shown by the patent to Selden and Griswold, was a notable step in advance,—a marked improvement; and, to those who made it, we think the quality of inventors ought not to be denied. Thomson v. Bank, 10 U. S. App. 512, 3 C. C. A. 518, 53 Fed. 250; Loom Co. v. Higgins, 105 U. S. 580, 591; Consolidated Safety-Valve Co. v. Crosby Steam-Gauge & Valve Co., 113 U. S. 157, 179, 5 Sup. Ct. 513; Magowan v. Packing Co., 141 U. S. 332, 341, 343, 12 Sup. Ct. 71; The Barbed-Wire Patent, 143 U. S. 275, 281, 283, 12 Sup. Ct. 443, 450.

This view is confirmed by the facts that the patent in suit was dated June 29, 1880; that one or both the patentees have ever since been continuously manufacturing and successfully selling the irons constructed under this patent; that one of the appellees was a partner for several years in a firm which purchased these irons of one or both of the patentees; and that we now find him and his partner manufacturing and selling, not the hingeless utensils shown by the patents they plead, nor the old waffle iron, without handles, and with its hinge on one side of the pan relatively to its pivots, but an iron which embodies the very improvements of the patentees, with the exception of the mere colorable evasion of making the hinge itself the journal, in place of inserting the journal in the hinge. Actions often speak louder, and frequently more truthfully, than words. It is not impossible that the reason why the appellees are not using the old devices they plead is that the improvements described in this patent have made them useless and unmerchantable. If this is not so, they can abandon the improvements of Selden and Griswold, and go back to the devices they plead.

In our opinion the first and second claims of the patent in suit are neither anticipated nor restricted by the prior state of the art, nor by the patents pleaded in the answer, and the appellees are infringers of them.

The decree below is reversed, with costs, and the cause remanded, with directions to enter a decree in favor of the appellant for a perpetual injunction, damages, and costs.

LE FAVOUR v. RICE.

(Circuit Court of Appeals, First Circuit. April 26, 1894.)

No. 74.

1. PATENTS—LIMITATION OF CLAIM—BOOT AND SHOE SHANKS.
   In a patent claiming a boot and shoe shank, made of leather and steel, secured together by rivets, the specification stated that steel shanks were well known, but were objectionable, because almost certain to cut the parts against which they bear. *Held*, that the patent covered only a shank composed of two parts,—leather and steel, or their equivalents.

2. SAME.
   The Rice patent, No. 68,652, for a boot and shoe shank, construed as limited by reference to the specification, and *held* not infringed.

In Error to the Circuit Court of the United States for the District of Massachusetts.

This was an action by Caroline A. Rice, guardian, against Joseph W. Le Favour, for infringement of a patent. The circuit court rendered judgment for plaintiff. Defendant brought error.

Frederick P. Fish and William K. Richardson, for plaintiff in error.

Almon A. Strout and Frank L. Washburn, for defendant in error.

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

COLT, Circuit Judge. The subject-matter of this suit is a patent granted to Andrew Jacob Rice and Andrew James Rice, September 10, 1867, for an improved boot and shoe shank. The improvement consisted in making the shank of leather and steel, secured together by rivets. The specification declares:

"We make our shank in two parts, A and B. The part A is made in the desired shape for the shank, and the part B is made to fit upon it, and the two parts are then secured to each other in any convenient manner. We make the part A of leather, or any similar material possessing the requisite strength and pliability. * * * The part B we make of metal, as its only purpose is to strengthen the shank, and prevent it from getting out of shape. * * * Shanks of steel, leather, and other material are well known, but they are all liable to various objections. Steel shanks, though they are not liable to break, and retain their shape well, are almost certain, when the boot or shoe is worn, to cut the parts against which they bear, and all other shanks known to us are apt to break or get out of shape."

The claim is for a shank as an article of manufacture, made of leather and steel, secured together by rivets.

By the seventh assignment of error, the court refused to instruct the jury, at defendant's request, as follows:

"That, if the jury find that the defendant did not use in his shoes a shank made as an article of manufacture, of leather and steel, or equivalent materials, secured together by rivets, or equivalent means, the verdict must be for defendant."

