

Legal Notes.

A WATER STILL INFRINGEMENT CASE.—James W. Hale brought an action against the World Manufacturing Company for infringement of letters patent granted to him for an improvement in water stills for the distillation of water for domestic purposes. The Circuit Court dismissed the bill, on the ground that the water still manufactured by defendant did not infringe any of the claims of the patent sued upon. From this decree the complainant appealed, but the Circuit Court of Appeals (127 Fed. Rep. 964) affirmed the decision.

The Hale apparatus is simple enough. It consists of three separable parts—a boiler, in which the water to be distilled is contained; a collector for the distilled water, which fits on top of the boiler, and a condenser containing cold water for condensing the steam, which fits on top of the collector. The essential and patentable feature of the invention is a sterilizing chamber, consisting of the upper part of the boiler above the water, into which air is admitted and carried across the surface of the water through the steam, to a passage opposite the inlet, through which it passes, mixed with the steam, to the condenser.

The defendant's still is also composed of three separable parts—a boiler, a collector, and a condenser arranged to fit together in the order named. The collector, however, has no bottom or floor to serve as the top of a sterilizing chamber, but the steam rises directly from the boiler through the central opening into the condenser chamber. No attempt is made to confine the steam between the floor of the collector and the surface of the boiling water, so as to sterilize the air by compelling it to pass over the entire surface of the boiling water and mingle with the scalding steam before rising, through the steam passage, into the condenser.

An examination of the prior art satisfied the court that, before Hale took out his patent, patents had been issued for water stills consisting of three separable parts—a boiler, a collector, and a condenser—and also for water stills having air inlets to admit air for aerating purposes, and likewise water stills containing provisions for purifying and sterilizing the admitted air.

Since there was no attempt to confine the steam in a chamber for sterilizing purposes in the defendant's apparatus, and for compelling the air to pass over the entire surface of the boiling water and mingle with it, the essential element of the Hale patent was lacking in defendant's device.

SOME ELEMENTS OF PATENT LAW.—In the case of *Sanders v. Hancock* (128 Fed. Rep. 424) the court laid down with such admirable clearness the elements of patent law, that we feel prompted to quote below a few of the remarks made: It is well settled that a mere conception or idea of a desirable function or result, resting in the mind, which might be obtained by a machine or device, is not invention, either for the purpose of obtaining a monopoly, or for the purpose of making the defense of prior invention. Invention in the legal sense must involve a practical, successful, operative device. It must be a perfected invention, and either put to practical use, or be clearly capable of such use, and the novelty of an invention is not negated by a prior useless process or thing. Nor is anticipation made out by a device which might, by slight modification, be made to perform the same function, if the prior invention were not designed by its maker nor adapted to actual use for the performance of such function. Another well-settled proposition is that even in a combination patent infringement is well established whenever the alleged infringing device accomplishes the same result, and substantially in the same way. And mere colorable and immaterial difference in the mechanical arrangement and adjustment, or difference in the form of parts of the structure, or methods of fastening or bolting such forms together, does not avoid infringement, as omitting an element, so long as the same result is obtained, and substantially in the same way. Nor for similar reasons will an immaterial addition avoid infringement. No rearrangement or transposition of the parts or substitution of one thing for another avoids infringement, so long as the fact remains that the same result is worked out in practically the same way.

Attention may be called to the now well-established doctrine of the recent cases in regard to combination patents, which put those inventions on a different footing from what the tendency of the reasoning of the older cases put them. The older cases are well calculated to create the impression that a combination patent must in all cases receive a narrow construction, and that such an invention is hardly entitled to the benefit of the doctrine of equivalents. It has been demonstrated, and particularly in recent years, that patents which satisfy in the highest degree the require-

ments of the public, and a growing and complex business establishment such as ours, are not limited to the class called the primary or pioneer patents, but include combination patents. Indeed, the practical utility, and the change from failure to success, is shown in the highest degree in combination patents, and in view of this a more liberal attitude is now shown toward such patents. In the case of *Brammer v. Schroeder*, 106 Fed. 918, 920-921, 46 C. C. A. 41, the result of the more modern cases is restated by Judge Sanborn in the following language: "One who invents and secures a patent for a machine or combination which first performs a useful function is thereby protected against all machines and combinations which perform the same function by equivalent mechanical devices. . . . In other words, the term mechanical equivalent, when applied to the interpretation of a pioneer patent, has a broad and generous signification. This general rule of law, like every other principle of jurisprudence, applies equally to all patents, whether for combinations, machines, or combinations of matter. If, however, one invents and secures a patent for a new combination of old mechanical elements, which first performs a useful function, he is protected against all machines and combinations which perform the same function by equivalent mechanical devices, to the same extent and in the same manner as one who invents and patents a machine or composition of matter of like primary character. The doctrine of mechanical equivalents is governed by the same rules, and has the same application, when the infringement of a patent for a combination is in question as when the issue is over the infringement of a patent for any other invention."

