

11. The administration of estates is strictly local, but this suit is not any part of such administration. The plaintiff, by becoming administratrix, became the person to whom the right of action was given. The administration merely designated the person; the statute gives the right of recovery. A mortgage of land in New York authorized the mortgagee, of Vermont, his executors, administrators, or assigns, to sell; a sale by any executor in Vermont was good, because the letters there merely designated the person to execute the power. *Doolittle v. Lewis*, 7 Johns. Ch. 45. An administrator in another jurisdiction would have the right to sue there, under this statute, when there was no administrator in New Jersey. *Dennick v. Railroad Co.*, supra. But this does not show that an administrator in New Jersey, who had acquired the right of recovery, might not sue elsewhere. In that case, Mr. Justice Miller, in delivering the opinion of the court, said:

"Whenever, by either the common law or the statute law of a state, a right of action has become fixed, and a legal liability incurred, that liability may be enforced, and the right of action pursued, in any court which has jurisdiction of such matters, and can obtain jurisdiction of the parties."

The same right exists as to any cause of action accruing to an administrator concerning even assets of the estate.

"So, too, where the title to property in possession, and even in choses in action of a negotiable character, becomes perfected, under the administration, in one state or country, any action requisite to vindicate and enforce such title may be maintained without recourse to any local administration." 2 Redf. Wills, c. 1, § 2.

After the plaintiff had become administratrix in New Jersey, and this cause of action had accrued to her there, it could not again accrue to any other administrator elsewhere; and she would be the only person who could sue upon it anywhere. As the requisite diversity of citizenship exists, she is entitled to sue in this court.

Demurrer overruled, with leave to withdraw it, and answer over by August rule day.

THE DRESDEN.

UNITUS et ux. v. THE DRESDEN.

(District Court, D. Maryland. July 10, 1894.)

1. NEGLIGENCE—INDEPENDENT CONTRACTORS — LOADING PASSENGERS' BAGGAGE ON SHIP.

Stevedores bringing passengers' baggage on board a steamship, and placing it where requested by passengers for their convenience, are not exercising an independent employment, but are performing a duty which rests on the ship, and it is the duty of the ship's officers to see that risk of accident to persons on board is avoided.

2. SAME.

The use, for lowering baggage into a steamship, of the same companion way used by passengers and their friends in passing up and down, where the ship has more than one that could be so used, is want of care for which

the ship is liable to such a person injured by the fall of a trunk, caused by its handle breaking while being so lowered.

This was a libel by Matthew Unitus and Aggie Unitus, his wife, against the steamship Dresden for personal injuries.

William Colton, for libellants.

Thomas W. Hall, for respondent.

MORRIS, District Judge. The libellant, Aggie Unitus, went aboard the steamship Dresden just before her hour of sailing from Baltimore for Bremen, to bid good-bye to a friend who was about to make a voyage on her as a steerage passenger. The libellant, by request of her friend, had brought her some clothing and some food for the voyage. They, together with two other friends, went below, to place the articles in the steerage, and were returning up one of the forward companion ways to the deck, when the libellant was struck by a trunk which had fallen down the companion way. She was knocked down and injured, and she now seeks compensation by this libel in rem against the steamship.

It is not denied that friends of passengers about to sail were permitted to be aboard, and that, if the libellant was injured through the negligence of those in charge of the steamer, she can maintain this libel. The testimony on behalf of the steamship tends to prove that the trunk was being carried from the wharf to the steerage by a stevedore, and that he had it on the top step of the companion way, waiting for two stevedores who were below to come and take it from him, when the top strap or handle by which he was holding it broke, and it fell against the libellant, who had just started up the steps.

The proof on behalf of the steamer establishes that the loading of the steamer, both as to her cargo and the baggage of her passengers, was not attended to by her seamen, but was done by a firm of stevedores under a contract. By the contract the firm of stevedores was paid a certain rate per ton for the cargo, and for handling the baggage was paid a certain rate per day for each man furnished. It is contended under these circumstances that for the negligence of the stevedore which caused the accident the stevedore who made the contract could be held liable, and, it not being the act of any of the ship's employes, the ship is not liable. It is quite true that when stevedores have made a contract to load or unload a ship, and are exercising a well-known, distinct, and independent employment, and are not under the immediate supervision and control of those in charge of the ship, it has been held that they are contractors, and are not employes, and that the ship is not liable. *Linton v. Smith*, 8 Gray, 147. But in handling the baggage of passengers, bringing it on board from the wharf, and placing it in the steerage berth compartment, where the passengers may request to have it placed so as to be convenient for their use during the voyage, in doing such acts as these the stevedores are not exercising an independent employment. They are performing a duty to the passengers which rests upon the ship. It is of a personal

kind, requiring the supervision of the ship's officers. It is the duty of the ship's officers to see it so performed that risk of accident to persons on board is avoided.

In this case there were two or three companion ways to the steerage, which could be used, and it would seem to have been want of care not to prevent the stevedores from using the same one for lowering baggage which was being used by the passengers and their friends in passing up and down. I think the steamship is liable.

As to the extent of the libellant's injury, the testimony is very conflicting, and the court has not had the benefit of some testimony which the libellant could have obtained, and which would have been of weight. The appearance of the libellant indicates that she is in good health, but she complains of pains in her head, and general nervous disturbance. The fact that in a day or two after the accident a suit was entered claiming large damages for permanent injuries, which could not then have been more than apprehended, indicates some disposition to exaggerate the damages. The libellant speaks only the Polish language, and it is difficult to question her precisely as to her sufferings. A physician who examined her for the purpose of testifying in her behalf at this trial considers her general health as seriously affected, but a physician to whose office she went just after she came off the ship, and who visited her twice afterwards, makes very light of her injury. I shall award \$750.

TEXAS & P. RY. CO. v. WILLIAMS.

(Circuit Court of Appeals, Fifth Circuit. April 24, 1894.)

No. 175.

