant, on improvements in excelsior machines. The defendant has interposed as grounds of defense: license, invention of the machine by defendant, abandonment, two years' prior use, that the claims are for aggregations, lack of novelty, and lack of invention. The defendant's contention—and the only one which the court deems it necessary to pass upon—is that the complainant's patent is void for lack of novelty and lack of invention. The object of the invention is to enable upright excelsior machines to cut a larger quantity of long, unbroken, hair-like fibers from wood than prior machines had been able to cut, and to produce a machine which could be operated more cheaply, while it would last longer, and need less repairs. The claims as finally allowed, and the claims originally made and rejected, and afterwards canceled by complainant, and also the various amendments which appear in the record of the application on which the patent was granted, are as follows:

- Jan. 23, '91.* 1. In an excelsior machine a framework, a driving mechanism carried thereon, a reciprocating frame carrying knives connected to such driving mechanism, a pair of corrugated rolls to hold the block of wood in place. the lower roll journaled in boxing, upon the uprights, ^{movable vertically upon a recessed bed-plate bolted to the frame} the upper journaled on a movable sliding plate, and ^{to such sliding plate} springs connected ^{therewith} whose tension holds the upper roll in contact with the wood, all combined substantially as shown and described.
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- Dec. 15, '90.* 1. In an excelsior machine a framework, driving mechanism carried therein, reciprocating knives connected to the driving mechanism, a pair of corrugated rolls for holding the block of wood, the upper connected to a sliding plate, a pair of springs connected to such sliding plate, for holding the upper roll in contact with ^{recessed} the wood, the sliding plate moving vertically upon a bed plate having lugs to prevent any lateral movement of the ^{and its central part recessed as shown} slide and crank and gear mechanism connected to such ^{sliding plate} sliding plate for lifting the same, all combined substantially as shown and described.

Jan. 23, '91. 3. In an excelsior machine a framework, driving mechanism carried thereon, reciprocating knives connected to the driving mechanism, a pair of corrugated rolls for receiving and holding the block of wood to be operated upon, the lower one journalled in boxings upon the up-rights of the frame, the upper one journalled in boxings

Dec. 15, '90. ~~sliding upon a recessed bed-plate bolted to the frame~~
upon a sliding plate, springs connected to such sliding plate for holding the upper roll in contact with the wood, pinions connected to the shaft of such roll, a vertical shaft connected to and revoluble by the main shaft provided with worms engaging with gears on the corrugated rolls and so disposed that the upper and lower rolls revolve in opposite directions for holding the block of wood and feeding it to the knives, all combined substantially as shown and described.

2. In an excelsior machine a framework, driving mechanism carried in bearings thereon, a vertically reciprocating slide frame carrying scoring and shaving knives connected to such driving mechanism, a pair of corrugated rolls for gripping and feeding the wood to the knives, the lower one journalled in boxings on the framework, the upper one journalled in bearings on a sliding plate, springs connected to such plate for holding the upper roll in contact with the wood, such

Dec. 15, '90. ~~its central point recessed and~~ recessed

Nov. 28, '90. sliding plate moving vertically in bed plates let into
and
the framework provided with lugs for preventing the lateral movement of the slide, all combined substantially as shown and described.

Erase and insert A.
Nov. 28, '90. 5. In an excelsior machine the bed plate (8), the central portion set in and its ends provided with lugs, substantially as and for the purpose described.

4. 3. In an excelsior machine the bed plate (8), its central portion recessed and let into the upright of the frame, its ends provided with lugs, in combination with a sliding plate (5) and an upper corrugated roll journalled therein, substantially as shown and described.

Nov. 28, '90. 4. ~~8.~~ In an excelsior machine the sliding plate (5) having a rack-bar at its upper end and a slot (11) at its lower end secured to the upright (f) of the frame by a countersunk bolt (9) and a lower bolt (10), such plate sliding upon a bed plate (8) having its central part set back and lugs (1) upon its upper and lower ends, and having a boss (26), in combination with springs (2) connected to the sliding plate, substantially as shown and described.

Jan. 23, '91. 7. In an excelsior machine a pair of corrugated rolls for gripping a block of wood, the lower one journalled in bearings on the framework, the upper one journalled in bearings on a plate sliding vertically upon the framework, in combination with springs connected to such slide for holding the upper roll against the block of wood, the shafts of such rolls provided with pinions which engage with worms upon a vertical rod driven from the main shaft, whereby the upper and lower rolls are revolvable in opposite directions for gripping the wood and feeding it to the knives, all combined substantially as shown and described.

Dec. 15, '90. ~~a recessed bed-plate bolted to~~

5. ~~8.~~ In an excelsior machine a framework, plates connected to the sides thereof, auxilliary plates adjustably connected to such side plates, wooden backings connected to lugs, one to the adjustable plate and the other to the stationary plate, and set with the grain of the wood vertically and at such a distance as to permit the passage of the knives between such wooden backings, all combined substantially as shown and described.

6. ~~8.~~ In an excelsior machine a framework, driving mechanism carried thereon, a vertically reciprocating slide frame carrying scoring and shaving knives connected to such driving mechanism, such slide frame provided with wooden backings, the grain of the wood being vertical on either side, metal plates connected to the side of the framework, and means for adjusting the same to compensate for the wear of the parts during the operation of the machine, all combined substantially as shown and described.

