

of bone dust, or bone ash, or animal carbon, and is fit only for fertilizing purposes. The product in question in this case does not come within this last clause of the paragraph, for the finding of the court below is that it is fit for other than fertilizing purposes. It does not come under the first clause, as we have seen, because it is not "crude bones, not burned, calcined, ground, steamed, or otherwise manufactured."

It is urged that, in case of doubt, the doubt should be resolved in favor of the importer, and that duties are never imposed upon doubtful interpretation. But this is not a case of doubt. The statute is clear, and its meaning is not uncertain or ambiguous. It is so plain that to read it is to construe it. The judgment of the circuit court will be affirmed.

PILLSBURY-WASHBURN FLOUR-MILLS CO., Limited, et al., v. AMERICAN WIRED-HOOP CO.

(Circuit Court, D. Minnesota. November 30, 1897.)

1. PATENTS—INVENTION—MACHINE FOR PRINTING BARREL HEADS.

The Hooper patent, No. 557,582, for a printing press designed especially for printing on barrel heads, is void for want of invention, in view of the prior state of the art.

2. SAME—MACHINE FOR PRINTING ON BOARDS.

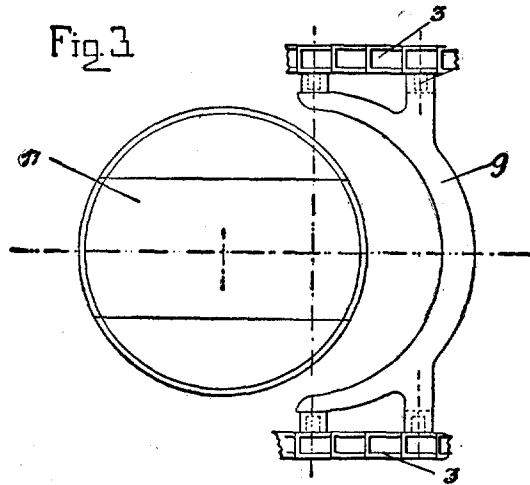
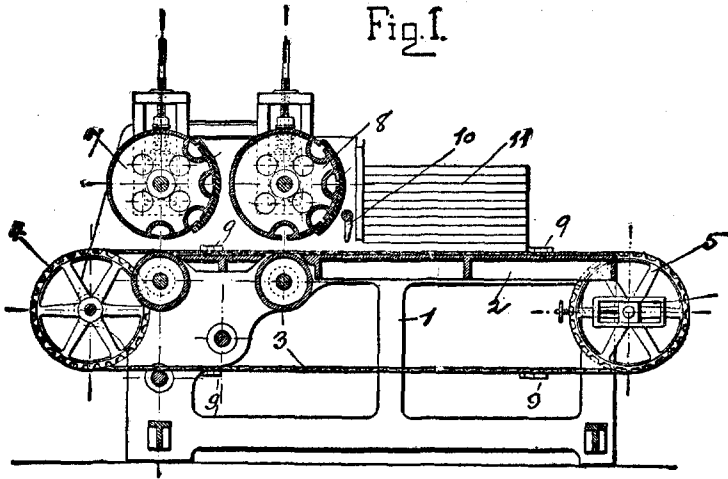
The Hooper & Hollingsworth patent, No. 359,972, for a machine for printing on boards, and which is especially designed for printing in two colors at one operation, by a combination of two type cylinders, and elastic-face feed rollers between them, construed, and held infringed as to the first, second, and third claims, and not infringed as to the sixth claim.

This was a suit in equity by the Pillsbury-Washburn Flour-Mills Company, Limited, and Francis X. Hooper, against the American Wired-Hoop Company, for alleged infringement of letters patent No. 359,972, issued March 22, 1887, to F. X. Hooper and W. Hollingsworth, for a machine for printing on boards, and also No. 557,582, issued April 7, 1896, for a printing press designed especially for printing barrel heads. The patent of 1887 is adapted for printing upon boards with two colors in one continuous operation. In the specifications the patentees say:

"One description of boards which are to be printed by this machine are used for the ends of boxes; such boxes as are employed for packing goods of various kinds,—notably, canned goods, such as oysters, fruits, etc. Instead of stenciling upon the end of the ready-made box, to denote its contents, the board designed for the box end is printed previous to being made up into the box. Where boxes are made up in large numbers for packing special articles, this plan is found more economical, besides producing neater and better work. Another kind of boards which may be printed to advantage are those used for advertising signs."

