

## Legal Notes.

**WHAT CONSTITUTES INVENTION.**—Joseph B. Mockridge on March 14, 1893, was granted a patent for an invention, the purpose of which was to provide a new and improved means for securing railroads and shippers of merchandise against loss of freight, by preventing the merchandise from being sent to wrong places, and keeping a record of the merchandise loaded into each railroad car, so that it could be easily traced, until it finally arrived at its proper destination. The invention consisted in means by which the shipping was controlled in such a manner as to prevent the merchandise from being loaded into the wrong car at the shipping station; and secondly in case it should happen that a package was wrongly loaded into a car, then to detect at once the respective car into which it had been wrongly placed.

The means described in the specification may be briefly summarized as follows:

1. The cars upon which the merchandise is to be shipped are numbered, the numeral upon each car designating a destination.

2. A shipping receipt is prepared at the shipping office, containing, besides the usual descriptive matter, the number of the car into which the package is to be loaded and designating the package by a given number.

3. A check is prepared simultaneously with the shipping receipt, containing the number of the car and the numbers of the packages.

4. A removable box is placed upon the car for receiving the checks of the merchandise loaded into it.

The validity of this patent came up for decision in the case of *Hock vs. the N. Y. C. & H. R. RR.* The court said: "Whether the patent is to be regarded as one for an improvement in an art, or as one for a machine, we are of the opinion that it discloses nothing of patentable novelty. It purports to disclose to the public, and especially to that part of the public engaged in shipping and transporting, an improved method of preventing and rectifying mistakes in the transaction of their business. Such improvements generally suggest themselves, as their necessity becomes apparent, to the intelligent and enterprising men who usually conduct this kind of business, and it would be surprising indeed if the long and extensive experience of forwarders and carriers had not disclosed so obvious a method as that which is disclosed. What the patentee seems to have done has been to provide evidence that a certain parcel or lot of merchandise has been deposited in a predetermined place, or, if it has not been deposited there, to denote at what other place it has been deposited. There are various ways of doing this, so familiar that the court can take judicial notice of them. One is by having the person with whom the parcel is deposited preserve a record of it, to be returned for examination to the sender. Another is by having a record kept by a tallyman. Another is by having the truckman or other person making delivery return a voucher from the receiver to the shipping clerk. A common instance is that adopted by express companies who provide their expressmen with a book in which, when the parcel is delivered at a store or house, the receiver signs his name. The patentee has provided a box in which the truckman is to deposit the voucher instead of returning it to the shipping clerk, and has located it at the most convenient place, and where there is the least likelihood of his making the mistake of depositing the voucher in the wrong one. All this evidences good judgment upon the part of one who is experienced in the particular business, but it does not rise to the level of invention."

**CONSTRUCTION OF PATENT CLAIMS.**—The Nash patent, No. 433,088, covers a water meter with its chamber-forming case made relatively strong, in combination with an inclosing head therefor made relatively weak, either by being made thinner throughout, or by having a weakening groove, to form a yielding part against interior pressure, the object being, as shown by the specification, to prevent injury to the other parts by freezing. This patent was made the basis of an infringement suit brought by the National Meter Company against the Neptune Meter Company (122 Fed. Rep. 75).

In delivering the opinion of the court, District Judge Archibald stated that the idea of a weakened head or part to relieve from the strain of excessive interior pressure in an inclosed chamber was not new with Nash, but that he was the first to apply it to water meters and to obviate the danger in case of freezing. To this extent he was a pioneer. He was, therefore, entitled to the fruits of his inventive skill. The expanding power of water in freezing is substantially irresistible, and operates in its own peculiar way. It is not a fluid pressure, so as to have the strain transmitted from one point to another, but it is a

pressure exerted as the water turns to a solid. If freezing occurs in a meter chamber, something, by predetermined arrangement, must be prepared to give way, or the meter case will be rent asunder. Nash's fourteenth claim reads:

"The combination with a water meter having its chamber-forming case made relatively strong, of an inclosing-head therefor made relatively weak, whereby to form a yielding part against undue interior pressure."

The fifteenth claim reads:

"The case or inclosing head of a water meter case having a groove or surface recess to reduce the thickness of the inclosing-head over the measuring-chamber, substantially as described, and for the purpose stated."

The first of these claims is in very broad terms, and covers every case where the inclosing head is made relatively weak, by whatever device effected, and comes very near in this to an attempt to claim a result or idea, rather than the structural means by which it is produced or carried out, which latter is alone patentable. Neither is there any reference back to the specifications by the usual formula "substantially as described," or "for the purpose designated." Thus the ground is laid for the contention that the claim is not limited to provide against strain from freezing only, but from undue interior pressure of every character as well. The same was urged with respect to the fifteenth claim where the reference appears, but is equally unavailing as to both. Says the court: "The manifest purpose of endeavoring to broaden their scope in this way, so as to make them apply to all cases of excessive interior fluid pressure, such as water hammer or abnormal hydrostatic head, is to enlarge the art to which they are to be assigned, and so the easier to demolish them." But it seemed useless to the court to argue that either claim can be so separated from the connection in which it is found or extended to embrace a function not there specified. It is no doubt true that an element not stated in a claim cannot be brought forward from the specification and imported into it. But, said the court, that is by no means to say that the specifications which precede did not limit it, or that they are not to be resorted to as they always freely are, to explain it and give it character. It seemed to the court that the inventor, in the present instance, did not and could not claim what was thus sought to be thrust upon him. He was not seeking, in this feature of his invention, to provide against anything else but ice pressure, and while it may be desirable in all water meters to have a yielding part that will go down under stress of undue internal forces, he must abide by what he has described and claimed.

