

"Castoria," with some description of the preparation, as a label, substantially as used on the complainant's packages and on the defendants' packages, did pass into the public domain on the expiration of the patent. It was within the power of the complainant to have made this matter clear, and to have shown exactly what other of the marks and descriptions specially claimed by it, and now used by the defendants, were trade-marks not within the public domain, because not used to name and particularly describe and designate the patented article during the life of the patent. What may be shown on a final hearing with regard to these matters will control the case, and doubtless do equity between the parties; but, on the showing made at this time, I am unable to attribute error to the judge *a quo* in refusing the injunction *pendente lite*.

WHITNEY v. GAIR.

(Circuit Court, E. D. New York. December 9, 1898.)

PATENTS—INVENTION—FOLDING PAPER BOX.

The Elliott patent, No. 350,727, for a folding paper box, the essential feature of which is the strutting or bracing action of the side pieces in holding the parts in position, shows patentable invention, and was not anticipated.

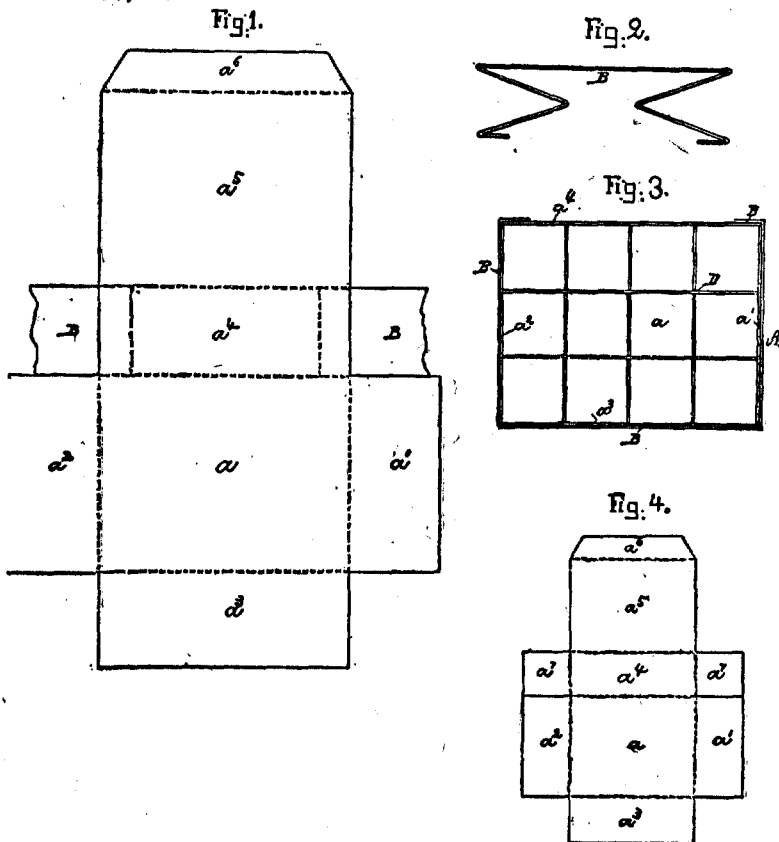
This was a suit in equity by Fred. A. Whitney against Robert Gair for the infringement of a patent.

Louis W. Southgate and Philip W. Southgate, for complainant.
Dickerson & Brown, for defendant.

THOMAS, District Judge. The complainant, Whitney, since February, 1888, has been, and is now, the owner of letters patent of the United States, numbered 350,727, issued to Charles W. Elliott, on the 12th day of October, 1886, for a folding paper box. Since the acquisition of such rights, the complainant has been engaged in the manufacture and sale of folding paper boxes pursuant to such patent, and, from small beginnings, has built up a business of great extent and value, and the precise box made and sold by him is, for the purpose for which it is intended, the most acceptable and the most widely accepted. So thoroughly useful, desirable, and valuable is the box fashioned by the complainant pursuant to his patent that the defendant, Gair, the largest manufacturer of paper boxes in the United States, has appropriated the precise pattern of box, and ingrafted it upon, and, to a large extent, made its manufacture a part of, his own business; while other manufacturers, either from recognition of the complainant's rights, or for other reasons, have not infringed or ceased to infringe thereon. Therefore the complainant owns letters patent, and makes paper boxes pursuant thereto, and the defendant has nicely imitated the complainant's product, and deliberately seeks to avail himself of its advantages. The defendant justifies this absolute imitation of the complainant's box upon the ground that the same was not patentable, as the essential functions of the parts composing the

box had been anticipated by prior patents. The letters patent under which complainant claims show certain illustrative figures and specifications. The following figures are important for this discussion:

No. 350,727.



