HERALD AND EXPOSITOR.

CARLISLE, PENN'A.

THE PARKER WHEEL PATENT.

Parker vs. J. Brandt and several others on separate Bills.—In the Circuit Court of the United States in Equity before Kane, Judge.

These were motions for special injunctions against the defendants, on bills charging them with infringing the Patent right claimed by complainant "to a new and useful improvement in the application of hydraulic power by method of combining percussion and reaction" in vertical and Horizontal reaction wheels, as set out in the specification, and alleged to have been invented by Austin and Zebulon Parker, in 1827, and patented to them in 1829, and renewed in 1843.

The defendants, it was proved did not use the reaction wheels of the complainant, but some of them used two vertical reaction wheels on the same horizontal shaft, according to the plan of one Morris Johnson, who had obtained a patent in 1837, under which, from time to time, rights were sold in Ohio, Pennsylvania, &c., to the number of two thousand and more, and that these wheels had been run and used without question, or disturbance, until within the last year, when Parker claimed that they were an infringement of his right.

The complainant charged in his bill, that the defendants infringed his patent, in setting up, running and using two percussion and reaction water wheels on the same horizontal shaft, and in using a cylinder surrounding the shaft, &c., and concentric therewith.

The defendants admitted the use by them of two reaction wheels on the same horizontal shaft, but they denied the use of the percussion and reaction wheels claimed by the complainant. The defendants admitted the use of a snail shaped water chamber, between these wheels, but denied that they used the outer concentric cylinder claimed as the invention of Austin and Zebulon Parker, and the defendants affirmed "that reaction wheels in pairs on a horizontal shaft, and the water chamber around the shaft as used by them, were substantially the same, as those which were in use before the alleged discovery and improvement of Austin and Zebulon Parker."

The defendant also denied that the Parkers had invented the use of re-action wheels in *pairs* on the same horizontal shaft, or that they were inventors of the inner and outer cylinders for such wheels, or the spout, &c., to admit the water. The defendants affirmed that these and re-action wheels were known and used before the period, 1827, to which the complainant carried back the claim of his invention.

The complainant in the amendment to his bills, claimed also, as the invention of the Parkers, "that they were the first persons to discover, and by mechanical devices to apply to use, in reaction wheels, the centrifugal force of water revolving vertically round the shaft, and passing into, and acting upon the wheels in the direction of their revolution."

The defendants denied that this principle was the subject of, or patented to the Parkers and averred that it was known and applied to use in reaction wheels before the period claimed as the date of their invention.

The complainant in his amended bill averred that his right to this principal was established in the action of Parker vs. Hulm tried in this Court in Novemcer last.

The defendants admitted that it does appear that the jury found against the defendant in that case and "from the testimony adduced in the trial, and the law as laid down by the Court," that the Parkers were the first to invent the principal stated, and also, "that they were the first persons to invent and apply to use vertical reaction wheels, having two or more wheels arranged in pairs ou the same horizontal shaft."

But the defendants denied that anything decided in that case could be used to their prejudice, for the following reasons.

1. They were no parties to that suit, had no notice of it, had no opportunity to array and produce testimony, and to cross-examine witnesses in it; and to give it effect against them would be depriving these defendants of their constitutional right of trial by Jury.

2. Because these defendants can produce evidence, as they believe, which was not given on the trial of that case, which would on both points so found by the Jury, defeat the claim of the plaintiff.

3. Because the authority of that case is shaken, and its effect destroyed, so far as regards others, who were neither parties nor privies to it, by two other cases tried very recently on the same title and patent, in the Circuit Court in the United States, one in the Circuit Court for the State of Ohio, the case of Zebulon Parker vs. Stiles; the other in the Circuit Court of the State of Indiana, Parker vs. Moreland.

In the case of Parker vs. Stiles, in Ohio, where it is alleged that Austin and Zebulon Parker made the invention and improvement for which the patent of the 19th of October, 1829, was issued, it was further proved that vertical reaction wheels in pairs were not invented by them, but were known and used long before their patent, and the date of their alleged invention.

And in that case it was proved that the fact of such antecedent use had been admitted by Parker himself.

