

his own name, and that he had a right to use it as he would. Therein he was in error. A man may not use his own name to accomplish a fraud, designed or constructive. The case is too plain for further comment. The decree will be reversed, and the cause remanded to the court below, with directions to enter a decree in favor of the complainant (appellant here) pursuant to the prayer of the bill.

SHOWALTER, Circuit Judge, sat at the hearing of this case, concurred in the decision, but died before the preparation of the opinion.

CITY OF BOSTON v. ALLEN.

(Circuit Court of Appeals, First Circuit. December 9, 1893.)

No. 245.

1. PATENTS—INFRINGEMENT—PATENT FOR COMBINATION.

In the patent for a combination in suit here, the description in the specification of details which the claim does not make elements of the combination, and which are not essential to it, is to be held as only pointing out the better method, and it is not essential, to constitute an infringement, that the infringing device should contain such details.

2. SAME—IMPLIED LICENSE.

The fact that an engineer in the employ of a city, in building a ferry for the city, made an improvement in the gangway used, which improvement he afterwards patented, raises no presumption, either of law or fact, in favor of an implied license to the city to use the patented device at another ferry built at another place several years afterwards.

3. SAME—ACTION AT LAW FOR INFRINGEMENT—DAMAGES.

In an action at law for infringement, where plaintiff shows no established license fee, no market price, and no other use of the invention than that by defendant, there is no basis upon which substantial damages can be computed, and nominal damages only are recoverable. *Coupe v. Royer*, 15 Sup. Ct. 199, 155 U. S. 565, applied.

In Error to the Circuit Court of the United States for the District of Massachusetts.

This was an action at law by William H. Allen against the city of Boston for the infringement of a patent. The defendant brings error.

Thomas M. Babson (Frederick E. Hurd, on the brief), for plaintiff in error.

Francis S. Hesseltine, for defendant in error.

Before PUTNAM, Circuit Judge, and WEBB and BROWN, District Judges.

PUTNAM, Circuit Judge. This writ of error was brought to reverse a judgment obtained against the plaintiff in error for a substantial amount of damages in a suit for an infringement of a patent for improvements in supplemental gangways for ferryboats, which issued November 18, 1884, to one Doten. The plaintiff below is his assignee of record, and the suit was for an infringement which occurred after the assignment. The city of Boston was and is the owner of two separate ferries to East Boston, known as the North and South

Ferries; but both of them were and are under the control of the same officers, and run by the same department, known as the "Ferry Department." The North Ferry was rebuilt within two years before the patent in controversy issued, in accordance with general plans made by the city engineer, but under the supervision and the immediate charge of Doten, who was then the engineer of the ferry department. The most favorable aspect of the case for the plaintiff below is that the improvements covered by the patent were suggested by Doten during the rebuilding of the North Ferry, and while it was his duty to use his skill as a mechanic and an engineer in the interests of the city in carrying on that work; and that the improvements, while not material to the work, were incidental to it, and apparently advantageous. No compensation was demanded by Doten for the use of the improvements at the North Ferry until in 1885, after Doten had left the employment of the city, he made a claim on the officers of the ferry department for reimbursement for the use of his improvements; but this claim was not followed up. The title of the patent came into the plaintiff below in July, 1890, and subsequent to that date the patented improvements were made use of by the city at the South Ferry. The suit covers both ferries, but no question was made at the trial with reference to the claim of the city that it rightfully applied, and continued to use, the improvements so far as the North Ferry was concerned; and the damages awarded by the jury were entirely with reference to the other. The case fails to show that there ever was any use of the improvements elsewhere than on the two ferries spoken of, or that the patentee or his assignee ever received any royalty or other compensation for the use of the patented device; and there was no evidence bearing on the question of damages, except what appeared as to the amount of travel over each of the two ferries in question, and what related to the nature of the device. The specification shows some details which are not covered by the claim.

One of the assignments of error objects to the charge of the court on the ground that it was not sufficiently specific in explaining to the jury the importance of the various elements of a claim for a patented combination, to which class the patent at bar belongs. The controversy which arose with reference to this part of the case issued out of the fact that the details referred to were not used at the South Ferry. It is, however, so well settled, as applied to the case at bar, that a description in a specification of details which the claim does not make elements of the combination, and which are not essential to it, is to be held as only pointing out the better method of using the combination, that we need not consider this exception further. On the record as made, there were no proofs, and nothing in the patent, to require the court to state to the jury, on the issue of infringement, anything more with reference to the law as to patents for combinations than the general rules which the charge contains.

Another ground of exception was that the defendant below contended that, even if the patented device was used by the city, it did it under an implied license, which covered the South Ferry as well as the North Ferry, and that this issue should have been submitted to the jury. It is to be noticed that the only contention on this point

of the defendant below is with reference to the doctrine of implied license.

The third ground of exception was that the court should have instructed the jury, as requested by the defendant below, that, on the evidence produced, the jury should not render a verdict for more than nominal damages. With reference to the general subject-matter presented to us by the request for instructions as to an implied license, it first came before the supreme court in *McClurg v. Kingsland*, 1 How. 202. The subsequent cases in that court touching the same subject are *Hapgood v. Hewitt*, 119 U. S. 226, 7 Sup. Ct. 193; *Wade v. Metcalf*, 129 U. S. 202, 9 Sup. Ct. 271; *Solomons v. U. S.*, 137 U. S. 342, 11 Sup. Ct. 88; *Dalzell v. Manufacturing Co.*, 149 U. S. 315, 13 Sup. Ct. 886; *Lane & Bodley Co. v. Locke*, 150 U. S. 193, 14 Sup. Ct. 78; *Keyes v. Mining Co.*, 158 U. S. 150, 15 Sup. Ct. 772; and *Gill v. U. S.*, 160 U. S. 426, 16 Sup. Ct. 322.

Wade v. Metcalf, which related to specific machines, held that that case turned on section 4899 of the Revised Statutes. This reads as follows:

"Sec. 4899. Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor."

Solomons v. U. S., in discussing the general subject-matter, describes two subdivisions, which are important to be kept carefully in view. There may be other subdivisions, which we need not notice. The opinion of Mr. Justice Brewer says, at page 346, 137 U. S., and page 89, 11 Sup. Ct.:

"If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which he has been employed and paid to accomplish becomes, when accomplished, the property of his employer."

It will be seen that this has no relation to the doctrine of implied license, and it was so understood by the learned justice who drew the opinion, because he proceeds afterwards on the same page to state under what circumstances a jury or a court trying the facts is warranted in finding that an implied license is given. In *Gill v. U. S.*, the whole subject-matter was reviewed by Mr. Justice Brown, but we discover there no intention to disregard the opinion in *Solomons v. U. S.* Indeed, the distinction which it makes is clearly recognized at page 435, 160 U. S., and page 326, 16 Sup. Ct. There is much ground for claiming that Doten, through his relations to the city, came within the citation made from *Solomons v. U. S.*; but, at the trial below and in this court the city specifically rested its case on the doctrine of implied license. An examination of the cases which we have cited will make it clear that the existence of such a license has always been treated as a mixed question of law and fact. Therefore the determination of this issue in one suit cannot make a decisive precedent for another, because the results of such questions may be caused to differ by slight circumstances.