SIEMENS-LUNGREN CO. *v.* HATCH *et al.*

(*Circuit Court, D. Massachusetts.* July 24, 1891.)

PATENTS FOR INVENTIONS—INFRINGEMENT—PRELIMINARY INJUNCTION.

Where, on motion for a preliminary injunction to restrain infringement, it is necessary for the patentee to show that he made the invention some years before he applied for a patent, in order to meet the charge of anticipation, the finding of the examiner of interferences to the effect that the patentee did make the invention at the earlier date is not sufficient proof of the fact to warrant issuing the injunction when the evidence on which the examiner based his finding is not preserved.

In Equity.

J. R. Bennett and *W. B. H. Dowse*, for complainant.

J. L. S. Roberts, for respondents.

CARPENTER, J. This is a motion for an interlocutory injunction to restrain the respondents from infringing letters patent No. 282,337, granted July 31, 1883, to Andrew P. Lipsey, for gas-burner; and No. 299,660, granted June 3, 1884, to Andrew P. Lipsey, for gas-burner. Several questions arise on the affidavits, which I do not find it necessary to decide, because, in my view, the present motion must be disposed of on a single consideration, which is as follows: It is admitted that the patents in suit are anticipated by patents to Christian Westphal, in the German empire, May 9, 1882, and numbered 21,809; and in France, March 2, 1882, and numbered 147,691,—unless the court shall find that the invention of Lipsey was made at a certain time earlier than the date of his application for a patent. The complainant for proof of this point relies on the affidavit of Lipsey and on the finding of the examiner of interferences in an interference between the application for letters patent No. 299,660, and the application of J. Gardner Sanderson, upon which letters patent were granted to said Sanderson, January 29, 1884,—No. 292,766. The affidavit of Lipsey uses only these words: "I completed the inventions which are the subject of those patents in March, 1881, having first conceived of them as early as July, 1877." The finding of the examiner is that "upon the testimony adduced in behalf of Lipsey, it appears that he conceived of this improvement in March, 1881, and immediately made sketches illustrating the arrangement and disposition of parts in his proposed lamp." Either of the dates here given would, it appears, be sufficiently early to negative the claim of anticipation. It is undoubtedly true, as the respondent contends, that the decision of the examiner is by no means entitled to the weight which would be given to a final adjudication by a court of justice, but I am not disposed to say that it should be entirely disregarded. It is a final decision of a tribunal competent to hear and decide the question of priority of invention, and such a decision might in some cases be entitled to much weight. But not even a decision of a court would be conclusive; and still more must this decision be scrutinized in order to see whether the ground and manner of the decision are such that this court may with a good conscience take the finding as establishing the facts therein set forth. I

think the decision does not stand this test. I do not mean that the decision appears to me to be wrong,—in fact I think it altogether probable that it is right; but it does not present the facts in such a way that I can clearly see that it is right. The drawings made by Lipsey in 1881 are not presented, nor are they described, except in the most general terms; and I have no means of judging whether, as the examiner says, they "correspond in all material respects with the drawings filed with the application, and exhibit a mature conception of the invention as presented in the application, and of the other means by which it is now proposed to carry the same into practice." And while the examiner fixes the date of the making of the drawings "upon the testimony adduced," he makes no further statement as to the character and amount of the testimony. Here, then, at the very essential point in dispute, the examiner gives only his conclusion, without setting out the grounds on which it is based. Such an opinion is doubtless entirely sufficient for the purpose for which it was prepared, but it furnishes no sufficient basis for a finding such as I am asked to make. The affidavit of Lipsey, not to mention that he puts the conception of his invention several years earlier than does the examiner, is but a bare allegation that he conceived the inventions here patented at a certain time. In order that I may be satisfied that he is right, I must see the thing which he then invented, so that I may judge whether it be the thing here patented. The infringement seems to be clearly made out, and in this state of the case the complainant insists that there should be an injunction, even if there be doubt on the other issues here raised; and he cites *Manufacturing Co.* v. *Deering*, 20 Fed. Rep. 795; *Foster* v. *Crossin*, 23 Fed. Rep. 400; *Hat-Sweat Manuf'g Co.* v. *Davis Sewing-Mach. Co.*, 32 Fed. Rep. 401. I think these cases support the proposition that the case for an injunction need not necessarily be made out in any of the methods commonly used in patent cases, as by showing a judicial decision or public acquiescence. But, on the other hand, they apply and enforce the general doctrine which controls the exercise of the equitable jurisdiction in the granting an interlocutory injunction, namely, that the court must on the whole case be well satisfied that the bill can be maintained. When, as in this case, the evidence fails to satisfy the court on one essential point, the whole contention of the complainant must fail. The motion must be dismissed.

COSTON *v.* PAIN *et al.*

(*Circuit Court, S. D. New York.* July 7, 1891.)

PATENTS FOR INVENTIONS—PATENTABLE INVENTION—PYROTECHNIC SIGNAL.

The first claim of letters patent No. 237,092, issued February 1, 1881, to William F. Coston, for a pyrotechnic signal, having one or more colored lights arranged to burn and be exhibited from the hand, or at the surface, with one or more aerial signal lights arranged to be thrown into the air, and exhibited while aloft, is void for want of patentable invention.

In Equity.

Walter K. Griffin, for plaintiff.

Francis Forbes, for defendant Pain.

Walter D. Edmonds, for defendants C. H. Mallory & Co.

SHIPMAN, J. This is a bill in equity which is based upon the alleged infringement of letters patent No. 237,092, dated February 1, 1881, to William F. Coston, assignor to the plaintiff, for an improved pyrotechnic signal. The specification says that—

"The invention consists in the combination of one or more colored lights, arranged to be exhibited or burned on the vessel's deck or from the ground, with one or more colored stars, to be shot up into the air and burned while aloft,"

—And also in the novel construction of divers parts of the mechanism of the signal. The claims are six in number. The first, which is the only one said to have been infringed, is as follows:

"(1) A pyrotechnic signal, having one or more colored lights arranged to burn and be exhibited from the hand or at the surface, with one or more aerial signal lights, arranged to be thrown into the air and exhibited while aloft."

The patentee in his specification defines the term "colored light" as follows:

"It will be understood that by the term 'colored light' is meant a light which presents a positive color other than and different from the light which is produced by the burning of the mealed powder, niter, etc., ordinarily used in Roman candles, and similar pyrotechnics."

The other claims are for various mechanical parts of the signal, which were not infringed. The defendant Pain's signal is an infringement of the first claim. Various defenses were interposed, but I shall consider only the patentability of the first claim, in view of the state of the art at the date of the invention. For many years, Coston's pyrotechnic stationary night signals had been extensively used at the life-saving stations of this country, and on board lines of ocean steamers. The signal is partially described in letters patent No. 23,529, dated April 5, 1859, to G. A. Lilliendahl, assignor to the plaintiff, and No. 115,935, dated June 13, 1871, to the plaintiff. It was, in general terms, a firework, to be held in the hand, and to be burned on the vessel's deck, and consisted in the combination of one or more colored lights, which were successively ignited. The "positive color" which is spoken of in