The defendant's shank was made of a single piece of steel. It is clear to us that the patent can only be construed to cover a shank composed of leather and steel, or their equivalents. A construction which would so enlarge the patent as to embrace a shank made entirely of steel would be in violation of the express language of the specification, wherein it is stated that steel shanks were well known, and were open to the objection of cutting the parts of the leather against which they bore. There was also introduced in evidence several prior patents for different forms of steel shanks. We think the court, as requested by the defendant, should have charged the jury that the patent was for a shank composed of two parts,—namely, leather and steel, or their equivalents,—fastened together, and that, if the defendant did not use a shank so constructed, he was entitled to a verdict. As to the alleged waiver of this request by agreement of counsel, except so far as it was embraced in the judge's charge, we do not think the bill of exceptions supports the position of the plaintiff, now defendant in error. At most, the

waiver only extended to the question of anticipation, and it did not embrace the question of the legal construction of the patent.

For these reasons, the judgment of the circuit court is reversed, and this cause is remanded to that court, with directions to grant a new trial.

SHIPMAN ENGINE CO. v. McLAUGHLIN.

(Circuit Court, D. Massachusetts. June 28, 1894.)

No. 2,889.

PATENTS—LIMITATION OF CLAIM—HYDROCARBON FURNACES.

The Shipman patent, No. 304,365, for improvements in hydrocarbon furnaces, in view of its construction in the case of Shipman Engine Co. v. Rochester Tool Works, 34 Fed. 747, the language of its specifications, and the proceedings in the patent office, must be limited, in a suit where the parties and the evidence are substantially the same, as to both its first and second claims, to a structure in which the oil is drawn upward from the reservoir to the atomizing jet by suction, and an apparatus in which the oil is fed from the reservoir to the atomizing jet by gravity is not within the patent.

This was a suit by the Shipman Engine Company against George G. McLaughlin for infringement of a patent.

Samuel J. Elder and E. A. Whitman, for complainant.
Charles E. Mitchell and Josiah Sullivan, for defendant.

COLT, Circuit Judge. This suit is for infringement of letters patent No. 304,365, granted Albert H. Shipman, for improvements in hydrocarbon furnaces.

In the case of This Complainant v. Rochester Tool Works, 34 Fed. 747, the same patent was before Judge Wallace. The evidence in the two cases is substantially the same, and the parties are really the same, though the nominal defendant in the present suit is different. In legal effect, this suit stands as if it were a proceeding in the nature of contempt, brought against the Rochester Tool Company in the original suit, or a new bill brought against that company by the complainant. Judge Wallace held that the Shipman patent possessed patentable novelty, and that the defendant infringed the second claim. In the apparatus which was found to infringe this claim, the oil reservoir was located below the atomizer, and the oil was drawn upward by suction from the reservoir. After that decision the defendant, under the advice of counsel, made certain changes in the construction of its furnace, by locating the oil reservoir above the atomizer, and by inserting a stop valve in the oil pipe. The question in this case is whether this apparatus infringes the first claim of the patent. This claim does not describe the oil reservoir as located below the atomizer, and the oil drawn upward therefrom, and is therefore broader in its language than the second claim.

The solution of this question turns upon Judge Wallace's construction of the patent, the language of the patent itself, and the file wrapper and contents Judge Wallace held that Shipman was

not a pioneer in the art of utilizing liquid fuel as a substitute for coal for producing heat or steam; that he only assumes to have invented certain improvements in hydrocarbon furnaces for use under a steam boiler; that his apparatus consisted of a "combination of parts, each of which was old and well-known when he took up the subject, several of which had previously been used in such burners to perform in combination the functions they performed in his apparatus, but all of which had never before been combined together in the same apparatus." He further held that the invention of Shipman resided in his valve or regulator in the steam pipe, by means of which the flow of oil is controlled by the steam suction which is automatically regulated by the valve; that this regulator performed a new function, in that it dispensed with an additional valve in the oil pipe which existed in prior furnaces. The old burners described in the Caldwell, Burbank, and Kite patents belong to the Shipman type, where the oil reservoir is located below the atomizer, and the oil is drawn up by suction; and Judge Wallace declares that these burners contain the combination found in the Shipman patent, with the exception of the regulator. The Dickerson patent, which belongs to the other type of burners, where the oil reservoir is placed above the atomizer, and the oil is fed to the atomizing jet by gravity, Judge Wallace decided, did not anticipate Shipman, because the oil is not obtained by suction, but by gravity, and because the regulator is required to be applied to the oil pipe as well as the steam pipe; in other words, the Dickerson apparatus contains a separate valve in each pipe, and the supply of oil is regulated by the valve in the oil pipe.

