

KERRY et al. v. TOUPIN.

(Circuit Court, D. Massachusetts. March 1, 1894.)

No. 3,179.

1. TRADE-MARKS—RIGHT TO—ALIENS.

Citizens of Canada, who are engaged in the manufacture of trade-marked articles, and who have a place of business in the state of New York, where they make and ship such articles for sale in the United States, are within the international convention of March 20, 1883, for the protection of industrial property; and they may sue in the United States courts for the infringement of their trade-marks by its citizens.

2. SAME—WHAT CONSTITUTES—INFRINGEMENT.

Complainants manufactured a medicinal compound under the name of "Syrup of Red Spruce Gum;" and for some 20 years or more that name was placed conspicuously on the package in which the compound was sold, and in connection therewith appeared a cut of an Indian against a background of spruce trees and a waterfall. *Held*, that the adoption and continuous use of this distinctive name and device entitle complainants to claim it as a trade-mark, and to be protected against its infringement by persons making similar goods.

In Equity. On final hearing. Bill by John Kerry and others against Hercule A. Toupin to restrain the infringement of complainants' trade-mark. Decree for complainants.

Edward S. Beach, for complainants.

John J. Hogan and William A. Hogan, for defendant.

ALDRICH, District Judge. This cause came on for hearing upon bill, answer, and proofs. In 1860 Henry R. Gray originated a medicinal preparation, to which he gave the fanciful name of "Syrup of Red Spruce Gum." The compound composed several ingredients, but the oleo-resin of the spruce was the leading medicinal feature. It is not necessary to consider the character of the preparation, further than to find that it was an original and artificial composition of several natural products, and a useful remedy in throat and lung troubles. The originator proceeded at once to manufacture and place such preparation before the public. It was put up in four-sided, oblong bottles, wrapped in blue wrappers, on which appeared, in conspicuous type, the trade-name, "Syrup of Red Spruce Gum," and in connection therewith the figure of an Indian, with a background of spruce trees and a waterfall. There was proper registration of such name and mark at Ottawa in 1872, and at Washington in 1874. Between 1860 and 1875, the originator used this name and mark continuously, and expended several thousand dollars in advertising and establishing the name and a trade. In 1875 he assigned all his rights to Kerry, Watson & Co., of Montreal, to which the complainants have succeeded. Since 1875 the complainants have used the name, mark, and wrapper continuously, and have expended, as the evidence shows, something like \$7,000 annually in advertising. They have a manufactory and place of business in Montreal, and for about 15 years have had a place of business at Rouse's Point, N. Y., where they manufacture and ship to various points in the United States. The complainants' annual

output is something like 1,000 gross in Canada, and 500 gross in the United States; and the evidence shows that the preparation has merit, and an established reputation in the markets.

The complainants, in this proceeding, do not now rely on the registration for relief, but urge the certificates as evidence of the adoption of the name, mark, and wrapper. Neither do they ask to be protected in a monopoly of their product, but against the use by the defendant of their trade name and mark under circumstances which shall induce the public to buy another preparation, supposing it to be the "Syrup of Red Spruce Gum" placed in the market by the complainants; and to this extent, I think, they are entitled to protection. The complainants, citizens of Canada, having an industrial or commercial establishment in the state of New York, would seem to be within the third and eighth articles of the international convention of March 20, 1883, in which Great Britain joined, for the protection of industrial property. As translated, (*La Republique Francaise v. Schultz*, 57 Fed. 37, 40,) the treaty covers trade-marks, commercial marks, and commercial names, as well. The complainants' name, "Syrup of Red Spruce Gum," adopted and continued in the manner shown, is a trade-name, and the device embodying the name and the cut, as printed on the blue wrapper, has become a distinctive mark in the trade, as applied to their cough mixture, and as such is entitled to protection. *Improved Fig Syrup Co. v. California Fig Syrup Co.*, 4 C. C. A. 264, 54 Fed. 175, 7 U. S. App. 588.

The defendant has adopted a bottle so similar in shape, and a wrapper so similar in color, with a combination of words, including the name, "Syrup of Red Spruce Gum," conspicuously displayed, with a border and cut so like the complainants' in general appearance, as to compel the conclusion that the purpose was to trade on the complainants' reputation, and the notoriety created by a long and continuous use of their distinctive marks and name. That the defendant has changed the wrapper somewhat in detail does not relieve him. He has studiously preserved a catching general appearance, well calculated to deceive the trade, and induce the public to buy his preparation, supposing it to be the preparation known as the "Syrup of Red Spruce Gum" which the complainants and their grantor have continued in the markets for 30 years or more. The complainants are entitled to an injunction in accordance with these views, and to an accounting, and it is so ordered.

