

that the variances in process are immaterial, or the starting materials equivalents of those of the patents. There being no such proof here, the complainant must stand or fall by the results of the tests of the patent; and, since the defendant's color does not respond to these, it cannot be held to be an infringement. The conclusion thus reached renders it unnecessary to discuss the other points raised in the case. The decree of the circuit court is reversed, with costs, and cause remanded, with instructions to dismiss the bill.

On Rehearing.

PER CURIAM. In the patent, as it was finally amended in the patent office, and in the form in which that office notified the patentees that it was prepared to issue it upon payment of the fees, the sixth test was phrased as follows: "Reducing agents destroy the color, forming alpha-naphthylamine besides other products." In the printed copies as they were subsequently issued, the same test is phrased as follows: "Reducing agents destroy the color-forming alpha-naphthylamine besides other products." The record does not disclose which of these forms appeared in the original letters patent, "issued in the name of the United States of America under the seal of the patent office, and signed by the secretary of the interior, and countersigned by the commissioner of patents," as provided in section 4884 of the United States Revised Statutes. We assumed, perhaps erroneously, that the original letters patent conformed to the text of the amendments as allowed; but, if such original letters patent were phrased in the alternative, the situation is not materially changed. In the brief filed with this petition, it is asserted that the statement, "Reducing agents destroy the color-forming alpha-naphthylamine besides other products," is not untrue as to either complainant's or defendant's color. We do not find this assertion to be supported by the proof. The complainant's expert did, under cross-examination, make the following statements:

"My view is that by reducing agents alpha-naphthylamine, which was used to form the color of the patent in suit, and therefore in the patent is named the color-forming alpha-naphthylamine, is destroyed."

"Your interpretation that reducing agents are applied to the color is the right one. The meaning of this sentence is very clear. Reducing agents are applied to the color. The reaction which takes place destroys the alpha-naphthylamine besides other products."

"Alpha-naphthylamine is the most characteristic constituent of the so-called 'naphthol-black color compound.' Therefore that sentence, perhaps only to emphasize that alpha-naphthylamine is so important in the process, states that alpha-naphthylamine is destroyed by the reduction process."

None of these accurately states the fact. It is not true that any "alpha-naphthylamine is destroyed by reducing agents," nor that "the reaction which takes place [when reducing agents are applied to the product] destroys the alpha-naphthylamine," nor that "alpha-naphthylamine, * * * the most characteristic constituent of the * * * compound, * * * is destroyed by the reduction process," for the very good reason, as pointed out in the original opinion, that the alpha-naphthylamine had ceased to exist before the product was obtained, having perished in the process of chemical

combination which gave birth to the product. Certainly, in defendant's color there is no alpha-naphthylamine for reducing agents to destroy. If the same is true of a color produced according to the "example" set forth in the patent, as the evidence shows, then the sixth test is a false one, and must have been known to the patentees to be a false one when they received their patent. Their proper course would have been to correct this false statement by reissue.

Inasmuch as complainant now contends that a highly meritorious discovery and a patent otherwise valid has been wrecked by holding the inventors to a rigid construction of tests which they were under no obligation to insert in their specification, it may be appropriate to decide the question, which was not passed upon in the original opinion. It was contended that although the patent could not be sustained for the broad discovery set forth in the specification, that "any sulpho acid of any radical," when treated according to the process described, would give the result indicated, because no such broad discovery had been made, it might yet be valid for the definite product of a special process set forth in the specification as an "example." Reference may be had to our former opinion for a brief statement of the argument in support of this contention. A majority of this court, whose opinion is hereinafter set forth, are unable to assent to the conclusion sought to be sustained. To do so would be practically to rewrite the patent. Such a restriction of it to the product of the special process conforms neither to what the patentees have asserted to be their invention, nor to what they undertook to claim. Even upon this appeal it was still insisted by their counsel that their patent covers such sulpho acids of the general formula as might, when subjected to their process, produce naphthol-black. Their expert advanced this theory of a narrow construction only as a last resource, when the inherent defects of the patent were made apparent. We are unable to find in the patent or elsewhere any evidence that paragraph 3 was inserted merely as a "help to a better comprehension of the special process." On the contrary, it is the special process which is given "as an example" or helpful elucidation of the general process. Moreover, the statement is hardly accurate that paragraph 3 "only describes the class of bodies to which naphthol belongs," nor are we able to see that it "covers only the first step in the reaction." Manifestly, it does more than describe a class of bodies; it gives a recipe:

"First. Take one of a group of compounds which have been obtained by the reaction of certain acids upon a named substance. Second. Convert this into the diazo-azo compound, with a nitrous acid. Third. Take the compound thus formed, and allow it to react upon naphthol or naphthol-sulphonic acids. Fourth. Keeping it during this reaction in an alkaline solution."

And the following out of this recipe will take the experimenter from the first to the last step of the process. We do not understand from the testimony that any one skilled in the art would have any difficulty in applying the process of paragraph 3 seriatim to every sulpho acid in the group corresponding to its general formula. Certainly, he would not when further assisted as to details

by the "example" given of how to treat one of this general group. That paragraph 3 states what the patentees declare to be their invention seems to us beyond doubt, and the only fair interpretation of the patent is that originally given by complainant's expert, that their invention is, broadly, the formation by their process of the product sought to be patented from any sulpho acid of any radical; any one radical being susceptible of use interchangeably with any other, being the equivalent of that other and the products of all technically the same. The evidence shows conclusively that the statement that they had discovered that "any sulpho acid of any radical," treated according to their process, would give the product they said it would, was untrue. Briefly stated, the "discovery" which the inventors profess to disclose is that all mono-sulpho acids and all di-sulpho acids, treated in a prescribed way, will give a specific result; while the fact is that, so far as appears, no mono-sulpho acid thus treated will give such result; and, when they professed thus to disclose their "discovery," they either knew that the mono-sulpho acids will not give such result, or else knew nothing about the reaction of mono-sulpho acids under such process. In either case the "discovery" which they disclosed is not the "discovery" they made, and it is for the discovery or invention which the patentee makes and discloses that patent issues. Petition for rehearing is denied.

MEMORANDUM DECISIONS.

BEACH v. INMAN et al.

(Circuit Court of Appeals, Second Circuit. February 1, 1897.)

PATENTS—INFRINGEMENT—PAPER-BOX MACHINE.

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

Edmund Wetmore, for appellants.

John Dane, Jr., for appellee.

Before WALLACE, LACOMBE, and SHIPMAN, Circuit Judges.

PER CURIAM. We agree with the judge who heard the motion in the circuit court that the grooved roller of defendant's machine is substantially the upper clamping die of the patent, for the mechanical reasons set forth in the opinion below. That being so, defendant's machine is an infringement, and the order of the circuit court (75 Fed. 840) is affirmed, with costs.