

court of last resort. The defendants admitted doing the acts which were complained of as infringing, and resisted the application for an interlocutory injunction, on the ground that the machinery which they had constructed for doing exactly the same kind of work by substantially the same process as the mechanism described in the plaintiffs' patent was, nevertheless, so different in the details of its construction and operation as to avoid infringement, and they relied entirely upon a comparison of the different devices to make their defense good. The rule applied in that case, while of general application, has its limitations. It is not necessarily inconsistent with the principles above set forth. The chancellor is called upon to exercise a sound discretion, and, upon consideration of all the recognized rules governing equity practice, and the facts in each particular case, he must apply the rule which will come the nearest to working out complete equity between the parties. Now, as I view the situation of the parties, the defendants and people to be benefited by the harbor improvements which they have undertaken to make will probably sustain heavy losses, and be subjected to inconvenience, by being prevented from using the Atlas, and, if it should be finally adjudged that this vessel is not an infringement of the valid claims of the Bowers patent, they will have suffered deprivation of legal rights, for which they will be without adequate remedy. On the other hand, if the plaintiffs finally prevail, the exact amount necessary to compensate them for the infringement can be computed and recovered in an action for damages. The showing as to the solvency of the defendants goes only to this extent: that the New York Dredging Company does not own property within this jurisdiction. From this I may fairly infer that said company is responsible, and any liability for damages which it may incur can be, with but little extra trouble, enforced by a court having jurisdiction where its property may be found.

It is my conclusion that there must be a decree denying the present application, but with leave to renew the application before the final hearing, upon a further showing, if the complainants shall elect to do so.

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H. W. JOHNS MANUF'G CO. v. ROBERTSON et al.

(Circuit Court of Appeals, Second Circuit. January 7, 1897.)

1. PATENTS—EQUIVALENTS—ASBESTUS ROPE PACKING.

In an asbestus rope for steam packing, a sizing made of starch, to cause the asbestus strands to stick to the central core of the rope, is not the equivalent of a solution of India rubber, which saturates the core to make it elastic.

2. SAME.

The Johns patent, No. 257,167, for an asbestus rope steam packing, construed, and held not infringed as to the third claim. 60 Fed. 900, affirmed.

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

This was a suit in equity by the H. W. Johns Manufacturing Company against Henry M. Robertson and George T. Sinclair for in-

fringement of a patent for an asbestos rope steam packing. The circuit court dismissed the bill, holding that the claim sued on must be so limited by reference to the specifications as to avoid infringement, and, if not so limited, that it was anticipated. 60 Fed. 900. The complainant has appealed.

Edmund Wetmore, for appellant.

Joseph D. Gallagher and Hugh C. Lord, for appellees.

Before LACOMBE and SHIPMAN, Circuit Judges.

SHIPMAN, Circuit Judge. This is an appeal from a decree of the circuit court for the Southern district of New York which dismissed the bill brought by the H. W. Johns Manufacturing Company against the defendants for an infringement of letters patent No. 257,167, dated May 2, 1882, and issued to Henry W. Johns, for an asbestos rope steam packing. In Judge Townsend's opinion the full text of the specification is quoted (60 Fed. 900), from which it appears that the entire invention was an asbestos rope, with or without a central core of asbestos or hemp; the outside fibers of the rope being laid flat in the direction of the rope, and the interstices between the outside strands being filled or evenly built up by a sizing composed wholly or in part of asbestos. The specification adds that "the central strand may be saturated with a solution of India rubber, which I find imparts a degree of elasticity which does not interfere with the solidity of the packing." An examination of the descriptive part of the specification, apart from the claim, would lead the mind to suppose that this addendum was not an integral part of the invention, but was a detail which was, if used at all, to be employed in connection with the external paste coating of the rope, which apparently constituted the significant feature of the improvement. The third claim, however, is as follows: "The asbestos rope packing for steam joints, composed of a series of strands of asbestos, with a central core saturated with a solution of India rubber, as hereinbefore set forth." The correspondence between the patent office and the patentee's attorney shows that the patent office allowed this claim; the patentee having pointed out that it was for a central core saturated with a solution of India rubber, and not for a solid rubber core which had been previously used. The defendants sell an asbestos packing not externally cemented, but having a central core, upon which a sizing made of starch is used to cause the outside strands to adhere to the inside core. The question is one of infringement, and is whether starch can be considered an equivalent of India rubber, in this patent.