The defendants contended that a water meter is nothing more than a water motor, reference being made to a Scotch patent to show that they are interchangeable. "In structure and general mode of operation, this may be true, but for the purpose of this case it is not. A meter, however actuated, is not designed for exerting or transmitting power, but simply for measuring, registering fluid volume, and as a matter of applied art the two are essentially different. The manifest object of this opinion . . . is to draw the case within the circle of the motor or power reference relied upon, or at least to establish a close analogy to that art." To the court this seemed not very material.

Analyzing the various points relied upon by the defendant, the court came to the conclusion that the claims of the patent must be sustained and that the defendant was chargeable with infringement.

**INFRINGEMENT OF A TRADE MARK COMMITTED IN A FOREIGN COUNTRY.**—In the action brought by the Vacuum Oil Company vs. the Eagle Oil Company (122 Fed. Rep. 105), infringement of a trade mark and unfair competition were charged. The defendant filed a plea to the bill stating "that all such acts and deeds" complained of, "if performed or done at all, . . . were wholly done or performed by it without the borders and boundaries of the United States, and wholly within the boundaries of some foreign nation." The plea further alleged that "legal proceedings had been introduced by the plaintiff to restrain the defendant from the consummation of the very acts and deeds performed in the German empire with regard to the word 'Vacuum,' which the plaintiff here again asks relief against and recovery in this suit." It was further stated in the plea that "the plaintiff had instituted legal proceedings in the kingdom of Denmark to restrain the use of the word 'Vacuum' on oil products." The complainant very properly objected to the plea on account of multifariousness, but the court overruled him, holding that all the facts stated tended to a single issue.

The point, however, upon which the case hinged, was the general question whether the courts of the United States can decide the manner in which business in a foreign country should be conducted. If the complainant's contention be true that the court acquires jurisdiction whenever it can obtain jurisdic-

tion of the parties, it is immaterial whether the defendant, in cases of this character, be a citizen of the United States, an alien, or a mere sojourner here. The court decided that trade-mark rights acquired in the United States, whether by registration or by common law, afforded no protection against acts committed wholly in a foreign country.

To the lawyer who is at all familiar with equity practice the decision seems contrary to the long-established doctrine that equity acts *in personam*, and that it matters little where the subject-matter is situated, or the acts complained of were performed. Even before Lord Hardwicke's day, English Chancellors interfered to protect rights in property situated in other jurisdictions (witness the *Penn vs. Lord Baltimore* case), and sometimes even protected foreigners in their property rights, as in the case of the *Emperor of Austria vs. Day and Kossuth*, in which it was decided that Louis Kossuth should be restrained from printing in England banknotes which when circulated in Austria-Hungary would depreciate the value of the imperial currency. Why then should a court of equity not restrain a defendant residing within its jurisdiction from committing acts without that jurisdiction, to the detriment of the complainant?

**THE LIMIT OF A MAN'S RIGHT TO USE HIS OWN NAME AS A TRADE MARK.**—In the case of the *Royal Baking Powder Company vs. Royal* (122 Fed. Rep. 337), it appeared that the complainant company had for many years been making and selling a baking powder under the name of "Royal," by which name its product was called for by purchasers. The defendant, whose surname is Royal, commenced the manufacture and sale of a baking powder which he packed in cans similar in size and shape to complainant's, and having a label similar in color and general appearance, bearing his name in large letters. He also advertised his baking powder as the "New Royal." Having been enjoined from such advertising and from using the labels, he changed the color of the label from red to blue, on which was printed the name "Maxim Baking Powder;" but still having his name in prominent letters on the front of the cans. There was evidence that this baking powder had, in some cases, been sold as that of complainant's, and that retailers had given it to customers calling for Royal Baking Powder, without explaining that it was not the well-known product of the complainant company.

The court held that all the facts showed a purpose on the part of the defendant so to use his name as to sell his product as that of complainant, and that while he would not be enjoined from using his name, he would be restrained from placing it on the front label of his cans.

A person has the right honestly to use his own name in connection with his business, even though he may thereby interfere with or injure the business of another, but a court of equity will restrain him from intentionally so using it as to deceive the public—or enable others to do so—into buying his goods as those of another, and will require him, when entering a business in which another is engaged, and using the name, to use every means reasonably possible to distinguish his own business and goods from those of his competitor.

**LACHES IN INFRINGEMENT SUITS.**—In July, 1901, the Circuit Court for the Second District of New York sustained the first three claims of a patent which was made the subject of the suit of *Timolat vs. Manning*, and found them to be infringed by the device then before the court. Subsequently, in November, 1901, suit was brought against another infringer upon a different device and a preliminary injunction was granted by the same Judge who heard the *Manning* case. Appeal was taken in that case. The case which recently came up before the Circuit Court of Appeals was the case of *Timolat vs. Franklin Boiler Works Company* (122 Fed. Rep. 69). The appellant in this suit contended that some laches of the complainant should require a denial of injunctive relief. The defendant did not put his tool on the market until the spring or summer of 1899. Then a month or so thereafter complainant began litigation with the infringers, and have continued to litigate ever since. Circuit Judge Lacombe, who wrote the opinion, states that they were under no obligation to sue everyone at the same time.

The use of a different, but mechanically equivalent, method or material to construct some of the elements of a patented combination will not avoid infringement where the principle or mode of operation is adopted, and the elements, when constructed, perform the same functions by the same means as, or by mechanically equivalent means to, those described in the patent.

The commercial success of a complicated machine covered by a patent containing a large number of claims is not persuasive evidence, in itself, that a single element or part of the machine involves invention.