From a careful perusal of Judge Wallace's opinion, I think the Shipman patent must be limited to that class of hydrocarbon burners in which the oil is drawn upward by means of suction from a reservoir located below the atomizer.

This construction of the patent is confirmed by the language of the specification which says, "From the reservoir, Q, the liquid fuel is drawn upward through the pipe or oil conduit."

This construction is further confirmed by what took place in the patent office. The first claim of the patent on which the complainant now relies was twice rejected on reference to the Dickerson patent, whereupon Shipman writes as follows to the commissioner of patents:

"In the Dickerson invention the naphtha 'flows' to the burner, while in applicant's the fluid is raised to the jets by the action of the steam; and hence the supply of naphtha requires to be regulated by a cock operated by an attendant, in the one case, while in applicant's apparatus no liquid is delivered from the oil reservoir to the combustion devices, except when the steam is being discharged from its jet."

It is also significant that Shipman changed the words "fed upward," in his original application, to "drawn upward," as now found in his specification.

In view of these considerations, I think that the first claim of the Shipman patent, although broader in its language than the second claim, is limited to a structure in which the oil is drawn

upward from the reservoir to the atomizing jet by suction, and that an apparatus in which the oil is fed from the reservoir to the atomizing jet by gravity is not within the patent, and therefore cannot infringe it.

In an apparatus where the oil is fed by gravity, the oil pipe must, of necessity, contain some form of valve or regulator, in order to stop the flow of oil when the burner is not in operation. The defendant's apparatus has a stop valve in the oil pipe which opens when the steam reaches a certain pressure, and which closes when that pressure is reduced to a certain point; and the opening of the stop valve permits the oil to flow to the atomizing jet, and the closing of the valve prevents its further flow. In this respect it differs in construction and mode of operation from the Shipman device.

It may be true, as contended by the complainant, that, after the oil has reached the atomizing jet, its discharge, when the apparatus is in operation, is regulated, in part at least, by the steam pressure in the steam pipe, and that to this extent it resembles the Shipman burner, and differs from the Dickerson burner. Admitting this to be so, I do not think this circumstance brings the defendant's burner within any fair or legitimate construction of the Shipman patent.

Bill dismissed.

EDISON ELECTRIC LIGHT CO. et al. v. BOSTON INCANDESCENT LAMP CO. et al.

(Circuit Court, D. Massachusetts. June 11, 1894.)

No. 3,246.

PATENTS—LIMITATION OF CLAIM — INFRINGEMENT — INCANDESCENT ELECTRIC LAMPS.

In the Edison incandescent lamp patent, No. 223,898, claim 2, for the combination of carbon filaments with a glass receiver, from which the air is exhausted, and conductors passing through the glass, is not to be limited to the conductors of platinum wire pointed out in the specification, and employed in practice, for the patent covers a pioneer invention, and the elements of the combination other than the carbon filament are subordinate; and therefore the claim is infringed by a lamp, constructed under the Pollard patent of 1892, containing all the elements of the combination, but using conductors of powdered silver, although powdered silver was not a known substitute for platinum in the combination at the date of the Edison patent.

This was a suit by the Edison Electric Light Company and others against the Boston Incandescent Lamp Company and others. Complainants moved for a preliminary injunction.

Fish, Richardson & Storrow, for complainants.

John Lowell and John Lowell, Jr., for defendants.

COLT, Circuit Judge. The second claim of the Edison incandescent lamp patent (No. 223,898) is for "the combination of carbon