

EN BANC

[G.R. No. 4720. January 19, 1909.]

CARLOS GSELL, plaintiff-appellee, vs. VALERIANO VELOSO YAP-JUE, defendant-appellant.

Chicote & Miranda, for appellant.
Haussermann Cohn, for appellee.

SYLLABUS

1. INFRINGEMENT OF PATENTS; PROCESS OF MANUFACTURE. — The manufacture of cane handles for walking sticks and umbrellas by a process identical with plaintiff's patented process therefor, save only for the substitution of a blast lamp or blowpipe fed by alcohol, for a blast lamp or blowpipe fed by petroleum or mineral fuel, in applying heat for the purpose of curving such handles, is an infringement upon the patented process.

2. ID.; ID.; INJUNCTION; CONTEMPT. — The use of a process in all respects identical with a process protected by a valid patent, save only that a well-known mechanical equivalent is substituted in lieu of some particular part of the patented process, is an infringement upon the rights of the owner of the patent, which will be enjoined in appropriate proceeding and the use of such process, after the order enjoining its use has been issued, is a "contempt," under the provisions of section 172 of the Code of Civil Procedure.

DECISION

CARSON, J p:

This is an appeal from a final order of the Court of First Instance of the city of Manila, in contempt proceedings prosecuted under the provisions of section 172 of the Code of Civil Procedure. The principal case to which these proceedings are ancillary, was an action to enjoin infringement of a patented process for the manufacture of curved handles for canes, parasols, and umbrellas. In that case plaintiff established his title to a valid patent covering the process in question, and obtained against this defendant a judgment, granting a perpetual injunction restraining its infringement, which judgment was affirmed by this court on appeal (6 Phil. Rep., 143.) The order was couched in the following terms:

"It is ordered that the defendant abstain from manufacturing canes and umbrellas with a curved handle by means of a lamp or blowpipe fed with mineral oil or petroleum, which process was protected by patent No. 19228, issued in favor of Henry Gsell, and by him transferred to Carlos Gsell —"

and the process therein mentioned is fully described in the following statement which accompanied the application for the patent:

"After the canes have been cut for cane or umbrella handles, the outsides are thoroughly cleaned. This operation having, been performed, they are then trimmed and the interior cleaned by means of a gimlet of about 15 centimeters in length operated by a wheel, by means of which the knots inside are broken. There is then introduced to a depth of about 15 centimeters a piece of very clean bamboo, which completely fills the hole made by the gimlet, thereby giving to the cane the necessary strength to resist the heat of the lamp or blowpipe without breaking or cracking.

"This operation having been performed, the cane, the end of which is attached to a fixed point, is given the shape of a hook or some other form by means of fire and pressure. Once the cane has been shaped as desired, it is allowed to cool, and is then cleaned, varnished, and ornamented at will.

"This industry requires skillful handiwork, owing to the great risk engendered by the treatment of such fragile material as a light cane. On the other hand, however, it affords large profits to the workman.

"NOTE.—The patent applied for shall be for the industrial product 'cane handles for walking sticks and umbrellas, curved by means of a small lamp or blowpipe, fed by petroleum or mineral fuel.'"

Thereafter the defendant continued to manufacture curved cane handles for walking sticks and umbrellas by a process in all respects identical with that used by the plaintiff under his patent, except only that he substituted for a lamp fed with petroleum or mineral oil, a lamp fed with alcohol, as appears from a stipulation entered into between plaintiff and defendant in the following terms:

"The plaintiff and defendant agree upon the fact that the defendant has used and is still using a process for curving handles of canes and umbrellas identical with that described in the application for the patent by the plaintiff with the exception that he has substituted for the lamp fed with oil another lamp fed with alcohol."

Contempt proceedings were instituted against the defendant in the month of February, 1904, the plaintiff in the original action alleging that the "Defendant in disobedience of the judgment of the same was and is now engaged in the unlawful manufacture of umbrella handles by the identical process described in and protected by said patent, No. 19228, or a process so like the patented process as to be indistinguishable."

The trial court found the defendant "not guilty" of contempt as charged; and this court, on appeal, held that —

"The violation, if there has been any, was not of such a character that it could be made patent by the mere announcement of the acts performed by the defendant, which are alleged to constitute the said violation. These acts were not clearly and manifestly contrary to the precise terms of the prohibition. according to the express language of the judgment, the prohibition is against the manufacture of canes and umbrellas within curved handles by means of the use of a coal or mineral burning lamp or blowpipe and the parties have stipulated that the defendant did not use a coal or mineral oil-burning lamp but an alcohol-burning lamp.

