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. Gunckel, 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.

(8) The combination, with the laminated posts, of the continuous girts secured thereto, and the tiebeams, also secured thereto and to one another, substantially as set forth.

(13) The combination, with the posts and girts, of the angle plates connecting them, and forming supports for the veneer shelves.

All the material parts of the combination are old. Continuous laminated metal posts, metal tie girts, and angle pieces had been used before the patentee adopted this plan of construction. It was not a new discovery that iron and steel were susceptible to the extremes of heat and cold, and that, when used in the construction of bridges, towers, and other structures, this difficulty would be encountered at the outset, and must be obviated to a greater or less extent. The patentee claims by his improvement in construction to have practically obviated the effect of this expansion and contraction of iron or steel used in buildings. He cannot and does not claim that he was the first and original inventor of an iron and masonry building,—that is, a building composed of any kind of iron or metal and mason work, having exterior walls of masonry of suitable material, supported at proper intervals upon the framework; but he claims to have made an improvement in such structures, consisting of his alleged novel construction and combination of parts described in his specification. Buildings composed entirely of metal, or composed of iron frames encased in concrete, had been described in letters patent before this patent issued to complainant; and these buildings were tied to and bound with the girts connected with the posts by angle pieces riveted thereto, so as to make a complete and durable structure. See patents of Butz, 1884; Sisson & Wetmore, 1872; Fryer, 1869; and Hardy, 1875.

It is doubtful if Buffington's patent is not merely for an aggregation of separate elements, as distinguished from a patentable combination; but, if it be the latter, then, in view of the state of the art, it must be restricted and limited to the form and arrangement described in his specification. Looking at these three claims, which it is charged the defendant has infringed, it is found that the defendant's building has no such specified arrangement of tiebeams and girts, and no such framing posts are used, as are described in the Buffington specification. The defendant, according to the evidence, makes his framing posts of a central iron plate, with what are called Z-shaped irons, riveted thereto. While this possibly may be a laminated plate, from the fact that one plate of iron has another plate lying over a part of it, it is not the framing post composed of metal plates secured with their flat sides together, and breaking joints, described in the Buffington specification. The same may be said of the tiebeams and girts. They are not secured and connected to the posts, nor are they arranged in the same manner as is described in complainant's patent.

In my view, the complainant is limited to the manner of connecting these parts set forth in his specification. The construction of defendant's building, as given in the testimony, upon the view taken by me of the extent of complainant's patent, does not infringe

either one of the seventh, eighth, or thirteenth claims, and a decree must be entered dismissing the bill, with costs. Ordered accordingly.

CUTTER ELECTRICAL & MANUF'G CO. v. CLEVERLY et al.

(Circuit Court, E. D. Pennsylvania. December 18, 1894.)

No. 24.

1. PATENTABLE INVENTION—SUBSTITUTION—ELECTRICAL SWITCHES.
The substitution, in a combination, of one well-known electrical switch for another, without producing any change in function or result, does not involve invention.

2. SAME.
The Cutter patent, No. 437,667, for improvements in electrical switches, *held* void for want of invention.

This was a suit in equity by the Cutter Electrical & Manufacturing Company against Henry A. Cleverly, Frank Stevens, and Samuel Walsh for alleged infringement of a patent.

Duncan & Page, for complainant.
Ernest Howard Hunter, for defendants.

DALLAS, Circuit Judge. This suit is brought for the alleged infringement of letters patent No. 437,667, issued September 30, 1890, to Henry B. Cutter, as joint inventor with and assignee of Lucius T. Stanley, for "certain new and useful improvements in electrical switches"; and the bill contains the usual prayer for an injunction and an account. The patent contains five claims, but only two of them are involved in this controversy, viz.:

(4) "In an electric switch, the combination with a rocking lever constituting a part of the operative parts of the switch mechanism, of a face plate for inclosing said switch mechanism in a suitable receptacle, and push buttons passing through said face plate and connected with opposite ends of said rocking lever, as set forth."

(5) "A spring-actuated electric switch adapted to be inserted in a recess in a wall, and a pivoted lever for operating the same, in combination with a face plate for covering said recess and inclosing said switch, and push buttons passing through said face plate and connected with the lever of the switch mechanism, whereby the switch may be set in action or operation to make or break circuit by pushing one or the other of the said buttons."

No one of the devices mentioned in either of these claims, separately considered, was new. This is true with respect to the character or form of switch employed, as well as of the other details. The complainant's expert testified:

"I do not understand that the general principles of the switch mechanism shown in the Stanley & Cutter patent were new at the date which the patent bears. This is illustrated by the exhibit, Cleveland 1888 patent, in which a switch operating upon a similar principle is shown and described."