Fig. 1 is a vertical, longitudinal section of this machine. In his description the patentee says:

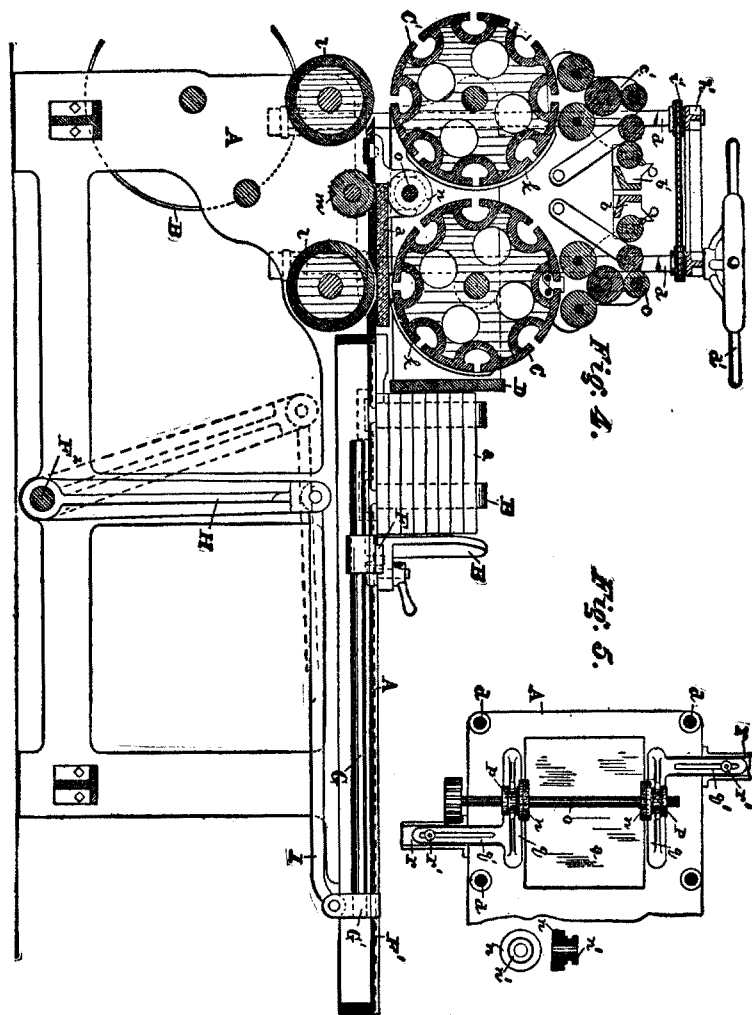
"Referring to Fig. 1, 1 is the frame of the machine. 2 is the bed. 3 is a feed chain. 4 and 5 are sprocket wheels mounted in a frame, by which the feed chain is driven. 7 and 8 are two printing rollers suitably geared with the driving mechanism, so as to turn in the proper order in relation to the



feed. 9, 9, 9, 9, are feed knockers secured upon the feed chain in the manner shown in Figs. 3 and 4; and, as shown in those figures, the knocker is approximately semicircular in shape, and conforms in outline to a barrel head which is divided into several pieces. In order to feed a barrel head or other board divided into several parts on the feed belt, it is necessary to provide a knocker of peculiar form, conforming in shape to the barrel head or other board, and this feed of an irregular shape presses all the pieces of the board forward at the same time."

The claims read as follows:

"(1) In a machine for printing barrel heads consisting of several pieces, the combination of printing rollers, a curved barrel-head holder, being of the same radius as the barrel head, and opening in a direction away from the direction of the feed, and a feed belt carrying an oppositely curved knocker, also of the same radius as the barrel head,—the curved knocker being arranged to engage the ends of the boards forming the barrel head to be printed, and to hold them in a circular form while being carried to the print-



ing rollers,—as and for the purpose specified. (2) In a machine for printing barrel heads consisting of several pieces, the combination of printing rollers, a curved barrel-head holder, semicircular in form, being of the same radius as the barrel head, and opening in a direction away from the direction of the feed, and a feed belt carrying an oppositely curved knocker, semicircular in form, also of the same radius as the barrel head,—the curved knocker being arranged to engage the ends of the boards forming the barrel head to be printed, and to hold them in a circular form while being carried to the printing rollers, as and for the purpose specified."