An analysis and comparison of the rejected and canceled claim 1 of the application, and the original claim 2 of the application, which became claim 1 of the patent, will show that the only ma-

terial difference between them is in the addition of lugs to the bed plate, and the crank and gear mechanism for operating the sliding plate in the claim allowed. Claim 1 of the application was rejected by the examiner on the distinct ground that it had been anticipated in former patents, American, English, and German. This decision of the examiner was acquiesced in by the complainant, and the rejected claim was canceled. The patentee having once presented his claim in that form, and the patent office having rejected it, and he having acquiesced in that rejection, is, under the repeated decisions of the supreme court, now estopped to claim the benefit of his rejected claim, or such a construction of his present claims as would be equivalent thereto. *Leggett v. Avery*, 101 U. S. 256; *Shepard v. Carrigan*, 116 U. S. 593, 6 Sup. Ct. 493; *Crawford v. Heysinger*, 123 U. S. 589, 8 Sup. Ct. 399; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 5 Sup. Ct. 475.

It is true that these were cases where the original claim was broader than the one allowed, but the principle is the same if the rejected claim is narrower. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 14 Sup. Ct. 627. Why the claims 1 to 4, inclusive, of the present patent were allowed after the rejection of claims 1, 3, 5, and 7 of the original application does not appear. The objections made to the claims as originally presented seem to be equally applicable to those allowed. The crank and gear mechanism for operating the sliding plate are old and familiar, and no novelty is shown in their combination or use. The lugs to prevent lateral movement of the sliding plate are made an element in the first four claims of the patent, and it would seem that they constituted the feature which was regarded by the examiner as distinguishing these four claims from the prior art. The use of lugs to prevent lateral movement has been long known and practiced, and, even if this were not so, their application by the patentee as shown and described in his patent would not constitute invention. If lugs had not been previously used in excelsior machines, their use would have been readily suggested to a skillful mechanic familiar with such machines.

If the springs connected with the sliding plate for holding the upper roll in contact with the wood were not the mechanical equivalent of the weights formerly in use to accomplish the same purpose (and I am inclined to think they are), still the springs were an essential part of the rejected claims, and, having acquiesced in their rejection, the complainant is now estopped to ask for such a construction of his present claims as would give him the benefit of his rejected claims.

Claims 5 and 6 are in all their essential features old and well known, and conceded to be, except that the wooden linings in the slides are arranged with the grain of the wood running vertically with the line of motion. Wooden bearings, wooden linings for bearings, and wooden slides for bearings are all old and well-known devices. Wooden bearings for excelsior machines were known and in use prior to complainant's alleged invention, differ-

ing from it in no important particular except that the grain of the wood was placed at right angles with the line of motion. This change, in my opinion, does not constitute invention.

In view of what has already been said, I do not deem it necessary to express any opinion upon the other grounds of defense. The bill will be dismissed for want of equity, at complainant's cost.

ELECTRIC MANUF'G CO. et al. v. EDISON ELECTRIC LIGHT CO. et al.

(Circuit Court of Appeals, Seventh Circuit. May 1, 1894.)

No. 135.

1. PATENTS FOR INVENTIONS—ACTION FOR INFRINGEMENT—INJUNCTION.

Where a patent has been sustained after protracted and expensive litigation, the right of the owner to a preliminary injunction against a new infringer can be defeated only by a new defense, which is sustained by such convincing proof as to raise a presumption that it would have defeated the patent if produced at the original trial, and every reasonable doubt should be resolved against the new defense. 57 Fed. 616, affirmed.

2. SAME—ELECTRIC LIGHTS.

On a motion for a preliminary injunction against the infringement of letters patent No. 223,898, issued January 27, 1880, to Thomas A. Edison, for an improved electric lamp, there were ex parte proofs of an alleged anticipation by Henry Goebel in 1854, and subsequently. *Held*, that these were insufficient to overcome the effect of the adjudications sustaining the patent, because of the improbability of Goebel's making so important a discovery without its becoming generally known, and without his obtaining a patent for it. 57 Fed. 616, affirmed.

Appeal from the Circuit Court of the United States for the Eastern District of Wisconsin.

Suit by the Edison Electric Light Company and the Edison General Electric Company against the Electric Manufacturing Company, T. A. Pamperin, Julius B. Grunert, and George Beyer to restrain the infringement of a patent. Defendants appeal from an order granting a preliminary injunction.

The appellees filed their bill in the court below to restrain the infringement by the appellants here of the second claim of letters patent No. 223,898, issued to Thomas A. Edison, January 27, 1880, for improvements in electric lamps, which claim is as follows: "The combination of carbon filaments with a receiver made entirely of glass, and conductors passing through the glass, and from which receiver the air is exhausted, for the purposes set forth." By the original answer, the defendants below conceded that they had infringed the second claim as it had been construed by the courts, but afterwards, by amendment, denied infringement, substantially upon the ground that, by the proper and narrower construction which they insisted should be given to the claim by reason of the prior state of the art, founded upon an alleged prior invention by one Goebel, not considered in the prior litigation, the defendants' lamp should not be construed as infringing upon the patented rights of the appellees. The patent itself was also attacked upon the ground of the alleged prior invention of Goebel. The court below, upon a hearing, granted an injunction pendente lite, from which order this appeal is prosecuted. The case below is reported in 57 Fed. 616, where the facts are sufficiently stated for the disposition of the case here.

W. H. Webster (Wm. H. Kenyon, John J. Herrick, Allan D. Kenyon, and A. P. Smith, of counsel), for appellants.