

sented that question for determination. In disposing of the appeal of the commission, the supreme court declared as follows:

"Whether congress intended to confer upon the interstate commerce commission the power to itself fix rates, was mooted in the courts below, and is discussed in the briefs of counsel. We do not find any provision of the act that expressly, or by necessary implication, confers such a power. It is argued on behalf of the commission that the power to pass upon the reasonableness of existing rates implies a right to prescribe rates. This is not necessarily so. The reasonableness of the rate, in a given case, depends on the facts; and the function of the commission is to consider these facts, and give them their proper weight. If the commission, instead of withholding judgment in such a matter until an issue shall be made and the facts found, itself fixes a rate, that rate is prejudged by the commission to be reasonable. We prefer to adopt the view expressed by the late Justice Jackson, when circuit judge, in the case of *Interstate Commerce Commission v. Baltimore & O. R. Co.*, 43 Fed. 37, and whose judgment was affirmed by this court (145 U. S. 263, 12 Sup. Ct. 844): 'Subject to the two leading prohibitions that their charges shall not be unjust or unreasonable, and that they shall not unjustly discriminate, so as to give undue preference or disadvantage to persons or traffic similarly circumstanced, the act to regulate commerce leaves common carriers as they were at the common law,—free to make special contracts looking to the increase of their business, to classify their traffic, to adjust and apportion their rates so as to meet the necessities of commerce, and generally to manage their important interests upon the same principles which are regarded as sound, and adopted in other trades and pursuits.'

These views of the supreme court decisively show that the interstate commerce commission is not clothed with the power to fix rates which it undertook to exercise in this case. The petition of the interstate commerce commission must be dismissed. Let a decree to that effect be drawn.

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FRENCH et al. v. ALTER & JULIAN CO. et al.

(Circuit Court, S. D. Ohio, W. D. June 1, 1896.)

No. 4,895.

**TRADE-MARK—PRELIMINARY INJUNCTION.**

A preliminary injunction upon a trade-mark which has not been established by adjudication will not be granted, where defendant's affidavits indicate a prior use, though it be doubtful whether the same was not abandoned.

This was a bill in equity by French, Shriner & Urner against the Alter & Julian Company and others for alleged infringement of a trade-mark. Complainants moved for a preliminary injunction.

Fish, Richardson & Storrow and Joseph Willby, for complainants.  
Wood & Boyd, for respondents.

SAGE, District Judge. The motion for a temporary injunction is overruled, for the reason that affidavits filed on behalf of defendants indicate prior use of the trade-mark claimed by complainants. Whether such prior use is established, and, if so, whether it was limited and has been abandoned, is in dispute, and need not now be determined. It is sufficient to say that, the complainants' title to the

trade-mark not having been established by adjudication, and being now called in question, the doubt is enough to authorize the court, in its discretion, to refuse a temporary injunction, and leave the question for determination upon the final hearing.

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AMERICAN GRAPHOPHONE CO. v. AMET.<sup>1</sup>

(Circuit Court, N. D. Illinois. April 6, 1896.)

**1. PATENTS FOR INVENTIONS—PATENTABILITY—COMBINATION—GRAPHOPHONE.**

Letters patent, No. 341,214, issued to Bell & Taintor, May 4, 1886, for an improvement in recording and reproducing speech and other sounds, consisting of the combination with a grooved tablet, or other body, having a sound record formed therein, of a reproducer having a rubbing style loosely mounted so that it is free to move laterally, and thus adjust itself to the groove, are not void for want of invention.

**2. SAME—INFRINGEMENT.**

Such patent is infringed by a device in the essential characteristic of a loose joint, so as to enable the style to follow the groove of the record, and only used in connection with a sound record made by the patentee, since in the practical use of such device one of the elements of said patented combination is actually and necessarily employed.

**3. SAME—ABANDONMENT—SALE OF PART OF COMBINATION.**

The sale of such sound records by the patentee, in the open market, apart from the rest of the machine, does not release that element of the patented combination from the monopoly of the patent.

**In Equity.**

Suit for injunction by the American Graphophone Company against Edward H. Amet.

Poole & Brown and Pollok & Mauro, for complainant.  
Munday, Evarts & Adcock, for defendant.

