

LUBLIN v. STEWART, HOWE & MAY CO. et al.

(Circuit Court, D. New Jersey. June 12, 1896.)

1. PATENTS—INVENTION—DRESS STAYS.

The Bray patent, No. 440,246, for an improvement in dress stays, which is designed to prevent the steels from breaking their covering and working out longitudinally, is void for want of invention, in view of the Curtis patent, No. 243,519, for an improvement in the back of corsets.

2. RES JUDICATA—QUESTIONS LITIGATED—PATENT CASES.

Where, in a patent infringement suit, defendants did not deny the validity of the patent, but claimed a license under it to sell the patented articles, and the existence of such license was the only issue litigated, *held*, that a decision in favor of complainant did not estop defendants from questioning, in a subsequent suit, the validity of the patent.

This was suit in equity by Oscar Lublin against the Stewart, Howe & May Company and others for alleged infringement of letters patent No. 440,246, issued November 11, 1890, for an improvement in dress stays.

C. E. Mitchell and H. B. Brownell, for complainant.

William A. Jenner and C. Godfrey Patterson, for defendants.

GREEN, District Judge. The complainant, who claims to be the owner of an undivided one-half interest in letters patent No. 440,246, files this bill of complaint against the defendants to enjoin them from further infringement of the letters patent in question. The letters patent were granted on or about November 11, 1890, to one Morris P. Bray, for an "improvement in dress stays." The patentee, Bray, who was the owner of the other undivided half interest, is made a party defendant, because, as it is stated in the bill of complaint, he refused to become a party complainant in this action.

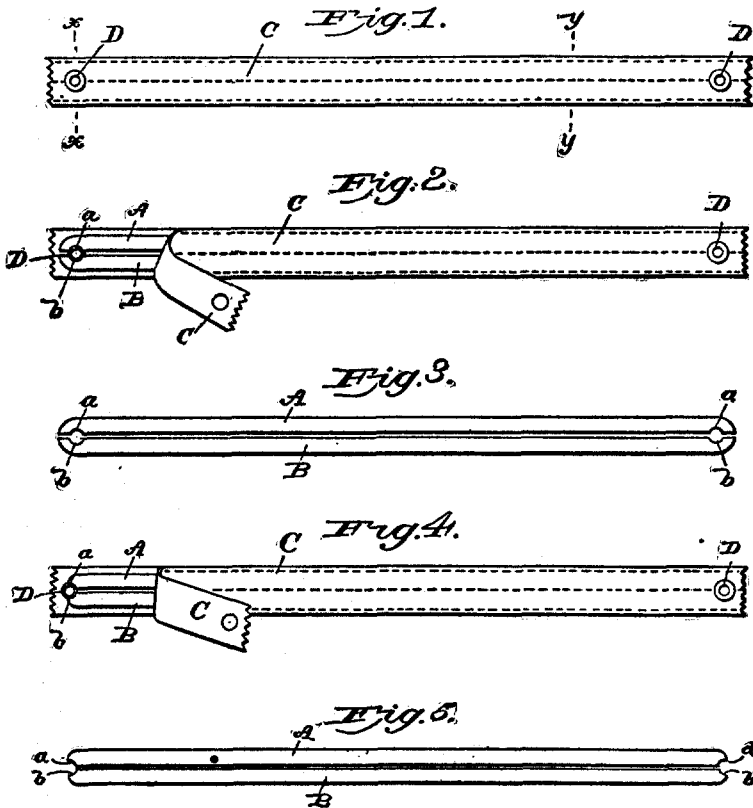
The bill of complaint contains, among other things, an allegation of the grant of the letters patent to Bray; the assignment by him to the complainant of an undivided half interest therein on or about May 2, 1891; the formation of a partnership between Bray and the complainant to manufacture and sell dress stays under the letters patent; the actual manufacture and sale thereof under the partnership agreement, and the manufacture and sale of the identical dress stays by all the defendants other than Bray, in direct violation of the rights of the complainant, and in infringement of the letters patent, to the great pecuniary loss of the complainant; and a prayer for an injunction, an accounting, and for such other equitable relief as should be pertinent to the issue.

The defendants, at first jointly answering, made no attack upon the validity of the letters patent, but, practically admitting such validity, based their defense upon an alleged legal right to make and vend the stays in question, claiming that by virtue of various mesne assignments from Bray, the patentee, to them, or to some of them, they had acquired an interest in or a title to the letters

patent. Upon this allegation issue was joined and testimony was taken. During its progress, all the defendants except Bray moved the court for leave to file an amended answer, by which they changed the ground of their defense very materially. As heretofore stated, in their original answer no attack upon the validity of the letters patent in question was suggested. But by their amended answer that validity was seriously drawn in question, and it was asserted that the invention thereby protected was wholly wanting in patentable novelty, and that it was in fact fully anticipated by an invention made by one Curtis for an improvement in corsets, and for which letters patent had been granted to him June 28, 1881. Under the somewhat peculiar circumstances which surrounded this case, although not without hesitation, leave to file the amended answer was granted, and thus was raised what has become the chief issue in this litigation.

