

or of one-half to A. G. Jennings & Sons, for a warp-knitting machine; and on letters patent No. 397,140, dated February 5, 1889, and granted to the same Payne and William Campion, of Nottingham, assignors to A. G. Jennings & Sons, for a warp-knitting machine. Both patents were assigned regularly to the plaintiff, as the trustee of Payne and of Jennings. The first consists of a warp machine, which combines a needle-bar, having bearded needles, a presser-bar, a point or sinker-bar, a fixed sley-bar, guide-bars, mechanism by which motion is imparted to the needle-bar, presser-bar, point or sinker-bar, and guide-bars from a longitudinal cam shaft, and devices for imparting endwise motion to the guide-bars. The claims are for various combinations of these parts. The second is expressly for improvements on the first, and consists of a warp machine, which combines a needle-bar, having bearded needles, a presser-bar, a sinker-bar to which is secured the sley, said sley being placed below the sinkers on the sinker-bar, guide-bars, and mechanism by which motion is imparted to said bars from cams of a longitudinal cam shaft; the laterally reciprocating motion of the guide-bars being extended or shortened by suitable adjusting mechanism, and endwise motion being imparted simultaneously thereto by a rotary stud-wheel and lever connection. The claims are for various combinations of these parts in such a machine. The principal new elements of these combinations are the independent presser-bar and stationary sinker-bar.

Payne was a partner, at Nottingham, with William Henry Revis, in the manufacture of such machines, and Campion was in their employ. These inventions were used in their business, and patented in England. The assets of the firm went to an assignee, and finally to Revis, who became a partner in the firm there of Revis, Brewin & Marriott, which also manufactured and sold such machines in England, using, among others, these inventions. Payne made such machines for sale in this country. He claimed that Revis, Brewin & Marriott sent machines to this country. In 1891, Payne brought a suit on each one of these patents in this court, against Revis and Jennings, for infringements. Service was made on Revis, and he answered that he and Payne had been partners at Nottingham, under the firm names of H. B. Payne & Co. and J. B. Whitehall & Co., and that Campion was one of the employes of the partnership; that the partnerships paid all the expenses, and furnished all the materials and necessary facilities, for experimenting, perfecting, and testing the inventions; and that it was understood and agreed between Revis and Payne and Campion that all the inventions and improvements which should be made or discovered by themselves, or by their workmen, during the continuance of the partnership, should be the property of and held and used for the benefit of the partnership; and that the patents issued therefor, either in England or any country foreign to the firms, should be the property of the partnership; and that, by reason of these facts, the inventions patented in these letters patent were and continued to be the property of the partnership; and that these patents, therefore, in equity, belonged to him, and to the firm of which he was a member. The bills were amended by leave of court, and Marriott made a party defendant; and, on failure of Revis to answer

the amended bill, it was taken pro confesso, and decrees were entered therein, adjudging the patents to be valid, that the defendant had infringed, and enjoining them from in any manner, directly or indirectly, making, constructing, issuing, or vending to others, without the license or authority of the complainant, any warp-knitting machine made according to and employing and containing these inventions. After this, Revis, Brewin & Marriott manufactured in England four such warp machines, made according to these patents, having the independent presser-bar and stationary sinker-bar and their attachments in the combinations of the patents, and sold them to these defendants, who brought them to the United States, and now use them here. This bringing and use of these machines is the infringement complained of.

In this suit the defendants answer that the inventions covered by these letters patent, and all rights in the same, were vested in a partnership consisting of William Henry Revis and Henry Blackford Payne, doing business in the city of Nottingham, England, under the names of J. B. Whitehall & Co. and H. B. Payne & Co.; and that all the property, including the inventions and rights thereunder, was, for valuable considerations, sold to William Henry Revis; and that these alleged inventions were and are the property of William Henry Revis; and that the machines alleged to infringe these patents were made by William Henry Revis or the firm of Revis, Brewin & Marriott, of which he was a co-partner; and that, by virtue thereof, the defendants had the right and license to use these machines. So, these machines came from Revis, or the firm of Revis, Brewin & Marriott, into this country, in violation of the injunctions of this court against Revis in the suit brought by Payne against Revis here; and these injunctions still, so far as appears, continue in force; and the decrees, although not made between exactly the parties to this suit, were made between those under whom the parties here respectively claim, and would, on common principles, be conclusive of what was there decreed; and if the parties were not technically the same, either in name or in privity, the decrees upon the point of the ownership of the inventions, which was there in controversy, might be conclusive as a link in the plaintiff's chain of title. *Barr v. Gratz*, 4 Wheat. 213. When the defendants justify under Revis and his title, the decrees would be admissible, as a deed from him might be to show that he did not have the title. This seems to settle the title of the plaintiff to, and the validity of, the patent. If not, the evidence in this case to show the title of Revis to the inventions consists largely of the testimony of Revis as to an oral arrangement by which he claims it was to go to him; and in one place, when asked directly what the terms of this oral agreement were, he answered: "The terms of the oral agreement were that all inventions and patent rights obtained for said inventions should be the property of the firm, and should belong to both whilst members of that firm." *Prima facie*, the title to the inventions was previously, and at the time of the grant of the patents, in the patentees; and, if the question was open, all the evidence in the case, considered with this statement of Revis, would fail to show that the title to the patents, either legally or equitably, belonged to Revis, or

