

it does not insist upon the exercise of the will, but cures, or professes to cure, in despite of the will. Therein it strikes "a great popular chord," in that it enables one to indulge a habit of which he desires to be rid while partaking of the cure. An easy road to health will always be as popular as an easy road to wealth. This consideration, coupled with judicious advertising, may possibly account for the alleged large sales of the remedy of the appellee and the alleged diminished sales of the remedy of the appellant. At all events, this is a distinguishing characteristic claimed for the remedy of the appellee that brings into bold relief the fact that the appellee is a rival of the appellant, and not a counterfeiter of its goods. We think the court below was not in error in dismissing the bill.

Decree affirmed.

TRUMAN v. DEERE IMPLEMENT CO.

TRUMAN v. HOLMES et al.

(Circuit Court, N. D. California. February 23, 1897.)

1. PATENTS—CONSTRUCTION.

A patentee cannot insist on the construction of his patent which will include what he was expressly required to abandon as a condition of the grant, even if this takes away a part of the real invention.

2. SAME—BREAKING-CARTS.

The Putnam patent, No. 232,207, for an improvement in breaking-carts, is confined by the language of the claim and the patentee's acquiescence in amendments required by the patent office to a cart in which the foot-board is sustained below the shafts by straps passing beneath the axle.

Copy of file wrapper and contents in the matter of the patent granted De Witt C. Putnam, September 14, 1880, No. 232,207:

Department of the Interior, United States Patent Office.

To All Persons to Whom These Presents Shall Come, Greeting: This is to certify that the annexed is a true copy from the records of this office of the file wrapper and contents in the matter of the letters patent granted De Witt C. Putnam, September 14, 1880, Number 232,207, for improvement in breaking-carts. In testimony whereof I, John S. Seymour, commissioner of patents, have caused the seal of the patent office to be affixed this 6th day of September, in the year of our Lord one thousand eight hundred and ninety-three, and of the independence of the United States the one hundred and eighteenth.

[Seal.]

John S. Seymour, Commissioner.

Petition.

To the Commissioner of Patents: Your petitioner, De Witt C. Putnam, of Petaluma, Sonoma Co., Cal., prays that a patent may be granted to him for the invention set forth in the annexed specification. And he further prays that you will recognize Dewey & Co., San Francisco, Cal. (consisting of A. T. Dewey, W. B. Ewer, and Geo. H. Strong), and A. H. Evans, of Washington, D. C., as his attorneys, hereby appointed to alter or amend the said specification, and to receive the letters patent when issued.

D. W. C. Putnam.

Oath.

City and County of San Francisco, State of California—ss.: On this twenty-fourth day of April, 1880, before the subscriber, personally appeared the within named De Witt C. Putnam, and made solemn oath that he verily believes himself to be the original, first, and sole inventor of the breaking-cart herein described; that he does not know or believe that the same was ever before known

or used, and that the invention described and claimed in the annexed specification has not been patented to him, nor with his knowledge or consent, in any foreign country, and that he is a citizen of the United States.

[L. S.]

J. H. Blood, Notary Public.

Specification.

To All Whom It May Concern:

Be it known that I, De Witt C. Putnam, of Petaluma, county of Sonoma, and state of California, have invented an improved breaking-cart, and I hereby declare the following to be a full, clear and exact description thereof:

My invention relates to certain improvements in that class of vehicles known as "breaking-carts," in which young colts are broken to harness.

Erase
&
insert
"A"

Carts of this description are usually provided with very long shafts, and the seat is placed on springs immediately over the axle, or at such a distance back that the driver is not in danger of being kicked by a fractious animal. In this class of vehicles the foot-board is usually secured to the axle, while the seat is on springs, and it is therefore uncomfortable to ride upon, since, while the body of the occupant may move up and down, his feet must remain stationary.

My improvement consists in so attaching the foot-board to the vehicle that it shall move in unison with the seat, the same spring which supports the seat serving as a spring for the foot-board, as is more fully described in the accompanying drawings, in which Fig. 1 is a longitudinal section of my device; Fig. 2 is a bottom view; Figs. 3 and 4 are modifications.

Breaking-carts usually have two wheels A only, and the springs B are secured both to the axle C and the shafts D, said shafts being secured on the springs in the manner shown.