"The question, however, arises as to whether that prohibition included the substitution of alcohol for coal or mineral oil. In more abstract and general terms, the appellant propounds this question in his brief, as follows: 'The question presented by this appeal is whether or not the use of a patented process by a third person, without license or authority therefor, constitutes an infringement when the alleged infringer has substituted in lieu of some unessential part of the patented process a well-known mechanical equivalent.' It is seen that by its very terms this question implies in the present case the existence of two fundamental facts which must first be duly established, viz: (1) That the use of the lamp fed with petroleum or mineral oil was an unessential part of the patented process the use of which by the accused was prohibited by the said judgment; and (2) that alcohol is an equivalent and proper substitute, well known as such, for mineral oil or petroleum in connection with the said process. The appellant has failed to affirmatively establish either of these two essential facts. He has merely assumed their existence, without proving the same, thus begging the whole question. Consequently the contempt with which the accused is charged has not been fully and satisfactorily proved, and the order appealed from should accordingly be affirmed in so far as it holds that the defendant is not guilty of contempt." (7 Phil. Rep., 130.)

Thereafter the plaintiff continued the use of the patented process, save only for the substitution of a lamp fed by alcohol for a lamp fed by petroleum or mineral oil, and new proceedings were instituted under the provisions of section 172 for the purpose of enforcing the original injunction above cited. Substantially the same question is submitted in these new proceedings as that submitted in the former case, but at the trial of this case testimony was introduced which, in our opinion, leaves no room for doubt, first, that alcohol is an equivalent or substitute, which known as such at the time when the patent was issued, for mineral oil or petroleum, in connection with blast lamps or blowpipes such as that which plaintiff uses in the patented process, and, second, that the use of a blast lamp or blowpipe fed with petroleum or mineral oil, rather than one fed with alcohol, is an unessential part of the patented process the use of which was prohibited by the said judgment.

It was clearly proven at the trial, that kerosene and alcohol blast lamps are agencies for producing and applying heat, well known throughout the world long, prior to 1906, the date of the issue of the patent; that it is and for many years has been known that one may for all ordinary purposes be used in the place of the other, and especially for the purpose of applying heat in the manner described in the patent; that the only consideration which determines the employment of one in place of the other is the convenience of the user and the question of relative cost; and that the principle upon which both lamps work is substantially identical, the only difference in construction being occasioned by the application of this principle to oils of different physical and chemical composition.

The plaintiff does not and can not claim a patent upon the particular lamp used by him. The patent, however, gives him the exclusive right to the use of "la lamparilla o soplete, alimentada de petroleo o esencia mineral" (the small lamp or blowpipe fed with petroleum or mineral oil) in manufacturing curved handles for umbrellas and canes, to which reference is made in the above-cited descriptive statement and annexed note. "The small lamp or blowpipe" mentioned in the descriptive statement and annexed note which accompanied the application for the patent, evidently referred to the design of a blast

lamp which was attached thereto; and in our opinion both plaintiff and defendant make use of a blast lamp substantially similar, in principle and design, to that referred to in the descriptive statement and the annexed note, for the exclusive use of which in the manufacture of curved handles, plaintiff holds a patent. True, defendant's blast lamp is fed with alcohol, and its shape varies in unimportant details, for the purpose of accommodating the principle, by which the flame is secured, to the different physical and chemical composition of the fuel used therein; but the principle on which it works, its mode of application, and its general design distinguish it in no essential particular from that used by the plaintiff. If the original design accompanying the statement had shown a blast lamp made of brass or delf, he would be a reckless advocate who would claim that the patent might lawfully be evaded by the use of a lamp made of iron or tin; or if the original design had shown a blast lamp 6 inches high, with a nozzle 4 inches long it would hardly be seriously contended that the use of a lamp 8 inches high with a nozzle 3 inches long would protect the ingenious individual, who in all other respects borrowed the patented process, from the consequences of an action for damages for infringement. But in the light of the evidence of record in this case, the reasoning upon which these hypothetical claims should be rejected applies with equal force to the contentions of the defendant, the ground for the rejection of the claims in each case being the same, and resting on the fact that unessential changes, which do not affect the principle of the blast lamp used in the patented process, or the mode of application of heat authorized by the patent, are not sufficient to support a contention that the process in one case is in any essential particular different from that used in the other.

Counsel for plaintiff invokes the doctrine of "mechanical equivalents" in support of his contention, and indeed that doctrine is strikingly applicable to the facts in this case. This doctrine is founded upon sound rules of reason and logic, and unless restrained or modified by law in a particular jurisdiction, is of universal application, so that it matters not whether a patent be issued by one sovereignty or another, the doctrine may properly be invoked to protect the patentee from colorable invasions of his patent under the guise of a substitution of some part of his invention by some well-known mechanical equivalent. Our attention has not been called to any provision of the patent law of Spain, which denies to patentees thereunder the just and equitable protection of the doctrine; and indeed a patent law which failed to recognize this doctrine would afford scant protection to inventors, for it is difficult if not impossible to conceive an invention, which is incapable of alteration or change in some unessential part, so as to bring that part outside of the express terms of any form of language which might be used in granting a patent for the invention; and as has been well said by counsel for plaintiff, human ingenuity would be taxed beyond its powers in preparing a grant of a patent so comprehensive in its terms, "as to include within the express terms of its detailed description every possible alternative of form, size, shape, material, location, color, weight, etc., of every wheel, rod, bolt, nut, screw, plate, and other component parts of an invention."

