

JOURNAL OF PATENT LAW.

A COVENANT NOT TO INFRINGE—A SLIGHT CHANGE OF MECHANICAL STRUCTURE IS NOT THE SUBJECT OF A PATENT, BUT IS AN INFRINGEMENT.

Where a defendant covenants not to further infringe an existing patent, and receives for entering into such covenant a valuable consideration, he will be enjoined by a court of equity from infringing, unless he shows some equitable reason why he should not be bound by his covenant. The application of this principle of patent law is illustrated in the case of *Sargent et al. versus Larned et al.*, decided in the first Circuit Court of the United States by Judge Curtis.

The alleged infringement for which the action was brought was upon a patent for a machine for paring apples, invented by Ephraim L. Pratt, and patented Oct. 4, 1853. There were two instruments executed by the parties, and, taking the two together, it appears that on Sept. 6, 1853, the defendant Seagrave received from the plaintiffs a qualified license to complete and sell certain machines, including the improvement for which Pratt's Letters Patent were issued; and in the May following this license was relinquished, and another, and a different license to sell certain of the said machines, was substituted, and Seagrave expressly covenanted to make no more of said machines after the date of said instrument; but it appears that he subsequently *did* so, although the defendant claimed that they were different in their construction from those covered by the plaintiff's patent, and consequently were no infringement. The counsel for the complainant insisted that the respondent Seagrave was estopped by his covenant from disputing the validity of the patent, and, in reference to this covenant, the court said: "If this was a valid contract, a court of equity will not allow Seagrave to violate his covenant and defend himself by attacking the validity of the patent. He must keep his covenant to desist from the manufacture, unless he shows some equitable reason why its performance should not be decreed. It is open to the defendants to allege and prove any facts which render a specific performance of the covenant inequitable, and great latitude is allowed to the covenanter who resists performance.

"It appears from the facts alleged in the answers relating to this subject, that Seagrave's machine was completed and put in use about nine or ten months before the date of Pratt's patent; that Seagrave had no belief that any patent could or would be granted for anything contained in Pratt's machine, and he told the plaintiffs that if a patent should be finally obtained, which would be valid at law, and he should continue to use it, he would make them a fair allowance therefor. An interference was afterwards declared by the Patent Office, between Pratt's and Seagrave's inventions; upon which Sargent and Foster and Seagrave met together and made an arrangement set forth and embodied in a partly-written and partly-verbal contract, dated Sept. 6, 1853. By this arrangement it was mutually agreed that Seagrave should withdraw all opposition to Pratt's claim and should petition the Patent Office to grant the said claim, which Seagrave accordingly did, and the patent to said Pratt issued immediately after. On the other hand Seagrave was to have the right to use the patented improvement upon as many machines as he had castings for, and it was further agreed that said Sargent and Foster and Seagrave might use each other's improvement.

"After this arrangement Seagrave went on making machines. Sargent and Foster received the patent of Pratt, and said Seagrave applied to the plaintiffs to have the verbal part of the contract reduced to writing; but they refused to do it, and Seagrave went on to finish up the machines. While at work on these machines, his own patent was issued, dated April 18, 1854.

"A new contract was entered into, May 26, 1854, whereby, in consideration of the complainants' buying, for \$117, all the odds and ends and parts of machines which said Seagrave had on hand; they being machines containing the knife-holder loose upon the knife-rod, or, in other words, containing Pratt's alleged improvement, said Seagrave agreed to give up all rights acquired by him under and by virtue of the first contract. In pursuance of this agreement Seagrave sold and delivered to the complainants all the parts of such machines as he then had on hand, and from that time it was alleged Seagrave ceased wholly from making such machines as contained said Pratt's improvement, and resumed the

manufacture of machines previously patented by himself, adding other and further improvements, one of which was the mode of connecting the spring which draws the knife-rod towards the apple with the knife-rod itself. In no instance had the defendant Seagrave made a machine, since said last-mentioned agreement, having a knife-holder united to the knife-rod in the manner described in Pratt's patent.

The court, referring to the facts we have briefly stated, said: "The defendants have stated in their answer some circumstances which are relied on by their counsel as furnishing equitable reasons for preventing the interposition of the court. But it will be perceived that the defendants do not here claim the right to continue the manufacture, notwithstanding the covenant. On the contrary, the defense is a denial that the covenant has been violated, and my opinion is that if the facts alleged in the answer were proved, they would not affect the validity of the final agreement of May 26, 1854, which contains the covenant in question. If those facts were true, there was, at the date of the agreement, a controversy between the complainants and Seagrave, in which Seagrave was equitably right, and in the course of which the conduct of the complainants had been unfair; but, assuming this to be so, Seagrave, with a knowledge of all the facts, and under no duress, made the agreement for a compromise of May 26th, and then the complainants executed it on their part and bought the machines and parts of machines, and paid for them as agreed. The answer does not show any reason to suppose that the agreement was unconscientious or unreasonable. Seagrave cannot be allowed to go behind the agreement, especially when he retains the fruit of it. Moreover, there is no evidence of the facts alleged in the answer respecting these negotiations. The bill alleges that the agreement of May 26th was entered into by the complainants for the sake of avoiding litigation, and because Seagrave was not pecuniarily responsible. The answer does not deny either of these allegations. So far as the motives of the complainants for entering into the contract are concerned, and so far as respects the pecuniary responsibility of Seagrave, the answer is silent; and as to motive of Seagrave, the bill charges nothing. The answer goes into a history of negotiations and agreements which it alleges preceded this agreement. But this is responsive to nothing in the bill, which contains no allegations concerning any such negotiations or agreements, nor respecting the state of the controversy between the parties, further than to say (what the answer, in substance, admits) that the complainants requested Seagrave to desist from making machines which violated their patent.

