

textile substances and the surfaces of other things. The purpose of the invention of that patent was to utilize maltha in a cold state by dissolving it and holding it in solution by means of a solvent, thus dispensing with the common melting agency of heat. After naming bisulphide of carbon as the best solvent for the purpose, the specification proceeds thus: "Bisulphide of carbon has also great penetrating power, and after evaporation, when the composition is spread on or otherwise applied to a surface, it leaves a solid, dry, firm coat or covering, which is elastic and pliable, and which will protect the surface or substance it is applied to both against the elements and against acids and alkalies." The roofing-fabric patent of September 14, 1886, prescribed the application of maltha alone by the hot method, stating that the results were equally satisfactory whether the hot or the cold method was pursued. Then, not stopping to discuss No. 348,993 and No. 348,994, we have the patent No. 348,995 for "paper painted or saturated with a compound of maltha and bisulphide of carbon." Now, after this lavish issue of patents involving the same subject-matter, and to the same patentees, could the monopoly be still further broadened and prolonged by the grant of a later patent for "paper coated or saturated with maltha" alone? We have no hesitation in responding negatively. Such an extension of exclusive privileges would be a sheer abuse of the patent laws. Assuredly, in view of the prior state of the art, the mere dispensing with the solvent, and the application of pure maltha to paper as a coating substance, did not involve invention. Moreover, as is indicated by the above quotation from the first of these maltha patents, bisulphide of carbon quickly evaporates, and thus paper treated with the compound of the prior patent (No. 348,995), after the evaporation of the solvent, becomes essentially "paper coated or saturated with maltha." In our opinion, this case is clearly within the principle declared in *Miller v. Manufacturing Co.*, 151 U. S. 186, 14 Sup. Ct. 310,—that no patent can rightfully issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ. Upon the case presented by this record, the court below should have dismissed the bill of complaint.

The decree of the circuit court is reversed, and the case is remanded to that court, with a direction to enter a decree dismissing the bill with costs.

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EDISON et al. v. HARDIE.

SAME v. POMEROY DUPLICATOR CO. et al.

(Circuit Court, D. New Jersey. June 15, 1895.)

PATENTS—INVENTION AND UTILITY—INFRINGEMENT—STENCIL SHEETS.

The Edison patent, No. 224,665, for an invention relating to autographic stencil sheets for multiplication of writings, and which consists in the use of a slab having numerous fine points or projections, upon which the sheet is laid, and which are made to penetrate the paper upwardly by the use of a blunt stylus pressed upon the sheet by the hand in writing, sustained, as a meritorious and useful invention, and *held* infringed.

These were suits in equity by Thomas A. Edison and others against William C. Hardie, and against the Pomeroy Duplicator Company and others, respectively, for infringement of a patent relating to autographic stencil sheets for the multiplication of writings.

Dyer & Driscoll, for complainants.

Gallagher & Richards, for defendants.

ACHESON, Circuit Judge. Each of these suits is upon letters patent No. 224,665, dated February 17, 1880, issued to Thomas A. Edison. The invention relates to autographic stencil sheets of paper for the multiplication of writings, etc. The object is accomplished by means of a slab or plate provided with a number of perforating points or projections, closely proximate, upon which a sheet of paper is laid, and the use by the person writing of a blunt stylus, which is pressed on the sheet by the hand with a force sufficient to cause the points or projections of the plate to penetrate the paper upwardly in the lines beneath the stylus. In his specification the patentee states:

"I make use of a slab or plate with a surface of numerous sharp points. Such surface is represented at a, composed of needle points set closely together, or wire points, the extreme ends of which are in the same plane, and the bodies united by solder or cast metal; or the said surface may be a metal plate with its surface scored with grooves that leave the intervening sharp points projecting. \* \* \* A steel plate thus prepared and hardened is preferred."

The claims of the patent are as follows:

"(1) The method herein specified of preparing stencil sheets for printing, consisting in pressing the sheet, in the lines to be printed, against the numerous fine perforating points of a slab, by means of a blunt stylus that is passed over the sheet at the lines to be perforated, and forces such sheet upon the points, substantially as set forth. (2) As an appliance for puncturing stencil sheets by the aforesaid method, the slab, a, having a surface composed of numerous and closely-proximate penetrating points, in combination with a blunt stylus adapted to be moved by hand over the paper to be perforated, substantially as set forth. (3) An autographic stencil sheet, substantially as described, for multiply printing, having perforations that are the largest at the side next the surface to be printed, substantially as set forth."

The defenses of lack of novelty and want of invention are not sustained by the proofs. That the invention was one of decided merit, and is of great utility, the evidence demonstrates. It is satisfactorily shown that Edison was the first to use the plate upon which the stencil sheet rests as the perforating instrument; the stylus being, relatively to the projections of the plate, so blunt that it cannot enter the spaces between the projections, but bridges the projections, and passes freely over them, so as to admit of easy writing. This is the gist of the invention. The Adair patent for a check protector proceeded upon a different principle. By his method the perforation of the paper was effected by the sharp point of the stylus, and not by the corrugated or roughened face of the plate, block, or tablet. His patent calls for a "sharp-pointed stylus," and, as stated in his specification, "the result is that the point of the stylus punches the paper between the ridges of the corrugations, or between the highest points of the roughened surface below."

A careful examination of the proofs and exhibits has satisfied me that the charge of infringement is fully made out. The defendants' stencil plate is a metal plate scored in two directions with fine grooves, which create intervening sharp points, upwardly projecting, and their stylus is blunt, when compared with the points or projections of their plate. In a word, their stylus and the projections or perforating points of their plate are so related to each other as to accomplish the results contemplated and disclosed by the patent in suit, in the manner therein prescribed.

I see nothing in the patent calling for the limitations upon which the defendants insist, namely, that the points on the plate must be "conical or pyramidal in form," and the stylus must be of "some soft or yielding material." No special formation of the points is specified, and, as to the stylus, the only limitation expressed is that it shall be "blunt." The specification states that "any suitable blunt pencil or stylus may be used." In each case there will be a decree in favor of the plaintiffs.

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WOODMANSE & HEWITT MANUF'G CO. v. WILLIAMS et al.

(Circuit Court of Appeals, Sixth Circuit. June 4, 1895.)

No. 267.

1. EQUITY JURISDICTION IN PATENT CASES.

The ground upon which a court of equity takes cognizance of an infringement suit is the relief through an injunction. There is nothing peculiar to infringement suits for damages and profits whereby equity jurisdiction may be maintained, and it must appear that the remedy at law is inadequate.

2. SAME—LACHES OF PATENT OWNER—EFFECT OF ASSIGNMENT.

The negligence or acquiescence of the former owners of a patent in an alleged infringement has, in equity, the same effect upon an assignee's rights as his own neglect or acquiescence.

3. SAME.

Fourteen years' delay by a patent owner and his predecessors in interest, in making any attempt to assert their rights against an alleged infringing company, openly engaged in making and selling a rival and competitive machine, and without even serving notice of infringement, held such laches as to require dismissal of the bill.

4. SAME.

Laches is a defense which may be made by demurrer, or by plea, or by answer, or presented on argument either upon preliminary or final hearing. It need not be formally set up in answer.

Appeal from the Circuit Court of the United States for the Western District of Michigan.

This was a bill by the Woodmanse & Hewitt Manufacturing Company against Bradley S. Williams, Malcolm B. Williams, Homer Manvel, and the Williams Manufacturing Company for alleged infringement of certain patents for improvements in windmills. The circuit court dismissed the bill on the ground of laches, and complainant appeals.