The patent involved in this suit is for certain "new and useful improvements in dress stays." The patentee carefully limits his invention by the words of description. He says: "My present improvement has nothing to do with the construction of dress stays proper, but pertains solely to the securing of the ends of the steels (stays) to the outer covering." "Heretofore the main difficulty with twin stays has been owing to the longitudinal displacement of the steels for want of a proper fastening device, but my invention overcomes this difficulty, and at the same time leaves the stay flexible throughout its entire length." The longitudinal displacement of the stay to which the patentee refers consists in nothing more or less than the movement of the stay in the cover or pocket in which it is confined on the corset or dress waist, caused by the movement of the body of the wearer. Such movement of the body, communicating pressure to the stay, causes it to bend, shortening its length for the time. Upon reaction of the body, the pressure upon the stay would be relaxed, and its forced curvature would cause it to spring back to its original longitudinal position with considerable force. This would tend to cause the end of the stay to strike against the top or bottom of the covering or pocket in which it was placed, with the necessary and consequent result of a wearing away or a rupture, or at least a fraying of the covering fabric, permitting the protruding end of the stay to penetrate the other clothing, if not the person, of the wearer. This had been a serious difficulty to the success of metallic dress stays, and it had engaged the attention of not only Bray, the patentee, but as well of others, interested in overcoming it. Bray had, as early as 1881, sought to obviate the difficulty by reinforcing the ends of the pockets or covers of the stays with metallic tips of sufficient strength to resist the destructive action of the stay, but his invention, although a decided improvement, was not completely successful. Finally he made the improvement which is involved in this suit, and the result has been, as is shown by the testimony, that he has produced a popular, effective, and the least destructive substitute for the old and displaced whalebone stay which the trade has known.

And this is how he accomplished such result. He says, referring to the drawings, here reproduced:



"At or near the ends of the twin steels, A, B, are circular complementary recesses, a, b. When the steels are within the covering, C, an eyelet, D, is inserted through the recesses and covering, and clamped, thus securing the steels in position within said covering. The eyelet fits the recesses snugly, so that there can be no displacement of the several parts of the stay. The recesses may be formed in the steels a short distance from the ends thereof, as shown in Figures 2 and 3 (of the patent), or said recesses may be formed within the ends of the steel, as shown at Figures 4 and 5, it being immaterial where the recesses are formed, so long as they are near the ends of the steel, so as not to interfere with the stitching of the stay within the garment."

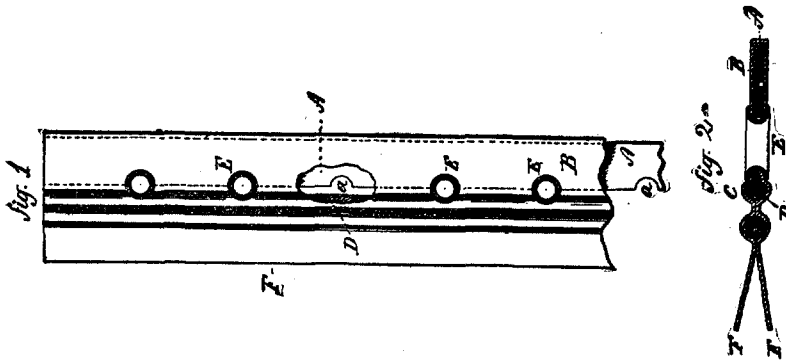
The first claim of the patent, which is the only one which need be considered, is as follows:

"(1) In a dress stay, composed of twin steels within a suitable covering, the combination of the steels having circular complementary recesses, with an eyelet secured to the covering through said recesses, substantially as shown and set forth."

The main question to be considered is this: Does this combination show patentable novelty in view of the state of the art, having especial regard to the invention of Augustine B. Curtis for an im-

provement in corsets, secured to him by letters patent No. 243,519, dated June 28, 1881? What is the invention of Curtis? He says that his invention relates "to an improvement in the back of corsets; that is to say, in the section at each of the rear edges, and in which the eyelets are placed for lacing. It is a common practice to place a bone or stay at the edge, and in rear of that stay to introduce the eyelets, the eyelets being arranged so that the strain (of the lacing) comes entirely on the fabric. The result is that the fabric soon yields, and the eyelets are easily detached. To obviate this difficulty, in some cases, a broad stay has been introduced, with perforations through the stay and fabric, and the eyelets inserted in said perforations; but this necessitates so broad a stay that the expense is too great for practical use, and, further, the large perforation in the center of the stay so weakens it that it breaks to such an extent that, aside from its cost, it is impracticable." The object of this invention is to overcome this difficulty, and it consists in the construction as hereinafter described, and particularly recited in the claim.

Fig. 1 and Fig. 2 represent the invention, as follows:



—and the patentee thus describes it:

"I first make a stay, A, of metal, and upon one edge cut a series of notches, a, corresponding to the position where the eyelets, E, are to be introduced. This stay is introduced into a pocket, B, at the edge of the corset, and in rear of the pocket, B, a second pocket, C, is formed, into which a cord or other flexible stay is introduced, and distant from the edge of the stay, A, less than the diameter of the eyelet, as seen in Fig. 1, where a portion of the outer fabric is cut away to show the stays, A and D, in their proper relative position. The fabric is perforated at the notches, a, in the metal stay, and at the side of the flexible stay, D; then eyelets, E, introduced, and struck down onto the metal stay around the notches, and also on the flexible stay, as seen in Fig. 2. The metal stay forms a support to take the strain of the eyelets, and, being unyielding, firmly retains the eyelets in their position. The flexible stay, D, gives a thickness at the opposite side of the eyelet corresponding to the metal stay, so that the eyelets will close firmly upon that edge. The stay, D, is here represented as a cord, but it will be understood that it is only necessary that it should be of such a character as to thicken the corset upon that side of the eyelets, so that the closing of the eyelets may be firm and strong upon the fabric; hence by the term 'stay, D,' I wish to be understood as including any thickening of the fabric upon that side of the eyelets. The fabric which forms the rear section extends beyond the stays in the shape of a double

flap, F, F, for attachment to the adjoining section. As these sections are straight, and of equal width from top to bottom, they may be made as an article of manufacture independent of the corset, and furnished to corset manufacturers to be attached to corsets, or to the wearer for the alteration or repair of corsets."