And the plaintiff therein did not pretend to claim as the invention of the said Parkers, the discovery of the centrifugal force of water revolving vortically round the shaft, and the application thereof to use as a motive power in reaction wheels, but he confined his claim to the particular mechanical devices which he alleged to be his "machine," and with which he affirmed that of the defendant conflicted.

And the evidence in that case showed conclusively that he could not have made such a claim, and sustained it, however successfully he could, on that evidence, maintain a claim for a superior mode of so applying the water, and the infringement by the defendant of that particular mode.

In the said case in Indiana, there was a verdict for the defendant, deciding all the points against the claim of the plaintiff.

And the defendants submitted, that if it was made to appear that the complainants claimed here in the case of Parker vs. Hulme, as the invention of the said Austin and Zebulon Parker, that they were the first persons to invent and apply to use vertical reaction wheels, having two or more reaction wheels arranged in pairs on the same horizontal shaft, and it is shown that in the case of Parker vs. Stiles, as aforesaid tried in Ohio, at or about the same time, this claim was wholly abandoned and disproved, that this should avoid and annul the effect of the case of Parker vs. Hulme, against persons who are strangers to it.

The defendants put in evidence a book called "A New Century in Invention, by James White, Civil Engineer," published in 1822, containing a description of a horizontal water wheel, with the affidavit of Solo. Roberts, Esq., that the wheel there described was identical in principle with the turbine of Fourneyron, "having the same vertical motion, the same centrifugal force and fixed curved guides."

They also put in evidence the *Journal des Mines, Vol. 33*, published in 1813, describing D'Eclot turbine, being one of those called by Weisbach, in his work on mechanics, "*centrifugal turbines*."

Also the model of wheels in pairs, on a horizontal shaft, with cylindric water chamber, with an internal curved guide round the shaft, which Mr. Squires deposed was built and used in the State of New York, several years before Parker's invention.

The motions for injunctions in these cases had been made on the 11th of March, and rejected by the Court, for the reason that the complainant had not set out in his bills the recovery at law, in the case of Parker vs. Hulm, or the use and possession of his right under the patent.

The bills were so amended, and the defendants put in full answers, and those motions were now made.

Campbell, with whom was Cadwallader, read the answer of the defendants, contended that it was in effect a demurrer to the result of the trial at law in the Parker vs. Hulme,—That while it denied the originality, and affirmed the prior use of machines, it was too vague in not stating more particularly, than by referring States, the places where such machines were known & used. He objected, also, that the answer in its negation, was in the words of the bill, and therefore evasion. He contended that the complainant, on this motion, was only bound in a patent cause, and on the question of issuing an injunction, to show a fair and honest trial at law, and a verdict for the plaintiff. That this was sufficient for the present purpose, although the verdict was certainly not conclusive on the defendants, who were not parties to it, and who may take depositions, and have the case decided on its merits at the final hearing.

Penrose, with whom was Mallery, denied that the answers were objectionable, and said that the proper and only course, if the complainant alleged defects, was to except to it upon which, and a reference to a master for a report, this question would be propelly settled. He said that he and his colleague had entire confidence in the justice of the defence made by the defendants, and that they would be able, if time were given, fully to maintain every fact alleged by the answers.

He admitted however, that he entered on the argument with embarrassment. The proceeding itself was anomalous. It was a motion for a special injunction, which, if granted, would have the effect, perhaps of stopping the defendant's mills. It was the most formidable weapon in the hand of judicial power. It might strike down the defendant, by crushing the very means by which he lived. Contrary to principles of jurisprudence, considered sacred and of inestimable value in other and ordinary judicial proceedings, it is made to reach the defendant before a trial on the merits, and, according to the usual course of Courts of Equity, time is not given him to produce his evidence, and array it against the demands of the plaintiff. All the ordinary rules of evidence are disregarded—affidavits are received, taken without notice and without cross-examination—affidavits, too, of persons who may be interested in the question or the cause; and a trial, verdict, and judgement in a case to which he was not a party, and of which he had no knowledge, is received in evidence against, and made to affect him.—Thus, on a question among the gravest, most deeply affecting the defendant, the frailest of all evidence (which would be scouted in ordinary judicial proceedings) is received.—But the defendants are now in different circumstances from those in which they stood when these injunctions were moved for and rejected. They are now before the Court on full answers; and on such a question, where such frail evidence was received for the complainant, it was just that full effect should be given to these answers, at all events, until the defendants had time to produce better evidence, of which they had information, from the most respectable sources, in Ohio, Indiana, in New York, and in our own State fully to sustain their answers.

