

See, also, Gray, Restr. Alien. Prop. §§ 140-142.

Indeed, Mrs. Seat's power of disposition would have become complete at the time when she made the deed to the McWhirters, even if her husband had then been in life. By the act of 1869-70 (section 3350, Mill. & V. Code) it was provided that, where property was settled upon a married woman to her separate use, she should have the same power of disposition as if she were a feme sole, unless the power of disposition was expressly withheld. Under the statute, the mere mention of one mode of disposition does not exclude others. *Lightfoot v. Bass*, 8 Lea, 350. The statute has been held to apply to settlements made before the statute, as well as to those after its passage. *Molloy v. Clapp*, 2 Lea, 586. Of course, the statute could not enlarge the estate previously vested, but it could enlarge the power of disposition of her separate estate by a married woman, limitations of which are not in the nature of vested rights, but are mere personal disabilities, that may be varied from time to time by the legislature in the exercise of that power which is usually called, for want of a more satisfactory description, the police power of the state.

It follows from the foregoing that, when Mr. Seat made the deed to the McWhirters, she owned absolutely the entire fund left to her by her father's will, and that she had full power to dispose of the same. By that deed, therefore, the validity of which, as between Mrs. Seat and all claiming under her, on one hand, and the McWhirters, on the other, has been conclusively adjudged in the decree dismissing the bill brought by Mrs. Seat in her lifetime against the McWhirters, Mrs. Seat and her legatees are estopped to claim that any of the property thereby conveyed is subject to a trust in her favor to pay what was received by her husband from her father's estate. The deed was, in effect, a release upon valuable consideration of all the property held by her husband, either in his own name or as trustee, and the fairness of it is not here open to investigation. The demurrer to the bill should have been sustained, not for nonjoinder of necessary parties, as held by the learned judge at the circuit, but because the bill failed on its merits. The decree dismissing the bill must therefore be affirmed, at the costs of the appellants.

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NATIONAL HOLLOW BRAKE BEAM CO. et al. v. INTERCHANGEABLE  
BRAKE BEAM CO.

CHICAGO RAILWAY EQUIPMENT CO. v. SAME.

(Circuit Court, E. D. Missouri. October 20, 1897.)

Nos. 4,047 and 4,048.

1. EQUITY PLEADING.—WAIVER OF ANSWER UNDER OATH—EXCEPTIONS TO ANSWER.

The waiver of an oath to the answer merely affects the evidential character and value of the answer, and does not operate as a waiver of complainant's right to except thereto for failure to answer interrogatories.

2. SAME—INTERROGATORIES.

In a patent infringement suit, where one of the issues is as to infringement or noninfringement, interrogatories attached to the bill, which require

disclosures going directly to this issue, cannot be objected to on the theory that the bill is for a discovery in aid of an accounting, and that, if any of the defenses set up prevail, the answers would be unnecessary, and therefore ought not to be required at that stage of the case.

3. SAME.

Equity rule 39, which dispenses with a full answer in cases where defendant might, by plea, protect himself from answer and discovery, will not protect a defendant in a patent suit from answering fully to interrogatories, where he has set up every possible defense, on the theory that each of these defenses might have been set up by a plea; for the proper office of a technical plea is to interpose some conclusive defense which may determine the suit without a hearing on the merits.

4. SAME—DISCOVERY.

Though bills of discovery are not now as necessarily and commonly resorted to as formerly, when parties were disqualified from testifying, yet discovery is still permissible, and is an invaluable aid in the administration of equitable remedies, in order to search the consciences of the parties, and thereby the more readily reach and deal with the very matter in dispute.

These were two suits in equity for infringement of a patent, the first being brought by the National Hollow Brake Beam Company and the Chicago Railway Equipment Company jointly, and the second by the last-named company alone, against the Interchangeable Brake Beam Company. The causes were heard together on exceptions to the answers of the defendant.

Paul Bakewell and James A. Carr, for complainants.  
Noble & Shields, for defendant.

