

"It was manifestly the purpose of congress, in changing the provision for 'embroidered and hemstitched handkerchiefs' in paragraph 373, Act Oct. 1, 1890, to 'embroidered handkerchiefs,' in paragraph 276 of the new act, to include all embroidered handkerchiefs, whether they are hemstitched, imitation hemstitched, scalloped, plain, reverse, or otherwise. This is plain from the language of the provision itself, as well as from its association with or inclusion in the same paragraph and at the same rate with other articles composed of the same materials, embroidered by hand or machinery. There could be no good reason for imposing the higher rate on embroidered handkerchiefs with a plain hem, or not hemmed at all, while admitting embroidered handkerchiefs when hemstitched, imitation hemstitched, or scalloped, at the lower rate; and it cannot be assumed that congress would perpetrate an absurdity or work an incongruity. The term 'embroidered handkerchiefs' (paragraph 276) is descriptive, and not a commercial or trade designation. It is therefore immaterial whether the handkerchiefs in question are or are not known commercially as 'embroidered and hemstitched handkerchiefs,' or 'embroidered and scalloped handkerchiefs.'"

The decree below is affirmed.

FIELD et al. v. UNITED STATES.

(Circuit Court of Appeals, Seventh Circuit. November 22, 1898.)

No. 504.

1. CUSTOMS DUTIES—CONSTRUCTION OF LAW—COMMERCIAL DESIGNATION.

To constitute a commercial or trade designation, as contradistinguished from a descriptive term, the words, it would seem, must be used in commerce in an unvarying or stereotyped order.¹

2. SAME—CLASSIFICATION—EMBROIDERED HANDKERCHIEFS.

Embroidered handkerchiefs, although both hemstitched and embroidered, are dutiable under paragraph 276 of the tariff law of 1894, as "embroidered handkerchiefs"; such words being descriptive, and not a trade-name.

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

This is an appeal from a decree of the circuit court affirming a decision of the board of general appraisers as to the classification of certain imported merchandise.

J. M. Barnes, for appellants.

John C. Black, for the United States.

Before WOODS, JENKINS, and SHOWALTER, Circuit Judges.

WOODS, Circuit Judge. The question here, as in the case of Carson v. Nixon, 90 Fed. 409, is whether, under the act of August 28, 1894, certain imported handkerchiefs, which were both hemstitched and embroidered, were dutiable at 50 per cent. ad valorem, according to paragraph 276, as "embroidered handkerchiefs," or 40 per cent. ad valorem, according to paragraph 258, as "handkerchiefs not specially provided for in this act." The testimony in this record was given in the main by other witnesses than those examined in the case of Carson v. Nixon, supra, and in important particulars is not the same as in that

¹ As to use of commercial and trade terms in tariff laws, see note to Dennison Mfg. Co. v. U. S., 18 C. C. A. 545.

case; but it was conceded at the argument that the cases were heard together by the board of general appraisers, and that the testimony in both cases was considered by that board in determining each. After the appeals to the circuit court had been docketed, additional and distinct testimony was taken in each case; and it is now contended in behalf of the appellants that this appeal must be determined upon the record before us, without reference to the testimony in the other case. In view of the admission that there was evidence before the board of general appraisers which is not presented, it is not clear that the appeal ought not to be dismissed on that ground, especially since there is no certificate of evidence in the record, and the certificate of the clerk is simply that the transcript "is a true and complete transcript of the record of the proceedings had" in the circuit court; but, passing that question, we are of opinion that on the evidence before us the decree below should be affirmed.

The question for decision is whether the words "embroidered handkerchiefs," as used in paragraph 276 of the act of 1894, are descriptive, or constitute a trade-name, according to the rule defined by the supreme court in *Maddock v. Magone*, 152 U. S. 368, 14 Sup. Ct. 588, and quoted in *Carson v. Nixon*, *supra*. There is in this record much testimony to the effect that a handkerchief which is hemmed only is known commercially and is invoiced as a "hemmed handkerchief," one which is hemstitched only as a "hemstitched handkerchief," and one which is both hemstitched and embroidered as a "hemstitched and embroidered handkerchief"; though in respect to the last the witnesses have used the words interchangeably, and evidently in a descriptive sense, sometimes saying "hemstitched and embroidered," and sometimes "embroidered and hemstitched." To constitute a name or designation, as contradistinguished from description, the words, it would seem, should be used in an unvarying or stereotyped order. No witness has professed to know or has testified that there is a particular make of handkerchiefs, which generally throughout the United States is known commercially as an "embroidered handkerchief," which does not include embroidered handkerchiefs which are also hemmed or hemstitched or scalloped. Indeed, the contention in this case is that the "embroidered handkerchief" is scalloped, and not one which is hemmed, as was contended and testified in *Carson v. Nixon*. While we are not to import the testimony of that case into this, yet, with the knowledge of it fresh in mind, we are justified in looking critically into the testimony presented, and in refusing to regard it as establishing inferentially something which is not directly stated, and which, if stated, would be inconsistent with the proof made in the other case.

