

ord, nor served with process, and that a decree to enforce such judgment is void. So far as concerns the power of the court to enforce the lien upon the vessel without first obtaining judgment for the penalty, the appellants' contention is not in accord with the reasonable and fair construction of the statute, nor with the authorities. The Missouri, 3 Ben. 508, Fed. Cas. No. 9,652; *Id.*, 9 Blatchf. 433, Fed. Cas. No. 15,785; *U. S. v. The Queen*, 4 Ben. 237, Fed. Cas. No. 16,107; *Id.*, 11 Blatchf. 416, Fed. Cas. No. 16,108. In these decisions it is held that the words, "holden for the payment of such penalty," are intended to create an original liability upon the part of the vessel for a penalty equal to that imposed upon the owner or master, and that the provision for the seizure of the vessel and the summary proceeding against her precludes the idea of delay, and carries the meaning that the seizure and proceeding may be predicated directly upon the unlawful act whereby the penalty is incurred, and without preliminary action or proceeding to establish the liability of the owner or the master. The district court undoubtedly had the power to decree the sale of the vessel on account of the penalty incurred by the master, in the sum of \$1,000 and costs, and the cause will be remanded to the district court, with instructions to modify its decree in accordance with this opinion.

RUSSELL v. KERN.

(Circuit Court, E. D. Wisconsin. September 13, 1894.)

1. PATENTS—IDENTITY OF INVENTION.

It appeared on demurrer that certain patents to George T. Smith (Nos. 187,923, 194,539, 208,936, 236,101, and 258,142), for machines for middlings purifying and flour dressing, covered the same invention shown and described in prior and expired patents to the same inventor. *Held*, that the question of identity is one of law, which can be determined solely from the face of the patents. *Heald v. Rice*, 104 U. S. 737; *Miller v. Manufacturing Co.*, 14 Sup. Ct. 310, 151 U. S. 186.

2. SAME—EXTENSION OF MONOPOLY.

The patents are invalid, as operating to extend the monopoly beyond the period allowed by law. *Miller v. Manufacturing Co.*, *supra*; *Oval Wood Dish Co. v. Sandy Creek Wood Manuf'g Co.*, 60 Fed. 285.

3. SAME—VALIDITY—PRELIMINARY HEARING.

Where a demurrer raises the question of invalidity on a preliminary hearing, while the question is ordinarily left to final hearing, it may be determined on preliminary hearing, where the issue is squarely presented on the face of the complainant's bill.

This was a suit by John H. Russell against John F. Kern for the infringement of certain patents, hereinafter enumerated in the opinion of the court. There was a demurrer to the original amended bill (58 Fed. 382), and, the bill having been further amended, the defendant again demurs.

George E. Sutherland, for complainant.

H. C. Gridley and Samuel Howard, for defendant.

SEAMAN, District Judge. The defendant demurs to an amended bill, alleging ownership in complainant and infringement by defendant of 10 several letters patent, issued to George T. Smith, for machines for middlings purifying and flour dressing, and for process, as-

serted as constituting one compact machine. Copies of the patents are annexed to and made part of the bill of complaint, and are numbered and dated as follows: First, No. 133,898, issued December 10, 1872, on application filed October 21, 1872, for machine for dressing flour; second, No. 137,495, issued April 1, 1873, on application filed October 12, 1872, for process of manufacturing flour; third, No. 154,770, issued September 8, 1874, on application filed August 17, 1874, for flour-dressing machine; fourth, No. 158,992, issued January 19, 1875, on application filed May 20, 1872, for middlings-purifying machine; fifth, No. 164,050, issued June 1, 1875, on application filed July 12, 1871, for machine for dressing flour and middlings; sixth, No. 187,923, issued February 27, 1877, on application filed December 28, 1876, for middlings purifier; seventh, No. 194,539, issued August 28, 1877, on application filed September 8, 1874, for middlings purifier; eighth, No. 208,936, issued October 15, 1878, on application filed August 29, 1878, for middlings purifier; ninth, No. 236,101, issued December 28, 1880, on application filed November 2, 1880, for middlings purifier; tenth, No. 258,142, issued May 16, 1882, on application filed January 4, 1873, for middlings purifier.

This case was before the court upon demurrer to the original amended bill, and demurrer overruled. 58 Fed. 382. The bill of complaint has been further amended, and new points are now raised by demurrer. The following allegation in the original bill is now, among other changes, omitted, viz.:

The complainant further shows, upon information and belief, and charges the fact to be, that it is impossible to assess damages or estimate profits arising singly from the use of one of the devices covered by the George T. Smith's patents above mentioned, or any combination thereof less than the whole of them, and that damages cannot be assessed or profits determined in any other way than by taking the George T. Smith's middlings-purifying machine as a whole, as the same has been used by the defendant, and assessing damages or estimating profits for the use of said machine as a whole, and damages cannot be assessed or determined in parts or for parts thereof.

