

uses, and whether the defendants are within or without the boundaries, will have to be decided upon the hearing. It is sufficient now to say that, in my opinion, the defendants are upon debatable ground.

My conclusion is that this is a case for an order requiring the defendants to give bond in the sum of \$10,000 to the complainants for the payment of any profits or damages that may be decreed against them; and an order will be made also requiring them to keep an account of their manufactures and sales, to be produced when called for by the court.

The motion for a preliminary injunction is overruled, with leave to renew it if the bond above provided for be not furnished within 20 days from the date of the entry.

MACBETH et al. v. GILLINDER et al.

(Circuit Court, E. D. Pennsylvania. May 10, 1889.)

No. 6.

1. PATENTS FOR INVENTIONS—COMITY BETWEEN CIRCUIT COURTS.

A circuit court will not disregard a decision by another circuit court sustaining a patent, and declaring infringement, unless fully convinced that such decision is erroneous, and the existence of a grave doubt as to the soundness thereof is not sufficient warrant for refusing to follow it.

2. SAME—VALIDITY—DESIGNS FOR LAMP CHIMNEYS.

Letters patent No. 14,373, issued October 30, 1883, to George A. Macbeth, as assignee of Henry Dietrich, for a design for lamp chimneys, consisting in what is called the "pearl top," are valid.

3. SAME—ABANDONMENT—INFRINGEMENT.

It is not an infringement of this patent to make or sell a lamp chimney with a so-called "prism top," as the original application included such a top, which was stricken out at the suggestion of the patent office, and the patentee, by accepting his patent, with this amendment, waived his claim to such design as effectually as if he had filed a disclaimer thereof, upon the suggestion of the patent office.

4. SAME.

The fact that the patentee subsequently applied for and received another patent for what is claimed to be virtually the same design would not affect the force of the estoppel against him under the former patent; for, if it was the same design, the new patent merely added force to the implication that it was not included in the old one, and, if it was not the same design, the taking of the new patent was a renewal of the assertion that this design was open to the public.

In Equity. Bill by Macbeth and others against Gillinder and others for infringement of a design patent. Decree for complainants.

James I. Kay, Francis T. Chambers, and George H. Christy, for plaintiffs.

George Harding and George J. Harding, for defendants.

BUTLER, District Judge. The suit is for infringing letters patent No. 14,373—"Designs for Lamp Chimneys"—granted to George A. Macbeth, assignee of Henry Dietrich, October 30, 1883. This patent was involved in a suit by the same plaintiffs against Evans & Co.,¹

¹ No opinion rendered.

in the circuit court at Pittsburgh, No. 19, November term, 1884. It was there held to be valid; and a crimp-top chimney, such as that manufactured by the defendants, and here involved, was held to be an infringement. Unless, therefore, we disregard that decision the bill must be sustained, and the defendants held responsible to this extent. We cannot disregard it, unless fully convinced that it is erroneous. The importance of uniformity of decisions in courts of co-ordinate jurisdiction and authority, is such that even grave doubt respecting the soundness of a particular decision is not a sufficient warrant for disregarding it. The proper remedy, where such doubt exists, is by appeal. To courts of last resort this rule does not apply with equal force. The controlling effect of their decisions on all inferior tribunals within their jurisdiction, secures uniformity. We listened to an earnest and very able argument, intended to convince us that the decision at Pittsburgh is erroneous. We have patiently and fully considered what was urged; but we are not convinced. We must therefore follow *Macbeth v. Evans*.

Nothing remains but to determine whether the defendants' "prism-top" chimney, is an infringement. When the case was before us on motion for preliminary injunction, we were not satisfied it was an infringement, and we therefore refused to include it in the writ issued. When application for the patent was originally made the patentee claimed not only the "pearl top," but also two other designs, one of which was substantially, if not absolutely, identical with the defendants' "prism top"—as appears by the drawings filed. He was informed by the office that these several designs could not be embraced in the letters applied for; whereupon he amended the application, withdrawing therefrom everything except the pearl top,—illustrated by the figures accompanying the patent. In view of these facts he cannot now be permitted to claim that the letters cover the top in question. If it were proved, as he asserts, that the patent might, in the absence of these facts, be construed to embrace it—that the office was mistaken, and he was misled—the result would be the same. He cannot be permitted to turn round after obtaining a patent on the only terms upon which the office would grant it, and after declaring by his conduct, and language as emphatic as he could employ, that this top is not embraced, hold those who have engaged in its manufacture, guilty of infringement. He is estopped by the circumstances under which the patent was obtained. The case cannot be distinguished in principle, from those in which a patentee at the instance of the office, or to avoid some obstacle in his way, disclaims a part of his original demand. Here, as there, the part yielded and abandoned, cannot subsequently be set up as protected by the patent. The argument based on the fact that the language of the claim was not changed, has little force. The patentee having agreed to omit this top, and obtaining his patent by this means, the claim must be read accordingly, even though this may limit the scope to which it otherwise would be entitled.

We attach little importance to his subsequent conduct in applying for and taking the "Macbeth patent." If it is virtually for the same top as that withdrawn from the former patent, his conduct in taking

it was a repetition of his declaration that this top was not embraced in the former patent; but this could add nothing to the force and effect of what preceded it. The record of the office was a continuing declaration to the public that this design was not embraced in the patent under consideration. If the "Macbeth patent" is not, as the plaintiff asserts, for the prism top, the effect of his former conduct is not weakened, but rather strengthened by taking this patent; for in such case it not only was at the time, but continues to be an assertion that the manufacture of this top is open to all who may choose to engage in it. A decree will be entered in accordance with this opinion.

MACBETH et al. v. GILLINDER et al.

(Circuit Court, E. D. Pennsylvania. November 17, 1891.)

No. 6.

1. **DESIGNED PATENTS—INFRINGEMENT.**

In determining whether a design patent is infringed, the test is whether the alleged infringing article presents to the eye of an ordinary purchaser the same appearance as the patented article.

2. **SAME—DESIGNS FOR LAMP CHIMNEYS.**

Letters patent No. 14,373, issued October 30, 1883, to George A. Macbeth, for a design for lamp chimneys, consisting of a so-called "pearl top," are infringed by one who manufactures or sells a lamp chimney presenting the same appearance to the eye of an ordinary purchaser; and it is immaterial whether such appearance was caused intentionally, or by the worn condition of the tools by which they are made, as claimed by defendants.

In Equity. Bill by Macbeth and others against Gillinder and others, constituting the firm of Gillinder & Sons, for infringement of letters patent No. 14,373, granted October 30, 1883, to George A. Macbeth, as assignee of Henry Dietrichs, for designs for lamp chimneys. The patent was heretofore sustained, and an injunction granted. 54 Fed. Rep. 169. The cause is now heard on motion for an attachment for violating the injunction. Referred to a master to ascertain the facts.

James I. Kay, Francis T. Chambers, and George H. Christy, for plaintiffs.

George Harding and George J. Harding, for defendants.

BUTLER, District Judge. Have the respondents disregarded the injunction? The decree of the court limited the patent to chimney tops with circular or flared mouth, "having a beading, or similar ornamentation, raised above," so as to present a pearl-like appearance—which the complainants call a "pearl top." The reasons for this limitation are stated in the opinion filed. The only feature of the case, as then presented, which called for extended remark, was that arising from the complainants' effort to extend the patent so as to cover the respondents' "prism top." The validity of the patent, and its infringement by the manufacture or sale of the "small pearl top," before the court, had been settled in a former suit. We had no occasion, therefore, to remark upon