It may be conceded, as asserted, that "in the testimony taken at New York nearly every witness stated that handkerchiefs invoiced as embroidered or scalloped never included those which were both hemstitched and embroidered." That was true by the conjunctive force of the latter words, without regard to the question whether they constituted a trade-name. It was so declared by the courts in a number of cases. *Rice v. U. S.*, 10 U. S. App. 670, 4 C. C. A. 104, 53 Fed. 910; *U. S. v. Gribbon*, 14 U. S. App. 382, 5 C. C. A. 287,

55 Fed. 874; *Wilson v. U. S.*, 9 U. S. App. 674, 6 C. C. A. 310, 57 Fed. 199. But the further assertion that "several witnesses stated that the word 'embroidered' was a trade-name" is not fully borne out by the portions of the record to which reference has been made. To the question, "Is there any difference between what is commercially known as a 'hemstitched and embroidered handkerchief' and what is known as an 'embroidered handkerchief'?" the witness answered, "Yes, sir; an embroidered handkerchief is a separate and distinct kind of handkerchief, as shown by the testimony of the principal importers at New York, as stated in the decision." It will be observed that in the second clause of the question the words "what is known" are repeated, but the word "commercially," found in the first clause, is omitted; and the answer, therefore, if given intelligently and discriminatingly, attributes no commercial significance to the words "an embroidered handkerchief." To the question whether handkerchiefs specified in an entry as "initials hemstitched and embroidered handkerchiefs scalloped embroidered linen" (without punctuation) were known in trade and commerce by the designations so written, a witness answered, "Yes;" and to the further question whether articles "specified as embroidered and scalloped handkerchiefs are those known as embroidered and hemstitched," he answered, "No." Another witness testified that, upon an order for "an embroidered handkerchief," he would send a scalloped handkerchief like the sample shown him, which he said was "simply a plain handkerchief embroidered at the edges," in the manufacture of which "there was no additional process." The only other witness whose testimony is cited on this point, referring to the same sample, said, "That is what we term an embroidered handkerchief," and would send in response to "an order for an embroidered handkerchief." The record shows, in the examination of another witness, the following questions and answers: "Do you import imitation hemstitched and embroidered handkerchiefs? A. We do. Q. How are they known in the trade? A. As 'embroidered handkerchiefs.' Q. As 'embroidered and hemstitched'? A. Yes, sir; I usually call them that." To help out the evidence adduced, which in itself is evidently insufficient, reference is made to the statement found in the opinion of the court in *U. S. v. Gribbon*, supra, that the "proofs also showed * * * that handkerchiefs which were embroidered only were likewise a standard article at that time"; and it is asked, "Ought not this finding to have great weight in the determination of the present question?" If it ought, then reference may also be made to the opinion of this court in *Carson v. Nixon*; and, on the conflicting evidence in the two cases, it is clear that the word "embroidered," as applied to handkerchiefs, has no settled significance as a trade-name. In Chicago it is a very cheap hemmed handkerchief, while in New York it is a scalloped handkerchief. The word must therefore have been used by congress in its ordinary, descriptive sense. The decree below is affirmed.

NORTON et al. v. JENSEN.

(Circuit Court of Appeals, Ninth Circuit. October 24, 1898.)

No. 421.

1. PATENTS—PRESUMPTION OF VALIDITY.

Where two patents apparently describe and claim the same art or article, the question of identity is open for examination, with the presumption in favor of their diversity.

2. SAME—RES JUDICATA—IDENTITY OF SUBJECT-MATTER.

A judgment in a suit for infringement of a patent does not render res judicata questions arising in a subsequent suit between the same parties for the infringement of the same patent by a machine for which a patent has been granted to the defendant since the former judgment was rendered, the subject-matter of the two suits not being identical.

3. SAME—CONSTRUCTION OF CLAIMS — ACQUESCENCE IN REJECTION OF BROAD CLAIMS.

Where an applicant for a patent, after the rejection of his broad claims as the original inventor of a machine, acquiesces in such rejection, and amends and limits his claims to improvements merely, his action amounts to a disclaimer as to his broad claims, and a patent granted on such amended application is to be strictly construed, and confined to the improvements specified.

4. SAME—CAN-HEADING MACHINES.

Where amendments to an application for a patent for improvements in a can-heading machine, made to meet objections of the patent office, and on which a patent was finally granted, described for the first time an annular space created between the can-body and the mold, into which the flange of the can-head was forced in applying it to the body, such space became an essential element of the combination, and a device which omits such element is not an infringement.

5. SAME.

The Norton patent, No. 267,014, for improvements in a can-heading machine, on the facts disclosed by the file wrapper (which was not in evidence in *Norton v. Jensen*, 7 U. S. App. 103, 1 C. C. A. 452, and 49 Fed. 859), is not for a primary invention, and must be narrowly construed, and confined to the particular combination described. It is not infringed by a machine made under the Jensen patent, No. 443,445, for a new and improved machine for capping and crimping cans.

6. SAME.

Neither the Norton and Hodgson patent, No. 274,363, the Jordan patent, No. 322,060, both for improvements on the original Norton patent, No. 267,014, for improvements in can-heading machines, nor the Norton & Hodgson patent, No. 294,065, for a can-ending and seaming machine, is infringed by a machine made under the Jensen patent, No. 443,445, for a new and improved machine for capping and crimping cans.

Appeal from the Circuit Court of the United States for the District of Oregon.

This was a suit in equity by Edwin Norton and Oliver W. Norton, the appellants, against Mathias Jensen, the appellee, for the infringement of four letters patent, viz.: (1) The Norton patent, No. 267,014, dated November 7, 1882, as to claims 1 and 2; (2) the Norton and Hodgson patent, No. 274,363, dated March 20, 1883, as to claims 6 and 7; (3) the Norton and Hodgson patent, No. 294,065, dated February 26, 1884, as to claim 14; (4) the Jordan patent, No. 322,060, dated July 14, 1885, as to claims 1, 2, 6, 7, 11, 12, and 13. The patents, generally speaking, cover inventions for automatically putting the bottoms and heads on tin cans. The first of these patents (the Norton patent, No. 267,014) is upon what appellants claim to be the original invention of a machine for automatically applying tight, exterior fitting can-heads to can-bodies. The Norton and Hodgson patent, No. 274,363, and the Jordan patent, No. 322,060, are for improvements upon the Norton patent, No. 267,-