Fig. 4 is a vertical, longitudinal section of this machine.

"The letter A designates the frame and table; B, the drive pulley. This machine has two type cylinders, C, C', both mounted in a movable frame, D, above the table. Each cylinder is designed to work a different colored ink, so that a board, a, passing below the cylinders, will receive an imprint of

two colors. Two ink receptacles, b, b', are provided above the cylinders, and two sets of ink-distributing rollers, c, c', of suitable or well-known construction in printing machines, are also provided. * * * Two feed rollers, each having an elastic face, n, bear down on the upper side of the board, a, so that the board is between the lower roller, m, and the two upper ones, n. The two upper rollers, n (see Fig. 5), are narrow, and each bears on the surface of the board, a, along one edge. These rollers are made of metal, n', and have a rubber ring, n, around the metal part. The rubber-ring part comes in contact with the board, and as it has a good grip thereon the feed movement of the board is insured, and the rollers avoid defacing the imprint made by the first cylinder."

Claim 6 of this patent reads as follows:

"In a machine for printing boards in two colors at one operation, the combination of two type cylinders, and elastic-face feed rollers between the said two cylinders, for the purpose set forth."

In patent No. 557,582 the patentee says:

"The primary object of this invention is to print any desired matter upon a barrel head composed of several pieces, and maintain the barrel head in circular form or alignment while being printed, so as to cause the printed matter to register when the head is put in a barrel. To accomplish this result, the barrel heads are placed in the receiver, one upon the other, with the divisions between the parts forming each head parallel to the feed. This is an essential feature in the mode of operation. The holder, containing a number of barrel heads, is curved so as to fit the circle of the barrel head, and the boards are pressed into it when placed in the machine so as to bring them into circular alignment, and force the edges of the several pieces together closely. When the bottom barrel head, consisting of several pieces, drops onto the table between the feed chains, the pieces are, in consequence of the alignment produced by the holder, in circular form. While thus lying upon the table, they are struck by the curved knocker [Fig. 3], which is of the same radius as the curve of the barrel head, and fed forward by it, still being retained in circular alignment, and the edges of the pieces pressed closely together by the curve of the knocker, and are thus held by the curved knocker in circular alignment while being carried to the printing and feed rollers, by which they are caught, and printed in this position. It will be seen that the position of the boards, and the maintenance of that position in a divided barrel head, is of the utmost importance."

Paul & Hawley, for complainants.

Walter H. Chamberlain, for defendant.

LOCHREN, District Judge. I shall have to pass upon this question at the present time, as, owing to pressure of business, I am unable to take the case under consideration. My impression is that the patent of 1896 is not valid, and that, in view of the state of the art at that time, it contains no feature that was novel. It appears that, before that time, conveyors had been made to correspond in shape with the article of wood to be printed, so as to move it directly forward in the movable frame. They generally printed parts of boxes, which were rectangular pieces of wood, using a hopper which was square in shape; and the use of the square hopper showed that it was obviously necessary to have something which would keep these pieces of wood in proper place to be taken by the conveyor under the printing press. The changes in the conveyors previously used show that it was understood to be necessary that they should be so fashioned as to convey the articles to be printed without moving to one side or the other under the roller that was to do the printing. It

would be obvious to anybody who was engaged in that business that it would be necessary to carry the boards forward directly under the portion of the roller that was to make the impression upon them. So, I think, as long as a hopper was necessary there, and was used to insure the placing of those barrel heads under the right portion of the roller, the use of a circular form of hopper would occur to any one as the kind necessary to be used for that purpose.

With reference to the sixth specification of the patent of 1887, I think it is obvious that there is no infringement of that. That is for a feed roller between two cylinders for the purpose set forth, which was to carry, or assist in carrying forward, from one cylinder to the other, the wood to be printed, as this endless conveyor was used in the machine. Although it did at the same time perform the service that is performed by the defendant's roller, still that is not what it was made for, nor the purpose set forth. The defendant's roller does not operate as a feed roller. It is simply an idle roller, and does not press particularly upon the wood to be moved, as it rests in the slots, although it may, and practically does, serve to keep the wood from moving from one side to the other.