The only claim made is this:

"In the back section of a corset, a notched stay, A, introduced in a pocket at the rear edge, combined with a flexible stay at the side of the metal stay, and eyelets introduced through the fabric at the notches in the metal stay, and struck down around the respective notches and onto the flexible stay, substantially as described."

Even a casual reading of the specification and of the claim discloses the intent of the inventor. It was definite in its avowed purpose. The end to be accomplished was the providing of a sufficient and permanent support to the eyelet. The work of the metal stay was to bear the strain put upon the eyelet by the lacing cord, and, being unyielding in its nature and from its construction, with the eyelets used as rivets, not easily displaced, it retained the eyelet firmly in its position. It was the destructive strain upon an unsupported eyelet, and the necessary yielding to that strain by the eyelet, equally destructive to itself and to the fabric in which it was inserted, that demanded remedy from invention. Movement of the eyelet was the difficulty to be overcome. Curtis did overcome it, and made the eyelet immovable by clamping it to a metallic stay, rendered incapable of displacement by the eyelet itself. That clamping made it practically a component part of the stay, and it gathered to itself both the rigidity and immovability which characterized its supporting base and to which it clearly contributed. The vexatious problem had at last been solved.

From this brief statement of the design of the Curtis invention it seems very difficult to differentiate the Bray invention from it, to such a degree, at least, as would dignify the latter with inventive ability. Curtis sought to obtain immovability and rigidity of the elements with which he was dealing,—that is, the eyelet and the reinforcing stay,—and this he obtained by using a steel stay, properly notched, and fastened by an eyelet clamped through the notches in the steel upon the underlying fabric, holding the steel permanently to the fabric. Mr. Newbury, the expert witness for the defendant, in comparing the Curtis invention with the Bray invention uses the following words:

"Now, comparing the stay shown in this Curtis patent with the one shown in the patent in suit, I find that the stay of the Curtis patent is composed of an outer covering or fabric, in which there are pockets, formed parallel with each other. In one of these pockets a steel is inserted, said steel being provided with notches, or, as termed in the patent in suit, with 'complementary recesses,' and the outer covering is perforated opposite these complementary recesses or notches, and eyelets, which serve as rivets, are inserted, so that they form abutments or stops which prevent the longitudinal movement of the steel in the pocket. In this respect the stay of the said Curtis patent is identical with the stay shown in Figs. 1, 2, and 3 of the patent in suit. There is also the same co-action between the pocket, complementary recess, and eyelet or rivet of the stay of this Curtis patent that there is between the pocket, complementary recess, and eyelet of the patent in suit. In each case the eyelet occupies a portion of the space of the pocket, the complementary

recess permitting this, and affords an abutting surface to abut against the eyelet, and in this way prevent a displacement of the parts."

And this seems to be an impartial and just statement of the similarity between the two. The fact that the eyelet in the Curtis invention may be, and was primarily designed to be, used for the lacing cord, does not detract from the conclusion of this expert witness as to the practical identity of the two inventions. Such use is simply an additional function of the eyelet. It would in no manner modify or lessen the co-action of the stay, of its covering pocket, and of the eyelet in preventing displacement of the various component parts; for, whether the lacing cord be inserted through the eyelet or not, the immobility of the stay remains undisturbed. The action is reciprocal. The eyelet as a rivet secured the stay; the stay as a base secures the eyelet. Both from this reciprocal action become fixed and immovable. It is hardly necessary to say that, stripped of all technicalities, this alleged invention of Bray simply fixes in a receptacle prepared for it a steel stay by means of rivets (eyelets) driven through the stay and the covering fabric; that, and nothing more. But to obtain immobility by the use of rivets is certainly far removed from the domain of inventive thought. Given the stay as described by Curtis, surely a person of ordinary mechanical skill, seeing the effect of the riveting eyelet upon the metallic base, could produce the improvement which Bray accomplished. The same elements are in both; the action is not dissimilar; the use so nearly analogous that the applicability of the device to the alleged new use would occur to any one with ordinary mechanical skill. These things being so, the claim of invention vanishes.

But it is insisted by the complainant that the defendants are estopped from attacking now the validity of this patent. It is charged in the bill of complaint that on or about the 29th day of January, 1892, said Bray and your orator brought a suit in equity in the United States circuit court in and for the Second circuit and Southern district of New York against E. J. Denning et al., alleging infringement by them of said letters patent No. 440,246, by reason of their sale of the dress stays made by said Stewart, Howe & May. That thereupon the said Stewart, Howe & May assumed the defense of said suit, and, answer and replication being duly filed, testimony was taken at great length for both sides, and in due course the said cause came on to be heard at the April term, 1893 (56 Fed. 1019) of said court before the Honorable Hoyt H. Wheeler, who, after hearing counsel for both sides, and after due consideration, filed his decision therein in favor of the complainant in said suit, and thereafter a decree was duly entered therein, a certified copy whereof is hereto annexed, and made a part of this bill. It further appears that after this favorable judgment this cause was carried by appeal to the circuit court of appeals for the Second judicial circuit, and in an opinion there rendered (10 C. C. A. 7, 61 Fed. 652) it was declared: "As the record title to the patent is in the complainant, its validity in no way assailed, and infringement conceded, defendants can justify their dealing in the articles

