

are multiplied. First, the clip has to be riveted to the torpedo case, requiring as much or more time than to solder them on; then the strap has to be fastened to the clip, so that the operation is much more expensive than soldering.

The torpedo made under the patent has been manufactured in large numbers, and successfully marketed.

We next turn to the question of infringement. The respondent has made and sold a torpedo in which the tin shell is charged before a clip or lead strip is attached. In opposite sides of the flanges around the torpedo case are cut grooves, in which is seated an oblong-shaped wire clip, which extends across the upper shell face, and the ends of which are bent over the torpedo sides. They seat themselves in the flange grooves, and are then turned or bent upward against the lower shell face. This clip seems to hold the two portions of the torpedo together, and affords a means of attaching a lead strip, which is passed through the stirrups or ends of the clip, and serves to attach the torpedo to the rail. If we are right in our construction of the term "detachable clip" in Beckwith's claims, there can be no question but that this device infringes. The details may differ somewhat, but the difference is in form, not in substance. The same means—a detachable clip, a torpedo, and a lead attaching strip—are used in substantially the same way to accomplish precisely the same result. The clip of Schooley may be heavier in material, less easy to disengage, and be made of wire instead of tin or sheet metal, but there are no limitations implied or expressed in Beckwith's claims in either or any of these particulars which restrict them to such narrow limits. The substance of what Beckwith invented is found in what Schooley has constructed. This seems to us quite clear if we inquire what the effect on Beckwith's application for a patent would have been had Schooley's device existed before it. Clearly, it must have anticipated it, and prevented the allowing of the claims now in controversy. In it Beckwith would be met by a combination which included a torpedo, a clip that, as compared with prior methods, must properly be embraced by the term "detachable," means for attaching the clip to the torpedo, and a lead for attaching it to the rail, all of which are elements of Beckwith's claims. Such being the case, their use in combination subsequent to Beckwith's patent must be adjudged an infringement thereof.

A decree may be prepared adjudging the respondent infringes the claims noted.

NEW YORK PAPER-BAG MACH. & MANUF'G CO. v. WESTERN PAPER-BAG CO.

(Circuit Court, N. D. Illinois. November 13, 1895.)

PATENTS—PRELIMINARY INJUNCTION—PAPER-BAG MACHINES.

A preliminary injunction, based on claim 9 of the Leinbach, Wolle & Brunner patent, No. 242,661, for a paper-bag machine, refused, because the court was not sufficiently assured that the hinged folding plates of said claim, with the associated mechanism, as described, were to any degree practically operative for the purpose of making paper bags.

This was a suit by the New York Paper-Bag Machine & Manufacturing Company against the Western Paper-Bag Company for alleged infringement of letters patent No. 242,661, issued June 7, 1881, to Leinbach, Wolle & Brunner. The case was heard on motion for a preliminary injunction.

Albert H. Walker, for complainant.

Offield, Towle & Linthicum, for defendant.

SHOWALTER, Circuit Judge. This is a motion for an injunction pendente lite on a bill to enjoin an infringement of the ninth claim of letters patent No. 242,661, dated June 7, 1881, for a machine to make paper bags. Said "invention," as stated in the specification, "comprises certain features of construction, and certain combinations of parts, whereby a sheet of paper is first folded so as to form the tube with tucked-in sides, and this tube is then cut into lengths and formed into bags." The paper-bag machine proposed in this patent is complicated in structure, the diagrams accompanying the specification being 30 in number. After describing the different parts of the machine, and explaining the operation, the specification contains the following statement:

"The machine is continuous in its operation, and can be driven at a very high rate of speed, both of which features are of importance in the manufacture of bags on a commercial scale, as it is essential that the bags shall be made rapidly and cheaply."

Also the following:

"The devices for forming the tube with tucked-in sides may be independent of the devices for making the bag from the tube, said tube being fed from one machine to another."

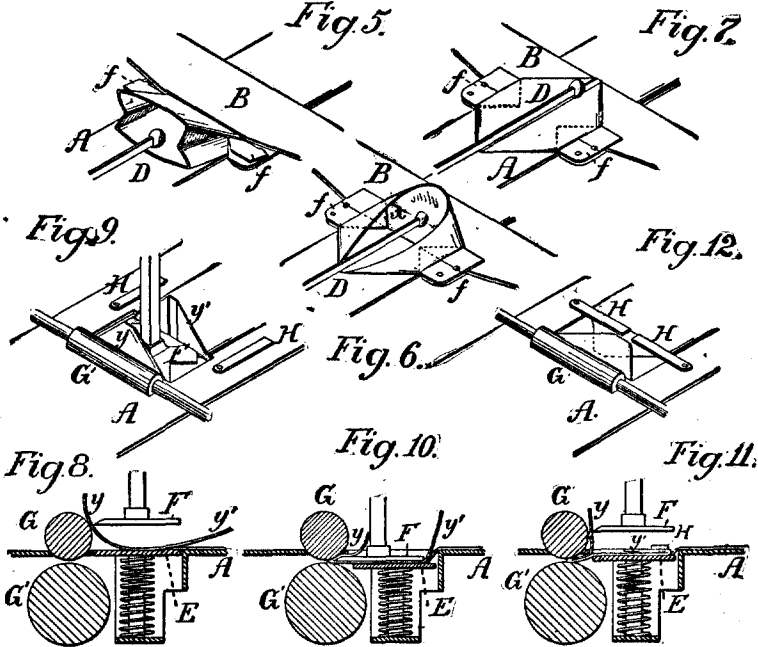
The ninth claim has reference to "the devices for making the bag from the tube" already having the "tucked-in sides." Said claim is in words following:

"The hinged folding plates, f, each having a beveled inner end, whereby, when the plates are unfolded, said inner ends are adapted to the internal triangular flaps formed in the bag bottom, all substantially as set forth."