It is, however, insisted that a new organism was created by so combining the old devices as to produce the patented contrivance, with its adaptation to be "fitted in a recess, covered by a face plate flush with the wall, and operated by push buttons, like the ordinary

flush or push-button switches, and yet have the capabilities and functions required of switches used generally in systems of electrical distribution." But careful examination of the evidence as to the prior state of the art has forced upon me the conviction that nothing whatever was done by Cutter and Stanley which entitles them to be ranked as inventors. Mr. Cutter admits in his testimony that the Bosworth patent of 1887 shows a flush push-button device for opening and closing a circuit, and that it was his knowledge of that device which led to the "invention" of the device in suit; but he adds that the earlier one, though used for a number of years to control electric gas-lighting burners, requiring electric currents of very low amperage, would not be applicable for the opening and closing of an electric light circuit, because such a circuit would carry an electrical current sufficiently heavy to destroy it. His design, he says, was to provide a device suitable for controlling electric light currents, and "having the same ornamental features as the Bosworth device." In other words, it was proposed to alter that device only to the extent which might be requisite to adapt it for use in connection with electric light circuits; and to effect this purpose no change in the face plate, push buttons, or inclosing receptacle for insertion in a recess in the wall was necessary or was made. The retention of all these parts was needful to produce the same ornamental features as the Bosworth device, and accordingly they were all retained. The only departure from that device consisted in the character of the switch mechanism which was introduced, and that, as already mentioned, the complainant's expert has conceded to be old, and to be shown by at least the Cleveland patent of 1888, as it certainly is. What is relied upon as evidencing invention amounts to nothing more than the substitution, in an obvious way, and without producing any difference in function or result, of the switch of the Cleveland patent and others, for that shown in the Gisborne patent of 1861. It is unnecessary to refer to any of the several patents which have been produced, in detail. Suffice it to say that investigation of all of them constrains the conclusion that the inventive faculty could not reasonably be said to have been exercised in forming the construction for which protection is now asked. The complainant's expert testified that if the combination desired had been clearly placed before him as a "mechanical problem," he would have experienced no serious difficulty in solving it. He added, it is true, that the idea had not occurred to him or to others, but he defines the word "idea," as used by him, by saying that if he had been told the combination in question "had been thought of and was desired" he would have experienced no difficulty in constructing a mechanical device which would have fulfilled the conditions imposed; that "if an intelligent explanation of the idea had been made, * * * skill alone would have been able to produce the combination described." The testimony of the witness cannot, I think, be read without perceiving that he was unable to claim for Stanley and Cutter any other merit than that of having suggested that by simply substituting one well-known piece

of mechanism for another a beneficial result would be obtained,—that is to say, that their conception was a good one, but was not inventive; that their thought was a happy one, but created nothing, because the concrete expression of their idea was already existent, and derived nothing from them but their perception of its more extended applicability. The learned counsel of the complainant has frankly said that "the invention * * * may be summed up in the statement that it was the result of an intelligent conception or idea," and that, "this much [the idea of what was wanted] being once in the minds of the inventors, the rest was very easy"; but, unfortunately for the plaintiff, "the rest" was not only easy,—it had actually been accomplished.

There is evidence that the patented apparatus supplied a want, and that it has gone quite extensively into use; and the witness to whom I have before referred has testified that, although he was in the business, "the idea" had never occurred to him. This kind of testimony is of consequence in doubtful cases, but in the present one the effect of the more direct evidence is conclusive, and therefore no weight can be attached to the proof I have adverted to. Bill dismissed, with costs.

HEATON-PENINSULAR BUTTON FASTENER CO. v. ROONEY.

(Circuit Court, D. Massachusetts. December 27, 1894.)

No. 432.

PATENTS—PRELIMINARY INJUNCTION—BUTTON FASTENERS.

Preliminary injunction against alleged infringement of the Eggleston patent, No. 293,234, for a device for setting a button having a metallic staple, refused because the court was in doubt on the question of infringement.

This was a suit in equity by the Heaton-Peninsular Button Fastener Company against William Rooney, for alleged infringement of a patent. Complainant moved for a preliminary injunction.

Lange & Roberts, for complainant.

John R. Bennett and Wm. B. H. Dowse, for defendant.

COLT, Circuit Judge. The Eggleston patent, No. 293,234, upon which suit is now brought, and which has been duly assigned to the plaintiff, is for a device for setting a button to which a metallic staple is attached. It is composed of a driver, anvil, and guide. The guide contains a groove for the reception of the staple, which is strung upon the eye of a button, and for the passage of the staple and driver during the operation of setting the staple in the fabric. The guide also has two slots for holding the eye of the button; the front slot, i, "for the reception of that portion of the button eye which is between the staple and the button," and the rear slot, n, "for the reception of that portion of the button eye that is below the staple." The single claim of the patent is for the guide, provided with the slot, i, and groove, in combination with the driver and anvil; the groove and slot, i, being so placed with reference to each