only by showing that they had the right to sell them. This they seek to do by proving that Stewart, Howe & May manufactured the articles under a license;" and the judgment of the court was that the defendants had failed in this particular. And the insistence of the complainant is that from this judicial determination by the court arises an estoppel, operative against the present defendants, which bars their right to question the validity of the letters patent. It may be taken as settled that a judgment at law or in equity is a bar only as to the matters actually litigated, or which ought to have been litigated, in the suit; that is, the matters actually in issue are forever settled, so far as the parties and their privies are concerned. But further than this the principle of estoppel does not obtain. The "matters in issue" may be fairly well defined as "that ultimate fact or state of facts in dispute, upon which the verdict or finding is predicated." *Smith v. Ontario*, 4 Fed. 386. Now, the record in the case in New York shows very clearly that the validity of the letters patent here involved was, by the defendants there, not contested in any way. The defendants were charged, indeed, in that suit, with infringement, but, admitting the validity of the patent, they claimed a license to sell the stays in question from one who owned an interest in the patent. And this was the sole issue which was litigated. Indeed, a licensee having accepted a license is estopped from denying the validity of the patent in any suit in which the exercise of alleged license privileges is the basis of the controversy. Therefore the defendants were debarred from attacking in the New York suit the validity of these letters patent, even if they had been so minded. Admitting, then, that the defendants to the present suit took an active part in the defense of the suit in New York, as is alleged,—so active, indeed, as to bring themselves within the binding force and effect of any decree therein made,—it is evident that the only issue settled beyond peradventure was that which concerned itself with the alleged license. That this was the issue is expressly settled by the circuit court of appeals in its decree in these words: "The defendants having failed to make out the defense of license, the decree of the circuit court was correct, and judgment is affirmed, with costs." It seems clear, therefore, that the question of the validity of the letters patent was not litigated in the New York case. This being so, that decree is not an estoppel on the issue now presented for the first time. But, apart from this, the evidence on the part of the complainant does not satisfactorily show such a connection of the defendants in the present case with the suit in New York as would justify the invoking of the doctrine of estoppel. The testimony is conflicting, and evenly balanced, to say the least; and, as the burden is on the complainant, failure to sustain it must result in the failure of the allegations in this respect. The conclusion is that the defendants are not estopped from contesting the validity of the letters patent in this action by the decree of the court in New York.

Having found that the letters patent are invalid, it is not necessary to examine the status of the present title to them. It is

only necessary to say that whatever title the defendants may have clearly was taken by them with knowledge, actual or implied, of the rights of the complainant. The bill of complaint must be dismissed.

TAYLOR et al. v. SAWYER SPINDLE CO.

(Circuit Court of Appeals, Third Circuit. June 30, 1896.)

1. PATENTS—INFRINGEMENT SUITS—LACHES.

Mere delay in prosecuting infringers, unaccompanied by circumstances amounting to an equitable estoppel, will not prevent a patent owner from maintaining suits for equitable relief. *Held*, therefore, that a delay of over seven years after issuance of the patent, before the institution of any infringement suits, was not sufficient ground for refusing either an injunction or an accounting, as against an infringing corporation organized more than a year after the institution of the first suit against another infringer. 69 Fed. 837, affirmed.

2. SAME—INFRINGEMENT.

A machine which contains all the essential elements, or their equivalents, of the patented machine, infringes the patent, notwithstanding mere differences of form.

3. SAME—INVENTION—SPINNING MACHINES.

A new combination and arrangement of old parts, whereby spinning spindles, instead of running in rigid bearings, are flexibly mounted on the rail, so as to allow of greatly increased speed of revolution, *held* to disclose the exercise of inventive faculty; it appearing that this result had long been sought by inventors, and that the superiority of the device had caused its general adoption and large use by silk spinners. 69 Fed. 837, affirmed.

4. SAME—ANTICIPATION—DOUBLE USE.

The use of yielding attachments, with adjustable devices, applied to the combined step and bolster bearings of a spinning spindle, was not anticipated by the use of similar devices in centrifugal machines, or hydro-extractors, for drying sugar or creaming milk. The two classes of machines are so different in size, structure, and the uses to which they are adapted, that it is not a case of double use. *Potts & Co. v. Creager*, 15 Sup. Ct. 194, 155 U. S. 607, applied.

5. SAME—CONSTRUCTION OF CLAIMS—OMISSION OF ELEMENTS.

In the claims of a patent for a combination of a spindle, its supporting tube, and devices for flexibly mounting it upon the rail, there is no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood, and hence the omission of the sleeve whirl from the claims does not affect their validity.

6. SAME—SPINNING SPINDLES.

The Atwood patent, No. 253,572, for "improvements in the supports for spindles for spinning machines," *held* valid and infringed as to claims 3, 4, and 5. 69 Fed. 837, affirmed.

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

Edward Q. Keasbey, for appellants.

Frederick P. Fish, for appellee.

Before ACHESON, Circuit Judge, and WALES and GREEN, District Judges.