In order to attach the foot-board E to the wheels, I place metallic straps or bands F in a proper position to hold the foot-board, connecting these straps with the shafts and seat, and not with the axle.

In Figs. 1 and 2 I have shown the straps connected with the shafts at the rear ends and forward of the whiffletree-bar.

The seat and foot-board have therefore a corresponding vertical motion, the shafts being connected with the springs, as described.

Figs. 3 and 4 show modifications of my device. In Fig. 3 the straps F have their forward ends secured on the shaft and their rear ends with the seat itself, the straps passing in front of the axle instead of to the rear, as shown in Fig. 1. In Fig. 4 I have shown the strap F in a single piece passing transversely under the foot-board, the two ends being connected with the opposite shafts.

In either case the operation is the same, the foot-board being sustained by the springs, the same as the seat is, and independent, as far as its connections are concerned, from the axle of the vehicle. This relieves the rider from the disagreeable jar incident to this class of vehicles, where the foot-boards are connected with the axles, as is usually done.

Having thus described my invention, what I claim as new and desire to secure by letters patent is—

The improvement in breaking-carts, consisting in suspending the foot-board E by means of straps or hangers F from the shafts, seat, or that portion of the vehicle connected with the springs alone, whereby the seat and foot-board having a common vertical movement substantially as and for the purpose herein described.

In witness whereof I have hereunto set my hand.

D. W. C. Putnam.

Witnesses:

S. H. Nourse.

Frank A. Brooks.

Original Specn.

Cancelled per "A."

(Endorsements:) Patented File. U. S. Patent Office, May 22, 1880.

A. W., 6-2-80.

Department of the Interior.

United States Patent Office, Washington, D. C., June 2nd, 1880.

De Witt C. Putnam,	} Breaking-Cart.
Care A. H. Evans & Co.,	
Present.	

Filed May 22, 1880.

#10,810.

Room No. 87.

The patent of Jesse Winecoff, Oct. 17, 1871, No. 119,956 (Sulkies) substantially answers the claim.

It is therefore rejected.

Sanders, Examiner.

Chandler, Asst. Exr.

(Endorsements:) Office Letter. June 2, 1880. Patented File.

In the matter of the application of De Witt C. Putnam. Breaking-Cart. Filed ——. To the Hon. Comr. of Patents—Sir: I hereby amend by erasing the entire specification and substituting the following:

Amended Specification.

To All Whom It May Concern:

Be it known that I, De Witt C. Putnam, of Petaluma, county of Sonoma, and state of California, have invented an improved breaking-cart, and I hereby declare the following to be a full, clear and exact description thereof:

My invention relates to certain improvements in that class of vehicles known as breaking carts, in which young colts are broken to harness.

Carts of this description are usually provided with very long shafts, and the seat is placed on springs immediately over the axle, or at such a distance back that the driver is not in danger of being kicked by a fractious animal. In this class of vehicles the foot-board is usually secured to the axle, while the seat is on springs, and it is, therefore, uncomfortable to ride upon, since while the body of the occupant may move up and down his feet must remain stationary.

My improvements consist in so attaching the foot-board to the vehicle that it shall move in unison with the seat, the same spring which supports the seat serving as a spring for the foot-board, as is more fully described in the accompanying drawings, in which

Fig. 1 is a longitudinal section of my device.

Fig. 2 is a bottom view.

Breaking-carts usually have two wheels A only, and the springs B are secured both to the axle C and the shafts D, said shafts being secured on the springs in the manner shown.

In order to attach the foot-board E to the vehicle, I place metallic straps or bands F in a proper position to hold the foot-board, connecting these straps with the shafts and seat, and not with the axle. I have shown the straps connected with the shafts at the rear ends of and forward of the whiffletree bar.

It will be seen by this construction that the rear ends of the shafts and the seat are supported upon the spring B, while the straps F pass beneath the axle and are bent up so that their rear and their front ends are secured to the shafts at points behind and in front of the axle, while the central portion does not touch it at all.

