

BLATCHFORD, Justice. The claim of the Locke patent is a claim to a combination of mechanism, and is as follows:

"The combination of the sliding frame, B, provided with the curved guides, b', the pivoted frame, D, the spring, H', the shafts, E, and the cutter-heads and cutters, F, G, with each other, and with the uprights, C, and the main frame, A, substantially as herein shown and described."

In view of the state of the art, and of the claims made by Locke in his application and rejected, this claim to a combination must be construed strictly, and every element in it must be found in the defendant's structure to constitute infringement. The spring, H', and the sliding frame, B, provided with the curved guides, B', are not found in the defendant's machine; nor is any one of them, or any substantial equivalent for it, found there.

As to the Doane and Bugbee patent, it is admitted that the first three claims of it are infringed, if they are valid. The attempt of Locke to make a structure embodying these three claims was a mere experiment, and was abandoned, and not resumed. It did not contemplate the use of the spoke as a guiding element. The machine of Doane and Bugbee was completed, and practically and successfully worked, prior to February, 24, 1879. The two machines on which Allen worked before July, 1879, were neither of them put to any practical work, and each of them was destroyed as useless. He did not commence till April, 1879, the construction of the successful machine which he completed. The fact that when Allen applied for his patent, his claims were rejected as anticipated in the Doane and Bugbee patent, and he did not apply for an interference, is of weight to show that he did not then claim priority to Doane and Bugbee, because he accepted a patent without the rejected claims.

There must be a decree dismissing the bill as to the Locke patent, and awarding an injunction and an account of profits and damages as to the first three claims of the Doane and Bugbee patent, without costs to either party to and including the hearing. The question of subsequent costs is reserved.

HAYES v. BICKELHOUP, Jr., and another.

(Circuit Court, S. D. New York. June 16, 1885.)

PATENTS FOR INVENTIONS—ESTOPPEL—PRINCIPAL AND AGENT.

A servant or agent sued separately for infringing a patent is not bound by a former decision against his principal upon the question of the validity of the patent.

In Equity.

Livingston Gifford, for plaintiff.

Sanford H. Steele, for defendants.

WHEELER, J. This cause has been heard on a motion for a preliminary injunction. The defendants appear to have been servants or agents of George Bickelhaupt, Sr., in doing what was adjudged to be an infringement of the same claim of the same patent,—claim 2 of reissue 8,688,—in controversy here. 21 Fed. Rep. 567; 23 Fed. Rep. 183. It is urged that the adjudication there binds them here, and that they are not entitled to be heard here as to the validity or scope of the claim, nor as to whether what is the same as was there held to be an infringement is so. It is true, probably, that the decision there reached bound them as the servants or agents of that defendant as to what was then adjudged, and that they might have been proceeded with for contempt for any continuation in doing what was then enjoined, without having become or been made parties to the suit any further than they were. They might have been made, or on their own motion have become, parties to the suit, so that whatever was adjudged in it would have bound them. But they were not made actual parties to the suit, and were not called upon to litigate the questions involved in it, and did not voluntarily become parties to it, so as to be bound by such adjudication as might be had in it as parties to suits are bound. They were bound only through their relation to their employer or principal, and the decree and injunction would only affect them through him, and could only be applied to them through him. This is a new suit against them acting in their own right for what is claimed to be a new infringement. They appear to be entitled to make any defense that any one charged with infringement would be.

This claim was held to be valid upon the authority of *Hayes v. Bockel*, 11 Fed. Rep. 87. It was intended to follow *Hayes v. Seton*, 12 Fed. Rep. 120, and *Hayes v. Dayton*, 20 Fed. Rep. 690, as far as they went in determining the question of infringement. What was before the courts, respectively, in those cases was not shown, but has, to some extent, been shown now. It appears now that by mistake or otherwise the letters upon that part of plaintiff's Exhibit No. 5 referred to in *Hayes v. Bockel*, showing the patented invention, were misplaced so as to make the invention appear to be different from what it really was, and more different from Dench's patent, with which it was compared, than it really was. It also appears that what was held not to be an infringement in *Hayes v. Seton* and *Hayes v. Dayton* was very similar to what is now claimed to be an infringement. And it is suggested that some of these questions are likely to be reheard before the judge who rendered those decisions. These considerations throw sufficient doubt about the propriety of an injunction in this case to appear to warrant continuing this motion to final hearing.

Motion continued to hearing.

PARKER, Trustee, v. MCKEE and another.

(Circuit Court, S. D. New York. June 17, 1885.)

1. PATENTS FOR INVENTIONS—INFRINGEMENT—INJUNCTION.

Parker v. Stow, 23 Fed. Rep. followed, and preliminary injunction granted.

2. SAME—INFRINGEMENT BY PARTNER.

Where a member of a firm alleged to be infringing a patent was formerly a part owner of the patent, he will be estopped from denying its validity, unless it is shown that the conveyance of his title to the plaintiff was wholly without consideration.

In Equity.

W. C. Strawbridge, for plaintiff.

Walter D. Edmonds, for defendants.

WHEELER, J. This motion for a preliminary injunction cannot be denied without overruling, in effect, *Parker v. Stow*, 23 Fed. Rep. 252, and *Parker v. Montpelier Carriage Co.* Id. 886, which followed that decision. There are alleged anticipating devices put into this case which were not in either of those cases, but none of them is any nearer like the patented invention than some that were in those cases and considered, nor any nearer like it than long and well known chaise and carriage tops are. A point is made that the first reissue narrowed the patent by making the locking device a necessary part of it, and that the second reissue, although it only restored the original, broadened the second reissue to cover this infringement, and that what was surrendered of the original to obtain the first reissue could not lawfully be so reclaimed in the second. A comparison of the claims of the original with those of the first reissue shows that there was nothing covered by the former which was not included in the latter. Therefore nothing appears to have been abandoned by surrendering the original and taking that reissue, and it is not necessary to consider in this view what the effect would have been if there had been such an abandonment.

There is a strong reason for maintaining the validity of the patent in this case that did not exist in either of those cases, and that is that one of the defendants, who are a firm doing the business that infringes, was once an owner in the patent, and his title has passed to the plaintiff as a title to a valid patent. It is admitted that such a conveyance upon a valuable consideration would estop him from denying the validity of the patent, but it is urged that this conveyance was without consideration, and that therefore it does not work any estoppel. It does not appear, however, so far as has been noticed, that the conveyance of his interest was entirely without consideration, and the presumption would seem to be that it was upon consideration, and that the estoppel should follow. But the plaintiff appears to be entitled to an injunction independently of this ground. Motion granted.