

below, which was the usual one sustaining the patent, finding infringement, and directing an injunction and accounting, was neither a final decree, nor an appealable interlocutory decree under section 7. It was held, however, that the court had jurisdiction under section 7, and that the complainant, by submitting the cause on its merits, had waived his right to object to a full determination of the controversy, and could not thereafter question the jurisdiction on a motion for rehearing. The court, nevertheless, modified its former decree, so as merely to remand the cause, and direct that the injunction be dismissed.

In the mean time the case of *Richmond v. Atwood*, 5 U. S. App. 1, 1 C. C. A. 144, 48 Fed. Rep. 910, had been decided in the first circuit, and there again the case was apparently considered on its merits without question. The decree, however, was merely to the effect that "the complainant is not entitled to an injunction, and the decree of the circuit court is accordingly reversed." Thereafter a petition for a rehearing was filed, and on the hearing thereof the court itself raised the question as to the extent of its jurisdiction, and as to the form of its mandate, to wit, whether it should simply order that the decree for an injunction be reversed, or should direct that the bill be dismissed. Briefs were filed on this question, and, after full consideration, the court held substantially as follows:

(1) That a decree which is rendered after a full hearing on the merits, and which sustains the validity of the patent, declares infringement, and awards a perpetual injunction and an accounting, is an "interlocutory decree" granting an injunction, from which an appeal will lie under section 7.

(2) That the term "interlocutory order or decree" was used in its broadest sense in section 7, and should be given full scope, to the end that a party aggrieved by an order or decree granting an injunction at any stage of the proceedings may have a speedy remedy by appeal.

(3) That, on such an appeal in a patent case, where the whole record is before the circuit court of appeals, and, in order to determine the rightfulness of the injunction, the court necessarily examines the whole case on its merits, and reaches the conclusion that there is no infringement, it may not only reverse the decree, and dissolve the injunction, but may also vacate the order for an accounting, and order the bill dismissed; thus rendering such a decree as the lower court should have rendered on the whole case.

The most recent case involving this question is that of *Columbus Watch Co. v. Robbins*, 52 Fed. Rep. 387, decided in the sixth circuit. There the decree below was the same as in the *Munger and Atwood Cases*, and the parties to the appeal joined in an application to the court to hear and finally determine the cause on its merits. The court held, however, that it could not take jurisdiction, even by consent, of the whole controversy; that the appeal only brought up for review that part of the interlocutory decree relating to the injunction, that all other parts of the decree—such as those relating to the validity of the patent, its infringement, and the questions that may arise on the accounting ordered to ascertain damages and profits—had not yet left the jurisdiction of the trial court; and that the only question presented for determination was whether the decree for an infringement was providently granted, in the legal discretion of the trial court, which question involved only incidentally the question of the validity of the patent, and the infringement complained of. In its opinion the court referred to the first decision in the *Atwood Case* and to both decisions in the *Munger Case*. It considered that the last decision in the *Munger Case* indicated an opinion that the court had full jurisdiction on the merits, and, in view of this difference between the two circuits, certified the question to the supreme court for decision, under section 6 of the act creating the circuit court of appeals. This important question is thus in a fair way to be soon settled by ultimate authority.

## EAGLE PENCIL CO. v. AMERICAN LEAD PENCIL CO.

(Circuit Court, S. D. New York. December 17, 1892.)

### 1. DESIGN PATENTS—INVENTION—PEN CASES.

Design patent No. 20,156, issued September 16, 1890, to Charles W. Boman for a fountain pen case, having a milled handle and a plain cap, both rounded at the ends, with a bead around the handle at the end of the cap, is void for want of invention.

**2. SAME—PEN TIPS.**

Design patent No. 20,157, issued September 23, 1890, to Charles W. Boman for a pen tip, consisting of two cylinders of different sizes, with a beveled connection between them, and a bead around the smaller one near the bevel, and an abrupt flare at the end of it, is void for want of invention.

**3. SAME—PEN CASES.**

Design patent No. 20,158, issued to Charles W. Boman for a pen case, consisting substantially of the handle of his patent No. 20,156, made plain instead of milled, and the pen tip of his patent No. 20,157, brought together, is void for want of invention.

In Equity. Suit by the Eagle Pencil Company against the American Lead Pencil Company for infringement of certain design patents. Bill dismissed.

Samuel A. Duncan and Robert H. Duncan, for plaintiff.  
Edmund Wetmore, for defendant.

WHEELER, District Judge. This suit is brought upon three design patents granted to Charles W. Boman, assignor to the plaintiff, —No. 20,156, dated September 16, 1890, for a fountain pen case; No. 20,157, dated September 23, 1890, for a pen tip; and No. 20,158, dated September 23, 1890, for a pen case. The design of the first is of a milled handle and a plain cap, both rounded at the ends, with a bead around the handle at the end of the cap. That of the second is of two cylinders of different sizes, with a beveled connection between them, and a bead around the smaller one near the bevel, and an abrupt flare at the other end of it. That of the third is really the handle of the first, plain, and the tip of the second, brought together.

Pen cases of various materials consisting of a handle and a cap, caps and handles having rounded ends, milled handles, beads around handles to stop the caps, and around cylinders for ornament, pen tips of cylinders of different sizes, and pen tips with flares at the end, were all old. What Boman really accomplished as to the first patent was to bring a milled handle and a plain cap together in a fountain pen case. What he accomplished as to the second was to put an abrupt flare to the end of a pen tip of two cylinders of different sizes. And what he accomplished as to the third was to make the handle of his first plain, and bring to it the tip of his second. These changes produced things not exactly known before, and in that sense new, but they seem to have been due more to good taste than inventive skill, and really too slight to sustain either patent. *Atlantic Works v. Brady*, 107 U. S. 192, 2 Sup. Ct. Rep. 225.

Let a decree be entered dismissing the bill, with costs.

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BROWER v. BOULTON et al.

(Circuit Court, S. D. New York. December 17, 1892.)

**1. TRADE-MARKS—VALIDITY—REGISTRATION.**

Plaintiff's predecessors in business, good will, and trade-marks used the words "La Venezolana" on five shipments of flour in 1873, three in 1885, one in 1886, several in 1887, 1888, 1889, and 1890. Plaintiff used them on similar shipments thereafter, and caused same to be registered as a trade-mark No-