

In *Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 7 C. C. A. 498, 58 Fed. 818, we had occasion to consider the effect of an estoppel as against a licensee operating under the peculiar agreement existing in that case, and used the following language:

"So far as this suit is concerned, the various patents referred to in the agreement are to be held valid, and the claims in each to be fully sustained, according to their fair intent, as such claims are usually construed under the rules of the patent laws; and, so far as the validity and extent of the claims are concerned, neither is to be diminished by any prior patents or inventions, known or unknown, disclosed or undisclosed, although they may come in to some extent for the purpose which we will state. The record contains very much touching the state of the art and prior patents. From what we have already said, it is plain that they cannot be introduced here for the purpose of invalidating any of the patents covered by the contract, or any portion of any claim of any of such patents. Nevertheless they, as well as the file wrappers and their contents, are appropriate to be considered for ascertaining the true construction of the various patents involved, and especially for determining whether, according to such construction, the improvements were of a primary or secondary character, and how far the combinations admit of the doctrine of equivalents."

These expressions were special, and, when used, were limited to that case. They happen to define accurately the operation of the estoppel in the case at bar on the questions of novelty, utility, patentable invention, anticipatory matter, and the state of the art; and they leave for our consideration none of these, except the state of the art, and anticipatory matter as a part of the state of the art, and these only as bearing on the construction of the patent.

We do not understand that these propositions are contested by the respondents below, now the appellees; yet we have deemed it necessary to state them at length, in order that we may accurately consider the effect which the patent in question has as between the parties to this suit. We also refer, in this connection, to *Clark v. Adie*, L. R. 2 App. Cas. 423; *Trotman v. Wood*, 16 C. B. (N. S.) 479; *Crosthwaite v. Steel*, 6 R. P. C. 190; *Ashworth v. Roberts*, 9 R. P. C. 309.

Applying these principles, and construing the patent in suit in the light of the art, we concur in the conclusion of the circuit court, for the reasons stated in the opinion filed in that court.

Decree of the circuit court affirmed.

WOODWARD et al. v. BOSTON LASTING MACH. CO.

(Circuit Court of Appeals, First Circuit. June 23, 1894.)

No. 61.

1. PATENTS—ASSIGNMENT—ESTOPPEL OF ASSIGNOR—WAIVER.

The estoppel of a patentee, who has assigned his patent, to set up its invalidity as a defense to a suit against him by the assignee for infringement, is not waived by the assignee failing to anticipate such defense in his bill, or to except to the answer setting it up, and the court will give effect to the estoppel although the parties did not wish to raise it.

2. APPEAL—DECISION—RESERVING LEAVE TO FILE BILL OF REVIEW.

Where a decree is affirmed on an issue not anticipated by appellants, which the parties did not intend to raise, and which appellants suggest

can be met by further proofs, liberty may be reserved to them to apply to the court below for leave to file a bill of review, and to proceed thereon as that court may determine, with reference to the matter.

This was a petition by Erastus Woodward and others, appellants, for a rehearing of their appeal, after a decision affirming the decree of the circuit court. 8 C. C. A. 622, 60 Fed. 283. Leave to file briefs was granted to both parties.

Causten Browne and Geo. O. G. Coale, for appellants.
J. E. Maynardier, for appellee.

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

PER CURIAM. The court has given careful attention to the petition for a rehearing filed in this case, and the briefs thereon filed by each party by leave of court, which have fully argued the grounds on which the court decided this case in its opinion in 8 C. C. A. 622, 60 Fed. 283. The matter is so important that it is proper to explain why we deny the petition.

For all we need say touching the rule of estoppel applicable to this case, in addition to what appears in the opinion in 8 C. C. A. 622, 60 Fed. 283, we refer to the opinion passed down this day in *Babcock v. Clarkson*, 63 Fed. 607.