The specifications state:

"Figure 1 is a blank from which my box is made. Figure 2 is an edge view of a folded strip to form a band for my box. Figure 3 is a plan of my box, with its cover off, and an egg-holder inside of it. Figure 4 is a modification. My invention consists in a folding box provided with a band to keep parts of the box in proper relation to each other when the box is made ready for use. In Figure 1 I have shown a blank of strawboard or the like material from which the box, A, and also the cover are made. In this blank the part a, which forms the bottom of the box, has the usual flaps, a1, a2, a3, a4, adapted to form the sides of the box, A, as shown in Figure 3. The blank is also in the case shown provided with a flap, a5 (having lip, a6), which forms the cover of the box, A. The ends of the strip, B (shown in Figure 2), are secured to the side, a4, as in Figure 3; and, when flaps a1, a2, a3, and a4 are set up, band B is passed around them, as clearly shown in Figure 3. In Figure 4 I have shown a modification of the blank from which box, A, is formed, the difference being that the flap a4 in the modification is provided with end flaps, a7, to which the ends of the band, B, are attached. Boxes thus made can be folded compactly, and easily made ready for use. They are especially de-

sirable as egg-carriers when provided with the well-known folding egg-holder, D (shown in Figure 3). What I claim is the folding box, A, in combination with bands, B, substantially as and for the purpose set forth."

The box thus described shows certain valuable features: (1) A folding box made from a single blank, save the band, B, which, for the economical use of material, is cut separately, and attached to the flap a^4 ; (2) the parts thus secured are quickly and conveniently folded into a box, with a cover shutting into and held in place by its lip, a^6 , passing between flap a^3 and the folding band, B; (3) the side flaps a^1 , a^2 , press on the front flap, a^3 , whereby flap a^3 is crowded against the band, B. Thus, the side and front flaps are kept in place, and necessarily support the bottom of the box, whether it is empty or filled. This strutting or bracing action of the side flaps reaches its full useful function because all the sides of the box are sufficiently high to furnish all necessary support by simple pressure on the band, without the use of other device; and this function obtained by the combination of these parts is claimed to be new.

The alleged anticipations may be considered. Letters No. 265,419, issued to John Howenstine in 1882, are said to anticipate it. The box as described in the letters consists of three parts: (1) A blank composing the bottom and two side flaps of the box, generally corresponding to a , a^3 , and a^4 of complainant's box, and two narrow flaps, corresponding in position with a^1 and a^2 in complainant's box. Around these flaps is placed a separate band, at whose end are hooks or tongue lugs, which pass through and interlock in a circular opening in one side of the box, corresponding to a^3 in complainant's box, while at about the middle of such band is a tongue which passes through a circular opening in the opposite side. Thus, it will be seen that this band, hooking into the two sides of the box with its own ends interlocking, makes up two sides of the box, and holds the remaining two sides in place. The strutting action of the narrow side flaps, corresponding in position with complainant's box flaps a^1 , a^2 , is very slight, and, in fact and in contemplation of the patentee, is not useful in holding the box in place. It is true that this arises from the fact that these flaps are too narrow to push with any useful force against the other sides. They may have a strutting action proportioned to their width; but the width is such that the strutting action is practically unimportant, so much so that it is easily concluded that the patentee did not observe the function, nor advise of its existence, and hence provided the separate band, with its duplication of awkward and puzzling hooks and tongues, to hold the box in place.

The further prior patent that deserves attention is that of Fiske, to whom letters No. 265,590 were issued in 1882. This open box is made from a single piece of paper. It consists of a rectangular bottom, with three flaps corresponding in position somewhat with the flaps a^1 , a^2 , a^3 , of complainant's box, but not rectangular. A band connected with a part of the bottom piece is carried around the three irregular sides; and a tongue at one end of this band passes through a slit in its other end; and a tongue in the irregular side, corresponding to a^3 in complainant's box, passes through a slit in the tongue end of the band, and secures together the band, and holds it to the side.

Thus, the box, flaring in shape, was held together. Thus far it is obvious that the box was held in place by the tongue on one end of the box passing through the slit in its other end, and by locking the tongue to the side of the box by the tongue of such side passing through a slit in the tongue of the band. The sides corresponding to a^1 , a^2 , a^3 , in complainant's box were not intended to have a strutting action, and the flaring shape of these sides prevented such action, unless the band were pulled so tight as to distort these sides, and thus bring them together, which was not intended; nor is there any evidence that such function was ascribed to them or expected of them. However, the specification states:

"By making the scores between the parts e, f, g, h, i [by which are described the parts into which the band is divided by oblique creases], at right angles to the edges of those parts, and making the strip of material from which those parts are formed straight, and by making the part d [part corresponding to side a^3 in complainant's box] rectangular in form, the box will be rectangular in form when put together."

