

mining the dutiable value of merchandise, the actual or usual charge for putting up, preparing, and packing for transportation should be added to the cost, or to the general market value, had been repealed by section 7 of the tariff act of 1883 (22 Stat. 523), which provided that none of the charges imposed by section 2907 should be estimated in ascertaining the value of goods to be imported. The question of fact properly before the jury was, whether the appraisers had estimated in accordance with the old or new statutory requirements, and was one upon which the only testimony in the case, that of Mr. Baudoine, was not entirely in harmony with itself. He clearly said that the advances made by him upon the invoice were made to cover the expense of the jobber's cutting the full pieces according to the ordered lengths, of ticketing, taping, or tying them up, and placing them ready for shipment. If these charges of ticketing and preparation for market were added, the appraisement was not in accordance with the statute. Both parties having virtually requested the court to find the facts, they are concluded by its finding, if there was any evidence to sustain it, and the only witness said enough to justify the court's conclusion of fact. *Merwin v. Magone* (not yet officially reported) 70 Fed. 776; *Chrystie v. Foster*, 9 C. C. A. 606, 61 Fed. 551; *Beuttell v. Magone*, 157 U. S. 154, 15 Sup. Ct. 566; *Kirtz v. Peck*, 113 N. Y. 222, 21 N. E. 130.

Since the decisions of *Oelbermann v. Merritt*, 123 U. S. 356, 8 Sup. Ct. 151, and *Mustin v. Cadwalader*, 123 U. S. 369, 8 Sup. Ct. 158, it has not been doubted that section 2930 of the Revised Statutes required that the merchant appraiser in a reappraisement should be familiar with the character and value of the goods, and that, in an action at law to recover an exaction, claimed to have been illegal in consequence of the inability of the merchant appraiser to meet this requirement, the importer, if the objection had been duly taken in his protest, could show by the testimony of the appraiser himself that the provisions of the statute had been disregarded. The question is purely one of fact, which, when submitted to the jury, would naturally be accompanied by some instructions from the court; but, if it is left by both parties to the court, neither can complain, if his opinion is justified by any of the testimony. In this case Mr. Ballin led the court to believe that he was not familiar with the particular class of goods which he was called upon to appraise. The judgment of the circuit court is affirmed.

SCOTT v. HOE et al.

(Circuit Court of Appeals, Third Circuit. December 2, 1895.)

No. 27.

PATENTS—CONSTRUCTION OF CLAIMS—VALIDITY—FOLDING MACHINE.

Claims 1, 2, 3, 8, 9, 17, and 29 of the Crowell patent No. 331,280, for improvements in machines for folding paper and other materials, cannot be construed as covering a process. They are for mechanism for producing a folding operation, and there was nothing in the prior art anticipat-

ing them, or imposing any limitations not prescribed by the plain meaning of their terms. *Held*, therefore, that they were infringed by a machine, differing somewhat in details, but accomplishing the same end in substantially the same way and by substantially the same means. 65 Fed. 606, affirmed.

Appeal from the Circuit Court of the United States for the District of New Jersey.

This was a suit in equity by Robert Hoe and others against Walter Scott for alleged infringement of letters patent No. 331,280, granted December 1, 1885, to R. Hoe & Co., assignees of Luther C. Crowell, for improvements in machines for folding paper and other materials. The circuit court rendered a decree for complainants. See 65 Fed. 606, where the facts are fully stated in the opinion of Acheson, circuit judge. Defendant appeals.

B. F. Lee, for appellant.

M. B. Phillips and Samuel A. Duncan, for appellees.

Before DALLAS, Circuit Judge, and BUTLER and WALES, District Judges.

DALLAS, Circuit Judge. The 32 errors alleged in this case, are, in appellant's brief, resolved into the following propositions:

"(1) Without reference to the state of the art as disclosed by the proofs, the machine constructed by the defendant at Plainfield, New Jersey, for the Montreal Star newspaper, differs so materially from what is described in the specification and drawings of the Crowell patent, No. 331,280, that there can be no infringement of any of the seven claims in controversy.

"(2) In view of the state of the art, as it existed at the date of the complainants' invention, the patent in suit, No. 331,280, cannot be so construed as to bring the defendant's machine within the scope of any of the seven claims in controversy.

"(3) Each of the seven claims in controversy is void for want of invention.

"(4) If the claims said to be infringed cover a process, then there is plainly no infringement. The machine built by defendant at Plainfield, New Jersey, was sold to the Montreal Star, a newspaper published in Montreal, Canada, in which city alone it was used and operated.

"(5) The alleged invention or discovery of the patent in suit was in public use and on sale for more than two years prior to the application therefor."