It is said that the right to set up estoppel was waived in various ways. There was no waiver by the pleadings. The estoppel would properly arise as a matter of rebuttal by complainant, on the proofs, and not on the pleadings. The complainant might have anticipated the defense of invalidity by inserting, in its bill, charges and an avoidance; but it was at its option to do so, and it lost no rights by not availing itself of this option. Story, Eq. Pl. § 33.

In *Underwood v. Warren*, 21 Fed. 573, the question of estoppel was raised by exceptions to the answer; but this was irregular, and was apparently permitted because no one objected to this method of proceeding. An answer is clearly not insufficient merely because it sets up a defense which may be rebutted, and parties cannot be compelled to try on exceptions an issue of this kind.

It is said, and is apparently true, that the parties did not wish to raise this question. But that, if successful, would, in effect, result in submitting to the court a moot patent cause, which, on account of the public interests involved, the court is ordinarily disinclined to permit. As a general rule, the court, before passing on the question of patentability, is entitled to require that it should be properly presented by parties legally competent and interested to do it.

The court sees no occasion to modify its conclusions touching the relations of defendant Barrett to defendant Woodward.

It is apparent that the result has turned on an issue which the appellants did not anticipate, either in this court or in the court below; and the surprise comes from the fact that the issue was raised by the court, while the parties intended not to raise it. The appellants suggest that the issue can be met by further proofs.

Therefore, a special mandate is requested, which we will grant, as the circumstances are so peculiar. *Smith v. Weeks*, 3 C. C. A. 644, 53 Fed. 758. It must be expressly understood that we are not committed to any phases of the law which the new proofs, if taken, may raise, nor barred from applying to them the rule of *Telegraph Co. v. Himmer*, 19 Fed. 322, if it meets our approval and comes in point.

Ordered: The petition for a rehearing is denied. The judgment already entered is amended to read as follows: "The decree of the circuit court is affirmed. This court reserves to the appellants liberty to file in the circuit court an application for leave to file a bill of review, or leave to adopt other appropriate methods, and to proceed thereon as that court may determine, with reference to the matter of estoppel appearing in the opinion of this court passed down March 5, 1894; the appellees to recover costs of appeal."

DE LORIEA et al. v. WHITNEY.

(Circuit Court of Appeals, First Circuit. June 22, 1894.)

No. 88.

1. PATENTS—ACTIONS FOR INFRINGEMENT—DIRECTING VERDICT.

When, in an action at law, the essence of an alleged infringing machine is not in dispute, so that the question of infringement by it turns plainly on the construction of the patent alleged to be infringed, and such construction is for the determination of the court, either on the face of the patent, or on its face in connection with facts of such nature that their existence and effect cannot be reasonably disputed, the entire issue of infringement is practically for the court. In regard to these particulars, the same rules of construction apply as apply to other instruments.

2. SAME.

Royer v. Belting Co., 10 Sup. Ct. 833, 135 U. S. 319, touching what issues are for the jury, explained.

3. SAME—EVIDENCE—CONSTRUCTION OF PATENT.

The facts that a patented machine was the first successful one, and that it had great commercial success, are limited in their application to questions of utility or patentable invention, and have no pertinency in cases turning on the construction of the patent.

4. SAME — LIMITATION OF CLAIMS — MACHINES FOR UNHAIRING AND SCOURING HIDES.

The McDonald patent, No. 210,797, for a machine for unhairing and scouring hides and skins, must be limited to a machine containing two feed rolls and a supporting roll and a scouring roll; is not entitled to a broad range of equivalents, but falls within *Fay v. Cordesman*, 3 Sup. Ct. 236, 109 U. S. 408, and cases of that class; and is not infringed by a machine which contains three rolls, the lower acting as a combined feed roll and supporting roll.

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

This was an action by Joseph F. De Loriea and Griffin Place, executors of James W. McDonald, against Arthur E. Whitney, for damages for infringement of letters patent No. 210,797, issued December 10, 1878, for a machine for unhairing and scouring hides and skins. On trial in the circuit court the judge instructed the jury to find for defendant. Judgment for defendant was entered on the verdict. Plaintiffs brought error.