The front board E, with its turned-up front portion, is then secured upon the bottom and front portions of the straps F. Being thus entirely independent of any direct connection with the axle, it will have the same movement imparted to it by the action of the spring that the shafts have, and it will have none of the unpleasant jar that a stationary foot-board or one supported from the axle will have, while the arrangement of the straps parallel with the shafts facilitates the attachment of the transverse foot-board and makes a strong construction.

Having thus described my invention, what I claim as new and desire to secure by letters patent is: the braces or straps F, having their ends secured to the shafts before and behind the axle, while the central portion extends beneath the axle and parallel with the shafts, and is adapted to support the transverse foot-board E, substantially as and for the purpose herein described.

I also amend by cancelling the drawing on file and substituting the new drawing filed herewith.

De Witt C. Putnam,
By A. H. Evans, Att'y.

(Endorsements:) "A" July 19, 1880. Amended Specn. Patented File. U. S.
Patent Office, July 19, 1880.

10810

1880.

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No. 232,207.

Of De Witt C. Putnam,
County of Petaluma,
State of Sonoma,
California,
"Breaking-Cart."

Rec'd May 22, 1880.

Petition " " "

Affidavit " " "

Specification " " "

Drawing " " "

Model Not required

Cert. dep. \$15, May 22, 1880.

Cash

Add'l fee Cert. \$20, Aug. 25, 1880.

" " Cash

Examined July 22, '80, Sanders.

Issued July 23, 1880, Arthur W. Crossley.

Patented Sept. 14, 1880.

Circular July 23, 1880.

Dewey & Co., San Francisco, Cal.
A. H. Evans, Present.

1880.
Contents.

Application papers.

1. Ref. June 2, 1880.

2. "A" July 19, 1880.

21. Carriages and Wagons. Sulkies.

D. S.

Title. Improvement in Breaking-Carts.

Fig. 1.

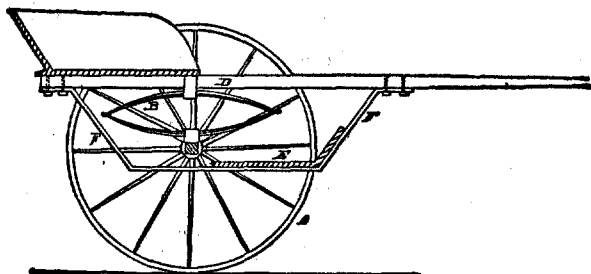
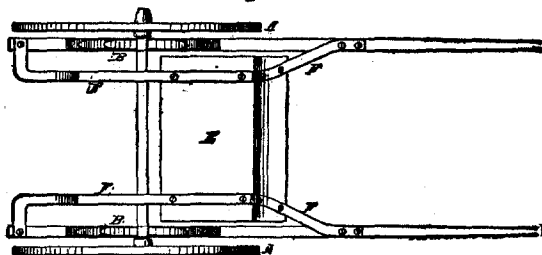


Fig. 2.



United States Patent Office.

De Witt C. Putnam, of Petaluma, California.

Breaking-Cart.

Specification forming part of letters patent No. 232,207, dated September 14, 1880; application filed May 22, 1880. (No model.)

To All Whom It May Concern:

Be it known that I, De Witt C. Putnam, of Petaluma, county of Sonoma, and state of California, have invented an improved breaking-cart; and I hereby declare the following to be a full, clear, and exact description thereof:

My invention relates to certain improvements in that class of vehicles known as "breaking-carts," in which young colts are broken to harness.

Carts of this description are usually provided with very long shafts, and the seat is placed on springs immediately over the axle, or at such a distance back that the driver is not in danger of being kicked by a fractious animal. In this class of vehicles the foot-board is usually secured to the axle, while the seat is on springs, and it is therefore uncomfortable to ride upon, since, while the body of the occupant may move up and down, his feet must remain stationary.

My improvements consist in so attaching the foot-board to the vehicle that it shall move in unison with the seat, the same spring which supports the seat serving as a spring for the foot-board, as is more fully described in the accompanying drawings, in which—

Figure 1 is a longitudinal section of my device. Fig. 2 is a bottom view.

Breaking-carts usually have two wheels, A, only, and the springs B are secured both to the axle C and the shafts D, said shafts being secured on the springs in the manner shown.