that anything more belonged to him than the right, as partner, to the use of the inventions by the firm or firms of himself and Payne, while both should be members. The dissolution or winding up of the partnerships would end his right, and leave the title to the patents as before, and in the plaintiff. Now, infringement is denied, but apparently not very strenuously. Altogether, as the machines were avowedly made under these patents in connection with others, claiming the right to so make them, infringement seems, without going through the intricacy of the mechanism, to be well established. The plaintiff therefore appears to be entitled to relief.

In the course of taking the testimony, several objections were taken to answers of witnesses for inadmissibility, which have been made subjects of motions to suppress. The objections relate to the consideration to be given to these particular answers, and not to the general competency of any witness, or branch of his testimony. Such objections do not warrant such proceedings. Motions to suppress overruled, and decree for plaintiff.

E. M. MILLER CO. v. MERIDEN BRONZE CO.

(Circuit Court, D. Connecticut. April 22, 1897.)

1. PATENTS—LIMITATION BY PRIOR ART—BURDEN OF PROOF.

A defendant who relies upon the prior art to limit the scope of the patent sued on has not the burden of proving that earlier patents were useful, operative, or commercially successful, or that they stated all the undeveloped possibilities of the invention therein disclosed. The mere fact that a patented device is limited in operation or application is not alone sufficient to destroy its relevancy in a consideration of the prior art. Mere paper patents may negative patentable novelty, if they sufficiently disclose the principles of the alleged invention, or if the alleged objections thereto could be obviated by mere mechanical skill.

2. SAME—INVENTION—INFRINGEMENT—LAMP-WICK ADJUSTERS.

The Homan patent, No. 477,865, for a device for adjusting the wick of a central-draft lamp, which combines the advantages both of a screw action and a direct-thrust action, is without patentable invention or novelty, and, even if conceded to be valid, is limited to the exact construction shown, or the ordinary equivalents thereof.

Mitchell, Bartlett & Brownell, for complainant.
John K. Beach and E. M. Marble, for defendant.

TOWNSEND, District Judge. This bill in equity alleges infringement of the first claim of patent No. 477,865, granted June 28, 1892, to William C. Homan, and duly assigned to the complainant. Said claim is as follows:

"(1) In a wick adjuster for central-draft lamps, the combination, with a wick-band, of a drawbar attached thereto; a stem connected at its upper end with the upper end of the said bar, and provided at its lower end with coarse screw threads; a tube having a centrally perforated knurled operating nut, located at its upper end, and constructed with internal screw threads corresponding in pitch to the threads of the stem aforesaid; and a rotatable suspension sleeve mounted on the tube below the said nut, and adapted to be removably secured to the lamp found in which it suspends the said tube,—substantially as described."