"Shortly stated, the case is this:—The bill alleges that a controversy existed concerning the violation of a patent, and that an agreement of compromise was made by the complainants, to avoid litigation, and because the defendant was not pecuniarily responsible. The answer says nothing of either of these points, but goes into a history of the controversy which was compromised. I am of opinion that it is not responsive to the bill and is not evidence, and that no sufficient reason appears why the compromise should not be executed on Seagrave's part. As to the other question, whether the machines made by Seagrave do include, in substance, the improvement for which the complainants' Letters Patent were granted, I am of opinion that the infringement is made out.

"The improvement patented consists in so attaching the knife-block to the rod which moves it as to allow it to rotate around the rod at right angles therewith, and thus the knife accommodates itself to any irregularity in the surface of the vegetable to be pared. The defendants, instead of making the knife thus movable on the rod, have made the rod movable in its socket. The knife-block has the same motion; but, in one, it is around the rod, in the other, it is with the rod. The change is so obvious and slight, and its practical effect so small, if it be anything, that I cannot consider it introduces a substantially new mode of operation, within the meaning of the patent law. It is one of those changes of form merely, or of mechanical structure, which would not be the subject of a patent without showing that some new or materially-improved result is obtained by it, which is not made out in this case. As against Seagrave, I think the complainants entitled to a decree for an injunction and an account. **But Larned—**

the other defendant—is merely a workman in the employment of Seagrave. No decree for an account can be had as against him, for he has nothing to do with any profits; and upon the facts of the case I entertain doubts whether he ought to be enjoined, upon the footing of Seagrave's covenant. Unless the complainants elect to dismiss their bill, as against Larned, and take a decree against Seagrave alone, I must consider what is to be the effect of thus enjoining Larned."

INFRINGEMENT CASE.

UNITED STATES CIRCUIT COURT, BOSTON.

Before Judge Sprague and a Jury.

JUNE 11.—*Charles A. Eames vs. Aldrick S. Cook.*—

This was a suit for infringement of a patent for an improvement in boot-trees, held by the plaintiff, and granted to him May 27, 1856. The parties both reside in Milford, Mass.

The boot-tree patented to the plaintiff was claimed to be so arranged and contrived as to be adapted to tree boots varying very considerably in sizes and pattern or style, and it was claimed that the mode of applying the force or stretching power to boots was such that its use did not expose the boots to be burst or torn, as was the case with trees previously in use, when worked by machinery.

The general issue was pleaded by the defendant, and under this plea the defendant denied that the plaintiff was the first inventor of the machine described in his patent, and contended that the same arrangement shown in the plaintiff's patent had existed in boot-trees previously made by Reuben L. Lewis, of Milford, and was shown also in boot-trees patented to Wm. Upfield in 1850, and to Jarvis Howe in 1848; and the Howe tree was relied on particularly, as containing the same arrangement and operating on the same principle as that claimed by the plaintiff in his patent, and the evidence in the case related mainly to a comparison of these two trees (Howe's and the plaintiff's) in respect to the construction and mode of operation of each, respectively.

Judge Sprague charged the jury very fully and clearly on all the points raised on either side, and analyzed the plaintiff's machine, as described in his patent, and those of Howe, Lewis and Upfield, relied on in defense, with reference to all the evidence in regard to each, and stated the bearing of all the evidence upon the various points in dispute, and the law applicable to the questions raised, with the dialectic skill for which the judge is so distinguished in cases relating to patents.

The jury found a verdict for the plaintiff, thus sustaining the validity of his patent, and assessed damages for infringement in the sum of \$1,000.

POLYTECHNIC ASSOCIATION OF THE AMERICAN INSTITUTE.

[Reported expressly for the Scientific American.]

On Thursday evening, June 14th, the usual weekly meeting of the Polytechnic Association was held at its room in the Cooper Institute, this city; Professor Mason presiding.

MISCELLANEOUS BUSINESS.

Bitumen.—Dr. Stevens read a paper on bitumen, giving an account of the origin, localities and properties of that remarkable substance. Asphaltum, coal, rock oil and burning springs have a similar vegetable origin; heat, pressure and chemical agencies accounting for all the specific differences. When all the mineral coal is exhausted, the doctor thinks that there will be found plenty of bitumen, for lighting purposes, to supply its place.

Japanese Paper.—Mr. Bruen exhibited samples of the paper in which the presents sent by the Japanese embassy to Mayor Wood were wrapped. The paper is of a light straw color and remarkably stout, being nearly as strong as calico. The fiber of the paper material is very long and resembles raw cotton.

The president here called up the regular subject—"Gas and Gas-burning," for the

DISCUSSION.

Professor Hedrick—Coal gas cannot be profitably made on a small scale, for the reason that the apparatus and the process are too complicated. Resin or oil gas, however, may be made at a moderate cost, the apparatus required is small and simple, and the gases, when generated, need only to be cooled to condense tarry matter, and to be washed with water, when they are fit for burning. Ordinary coal gas is a mixture of many gases