

Case No. 7,063.

IRISH v. KNAPP.

{5 Ban. & A. 47;<sup>1</sup> 18 O. G. 735.}

Circuit Court, E. D. Pennsylvania.

Dec. 20, 1879.

PATENTS—NOVELTY OF INVENTION.

The process of preparing and producing colored protographs on glass described and claimed in letters patent dated June 27th, 1876, numbered 179,316, granted to the complainant is, as an entirety, novel.

{This was a bill in equity by Benjamin T. Irish against T. Knapp.}

Strawbridge & Taylor, for complainant.

W. W. Weighley and S. E. Cavin, for defendant.

BUTLER, District Judge. This suit is for the infringement of letters patent No. 179,316, issued to the plaintiff, June 27th, 1876, for certain new and improved methods of making colored photographs on glass, described substantially as follows: Attach the unmounted photograph to a glass by means of paste. After the moisture has dried out, render the paper transparent by grinding down from the back till quite thin with emery-cloth, fine sand-paper, or the like; then place it in a bath of melted paraffine, or other similar substance. After a few minutes, remove it and rub off the surplus wax. After the print is thus rendered transparent, paint it on the back with oil-colors or touch up such parts as need it; then lay a second glass against the back of the picture and put oil-colors on its outer side, placing the various tints opposite such parts as may be proper. The colors on the back of the second glass being separated from the picture as described, it is asserted that greater smoothness and softness are thus obtained, and that while the application of paint directly to the paper requires the skill of an artist, the application of color by means of a second glass does not. The claim is in the following language: "What I claim, and desire to secure by letters patent, is: The process of preparing and producing colored photographs on glass by first mounting the photograph on glass, face downward, then grinding it thin from the back, and then treating it with paraffine or its equivalent, as specified, for the after reception of oil-colors, applied directly to the back of the picture, or to a second glass, to be applied as a backing, substantially as herein described."

While the description or specification seems to contemplate painting or touching up the back of the picture, and also the use of the second glass in all cases, and thus presents a single method of making colored photographs on glass, the claim, as I understand it, has a double aspect, and embraces two processes, the one terminating with the application of paint to the back of the picture and the other with the application of a second glass colored on the outer side.

The defendant does not deny the charge of infringement. The picture obtained from him and produced in evidence was made by the process which embraces the second

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glass. The defence is rested on the allegation that the plaintiff was not the first inventor or discoverer of this process. To prove the allegation, several witnesses were produced. A careful examination of their testimony has satisfied me that, although the plaintiff was not the first to discover and use the first of the processes embraced in the claim, as before indicated, he was the first to discover the second of these processes, embracing the use of an additional glass. The statements of Mr. Wentworth, Mr. Broadbent, and others leave no room to doubt that the process which is completed by the application of paint directly to the back of the picture did not originate with the plaintiff. The "ivory type," extensively manufactured many years prior to the date of the patent, was made according to this process, the paint being applied sometimes to the face and sometimes to the back of the picture.

As respects the process, however, which embraces the additional glass—the process here particularly involved—the defendant's allegation is not proved. The testimony of Mr. Loudner, invoked to sustain it, is not sufficient for the purpose. The witness is interested, and cannot, therefore, be supposed unwilling to tell all he knows, and yet when cross-examined and required to describe the process he used, being afforded the fairest and fullest opportunity to do so, he omitted the use of the second glass from his statement. When asked whether it was the same as that described in the Photographic Bulletin, and known as "Krauss's," in which the second glass was mentioned, he said it was "to the best of his knowledge,"

and “as near as he could recollect.” These expressions show that he had no certain recollection about it. The Photographic Bulletin, put in evidence, contains nothing of value. Its statements are not evidence. The description of this process, after the date of letters patent, and crediting the invention to another, is unimportant. That no photograph having the second glass, made prior to the date of this patent, was produced is a very significant fact. I feel no hesitation in saying that, as respects the process which involves the use of this glass, the claim is well founded, and the patent valid.

The suggestion that the second glass is of no value does not come with much force from one who has adopted its use. The facility it affords for applying color, and the smoothness and softness it imparts to the picture, leave no room for doubt on the question of value. I have passed upon the questions presented by counsel, and do not feel called upon to consider any other, if such might be raised upon the fact.

{Decree: And now, to wit, December 20, 1879, this cause having been heard upon pleadings and proofs and argument of counsel for the respective parties, it is ordered, adjudged, and decreed that letters patent of the United States No. 179,316, dated July 27, 1876, to Benjamin T. Irish, for an improvement in processes of preparing and producing colored photographs on glass, which process consists in applying to the back of a picture mounted upon glass a second glass, upon the back of which second glass, oil-colors are applied opposite such parts of the picture as may be desired, are good and valid to the extent of the process above described. That the title to said letters patent No. 179,316 is duly vested in said complainant, and that said letters patent are infringed by the said defendant, by reason of the use of said second glass having oil-colors placed on its back, said second glass having been placed at the back of the picture, as described and claimed in said letters patent. That the defendant, T. Knapp, his servants, workmen, agents, clerks, and attorneys, be perpetually enjoined, and restrained from making, using or vending any photographs having a second glass with oil-colors on its back applied to the back of photographs on glass, as described and claimed in said letters patent No. 179,316. That the complainant do recover of the defendant, T. Knapp, the profits and gains made and received by him in consequence of the infringement and violation of the exclusive rights of the complainant under said letters patent No. 179,316, dated July 27, 1876, together with the damages the said complainant has sustained thereby, together also with the costs of prosecution of this cause against said defendant]<sup>2</sup>

<sup>1</sup> [Reported by Hubert A. Banning, Esq., and Henry Arden, Esq., and here reprinted by permission.]

<sup>2</sup> [From 18 O. G. 735.]