

HARMON *et al.* v. STRUTHERS *et al.*

(Circuit Court, W. D. Pennsylvania. November 20, 1891.)

## PATENTS FOR INVENTIONS—INFRINGEMENT—RES JUDICATA—EFFECT OF INTERLOCUTORY DECREE.

In a suit for infringement of letters patent there was a decree for plaintiffs, awarding an injunction, and for an account, and a reference to a master. The defendants quit using the device so held to infringe, substituting a different device, which was openly used by other persons, and as to which there had been no adjudication. Then, pending the reference before the master, the plaintiffs brought a new suit in the same court, against the same defendants. The answer therein not only denied infringement, but alleged that one G., and not the patentee, was the original and first inventor of the patented device, which defense was not set up in the first suit. *Held*, that the decree was interlocutory, and did not, in the second suit, preclude inquiry into the validity of the patent.

In Equity. Suit for infringement of patent. Heard upon exceptions to answer. Exceptions overruled.

*W. Bakewell & Sons*, for exceptions.

*D. F. Patterson* and *James C. Boyce*, for defendants.

ACHESON, J. This bill, which is for the infringement of letters patent for an invention, after the usual recitals and averments, recites a previous suit in equity by the plaintiffs against the defendants, in this court, for the infringement of the same patent, in which there was a decree, in the ordinary form, in favor of the plaintiffs, awarding an injunction, and for an account, and a reference to a master to take the account. 43 Fed. Rep. 437. In their answer to the present bill the defendants state that, upon the decision of the court, they abandoned the use of the device held to infringe the patent, and that they are now using a different device, which they particularly describe, and which they deny is an infringement. The answer also alleges that the patented improvement was not the invention of the patentee, but, in fact, was invented by George H. Gibbs, who put the device in public use by sales more than two years before the date of the application for the patent sued on. The plaintiffs contend that the defendants are estopped by the proceedings in the former suit from questioning the validity of the letters patent, and they seek to narrow the issue to the single question whether the device now used by the defendants infringes the patent.

Two facts are here to be noted: *First*, the other case is still pending before the master under the order of reference; *second*, the defense that George H. Gibbs was the original and first inventor of the patented device was not set up or considered in the former suit. It is to be added that it sufficiently appears to us that the particular device involved in the present suit is openly used by other manufacturers besides the defendants; and there has been no adjudication affecting the right of the public to use the same, nor has the question been raised until now. Are the defendants, then, here shut up to the single issue of infringement? It cannot be maintained that the present is a continuation of the earlier suit. It is an independent suit in form and substance. Nor

is it material that both suits are in the same court. Being distinct proceedings, no greater effect is here to be given to the former decree than if it had been made in another court. Neither is it a matter of any moment that, heretofore, for satisfactory reasons, we refused the defendants a rehearing in the first case, for the refusal did not make the decree any more conclusive than it was before. According to the language of all the authorities, to conclude the parties the former judgment or decree must have been final. Now we find, in the opinion of the supreme court in *Beebe v. Russell*, 19 How. 283, 285, a final decree thus explained:

“When a decree finally decides and disposes of the whole merits of the cause, and reserves no further questions or directions for the future judgment of the court, so that it will not be necessary to bring the cause again before the court for its final decision, it is a final decree.”