To show the value of their answers, he cited *Dreury on Injunctions*—278; *Smyth vs. Smyth*, 1. *Swan*, 252; *Elurn vs. Tindal—Web Pat. Cases*, 730; *Brooks vs. Bicknel*—3, *McLean*, 250, 255; *Orr vs. Littlefield*—2, *N. & M.*, 13 19.

There was a conflict of authority as to whether affidavits should be received to contradict the answer, but all agreed that unless the answer was so contradicted, it must stand against the motion for the special injunction, or any other decree.

But another anomaly in judicial proceedings exists here to embarrass the counsel for these defendants.

Offers of compromise are familiar to lawyers and judges. It is right they should be made; but if the party to whom they are made honestly believes that he is right, and rejects the offer, in ordinary cases is not permitted to be given in evidence against him: nor is it ever visited upon him in the shape of a penalty. It may be well to argue that it would be more convenient to yield to an unjust demand, than to contest it—better to buy peace than to resist aggression; and yet there is that sturdy spirit, which was in our ancestors, and is in our fellow citizens, not to compromise rights which they believe they honestly posess, or to yield to unjust demands.

Here the complainant has boldly thrown before the Court his offer to compromise, as a subject proper for consideration on this motion. And on the former occasion the President Judge of this Court commended this offer to the consideration of the counsel, that they might advise their clients to accept it. We know that this was kindly meant by him. The counsel of the defendants need not profess here the sentiment of great respect for this Court, but in the absence of that Judge they may be permitted to say they yield to none in their high regard for his learning and ability as a Judge, and his integrity as a man. We do not suppose that he designed that this advice should be published. But while we were prompted by our oath of allegiance, of fidelity to the Court, to regard with great respect the advice thus given, we are indebted to the complainants, special zeal for reminding our clients of our sworn fidelity to them, by sending them slips containing this advice, taken down by one of his counsel, and published. Sent, no doubt, that our clients might be put to enquiry as to our fidelity to them. All this is certainly out of the ordinary course. But it has prompted us to a critical and careful examination of the subject, to the most laborious research, to the most extensive correspondence, and enquiry, and we now say that unless we have been misinformed, by men of the highest standing, professionally as well as personally, we believe we can prove all that is alleged in these answers; and that we would have been wanting in fidelity to our clients, if we had not advised them, that they, in our judgement, had an honest and just defence to the demand of the plaintiffs against them.

He said he might also state here, that after having heard of the remarks made by Judge Grier not by him written out, but as he understood taken down by one of complainants counsel, he was anxious to learn from him in what particular, in his judgment, the machine of the defendants infringed the patent of the complainant. For this purpose I called to see him. The Judge candidly replied that he had not time to study the mechanical question, that he did not understand it. That he had not designed to express any opinion upon it. That the remarks he had made were upon the legal effort of the case of Parker vs. Hulme; on the question of granting a special injunction, as it was *then* presented.

To that extent his colleague and himself were relieved from the weight of Judge Grier's authority on the mechanical question, and on the question *now* presented with new evidence, and under different circumstances.

The complainant casts himself upon the establishment of his legal title at law by the case of Parker vs. Hulm. It is, no doubt, on this question competent evidence, but he contended that it was met by two other cases tried in the *same* Court, for that the Circuit Courts were but branches of the same Supreme Court, one in the Circuit Court for Ohio, one for the State of Indiana.

The legal title could not in these circumstances be considered as settled, as it would be a still more startling anomaly if this patent, struck down by the law and evidence in every other District, should be permitted in the Eastern District of Pennsylvania to stand, to appropriate a law of motion, a law of nature, and before hearing, and without time to bring in the evidence, to stop mills and machinery, wherever the curious eye of learned research, detected *that principle*; although such machinery, to ordinary inspection, differs from that of Parker, and in one case, from that in another.

A new trial is granted between the same parties on the discovery of new evidence.—That principle should apply with greater force, to a case to which any effort is sought to be given against a person not a party to it.

