

Syllabus.

was first taken at the subsequent hearing before a master, and was therefore held to have been waived.

In some later cases in the Circuit Courts of the United States it has been assumed that the defendant was bound to allege and prove that the patented articles were not marked, if he would, upon that ground, avoid liability for damages under the section in question. But in none of those cases was that point in judgment. In *Goodyear v. Allyn*, 6 Blatchford, 33, the only question before the court was of granting an injunction, a matter not touched by this section. In *Herring v. Gage*, 15 Blatchford, 124, the point decided was that the statute did not apply to the marking of the articles made and used by the infringing defendants. In *New York Pharmaceutical Association v. Tilden*, 21 Blatchford, 190, the answer alleged and the proof showed that the plaintiffs' goods were not marked, and the question was as to the sufficiency of a verbal notice to charge the defendants in damages. And in *Allen v. Deacon*, 10 Sawyer, 210, the want of marking was alleged and proved by the defendant, and he was also proved to have been duly notified of the infringement. On the other hand, in *McComb v. Brodie*, 1 Woods, 153, it was held that if the patentee did not prove that his articles were marked, or that he gave the defendant notice of the infringement, he could recover only nominal damages.

The patent having now expired, so that the injunction is of no further value, the decree is reversed and the case remanded to the Circuit Court with directions to

Dismiss the bill.

CARNE v. RUSS.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR
THE NORTHERN DISTRICT OF ILLINOIS.

No. 229. Argued and submitted January 25, 1894. — Decided March 5, 1894.

If, at the hearing of a bill in equity to redeem land worth more than \$5000 from incumbrances, the only controversy is as to less than that amount of incumbrances, no appeal lies to this court.

Opinion of the Court.

THE case is stated in the opinion.

Mr. George W. Smith for appellants.

Mr. Allan C. Story, for appellee, submitted on his brief.

MR. JUSTICE GRAY delivered the opinion of the court.

This was a bill in equity by Russ, as the owner of land in Chicago, worth more than \$40,000, against Ogden and others, to set aside and cancel, as creating a cloud upon his title, a tax deed to Ogden, and a certificate of tax sale procured by the other defendants as his agents.

The bill alleged that the taxes upon which the tax deed and certificate were issued were illegally levied and apportioned, and that the plaintiff had tendered to the defendants the full amount of the taxes paid by them.

The defendants answered, denying the plaintiff's title, the illegality of the taxes, and the tender of payment. But Ogden, in his answer, offered to waive his claim of title to the land and to reconvey it to the plaintiff, if the plaintiff would pay him the sums paid by him, with penalties accrued thereon and ten per cent interest. And the other defendants, in their answers, disclaimed all title in themselves.

At the hearing, the defendants contended that the sums which the plaintiff was in equity bound to pay them amounted to \$8705.34. But the Circuit Court held that those sums amounted to \$4291.84 only, and that the plaintiff, upon paying this amount, (which he forthwith paid into court,) was entitled to the relief prayed for, and entered a final decree in his favor. The defendants appealed to this court.

Upon the admissions of the answers, and upon the claims made by the defendants in the Circuit Court, and renewed in this court, it clearly appears that the plaintiff's title to the land was not really contested, but that the only matter in controversy was the amount of money which the plaintiff was equitably bound to pay to the defendants, and that the difference between the sum which the Circuit Court held him to pay and the highest sum claimed by the defendants was less

Statement of the Case.

than \$5000. The amount in controversy, therefore, is insufficient to support the appellate jurisdiction of this court. Act of February 16, 1875, c. 77, § 3; 18 Stat. 316; *Peyton v. Robertson*, 9 Wheat. 527; *Farmers' Bank of Alexandria v. Hooff*, 7 Pet. 168; *Ross v. Prentiss*, 3 How. 771; *Tintsman v. National Bank*, 100 U. S. 6.

Appeal dismissed.

 JOHNSON COMPANY *v.* WHARTON.

ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE
EASTERN DISTRICT OF PENNSYLVANIA.

No. 114. Argued November 24, 1893. — Decided March 5, 1894.

A judgment recovered in a Circuit Court of the United States in favor of the plaintiff by the owner of a patent right in an action against a licensee to recover royalties on sales of the patented article, where the sole defence set up was that the articles manufactured and sold by the defendant were not covered by the patent, in which the amount recovered was not sufficient to permit a review by this court, is a bar to an action in the same Circuit Court by the same plaintiff against the same defendant, to recover like royalties on other like sales where the same defence is set up, and no other, and the amount involved is sufficient to authorize a review here.

By written agreement executed November 24, 1885, between William Wharton, Jr., & Co., a limited partnership association, and the Johnson Steel Street Rail Company, a corporation — to be hereafter referred to as the Wharton and Johnson companies — the latter acquired the right to make and sell, upon certain conditions, guard rails constructed according to the specifications attached to letters patent granted to William Wharton, Jr., for an improved guard rail.

The present action was brought upon this agreement of license to recover the stipulated royalties or fees for guard rails sold and delivered by the Johnson Company between January 10, 1888, and June 4, 1889.

In its statement of demand the Wharton Company averred that the Johnson Company commenced and continued the sale of guard rails, and voluntarily rendered statements and paid