1. MASTER AND SERVANT—ASSAULT BY RAILWAY CONDUCTOR—SCOPE OF EMPLOYMENT.

In an action against a railway company for an assault committed by its conductor, there is no question to be submitted to the jury as to whether such conductor was acting beyond the scope of his employment, when his own testimony shows that such assault was committed in resenting an insult which he had provoked by his language and conduct while acting as conductor.

2. SAME—PLEADING AND PROOF.

Under allegations that plaintiff was knocked and kicked from defendant's railway train by its conductor, he may recover on proof that the conductor alarmed him to such an extent that he jumped off the train; forcing him off the train in an unlawful manner being the gravamen of the complaint.

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

This was a suit for personal injuries, brought by Louis Williams, defendant in error, against the plaintiff in error, in which he alleged that he was a section hand in the service of plaintiff in error, and while riding on one of the regular passenger trains from Dallas to his place of work, by permission of the road master, he was assaulted and beaten and kicked from the train by the company's conductor in charge. The case being removed from the state

court where it was commenced to the circuit court of the United States for the northern district of Texas, and brought to trial, the jury found a verdict for the plaintiff in the sum of \$1,562, damages.

The facts of the case, as testified to by the conductor and found in the record, as far as necessary to decide the questions arising herein, are these: Williams, the plaintiff below, upon being found without a ticket in a car of one of defendant's trains soon after leaving Dallas, was asked for his fare, and replied that he was being passed down on the train by the road master, who was on board. The conductor, Nicely, made inquiry of the road master, pointing out Williams to him, but the road master denied having given Williams any permission to ride free. Upon this the conductor again demanded the fare, telling Williams that he would have to pay, when Williams replied that he had no money, and could not pay his fare, whereupon the conductor told him to get out at the next stop, and stay off. The language of Nicely, the conductor, in testifying in regard to the subsequent assault, is: "We got to talking then, and finally he intimated that the road master had lied. I told him not to call the road master a liar, and he rather intimated that I was lying myself. He said, if the road master said he did not tell him to get on, he lied. I told him not to call me a liar, and he intimated that, if I or any one else said the road master did not tell him to get on there, they lied. I struck him three or four times with my left hand, and may have hit him once or twice with my right hand, but my right arm was in a bad condition, and I could not use it well." After this the testimony shows that Williams declared that he would not stand it, getting up from his seat. The conductor, knowing Williams to be a much larger and more powerful man than he, took a knife from his pocket, and told him he would have to stand it, for, if he put his hand on him, he would cut his throat. At this Williams rushed through the door, out upon the platform, and jumped from the moving train. Upon cross-examination, Nicely explains more fully what occurred at the time when, in his direct examination, he states, "We got to talking." He says: "When I went back in there, after talking to the road master, I do not remember the exact words that passed between us. I may have said he was a damned lie. I do not know that I told him in addition that he was a d—d black son of a bitch. It is not a fact that I did not say anything about fare when I went back there after talking to the road master. I asked him for his fare, and gave him all the opportunities a man wanted to pay it. He told me he did not have any money. * * * As to whether I cursed him before he insulted me, I may have used some strong language in talking to him. Sometimes I swear, and I may have sworn on this occasion, but, after I struck him, there was not much said." The testimony on behalf of the plaintiff is not in the record, but, in the bill of exceptions, it is admitted that it "tended strongly to sustain all the allegations in his petition."

Upon the trial, the charge of the court in which it is claimed the court erred was: "If plaintiff was a trespasser on defendant's train, and had no right to be there, and the conductor demanded his fare, and he declined to pay it, then the conductor had the right to stop the car, and to put plaintiff off, using no more force than was necessary for that purpose; but if the plaintiff intimated to the conductor that the road master and the conductor were lying in the matter of the pass which plaintiff claimed the road master had promised him, and thereupon the conductor beat plaintiff over the head with his fist and ticket punch, and cursed and abused him, and afterwards drew his pocket knife, and alarmed plaintiff to such an extent that he jumped off the car while the train was in motion, at its usual rate of speed, at that place, then you will find for the plaintiff reasonable compensation for the bodily injuries he received from such assault and battery from the conductor and his fall from the cars, when he jumped off." This charge was excepted to, and the court requested to charge: "You are instructed that if you believe from the evidence that plaintiff was upon the train at the time in question not by authority of the road master, and that he had time to tender his fare before he was ejected from or jumped from the train, which fact you will determine from the evidence, and you further find from the evidence that the assault committed by the conductor upon the plaintiff was made solely by

said conductor to resent a real or fancied insult, and that the action of the conductor was actuated solely thereby, you will find for the defendant,"—which charge the court refused to give. Giving the charge given, and refusing that asked, were excepted to, and have been assigned as error.

T. J. Freeman, for plaintiff in error.

M. M. Parks, for defendant in error.

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

LOCKE, District Judge (after stating the facts). There is no doubt about the law, contended for in this case, that, if the servant of the defendant in the court below (plaintiff in error) committed an assault while acting within the scope of his employment, the company is liable, but, if not so acting, it is not. *Railroad Co. v. Hanning*, 15 Wall. 649; *Railroad Co. v. Derby*, 14 How. 468. The difficulty is, in making application of such principle to the facts as proven, and the only question for our examination is whether such facts raised a question as to whether or not he was so acting sufficient to submit to the jury. Where there is such question, it is one of fact, and should be so submitted (*Redding v. Railroad Co.*, 3 S. C. 1); but here the trial court did not consider the testimony justified such submission. The position of the conductor made it his duty to collect the fare from those he found on the train without tickets, passes, or recognized right to ride, and in doing this, or attempting to do this, or in meeting any exigency or emergency naturally and necessarily growing out of this duty, his conduct, or the course he pursued in performing it, would be within the scope of his employment. The testimony here shows that he approached Williams for his fare, but was informed that he was being passed by the road master, but, upon being told by that party that he had not given Williams permission to ride, he went back to Williams, and again demanded his fare, and, in doing this, he admits that he may have used strong language, may have sworn, and said that he was a "damned lie." How far this was proven by the testimony of the plaintiff, which was before the court, the record does not disclose, and we can only determine what preceded the assault by the admission of Nicely himself. He was at that time acting within the scope of his employment, and when his abuse was answered by something which implied the same insult he had been heaping upon Williams, and which had naturally been drawn out by his own language and conduct, we do not consider that it can be properly claimed that he immediately abandoned his employment as conductor, and commenced an attack solely in his personal capacity. If, as is claimed, he was resenting a fancied insult as a man, it plainly appears from his own testimony that it was one which he had provoked as conductor, and we consider that such character should reasonably be held to cover the whole transaction, and that the entire evidence, when properly considered, cannot reasonably raise a question whether he was not acting beyond the scope of his employment, which should have been submitted to the jury. In