In the case of Z. Parker, the patentee himself, vs. Stiles, tried in Ohio. The evidence was so clear, that the use of reaction wheels in pairs on a horizontal shaft was not the invention of Parker, that it was admitted by the plaintiff's counsel; who took the ground that this *was not claimed in the patent.*" The Court, Judge Leavitt, arguing on this construction, decided that it was not so claimed and closed his argument on the point, by saying "now the arrangement of *wheels* on a horizontal shaft has been long known and used; nor can it be presumed that these patentees were ignorant of the fact, and intended to claim it as new." (*Western Law Journal* 181, *January* 1850. *Parker vs. Stiles,*) and in point of fact, as the answers alledges, it was proven in that case that Parker had admitted his knowledge of such prior use.

He now claims it by these bills, and he did claim it in the case of Parker vs. Hulme and your Honor, in that case, with better reasoning, than that of Judge Leavitt, decided that it *is* included in the spicification of the patent.

The new evidence furnished in the Ohio case proves this claim to have been false, and if it had been given in the case of Parker vs. Hulme the verdict and judgement would have been the other way.

1. Because a false claim, as to part of a machine, not disclaimed within a reasonable period, and nineteen years is not a reasonable period, as no period is, if the patentee knew his claim to be false, renders invalid the whole patent. Curtis 182, 187, 188, 488.

2. On one point, placing wheels in pairs on the same horizontal shaft, the verdict is clearly wrong, and as the Court cannot determine how far the error influenced the general verdict, it should set it aside as particulaly.

3. The evidence of the antecedent use of wheels in pairs on a horizontal shaft, would prove, also, that the verdict was wrong on the other point, as the use of a water chamber between the wheel *must* require that the water should be led on so as to move *with* the wheels, and by mechanical necessity verticle motion, and centrifugal force in such cases must be produced.

4. So much of the evidence as is given in the report of the case shows this to be true.

In the case of Parker vs. Moreland, in the Circuit Court of Indiana, all the points were decided, and a verdict passed against the plaintiff.

All this is affirmed in the answers of the defendants. This was enough to stay the hand of a Court of Equity to withhold injunctions until the defendats could produce the evidences given in those cases.

The complainants here introduced affidavits, of Messrs. Cresson, Smith and Harding, taken since the argument commenced, to prove that the wheel described in the book called a "New Century of Inventions," was an impact wheel, &c.

Previous to proceeding Mr. Penrose urged on the Court that testimony so introduced, certainly ought to induce the Court to give the defendants time to meet it, and he asked for time for that purpose, proposing, however, to go on with the argument, and leave that question to be considered with the rest.

The defendants certainly do not use the machine of the Parkers, but a very different machine. But it is because of the alleged appropriation by the complainant of the centrifugal force of water, revolving round the axis of the reaction wheel, that the defendants, it is said, have offended.

The antecedent use of that force, in other such machines, avoided the comprehensive character of the plaintiff's claim, leaving him only his peculiar mechanical devices, if new, as his mode of producing an effect which had been produced before.

The new evidence is in part with that design. *Weisbach* in his work on mechanics after having considered a class of impact wheels, vol 2, page 236, and in which he says, that the water moves on a cylenderical surface, and each element of water retains the same relative position to the axis proceeds. "But we have now to consider wheels in which the water besides a rotary and verticle motion possesses a motion inwards and outwards in reference to the axis and more or less radial. The peculiarity of such turbines is that their motion depends on the *centrifugal force* of the water, so that they might be termed *centrifugal turbines*." And he gives the formula, for calculating the effect of the water's centrifugal force "when its motion is in a spiral line round a centre, or when the motion is radial and rotary at the same time."

Of this class of "*centrifugal turbines*." Weisbach enumerates *Whitelow* Turbine; which is nearly on the same plan with *d'Eclot*; described in 1813, in the *Journal des Mines*, vol. 33. It is a reaction wheel, into the centre of which by a *cylinder* from beneath the water is introduced. It is the same principle, that is, in mechanical construction, as the reaction wheel of Rumsey, our own countryman, invented here about the beginning of the present century.

"In the Rumsey wheel the water is let on either from below, or above, through a cylinder into the centre of the wheel. Fourneyron's turbine is of the same class, and without his internal *fixed girder*, there is in his, and all these wheels, the same centrifugal force of water, revolving "in a spiral line round the centre" (vertically) "the motion being radical and rotary at the same titne."

