

The fact that the patented device went at once into such public use as almost to supersede older devices is pregnant evidence of novelty, value, and usefulness; and this is a fact that has much weight, and is not to be overlooked. *NIXON, J.*, New York Belting & Packing Co. v. Magowan, 27 Fed. Rep. 362, (February 18, 1886.)

While it is true that the utility of a machine, instrument, or contrivance, as shown by the general public demand for it, when made known, is not conclusive evidence of novelty and invention, it is nevertheless highly persuasive in that direction, and, in the absence of pretty conclusive evidence to the contrary, will generally exercise controlling influence. *BUTLER, J.*, in *Hill v. Biddle*, 27 Fed. Rep. 560, (April 30, 1886.)

Where an old device or machine in general use, with acknowledged serious defects, which have long been endured because no one has previously discovered a means of obviating them, is taken in hand, and, by changing its form or structure, they are removed, and a different and improved result obtained, it may safely be affirmed that the change required invention. Where the improvement, and consequent public benefit, is great, very little evidence of invention is required. *BUTLER, J.*, in *Asmus v. Alden*, 27 Fed. Rep. 684; citing *Smith v. Goodyear Co.*, 93 U. S. 486; *Washburn & M. Manufg Co. v. Haish*, 4 Fed. Rep. 907; *Eppinger v. Richey*, 14 Blatchf. 307; *Isaac v. Abrams*, 34 O. G. 862, (May 13, 1886.)

The doctrine that independent evidence of invention, in addition to evidence of novelty and utility, is required to support a patent, reaffirmed in *Yale Lock Manufg Co. v. Greenleaf*, 117 U. S. 554, S. C. 6 Sup. Ct. Rep. 846, (March 16, 1886.) and in *Gardner v. Herz*, 6 Sup. Ct. Rep. 1027, (May 10, 1886.)

CHARLES C. LINTHICUM.

Chicago, July, 1886.

CLARK v. WILSON.

(Circuit Court, S. D. New York. July 13, 1886.)

1. PATENTS FOR INVENTIONS—EXPIRATION—ADAPTATION OF FOREIGN PATENT—WHEN IT WILL EXPIRE—CLARK'S PATENT FOR IMPROVEMENT IN CORRUGATED IRON SHUTTERS.

A patent which is a mere adaptation of a foreign patent expires in this country at the same time with the foreign patent, (16 St. at Large, 270; Rev. St. § 4887;) and patent No. 137,596, dated April 8, 1873, for an improvement in corrugated iron shutters by applying soft material thereon to deaden sound, is amenable to this rule.

2. SAME—IMPROVEMENT TO TAKE PATENT OUT OF OPERATION OF THE STATUTE.

Clark's patent, No. 137,596, dated April 8, 1873, for an improvement in corrugated metallic iron shutters by the application of soft material to deaden sound, is an adaptation of a foreign patent, and a slight modification therein, whereby such soft material is fastened at intervals, instead of at the ends only, is not such an improvement as to take the patent out of the operation of 16 St. at Large, 270, (Rev. St. § 4887,) which limits its exclusive enjoyment by the American patentee to the time limited by the patentee abroad.

In Equity.

Andrew J. Todd, for plaintiff.

Francis Forbes, for defendant.

WHEELER, J. The plaintiff's patent No. 137,595, dated April 8, 1873, is for an improvement in corrugated metallic rolling shutters, to deaden or prevent noise in raising or lowering them by applying to them strips of soft or pliant material, fastened when applied in the width, to the top of the shutter at one end, and to the bottom at the other, and also at any intermediate points, as required, so as to coil up with the shutter, and form a cushion between the coils. It was preceded by an English patent, No. 1,322, dated May 2, 1872, which

would run 14 years from that date, which described the same devices, except as to fastening the strips of soft or pliant material at intermediate points, as required. The claims of the two patents are the same, so far as they are now in question, and are each for the application to corrugated metal shutters of one or more strips or lengths of soft and pliant material, disposed in such manner as to act as a cushion between the coils of the shutters, substantially as and for the purpose described. The patent was granted under the act of 1870, by section 25 of which, if the invention or discovery is patented in a foreign country, the patent in this country is to expire at the same time with the foreign patent. 16 St. at Large, 270; Rev. St. § 4887.