instructing the jury that, if they found that the conductor alarmed the plaintiff to such an extent that he jumped off the car, they should find for the plaintiff, although the allegations of the petition were that he was knocked and kicked from the train, we consider that the judge charged upon the evidence before him, and that the variance between *allegata* and *probata* was immaterial. It was not such as could mislead or surprise the adverse party. *McClelland v. Smith*, 3 Tex. 210; *May v. Pollard*, 28 Tex. 677; and *Wiebusch v. Taylor*, 64 Tex. 53. Forcing the plaintiff off the train in a wrongful manner was the gravamen of the complaint, and, whether it were done with the hand, the foot, or threats of bodily injury, the effect was the same. The judgment of the circuit court is therefore affirmed, with costs.

In re SPOFFORD.

(Circuit Court, S. D. New York. May 22, 1894.)

1. WITNESS—COMPELLING ATTENDANCE BEFORE MASTER OUTSIDE JURISDICTION OF COURT.

On the appointment by a circuit court, in a suit in equity, of a master to take testimony in another district, a subpoena to appear and testify before him was issued by the circuit court for that district, and served on a witness therein, who appeared, but refused to be sworn. *Held*, that the witness was punishable for contempt by the court issuing the subpoena.

2. CONTEMPT — PUNISHMENT — REVIEW OF ORDER BY CIRCUIT COURT OF APPEALS.

Where a witness declines to be sworn, in order to present objections which his counsel might reasonably have supposed well founded, an order punishing him for contempt therefor may be in the alternative, or, if peremptory and final, its operation may be stayed until an appeal can be heard and determined by the circuit court of appeals, if that court has jurisdiction of such an appeal.

An order made in the suit of the Farmers' Loan & Trust Company against the Northern Pacific Railway Company, pending in the circuit court of the United States for the eastern district of Wisconsin, directed that testimony be taken before a master, with leave to take such testimony outside the district. Pursuant to such order, the master appointed proceeded to take testimony at New York City. A petition was presented on behalf of defendants to the circuit court for the southern district of New York for subpoenas to testify. Such subpoenas were issued, and one of them was served on Charles A. Spofford, requiring him to appear before the master, and to testify. Mr. Spofford appeared, but refused to be sworn. An order was obtained in the southern district requiring said Spofford to show cause why he should not be attached and punished as for contempt of court, in failing to obey the command of the subpoena.

Wheeler H. Peckham, for petitioners.
Root & Clarke, opposed.

LACOMBE, Circuit Judge. Although still of the opinion heretofore expressed in *Arnold v. Chesebrough*, 35 Fed. 16, the weight of authority in the circuit courts is so strongly the other way that I feel constrained to grant this motion. *Railroad Co. v. Drew*, 3 Woods, 691, Fed. Cas. No. 17,434; *In re Steward*, 29 Fed. 813; *Johnson Steel Street-Rail Co. v. North Branch Steel Co.*, 48 Fed. 191; *In re Allis*, 44 Fed. 217.

As the witness has been in no sense contumacious, but has declined to be sworn or to produce the books only in order to present objections which his counsel not unreasonably supposed to be well founded, the order may be in the alternative. It will, however, be made peremptory and final, if witness' counsel so desire; and in that case I shall, by a subsequent order, stay its operation until appeal can be heard and determined by the circuit court of appeals. The supreme court has, it is true, repeatedly held that it could not, either by appeal or writ of error, review the action of a circuit court, inflicting fine or imprisonment for a contempt (*Ex parte Kearney*, 7 Wheat. 38; *New Orleans v. Steamship Co.*, 20 Wall. 387; *Hayes v. Fischer*, 102 U. S. 121), on the expressed ground that no appellate jurisdiction in such cases had been conferred upon it by the laws of the United States. The old common-law rule, however,—that the order of a court, whose decisions on all other questions are reviewable, is sacred, and not to be inquired into, when it inflicts punishment for contempt,—seems abhorrent to the sense of natural justice. It puts the property and personal liberty of one individual practically at the mercy of another, who, being human, may presumably act, upon occasions, mistakenly, or from prejudice or passion. And it may well be that the circuit court of appeals may find in the broad grant of appellate jurisdiction to review final decisions of the circuit courts "in all cases other than those [where jurisdiction to review is conferred on the supreme court]," which is contained in section 6 of the act of 1891, sufficient warrant for holding that final orders, such as the one here moved for, may be by it examined into, reversed, or otherwise determined. The case at bar certainly presents interesting questions as to the power of a circuit court to take testimony in equity causes outside of its own jurisdiction, and upon issues other than such as are raised by the pleadings, which have never yet been passed upon by an appellate tribunal.

VULCAN IRON WORKS v. SMITH et al.¹

(Circuit Court of Appeals, Ninth Circuit. May 28, 1894.)

No. 111.

1. PATENTS—ANTICIPATION—BAND-SAW MILLS.

In the Smith patent, No. 442,645, for an improvement in band-saw mills, claim 1 of which is for the combination with the band wheels and main supporting frame or column of an integral standard carrying the front bearings of the upper and lower band-wheel shafts, the standard being attached to the front side of the main frame or column between the band

¹ Rehearing pending.

wheels, the essential feature covered by this claim is the outside support for the front bearings of the band-wheel shafts, which, as constructed, permits the removal and replacement of the band saw without difficulty or derangement of the machinery; and the claim was not anticipated by previous patents, none of which covered the combination in the same form, although its elements were found in them.

