

tached to the several bows and waistband, and the patentee so specifically states in his specification. It is urged, however, that claim 9 is not broader than the claim in the first reissue, and that therefore it is not invalid. Assuming this to be true, I am of opinion that the defendant's bustle does not infringe this claim. The Klous bustle has not the series of uprights which are the main feature of the Thomas invention. The claim says that the series of uprights or braces are united where they come together, which is at the bends. This feature is also absent from the Klous bustle. In the Klous bustle we find a new element, namely, a horizontal bow extending out from the waistband below the other bows. Single uprights are attached to this bow, while their upper ends are attached respectively to the bows and the waistband. The combination of elements which go to make up the ninth claim of the Thomas reissue are not found in the Klous bustle, nor what may fairly be considered their equivalent. The organization of the Klous bustle is quite different.

For these reasons I think that the bill should be dismissed.

WISE v. GRAND AVENUE RY. CO.

(Circuit Court, W. D. Missouri, W. D. January 5, 1888.)

1. PATENTS FOR INVENTIONS—INFRINGEMENT—INJUNCTION.

It is not necessary for a patentee to establish the validity of his patent at law before he can obtain equitable relief for its infringement; but the chancellor may in his discretion require an action at law to be brought and tried, before awarding an injunction, if he doubts the validity of the patent.

2. SAME—SUIT FOR INFRINGEMENT—LAW AND EQUITY.

A patentee may sue either at law or in equity for an infringement of his patent, according to the nature of the relief demanded.

3. SAME—SUIT FOR INFRINGEMENT—CERTAINTY IN PLEADING.

A bill to enjoin an alleged infringement of a patent described therein merely as an "Improvement in Cable Railways" is demurrable, as not showing with sufficient certainty in what the alleged invention consists.

In Equity. On demurrer to bill.

R. H. Manning, for complainant.

D. B. Holmes, for defendant.

THAYER, J. In this case the objections taken to the complaint are threefold and as follows: *First*, that the complaint does not contain any matter of equitable cognizance; *second*, that the complaint does not show in what the alleged invention of the complainant consists; and, *third*, that the bill does not show that the validity of the alleged patent has as yet been established at law.

The first and third objections to the bill are untenable. The complainant seeks an injunction to restrain an alleged infringement of letters patent, and, as an incident of such relief, he also prays for a discovery and an account of the profits realized by the defendant by the use of the

invention. This is a matter that falls within the equitable jurisdiction of the court. It is now settled that a patentee may sue either at law or in equity, according as the relief demanded is of a legal or equitable nature. If damages for an alleged infringement are sought, an action at law is the appropriate action; and if the patent has expired at the time suit is brought, so that an injunction cannot be awarded, it is ordinarily the exclusive remedy. But if the patent has not expired, and the patentee wishes to restrain acts of infringement, he may sue in equity for an injunction, and, as an incident to that form of relief, the court has power to decree an accounting as to profits realized by the defendant. A patentee is not compelled to sue at law and establish the validity of his patent in that forum as a *condition precedent* to obtaining equitable relief, although the chancellor may in his discretion require a suit at law to be brought and tried, before awarding an injunction, if he doubts the validity of the patent. But, as a matter of practice, courts of equity rarely, if ever, require a suit at law to be brought to establish the validity of a patent, preferring usually to hear and determine for themselves all questions that may arise affecting the validity of the same. These questions have all been so well settled that a reference to the authorities is all that is deemed necessary on these points of the demurrer. *Root v. Railway Co.*, 105 U. S. 189; *Cochrane v. Deener*, 94 U. S. 780; *Goodyear v. Day*, 2 Wall. Jr. 296; *Sickles v. Gloucester Co.*, 3 Wall. Jr. 186.

The second objection to the bill, in my opinion, is well founded; that is to say, the bill of complaint does not show with any certainty in what the alleged invention consists. It merely avers that plaintiff is the inventor of a new and useful device described in the specifications of letters patent of the United States No. 357,162, and therein named an "Improvement in Cable Railways;" that said letters were duly granted to complainant on February 1, 1887, and were signed and countersigned, respectively, by the secretary of the interior and commissioner of patents. After reading the bill, the court has no information respecting the invention further than is contained in the statement that it is called an "Improvement in Cable Railways," and that letters patent have been issued for the same. Neither the patent nor the specifications annexed thereto have been made exhibits to the bill, according to the usual practice in such cases. The result is that an expert machinist might make a careful examination of all the machinery and mechanical contrivances employed by the defendant, and, after such examination, he would be unable to determine or even guess, from the description of the complainant's invention contained in this bill, whether any such invention as is described is in use by the defendant. The complaint does not even show to what part of the machinery usually employed by a cable railroad the invention here in question appertains.

Without further comment it will suffice to say that the bill is clearly defective in the respect herein indicated, and the demurrer will be sustained for that reason.

GRAFF *et al.* v. BOESCH *et al.*

(Circuit Court, N. D. California. October 8, 1887.)

1. PATENTS FOR INVENTIONS—PATENTABILITY—INFRINGEMENT.

On the facts disclosed by the proofs, *held*, that the first claim of letters patent No. 289,571, granted to Carl Schwintzer and William Graff for a lamp-burner, shows a patentable invention, and is infringed by the lamp-burners sold by respondents.

2. SAME—RIGHTS OF PURCHASER IN THE UNITED STATES FROM MANUFACTURER IN A FOREIGN COUNTRY.

Where an invention was patented in Germany, and subsequently patented in the United States, and under the German patent-laws a manufacturer in Germany had a right to practice the invention in Germany, because he had made preparation to do so prior to the issue of the German patent, and for that reason the German patent was of no effect as against him, a purchaser in the United States, purchasing from such manufacturer in Germany, has no right to sell the articles in the course of trade in the United States without license from the owner of the United States patent.

(Syllabus by the Court.)

In Equity. Bill for infringement of patent.

Langhorne & Miller, for complainants.

Scrivner & Boone, for respondents.

SAWYER, J., (*orally*.) I have carefully examined this case. I am not satisfied that the first claim does not cover a patentable invention. It is a combination. The German court, which had it under consideration, evidently held it to be a patentable invention. It was also of the opinion that the defendants' instrument is an infringement, and so am I. At all events, I am not satisfied that it is not a patentable invention. The patent itself is *prima facie* evidence on this point which is not satisfactorily overthrown. It is claimed, however, because a man by the name of Hecht has a right to manufacture this invention in Germany, that these articles which the defendant brought here, having been purchased in Germany of him who had a right to manufacture them, the purchaser can lawfully import and sell them here. I do not think that can be done. I do not think the case is at all within the range of any of the cases cited. In fact the first case cited by the defendant is directly the other way. The case that has gone further than any of them is *Adams v. Burke*, 17 Wall. 453, decided by the supreme court, where the patentee holding an American patent has himself sold his right to a particular district, free from any restrictions whatever. It was held that a purchaser from an assignee within the district, to which the right was sold, of an article manufactured in the district, was authorized to use the article in any district. But the decision was carefully limited to the use. Nothing was said as to the right to sell the article outside the district.

The case of *McKay v. Wooster*, 2 Sawy. 373, cited from the decisions of this court, does not go so far as seems to be generally supposed, because that is limited, so far as the facts and the decision go, to the case where