This allegation was deemed material at the former hearing to save for consideration the earlier and expired patents, as entering into the asserted compact machine.

The original bill was filed May 31, 1892, after the following of the patents in suit had expired, viz.: No. 133,898, of December 10, 1872; No. 137,495, of April 1, 1873; No. 154,770, of September 8, 1874; No. 158,992, of May 20, 1872. And No. 164,050, which was dated June 1, 1875, expired immediately thereafter, and before return of subpoena, and appears fully anticipated by No. 133,898. No claim to relief in equity could be based upon either of these expired patents. The objections which are now raised to the remaining and unexpired patents are serious, and, if well taken, are fatal to any relief here.

1. The objection which will be first considered is that the invention shown and described in the later and unexpired patents is the same invention shown and described in one or the other of the prior and expired patents issued to the same inventor. These prior patents are each fully disclosed by the bill as entering into a cause of action. Comparing their specifications and drawings with those

of the later patents, and in the light of the summary of mechanical elements claimed for each, as set out in the brief for complainants, I can find no escape from the conclusion that these later patents are covered by those of earlier issue, and are invalid, under the rules clearly stated in the recent case of *Miller v. Manufacturing Co.*, 66 O. G. 845, 151 U. S. 186, 14 Sup. Ct. 310; also, in *Oval Wood Dish Co. v. Sandy Creek Wood Manuf'g Co.*, 66 O. G. 1895, 60 Fed. 285. The differences seem to be in phraseology and not in device. Their allowance would "operate to extend or prolong the monopoly beyond the period allowed by law." For this comparison, it does not seem that aid could be afforded by extrinsic evidence; but the question of identity is one of law, which can be determined solely from the face of the patents. *Heald v. Rice*, 104 U. S. 737; *Miller v. Manufacturing Co.*, supra. It is not a question of patentable invention, in the general sense, or of inquiry into the prior state of the art, but only whether or not the subsequent patents are mere duplications or aggregations of the prior patented devices of the same inventor, set out in the same bill. While this determination would ordinarily be left to final hearing, it seems so squarely presented on the face of this bill that exception may well be made in favor of the preliminary ruling here called for.

2. The further point is urged that it appears from the face of the bill that the complainant is the assignee only of rights here under letters patent No. 133,898, and another patent, not in suit. This involves a construction of the instruments of assignment, and beyond any consideration deemed necessary at the former hearing, if it be assumed that the amended bill excludes the granting of any relief under No. 133,898, as an expired patent. This point impresses me as well presented by demurrer, because the bill distinctly pleads these sources of title as allegations of title in complainant; and I think there is much force in the objection that the assignment may not be held applicable to the later patents, but, in the view reached upon the preceding point, do not find a decision necessary.

The questions here raised are fundamental, and if they can be decided at the threshold, and I am right in my views, it will prove a great saving to all parties to have them now determined. If I am mistaken, the correction can be had by an appeal before the large expense in preparation for final hearing shall be incurred; and, in anticipation of that course, I have not deemed it necessary to extend this opinion beyond a statement of my conclusions, especially as there are so many demands upon my time. The demurrer will be sustained, and the bill dismissed for want of equity.

SMITH et al. v. UNION IRON WORKS.

(Circuit Court, D. Minnesota, Fourth Division. November 26, 1894.)

1. PATENT—COMBINATION OF OLD DEVICES.

Claims 1 and 3 of the patent to Frederick Armstrong, No. 445,647, dated February 3, 1891, for an improvement in the shifting device on gang edgers, held valid in view of the evidence, and its use by the defendant enjoined.

2. SAME—PRIMA FACIE EVIDENCE.

The issuance of a patent is prima facie evidence of usefulness, novelty, and patentability, which can be overcome only by reliable and certain proof.

3. SAME—VALID COMBINATION.

A combination is valid when the several elements of which it is composed produce, by their joint action, a new and useful result, or an old result in a cheaper and more advantageous way.

This was a suit by Henry H. Smith and Alvarado Richardson, copartners trading as Smith & Richardson and as the Diamond Iron Works, against the Union Iron Works, to restrain the infringement of certain letters patent.

Paul & Hawley, for complainants.

