

notice to Drawbaugh, so as to ascertain *prima facie*, and with sufficient certainty for the purposes of an administrative decision, by whom the first invention of the microphone had been made. It would well have been urged on him that it was his duty to make such an investigation of a question which was not in issue in the pending suit, and which the decision of that suit might furnish no guide in determining.

It is objected that there was no established practice in the patent office by which the question of priority of invention could be ascertained, and that, for other reasons, such an application to the commissioner had no prospect of success. It seems to me clear that the duty of the respondent corporation was to test these questions rather than to consent that they must be decided against them, for an acquiescence in the delay seems to me to be no less than a consent that no favorable result could come from the application. That the unwarrantable delay thus caused was intended by the respondent corporation I can have no doubt. In matters of this consequence, involving the whole business of a company of so large capital and engaged in so large affairs, I cannot doubt that they were fully advised, both as to the facts and as to the law; and I think "that their acts were so gross as to forbid any inference except that they dishonestly delayed" the issue of the patent, taking advantage for that purpose of the perhaps excusable willingness of the officials of the patent office to postpone the decision of a sharply debated question, in which a large public interest was involved, on the chance that a decision of the supreme court might supersede the necessity for a decision on their part.

In March, 1888, a final decision was rendered by the supreme court in the action against the People's Telephone Company (8 Sup. Ct. 778), and the claim of Drawbaugh to the invention of the telephone was held to be unfounded. In June, 1886, the examiners in chief of the patent office had decided that Drawbaugh's application was barred by reason of two years' public use of the invention, and the time for an appeal from this decision expired in June, 1888. The commissioner then set on foot a proceeding to determine whether in fact there had been a public use of Drawbaugh's invention for two years before the date of his application; and the Berliner application was still suspended to await the result of an interference which might be declared in case Drawbaugh should prevail in the public-use proceeding, the rule of the patent office being that no interference could be declared unless in cases where the interfering applicant, if successful in the interference proceeding, would be entitled to a patent. This public-use proceeding, whose purpose is to permit the applicant to be heard on the question of public use when that question has been raised by the office, was strenuously objected to by Drawbaugh, who took no evidence in the proceeding. In October, 1891, the proceeding came to an end by a final decision of the commissioner to the effect that Drawbaugh was barred by the prior use of his invention. On the next day the Berliner patent was ordered to issue, "largely because well-settled principles of public policy forbid us to give any further opportunities for holding this application in the office."

There was no effort, so far as I can see in the evidence, on the part of the respondent corporation to prevent this further delay. There was ample evidence before the commissioner of the fact of prior use. The applicant Drawbaugh declined to take evidence in contradiction; and it seems to me clear that the respondent corporation should have urged upon the patent office a decision on the prima facie case which they had made. I am persuaded that the delay thus caused, as well as the delay previous to the decision of the supreme court, was intentionally acquiesced in by the respondent corporation for the purpose of delaying the issue of the patent. This seems to me the only conclusion from a consideration of the whole evidence. It is in proof that during the whole of the time from 1882 to the issue of the patent, and perhaps earlier, the solicitors of the Bell Company were urgently insisting to the officials of the patent office that prompt action should be taken in the application. Even while the "general understanding" was in force, to the effect that the application should await the decision of the Drawbaugh case in the courts, the evidence shows that these urgent applications were made to the patent-office officials. I cannot think that it was by any one expected that such oral applications should have any effect, unless, at least, they were made in support of formal applications made on the record, and of formal arguments and representations made in support of such applications. The officers of the company also testify that at all times they were urgent in pressing for the issue of the patent. As to their state of mind, and their actual intention at the time, I am free to say that I place less reliance on their statements now made than on a single statement made at the time. In February, 1886, while the "general understanding" was in force, Mr. Swan, one of the solicitors for the application, wrote as follows to the president of the Bell Company:

"I am working the Edison and Berliner cases along quietly, and think they will be granted by the examiner without interferences or appeals, so that we can take them out by paying the final fees. We have six months to do that in."

This is but a single paragraph out of many hundreds of pages; but I think it shows clearly what was the purpose of the respondent corporation, consciously formed by their officers, and perfectly understood by their agents at the patent office. The application was to be "worked along quietly," although apparently pushed with great energy. There would be delay, but no substantial obstacle to the grant of the patent; and even after the patent should be ordered to issue there might be a further delay within the limits of the law, and without imperiling the patent. If this letter does not mean this, I am at a loss to know what it does mean. My conclusion, therefore, is that the complainant has made out the case, and that there should be a decree that the patent in question is void, and shall be delivered up to be canceled.

BUFFINGTON'S IRON BLDG. CO. v. EUSTIS.

(Circuit Court, D. Minnesota, Fourth Division. May 1, 1894.)

PATENTS—LIMITATION—IRON-BUILDING CONSTRUCTION.

The Buffington patent, No. 383,170, for improvements in iron-building construction, if valid at all, must, in view of the prior art, be limited to the form and arrangement described in the specifications.

This was a bill by the Buffington's Iron-Building Company against William H. Eustis for alleged infringement of a patent.

P. H. Gunkel, for complainant.

D. F. Morgan and A. C. Paul, for defendant.

NELSON, District Judge. This suit is brought to recover damages for an infringement of letters patent No. 383,170, granted May 22, 1888, to Leroy S. Buffington, for "improvements in iron-building construction." He states: "My invention relates to fireproof buildings, composed chiefly of iron." The usual defenses are made by the defendant. The foundation of this controversy, as stated by counsel for complainant, is a claim for iron-building construction, combining masonry and iron in such a manner that the metal is largely used to carry the entire load of the completed building, whereas formerly the masonry was the principal supporting body of the completed building, and the iron columns, girts, etc., were used merely to stiffen it, while tending to make it fireproof or less combustible. In other words, the patent is for an improved plan of constructing iron and masonry fireproof buildings, and the 14 claims described in the specification constitute the plan of the patent.

The patentee states that the objects of his invention are mainly:

"First, the construction of an iron building in a manner that will practically obviate undue expansion and contraction during the extremes of heat and cold; second, a novel construction and arrangement of the main structure, and of the stairs and elevator shafts, whereby there is attained the necessary strength and stability, together with compactness, and the utilization of the space to the best advantage; and, third, an improved plan of floors, and means of bracing the iron beams in fireproof floors in such structures."

The framing posts of the structure are composed of iron or steel plates,—laminated posts. The joints of these plates are broken, so as to make the framing posts continuous, and by the omission, at proper intervals, of the outer plate, the posts taper from the foundation to the roof.

The bill of complaint alleges that the defendant has infringed, in the construction of an iron and masonry building in the city of Minneapolis, the seventh, eighth, and thirteenth claims of the patent, which are as follows:

(7) In a building frame, a series of continuous framing posts, composed of metal plates secured with their flat sides together, and breaking joints, in combination with girts and tiebeams secured thereto at each floor, substantially as set forth.