

Case No. 7,487.

JONES V. OSGOOD ET AL.

[6 Blatchf. 435; 3 Fish. Pat. Cas. 591.]<sup>1</sup>

Circuit Court, S. D. New York.

June 4, 1869.

PATENTS—SPECIFICATIONS—DISTINCTION—INFRINGEMENT BY OFFICERS OF CORPORATION—INDIVIDUAL LIABILITY.

1. The specification of the letters patent granted to Samuel T. Jones, February 24th, 1852, for an “improvement in the manufacture of zinc white,” includes in its claim what is found in the English letters patent, No. 11,964, granted November 16th, 1847, specification sealed and enrolled May 16th, 1848, to William Edward Newton, for “improvements in the mode or modes of manufacturing or preparing certain matters to be employed as pigments.”
2. Although the Jones patent was extended by the commissioner of patents, on the 23d of February, 1866, and the question of its extension was vigorously contested before the patent office, yet, as the existence of the Newton patent was not then adverted to, and there never had been any trial, at law or in equity, on the Jones patent, in which the full bearing of the Newton patent on the invention of Jones had been thoroughly examined, this court refused to grant a provisional injunction restraining the infringement of the Jones patent.
3. The specification of the Jones patent does not properly distinguish, within the meaning of the sixth section of the act of July 4, 1836 (5 Stat. 119), what was invented by Jones from what is found in the Newton patent.
4. The defendants being three individuals, and the infringement committed by them having arisen solely out of their connection with a New Jersey corporation, and only one, O., of the three defendants being interested in the management of the corporation, at the time the motion for a provisional injunction was made, and no infringement having been committed out of New Jersey, where the manufactory of the corporation was situated, and O.’s only concern with the infringement being as a director of the corporation, and he being only one of several directors, and it not appearing that he could control the use, or direct the disuse, by the corporation, of the infringing apparatus, the motion was denied.
5. Whether, even if a majority of the directors of the corporation were parties defendant to the suit, the suit ought not to have been brought in New Jersey, where the corporation was located, and carried on its business, quere.

[This was a motion [by Martha M. Jones, administratrix of Samuel T. Jones, deceased] for a provisional injunction, to restrain defendants [Franklin Osgood and others] from infringing letters patent [No. 8,756] for “improvement in the manufacture of zinc white,” granted to Samuel T. Jones, February 24, 1852, extended by the commissioner of patents, February 23, 1866, for seven years from February 24, 1866, but declared by act of congress, approved July 3, 1868 [15 Stat. 15], to be duly extended for seven years from July 23, 1864, the date of the expiration of an English patent granted to the inventor for the same invention. The alleged infringement consisted in the manufacture of zinc by the Bartlett Zinc Company, a corporation doing business in the state of New Jersey, where, if anywhere, the alleged infringement took place. Defendant Osgood was president and one

of several directors of said company, and was the only one of the defendants, at the time of the hearing, connected with or interested in the management of the corporation.

{The claim of the complainant's patent was as follows: "What I claim as my invention, and desire to secure by letters patent, is the use of a porous or fibrous bag or receiving chamber, with porous sides or bottom, or an air-tight chamber with a straining or porous bag adapted to the inside thereof, and used in connection with either a blowing or exhausting apparatus, so that the products of the distillation and oxygenation of zinc or other volatile metals may be separated from the accompanying air and gases, which latter will be forced or otherwise drawn through the pores of the cloth bag or chamber, and escape into the atmosphere."

{The claims of Newton's English patent were as follows: "First. The distillation of metallic zinc, or of oxide of zinc, or of zinc ore, by any of the means above-mentioned. Second. The application of furnaces similar to glass furnaces, reverberatory furnaces, and coke ovens, as above described, and the modifications of them respectively, in order to fit them for the purpose of manufacturing zinc white. Third. The novel construction of furnace for this purpose, above described, and shown in sheet III of the accompanying drawings. Fourth. I claim isolating the retorts from each other, and also cutting off the communication between the retorts and the oxidizing chamber, when required, whatever means may be employed to effect that object. I do not confine myself to the apparatus shown for the purpose, as I have done so merely for the purpose of illustration. Fifth. The employment of suitable apparatus for cleansing the mouths of the retorts, without being obliged to enter the oxidizing chamber. Sixth. The arrangement of apparatus shown and described, or any modification thereof, by which the retorts may be charged, cleaned, and replaced, or submitted to any operation required, without interfering with the oxidizing chamber. Seventh. The application or employment of blast furnaces for the production or manufacture of