And in the case of *Keystone Manufacturing Company v. Adams*, 151 U. S. 139, 14 Sup. Ct. 295, 38 L. Ed. 103, Mr. Justice Shiras, speaking for the court, said: "Where the patented invention consists of an improvement of machines previously existing, it is not always easy to point out what it is that distinguishes a new and successful machine from an old and ineffectual one. But when, in a class of machines widely used, it is made to appear that at last, after repeated and futile attempts, a machine has been contrived which accomplishes the result desired, and when the Patent Office has granted a patent to the successful inventor, the courts should not be ready to adopt a narrow or astute construction fatal to the grant." In the case of *Westinghouse v. Boyden Power Brake Company*, 170 U. S. 537, 18 Sup. Ct. 707, 42 L. Ed. 1136, Mr. Justice Brown, speaking for the court, said: "The fact that this invention was first in the line of those which resulted in placing it within the power of an engineer, running a long train, to stop in about half the time and half the distance within which any similar train had stopped, is certainly deserving of recognition, and entitles the patent to a liberality of construction which would not be accorded to an ordinary improvement upon prior devices." In another of these *Westinghouse* cases, namely, *Westinghouse Air Brake Company v. New York Air Brake Company*, 63 Fed. 962, 11 C. C. A. 528, Judge Shipman, giving the opinion of the Circuit Court of Appeals for the Second Circuit, said: "It is not important now to determine the grade of its pioneering, and whether it may be classed in the list of those inventions which are of the highest rank; but it was an invention created to achieve great necessities and overcome great hindrances, and was one of wide breadth. A court would not be justified in adopting a 'narrow or astute construction' which would minimize the character of the invention, leave its real scope open to trespasses, and thus be 'fatal to the grant.'"

PROCUREMENT BY FRAUD—REMEDY OF ACTUAL INVENTOR.—The *Standard Scale and Foundry Company* filed a bill in equity to enjoin *McDonald* from the use of a certain patent, and for an accounting to the complainant. The substance of the bill is that in 1901 one *Darius M. Orcutt* invented and perfected a wagon scale, known as the "Pitless Scale;" that said *Orcutt* was employed in 1901 by the defendants to superintend the manufacture and sale of wagon scales at their factory in this State, during which time he made and applied the discovery in question; that he filed an application for a patent on his invention, and that he was afterward informed, and for the first time learned, that the Commissioner of Patents, on an application for letters patent for said invention theretofore filed by two of the defendants, had granted the defendants letters patent therefor, issued on the 17th day of February, 1903; that the said patentees were not the original and first inventors of said device, and that they had obtained the same by fraudulent representations to the Patent Office, and in fraud of the rights of the first and original inventor; and that the complainant became the owner of all the rights and interest of *Orcutt* in said invention, by a proper deed of assignment, which had been duly filed in the office of the Commissioner of Patents.

To this bill the defendants demurred.

The question to be decided was where A claims to

be the original inventor of a patentable device, for which he is entitled to a patent from the United States, and B has wrongfully and surreptitiously, in fraud of the rights of A, obtained a patent from the government for the invention, has he a standing in a court of equity to enjoin B from the use of the patent, and for an accounting?

"As the exclusive right of the inventor to the use of his invention does not exist at common law, but depends alone upon legislative action, Congress has the power to prescribe the method and procedure by which such exclusive right shall be obtained. To this end, Congress has created a department known as the Patent Office, to which is committed the whole matter of procedure in obtaining patents. To that department the original inventor must first make his application for a patent, accompanied with suitable specifications, and certain descriptive, intelligible data. These are referred by the commissioner to a designated board of examiners, who, by reason of their learning and experience in such matters, are experts, presumably peculiarly qualified for determining whether the given device possesses the requisite qualities of an invention, as distinguished from mere mechanical skill; whether or not it be a practicable and useful device; and whether it has been anticipated in use by some other invention, or conflicts with some other patented grant. It does seem that it never was the mind of Congress that the inventor, without complying with the statutory scheme of submitting his claim to the Patent Office for its action thereon, could go into a United States court in the first instance to have determined the question of his right to a patent, and the exclusive use of the claimed invention."

"The bill discloses that, prior to the issuance of the patent to the defendants, the application of *Orcutt* to the Patent Office for a patent was filed. This brought the case precisely within the provision for a patent, conflicting with a 'pending application'; thus devolving upon the commissioner the duty imposed by the statute to give the required notice and proceed to the hearing, etc. While the bill is silent as to whether or not the commissioner observed the statute in this respect, the presumption is always to be indulged that the public officer did his mandatory duty."

"As persuasive proof that it was never contemplated by Congress that the mere claimant to an invention not patented, without more, could maintain a suit in equity against the patentee, is the provision of section 4915 of the statute [U. S. Comp. St., 1901, p. 3392] which provides as follows:

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that said applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner and all expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

"This statute shows that while Congress required the inventor to submit his claim for patent, in the first instance, to the patent department of the government, it did not intend that so valuable a thing as the inventor might obtain through the grant of a patent should be subject to the final arbitrament of that department. Why should Congress thus declare that, if the application for a patent should be refused either by the Commissioner of Patents or the Supreme Court of the District of Columbia, 'the applicant may have remedy by bill in equity,' if such remedy existed even in advance of any such adverse action by the Commissioner of Patents or the Supreme Court of the District of Columbia? The enactment would have been an act of supererogation."

"As only the exclusive owner is entitled to call in question the use of his invention by a third party, and he cannot be such exclusive owner with such right until he has obtained a patent, it should follow that the complainant is not entitled to call upon the defendants for an accounting, and to enjoin them from the further use of the invention, until it has obtained the statutory evidence of such exclusive right, which is a patent. Whether or not the complainant, in the event it obtains such patent, can compel the defendants to account for profits earned by them prior to the grant of a patent to the complainant, is not involved in this litigation. As the court has the right to assume that the complainant is prosecuting his application before the Commissioner of Patents as the statute contemplates, what is here held is that this suit is premature."

The demurrer was therefore sustained.