This would, indeed, make the box rectangular, but the support would be still the band locked at its ends into the rectangular side. But observe that the specification does not provide that the side corresponding to a^1 , a^2 , in complainant's box, should be rectangular; and hence there would be no strutting action by their pushing up against the band, directly or indirectly, although, possibly, the rectangular side, corresponding to a^3 , might push the two sides against the band. This was not intended as the means of support, and very remotely, if at all, foreshadows the action of the side flaps in the complainant's box. In both the Howenstine and Fiske patents, and probably in others, where a band is used to hold a box together, some part is brought directly or indirectly against and presses upon another part, and creates the friction that holds in usable form the assembled parts. The complainant has not received a patent for the employment of friction to hold together a box, but he has fashioned a box in such combination that the strutting force is adjusted with a nicety and effect that boxes in other form of parts have not produced. If devices for applying such force are patentable at all, the complainant's arrangement seems to be novel, and shows invention. The box is so simple as to beget a doubt of its evincing inventive skill; but it is evident that this very simplicity is of large economic value, and that much thought and contrivance have been used to attain the results which it embodies. The complainant has produced what has escaped the skill of others. The complainant's assignors may not have been conscious of the principle which he employs so happily in the adjustment of his box. He may have contrived his box after practical trials, and have attained the useful end without fully appreciating the function which his parts perform. In any case, his combination is new, and effects a new result. The other patents to which the attention of the court is called by the learned counsel for the defendant seem to be quite remote, and need not be considered, if the court is correct in its disposition of the Howenstine and Fiske patents.

The complainant should have a decree, with costs.

LETTIELIER v. MANN et al.

(Circuit Court, S. D. California. January 30, 1899.)

No. 697.

1. PATENTS—INVENTION—IMPROVEMENT OF EXISTING MACHINE.

Merely changing the location of parts in a successful machine, though it may add to its utility, involves only the exercise of mechanical skill, and does not constitute invention which will sustain a patent.

2. SAME—ANTICIPATION—KNOWLEDGE OF PRIOR DEVICE.

In considering the question of anticipation, it will be assumed that the patentee knew of the alleged anticipatory device when he made his own; and whether or not he in fact had such knowledge is immaterial.

3. SAME—INVENTION—ADAPTING OLD PARTS TO NEW USE.

A change in the size or shape of a part in an existing machine, so as to adapt the part to a new purpose, such as would occur to a mechanic of ordinary skill, does not constitute invention.

4. SAME—EFFECT OF PATENT AS EVIDENCE.

The rule that a patent is *prima facie* evidence of novelty and invention is merely a rule of evidence, and, while it casts the burden of proof on an alleged infringer, does not preclude the courts from declaring what constitutes novelty and invention.

5. SAME—MACHINE FOR MAKING BOX BINDING STRIPS.

The Lettelier patent, No. 482,484, for a machine for making box binding channel strips, so far as it shows a change of the location of the cutters and formers from the center of the shafts, as existing in a prior machine, to the ends, outside the bearings, though of utility, does not disclose invention; and the enlargement of the shoulders on the insertion rollers to serve as guides for the strip being channeled is merely a mechanical adaptation of the part as existing in the prior machine to a new use, which does not involve patentable invention, and which was anticipated in the device shown in the Nauman patent, No. 421,961.

This was a suit in equity by John G. Lettelier against William Mann and others for the alleged infringement of a patent.

H. C. Dillon, for complainant.

James E. Knight and C. K. Holloway, for defendants.

WELLBORN, District Judge. This is a suit for an injunction against, and damages on account of, alleged infringements of patent No. 482,484, on a machine for making box binding channel strips. The answer to the bill sets up, among other defenses, lack of novelty, or, more specifically, that the complainant's patent was anticipated by numerous other patents, and also by a machine known as the "Weston machine," constructed by Norton Bros., in Chicago, in March, 1886, for the Weston Basket Manufacturing Company, of San Francisco, Cal.

Complainant, in his application for a patent, outlines his machine thus:

"My invention consists, essentially, of a channel strip forming machine, having its rotary shears and formers arranged on the ends of their respective shafts on the outside of the shaft supporting frame of the machine, in combination with suitable gauges and guides arranged to hold the strip in position, and to discharge the scrap from the machine, and direct the strip through the shears and formers."

The figure given on the next page is a plan view of said machine.