2. SAME—LIMITATION OF CLAIM—PRIOR STATE OF ART—INFRINGEMENT.

As there was no invention in combining such elements found in previous patents, nor in overcoming their defects by merely increasing the strength of the parts, the claim cannot be construed broadly to cover the use of an integral outer standard attached to the main column between the band wheels, but must be limited to the construction shown of such outer support in the form of a single casting, as expressed in the application, stating the object to be to lessen the number of parts usually considered necessary; and hence that claim is not infringed by a combination in which the outside support is made of two parts, although they are bolted together so as to present the effect and produce the result of a single casting; and claims 2, 3, and 4, each of which merely adds to the combination of claim 1 an element found in previous patents, not involving invention, are not infringed by like combinations having the outside support so constructed. 57 Fed. 934, reversed.

3. SAME.

Claims 5, 6, and 10 of the patent, covering the straining device whereby the saw is kept at the proper tension, all the elements of which, except the mechanism supporting the knife-edged bearings of the rock shaft, are found in previous patents, is limited by such pre-existing devices, and hence is not infringed by the straining device of the Koefod patent, No. 468,303, the differences in the supporting mechanism being greater than the changes made by the Smith patent in adapting the previous devices. 57 Fed. 934, reversed.

Appeal from the Circuit Court of the United States for the Northern District of California.

This was a suit by Smith, Myers, and Schnier against the Vulcan Iron Works of San Francisco for infringement of a patent. The circuit court rendered an interlocutory decree for complainants. 57 Fed. 934. Defendant appealed.

Wm. F. Booth and John A. Wright, for appellant.

J. H. Miller and M. M. Estee, for appellees.

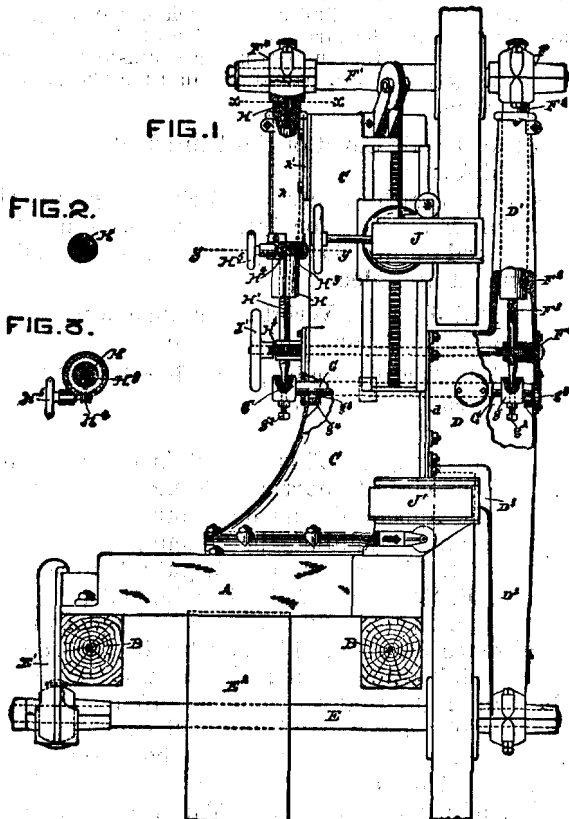
Before GILBERT, Circuit Judge, and KNOWLES and HAWLEY, District Judges.

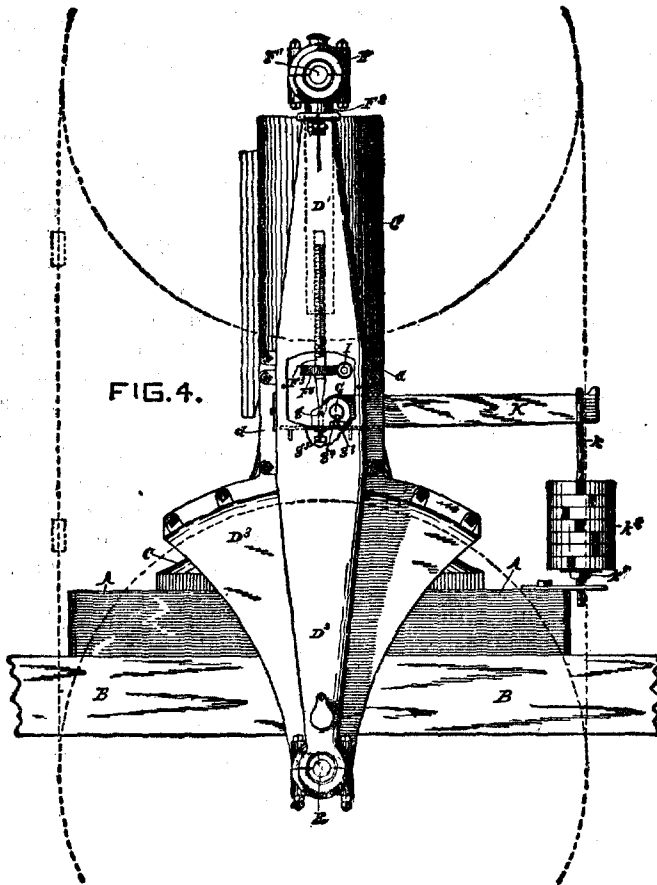
GILBERT, Circuit Judge. This appeal is taken from an interlocutory decree of the circuit court adjudging the patent sued upon to be valid, and the appellant, the defendant therein, to have infringed the same, and enjoining the defendant from further infringing. 57 Fed. 934. The complainant's patent is No. 442,645, and was granted to S. R. Smith on December 16, 1890, for an improvement in band-saw mills. The defenses relied upon on the appeal are: (1) The absence of patentable novelty in the combination of the claims of complainant's patent; (2) the want of patentable invention in the same; (3) that there is no infringement by the defendant. The complainant's band-saw mill consists of an endless band saw, stretched over and revolving about two large wheels, which are separated from each other by a space sufficient to admit of the operation of sawing lumber. The wheels are called the

upper band wheel and the lower band wheel. The frame of the mill, as shown in the patent, Fig. 1, consists of a base plate, A, an upright column, C, a horizontal portion, D, extending from the column, between the two band saws, and sustaining an upright arm, D¹, upon the outer side of the vertical plane of the band wheels, and a similar arm, D², extending downward; the object of both of which arms is to furnish outer bearings respectively for the upper and lower band wheels; the inner bearings being attached to the upright column, C, and both the upper bearings being placed in tubes set in the column, C, and in the outer arm, D¹. The first claim of the patent is as follows:

"In a band-saw mill, the combination, with the band wheels and main supporting frame or column, of an integral standard carrying the front bearings of the upper and lower band-wheel shafts; said standard being attached to the front side of said main frame or column between said band wheels, substantially as hereinbefore set forth."