The defenses are denial of patentable invention, in view of the state of the art, and noninfringement. The object of the alleged invention was to provide a special form of wick-adjusting devices for central-draft lamps, which would combine the advantages of a screw and direct-thrust action in the adjustment of the wick and extinguishment of the light. This was accomplished by a combination of the ordinary wick band with a shank projecting laterally outward, to which was rigidly secured a perpendicular rod or drawbar passing up through the upper surface of the lamp, coupled at its upper end to another, parallel rod or stem, extending into a tube suspended perpendicularly in the lamp; said tube and the lower end of said stem being provided with coarsely-pitched screw threads. At the upper end of said tube was placed a centrally perforated operating nut, and beneath this a rotatable threaded suspension sleeve, which served to suspend said tube and the stem therein. By this combination it was possible either by rotating said operating nut to slowly raise or lower the wick, or to move it quickly, as for lighting or extinguishing the lamp, by simply taking hold of the drawbar, or the connection between it and the stem, and directly raising or lowering it. The coarseness of the pitch of the threads permitted them to operate as idlers within the tube. Every element of this combination was old. Such a drawbar was shown in the prior Meyrose and Parker patents. Broadly coupling a drawbar and stem was old, is shown in the prior Woodward, Davis, and Hoerle patents, and is specifically disclaimed. In the prior Miller, Carr, and Atwood patents were shown means for raising or lowering the wick by ratchets or pinions. These patents are further important because they show devices "combining the advantages of a screw and a direct-thrust action in the adjustment of the wick and extinguishment of the light," which were the results accomplished by the device of the patent in suit, as stated by the patentee. A screw device for raising or lowering the wick was shown in the prior patent granted to F. R. Rhind, April 19, 1887. It comprised a tube extending into the body of the lamp, and capable of being used as a filler, and provided with exterior spiral ribs, on which a yoke attached to the wick holder operated to raise or lower the wick by means of a rotatable head. The patentee, Rhind, says, as to the pitch of the screw, as follows: "Preferably, the spiral rib is made of a quick pitch, so that slight extent of rotation will impart a considerable up or down movement to the wick." Patent No. 394,465, granted December 11, 1888, to Z. Davis, shows a solid drawbar and stem, and a screw device passing through a nut like that of the patent in suit. It describes a construction with the screw nut either at the top or the bottom of the bowl of the lamp. Patent No. 435,357, granted August 26, 1890, to N. M. Hoerle, shows a construction similar to that of Davis, except that in this device the screw thread appears to be sufficiently coarse to permit the quick-thrust operation described in the claim in suit. All the results ascribed to the patented combination are old, and the new construction is due to the assembling together of old elements, "effected without requiring any modification of the parts which was not an obvious one, and within the ordinary skill of the mechanic." *Briggs v.*

Ice Co., 8 C. C. A. 480, 60 Fed. 87, 89. Counsel for defendant therefore strenuously contends that there was no patentable novelty in the claimed combination, or in the resultant operation. He contends that in the light of the prior art, and of the disclaimer by the patentee, there is nothing more than an aggregation of the old and well-known push devices and the quick pitch screw illustrated by Hoerle and described by Rhind. He further contends that those prior patents which show the result of slow screw and quick thrust by means of a ratchet and pinion would, if later, infringe the patent in suit, and therefore anticipate it, under the familiar rule. Complainant contends, as to these prior patents, that it does not appear they were anything more than mere paper patents, that there is no suggestion that they were capable of successful practical operation, and that in none of them is shown the conception of any combination in which an idler screw tube is so constructed as to provide the advantages of the screw adjustment and direct thrust in one combination. It has not been shown that the prior screw devices were commercially successful, or that they were intended to be so operated as to combine the screw adjustment and quick thrust. But I do not understand that the law necessarily imposes upon a defendant, who relies upon the prior art to limit the scope of a patent, the burden of proving that prior patents were useful, operative, or commercially successful, or that they stated all the undeveloped possibilities of the invention therein disclosed. It is not necessary that the patentee should have conceived the idea of all the uses of which his invention is capable. He is entitled to all the beneficial uses embraced within the scope of his invention. *Manufacturing Co. v. Cary*, 147 U. S. 635, 13 Sup. Ct. 472; *Dixon-Woods Co. v. Pfeifer*, 5 C. C. A. 148, 55 Fed. 390; *Manufacturing Co. v. Robertson*, 23 C. C. A. 601, 77 Fed. 985. Nor is the mere fact that a patented device is limited in operation or application, alone sufficient to destroy its relevancy in a consideration of the prior art. The development of new industries, the discovery of new products, the adaptation of old materials to new uses, may suggest improvements upon devices of the prior art, the principles of which are already sufficiently disclosed, although not fully developed, because not demanded by the prior existing conditions. In the application of this doctrine, patents have been held void for improved stamps required by new internal revenue laws; for new adaptations of gate guards for elevated railways; new forms of bicycle bells, pedals, and rubber tires. It is well settled that mere paper patents may negative patentable novelty, provided they sufficiently disclose the principles of the alleged invention, or provided the alleged objections could be obviated by mere mechanical skill. *Pickering v. McCullough*, 104 U. S. 310. "The very fact that a machine is patented is some evidence of its operativeness, as well as of its utility." *Dashiell v. Grosvenor*, 162 U. S. 425, 432, 16 Sup. Ct. 805. When, therefore, a prior patent appears upon its face to be relevant to the consideration of the prior art, I think the later inventor should show either that such device was not useful, or that it did not so disclose the principle of the later patent as to deprive it of its claim of patentable novelty. Com-