The first three of these propositions embody the defenses most seriously relied on. Those defenses were fully considered by the circuit court, and the able and earnest argument of the appellant's counsel has failed to convince us that the learned judge of that court erred as to either of them. Both as to the validity of the claims involved and upon the question of infringement, our independent examination of the testimony and exhibits has brought us to the conclusion which was reached by him. We are all of opinion that anticipation has not been established, and that nothing has been shown to call for the imposition of any limitation upon the claims in suit which is not prescribed by the plain meaning of their terms. The appellant's machine is not, it is true, in every detail identical with that of the patent, but in all material respects it is the same. In substantially the same way, and by substantially the same means, it accomplished the same end. That it constitutes an infringement we have no doubt.

The fourth of appellant's propositions is based upon the suggestion that the claims sued on might be held to be for a process, and not for mechanism; but their language cannot be so understood, and there is nothing elsewhere in the patent, or in the evidence, to give color to such a construction of them. If there had been room for question as to their meaning in this respect, the solution of that question would have been for the court; but the court below had no doubt about it, nor have we. The patent is, as it purports to be, for "improvements in folding machines," and for nothing else. The hypothesis upon which this proposition is founded being inadmissible, it of course cannot be sustained.

The fifth proposition has not been very strenuously insisted upon. It is but briefly elucidated in the appellant's printed argument, and, as there explained, it seems to rest upon the suggestion which we have just disposed of, or to involve the assumption of anticipation, as to which we have already expressed our opinion.

Upon the questions of fact presented it would be profitless to enlarge. It is sufficient to say that we concur in the opinion of the circuit court, and its decree is therefore affirmed.

ST. LOUIS CAR-COUPLER CO. v. SHICKLE, HARRISON & HOWARD
IRON CO.

(Circuit Court, E. D. Missouri, E. D. November 30, 1895.)

1. INFRINGEMENT OF PATENTS—RIGHT TO MAKE REPAIRS.

A purchaser of a patented article may use it until it is worn out, and may repair and improve it as he pleases, provided that such repair and improvement do not amount to a reconstruction of the patented invention. *Wilson v. Simpson*, 9 How. 109; *Chaffee v. Belting Co.*, 22 How. 217; *Cotton-Tie Co. v. Simmons*, 1 Sup. Ct. 52, 106 U. S. 89,—followed.

2. SAME—MANUFACTURE AND SALE OF PARTS OF A COMBINATION.

It is an infringement to manufacture and sell that part of a machine which constitutes the peculiar feature of the combination, for the purpose of replacing the same when broken or worn out in the hands of purchasers; and the mere fact that such part is more liable to breakage than other parts does not bring it within the rule which allows the replacing of mere temporary parts, such as the knives of a planing machine.

3. SAME—CAR COUPLINGS.


The "coupling head" or "knuckle," which is the peculiar and unique feature of the combination constituting the improved car coupler of patent No. 519,216 (reissue No. 10,941), though more liable to breakage than other parts of the device, is not a mere temporary part, which may be made and sold for the purpose of replacing a broken or worn-out part without infringing the patent.

This was a bill by the St. Louis Car Coupler Company against the Shickle, Harrison & Howard Iron Company for alleged infringement of a patent for an improvement in car couplers.

Henry M. Post, for complainant.

T. A. Post and Geo. H. Knight, for defendant.

ADAMS, District Judge. The facts in this case are simple. The complainant, being the owner of letters patent of the United States

No. 519,216, and reissued letters patent No. 10,941, for new and useful improvements in car couplings, employed the defendant to manufacture about 1,000 complete couplers, according to the patented device. The defendant proceeded under such employment, and, after finishing the same, continued to manufacture a certain important element or part of the patented device, called in the patent the "coupling head," and generally referred to in the argument of counsel as the "knuckle," and has since then kept a stock of such knuckles on hand for sale, and has sold and disposed of them, without the sanction or authority of the complainant. The defendant claims that it could lawfully manufacture and sell these knuckles to such parties as had purchased the complete device, and who needed a knuckle for the purpose of supplying defective or broken ones in such couplers as they had before that time become possessed of. Complainant's patent is what is known as a "combination patent." For the purposes of this case, it does not seem necessary to more minutely describe the invention than to say that it consists (1) of the draw head, so constructed as to permit the attachment to it of the coupling head or knuckle; (2) the knuckle itself, consisting of a  shaped piece of metal, so connected with the draw head by a pivot pin running vertically through the draw head and through the knuckle as to permit of a partial revolution of the knuckle into a socket made for its reception in the draw head; (3) a locking pin, which, when two cars having these draw heads and knuckles attached thereto come into collision, automatically drops so as to lock the impinging knuckles together. From an inspection of the drawings of the patent and the model used by counsel at the argument, it is manifest that the knuckles or coupling heads are the important features of the combination. In the description of the patented device found in the patent, it is said:

"And when the coupling head is removed from the draw head, which can be done by withdrawing the pin, E, the remaining portion of the construction constitutes a sufficient means, of itself, for coupling with any center-draft coupling."