It is urged that this claim is anticipated by the English patent to William Newbury, No. 3,105, issued in 1808; by the United States patent to W. F. Parish, No. 388,069, of August 21, 1888; by the





patent to C. Meiner No. 246,330, of August 30, 1881; and by the patent to De Witt C. Prescott, No. 369,881, of September 13, 1887. The essential feature of the complainant's invention, as covered by the first claim, is obviously the outside support. The outside support, as constructed in his patent, in combination with the other elements, permits the removal and replacement of the band saw from and upon its carrying wheels without difficulty, and without derangement of the machinery. We fail to find the combination in this form in any of the other patents. In none of them is there a combination of a main column with an integral standard attached to the same at a point between the band wheels and at no other point. In the Newbury patent the band saws are supported between two equal columns, connected, it is true, at a point between the wheels, but neither of which is an outside standard, or so constructed as to permit the placing or removal of the band saw without disturbing the position of the machine. The same is true of the Parish patent. In the Meiner patent is found, per-

haps, the nearest approach to the complainant's invention, as covered by this claim, and, if the outer standard in that patent were so constructed as to be operated without its attachment at the upper and lower ends by screws connecting the same with the frame which incloses the whole machine, it would be clearly an anticipation of the complainant's claim for an integral outer standard, but in the use of those connecting screws a dissimilarity appears which, though slight, is, in our judgment, sufficient to defeat the defense of anticipation, and, although it is apparent that the Meiner mill might be so constructed that the connection of the ends of the outer standard with the main frame might be wholly unnecessary and superfluous, yet there is no intimation in the patent that the machine was by the inventor intended to be used or constructed in any manner other than that indicated in his specifications. The Prescott patent also lacks one of the essential elements of the complainant's first claim. Instead of an integral outer standard attached to the main column between the band wheels, it has two distinct outer standards or arms for carrying the outer bearings of the band wheels, the lower of which is attached to the column, but the upper is fixed to a column which is telescoped over the main column, and is moved vertically thereupon by means of a jack screw.

It is next contended that the first claim lacks patentable invention,—that the combination of elements produces no new and useful result. When the prior patents are considered, it is evident that the deviations made by the complainant from the devices that preceded him are but slight. In the Prescott patent he found the main column, in connection with band wheels and standards for carrying the outer bearings of the band wheels attached to the main column at points between the wheels, so constructed as to permit the convenient removal and replacement of the band saw, the lower standard integral and immovable, the upper movable vertically, its position and tension being controlled by a jack screw resting upon the upper portion of the lower standard, and connecting the two. In the Meiner patent he found a main supporting frame or column in connection with band-saw wheels, and an integral outer standard carrying the front bearings of the band-wheel shafts, and attached firmly by a connecting piece to the main frame at a point between the band wheels. The fact that the ends of the outer standard were capable of further connection with the main frame by movable bolts or screws renders it none the less an integral outer support. If, therefore, the complainant's first claim is to be regarded as covering broadly the combination with band wheels and a main supporting frame or column of an integral outer standard attached to the main column between the band wheels, it will be seen that he found those elements in the prior patents, and that he has taken the single main column of the Prescott patent and the integral outer standard of the Meiner patent, and has combined them in a machine which may be conceded to be neat, compact, and strong. But this was not invention. *Burt v. Evory*,

133 U. S. 349, 10 Sup. Ct. 394; Trimmer Co. v. Stevens, 137 U. S. 423, 11 Sup. Ct. 150; Setter Co. v. Keith, 139 U. S. 530, 11 Sup. Ct. 621; Ryan v. Hard, 145 U. S. 241, 12 Sup. Ct. 919; Derby v. Thompson, 146 U. S. 476, 13 Sup. Ct. 181.

It is urged that there was a defect in both those prior patents which the complainant has overcome, and that therein he has displayed invention. The defect is said to be the insufficiency of the outer supports of the band wheels to sustain the strain of the band saw, and the tendency to draw the wheels out of alignment. To correct this evil it was necessary that the outer standard should be made more firm and rigid. This the complainant has accomplished by increasing the strength of that part. If this is all that he has done, it is manifest that he has displayed no invention. If the prior machines were defective for want of strength or firmness, the remedy was too obvious to permit of discussion. It may be seen from a simple inspection of both the Prescott and the Meiner patents that machines made under either might have been so constructed as to absolutely overcome the defect referred to. In each the outer supports might have been made so firm and strong as to hold the band wheels in true alignment, no matter what the strain of the band saw. It is argued, further, that there must be invention in the complainant's machine from the fact that it produces more lumber per diem than any that preceded it. But the increased speed of the complainant's mill is due, not to the introduction of a new element into his combination, or to a new combination of known elements; it is attributable solely to the superior strength and firmness of the supporting column of the band wheels. It requires no reasoning to prove that, if the Prescott mill and the Meiner mill are constructed with equal strength and rigidity, they will run with the same speed and accomplish the same result with the complainant's mill. But, if there is in the complainant's combination invention sufficient to sustain the first claim of his patent, it is limited to the construction of the integral outer support in the form of a single casting, attached directly to the main frame or column, and his sole invention is expressed in his application where its object is said to be "also to lessen the number of parts usually considered necessary in this class of devices." By referring to the proceedings in the patent office had upon the filing of his application, it will be seen that the allowance of the first claim, after the same had been twice rejected, was based upon this view of his invention,—that his outer support or standard was a single casting attached to the main column with no intervening part, and that thereby the number of parts was lessened. In considering the question of infringement, the court must be guided by the construction so given to the plaintiff's invention. The evidence proves that the defendant has made band-saw mills in imitation of the complainant's machine, and which closely resemble it. But the defendant's outer support for the band wheels is not made in a single casting. It consists of two castings, firmly bolted together and to the main column at a point