The most serious question is with reference to the first, second, and third specifications of complainants' patent, which are really one, as far as they need be considered in this case, and is as to whether there is in the defendant's machine an infringement of these specifications of the patent owned by the complainants. It seems that, before that patent, printing in two colors was done, as shown by the Hinds machine, but by virtually separate machines; and this machine in question purposes to print boards in two colors at one operation, with one machine, by a combination of two type cylinders, each for a different color,—both cylinders and their inking devices being mounted in the same yielding frame. The cylinders in these machines of complainants and defendant are substantially alike, but the claim on the part of the defendant is that its cylinders are not mounted on the same yielding frame, and therefore do not come within the specification. Although the complainants' machine has the yielding portion in the upper part, containing the type cylinders and the inking devices, while the defendant's machine has it in the lower portion, containing the other cylinders, it seems to be admitted that, if that lower portion of the defendant's machine was so bound together that the yielding would be the same in both cylinders at once, there would be an infringement. Under the authority and the rules cited in the *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 958, as it is called, it does not occur to me that the fact that those cylinders are made to yield, not rigidly together, but one at a time, or only partially together, as they may be pressed upon by that portion of the wood that is moving forward, necessarily makes any special difference, as long as the cylinders are mounted in a frame, and there is a yielding, which, if not the same, is at least an equivalent, practically and mechanically, of that part of the complainants' patent. I am inclined to think that there is an infringement of the complainants' patent in that respect, and for that reason, and to that extent, I think complainants are entitled to judgment.

McDONALD et al. v. MILLER et al.

(Circuit Court, E. D. Wisconsin. January 7, 1898.)

PATENT INFRINGEMENT SUITS—EQUITY JURISDICTION.

A bill in equity for infringement of a patent is not maintainable when it is filed only a few days before the patent expires, and when there is no showing of special circumstances requiring the issuance of an injunction for the time the patent has to run. The mere formal right to an injunction without the actual need or intention to exercise it is not sufficient in such a case.

This was a suit in equity by James S. McDonald, trading under the name of J. S. McDonald & Co., and the Samuel Hano Company against Henry C. Miller and others, for alleged infringement of a patent. The cause was heard on demurrer to the bill.

Elliott & Hopkins, for complainants.
Benedict & Morsell, for defendants.

SEAMAN, District Judge. Upon the facts stated in the bill of complaint, even after allowing the amendment tendered at the hearing, I am of opinion that equitable interference is neither necessary nor proper for protecting any rights the complainants may have in the matters charged, and that the demurrer must be sustained. The bill alleges infringement of letters patent No. 224,529, issued February 17, 1880, to Samuel Hano, for an improvement in copying books, assigned to the complainant August, 1893. It was filed January 26, 1897, only 22 days before the expiration of the patent, and the subpoena was not returnable until after the expiration. No special circumstances are alleged to call for equitable relief, aside from the ordinary case of infringement. It is true that an injunction *pendente lite* is one of the forms of relief prayed for, but there was no actual application to that end, and apparently no intention to invoke such relief, as there was no allegation in the bill as filed of a state of facts upon which to found it, under the rule clearly established in this circuit in *Standard Elevator Co. v. Crane Elevator Co.*, 9 U. S. App. 556, 6 C. C. A. 100, and 56 Fed. 718, and subsequent cases. Unless a right existed to present injunctive relief when the action was commenced, I can find no allegation of wrong for which there may not be adequate legal remedy. The right to such injunction may not depend wholly upon the allegations of the bill, but may appear by supplemental showing when application is made, so that the absence of apt allegations in the former would not necessarily bar the application. Neither would the failure to apply for an injunction within the life of the patent operate of itself to deprive the case of equitable cognizance, even when the jurisdiction was acquired through the right to such relief. But the doors of equity are open only to those who come with clear showing of right, for which no adequate redress can be afforded at law, and the jurisdiction over causes for patent infringement is not excepted from this requirement. The need of injunctive relief—temporary or permanent, one or both—generally constitutes the main ground, and is often the sole ground for entertaining the cause. The