In other words, as I understand it, the draw heads themselves are so constructed that they may be used with any center-draft coupling; but the coupling heads or knuckles are unique, and can be used only in connection with the draw heads of the combination of this patent. It is these knuckles which the defendant has been manufacturing and keeping in stock for sale to such persons as required them for replacement of broken knuckles in couplings already possessed by them.

No question is raised as to the validity of complainant's patent, or as to the title of the complainant to such patent. At the oral argument it was suggested by defendant's counsel that the evidence failed to show that the knuckles manufactured by defendant embodied the device of complainant's patent. The case, however, discloses that this was never intended by the parties to be disputed, and, even were it otherwise, there is sufficient evidence to make prima facie proof that the knuckles manufactured and sold by de-

fendant involve the invention of the complainant. For instance, in the testimony of William V. Wolcott, president of the complainant company, the following appears, namely:

"Q. You heard the testimony with reference to the various letters patent. Under what letters patent were those couplers manufactured by the Shickle, Harrison & Howard Iron Company? A. The couplers made by the Shickle, Harrison & Howard Iron Company were made under reissue 10,941 and 519,216. Q. Now, will you state how those knuckles or couplers which you say were manufactured by the Shickle, Harrison & Howard Iron Company, after you had transferred your business to other manufacturers, compared or conformed to the letters patent you have just mentioned? A. They were substantially the same as described."

This testimony, taken in connection with that of John M. Harrison, secretary and treasurer of the defendant company, must be held sufficient, in the absence of any testimony to the contrary, to make a *prima facie* case on this point.

The real and only question argued by counsel, and presented to the court for its decision, is whether the knuckles so manufactured and sold by defendant are "repairs," within the meaning of the rule which entitles a purchaser of a patented article to repair it when worn out. The rule gathered from the leading cases of *Wilson v. Simpson*, 9 How. 109, *Chaffee v. Belting Co.*, 22 How. 217, 223, and *Cotton-Tie Co. v. Simmons*, 106 U. S. 89, 1 Sup. Ct. 52,—is that a purchaser of a patented article may use it until it is worn out, and may repair and improve it as he pleases, provided that such repair and improvement do not amount to a reconstruction of the patented invention. Bearing in mind that the knuckle is the chief element in the patented combination, it seems to me that the use of it to supply the place of knuckles worn out or broken in actual use amounts to reconstruction, and not repair. In the *Cotton-Tie Case*, *supra*, the supreme court considered a patented device known as a certain metallic cotton-bale tie, consisting of a band of iron in combination with a buckle. While the patentee manufactured these ties, and stamped on the buckles the words, "Licensed to use once only," the court seems to dispose of the case independently of such stamp, and holds that a person who purchased these ties could not, after having used them, straighten out and rivet together pieces of bands, and cut them into proper lengths, and then sell them with the buckles, to be used as ties; and this, too, notwithstanding the fact that the buckles were not injured, and required no treatment for the second use,—that such use was an infringement. In the case of *Davis Electrical Works v. Edison Electric Light Co.*, 8 C. C. A. 615, 60 Fed. 276, a combination consisting of a carbon filament in use in a vacuum was before the court. The lamp consisted of a glass receiver or bulb, into which the carbon filament is introduced by means of leading-in wires, all so prepared and constructed as to create and maintain a nearly perfect vacuum. The carbon filaments do not last as long as the glass bulb. The defendant in that case undertook to utilize the bulbs after the filament was destroyed by use, by making a hole in it and introducing a new filament, exhausting the air, and closing the hole by fusing a piece