between the band wheels. If the complainant were entitled to have his first claim so construed as to cover, in the broad sense of the word, the use of an integral outer standard, clearly the defendant's device would be an infringement, for that element of the combination as used by the defendant is none the less integral by reason of the fact that it is made of two parts so securely bolted together as to present the effect and produce the result of a single casting. But the complainant's invention being limited, as we have seen, by the prior state of the art, if not by the express words of his application, to the use of a single casting, the conclusion necessarily follows that the defendant has not infringed this claim of the patent. *Roemer v. Headley*, 132 U. S. 313, 10 Sup. Ct. 98; *Snow v. Railway Co.*, 121 U. S. 617, 7 Sup. Ct. 1343; *Hoff v. Manufacturing Co.*, 139 U. S. 326, 11 Sup. Ct. 580; *Derby v. Thompson*, 146 U. S. 476, 13 Sup. Ct. 181.

The second claim adds to the combination enumerated in the first the hollow supporting column in the outer standard, and the hollow castings attached to the main column opposite the same, to furnish supports for the bearings of the upper and lower band-wheel shafts. This claim combines with the first claim the element of hollow main standards and hollow outer standards, whereas, by the first claim, the standards may be either hollow or solid. The hollow standards are found both in the Parish patent and the Prescott patent, and in both are used for the same purpose as in the complainant's patent. There is, therefore, no invention in the combination of that element with those that compose the first claim. The complainant can only claim the hollow standards in combination with the use of an outer standard made of a single casting, and attached directly to the main column, and it follows that, if the defendant has not infringed the first claim, it has likewise not infringed the second. The same is true as to the third claim, which covers the use of an outer standard having a flanged, horizontal portion, to be secured to the main supporting frame, and vertical arms cast in one piece, with the central portion bored to receive the adjustable bearings of the upper band-wheel shaft. Claim 4 is as follows:

"(4) The combination of the base plate, A, cast in a single piece, the column, C, having a flanged base to be secured to the said base, A, the front support for the band-wheel shafts consisting of the castings, D, D¹, D², and shield, D³, together forming a supporting frame for band-saw mills, substantially as hereinbefore set forth."

The effect of this claim is to add to the elements already had under consideration the use of a base plate, which is a broad, heavy casting, a flange upon the base of the main column for the purpose of attaching the same to the base plate, and a shield above the lower band wheel. All of these elements are found in the prior patents. In the Prescott patent, the base plate, A, is used; in the same patent, as well as in the patent to Brophy, No. 261,579, of date July 25, 1882, and in the patent to Stephens, No. 322,465, of December 15, 1885, are found the flanged base of the main column. In the Hinkley patent, No. 348,280, of August

21, 1886, the lower band wheel is protected by a shield. The prior state of the art, therefore, leaves the complainant's invention, as formulated in the fourth claim, to the use with the other elements of a shield to the lower band wheel, made in a single casting, with an outer standard, as the same is described in the first claim. This claim the defendant, for the reasons above set forth, has not infringed.

The remainder of the assignments of error concern what is known in the complainant's patent as the straining device, referred to and described in claims 5, 6, and 10. The object of the straining device in a band-saw mill is to maintain a constant strain upon the band saw, thereby holding the same to its place upon the band wheels, and securing, by its proper tension, accuracy of work. In the complainant's patent, the shafts of the upper band wheels have their bearings on top of vertical columns or trunnions, movable vertically within the bore of the standards. These trunnions terminate below in screw shafts, which rest in the ends of short arms extending from a single rock shaft. By the turning of the rock shaft the trunnions are raised and lowered, carrying with them the upper band wheel. In order to hold the rock shaft under a constant tendency to turn, and to hold the trunnions up, and press the upper band wheel against the saw, a lever is secured to the rock shaft, and weights are imposed upon the lever. The rock shaft itself turns upon "knife edges," which are let into the shaft upon the lower side at either end, and these rest upon brackets projecting inwardly from the outer walls, respectively, of the outer standard and the main column. The claims are as follows:

"(5) In a band-saw mill, the combination of the supporting frame, the vertically adjusted bearings for the upper band-wheel shaft, mounted in said frame, the transverse shaft, G, mounted on knife-edge bearings, in said frame, and having arms, g, g', secured upon said shaft to support the bearings of said upper band-wheel shaft, and the weighted lever, K, secured upon said shaft between the knife-edge bearings to counterpoise the bearings of the upper band-wheel shaft, and provide a sensitive automatic adjustment for the same, whereby the saw is kept at the proper tension, substantially as hereinbefore set forth."

Claim 6 adds to the combination in claim 5, in substance, the following: (1) The knife-edge bearings let into the rock shaft; (2) the supporting plates, g⁴, resting on the brackets in the main frame; (3) that the short arms of the rock shaft have steps in their outer ends; (4) the hardened steel adjustment screws passing through said steps; (5) that the adjustable bearings of the upper band wheel rest upon these screws; (6) the rod, k, suspending the weights; (7) the cap nut, k, supporting the weights; (8) the movable weights. Claim 10 is as follows:

"(10) In a band-saw mill the combination of the column, C, brackets projecting from said column, a rock shaft having knife-edge bearings resting upon said brackets, a weighted lever, and two arms, g, g¹, screwed upon said rock shaft with the band-wheel shaft, and the boxes and rods supporting the boxes, said rods resting upon the arms, g, g¹, substantially as shown and described."