claim and the need must be bona fide, not a mere technical right or assertion, but of the essence of relief sought. In this case, as the patent was within a few days of expiration, there could, of course, be no permanent injunction, and the only basis for its support in equity is the possible right to a temporary injunction for this brief period. If that right exists, and the immediate acts of infringement appear liable to produce serious injury, I have no doubt such state of facts, properly alleged, would sustain a bill for complete redress in equity. But it seems to me equally clear, upon the principles of equity, and under the authorities as well, that to obtain recognition for this extreme case special equities must be set forth in the bill; that both the right to the present injunction, upon which jurisdiction hinges, and the necessity for enforcement, must clearly appear; that the right which runs with the grant of a patent, and which may be sufficient for the ordinary case, where a considerable period of the promised monopoly remains, is insufficient here without a showing of substantial benefit to be obtained through this strong arm of equity, and that the injunction is earnestly sought and intended as a primary object of the action; that such relief must be the purpose, and not the mere excuse or makeshift, for resort to the forum of equity; that a formal right alone, without the actual need or intention of its exercise, will not suffice; and that the bill in question fails to make the showing of special circumstances requisite in that view to call for the interference of equity. The following authorities support the general proposition, at least, and seem to me decisive: *Root v. Railway Co.*, 105 U. S. 189; *Hayward v. Andrews*, 106 U. S. 672, 1 Sup. Ct. 544; *Keyes v. Mining Co.*, 158 U. S. 150, 15 Sup. Ct. 772; *Russell v. Kern*, 34 U. S. App. 90, 16 C. C. A. 154, and 69 Fed. 94. The case of *Beedle v. Bennett*, 122 U. S. 71, 7 Sup. Ct. 1090, upon which counsel for complainant relies for maintaining the bill, is distinguishable upon the facts, and does not appear to intend modification of the rule held in the cases above cited. In *Clark v. Wooster*, 119 U. S. 322, 7 Sup. Ct. 217, the trial court having proceeded to a decree without objection by the defendant, it was held that, jurisdiction appearing "at the inception of the suit, even though upon a narrow ground,"—namely, the present right to an injunction,—retention of the bill, under the circumstances, was so far discretionary that the decree would not be reversed; but the opinion clearly recognizes the general doctrine as above indicated.

The amendment which complainant tendered at the hearing, by an allegation of public acquiescence in the validity of the patent, etc., and which was then allowed, must now be treated as purely formal, and not designed to accomplish the actual issuance of preliminary injunction, and, so viewed, does not furnish the allegation of special equity which is deemed essential. I further incline to the opinion that the bill is insufficient in failure to show proper diligence upon the part of complainant, or that the infringement by defendant was recently discovered. The demurrer is sustained.

MOORE v. NATIONAL WATER-TUBE BOILER CO.

(Circuit Court, D. New Jersey. November 29, 1897.)

1. PATENTS—LICENSES—ESTOPPEL OF LICENSEE.

One who has manufactured and used a patented device under a license cannot, in an action for royalties, set up the invalidity of the patent.

2. SAME.

A licensee who agrees to manufacture only machines containing the patented improvement is not liable for royalties on machines which, in violation of this stipulation, do not contain the improvement of the patent. Nor, in an action by the licensor to recover royalties, can there be a recovery of damages for this breach of the contract.

3. SAME—ACTION FOR ROYALTIES—SET-OFF.

In an action to recover royalties under a license, the defendant cannot set off a claim for damages for alleged failure of the licensor to make a formal transfer of patents subsequently obtained, which he had agreed to assign to the licensee.

This was a suit in equity by Edward J. Moore against the National Water-Tube Boiler Company for an accounting of royalties alleged to be due under a patent.

Alan H. Strong, for complainant.

John S. Voorhees, for defendant.

KIRKPATRICK, District Judge. The record in this case discloses that Edward J. Moore, the complainant, being the owner of certain patent rights particularly set out in the bill of complaint, entered into an agreement with William E. Kelley, in and by which he assigned, transferred, and set over to said Kelley the sole and exclusive right, during the life of said patents, to manufacture and sell, in a certain territory, sectional steam boilers and steam generators, containing the improvements referred to in all or any of the claims of said letters patent, the said rights to include all styles and kinds of sectional steam boilers and steam generators embodying the improvements referred to in any or all of the claims of said letters patent, and all improvements relating thereto that the complainant might devise or acquire during the continuance of the agreement. The complainant also agreed that, whatever improvements or inventions he might make during the continuance of the agreement which would improve the efficiency or reduce the cost of manufacturing said steam boilers, he would inform the party of the second part of the same, and, if patentable, and patents obtained therefor, assign the right to use the same to the party of the second part. In consideration of the transfer of this exclusive right, the defendant stipulated that during the continuance of said agreement he would not engage in the manufacture of any other water-tube sectional boilers than those covered by said agreement, and agreed to pay the sum of one dollar per horse power on each complete steam boiler or steam generator made and sold under said agreement. Kelley assigned the contract entered into between him and the complainant, with complainant's assent, to the defendant corporation, who accepted the same, and continued the manufacture and sale of water-tube boilers, and paid com-