of glass over it. This the defendant justified on the ground that it was repair, and not reconstruction. The court held that it amounted to reconstruction, and enjoined the defendant, as an infringer. To the same effect, also, is the case of *Aiken v. Print Works*, 2 Cliff. 435, Fed. Cas. No. 113. The general principle relied on by defendant's counsel is recognized, that if any element of a combination is temporary in its relation to the whole combination,—that is to say, if it is liable to be often worn out, and if the inventor contemplates that it would have to be frequently replaced anew during the time the machine, as a whole, might last,—such circumstance and intention would entitle an owner of the patented device to procure or manufacture such temporary part at his pleasure, and thereby incur no liability as an infringer. *Wilson v. Simpson*, supra; *Farrington v. Commissioners*, 4 Fish. Pat. Cas. 216, Fed. Cas. No. 4,687; *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, 14 Sup. Ct. 627; *Wallace v. Holmes*, 5 Fish. Pat. Cas. 37, Fed. Cas. No. 17,100; *Schneider v. Pountney*, 21 Fed. 399. But the facts do not support their contention. It appears that these knuckles turned out to be more liable to breakage than the draw head,—the other main element of the combination,—but neither the physical relation of these parts to each other, nor the evidence in the case satisfies me that the knuckle was regarded by the inventor as temporary, and as necessarily requiring to be frequently replaced, in the sense the blades or knives of the planing machine discussed in *Wilson v. Simpson*, supra, were regarded, or in the sense the bits or lips of the auger discussed in *Farrington v. Commissioners*, supra, were regarded. The case of *Wallace v. Holmes*, supra, is one similar in its essential facts to the case at bar. The complainants in that case had a patent for an improved burner in combination with a chimney. The defendants manufactured and sold the burner without the chimney, leaving purchasers to supply the chimney, without which such burner is useless. The court says:

"It is urged that, having made and sold burners only, the defendants are not infringers, though they have sold them throughout the country in competition with the complainants, and have, to their utmost ability, occupied the market, with the certain knowledge that such burners are to be used by the addition of a chimney. Manifestly, there is no merit in this defense," etc.

This knuckle is not an ordinary tool or piece of mechanism, which can be procured at any general hardware store, but is unique, and can be used only in connection with the balance of complainant's device. There can be no doubt, therefore, that the defendant intended to manufacture and sell the knuckle to be used in, and as forming an important and essential part of, the complainant's patented device. If the defendant can do this with impunity, it, or any other person, can certainly manufacture and sell the other less important parts, and thereby the value of complainant's monopoly will be limited to the first sales made by it. This cannot be the law. A decree may be prepared finding that defendant infringes, and for an injunction and accounting.

LOWELL MANUF'G CO. v. HOGG.

(Circuit Court, D. Massachusetts. December 3, 1895.)

1. DESIGN PATENTS—INFRINGEMENT — MARKING "PATENTED"—PLEADINGS AND PROOF.

Where a bill for infringement of a design patent fails to allege that the articles were marked "Patented," and the answer makes no denial of the fact, it is still open to defendant to make that defense, not only in respect to the penalties prescribed by the act of February 4, 1887 (24 Stat. 387), and damages, but also in respect to an accounting of profits. *Dunlap v. Schofield*, 14 Sup. Ct. 576, 152 U. S. 244, and *Coupe v. Royer*, 15 Sup. Ct. 199, 155 U. S. 565, applied.

2. SAME—AMENDMENTS TO BILL.

Where infringements were not willful, were few in number, and were discontinued upon notice of complainant's claims, the court declined, after final hearing, to permit an amendment to the bill by inserting an allegation that complainant's articles were marked "Patented."

This was a bill in equity by the Lowell Manufacturing Company against William J. Hogg for alleged infringement of a design patent.

Witter & Kenyon, for complainant.

Louis W. Southgate, for defendant.

PUTNAM, Circuit Judge. This is a bill in equity based on the infringement of a patent for a design. It prays for an injunction, for the enforcement of the penalties imposed by the act of February 4, 1887 (24 Stat. 387), for profits in excess of those penalties, and for damages. The bill failed to allege that the patented articles were marked as provided by sections 4900 and 4933 of the Revised Statutes, and the answer made no denial of this fact. Apparently, under *Rubber Co. v. Goodyear*, 9 Wall. 788, 801, the point could not be taken by the defendant, so far at least as applies to an accounting for profits. But this case was explained in the later case of *Dunlap v. Schofield*, 152 U. S. 244, 249, 14 Sup. Ct. 576, and under it and *Coupe v. Royer*, 155 U. S. 565, 583, 15 Sup. Ct. 199, it is open to the defendant here, so far at least as concerns the damages and penalties claimed. The principle applies as well to an accounting for profits, which, after all, is only one form of damages. The discussion in *Rubber Co. v. Goodyear*, where only profits were involved, went on this theory, and the same with *Sessions v. Romadka*, 145 U. S. 29, 49, 12 Sup. Ct. 799.

The defendant does not deny that the complainant is entitled to an injunction, but maintains that it is not entitled to the other relief prayed for, by reason of the want of allegations and proofs with reference to sections 4900 and 4933; and, as the record stands, the case on this point is with him. The complainant, however, now moves that the record be reopened to enable it to offer proofs that it complied with section 4900. Waiving the questions whether this would be effective without also amending the bill, and whether equity can enforce the penalties sought to be recovered, we cannot grant this motion. The answer denies that the defendant infringed after he had actual knowledge of the existence of the patent, and, under the circumstances of the case, we are not satisfied that his infringements were willful. They were few in number and within a period of four