

of these prior patents were thus changed—not surreptitiously, but openly—to indicate their adaptability to the same purpose; claiming that the change was of such trivial character in each case that it would readily and at once suggest itself to any ordinary mechanic seeking that purpose, and therefore involved no invention. It is manifest, however, that the purpose of the final invention was not realized in either of these devices, nor does it appear to have been contemplated in either, unless it be in that of Lozier, on which the stress of the argument for the defense centers; but that is, at best, a mere approach to the object thus assumed to have been in view, which could only be realized by the changes shown on behalf of the defendant, and was otherwise confessedly inoperative therefor. Upon the distinctions so conceded and appearing upon the face of the prior devices, respectively, I am of opinion that each is taken out of the range of anticipatory devices for the successful combination shown by the patent in question, and that the patent is sustainable under the view stated in *Topliff v. Topliff*, 145 U. S. 156, 161, 12 Sup. Ct. 825, that it is not sufficient, to constitute an anticipation, that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it was not designed by its maker, nor adapted nor actually used, for the performance of such functions. However narrow the interpretation must be upon the claims of this patent, I am satisfied that claims 1, 2, and 3 are infringed by the defendants, and that decree must enter accordingly. So ordered.

WARREN v. CASEY et al.

(Circuit Court, E. D. Pennsylvania. February 2, 1899.)

No. 16.

PATENTS—INVENTION—SPECTACLE CASES.

The Warren patent, No. 589,676, for a spectacle case, *held* void for lack of invention, and also not infringed.

This was a suit in equity by Warren against Casey & Chism for infringement of a patent.

Hector T. Fenton, for complainant.

Wiedersheim & Fairbanks, for defendants.

DALLAS, Circuit Judge. This suit is brought on letters patent No. 589,676, dated September 7, 1897, issued to the complainant for a spectacle case. As applied for, the patent contained two claims, as follows:

"(1) As a new article of manufacture, an eyeglass case, comprising a pocket composed of a back plate and a front piece, secured at three of its edges to the back plate, the free edge of the front piece cut low, to enhance the insertion and removal of an eyeglass, a bulged-out or buckled lid of stiff material, hinged to the upper edge of the back plate of the pocket, and a lock for securing the lid to the pocket, substantially as and for the purposes set forth.

"(2) As a new article of manufacture, an eyeglass case, comprising a pocket composed of a back plate and a front piece, secured at three of its edges to a back plate, a distance block in the middle of the pocket, to hold the

front piece away from the back plate, and protect the nose piece of an eyeglass, the free edge of the front piece cut low, to enhance the insertion and removal of an eyeglass, a bulged-out or buckled lid of stiff material, hinged to the upper edge of the back plate of the pocket, and a lock for securing the lid in a closed position, substantially as and for the purposes set forth."

Both claims were at first rejected; and the solicitor for the applicant then presented an argument in which he conceded that the Farley and Closs patents, which had been referred to by the examiner, "show distance blocks as in the application," but submitted "that taking any of the devices patented by Strauss, Sewell, or Hauck, and adding such distance block in the manner indicated by Farley or Closs, the new device would not be the same as that shown by the applicant, because the device would be lacking the buckled lid of sheet metal or other stiff material by which the nose piece of a pair of eyeglasses is protected, as is fully described in the application." Thereupon, and upon further consideration, claim 1 was again rejected, but claim 2 was allowed. This ruling of the patent office was acquiesced in by the applicant, and the patent was accordingly issued and accepted.