plainant royalties thereon. The agreement, among other things, provided for its termination at the option of the party of the second part thereto, or his assigns, upon giving three months' notice to the party of the first part. In accordance therewith, the defendant company, on the 14th day of May, 1894, gave notice to the complainant that, at the expiration of three months from the date thereof, it would cease building steam boilers and generators under said agreement, and that it would then surrender said agreement, and pay the royalty due, which notice was accepted by the complainant. The complainant claims that the defendant has not paid him all the royalties to which, under the agreement, he is entitled. The bill is filed for an accounting, and the prayer is for a decree directing the payment of such sum or sums of money as may be found due. The defendant's answer admits the execution of the agreement by the complainant and Kelley, and the assignment by Kelley to the defendant, and the termination of the same pursuant to notice, and admits that there is due the complainant, for royalties on water-tube boilers sold by it, the sum of \$682, and sets out in detail the specific boilers made and sold by it upon which said royalty was due, and which it is willing to pay. It is not disputed that other water-tube boilers than those so specified have been manufactured and sold by the defendant during the continuance of the agreement; and it is admitted that contracts were made by the defendant during the same period for the manufacture and sale of still other water-tube boilers, which were not completed until after the expiration of the contract. The controversy between the parties relates to these two classes of boilers, and the question to be determined is whether, under the circumstances, they are within the terms of the agreement, and the defendant liable for royalties thereon.

As has been said, it is admitted that water-tube boilers were manufactured and sold by the defendant during the continuance of the agreement, and, further, that they contained at least one of the devices of the complainant for which a patent had been obtained after the execution of the agreement, and which the defendant was entitled and permitted to use. No formal transfer of the patented device had been made, but it was used by the defendant under a claim of right, and royalties had been paid by the defendant for the manufacture and sale of boilers in which it had been incorporated. The defendant now insists that the complainant is not entitled to royalty on these boilers, because the patent for the device was invalid and void. The patented device was used by the defendant under the license acquired by the contract, and it cannot, when asked to pay the royalty provided therein, set up the invalidity of the claim of the patent. The validity of a patent cannot be determined in a suit against licensee for royalties, nor can the holder of a license deny the validity of a patent which he enjoys under it. 3 Rob. Pat. § 1252. In *Lawes v. Purser*, 6 El. & Bl. 932, the plaintiff, a patentee, had licensed the defendant to manufacture the article covered by the patent. The licensee refused to pay the royalties, and, being sued for the same, pleaded that the patent was void. The plaintiff demurred. The court, in giving judgment for plaintiff, said: "It would be monstrous if the defendant, after such an agreement acted upon, could on this ground refuse

payment." To the same effect are the cases *Covell v. Bostwick*, 39 Fed. 421; *Marston v. Swett*, 82 N. Y. 528.

The remaining boilers concerning which there is dispute are those for which orders were received, and upon which work was done during the continuance of the agreement, which were not delivered, set up, or completed until after its expiration, under the term of the notice given by defendant, and which contained none of the complainant's patented devices. The contract provides that there shall be paid one dollar per horse power for each complete steam boiler or generator made and sold under the agreement; that is to say, in pursuance of its terms. The defendant agreed that he would not engage in the manufacture and sale of any other water-tube boilers than those protected by the complainant's patents. These were the boilers to the manufacture and sale of which it was limited, and for which the royalty was to be paid. A failure to manufacture and sell the boilers containing the complainant's patented device worked a forfeiture of the agreement, but did not involve the payment of royalties. The boilers which do not contain the complainant's patented device, or any of them, are not such as are manufactured and sold under the terms of the agreement, but expressly contrary thereto, and no royalty is payable thereon. It may be that the defendant derived a benefit from its control of the Moore patents, and that its failure to incorporate these devices in the boilers made and sold by him during the continuance of the agreement was an injustice, and worked an injury to the complainant; but, if so, he cannot recover damages in this action, which is brought for royalties payable under the terms of the contract. There appear to have been one or two boilers which are not included in either class above mentioned. I refer to the Zell boiler, which was "rebuilt." It was not merely repaired; it was rebuilt. It was a complete steam boiler, made and sold by the defendant under the terms of the contract, and a royalty should be paid for its 166-horse power. Order 499 was for a boiler "traded for one previously sold." It was itself a complete steam boiler, made and sold under the contract, and it, too, is subject to a payment of royalty. If the boiler which had been previously made and sold, and which was accepted as part payment, should again be sold, no royalty would be payable thereon.