The prima facie assumption from the issuance of the patent is that this machine had patentable utility,—utility, to some degree, for the purpose of making paper bags, not utility solely for the purpose of affording suggestions, of one kind or another, whereby an operative paper-bag machine might, by the aid of invention, be ultimately made. It is now sworn positively by experts on behalf of defendant that the mechanical structures described and combined in this patent could not be operated to make paper bags, and that the specific device mentioned in the ninth claim could not, in combination with mechanism as proposed in the patent, be practically effective to form the internal triangular flap in the bag bottom. In other words, the monopoly insisted on by virtue of said ninth claim is disputed on the ground that said hinged folding plates, f, constitute no part of an operative machine; that said folding plates are worthless, except as allied to mechanism whereby they can be made to work; and that such mechanism is wanting in the machine described in the patent. The

specification has the following language descriptive of part of the operation of "the devices for making the bag from the tube" having the "tucked-in sides":

"As the plate, F, descends, it has a forward movement imparted to it, so as to insert the folded front edge of the tube beneath a pair of rollers, G, G', as shown in Fig. 10; these rollers serving to draw the tube forward while the plate, F, is retracted and caused to ascend. As the plate ascends, the front edge of the same applies paste to the under side of the flap, y, and vibrating fingers, H, H, act on the flap, y', so as to fold the same beneath the plate, F, as shown in Fig. 11, prior to the folding down of the flap, y, over said flap, y', as shown in Fig. 12."



It is possible that in passing down and touching the roller, S', the plate, F, may receive paste along the upper surface adjacent to that edge which last leaves said roller, and that the paste so received may be imparted to the flap, y, as described. It is also possible that the said edge of plate, F, might operate to fold and insert the flap, y, between the rollers, G, G', and then be retracted and caused to ascend in time for the fingers, H, H, to fold down the flap, y', while the bag bottom is passing between the rollers, G, G', and in time for the fold, y, to be pasted over the fold, y'. Yet the suggestions on behalf of defendant against the practicability of a machine made under this patent in the foregoing, as well as in many other, respects, seem plausible, especially in view of the fact that such machine never went into use, though, if it were "continuous in its operation," and could be "driven at a high rate of speed," it would certainly have been a source of great profit. Without doubt, the hinged folding plates, f, would assist other appropriate mechanism in forming the

internal triangular flap on the bag bottom in case they be made to pass into the tucks; the paper tube being held in the meantime by the presser plate, B. It is insisted, however, that said plates, f, are as likely to pass under the lower division of the tuck as into the tuck; also, that they may pass over the upper division of the tuck, or, in rapid movement, simply pierce and tear the bag blank, and that a like uncertainty is involved in the action of the rod, D; there being no adequate mechanism to control the position of the paper tube while said plates and rod act, even if said rod, D, be in itself a practical means, in any case, of accomplishing the result assigned to it in the patent. The machine described in this patent never came into use. No machine or model was constructed prior to the patent. In 1882 the patentees, it is said, built a machine, which, according to one affidavit, "was run * * * as a successful, operative machine." According to another, paper bags "were manufactured in small numbers, though not for sale, with that machine." I get the impression from the affidavits produced by complainants that the use of said machine, or of any machine made in accordance with the patent, for the purpose of actually manufacturing paper bags for sale, was not even seriously thought of after said experimental machine was constructed. The patentees turned said machine over to two professional inventors, Lorenz and Honiss, in order that the latter might use the same, or any suggestions which might occur to them in connection with it, in "inventing, designing, and constructing," I quote from the affidavit of Lorenz, a commercially operative paper-bag machine. Honiss swears:

"The first machine which we actually built in the course of our paper-bag machine work was completed, and ran admirably at very high speeds, early in 1884; and that machine contained hinged folding plates, each having a beveled inner end, whereby, when the plates were unfolded, said inner ends were adapted to the internal triangular flaps formed in the bag; and those hinged folding plates were carried crosswise of the machine upon arms substantially like the arm, f', of said letters patent No. 242,661; and the lower member of each pair of those folding plates was, in all respects, nearly or quite identical with the lower member of each pair of the hinged folding plates, f, of the said letters patent No. 242,661, except that it was made integral with the arm which carried it, instead of being a separable thing, as shown in said letters patent. But in that machine of 1884 the upper member of each of those pairs of folding plates was a skeleton device, the outline of which was substantially identical with the outline of the upper member of each pair of the hinged folding plates, f, of said letters patent No. 242,661, and which skeleton device was hinged to the lower member in substantially the same way, and on the same line, and for the same purpose, that the upper member of each pair of folding plates, f, is hinged to the lower member in the said letters patent No. 242,661; the difference between the upper members of the folding plates in the said machine of 1884, and the upper members of the folding plates in the said patent No. 242,661, consisting simply in the fact that the interior portion of the flat area of the latter was absent from the plates of the machine of 1884, but the mode of operation and function was the same. So, also, the upper members of the folding devices in the machine of 1884 were folded and unfolded by colliding with fixed stops attached to the frame of the machine, in substantially the same way that the upper members of the hinged folding plates, f, of the said patent No. 242,661, are folded and unfolded."

It is not disclosed how, in this machine of 1884, the tube with tucked-in sides was held while the folding plates were inserted, nor