Straining devices are found in most of the band-saw mills which preceded the complainant's invention. In the Parish patent the

vertically adjustable bearings of the upper band-wheel shaft are mounted as in the complainant's combination, and are supported upon rods, the lower ends of which connect with pivoted levers, the inner ends of which connect again with hanging rods, the lower ends of which connect with the arms of a rock shaft, with a central lever carrying a weight. Here are all the elements of the complainant's straining device, with the exception of the knife-edge bearings of the rock shaft and the mechanism necessary for the support of the same. In the Parish patent the rock shaft turns upon round journals. The use of the knife-edge bearing, however, is found in the straining device of the Prescott patent. There one of the rods which support the bearings of the band wheel is knife-edged below, and rests upon a pivoted lever, which supports the weights, and the advantage of the sensitiveness of the knife-edge bearing is distinctly claimed by Prescott in his application for patent. With these patents before him, the complainant combined the elements of his straining device. He mounted the rock shaft upon knife-edge bearings let into the shaft at either end, placed the upright rods which support the bearings upon steps let into the outer ends of short arms or levers attached to the rock shaft, and supported his knife-edge bearings upon brackets. Notwithstanding the prior state of the art, this combination, we think, displays invention. But the question arises whether the defendant has infringed this feature of the complainant's patent. The defendant has used the straining device patented to G. T. Koefoed on February 2, 1892, letters patent No. 468,303. In the Koefoed patent the supporting columns of the band-wheel bearings rest upon a transverse bar, which the complainant denominates a rock shaft, but which the defendant calls a straining lever. The lower ends of the supporting columns are knife edged, and rest directly upon the straining lever, and not upon arms projecting therefrom, as in the complainant's device. The straining lever itself, instead of turning upon knife-edge bearings let into the same, is constructed with short arms projecting laterally, and these arms rest upon knife-edge bearings placed, not in the arms, but let into supporting brackets below the same, which brackets project from the inner walls of the main frame and the outer standard. We are of the opinion that the Koefoed patent so far departs from the specific features which constitute the complainant's invention that it does not infringe the same. If the complainant's device were a pioneer invention, or if it introduced for the first time the use of a rock shaft on knife-edge bearings, or any other essential element of the combination, it would be entitled to a broader construction; but, narrowed as it is by the known and patented devices antecedent to it, the court is compelled to more strictly construe its claims. The Koefoed device goes further than to make merely formal changes in the complainant's patent. Its deviations therefrom do not consist in the mere transposition of parts, the placing of knife-edge bearings upon one part instead of another, the making a rock shaft in the form of a bar instead of a cylinder, but it introduces such change in the construction of the

parts as to avoid the elements of the complainant's invention, limited, as we have found the same to be, by the pre-existing devices. The defendant has not used a "shaft with arms, g, g¹," nor a shaft with knife-edge bearings, either let into the same or into the supporting mechanism of the same. He has used a shaft without the arms, g, g¹, for the support of the upper band-wheel bearings, and has not made the shaft to turn upon knife-edge bearings in the shaft, or beneath the same, but has connected it with knife-edge bearings by arms extending laterally therefrom. These differences, slight as they may be, are, in our judgment, as great as the changes which the complainant made in adapting the former devices, and are sufficient to relieve the defendant of the charge of infringement. The decree is therefore reversed, at the cost of the appellee.

TUTTLE v. CLAFLIN et al.

(Circuit Court, S. D. New York. March 15, 1894.)

PATENTS—INFRINGEMENT—ACCOUNTING FOR PROFITS.

Combinations covered by claims of complainant's patent for a frilling and crimping machine were used, with additional features, by defendants, in roller-plaiting machines, producing large quantities of plaitings finished for use as trimmings. On an accounting of profits from the infringement, there was no satisfactory proof that the finished product could be produced by complainant's machines: and it appeared that, while such plaitings could be made by hand, the process was tedious and expensive, and the product inferior and unmerchantable, and they had not been so made before the introduction of the roller-plaiting machines. *Held*, that defendants should not be held liable for profits to the amount of the difference between the cost of making the plaitings by machine and the cost—30 to 50 times greater—of making them by hand; the burden being on complainant to show that the profits were entirely due to his patented combinations, and that the cost price of hand-made plaitings was a fair measure of comparison.

This was a suit by Theodore A. Tuttle, trustee, against John Clafin, executor, and others, for infringement of a patent. The patent was sustained, and held to be infringed, and an accounting ordered. 19 Fed. 599. Defendants filed exceptions to the master's report on the accounting.

Benjamin F. Lee, for complainant.
Edmund Wetmore, for defendants.

COXE, District Judge. This action is based on letters patent No. 37,033, granted to Crosby and Kellogg, December 2, 1862, for an improvement in machines for frilling and crimping. The bill was filed August 1, 1878, 15 years and 8 months after the date of the patent. In March, 1884, the patent was sustained by this court (*Tuttle v. Clafin*, 19 Fed. 599), and the second and fourth claims were held to be valid and infringed. These claims are as follows:

"(2) In combination, a crimper and a smoother, substantially such as described, and acting, substantially as specified, to hold the crimps to an edge."

"(4) In combination with a crimper substantially such as specified, a spring

acting to force said crimper upon the goods while crimping them and relaxing its pressure while the crimper is retreating, substantially in the manner and for the purpose specified."

The second claim is the broader of the two, the fourth claim being for a more limited combination.

On the 24th of August, 1893, the master filed his report, in which he found no damages against the defendants, but reported the sum of \$76,215.85 "as the profits, gains and advantages which the said defendants have derived, received or become entitled to by reason of their infringement." The master proceeded upon the theory that the entire profit of the large roller plating machines used by the defendants was due to the combinations of the claims just quoted, and that the defendants had saved the difference between one-half a cent a yard, the cost when the machines were used, and the cost of making the same number of yards by hand, which was estimated to be 15 cents per yard for linen plaitings and 25 cents per yard for woolen plaitings. In other words, that it cost the defendants \$2,419.55 to plait 483,910 yards of goods on the machines; that if they had not used the machines they would have had the same number of yards plaited by hand at a cost of \$78,635.40, and that they had, therefore, saved the difference (\$76,215.85), and should pay it to the complainant. The comparison was not with the next best trimming, but with the same trimming made in the next best way, or in the way which the master found to be the next best.