ADAMS, District Judge. These two causes are submitted on exceptions to the answers of the defendant. These exceptions raise substantially the same questions, and may properly be considered together. The bills allege that the complainants are the owners of certain patents particularly described; that such patents are valid, and have been infringed by the defendant. The bill in No. 4,047 is for relief and discovery, and propounds to the defendant three interrogatories, as follows:

“(1) Whether, prior to the filing of this bill, and subsequent to December 8, 1892, the defendant, Interchangeable Brake Beam Company, made, sold, or used, or caused to be made, sold, or used, any railway brake beams like the brake beam herewith filed, and marked ‘Exhibit F’; and, if so, how many such brake beams were made, sold, or used, or caused to be made, sold, or used by it, and between what dates. (2) Whether it made, sold, or used, or caused to be made, sold, or used, the brake beam Exhibit F, before the filing of this bill, and after December 8, 1892. (3) Whether it made, sold, or used, or caused to be made, sold, or used, prior to the filing of this bill, and after December 8, 1892, any brake beams like the brake beam illustrated by Exhibit F, and, if so, how many.”

Exhibit F, referred to in the interrogatories, is a full-sized sample brake beam, and is charged to have been made by the defendant, and to be in all particulars like the brake beams made, sold, and used by the defendant, and to embody the device and invention of the complainant's patent, and to be an infringement thereof. The defendant's answer in case No. 4,047 denies the incorporation of the complainant, and the novelty and utility of the invention; alleges want of patent-

able invention, and that the device had been in public use and on sale in the United States for more than two years prior to the application for the patent; alleges anticipation of the invention by several persons; denies acquiescence by the public; and particularly denies any and all infringement by the defendant. From this general summary of the answer it will be seen that the defendant has pleaded and relies upon nearly every possible defense that can be made to a cause of the kind stated in the bill. The interrogatories addressed to the defendant relate to one of the several issues created by the answer, namely, the issue of infringement. The bill expressly waives answer under oath. The defendant fails to answer the interrogatories propounded, and the complainant excepts to the answer because of such failure, for insufficiency.

It is urged, first, by the defendant, in justification of such failure, that the complainant's waiver of an answer under oath is a waiver of all right to exceptions for insufficiency. This cause being against a corporation only, an answer under oath, even if not waived by the bill, could not have been required. Corporations answer under the sanction and solemnity of their seals only; but, whether defendants answer under oath or under corporate seals, when oaths are waived they are required to answer fully on every material issue. The waiver of an oath in any case is made by the complainant for the purpose of depriving the defendant of the advantage of his answer as evidence in his favor. If no such waiver is made, a sworn answer is taken as evidence in favor of the defendant, so forceful as to require two witnesses or one witness and corroborating circumstances to overcome it. From this it appears that the sole purpose of a waiver of an oath to an answer is to affect the evidential character and value of the answer. It has nothing to do with the answer as a pleading, and the rule prevails that the defendant must answer fairly and fully to each and every material fact alleged in the bill. This fair and full answer should serve the purpose of eliminating many undisputed facts from the case. If facts alleged by the complainant are admitted by the defendant in his answer, the necessity for consumption of time and expenditure of money in making proof thereof does not exist, and the court's attention is drawn to the debatable issues only. The power of the court to require such an answer ought not to be abridged at all; and therefore, if the complainant, for the purpose of preventing the defendant from making its answer equal in evidential strength to two witnesses, sees fit to waive the oath to the answer, the right to exceptions for insufficiency must still exist. *Gamewell Fire-Alarm Tel. Co. v. Mayor, etc.*, 31 Fed. 312; *Reed v. Insurance Co.*, 36 N. J. Eq. 393; *Colgate v. Compagnie Francaise*, 23 Fed. 82; *Whittemore v. Patten*, 81 Fed. 527, and cases cited.

Again, it is urged by the defendant that the several interrogatories of the complainant's bill are for a discovery in aid of an accounting, and that, as an accounting will not be necessary if any of its defenses prevail, answers to the interrogatories ought not now to be required. This, I think, is begging the question. One of the issues presented by the bill and answer is infringement or noninfringement. The interrogatories propounded go directly to this issue.

Again, it is urged by defendant that, under equity rule 39, it is not required to answer these interrogatories. This rule, so far as it is necessary to quote it, is as follows:

"The rule that if a defendant submits to answer he shall answer fully to all the matters of the bill, shall no longer apply in cases where he might by plea protect himself from such answer and discovery."