In order to attach the foot-board E to the vehicle, I place metallic straps or bands F in a proper position to hold the foot-board, connecting these straps with the shafts and seat, and not with the axle. I have shown the straps connected with the shafts at the rear ends of and forward of the whiffletree-bar.

It will be seen by this construction that the rear ends of the shafts and the seat are supported upon the spring B, while the straps F pass beneath the axle and are bent up, so that their rear and their front ends are secured to the shafts at points behind and in front of the axle, while the central portion does not touch it at all. The foot-board E, with its turned-up front portion, is then secured upon the bottom and front portions of the straps F. Being thus entirely independent of any direct connection with the axle, it will have the same movement imparted to it by the action of the spring that the shafts have, and it will have none of the unpleasant jar that a stationary foot-board or one supported from the axle will have, while the arrangement of the straps parallel with the shafts facilitates the attachment of the transverse foot-board and makes a strong construction.

Having thus described my invention, what I claim as new, and desire to secure by letters patent, is—

The braces or straps F, having their ends secured to the shafts before and behind the axle, while the central portion extends beneath the axle and parallel with the shafts, and is adapted to support the transverse foot-board E, substantially as and for the purpose herein described.

In witness whereof I have hereunto set my hand.

D. W. C. Putnam.

Witnesses:

S. H. Nourse,

Frank A. Brooks.

John L. Boone, for complainant.

Chas. E. Nougues and Dorn & Dorn, for respondents.

McKENNA, Circuit Judge (orally). This is a suit for the infringement of a patent for breaking-carts. The patent was issued September 14, 1880, to De Witt C. Putnam. The original application was made May 22, 1880. It was rejected June 2d, in the same

year, the patent office holding that a patent to one Jesse Winecoff, October 17, 1871 (No. 119,956), for sulkies, substantially answered the claim. This patent has been introduced in evidence, and consists of a two-wheeled vehicle of the sulky order, somewhat high, with a foot-board depending from its body. The foot-board is so attached to the vehicle that it moves in unison with the seat. The inventor, on this action of the patent office, amended his specification and claim, and it is necessary to compare them with the originals to ascertain what he gave up in order to secure his patent. I will not stop to read the original specifications, but will attach a copy of the file wrapper to the opinion. It will be observed upon inspection of the file wrapper that the remaining amendments made substantial omissions from the original. In the original he illustrated his invention in four ways by four figures, and gave descriptions of these figures. Describing 1 and 2, the applicant said:

"In Figures 1 and 2 I have shown the straps connected with the shafts at the rear end and forward of the whiffletree-bar."

Describing the result, he said:

"The seat and foot-board have therefore a corresponding vertical motion, the shafts being connected with the springs as described."

Describing Figs. 3 and 4 of the original specifications, he said:

"Figs. 3 and 4 show modifications of my device. In Fig. 3 the straps F have their forward ends secured on the shaft, and their rear ends with the seat itself, the straps passing in front of the axle instead of to the rear, as shown in Fig. 1. In Fig. 4 I have shown the strap F in a single piece, passing transversely under the foot-board, the two ends being connected with the opposite shafts. In either case the operation is the same, the foot-board being sustained by the springs, the same as the seat is, and independent, as far as its connections are concerned, from the axle of the vehicle. This relieves the rider from the disagreeable jar incident to this class of vehicles where the foot-boards are connected with the axles, as is usually done."

In the amendment to the specifications, Figs. 1 and 2 are retained, but Figs. 3 and 4 are omitted, he stating, "I also amend by canceling the drawing on file and substituting the new drawing filed herewith." Figs. 3 and 4 illustrate different constructions from Figs. 1 and 2. They illustrate the very constructions that are now contended for. The plaintiff, however, contends that those forms were not given up, and that his right to claim them is established by the decision of the court of appeals in the case of *Holmes v. Truman*, decided by the circuit court of appeals of this circuit, and reported in 14 C. C. A. 517, 67 Fed. 542. The case was at law, and was tried before a jury, I presiding at the trial. Among other things, I instructed the jury as follows:

"When a patentee has modified his claim in obedience to the requirements of the patent office, he cannot have for it a more extended construction, which has been rejected by the patent office. A patentee is not at liberty to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant. If, therefore, you find from all the evidence that the application for the patent sued upon, as originally filed in the patent office, was rejected upon the ground that said claim was anticipated by the Winecoff patent, defendants' Exhibit 5, and if

you further find that the applicant, D. C. Putnam, acquiesced in the rejection of said claim, and then modified and amended said claim so as to read as it now reads in the patent sued upon, then you are instructed that the plaintiff's patent must not now be construed to include generally the suspending of the foot-board by means of straps or hangers from the shafts, whereby the seat and foot-board have a common vertical movement, but it must be construed to include only the mode of suspension of the straps F described and claimed in the patent."