As to the whole case the defendant contends that it is entitled to set off, against any royalties for which it is liable, the damages which it says it has sustained by the failure of the complainant to assign to it all the patents which he had taken out for additional improvements made in water-tube boilers during the continuance of the agreement, and for failure to protect it from infringements. The testimony discloses but one infringer (a Mr. Gill), who, upon the demand of the complainant, desisted from the use of the patent. In causing the infringer to discontinue the use of the patented device, complainant performed his full duty required by the agreement. *Foster v. Goldschmidt*, 21 Fed. 70. The defendant appears to have had the use of the complainant's improvements, and the undisturbed use of the patents relating to steam boilers granted complainant subsequent to the agreement. If entitled to damages for the failure of complainant to make a formal transfer,

they cannot in this suit be set off against the complainant's claim for royalty.

It follows from what has been said that the complainant is entitled to recover the amount of royalties admitted to be due in the defendant's answer, and the sum of one dollar per horse power for each complete steam boiler or generator containing any of his patented devices made and sold by the defendant prior to the 14th day of August, 1894, deducting therefrom such allowances as, in order to induce sales or otherwise, he has voluntarily agreed to make therefrom. Let a decree be prepared in accordance with these views.

MOLINE PLOW CO. v. PARLIN & ORENDORFF CO. et al.

(Circuit Court, N. D. Illinois, S. D. December 13, 1897.)

PATENTS FOR INVENTIONS—ANTICIPATION—CORN PLANTERS.

Letters patent No. 326,449, issued September 15, 1885, to Levi J. Odell, for an improvement in check-rower attachments for corn planters, are not void for anticipation.

Suit by the Moline Plow Company against the Parlin & Orendorff Company and others to restrain the infringement of a patent.

Offield, Towle & Linthicum and Paul A. Staley, for complainant.

Bond, Adams, Pickard & Jackson and George B. Parkinson, for defendants.

GROSSCUP, District Judge. The bill is to restrain infringement of letters patent No. 326,449, to Levi J. Odell, dated September 15, 1885, for an improvement in check-rower attachments for corn planters. The patentee, Odell, had previously (June 16, 1885) taken out a patent for a complete corn planter. The patent under consideration refers to this previous patent, but does not, in my judgment, limit itself to being an improvement upon planters constructed under such previous patent. The patent under consideration is distinctly a check-rower attachment, and was unquestionably designed to be used in connection with any corn planter to which it could be adapted. The invention is described in the letters patent as follows:

"In the accompanying drawing [immediately following this description], Fig. 1 is a perspective view of my invention. Fig. 2 is a side elevation of the same; one of the seed tubes of the corn planter being partly broken away, so as to disclose the interior construction. A represents one of my improved corn planters, having the hoppers, B, the seed tubes, c, and mechanism for feeding seeds from the hoppers into the seed tubes; but as such mechanism may be of any preferred construction, and forms no part of this invention, it is not necessary to fully describe it here. To the outer sides of the hoppers are bolted bracket arms, a, which extend laterally out beyond, and in rear of, the supporting wheels; and to the outer ends of these arms are bolted bracket heads, b, which extend in the direction of the line of draft. To the front end of each of these heads is bolted a bracket, c, having a substantially vertical guard finger, d; and to these brackets are journaled grooved pulleys, e, which are supported in nearly a horizontal position. To the rear end of each of the heads, b, are also secured brackets, f, in which are journaled horizontal grooved wheels or rollers, g. Levers, h, are fulcrumed to the outside of the heads, b, near the centers thereof. The upper ends of these levers