WALES, District Judge. This is an appeal from the decree of the United States circuit court for the district of New Jersey, made

October 19, 1895, sustaining the validity of letters patent No. 253,572, issued to John E. Atwood, dated February 14, 1882, for "improvements in the supports for spindles for spinning machines," declaring that the defendant corporation had infringed the third, fourth, and fifth claims of the patent, and ordering an accounting of profits from March 23, 1891, the date of the organization of the defendant company. The patented improvements pertain to what are known as "self-adjusting spindles," and relate "to that class of such spindles having step and bolster bearings within a supporting tube." The specifications give the following description of the invention:

"The characteristic feature of my present invention is a supporting tube which is flexibly mounted with relation to the spindle rail, and contains the step and bolster bearings for the spindle, so that the latter and said tube may move together laterally in all directions during the self-adjustment of the spindle, while carrying an unequally balanced bobbin and its yarn, instead of relying upon the movement of the spindle and its bearings within, and independently of, the supporting tube, as heretofore in this class of spindles. By reason of my improvement, the means whereby the movable capacity or flexibility of the spindle is afforded are rendered openly accessible, and more easily renewed, if need be, than heretofore; and, further, elastic materials may be successfully employed, which would be liable to injury, and rendered inelastic, by oil, if located within the supporting tube, as heretofore. I am also enabled to readily graduate the degree of flexibility of the spindle with relation to the spindle rail, so as to accommodate the self-adjusting capacity of the spindle to the various conditions incident to its use in working with bobbins materially differing in size and weight. All of these advantages are due to the novel, characteristic feature before referred to."

The claims in issue are these:

"(3) The combination, substantially as hereinbefore described, of a spindle rail of a spinning machine, a spindle, and a supporting tube flexibly mounted with relation to the spindle rail, and containing step and bolster bearings.

"(4) The combination, substantially as hereinbefore described, of a spindle rail, a spindle, a supporting tube containing step and bolster bearings, flexible connections between said tube and the spindle rail, and adjusting devices for varying the degree of flexibility of the supporting tube and spindle therein.

"(5) The combination of the spindle rail, the spindle, the supporting tube, loosely mounted with relation to the rail, and containing the step and bolster bearings for the spindle, the spring, and the nut for compressing it, substantially as described."

The validity of the complainants' title is admitted. The first defense to the suit is that of laches, which was urged with much earnestness, and is made on the ground that the complainants had deprived themselves of relief in a court of equity by neglecting to prosecute any one for infringement until more than seven years after the date of the patent, and that the defendant had no notice of their claims until more than ten years after that date. It is alleged that the complainants permitted the manufacture and sale of the spindles complained of to be carried on for many years by men who were ignorant of their claim, and allowed the persons composing the defendant corporation to purchase the business without giving them notice; that spindles mounted flexibly, like those now complained of, were made and sold by the Cooke Locomotive & Machine Company, continuously and to a large extent, from August, 1881, until they sold the business to Mr. Taylor, Mr. Shaw, and Mr.

Cocker, and that the latter continued to make and sell the same spindles until the defendant corporation was formed, March 23, 1891,—the date from which infringement is charged in the bill. The first suit brought against any infringer of the Atwood patent was that of these complainants against W. G. & A. R. Morrison Company, September 2, 1889, in the district of Connecticut (52 Fed. 590), in which the validity of the patent was sustained, and there was a decree for the infringement of the second, third, and fifth claims, and for an accounting. Subsequently another suit was brought by complainants against the Morrison Company for infringement of the same patent by types of modified spindles manufactured by them, in which, on motion for a preliminary injunction, the patent was upheld. 54 Fed. 693. The theory of this defense is that there is no absolute right to an injunction on proof of infringement of a patent; that the complainant must present a case for equitable relief, and if it appears by the bill, or by the evidence, that by reason of his delay he is not entitled to the aid of a court of equity, it will be refused on final hearing, as well as on motion for a preliminary injunction. It is insisted that, if the Atwood patent has been infringed by the defendant, the only remedy for the complainants would be by an action at law for damages, and that the only possible relief obtainable in the present suit would be an injunction against future infringement.

It has never been held that mere laches, unaccompanied by circumstances which amount to an equitable estoppel, shut out a party from all relief in a court of equity. Knowledge of and long-continued acquiescence by a complainant in an infringement may, in special cases, be fatal on a motion for a preliminary injunction, but will not, on a final hearing, prevent the court from granting such relief as may be just and equitable. This is the general rule which is recognized in the authorities which are cited in the briefs of counsel. There is a want of satisfactory proof that the defendant acted in ignorance of the rights of the complainants, or that the latter had always had full knowledge of the alleged infringement. Notice was given to the public at large that the spindles were patented, and the defendant could not have been blind to the fact that the new spindles had gone into extensive use. The testimony of Mr. Taylor, of the defendant corporation, had reference to a time prior to the issue of the patent, when, as he says, Mr. Atwood saw the infringing spindles, or ones just like them, in operation in Paterson, and made no claim that the invention was his; but it is not pretended that Taylor, Shaw, and Cocker, or either of them, at the date of their incorporation, in March, 1891, did not know of the complainants' claims, for the suit against the Morrison Company had then been pending for more than a year. In *Kittle v. Hall*, 29 Fed. 508, it was held that, while long acquiescence might defeat a bill for infringement, no precedent had been discovered for the dismissal of a bill for so short a period as seven years, and that the defendants had not been misled, but knew of the plaintiff's rights. In *McLean v. Fleming*, 96 U. S. 245, the court said:

"Equity courts will not, in general, refuse an injunction on account of delay in seeking relief, where the proof of infringement is clear, even though the delay may be such as to preclude the party from any right to an account for past profits."