And again:

"I do not think it is material whether the strap is fastened directly to the shaft, but it must go under the axle."

It is claimed, however, as I have said, that the limitation put upon the claim by these instructions was removed by the court of appeals. The verdict in the case in the circuit court was for the plaintiff, Truman. Holmes took the case to the court of appeals, and assigned as error that the evidence showed that plaintiff's improvement was without invention, and that the court should have so instructed the jury on defendants' motion. Passing on the point, Judge Gilbert, speaking for the court, said:

"Upon the writ of error it is contended that the court erred in refusing, at the conclusion of the testimony in the case, to instruct the jury to return a verdict for the defendants in the action, for the reason that it was conclusively shown that the plaintiffs' improvement was without invention, and that the defendants had not infringed the same. The breaking cart which is the subject of the plaintiffs' patent is a low-bodied cart, in which the springs are supported directly upon the axle, with the shafts placed directly upon the springs. These shafts support the seat or cart body, and a foot-board, upon which the driver rests his feet, is fastened to and supported by a metal strap on each side, which is attached to the shafts in front of the axle, extends downward at an angle, and is then bent so as to pass back underneath the axle, parallel with the shaft, and is then bent upward, and its rear end is fastened to the shafts behind the axle. By this construction the foot-board moves vertically in unison with the seat and shafts. The advantage of this construction is that the seat is low with reference to the axle, and the driver sits easily and quietly, without deranging motion to the body, since the foot-board and the seat move in unison. With reference to this advantage, the evidence is that there were, before the plaintiffs' invention, but two classes of two-wheeled vehicles. One was the common butcher's cart, in which the seat is built high above the shafts, so that the feet of the driver rest on a floor, which is entirely above the springs. It was obviously impossible to construct a low cart in this manner. The other class was one in which the foot-rest was secured upon the axle or the shafts, while the seat was supported upon the springs. In this class of carts the body of the driver would move with the springs, while his feet would remain stationary. The patentee conceived the idea of making a low-seated cart, with the foot-rest supported below the shafts, and the axle between the springs and the seat, so that the axle was placed above the foot-rest, but beneath the springs and the seat. He placed the shafts on the springs, and the seat on the shafts, and supported the foot-rest underneath the axle by his metal straps. The claim of the patent is as follows: 'The brace or straps, F, having their ends secured to the shafts before and behind the axle, while the central portion extends beneath the axle, and parallel with the shafts, and is adapted to support the transverse foot-board, E, substantially as and for the purpose herein described.' It is impossible for the court to say, with reference to the testimony, that the jury should have been instructed that there was no invention in the plaintiffs' cart. The record shows that the cart was novel in construction, that it was useful, and that it went into immediate and general use. Counsel for the plaintiffs in error contend that there was nothing novel in the idea of suspending a foot-board in such a way that its vertical movement would be com-

mon to that of the seat, and that a particular and specific improvement in the means of suspension was all that the patentee could claim; and they argue that the iron strap of the patent as a device for holding the foot-board was not an invention, that the idea of such a strap was old, and that it was well known that two such straps, when hung parallel, would sustain anything laid across them. *This view of the patent leaves entirely out of sight the essence of the plaintiffs' invention, which is not merely the fact that the foot-board was hung beneath the shafts by iron braces, but that a cart was constructed with the seat directly above the springs and axle, thereby securing a low seat, with its advantages in connection with a breaking-cart, and a foot-rest which should move in unison with the same. In other words, it was the arrangement of the foot-board with reference to the other parts which was new.*"

The italics are mine, and I use them because on that portion of the opinion complainant relies for his contention. It is manifest that we may not determine the court's opinion from any particular passage. The whole opinion must be considered, and the question which was passed on. The only question involved was whether the construction of the strap, or its manner of fastening to the shafts, was essential. I held at the trial that it was not, but that the strap must go under the axle, and the court of appeals say:

"But it is a fair interpretation of plaintiffs' patent to say that they are protected in the use of a cart in which the shafts are placed directly upon the springs, and the foot-board is sustained beneath the axle by straps; and it is unimportant whether the straps are attached to any particular place along the shafts or to a cross-bar between the shafts, or whether they are made of one piece or of two or three pieces."

