

mated in money, the covenant is construed as a penalty. A fortiori is this construction applied to a case like the present, when the only breach established is the nonpayment of rent within the stipulated period, accompanied by proof that the rent then due and all rent subsequently accruing has been paid to the lessors, and accepted by them. "The subject-matter of the contract and the intention of the parties are the controlling guides. If, from the nature of the agreement, it is clear that any attempt to get at the actual damage would be difficult, if not vain, then the courts will incline to give the relief which the parties have agreed to. But if, on the other hand, the contract is such that the strict construction of the phraseology would work absurdity or oppression, the use of the term 'liquidated damages,' will not prevent the court from inquiring into the actual injury sustained, and doing justice between the parties." 2 Sedg. Dam. 215 (399, 400); 1 Pom. Eq. Jur. §§ 433, 444.

In this case, the order of court authorizing the receivers to re-enter and take possession of the leased property was passed on 25th July, 1891. The lease, by its terms, expired September 2, 1891. It therefore had only 38 days to run. It does not appear on what day the receivers actually took possession, but it is quite impossible that any substantial damage could have resulted from the annulling of the lease a few days before the expiration of its term, and the exaction of a penalty of \$5,000 as the consequence of such a default would be grossly excessive and inequitable. The judgment of the circuit court is affirmed, with costs.

PRATT v. LLOYD et al.¹

(Circuit Court, E. D. Pennsylvania. November 8, 1889.)

No. 1.

1. PATENTS—REISSUE—ENLARGING OR NARROWING CLAIM.

A reissue is not invalid for enlargement of specifications and claims, where the specifications contain merely a fuller statement of the ideas originally expressed, and the claims contain nothing which is not expressed or plainly implied in the original; nor for narrowing a claim, where what is omitted from the original is plainly implied, the device being incomplete without it.

2. SAME—INFRINGEMENT.

The Pratt reissue patent No. 7,795, for improvement in door-hanging devices, held not invalid for anticipation or for unwarranted enlargement of specifications and claims, and infringed.

This was a suit by Elias E. Pratt against Lloyd & Supplee to restrain the defendants from infringing complainant's reissued letters patent No. 7,795, dated July 17, 1887, for improvements in devices for hanging car doors. The complainant is a resident of Massachusetts, and the defendants are residents of Philadelphia. The bill asked the usual decree for an injunction and accounting.

¹ See Pratt v. Sencenbaugh, 64 Fed. 779.

The defenses were: First, that the reissue was invalid, because it was not for the same invention as the original patent; second, that by reason of the condition of the prior state of the art complainant's patent was either anticipated, or the invention thereunder claimed does not involve patentable novelty, and for these reasons the patent is void; third, that the defendants have not infringed complainant's patent.

The particular feature of the invention which was involved in the controversy related to claims 2 and 3 of the reissued patent, as follows, viz.: "(2) In a device for hanging the door of a car, the laterally elongated staple or lug, F, constructed and arranged to operate with the trucks, D, and door, G, substantially as set forth and specified. (3) The door, G, lugs, F, trucks, D, and runlet, B, combined and arranged to operate substantially as set forth and specified." The elements recited in these claims are stated by the specification to constitute a door-hanging device, which, in connection with the drawings, is described in the following language: "In the drawing, A represents the side of the car; G, the door; and P, the opening in the car which the door is designed to close. Immediately above this opening there is a runlet, B, attached to the side or body of the car by the screws, x, f. This runlet is provided with inwardly and horizontally projecting flanges or lips, C, C, near its base, forming a track on which the trucks or wheels, D, D, roll or traverse, the door, G, being suspended by means of the staples or lugs, F, F, which work in a slot or longitudinal opening between the flanges, and rest on the axles, z, z, by which the trucks are connected. The upper ends or loops of the staples are flattened or laterally elongated, as best seen in Fig. 4, having a straight horizontal section from d to p. * * * The elongated staples or lugs, F, give free play to the wheels, and prevent the parts from cramping or binding in moving the door. They also materially lessen the friction, the axle, z, rolling on the underside of the lug, F, instead of rotating in a fixed bearing or box, as the door is moved back and forth in opening and closing the same. * * *" The italics indicate the added specifications in the reissue.

Edward Wilhelm, an expert witness on behalf of the complainant, testified in part as follows: "In comparing the specification and drawing of the Pratt reissue, with the specification and drawing of the original patent, I find that they both describe and illustrate the same devices, combined and arranged to operate in the same manner in both. Both specifications and drawings describe and illustrate a door-hanging device comprising an overhead track composed of two parallel rails separated by an intervening slot or space, trucks which run upon the two rails, and which are each composed of two wheels secured to an axle extending transversely over the slot between the rails, hanger irons which are elongated in the longitudinal direction of the rails, and which rest upon the axles between the wheels, and extend downwardly through the slot between the rails and a door which is attached to the hanger irons below the rails, and is supported by these irons. The description of these devices is the same in both specifications, and, in addition to the description and drawing in the original patent, the description of the reissue is somewhat elaborated, as well as the drawings of the reissue, which latter represent in Figs. 3 and 4 enlarged views of the truck and hanger iron, which are not represented on so large a scale in the original drawing. * * * In comparing the second claim of the reissue with the second claim of the original patent, it appears that the element which is designated as the runlet, B, in the second original claim, is absent in the second reissued claim; but it is very obvious that something which takes the place of this runlet must be present as an implied element of the combination of the second claim, and * * * that includes two rails, of any suitable construction, forming a slot between them, and upon which the wheels of the truck travel; so that, including this implied element, the second reissued claim embraces the same number of elements as the second original claim. The remaining question is, then, only whether the elements themselves in the second reissued claim are the same elements, or substantially the same, which are referred to in the second original claim. There is no question that the door, G, and trucks, D, are the same in both claims. The element called the lugs, F, in the second original claim, is identified in the second reissue claim as the laterally elongated staple or lug, F. The original patent states, with ref-