GROSSCUP, District Judge. The bill is to restrain the infringement of letters patent No. 341,214, issued to Bell & Taintor, May 4, 1886, and also letters patent No. 341,288, issued to S. Taintor, of the same date. The first patent is for an improvement in recording and reproducing speech and other sounds; and the second, for an improvement in apparatus for recording and reproducing sounds, or sonorous vibrations. The defendant contests the validity of complainant's patents, and denies infringement.

Bell & Taintor lay no claim to having conceived the idea of a mechanism whereby speech or sound could be recorded and reproduced. Much thought and experimentation, before their patents were completed, were expended upon the general conception of such an instrument. But the fact remains that, prior to their graphophone, the conception of a phonograph had never been mechanically worked out to the extent of practical perfection. The graphophone, indeed, seems to have taken the place of all previous mechanisms, and to have advanced by a very large space, the art of recording and reproducing speech and sounds. All graphophones, or phonographs, are based upon the natural law that speech or sound impart to the surrounding air vibrations of a form and character exceptional to the peculiar

<sup>1</sup> Petition for rehearing pending.

speech and sound. Such air vibrations, pressing upon a diaphragm, set it into vibrations, either bodily or molecularly, corresponding to the air vibrations. The same form of air vibrations will always produce the same form of diaphragm vibrations. Conversely, the same form of diaphragm vibrations will reproduce the same form of air vibrations. The form of diaphragm vibrations, therefore, which, through the medium of the air vibrations, are the result of a particular speech or sound, will themselves, when the operation is inverted, reproduce like speech and sound. It was not difficult, at the time of complainant's patent, to convert air vibrations into their corresponding diaphragm vibrations, or diaphragm vibrations into their corresponding air vibrations. That was practically the telephone. The problem presented was to deposit in some substance these diaphragm vibrations, where, at will, they might be taken up and imparted to another diaphragm, which would transform them into air vibrations. The chief mechanical problem before the inventors was the making of a suitable and practical substance of deposit or record. The complainants accomplished this by providing, as a substance for the record, a compound of beeswax and paraffine, slightly cohesive and amorphous. Upon this was traced, by means of a cutting style, connected with the sound-receiving diaphragm, and vibrated by it, grooves whose vertical undulations corresponded with the vibrations imparted. The style, cutting these grooves, removed all the material necessary to be displaced, and thus left the surface and density of the substance as it was before, except for the grooves. These grooves were cut with sloping walls, into which another style, corresponding with the first, would easily fit. This second style, resting upon these grooves by gravity, and being of the proper weight, doubtless ascertained by experimentation, and being moved along the grooves by mechanism provided for that purpose, imparted to a second diaphragm the vibrations incident to the elevations and depressions of the bottom of the groove. The effect of the whole is to give to the second diaphragm a series of vibrations so nearly like those of the first that the air waves thereby set in motion will correspond very nearly to the air waves which, in the first instance, set the producing diaphragm in motion. In the view I take of the case, it is unnecessary to go in detail into the other and subsidiary features of the mechanism, which were calculated simply to make it more effective. Claim 22 is as follows:

"The combination, with a grooved tablet, or other body, having a sound record formed therein, of a reproducer having a rubbing style loosely mounted, so that it is free to move laterally, and thus adjust itself to the groove, substantially as described."

And claim 24 is as follows:

"The combination, with a sound record formed in a wax, or a wax-like material, of a reproducer having a rubbing style for receiving sonorous vibrations from said record, substantially as described."

It will be seen that, in order to follow the groove accurately, the reproducer must be loosely mounted, and this is accomplished by

the universal joint described in the patent. Much stress was laid by counsel for complainants upon the patentability of the adaptation of this universal joint to the purpose of a graphophone. If the validity of the patent depended upon this contention, I would be disposed to hold against it, for I can see nothing novel about the joint, except its new use; and such adaptation to new use is not, in my judgment, patentable invention. But while this element, separately considered, is not invention, the combination which embraces it, in my judgment, is. Such combination is the mechanical means whereby the art of recording and reproducing speech and sounds is first made practically effective. To deny to it the dignity and quality of invention would be to deny the patentability of every first great mechanical success. The substance upon which the record is cut, and the reproducer thus loosely mounted, by which it is enabled to follow the undulations of the groove, together constitute an effective portion of the mechanism. Either, without the other, would be useless for the purpose of a graphophone or phonograph. Together they bring about a successful result. They therefore constitute a patentable combination. The defendant's device, in the essential characteristic of a loose joint, so as to enable the style to follow the groove of the record, is like the complainant's reproducer. It is intended to perform the function of imparting to a diaphragm the vibrations consequent upon the undulations in this groove. Without the complainant's record the defendant's device would be useless. It is never used except in connection with complainant's record. In the practical use, therefore, of defendant's device, one of the elements of complainant's combination is actually and necessarily employed.