The guide curves of Fourneyron, he contended, were not introduced *to produce* but *to curb* and *restrain* the vertical motion of the water, so as to keep the buckets full; in order that the whole *vis viva* of the water might be used, and exhausted in giving motion to the wheel. *Weisbuch* 229, 236, 237, 239 240, 245, 247, 549, 256, 266, 267, 380, 281.

This view, supported by Weisbach, proved beyond a doubt, that the centrifugal force of water was by mechanical devices applied to use in reaction wheels before the invention of Parker. It was in Rumsey's wheel, it was so in d'Eclot's wheel, and in all these wheels the *outer cylinder* is used.

The wheel described in the new Century of Inventions beats a remarkable resemblance to Fourneyron's. It was published in 1822. In both there is the inner and outer cylander. Both provide for a closing of the cylinder at top for high falls for water. In both a lead or shute introduces the water at *the side* of the cylinder. In White's wheel, by a flume or shute, with a contracting throat. Both were fixed curved guides, and in both, to use the language of White, "*All* the water escaped in the *same* direction (relatively to the motion of the wheel) and that direction concurs with *that* in which the wheel is made to turn." So that Mr. Roberts might well say of it, that there is the same verticle motion, the same centrifugal force, and fixed curved guides in both, and that they are *identical in principle*. If White's wheel is an impact wheel, which is not admitted, we contended that the publication of its description is not less effective for the defendants.

For the complainant did not claim in his patent, simply a *new combination* of *old machinery*, but a combination of machinery which he claims to be his own invention.

If it is shown that much so claimed is not new, although the act of Congress may relieve him from forfeiture of the *parts* really his own invention, it would not prohibit him to fall back upon a claim for a combination of old machinery. So that if nothing more is done, than to substitute for White's wheel, the old reaction wheel, by which every part would be a combination of old machinery. Parker cannot object to the use of such machinery so combined. On this point, he cited Curtis, 182, 187, 183, 488, &c.

But White's wheel is not an impact wheel. It has narrow floats, or buckets, which overlap each other, and he reserved the right to give them "the *inclination*," to make them "the *most perfect*." In 2 Weisbach, 232, the author says, "if we give the buckets greater length and form them to such a hollow curve that the water leaves the wheel in a nearly horizontal direction, the water then not only infringes on the buckets, *but exerts a pressure* on it." It is a presure wheel, or if the orifice of discharge be contracted, it becomes a reaction wheel. And Parker's, in the Report of the Franklin Institute, is called "a true wheel of pressure." See Journal for July, 1846, page 35. The model of the wheels in pairs, on the same horizontal shaft, which Mr. Squire proved was in use in New York, many years before the alleged invention of the Parkers' very closely resembles the wheel of the Parkers', and cannot be distinguished in principle from it.

There is much other evidence, of which the defendants have information, but they have not had time to procure it.

But the complainants alleges *a possession* under his patent, as evidence to sustain his motion for injunctions, and on this point he files the deposition of Zubulon Parker. It is confessed that for many years after the patent, and up to 1835, the patentees slumbered on their rights. After that time some hundred rights were sold, and principally in Ohio. But this possession, such as it was, was of *their particular machine*. The defendants do not use that machine, but the machine which they do use, was patended to Johnson, in 1837, whose agents in Ohio, Pennsylvania, and elsewhere, *publicly* sold at different times more than two thousand rights. Under these mills were built, run, and used, without question or challenge of right by the Parkers, or any body else, until within the last year. There has, therefore, been, for the last twelve years, a peaceable possession of the defendants, public and notorious, certainly more public and notorious, than the use of reaction wheels in pairs on the horizontal shaft, of which Judge Leavitt said, "nor can it be presumed that these patentees were ignorant of it." If these wheels of the defendant's were so sold and used, and there was all this time the *silent acquiescence* of the Parker's, it is well settled that they can now make no claim against these defendants. *Curtis*, 395–6; *Runnel vs. Murry Jacobs*, 311, 346; *Wyeth vs. Stone*, 1 *Story, R.* 278; *Sanders vs. Smith, Maylane vs. Craig*, 711, 728, 730, 735. Certainly in these circumstances, they have no claim to an injunction.

But what is the infringement.

Is it the outter cylinder?—That is charged in the bill. The defendants do not use it, but a scrowled shaped water chamber. The outer cylinder for reaction wheels is much older than the patent of the Parkers.