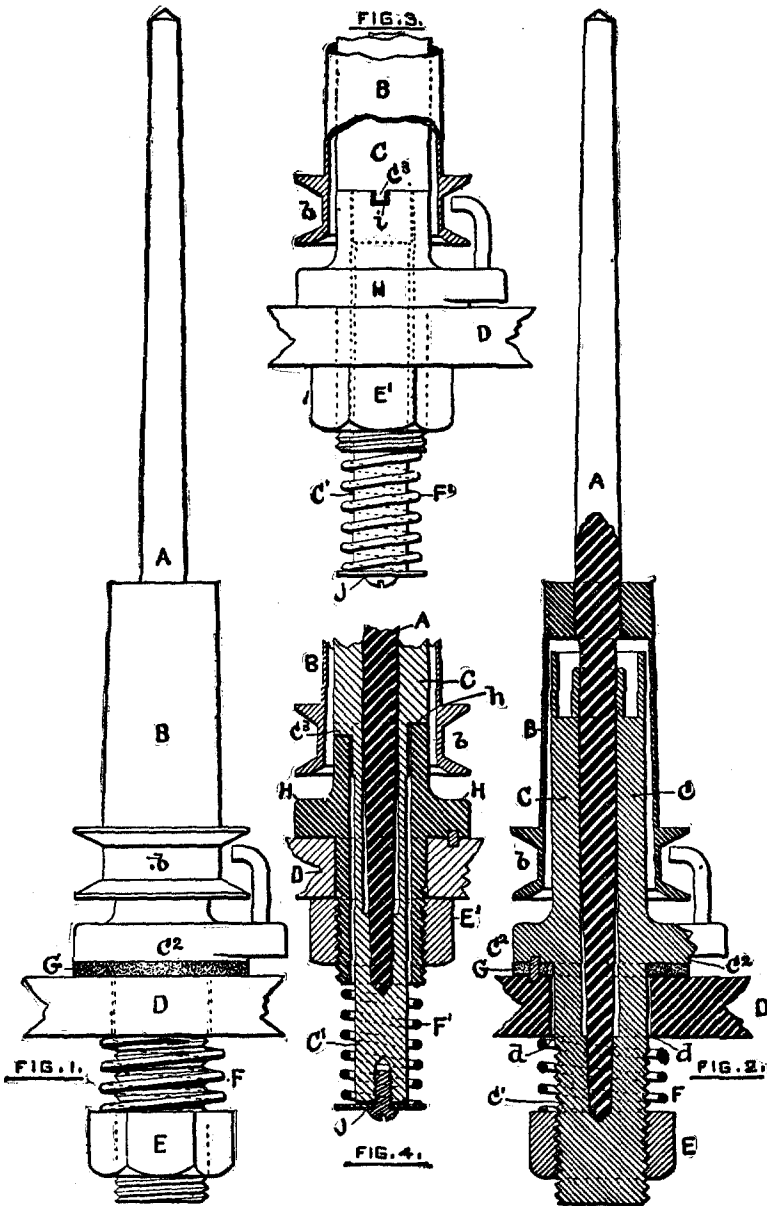
To the same effect are the cases of *Menendez v. Holt*, 128 U. S. 514, 9 Sup. Ct. 143; *Price v. Steel Co.*, 46 Fed. 107; *New York Grape-Sugar Co. v. Buffalo Grape-Sugar Co.*, 18 Fed. 638; *Gilmore v. Anderson*, 38 Fed. 846; *Brush Electric Co. v. Electric Imp. Co.*, 45 Fed. 241. In the last-cited case the court remarked that the doctrine of laches is generally applicable to preliminary injunctions only. In *Menendez v. Holt*, supra, the court, in discussing the question of laches, said:

"Mere delay or acquiescence cannot defeat the remedy by injunction in support of the legal right, unless it has been continued so long, and under such circumstances, as to defeat the right itself. Hence, upon an application to stay waste, relief will not be refused on the ground that, as the defendant had been allowed to cut down half the trees upon the complainants' land, he had acquired by that negligence the right to cut down the remainder [citing *Attorney General v. Eastlake*, 11 Hare, 205]. * * * Acquiescence, to avail, must be such as to create a new right in the defendant. Where consent by the owner * * * is to be inferred from his knowledge and silence merely, it lasts no longer than the silence from which it springs. It is in reality no more than a revocable license."

The defendant asserts that the complainants are not entitled to an accounting for profits; but the decree of the circuit court orders an accounting only from the date of the defendants' incorporation, from and after which time there were no laches, as complainants had already begun their suit against the Morrison Company. This was sufficient notice to the defendant that the validity of the patent was in litigation, and thus takes away the excuse of ignorance for continuing the infringement. There is no proof of nonuser or abandonment by the complainants, nor of any act or omission of theirs which could have induced the defendant to believe that it would not be held liable for manufacturing and selling the infringing articles. The evidence falls far short of proving an estoppel, or of proving such delay or acquiescence on the part of the complainants as should defeat the present suit.

