

WILLIS and others v. McCULLEN.¹*(Circuit Court, E. D. Pennsylvania. December 8, 1886.)*

PATENTS FOR INVENTIONS—INFRINGEMENT—SALE OF MATERIAL BY LICENSEE TO NON-LICENSEES.

Where a licensee to sell materials for use in a patented process to other licensees, sells said materials, to be used for such process, to other persons known not to be licensees, he is guilty of infringement.

In Equity.

Alexander & McGill and Charles Howson, for complainants.

John G. Johnson, for respondent.

McKENNAN, J. The respondent had a license to use the patented process, and also a license to sell materials for the process, to licensees. The use of the process by the respondent was limited to Philadelphia. Whether these license contracts have been kept in good faith, or violated, by the one party or the other, and whether the complainants could rightfully revoke their licenses, are questions which, under the circumstances here appearing, we cannot consider. *Hartell v. Tilghman*, 99 U. S. 547. The parties are citizens of the same state, and our jurisdiction, therefore, depends on the subject-matter involved. To the extent of questions arising out of the patent, and the respondent's acts in alleged violation of it, we have jurisdiction. Over controversies arising out of the license contracts we have not. Thus the complaint of infringement by use of the process in Philadelphia, and the sale of materials for use by licensees elsewhere, drops out of the case.

There is no license, or room for suggestion of license, to sell materials to others than licensees, for use in the process. That the respondent did sell to such persons for such use, knowing that the materials were purchased for this use, and intending that they should be so applied, is quite clear upon the proofs, if not admitted by the pleadings. Purchasers were solicited by advertisement and otherwise, with an especial view to this use. By these sales thus made the respondent became a party to their use. The question whether the complainants violated their contracts, and thus failed in the observance of good faith, urged upon us in justification of this, or as a reason why we should not interfere, cannot be considered. If they violated their contracts, the respondent has an ample remedy elsewhere. He cannot find or seek redress by infringing the patent.

A decree must therefore be entered against him, as respects such sales for use in the process to unlicensed persons.

¹ Reported by C. Berkeley Taylor, Esq., of the Philadelphia bar.
v.29F.no.13—41

SWIFT v. JENKS and others.

(Circuit Court, N. D. New York. January 31, 1887.)

PATENTS FOR INVENTIONS—DISCLOSURE OF INVENTION BY PRIOR PATENT—FAILURE TO CLAIM—ABANDONMENT.

The fifth and sixth claims of letters patent No. 283,931, issued to Allen W. Swift, for an improvement in lubricators, are invalid by reason that the invention covered thereby was disclosed by letters patent No. 255,353, issued to the same person, for an improvement in lubricators, and was abandoned to the public by failure to claim the devices set out by such claims.

2. SAME—FIFTH CLAIM OF PATENT No. 257,326.

The fifth claim of letters patent No. 257,326, issued to Ross J. Hoffman and owned by defendants, is for the same invention as that covered by the fifth and sixth claims aforesaid, and is also void.

In Equity.

C. H. Duell, for complainant.

Neri Pine, for defendants.

COXE, J. This is an equity action for infringement founded upon letters patent No. 283,931, granted to the complainant August 28, 1883, for an improvement in lubricators. The application was filed June 13, 1882. The bill prays for an injunction and an account, and for relief under section 4918 of the Revised Statutes. The invention relates to lubricators, designed chiefly for lubricating the valves and cylinders of steam-engines. Automatic action is secured by the gradual admission of water to the interior of the oil-cup, displacing therein a corresponding quantity of oil, and forcing it, through the lubricant duct, to the steam-pipe, from whence it is carried to the steam-chest valve and cylinder of the engine. The object of the invention is to enable the engineer to ascertain, by observation, whether the lubricator is working regularly. This is accomplished by extending the end of the drip-tube so near the wall of the oil-cup, which at this point is made of glass, that the drops of water, as they escape from the tube, are delivered against the inner surface of the glass, and are thus plainly seen, even when the oil is almost opaque. The claims in controversy are as follows:

"(5) In combination with the steam-condensing duct, and its horizontal extension, *c*, the lubricant cup, composed of metal, and provided in front of the duct extension, *c*, with an observation port, *r*, covered with a transparent plate, substantially as and for the purposes set forth.

"(6) In combination with the oil-cup of a lubricator, the port, *r*, covered by a glass plate, and the pipe or tube, *c*, having an inclined end or face, substantially as set forth."

In March, 1884, the patent was before the court upon a motion for a preliminary injunction. *Swift v. Jenks*, 19 Fed. Rep. 641.

One of the defenses interposed is that the complainant has fully described the devices covered by the claims in question in a prior patent, and, having failed to claim them there, they must be regarded as abandoned to the public.