It appears, however, that these records are sold by the complainant on the open market, and it is contended that such sale releases this element of the combination from the monopoly of the patent. I do not concur in this view. To make the graphophone more widely useful, the complainants make many records, embodying music, speech, and other sounds, and distribute these, by sale, to the users of the phone. But the record thus distributed remains an integral part of the combined mechanism. It is not a product of the machine, but still a part of it. It is not unusual, in many mechanisms, that some elements of their combination must be more frequently renewed than others. The sale of such parts, segregated from the machine, is only the replenishing of the combination by a substitution of a new element for the one worn out. Such action does not break the patentability of the combination. So, in this combination, substitution by sale of one or many records for another, though not due to the same necessity, ought to receive the same consideration. The keys of a piano may be replaced without releasing the combination of which the keys are an element from the monopoly of a patent. I can see no reason why the record of a graphophone may not, though for a different purpose, be likewise replaced without breaking the validity of the combination. Inasmuch, therefore, as defendant's device is only to be used in connection with one of the elements of complainant's patentable combination, I am of the opin-

ion that it infringes such combination as is expressed in claims 22 and 24, already quoted. A decree will therefore be entered for an injunction and accounting.

For decree, see 74 Fed. 1008.

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EXCELSIOR ELEVATOR GUARD & HATCH COVER CO. v. FOOTE et al.

(Circuit Court, S. D. New York. April 24, 1896.)

PATENTS—INVENTION—ADAPTATION OF EXISTING DEVICES—HOISTWAY COVERS.

The Fraser patent, No. 278,528, for means for closing and controlling hoistway covers, consisting of a combination of a number of doors, a cord or chain, a number of catches, and a connection between the catch of one door and an adjacent door, so that the closing of the latter will release the former, and admit of its closing, *held void*, as disclosing only mechanical skill in modifying and adapting pre-existing devices; and, even if patentable, *held not infringed*.

Lawyer & Edwards, for complainant.

S. O. Edmonds, for defendants.

TOWNSEND, District Judge. The complainant herein alleges infringement of the first claim of its patent, No. 278,528, for means for closing and controlling hoistway covers, granted to Daniel Fraser May 29, 1883, which claim is as follows:

"(1) The combination, with a number of hinged doors and a cord or chain for opening and closing them, of a number of catches for engaging with the doors when opened, and serving to hold them open independently of the cord or chain, and a connection between the catch of one door and an adjacent door, so that the closing of the last-mentioned door will effect the release of the other door from its catch, and admit of its closing, substantially as specified."

The chief defenses are lack of patentable novelty and denial of infringement. The patented improvement relates to devices for automatically closing elevator doors, hinged on one side of the elevator shaft, and opened and closed by cords or chains operated with pulleys, and having catches to engage said doors when opened. The prior art, as illustrated in patent No. 84,387, granted February 24, 1868, and reissued April 29, 1873, to James D. Sinclair, showed every element of the claim in suit except the fourth, said "connection between the catch of one door and an adjacent door."

The president of the complainant company admits that, long prior to the alleged invention of Fraser, he sold an apparatus in which each catch was operated by hand by means of a separate rope. What Fraser did was to substitute for the operation of said catches by hand their automatic operation by means of a rope connection between each door and the next succeeding catch, so that, as the first door closed, said rope caused the succeeding catch to disengage from its door, and to permit it to descend. In this way a successive automatic closing was accomplished. Patent No. 261,286, granted July 18, 1882, to Samuel W. Willard, showed, in a somewhat unwieldy contrivance, the idea of so connecting such hatchway doors that the operation of opening one of the doors caused another door on another floor to be automatically opened. Other devices in this art