Infringement is not seriously disputed; the defense on this point being that, if the patent is sustained at all, it must be confined to the precise form described and shown in the specifications and drawings. The specifications state:

"The spindle chosen to illustrate my invention is of that well-known variety which is constructed with a sleeve attached to the spindle blade, extending downwardly so as to encompass a support containing the bolster bearing, and which has a driving whirl located at or near the base of such sleeve. Such spindles have their foot rests in the base or closed end of the bolster support, and the spinning frame therefore requires only one spindle rail. As shown in all the figures of the drawings, A represents the spindle; B, the sleeve; and b, the whirl thereon. As shown in Fig. 2, the spindle is mounted in a supporting tube, C, which extends both above and below the spindle rail, D, and furnishes an upper or bolster bearing for the spindle in its portion, c, and a lower step bearing in its portion, c'. The supporting piece or tube, C, containing as it does the bolster and step bearings for the spindle, constitutes a combined bolster and step, which moves laterally with the spindle, in all directions, during its self-adjustment.



v.75P.no.4—20

"In order to permit the supporting tube, C, to move with the spindle as described, the spindle rail, D, has a circular opening, as at d (Figs. 1 and 2), which has a diameter slightly greater than the diameter of the lower portion, c', of the tube, C; so that between their coincident surfaces an ample annular space is afforded to allow of the desired lateral movement of said tube, and the spindle therein. For so securing the supporting tube and its spindle to the rail, D, that they will nevertheless be capable of the requisite lateral movement incident to the self-adjustment of the spindle, the lower end of the tube, c', is screw-threaded, and provided with a nut, E. A strong spiral spring, F, the tension of which may be variably regulated by said nut, surrounds said portion of the supporting tube between the nut and the under side of the rail; and the base or flange portion, c, of said tube is seated upon a washer or annulus, G, of flexible or elastic material, placed between said base and the top of the rail."

The defendant's spindle is almost identical with the Atwood spindle, differing only in form, but containing all the elements, or their equivalents, of the latter. The differences between the two are immaterial. In defendant's spindle a collar and set screw are substituted for the nut below the spring, and the whirl is attached directly to the shaft of the spindle; the supporting tube being made in two parts, and then rigidly fastened together by two arms, which bridge over the whirl, thus practically making one tube for the step and bolster bearings. The defendant has adopted the essential elements of the Atwood combination, namely, the flexibly mounted supporting tube, containing both step and bolster bearings, which is connected with the rail by a strong spiral spring and an adjusting nut. The defenses chiefly relied on are want of invention (as distinguished from mechanical skill) anticipation, and because the claims are inoperative and void. Atwood had invented his spindle, and put it into use, as early as July, 1878, although he did not make application for a patent until February 27, 1880. Prior to his invention, spindles had been run in rigid bearings; and their speed was limited on account of their tendency, under a high rate of revolution, to gyrate and cause severe pressure on the bearings, developing friction, and throwing off the bobbins. The production of a spinning frame is in direct ratio to the speed of the spindles, and every increase in speed at which the spindle can be practically run makes a proportionate increase in the production; and thus it was that inventors had long been endeavoring to mount a spindle in such a way as to obtain a greater rate of speed than was possible with the then existing machines. Numerous patents had been granted for improvements in these machines, but none of them contained the device of Atwood, who was the first to combine the step and bolster bearings of the supporting tube with a flexibly mounted spindle, whose rotary speed was only limited by relation to other parts of the machinery. Invention and patentability, however, are denied on the ground that Atwood's combination is only a new arrangement of well-known parts, which had already been combined to accomplish the same result, and that its only novelty consists in the location of the yielding attachments between the supporting tube and the rail, and the use of adjusting devices for varying the degree of flexibility,—in substance, nothing more than putting a cushion or spring of some kind between the journal box of a revolving shaft and the fixed base of support, and therefore showing only mechanical

skill. In support of this proposition, reliance is placed on the patent of F. J. Rabbeth, No. 227,129, dated May 4, 1880, for "a spinning spindle and bearing," and on certain prior patents for centrifugal machines. The essential difference between the Rabbeth spindle and the Atwood spindle is that the supporting tube in the former is rigidly fixed in the rail, while in the latter it is loosely or flexibly mounted on the rail. This, it has been well said, is the gist of the Atwood improvement, the value and superiority of which have been proved by its general adoption and large use by silk spinners. Its novelty and utility are thus placed beyond doubt, and that it required the exercise of inventive faculty to produce it appears from the prior history of the art. It would require too much space to review the long list of patents set out in the answer as being suggestive of the one in suit, only a few of which, however, are referred to in the brief of defendant's counsel. It may be sufficient to say that, with all the information derived from the alleged anticipations, it does not appear that any one, before Atwood, had caught the idea, and reduced it to practice, of arranging and combining old elements in such a manner as to produce a flexibly mounted spindle. He invented a new arrangement of parts, by which a new relation was formed between the rail and the supporting tube, and by that means superseded the former rigid-bearing spindle. It was a decided advance over all other supports, and that it required more than mechanical skill is evidenced by the fact that it had escaped the notice and observation of numerous inventors whose attention had been directed for many years to the achievement of the same or a similar result as the one reached by Atwood. In coming to this conclusion, we have not overlooked the contention that the use of yielding attachments, with adjustable devices, applied to the combined step and bolster bearings of a spinning spindle, was anticipated by the use of similar devices in centrifugal machines, or hydro-extractors, for drying sugar or creaming milk. In this connection, reference is made to four patents for centrifugal machines, namely, Weston's (No. 82,049), of September 8, 1886; Cramer's (No. 144,319), of November 4, 1873; English patent to Day (No. 772), of 1874; and Tolhurst's (No. 199), of January 8, 1878. It is claimed for the defendant that the Atwood spindle and the centrifugal machines contain the same combination of elements for the purpose of flexible adjustment to an unbalanced load; the only difference being that in the one case it is a spindle flexibly mounted upon a rail, and in the other a larger revolving shaft flexibly attached to the floor. The argument deduced from this is that mere changes of use and dimensions, without any change of function, do not involve invention; in other words, that the Atwood adjustable device is only a "double use" of that made use of in the centrifugal machines for the same purpose. The Cramer patent is particularly relied on in support of this proposition, and may be taken as a fair representative of the class to which it belongs. The two classes of machines are so different in size, in structure, and in the uses to which they are adapted, that, as Mr. Southworth, a witness for the complainants, said, "the inspection of a centrifugal machine would not lead a mechanic to use a flexible spindle, but would be likely to deter one from even experimenting in that di-