Comparison of the rejected claim with that which was allowed shows that the only material difference between them is that the latter contains a single element, which was not contained in the former, namely, "the distance block in the middle of the pocket, to hold the front piece away from the back plate, and protect the nose piece of an eyeglass"; and hence it is manifest that the office, in conceding the patentability of the subject-matter of the patent as it stands, gave controlling effect to its inclusion of the distance block. Without that block, the patentee's spectacle case would be devoid of novelty. This, I repeat, was, in effect, decided before the patent was granted, and that decision was not only acquiesced in, but is clearly sustained by the evidence now before the court. But the proofs also establish that a distance block, substantially the same as that which the specification states may, "if preferred," be inserted, had previously been used in similar devices; and upon what ground the examiner, who perceived and referred to this fact, based his final conclusion that "claim 2 appears to be allowable," is not apparent. In my opinion, the mere addition, to the admittedly old device described in the first claim, of so obvious a means of holding the front piece away from the back plate as the pre-existing distance block, could not possibly involve invention. Neither do I see how the part described as "a bulged-out or buckled lid of stiff material" could be supposed to impart patentability to that device, for that part (in itself not new) was, in precisely the same terms and with the same object, included as well in the claim which was rejected as in that which was allowed.

The patent, even if it were valid, has not been shown to have been infringed. The prior state of the art and the proceedings in the patent office require that it should be narrowly construed. The defendant's spectacle case has not "a bulged-out or buckled lid of stiff material." It is not absolutely limp or flabby, but it is not "stiff," in the sense in which that word ought, for the present purpose, to be understood. The complainant contends that "it will not yield easily to pressure," and that, therefore, it corresponds with the description

embodied in the specification. But the word "easily" is as vague and indefinite as is the word "stiff"; and to what extent a material may yield without being said to yield easily it is difficult to determine. I think, however, that the context is, in this instance, assisting; that the mention of "pressed paper" and of "sheet metal," as being material which would be suitable to form the lid, indicates that it was contemplated that it should be so composed as to be capable of resisting a quite considerable degree of pressure. In this view of the matter, I am confirmed by the fact that a witness for the complainant, upon being asked whether two samples of the complainant's case, which he had produced, both had a stiff, buckled lid, answered, "Not both of them; one has, and the other has not;" and by the fact that, upon comparison, it appears that the defendant's lid is substantially the same as that which the witness testified was not a stiff, buckled one, and is wholly without the very decided rigidity of the other.

The conclusion has been reached that the patent sued upon cannot be upheld, and also that the charge of infringement has not been maintained. The bill will be dismissed, with costs.

HOHORST v. HAMBURG-AMERICAN PACKET CO. et al.

(Circuit Court of Appeals, Second Circuit. January 5, 1899.)

No. 33.

PATENTS—INFRINGEMENT—ASCERTAINMENT OF PROFITS.

Nominal damages only are recoverable where, although it appears that the defendant has infringed, and has derived some benefit therefrom, yet the evidence is so uncertain, and the knowledge of the witnesses so limited, that it is impossible to obtain any basis for calculating the amount of profits, other than mere haphazard speculation; and such rule is peculiarly applicable to a case in which it appears that defendant did not knowingly infringe, and that complainant had knowledge of the infringement for years, but neither gave the defendant notice of his claim, nor commenced suit, until immediately prior to the expiration of the patent.

Appeal from the Circuit Court of the United States for the Southern District of New York.

This was a suit in equity by Freidrich Hohorst against the Hamburg-American Packet Company and others for infringement of a patent. From a decree for complainant for nominal damages only (84 Fed. 354), he appeals.

This cause comes here upon appeal from a final decree of the circuit court, Southern district of New York, entered after an accounting, which decree sustained the master in awarding nominal damages and no profits. 84 Fed. 354. The suit was brought to restrain infringement of United States letters patent No. 119,765, to complainant, dated October 10, 1871, for improvement in slings for packages. Defendant answered, and by interlocutory decree, October 24, 1894, the validity of the patent was sustained, infringement found, and the cause sent to a master to ascertain the damages and profits, if any. On May 15, 1896, the master reported that: "While the defendant has received advantage from the use of the infringing device, there is no evidence from which it is possible to compute, or express in dollars and cents, the profits, gains, and advantages made by said defendant, or which have arisen or accrued to it from such infringement. The complainant is accordingly entitled