The complainant does not take the position that the adhesive property of the India rubber solution produced an unanticipated benefit, by causing the outside strands to stick somewhat to the central core, but its theory is that the claim specifies India rubber generally,—an article which has many known qualities, among which is adhesiveness,—and therefore all materials which cause adhesiveness are equivalents. Thus, the expert for the complainant understands

that any solution which will be adhesive, but will not impart a degree of elasticity which interferes with the solidity of the packing, and will permit the separation of the strands, will be within the patent; and he further understands that the starch sizing, while adhesive, has not imparted a degree of elasticity which interferes with the solidity of the packing, and is therefore the equivalent of India rubber. The argument of the complainant is to the effect that India rubber has known qualities, and therefore any material which has any of the qualities of India rubber which have proved to be useful in rope packing is an equivalent. The specification does not permit this construction of the claim. No allusion was made to the adhesive quality of India rubber. It was to be used simply to impart elasticity, and not to impart adhesiveness; and the specification would be satisfied if the saturated core was not, and was so made as not to be, adhesive. Its language obviously meant that the central strand is saturated with an India rubber solution, so as to produce elasticity in the core, and thereby elasticity in the rope; and the meaning of the claim is, an asbestos rope, its central core being saturated with an India rubber solution for the purpose named in the specification. It is true that an inventor can secure, by means of his patent, the use of the patented combination for beneficial purposes which were unknown to him, and "is entitled to the benefit of all the uses to which it [the patented machine] can be put, no matter whether he had conceived the idea or not." *Roberts v. Ryer*, 91 U. S. 150; *Wells v. Jacques*, 5 O. G. 364, Fed. Cas. No. 17,398. Thus, a person who had ascertained that a solution of India rubber was useful in an asbestos rope packing for another purpose than that of producing elasticity, and who attempted to use it for that purpose alone, would be an infringer. But the patentee cannot prevent the use of ingredients in the combination which may accomplish the previously unknown result, but are not equivalents of the patented ingredient in the performance of the function which is specified and described in the claim; and therefore, if the starch sizing produces no elasticity, the defendants' packing is not an infringement, but is a new, though perhaps not a patentable, combination. When one combination is asserted to be an infringement of another patented combination, "a device in one, to be the equivalent of a device in another, must perform the same functions." *Rowell v. Lindsay*, 113 U. S. 97, 103, 5 Sup. Ct. 507. The complainant therefore adhered, in its part of the record, to the idea that a solution which should produce elasticity was desirable, and even necessary, and discarded, to a certain extent, the theory of its expert (who did not understand that any other quality than the adhesiveness of the rubber is made use of in the solution referred to in the complainant's patent), and attempted to prove that a starch sizing, which is adhesive, imparts also elasticity to an asbestos rope. One witness thought that it is necessary that some elastic and adhesive substance should be used, and he found that starch sizing produced elasticity, because, having caused the outside strands to adhere to the core, they can be laid more loosely together than otherwise would have been per-

missible. This was not the elasticity which the patentee stated in his specification when he said that a solution of rubber which saturated the core imparted elasticity,—in other words, made an elastic core. The other witnesses for the complainant added nothing to the general stock of knowledge in regard to the ability of a starch sizing to impart elasticity to a rope. In our opinion, a sizing made of starch, to cause the asbestos strands to stick to the central core, is not the equivalent of a solution of India rubber which saturates the core to make it elastic. The decree of the circuit court is affirmed, with costs of this court.

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**AMERICAN PNEUMATIC TOOL CO. v. BIGELOW CO.**

(Circuit Court of Appeals, Second Circuit. January 7, 1897.)

**PATENTS—PRELIMINARY INJUNCTION—PNEUMATIC DRILLING TOOL.**

The Bates patent, No. 364,081, for a pneumatic drilling tool, analyzed, and compared with an alleged infringing tool made under the Boyer patent, No. 549,102; and held, on appeal, that infringement was so doubtful as to require the dissolution of a preliminary injunction granted by the court below.

Appeal from the Circuit Court of the United States for the District of Connecticut.

This was a suit in equity by the American Pneumatic Tool Company against the Bigelow Company for alleged infringement of a patent for a pneumatic drilling tool. The defendant has appealed from an order of the circuit court granting a preliminary injunction.

Edward Rector, for appellant.

Leonard E. Curtis, for appellee.

Before LACOMBE and SHIPMAN, Circuit Judges.

SHIPMAN, Circuit Judge. This is an appeal from an order of the circuit court for the district of Connecticut, which granted an injunction pendente lite against the infringement of the third claim of letters patent No. 364,081, to Albert J. Bates, dated May 31, 1889, for a pneumatic drilling tool. The validity of this claim of the patent had been sustained by the decision of this court in the case of the present complainant against Robert C. Fisher et al. (18 C. C. A. 235, 71 Fed. 523). The infringing device in that case was known as the "Drawbaugh Tool," and is described in letters patent No. 472,495, dated April 5, 1892, to Daniel Drawbaugh. The alleged infringing tool in this case is described in letters patent No. 549,102, dated November 5, 1895, to Joseph Boyer. The facts in this case illustrate the difficulty which often arises in the decision of a motion for temporary injunction which is based upon an adjudication upon a different state of facts with respect to infringement. While the questions in regard to validity remain unaltered, the question in regard to infringement often requires an examination of a portion of the claim which in the first case was not adverted to, because infringement was palpable. In the Fisher Case, infringement being