This language defines exactly the invention,—disposes of clearly the unimportant variations from it which were claimed as essential. Counsel for complainant, however, contends that the phrase, "and the foot-board is sustained beneath the axle by straps," means lower than,—nearer to the ground; securing a low cart. But this would certainly not be the ordinary meaning of the word, and may be absolutely an incorrect use of the word "beneath," and cannot be attributed to the learned judge who delivered the opinion of the court. "Beneath," as a preposition, means "lower in place, with something directly over or under." Webst. Dict. It follows, therefore, that the construction of the patent confines it to a cart with straps beneath the axle, and that the carts of the respondent, not being of that construction, do not infringe.

It is complained by complainant's counsel that this construction takes from complainant a part of his invention. Without disputing this, it may be said that it cannot be helped. This is often the result of a defective or insufficient claim. This hardly needs illustration. If so, it will be found in *Cramer v. Fry*, 68 Fed. 201, and cases there cited. In one of these it was said by Mr. Justice Bradley:

"When a claim is so explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. * * * But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the patent office or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct (as they should always be), the patentee, in a suit brought upon the patent, is bound by it. He can claim nothing beyond it."

The bill will therefore be dismissed.

I think the same ruling will be applied to the case of *Truman v. Holmes*.

Mr. Boone: Did you honor take into consideration the fact that the testimony shows that they also did make other carts where it did pass under the axle? There is testimony to that effect.

The Court: It is new to me if there is.

Mr. Nongues: There is no testimony to that effect.

Mr. Boone: There is one branch of the case where there is testimony to show they had made carts so.

The Court: I did not so understand it. Look it up, and let me see it. I will reserve my opinion until I see what effect that has.

NOTE. On February 25, 1897, the decrees ordered in the foregoing opinion to be entered were set aside by order as follows:

"McKENNA, Circuit Judge. The decrees in these cases are set aside, because, in addition to the points decided, there are other points in the brief, which, by inadvertence, did not receive the deliberate consideration and judgment of the court."

The orders of submission in both cases were then vacated, and the cases restored to the calendar. On March 26, 1897, both cases were reargued before MORROW, District Judge, and the bill in each case was ordered dismissed.

DIAMOND MATCH CO. v. OHIO MATCH CO. et al.

(Circuit Court, N. D. Ohio, E. D. April 16, 1897.)

No. 5,591.

1. PATENTS—ACTIONS ON SEVERAL PATENTS—MISJOINDER.

A suit can be maintained on several patents only when the inventions covered thereby are embodied in the alleged infringing machine, process, manufacture, or composition of matter; and where the averment is that defendant's machines embody "either the whole, or one or more, of the said inventions" contained in the patent sued on, the bill is demurrable.

2. SAME—MISJOINDER OF DEFENDANTS.

A joinder of defendants alleged to be infringers is bad, unless they are alleged to be joint infringers.

3. SAME—PLEADING.

A bill which fails to show that the invention of the patent sued on was not patented or described in some printed publication in this or some foreign country prior to the patentee's alleged invention thereof is demurrable.

Edwin Walker and Charles Colahan, for complainant.

Kline, Carr, Tolles & Goff and E. A. Angell, for respondents.

SAGE, District Judge. This case is before the court upon three demurrers to the bill. The grounds of demurrer are:

First, that the bill sets up three several letters patent of the United States, relating to several alleged inventions, which are entirely distinct and separate from each other; that the said letters patent contain, in the aggregate, 58 claims, relating to alleged inventions, which are disassociated and disconnected one from the other; that the averment as to infringement in the bill is, in sub-