It is contended that because the defendant might have resorted to pleas in bar, and in this way presented each and every one of the defenses separately stated in the answer, he is thereby entitled to protection against discovery, found in rule 39, supra. I think this is a misconception of the rule, and a misconception of the office of pleas as distinguished from answers. The plea is an appropriate resort when the defendant relies upon some definite and conclusive ground why the suit should be either dismissed, delayed, or barred. Story, Eq. Pl. (10th Ed.) § 649; Coop. Eq. Pl. p. 223. The proper office of a plea is to interpose some ground of conclusive defense, like the pendency of a prior suit between the same parties, want of title in the complainant, statute of limitations, former adjudication, or that the defendant is an innocent purchaser for value, which may determine the suit without the necessity of an exhaustive hearing on the merits of the case under the several different defenses which may be appropriately made by answer. The defendant, by such a plea, rests his entire defense on it, and may not resort, after an adverse decision on his plea, to an answer on the merits. *Hughes v. Blake*, 6 Wheat. 453; *Rhode Island v. Massachusetts*, 14 Pet. 210, 257. The defendant, as already observed, has pleaded every conceivable defense in its answer, and, among them, the defense of non-infringement. The contention that all these defenses could have been interposed as technical pleas, in my opinion, overlooks the distinctive function of pleas, and cannot be assented to.

Judge Story, in his work on Equity Pleadings (section 652), says:

"But every defense which may be a full answer to the merits of the bill is not, as of course, to be considered as entitled to be brought forward by way of plea; \* \* \* for, where the defense consists of a variety of circumstances, there is no use in the plea; the examination must still be at large. \* \* \* The true end of a plea is to save to the parties the expense of an examination of the witnesses at large. And the defense proper for a plea is such as reduces the cause, or some part of it, to a single point."

And again, in section 653:

"Upon this account it is a general rule that a plea ought not to contain more defenses than one, and that a double plea is informal and multifarious, and therefore improper."

And again, in section 654:

"It may be laid down as a rule that various facts can never be pleaded in one plea, unless they are all conducive to a single point on which the defendant means to rest his defense. \* \* \*"

From these recognized principles it is clear that defendant's answer, involving, as it does, six different defenses, cannot be treated as the equivalent or substitute for so many pleas in bar, within the true meaning of rule 39. To permit defendant to claim immunity

from a full answer would, in effect, permit him to deny to complainant the right to make proof of infringement which is denied by the defendant.

Lord Langdale, in *Chadwick v. Broadwood*, 3 Beav. 540, referring to what the answer must contain by way of a discovery, makes the following very pertinent and rational observation:

"If they [the interrogatories] are material for the purpose of displacing the plea, they are to be answered; but, on the other hand, if they are not material for that purpose, you are not to answer them, for, by so doing, you over-rule your plea."

This doctrine seems to be founded on the intrinsic nature of pleas, as already observed. It presupposes that the plea raises a definite and distinct issue, single in its character, upon which interrogatories may be predicated, and also that there might be possible issues upon which evidence would be immaterial, and therefore not to be inquired into by interrogatories or otherwise; in other words, that the defendant stakes his case on his plea, and of necessity excludes consideration of other possible issues. For these reasons, the defendant is not protected by rule 39 from answering the interrogatories relative to infringement.

The bills in both of these causes are for relief and discovery. Notwithstanding the fact to which my attention was called in argument, that bills of discovery are not now as necessarily and commonly resorted to as formerly, when parties were disqualified from testifying; and, notwithstanding the fact that they may not be available in aid of actions at law,—yet, in my opinion, discovery is not only now permissible, but is an invaluable aid in the administration of equitable remedies. See rule 41 in equity, and addition to rule 41 made by the supreme court at its December term, 1871. These are remedies addressed to the conscience, and litigants in this court ought to have their consciences searched. By so doing, time is saved, expense is avoided, and the court is able the more readily to reach and deal with the very thing in dispute.

The foregoing remarks made in suit No. 4,047 are equally applicable to the other suit submitted, No. 4,048, and the exceptions in both are allowed

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#### VITASCOPE CO. v. UNITED STATES PHONOGRAPH CO.

(Circuit Court, D. New Jersey. September 4, 1897.)