The question on this provision of the statutes is whether the invention patented in this patent is the same as that patented in the English patent. The only thing added is the fastening of the strips, before fastened at the ends, at such intermediate points as should be required. This was such an obvious thing to do, to avoid their "rucking up," which the inventor testifies would prevent the operation of the device, as not to appear to amount to any real invention by itself. The substance of the invention consisted in providing the strips to be coiled in between the corrugations of the shutter, and when these had been contrived with fastenings at each end, such further intermediate fastenings as might be required would come from the skill of the mechanic rather than from the genius of the inventor. This was a mere incident to the principal invention, instead of being any substantial invention by itself, and appears to have been so understood by the inventor, from the alternative manner in which he mentioned it in the specification, and the identity of the claims; and, if these fastenings had been made a material element in the device of the American patent, it would narrow the patent, and bring it within the scope of the English patent, instead of making it for a different invention. What would infringe the American patent would infringe the English patent, and what would infringe that was made free to the public by the expiration of that and the corresponding American patent.

These considerations make it unnecessary to consider the effect of the certificate of addition to the French patent, which preceded the American patent, and expired, according to the provisions of the French law, at the same time as the prior English patent.

As the patent expired before this motion for a preliminary injunction was made, the motion must be denied.

TUTTLE and others v. GAYLORD.¹

(Circuit Court, N. D. New York. July 6, 1886.)

PATENTS FOR INVENTIONS—INFRINGEMENT—DAMAGES—VALUE OF PATENTED FEATURE MUST BE SHOWN.

When, in a suit for infringement of a patent which covers only one feature of a machine, there is no proof that the profits made by the infringer on the entire machine are due to the patented feature, only nominal damages can be allowed.

Exceptions to Master's Report.

C. H. Duell, for complainants.

J. R. Bennett, for defendant.

COXE, J. The complainants' patent is not for a harrow, but for a curved tooth, fastened at one end to the frame of the harrow, so that it forms an arch above the plane of the frame, and descends to the ground between the bars, its point inclining forward. *Reed v. Chase*, 25 Fed. Rep. 94. Upon the hearing before the master the defendant was required to produce, and did produce, a statement showing the number of harrows purchased and sold, and the prices paid by him to the manufacturers, and received by him from his customers. A copy of the complainants' record was also introduced in evidence. Here the proof closed. The defendant did not appear. The report of the master allows the complainants the entire gross profits upon the defendant's sales, being the difference between what he paid for the harrows at wholesale and sold them for at retail. To this award the defendant excepts.

No proof was offered showing, or tending to show, that the profit realized upon the sales of the harrows was due to the patented feature. No attempt was made to segregate the gross sum so received, for the purpose of ascertaining what proportion was due to the curved tooth, as distinguished from the other parts of the harrow. In the absence of such proof, it is entirely clear, that, in a case like the one at bar, where the patent does not cover the entire machine, but only one feature of it, the complainants can recover nominal damages alone. *Garretson v. Clark*, 111 U. S. 121; S. C. 4 Sup. Ct. Rep. 291; *Dobson v. Hartford Carpet Co.*, 114 U. S. 439; S. C. 5 Sup. Ct. Rep. 945.

The exceptions are allowed, and a decree for one dollar, nominal damages, may be entered.

TUTTLE and others v. LOOMIS and others.

(Circuit Court, N. D. New York. July 6, 1886.)

COXE, J. A decree in accordance with the decision in *Tuttle v. Gaylord*, *supra* may be entered in this cause.

¹ Edited by Charles C. Linthicum, Esq., of the Chicago bar.