Is it the use of the old reaction wheels in pairs on a horizontal shaft? Although this is charged in the bill, it would be strange, when it was desired to be claimed in the case in Ohio and proved to be old there, to permit it seriously to be urged now.

Is it the shute or water lead used by the defendants? This is not charged in the bill.—But such a shute is old; it is in White's wheel, and a mechanical necessity where vertical wheels in pairs on a horizontal shaft are used.

The question of infringement is always for a jury to decide. As to the machine of the defendants, it has never been tried. In Parker vs. Hulme, the machine used by the defendant was very different from that used by these defendants. On this point, it should have no effect against them.

He then showed, in the cases of several of the defendants, that they were charged with using, not vertical, but horizontal wheels. As to these a very different question was presented. They were not tried in the case of Parker vs. Hulme, which was of *Two vertical* wheels on a horizontal shaft. The Court expressly declared in that case, that of the "three forms of machinery" mentioned in the patent, "the first only is involved in the present controversy; the (case of Parker vs. Hulme) it is a compound vertical percussion and reaction water wheel, "with the method of applying the water on the same."

This Court rejected the motion made for an injunction, on the ground that a statement of this case was not made part of the bill.

Thus affirming that there must have been a trial at law, on which to ground so grave a motion, as that for a special injunction. That case had been shaken, and its effect met in the answer of the defendant. But in regard to horizontal wheels, there is no pretence to say that it is entitled to the slightest consideration on the motion.

In closing the argument intended to avert from the defendants the threatened blow which went to effect so many of the mill owners of Pennsylvania, in their means of livelihood, he said he might well say, at all events, that the case was one of doubt, upon which a chancellor should hesitate—The defendants asked only that the Court should delay until they could procure their testimony. If that testimony came and was not what it was represented to be, they would yield to the claim of the complainant, and their counsel would cheerfully advise them to that course. He thought in these circumstances, he might well invoke for the defendants the shield of the adjudicated principles, that permits a Court of Equity, on such a question, to weigh the disadvantage to the complainant of withholding, and the injury to the defendant, by granting an injunction; and when such injury would be great, to put the defendants on terms, and hold up the injunction until the final hearing on their merits.

There is abundant authority for this:—Curtis, 376; Wallace Jr. Rep., 557; Wilson vs. Barnum.

The defendants here offer such terms—to give bond to secure the complainants for anything he can recover.

What legitimate advantage can the injunction be to the complainant.

The Court will not harbor the idea that it is one of its propor officers to compel the defendants to submit to demands which they and their counsel believe to be unjust, without giving them an opportunity to investigate the merits.

Such a purpose is inconsistent with the principles of justice and jurisprudence, properly regarded as sacred in all free and civilized countries.

What other good can the complainant seek in these injunctions. His patent is about to expire, it is in its last year. They cannot settle the controversy. That must go on as there are suits pending not only in this District, but in the Western and Northern Districts of this State, in New York, Ohio and Indiana.

It is not a case in which there may be danger of others who will invade a claimed right. It is not probable that any one will hereafter, in the face of this controversy, set up machines or purchase them until it is settled.

To the complainant then, it can bring no legitimate advantage, while the defendant and to the community a great injury is wrought if injunctions should stop their Mills. No case can be imagined more proper for the application of the principle and practice for which the authority is cited.

It is true that the defendants are men of influence and consideration. It is due their intelligence, integrity and popular positions. It is true that those proceedings are designed to reach a very large number of the mill owners of Pennsylvania. We know that the complainant professing to have established his exclusive right to a principal of hydraulic, has made wide sprung claims against the owners of mills, having very different construction. We hear of many suits yet to be brought, and it is difficult to set limits to a claim so comprehensive. But although the mill owners of Pennsylvania are, no doubt, among the most intelligent and the most influential of our fellow citizens, they would disdain to continue their influence to inflict injury upon the complainant. For those whom we represent, the defendants, before this Court we may well deny such combination charged against them. If convinced that they have injured the complainant they will be prompt to repair the injury.

But the spirit which prompts to repair injuries, ignorantly inflicted, is the spirit to resist an unjust demand.

The Court declined hearing Mr. Cadwalader for the complainant, and postponed delivering an opinion until a future day.