Adopting this definition, Judge NIXON held, in *Chemical Works v. Hecker*, 2 Ban. & A. 351, that a decree in another circuit in a suit in equity between the same parties upon the same patent, declaring three claims void for want of novelty, but sustaining one claim, and adjudging the defendant to have infringed it, and ordering an account of the profits realized, was interlocutory merely, and did not so conclude the parties as to prevent an inquiry into the validity of the claims of the patent. It has been expressly ruled by the supreme court that a decree in a patent cause, such as the plaintiffs here rely on, is not a final decree from which an appeal will lie. *Barnard v. Gibson*, 7 How. 650; *Humiston v. Stainthorpe*, 2 Wall. 106. Again: Certainly the court might open such a decree, at a subsequent term, for a rehearing, upon additional proofs; but a final decree cannot be so opened at a subsequent term, and set aside or modified. *McMicken v. Perin*, 18 How. 507; *Bronson v. Schulten*, 104 U. S. 410. Once more: In *Fourniquet v. Perkins*, 16 How. 82, the circuit court had made a decree that the plaintiffs were entitled to certain property, and referred the matter to a master, to take and report an account, but at a subsequent term after the coming in of the master's report, upon exceptions thereto, reversed its previous decree, and dismissed the bill. The supreme court held that the former decree upon the merits was interlocutory, and open to revision, and under the control of the court at the final hearing, upon the exceptions to the master's report. Applying the principle of the decisions cited to this case, we have no difficulty in holding that our decree in the other suit is interlocutory, and does not here operate as an estoppel precluding inquiry into the validity of the patent. Our conclusion is by no means inconsistent with the ruling in *Thomson v. Wooster*, 114 U. S. 104, 5 Sup. Ct. Rep. 788, for that case merely decides that, while a decree *pro confesso* establishing the validity of a patent stands unrevoked, the defendant cannot question the validity of the patent before the master appointed to state an account, nor on appeal set up anything to impeach the decree except what appears on the face of the bill.

The exceptions to the answer are overruled.

**FALK v. GAST LITHOGRAPH & ENGRAVING Co., Limited.**

(Circuit Court, S. D. New York. November 30, 1891.)

**1. COPYRIGHT—INFRINGEMENT—NOTICE OF COPYRIGHT—PHOTOGRAPHS.**

In an action for the infringement of a copyright for a photograph, in order to sustain the defense that the copy which defendant reproduced was without the statutory notice of copyright, it is not sufficient that it was without the statutory notice when it came into defendant's possession, but it must be shown that it lacked such notice when it left plaintiff's possession.

**2. SAME—PUBLICATION—DELAY.**

A delay of the publication of a photograph for two months and eighteen days after the title was filed with the librarian of congress, as required by the copyright law, is not unreasonable.

**3. SAME—FOR WHAT ALLOWED—PHOTOGRAPHS.**

The facts that a photographer arranged the light, background, and other details for a photograph, and posed the subject so as to produce an artistic and pleasing picture, are sufficient to sustain a copyright for such photograph.

In Equity. On final hearing.

Bill for injunction by Benjamin J. Falk against the Gast Lithograph & Engraving Company, Limited. For opinion on motion for preliminary injunction, see 40 Fed. Rep. 168.

*Isaac N. Falk and Rowland Cox*, for complainant.

*William B. Ellison and Charles C. Gill*, for defendant.

COXE, J. This is an equity action to enjoin the infringement of a copyright for a photograph of Julia Marlowe. The photograph was taken by the complainant and copyrighted by him as proprietor. It is admitted that the photograph was copied by the defendant. The following are the principal defenses: *First*. The complainant failed to inscribe upon each copy of the photograph in question the notice required by law, the photograph copied by the defendant being without such notice. *Second*. The proof is insufficient of the mailing or delivery at the office of the librarian of congress of two copies of the photograph as required by sections 4956 and 4959 of the Revised Statutes. *Third*. The complainant lost his right to a copyright by unreasonably delaying the publication of the photograph. *Fourth*. The photograph in question is not the proper subject of a copyright, and the complainant has failed to show any title thereto as proprietor.

The testimony relating to the first defense should be scrutinized with unusual care, for the reason that the value of copyrights will be greatly impaired if such defenses are encouraged. It will be observed that the photograph from which the defendant copied the infringing device, the solar print which was subsequently colored by its artist and the negative of the solar print have all been lost or destroyed. The assertion that the photograph in question was without the statutory notice came from two witnesses who testified from memory only, after the lapse of a year, during which time they had examined hundreds of similar photographs. Moreover, their testimony does not agree, and the principal witness for the defendant has given two conflicting versions of the manner in which