rection." The object of flexibly mounting the hydro-extractor is to prevent the jar and concussion which arise from the great weight of the machine, and not to increase its speed. On the other hand, the flexible bearings in the spinning spindle are made use of to increase its speed, for the spindle can run as well at a speed of 5,000 revolutions in a rigid bearing. A careful examination of the specifications and drawings of the Cramer patent does not induce the belief that Atwood could have derived any aid from that source in contriving his spindle. Centrifugal machines had been in use in many mills where yarn was spun, and in shops where machinery was made for spinning yarn, for years before the Atwood improvement was invented, and no one ever supposed that a similar construction could be applied to a spinning spindle. One of the objects to be attained by loosely mounting the spindle in the rail was to maintain the spindle in a perpendicular position, and to diminish its inclination to gyrate. It is obvious that the functions of the one machine are different from the functions of the other, and it is also apparent that the means adopted by Cramer to produce a flexible adjustment differ from those adopted by Atwood for a similar purpose. The specifications of the Cramer patent state "that bolts, b, are provided with large heads and a washer, and each is encircled for a portion of its length by a heavy elastic cushion, preferably resembling a rubber car spring. These bolts are passed upward through holes in the platform, and are provided with nuts at their upper ends, and which, on being screwed down, securely and safely fasten the machine to the platform." In contrast to this, the spiral spring in the Atwood patent pulls the supporting tube down upon the rail, so as to prevent the tipping of the spindle; and, all parts of the machine being openly accessible, the degree of flexibility of the spindle with relation to the rail can be readily graduated. The Cramer patent is only "a paper patent," and has never been put into practical use, and may be considered as an abandoned experiment. It belongs, however, to the same class as the other centrifugal machines which have been referred to as anticipations of the flexible devices of Atwood, to show that the latter are only reproductions of the former. As we have seen, they are very different. The clamping nut and rubber spring used by Cramer have little or no analogy to the spiral spring, and the provision made for regulating its tension, as described in the Atwood patent. The centrifugal machine must have a strong foundation to rest upon, and to which it is "securely and safely" fastened, while the spinning spindle is sustained in mid-air by the rail on which it is loosely mounted. But, admitting the existence of a closer resemblance and analogy between the two classes of machines than have been shown, it by no means follows that the Atwood spindle would come within the rule of "a double use," and thus fall short of invention and patentability. In the recent case of *Potts & Co. v. Creager*, 155 U. S. 607, 15 Sup. Ct. 194, Mr. Justice Brown, speaking for the court, said:

"Indeed, it often requires as acute a perception of the relations between cause and effect, and as much of the peculiar inventive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the

device de novo. And this is not the less true if, after the thing had been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before; but the decisive answer is that with dozens, and perhaps hundreds, of others laboring in the same field, it had never occurred to any one before. * * * As a result of the authorities upon the subject, it may be said that, if the new use be so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use; but if the relations between them be remote, and especially if the use of the old device produce a new result, it may at least involve an exercise of the inventive faculty."

To the same effect are *Du Bois v. Kirk*, 158 U. S. 58, 15 Sup. Ct. 729, and *Tannage Patent Co. v. Zahn*, 17 C. C. A. 552, 70 Fed. 1003. In *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, the court held it—"not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such function."

As a further defense it is contended that the claims sued on must be construed as containing the sleeve whirl, in which case they are not infringed, because the defendant does not use the latter, or else they have no operative mechanism, and are void. The law on this subject is too well settled to be open for discussion. A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve whirl does not affect the validity of either one of the claims, which belong to that class where reference may be made to the specifications to supply in a claim what it is plain, to any one skilled in the art, is a necessary incident. *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 970; *Deering v. Harvester Works*, 155 U. S. 286, 15 Sup. Ct. 118. The decree of the circuit court is affirmed.

THE CLEARWATER (two cases).

THE BREAKWATER.

THE STILLWATER.

THE WANDERER (five cases).

NEW ORLEANS, B., R. M. & C. A. S. S. CO., Limited, v. LOUISIANA
CONST. & IMP. CO.

(Circuit Court of Appeals, Fifth Circuit. May 26, 1896.)

Nos. 467, 468, 469, 470, and 471.

WHARFAGE—CONTRACT—LEASE OF WHARVES BY NEW ORLEANS.

By the terms of the contract between the city of New Orleans and the Northeastern Railroad Company, under which wharves were built by the company between Port and Montegut streets, there was reserved to the city the right to collect usual wharfage dues from vessels occupying such wharves, with the consent of the company, but not on its business; and this right passed to the Louisiana Construction & Improvement Com-