##### 1. UNFAIR COMPETITION IN TRADE.

Complainants' assignors contracted with Thomas A. Edison for the manufacture by him of a certain number of machines, invented by Edison and another, for projecting apparently living figures on a screen. To distinguish these machines from others made for like purposes, they had coined the word "Vitascope," and it was agreed between the parties that they might call them "Vitascopes" or "Edison Vitascopes." Complainants failed to take and pay for all of said machines according to the contract, and thereafter Edison sold the machines not taken to reimburse himself for their cost. *Held*, that the purchasers from Edison, in offering these machines for sale as "Edison Vitascopes," were not guilty of unfair competition with complainants, since there was no misleading or deception of the pub-

lic, who in fact obtained the identical machines to which the name was intended to apply.

2. SAME.

The grounds on which unfair competition in trade will be enjoined are either that the means used are dishonest, or that, by false representation or imitation of a name or device, there is a tendency to create confusion in the trade, and work a fraud upon the public, by inducing it to accept a spurious article. Where these grounds are absent, and no trade-mark rights exist, injunction does not lie.

James Harold Warner, for the motion.  
Howard W. Hayes, opposed.

KIRKPATRICK, District Judge. The amended bill or complaint in this cause sets out that Raff & Gammon, the assignors of the complainants, in January, 1896, began the manufacture of a certain machine or device invented by Thomas A. Edison and Thomas Armat, to project upon a screen apparently living figures and scenes, in view of an audience, and that the said Raff & Gammon coined the word "Vitascope," and applied it to designate the said machine or device; that afterwards the said Raff & Gammon assigned to the complainants their rights to manufacture the said machines or devices, and to lease the same under the name of "Vitascope," and to sell territorial rights for giving public exhibitions with said machines and devices under the name of "Vitascope"; and that, in the exercise of such right, the complainants have manufactured a large number of such machines, and given thousands of exhibitions in all the large cities of the United States. The bill alleges that the said machines have been largely advertised, at great expense to them, as "Vitascopes" and "Edison Vitascopes," and have become known to the public by such name. The bill further alleges that on or about January 15, 1896, the said Raff & Gammon entered into an agreement with Thomas A. Edison whereby said Edison agreed to manufacture for them certain of the said machines and devices, and to permit said machines and devices to be known and called "Edison Vitascopes"; that said Edison also agreed, in consideration of the price paid for the manufacture of said machines and devices, to give to said Raff & Gammon the sole and exclusive right to use the name of Edison in connection with the word "Vitascope," as descriptive of said machines or devices, and that he, the said Edison, would not sell, lease, or otherwise dispose of machines similar to the ones referred to as "Edison Vitascopes." The case so presented is fully answered and denied in all material averments by the answer of the defendants and the affidavits annexed thereto. Edison, in his affidavit, denies the making of an agreement such as is set out in the complainants' bill, and avers that he did no more than undertake to make 100 projecting kinetoscopes, which, to distinguish from other machines made for like purpose, it was agreed should be called "Edison Vitascopes." Edison swears that he made these machines according to contract, and that Raff & Gammon failed to take and pay for all of them, and that he sold such of the machines as they neglected to take, to reimburse himself for their cost. It is stated in the answer, and not denied or disputed by the complainants, that

the machines or devices put upon the market by the defendants as "Vitascope" and "Edison Vitascope" are a part of the original lot of 100 machines or devices ordered by Raff & Gammon from Edison, and that the defendants' machines or devices are in all respects similar to those acquired from Edison by the complainants.