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erence to these lugs, F: 'The elongated staples or lugs, F, give free play to the sheaves, and prevent the parts from cramping or binding in moving the door.' No other staples or lugs are described, and I therefore conclude that the lugs, F, of the second original claim, are elongated staples or lugs, which perform the functions ascribed to them in the specification. With reference to the fourth element of the second original claim, which is designated as the runlet, B, the question is whether the implied element of a double track, with a slot between the rails thereof, the track being suitably supported, is substantially the same device which is designated by the term, 'runlet, B,' in this second claim. * * * It seems to me that, so far as the operation of the other elements of the claim is concerned, this runlet could be replaced with perfect propriety by a runlet which lacks the protective or housing features of the runlet of the patent, and still be a substantial equivalent of the runlet, B. Mr. Hunter (the expert for the defendants) seems to lay too much stress on the protective feature of the runlet, and he seems to lose sight of the fact that the housing of the track, sheaves, etc., is only one of the results which are mentioned in the last paragraph of the specification of the original patent preceding the claims, and he does not at all refer to the other result, which is stated in the same paragraph as follows: 'The elongated staples or lugs, F, give free play to the sheaves, and prevent the parts from cramping or binding in moving the door.' This feature of the patented device is certainly expressed as clearly in the original patent as the protective feature of the runlet."

Geo. W. Hey, for complainant.

Francis T. Chambers, for defendants.

Before McKENNAN, Circuit Judge, and BUTLER, District Judge.

BUTLER, District Judge. An extended discussion of this case is unnecessary.

It is scarcely disputed that the defendants' device infringes the reissued patent. It plainly does infringe.

The defendants' position—that the reissue is void because of anticipation and unjustifiable enlargement of specifications and claims—cannot be adopted.

We do not find anything in the art showing such anticipation.

The reissue we think is fully justified by what appears in the original specifications and drawing and the patent issued thereon. The specifications as well as the drawings plainly exhibit everything embraced. The enlargement of the former is nothing more than a fuller statement of the ideas originally expressed. No additional invention or thought is introduced. The second claim of the reissue, which is objected to, contains nothing which is not expressed or plainly implied in the original patent. On hasty reading the claim may seem to be narrower than the second claim of the original. On careful examination however it appears to be substantially the same as the latter. While the runlet or covered tracks are not expressly named it is plainly implied. The device described would be incomplete without it, or another substantially like it. The analysis and comparison of these claims by Mr. Wilhelm, plaintiff's expert, seems to be accurate, and may be accepted as a fuller expression of the court's views on this subject. We find the second and third claims infringed, and a decree will be entered accordingly.

DIAMOND MATCH CO. v. ADIRONDACK MATCH CO. et al.

(Circuit Court, D. Vermont. January 31, 1895.)

PATENTS—DURATION—FOREIGN PATENTS.

Under Rev. St. § 4887, providing that patents shall be so limited as to expire with any foreign patent for the same invention "having the shortest term," the United States patent does not cease when a foreign patent ceases because of nonpayment of patent office fees for more than a part of the term for which the patent might, on payment of all the fees, remain in force.

Suit by the Diamond Match Company against the Adirondack Match Company and others.

J. W. Russell, for orator.

Hamilton S. Peck, for defendants.

WHEELER, District Judge. This bill is brought upon letters patent of the United States, No. 313,064, dated March 3, 1885, and granted to Ezra B. Eddy, George H. Millin, and Edward Mousseau, of the dominion of Canada, for an improvement in apparatus for dipping matches. The defendants have pleaded section 19 of the Canadian statute of 46 Vict., of May 25, 1883, which provides that:

"The term limited for the duration of every patent of invention issued by the patent office shall be fifteen years, but at the time of the application therefor it shall be at the option of the applicant to pay the full fee required for the term of fifteen years or the partial fee required for the term of five years or the partial fee required for the term of ten years. In case a partial fee only is paid, the proportion of the fee paid shall be stated in the patent and the patent shall notwithstanding anything therein or in this act contained cease at the end of the term for which the partial fee has been paid unless a/ or before the expiration of the said term the holder of the patent pays the fee required for the further term of five or ten years and takes out from the patent office a certificate of such payment (in the form which may be from time to time adopted) to be attached to and refer to the patent."

—That letters patent of the dominion of Canada, No. 20,572, dated November 13, 1884, were granted to the same inventors for the same invention under that statute, subject to the conditions of that act, and to the option of the applicants contained in the patent for the payment of the full fee for the term of fifteen years, or a partial fee for a term of five or ten years, and that a partial fee for five years only has ever been paid, wherefore the Canadian patent expired on November 13, 1889; and they say that for that cause the patent of the United States expired at the same time. This plea has now been argued, and *Bate Refrigerating Co. v. Hammond Co.*, 129 U. S. 151, 9 Sup. Ct. 225, has been much relied upon in argument to support it. The patent in question there was issued in January, 1877, for five years, under, and conformed to, the Canadian statute of 35 Vict., of June 14, 1872, which provided:

"(17) Patents of invention issued by the patent office shall be valid for a period of five, ten, or fifteen years, at the option of the applicant, but at or before the expiration of the said five or ten years the holder thereof may obtain an extension thereof for another period of five years, and after those second five years may again obtain a further extension for another period of five years, not in any case to exceed a total period of fifteen years in all;"