The following citations from various decisions of the Federal Courts of the United States illustrate the application of the doctrine in that jurisdiction, and clearly point the way to the proper solution of the questions involved in the case at bar:

"Can the defendant have the right of infringement, by substituting in lieu of some of the parts of the combination well-known mechanical equivalents? I am quite clear that he

can not, both on principle and authority. It is not to be disputed that the inventor of an ordinary machine is, by his letters patent, protected against all mere formal alterations and against the substitution of mere mechanical equivalents. Why should not the inventor of a new combination receive the same protection? If he can not, then will his patent not be worth the parchment on which it is written.

"If no one can be held to infringe a patent for a combination unless he uses all the parts of the combination and the identical machinery as that of the patentee, then will no patent for a combination be infringed; for certainly no one capable of operating a machine can be incapable of adopting some formal alteration in the machinery, or of substituting mechanical equivalents. No one infringes a patent for a combination who does not employ all of the ingredients of the combination; but if he employs all the ingredients, or adopts mere formal alterations, or substitutes for one ingredient another which was well known at the date of the patent as a proper substitute for the one withdrawn, and which performs substantially the same function as the one withdrawn, he does infringe." (King vs. Louisville Cement Co., Fed. Cas., 7798.)

"Bona fide inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements; by which is meant that a patentee in such a case may substitute another ingredient for any one of the ingredients of his invention, if the ingredient substituted performs the same function as the one omitted and was well known at the date of his patent as a proper substitute for the one omitted in the patented combination. Apply that rule and it is clear that an alteration in a patented combination which merely substitutes another old ingredient for one of the ingredients in the patented combination, is an infringement of the patent, if the substitute performs the same function and was well known at the date of the patent as a proper substitute for the omitted ingredient." (Gould vs. Rees, 82 U. S., 187, 194.)

"Mere formal alterations in a combination in letters patent are no defense to the charge of infringement and the withdrawal of one ingredient from the same and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn.

"Bona fide inventors of a combination are as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what they have invented and caused to be patented as any other class of inventors. All alike have the right to suppress every colorable invasion of that which is secured to them by letters patent." (Seymour vs. Osborne, 78 U. S., 516, 556.)

"A claim for the particular means and mode of operation described in the specification extends, by operation of law, to the equivalent of such means — not equivalent simply because the same result is thereby produced — but equivalent as being substantially the same device in structure, arrangement and mode of operation." (Burden vs. Corning, Fed. Cas., 2143. Gottfried vs. Philip Best Brewing Co., Fed. Cas., 5633.)

"An equivalent device is such as a mechanic of ordinary skill in construction of similar machinery, having the forms, specifications and machine before him, could substitute in the place of the mechanism described without the exercise of the inventive faculty."

(Burden vs. Corning, supra.)

"All the elements of the invention in this case are old, and the rule in such cases, as before explained, undoubtedly is that a Patentee can not invoke the doctrine of equivalents to suppress all other improvements of the old machine, but he is entitled to treat everyone as an infringer who makes, uses, or vends his patented improvement without and other change than the employment of a substitute for one of its elements, well known as such at the date of his intention, and which any constructor acquainted with the art will know how to employ. The reason for the qualification of the rule as stated is, that such change — that is, the mere substitution of a well-known element for another — where it appears that the substituted element was well known as a usual substitute for the element left out — is merely a formal one, and nothing letter than a colorable evasion of the patent." (Union Sugar Refining Co. vs. Matthieson, Fed. Cas., 14399.)

Counsel for defendant insists that, under Spanish law, none of the steps of the process described in the descriptive statement, save those mentioned in the "note" thereto attached are included in the patent, and that the patent rights secured thereunder are strictly limited to the precise language of the "note" attached to the descriptive statement; while counsel for plaintiff appears to think that the language of the patent covers any process or device whereby wood or cane may be bent or curved by the use of heat. But for the purpose of this decision it is not necessary to consider these questions, further than to hold, as we do, that under the doctrine of equivalents, the language of the note in the descriptive statement applies to the operation of applying heat for the purpose of curving handles for canes and umbrellas by means of a blast lamp fed with alcohol, as well as by means of a blast lamp fed with petroleum or mineral oil; and the defendant having admitted the fact that he applied heat for the purpose of curving handles for canes and umbrellas by means of a blast lamp fed with alcohol, he must be deemed to have infringed plaintiff's patent, and to have been guilty of a contempt in violating the terms of the injunction issued in the principal case, wherein plaintiff was declared the owner of the patent in question, and defendant enjoined from its infringement.

The argument of counsel for defendant and appellant, based on the theory that the questions herein discussed and decided have been heretofore settled by this court, and that the subject-matter of this proceeding is res adjudicata between the parties thereto is sufficiently refuted by the simple reading of the decision of this court in the case relied upon. (Gsell vs. Veloso, 7 Phil. Rep., 130.)

The judgment of the lower court should be and is hereby affirmed, with the costs of this instance against the appellant.

Arellano, C.J., Torres, Mapa, Willard and Tracey, JJ., concur.