To make the words "Vitascope" or "Edison Vitascope" a distinguishing mark for the manufactured product to be used or sold was the purpose of their adoption, and no exclusive right to their use can be acquired except to identify the article with which they are associated. As the sole object of the name was to distinguish that particular machine or device from others of the same kind or class, I fail to see why the names "Vitascope" and "Edison Vitascope" are not as properly applied in describing the machines of the defendants as those of the complainants. The complainants, in their amended bill, do not ask an injunction because any trade-mark right in the words "Vitascope" and "Edison Vitascope" has been infringed, but relief is sought upon the ground that defendants' action tends to deceive, and is a fraud upon, the public. How is the public deceived, and in what way do the defendants perpetrate a fraud upon them? The defendants offer for sale machines or devices for projecting apparently living figures upon a screen, which are manufactured by Edison according to the ideas, plans, and specifications of himself and Thomas Armat upon the order of Raff & Gammon, and which, to distinguish them from other devices of like kind and purpose, Edison, the maker, and Raff & Gammon, for whom they were made, have agreed should be called "Vitascope" or "Edison Vitascope." What the public want, and what they ask for, is a machine made or invented by Edison projecting apparently living figures upon a screen. They get it. They are not deceived. No spurious machine is palmed off upon them, but they receive the identical device made by Edison, and which at the time of its creation was given the name "Vitascope" or "Edison Vitascope," and under which name it was sold to the complainants and defendants alike. It may be that the demand for the machine was in part procured, and the interest of the public excited, by the advertisements of the complainants, but that alone affords no ground for equitable relief. The case as presented seems to me to come clearly within the principle decided in *Appollinaris Co. v. Scherer*, 27 Fed. 18. There, however, the complainant possessed an element of strength wanting here, in that he had the undisputed exclusive right, so far as it could be acquired, to sell the product in the territory sought to be occupied by the defendant. There is no proof in this case of an exclusive right to the use of the words "Vitascope" and "Edison Vitascope," as connected with the machine. The bill alleges an agreement to that effect between Raff & Gammon and Thomas A. Edison, but it is specifically denied under oath by Edison himself.

The court is always willing to restrain unfair competition in trade, but the ground upon which such relief is granted rests upon principle,—either that the means used are dishonest, or that, by imitation of name or device, there is a tendency to create confusion in the

trade, and enable the seller to pass off upon the unwary his goods as those of another, and thereby deceive the purchaser; or that, by false representation, it is intended to mislead the public, and induce them to accept a spurious article in the place of one they have been accustomed to use. *Orr v. Johnston*, 13 Ch. Div. 434; *Fischer v. Blank*, 138 N. Y. 244, 33 N. E. 1040; *Sawyer v. Horn*, 4 Hughes, 239, 1 Fed. 24; *Wilson v. T. H. Garrett & Co.*, 47 U. S. App. 250, 24 C. C. A. 173, and 78 Fed. 472. As this case is now presented to the court, it lacks all of these principles. I am therefore of the opinion that a preliminary injunction should not issue as prayed for in the bill.

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GERMAN SAVINGS & LOAN SOC. v. DE LASHMUTT et al.

STARR et al. v. GERMAN SAVINGS & LOAN SOC. et al.

(Circuit Court, D. Oregon. September 4, 1897.)

1. DEEDS—SUIT TO CANCEL—UNDUE INFLUENCE—PLEADING.

When a deed is attacked on the ground of fraud in the grantee, by taking advantage of confidential relations between the grantor and himself, where the confidential relations are admitted, the burden is on the grantee to show that the grantor was not influenced thereby; and an answer stating that defendant does not know whether or not "she yielded to the persuasions or solicitations or directions, so fraudulently, as alleged, made by him, on account of or by reason of her said alleged confidence in him," etc., is to be construed as an admission that the conveyance was made as a result of the confidential relations, persuasions, etc.

2. SAME.

A deed obtained from a person of weak mind, while she was in a home for inebriates, in consideration of a debt due her grantee, and of a further advance made by him to relieve her pressing need of money, while acting as her agent and confidential adviser, is void, in the absence of any affirmative showing that she was not influenced by her relations with the grantee, and that she acted upon independent advice.

3. ACCORD AND SATISFACTION—CONSIDERATION.

Where a deed made in consideration of an existing debt and further advances is void because of confidential relations and undue influence, such debt and advances are a sufficient consideration to support a subsequent agreement of accord and satisfaction, made between the grantee and the grantor's heir after her death.

Martin L. Pipes, for complainants in cross bill.

Milton W. Smith and Walter S. Perry, for defendants in cross bill.

BELLINGER, District Judge. This is a suit by the German Savings & Loan Society to foreclose a mortgage, given by the defendants De Lashmutt and wife, upon certain real estate acquired by De Lashmutt by deed dated June 7, 1887, from Bridget Lavin, the mother of the defendant Starr. Starr appeared, and filed his cross bill, in which he alleges that on and long prior to June 7, 1887, De Lashmutt was the agent and confidential adviser of Bridget Lavin in respect to the management of her property, of which she owned a large amount, both real and personal; and, as such agent, he had long before said date collected the rents and profits of such property,