P. H. Gunckel, for defendant.

NELSON, District Judge. This is an action brought against defendant, the Union Iron Works, of Minneapolis, Minn., by complainants, for infringement of patent No. 445,647, dated February 3, 1891, granted to them as assignees of Frederick N. Armstrong. The infringement alleged is with respect to the first and third claims, which read as follows:

"(1) In a gang edger, the combination, with the movable saws, of a stationary shaft, 13, extending across the machine, the guide bar arranged below said shaft, the bars, 21, mounted upon said shaft, 13, each provided with a recess engaging said guide bar, 15, the saw guides secured to the upper ends of said bars, and engaging said saws, and the pivoted levers engaging said bars, substantially as described."

"(3) The combination, with the saws arranged to move longitudinally upon the saw arbor, of the transverse stationary shaft, 13, the guide bar, 15, arranged below said shaft, the bars, 21, mounted upon said shaft, 13, and engaging said guide bar, the saw guides mounted upon said bars, the curved projections, 27, upon said bars, and the pivoted levers, 29, engaging said projections, 27, substantially as described."

The patentee claims, by a combination of old devices, to have invented a certain new and useful improvement upon the shifting devices used in gang edgers. Defendant admits that it manufactured a gang edger with a shifting device practically the same as complainant's, and upon examination I am of opinion that the slight change in the form of the fastening of the guide bar is not a substantial difference, and that the defendant's shifting device is an infringement, if the Armstrong patent can be sustained.

Defendant contends that the patent is invalid, and that, in view of the prior state of the art, Armstrong's improvement did not constitute invention, but was the product of mere mechanical skill. The issuance of a patent is prima facie evidence of patentability, usefulness, and novelty; and this presumption can be overcome only by reliable and certain proof. It is well established that a combination is valid when the several elements of which it is composed produce, by their joint action, a new and useful result, or an old result in a cheaper and more advantageous way. I think the evidence fairly shows that a better and more advantageous result has been obtained by the complainant's device, and I do not think the patent has been proved to be void for want of novelty.

A decree for an injunction will be entered, each party to pay its own costs.

HUNT BROS. FRUIT-PACKING CO. v. CASSIDAY.

(Circuit Court of Appeals, Ninth Circuit. October 29, 1894.)

No. 157.

1. PATENTS—DAMAGES FOR INFRINGEMENT.

A jury can properly apportion all damages to the second claim of a patent when there is evidence tending to show that the royalty which the patentee had received was for this claim alone, and that the improvement covered by the first claim was not only valueless, but was a detriment to the machine.

2. SAME.

Where damages cannot be assessed upon the basis of a royalty, nor on that of lost sales, nor on that of hurtful competition, the proper method of assessing them is to ascertain what would have been a reasonable royalty for the infringer to have paid, and it is the legitimate province of a jury to determine this fact. *McKeever v. U. S.*, 14 Ct. Cl. 414; *Ross v. Railway Co.*, 45 Fed. 424; *Royer v. Coupe*, 29 Fed. 371; *Cary v. Manufacturing Co.*, 37 Fed. 654.

3. SAME.

Where there is no data from which the value of a royalty can be calculated with mathematical certainty, the damages, like damages in many other classes of cases, are calculable upon such evidence as it is in the nature of the case possible to produce.

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

This was an action at law by John W. Cassiday against the Hunt Brothers Fruit-Packing Company to recover damages for the infringement of certain letters patent. There was a judgment for plaintiff, which was reversed upon writ of error sued out by defendant, and the cause remanded for further proceedings. 3 C. C. A. 525, 53 Fed. 257. At the second trial there was also judgment for plaintiff. Defendant brings error.

Wheaton, Kalloch & Kierce, for plaintiff in error.

Estee & Miller, for defendant in error.

Before GILBERT, Circuit Judge, and MORROW, District Judge.

GILBERT, Circuit Judge. This writ of error is brought to review the judgment upon a second trial of an action at law for damages for the infringement of letters patent No. 172,608, of date January 27, 1876, issued to John W. Cassiday, for improvements in drying apparatus. The improvements covered by the patent refer to that class of fruit driers known as "stack driers," and are embraced in two claims,—the first, for a system of flues for distributing hot air through the stack of trays at different points; the second, for a mechanism to raise the fruit trays vertically, so that a tray may be inserted at the bottom of the stack, and be gradually raised in the process of drying, and finally removed from the top. Only the second claim was shown to have been infringed. At the first trial, the patentee, in endeavoring to establish the measure of damages by proof of an established royalty, furnished proof that the royalty which had been received was for the entire machine, including both the claims of the patent, and did not attempt to segregate the amount due to each claim.