zinc white or oxide of zinc, whether such furnaces are circular or of any other suitable form, and whether they are constructed and arranged in a vertical, inclined, or horizontal position. Eighth. The employment or introduction of currents of air into an oxidizing or other chamber, for the purpose of converting the metallic vapors of zinc into zinc white or oxide of zinc; also, the employment of an exhausting tube or blowing apparatus for conducting the metallic vapors to the oxidizing chamber, as above shown and described. I claim, also, the employment of wire gauze or sieves for sifting the products; also, the arrangement of vessels for receiving the heaviest portion of the products. Ninth. The arrangement of the oxidizing chambers so as to allow of the products being collected from them without the necessity of entering the said chambers. Having now described all that relates to the manufacture and manner of collecting zinc white, I will proceed to an explanation of that part of the invention which relates to the other colors, viz: yellow of zinc and green of zinc. Zinc yellow—As the manufacture of this substance forms the subject of a previous patent, I will merely remark that hydrochloric acid may be used, instead of sulphuric acid. Zinc green—Yellow having been produced by the patented process, is diluted with a suitable quantity of water, and mixed with a certain quantity of Prussian blue (previously mixed with a suitable quantity of water, oil, or other appropriate liquid) either in a hot or cold state. Green of zinc will thus be formed, the color of which will be as durable as the blue itself. The above substances may be employed for painting of any kind, or for any other purposes for which white lead or other pigments are usually employed.”<sup>2</sup>

C. A. Seward, C. M. Keller, E. W. Stoughton, and Geo. Gifford, for complainants.

A. J. Todd, T. C. T. Buckley, E. Pierrepont, and B. R. Curtis, for defendants.

BLATCHFORD, District Judge. Various interesting questions were discussed on this motion, but, in the view I take of the case, it is unnecessary to refer to many of them, as there is one ground that is fatal to the motion. The specification of the patent is, I think, so broad as to include what is found in the prior patent, granted in England, November 16th, 1847, No. 11,964, and the specification of which was sealed and enrolled May 16th, 1848, to William Edward Newton, for “improvements in the mode or modes of manufacturing or preparing certain matters to be employed as pigments.” The question of the extension of the Jones patent was vigorously contested before the patent office, but the existence of the Newton patent does not seem to have been adverted to. There never has been any trial, at law or in equity, on the Jones patent, in which the full bearing of what is found in the Newton patent on the invention of Jones has been thoroughly examined. The question, as between those patents, is now presented to me in the unsatisfactory form of ex parte affidavits, on both sides, without the benefit of a sifting of the testimony by cross-examination. From the most careful examination which I have been able to give to those affidavits, in connection with, the specification of the Jones patent, I cannot resist

the conclusion, that that specification, as now drawn, covers, in its claim, things which are found in the Newton patent. The specification is, also, open to the kindred objection, that it does not properly distinguish, within the meaning of the 6th section of the act of July 4, 1836 (5 Stat. 119), what was invented by Jones from what is found in the Newton patent. I by no means intend to say that there is not, in what Jones really invented, something which may lawfully be patented, by a properly drawn specification, even in view of what is found in the Newton patent.

Independently of the foregoing views, I should hesitate long before granting a provisional injunction in this case. It is shown that whatever infringement has been or is being committed by any of the three defendants on the plaintiff's patent, has arisen solely out of their connection with a New Jersey corporation, called the Bartlett Zinc Company, of which the defendant Osgood is president and a director, and of which the defendants Bartlett and Reid are not directors, although Bartlett has heretofore, and, perhaps, since the commencement of this suit been a director of it, and Reid was a director of it prior to the commencement of this suit, and is now secretary of it. The defendant Osgood is shown to be the only one of the defendants who is now connected with, or interested in, the management of the corporation. No infringement has been committed out of the state of New Jersey, where the manufactory of the corporation is situated. The patent is for the use of a certain apparatus in the collection of the products of the distillation or oxygenation of zinc and other volatile metals. It does not cover the use or sale of such products, when collected. Osgood's only concern with the infringement is as a, director of the corporation, and he is only one of several directors. It does not appear that he can control the use, or direct the disuse, of the apparatus by the corporation. The intendment would be to the contrary, as he is but one of several directors. It cannot fairly be said that the apparatus used by the corporation, in New Jersey, is used under the direction, management, and superintendence of Osgood, within the meaning of the case of *Goodyear v. Phelps* [Case No. 5,581]. It ought to appear that Osgood has power alone to direct the use or the disuse of the apparatus, or, at least, a majority of the directors ought to be parties to the suit. And even then, it would

be questionable whether the suit ought not to be brought in New Jersey, where the corporation is located, and carries on its business. *Goodyear v. Chaffee* [Id. 5,564]. The motion for an injunction is denied.

<sup>1</sup> [Reported by Hon. Samuel Blatchford, District Judge, and by Samuel S. Fisher, Esq., and here compiled and reprinted by permission. The syllabus and opinion are from 6 Blatchf. 435, and the statement is from 3 Fish. Pat. Cas. 591.]

<sup>2</sup> [From 3 Fish. Pat. Cas. 591.].