On the 26th of August, 1893, the defendants filed exceptions disputing the correctness of all the master's conclusions as to the profits derived by them. The exceptions present several questions of minor importance, the broad, fundamental question being whether the complainant is entitled to recover \$76,215.85 as profits from the defendants.

The testimony establishes two propositions—First, the combinations of the second and fourth claims of the Crosby and Kellogg patent would not produce the finished product of the infringing machines used by the defendants; and, second, if machines and products were identical, the comparison instituted by the master between the cost of making the plaitings by defendants' machines and the cost of making them by hand was not, upon the facts of this case, the proper rule of computation.

The invention is an ingenious device, designed originally for a sewing-machine attachment and intended to do the same general character of work as the Arnold ruffler, but it was distinctly an advance over the Arnold machine. It is entirely clear, however, that the mechanisms covered by the second and fourth claims did not and could not produce a commercial plaiting like those made on the defendants' machines, viz. a spaced and ironed wide plaiting ready for use as a trimming for ladies' gowns. The defendants' machines took the frills produced by the combinations of the claims, and by making the plaits uniform and ironing them down originated something which caught the market and produced the demand. In 1867 James Orr, of Glasgow, invented a roller-plaiting machine which seems to have created the demand for trimmings of this kind. At

least there is no satisfactory proof that for six years and more after the Crosby and Kellogg invention their machine, as patented, ever did or ever could make a yard of trimming like that made by the defendants' machines. It was to these machines, organized and perfected long after the Crosby and Kellogg invention, and containing as they did the condensed ingenuity of several prior structures, that the art was indebted for the trimming so fashionable during the period in question. Surely the features added to the machines by Orr, Griffith and Fanning, and particularly the ironing feature by which a perfectly symmetrical finish is imparted to the plaitings, must have contributed something to their value. To assert that the whole value is due to the Crosby and Kellogg invention is erroneous. The complainant is not entitled to appropriate the additional value imparted to the plaitings by those features of the infringing machines not found in the second and fourth claims.

But admitting that the machines used by the defendants were precisely the machines of the claims and nothing more, still the comparison instituted by the master between the cost of plaitings made on them and the cost of hand-made plaitings was, it is thought, founded upon mistaken premises. The punishment inflicted upon the defendants is out of all proportion to their fault. They have been adjudged to pay a very large sum of money upon the theory that they have made that sum or saved that sum by the use of the complainant's machine. The proof fails to satisfy the court of the soundness of this view.

Assuming, as we must, that the defendants would have acted in accordance with the ordinary rules which govern human conduct, it is hardly probable that they would have ordered nearly half a million yards of plaiting at such a ruinous cost. Surely there is no presumption that they would have done so. The witness best fitted to speak on this subject, the defendants' superintendent, says that they would not. The presumption was greater that the defendants would have given up the use of this trimming altogether, or would have adopted some substitute, rather than that they would have resorted to a method which common sense would reject both because of its enormous expense and also because of its inefficiency. Not only were plaitings made by hand too expensive, but they were so poorly done that it is doubtful whether the defendants could have used them at any price in competition with the machine-made plaitings. If this were an art in which hand-made plaitings had been used before to any appreciable degree as articles of commerce, and machine-made plaitings had superseded them, there would be more reason for asserting that the defendants would have continued to use the old method if they were prevented from adopting the new. But here there was no old method. The Crosby and Kellogg machine had been in existence for six years and had created no demand for kilt plaitings. Such plaitings could, of course, be made by hand, but the process was tedious and expensive and the product inferior and unmerchable. It is fair to say that, in a commercial sense, kilt plaitings were not made by hand prior to the introduction of the roller-plaiting machines. The infringing ma-

chines made the demand. They created the market. There is nothing but conjecture to show that the defendants would have resorted to the hand-made method. First, it was so expensive as to be practically prohibitory, and, second, it was impossible to make a marketable plaiting by hand,—one that could compete successfully with the machine-made plaitings.

But the matter should not be left to presumption. The burden was upon the complainant to establish the affirmative of both these propositions—First, that the profits were entirely due to the combination of the claims; and, second, that the cost price of hand-made plaitings was a fair measure of comparison. He has done neither.

Various illustrations will occur to any one familiar with patents where ingenious labor-saving machines have created an art which otherwise would not have existed. Take the paper-bag industry, for instance. Is it a fair assumption that a manufacturer who found himself precluded from using the patented machines, which turn out bags by the thousands, would attempt to supply the market with hand-made bags? A machine will sometimes make in a second an article which never was made before and which can be made by hand only after hours of painstaking toil by a skilled artisan. The machine will supply hundreds of millions of these articles annually to commerce at a price merely nominal. To make the same articles by hand, though physically and experimentally possible, is practically and commercially out of the question. The time, labor and money required would preclude such an attempt. An article costing a dollar cannot compete successfully with a better article costing a mill, and no rational being would attempt such a competition. And yet, if the doctrine of the report is pushed to its logical conclusion, the owners of patents for comparatively unimportant inventions will be able to levy an enormous tribute upon infringers, resulting in fabulous but unmerited wealth to the former and bankruptcy to the latter.

With the highest respect for the opinion of the learned master, the court is unable to agree with the conclusions reached by him.

The exceptions, so far as they relate to the questions discussed, must be sustained.

INTERIOR CONDUIT & INSULATION CO. v. EUREKA ELECTRIC CO.

(Circuit Court, S. D. New York. April 21, 1894.)

PATENTS—LIMITATION BY PRIOR STATE OF ART—ELECTRIC WIRING.

In the Johnson and Greenfield patent, No. 401,498, for improvements in wiring structures for electric lighting, claim 1, for the combination of a pipe of insulating material, a pair of wires insulated from each other and in close proximity within the pipe, each forming one side of an electric lighting circuit, and a safety catch interpolated in the circuit, and claim 3, for the combination of the same elements, having the wires twisted together, even if such combination involves invention, all the elements being old, in view of the prior use of similar devices and combinations, can be upheld only if limited to a complete system of pipes extending continuously through the building, as described and shown; and they are not infringed by structures which do not employ such a system.