RICHARDSON et al. v. SHEPARD et al.
(Circuit Court, D. Massachusetts. March 9, 1894.)

No. 3,100.

1. PATENTS FOR INVENTIONS—ANTICIPATION—HOOKS AND EYES.

Letters patent No. 411,857, granted October 1, 1889, to Frank E. De Long, were for an improvement in the ordinary hook for garments, consisting in the addition of a spring tongue placed intermediate between the side bars of the hook, its free end forming a loop coincident

with the bend of the hook; the tongue itself being bowed out towards the forward part of the hook, so that it will engage the eye, when fastened, and hold it in place. *Held*, that this was not anticipated by patent No. 195,825, granted October 2, 1877, to Joel Jenkins, for a safety pin whose guard has an "obstruction" to prevent the point of the pin being withdrawn from the guard by accident; for such obstruction has no spring, and is not displaced by inserting and removing the pin, as the tongue in De Long's patent is, where the hook engages the eye.

2. SAME.

Nor is De Long's device anticipated by English patent No. 8,068, granted in 1839 to John H. Rodgers, for a hook with a spring-bowed tongue to perform the same function as De Long's; for the Rodgers tongue does not form a loop coincident with the bend of the hook, and, in operation, its free end tends to abrade the garment, and to become so much displaced as to prevent the eye being withdrawn from the hook at all.

In Equity. On final hearing. Bill by Thomas De Q. Richardson and others against John Shepard and others for the infringement of complainants' patent. Decree for complainants.

Fish, Richardson & Storrow, Strawbridge & Taylor, and Bradbury Bedell, for complainants.

Thomas Ewing, Jr., for defendants.

COLT, Circuit Judge. This is a bill in equity brought for infringement of letters patent No. 411,857, granted October 1, 1889, to Frank E. De Long, for an improvement in hooks or fastenings for garments. The improvement of De Long over the ordinary hook consists in the addition of a spring-bowed tongue, placed intermediate between the side bars of the hook, and which forms a loop coincident with the bend of the hook. The specification says:

"Between the front and rear portions of the hook, and secured to a proper part thereof, is a spring tongue, B, which occupies part of the space between said portions, and is bowed or swelled outwardly so as to approach the front portion. * * * It will be seen that when an eye, loop, or ring is presented to the hook, and drawn between the front and rear portions thereof, it bears against the tongue, and rides over the same, forcing it backward so that said eye, etc., or ring is permitted to pass to the bend, D, the tongue then closing or returning to its normal position, and serving to retain the eye, etc., on the hook; it being noticed that the tongue prevents the return or displacement of the eye, etc., from the hook."

The single claim of the patent is as follows:

"A hook comprised of a hook proper and a shank formed of substantially parallel bars, and a tongue having its free end forming a loop coincident with the bend of the hook; said tongue and loop being intermediate of said side bars, substantially as described."

The only defense urged at the hearing was the invalidity of the patent, in the light of the prior state of the art. Of the many patents introduced in evidence as anticipating the De Long invention, I deem it necessary to consider only two,—the English patent No. 8,068, granted to John H. Rodgers, in 1839, and patent No. 195,825, granted to Joel Jenkins October 2, 1877. The Rodgers hook has a yielding resilient, humped tongue, and to this extent is similar to the De Long structure; but the end of the tongue, in this hook, is not carried around the bend of the hook. There are

two defects in the Rodgers hook: First, the end of the tongue, when the eye is inserted in the hook, is pressed down below the plane of the shank of the hook, and, coming in contact with the fabric, tends to abrade it; and, second, in inserting the eye in the hook, the spring tongue may become bent or displaced, in which case the eye, in attempting to unhook it, may pass behind or under the end of the tongue, and so prevent the disengagement of the eye from the hook. This hook was not a commercial success. The Jenkins patent is for a safety pin. The guard, which is integral with the wire of the pin, is composed of a series of convolutions lying close together, and forming a flat surface or bearing. This surface is then bent over, making a recess with two parallel, flat sides, within which the point of the pin is received, and protected by the upper and lower surface of the guard. The specification then declares:

"To prevent the point of the pin from being withdrawn from the guard, a, by accident, a small obstruction, c, is formed in the under surface of the guard, by bending one or more of the convolutions."

This obstruction offers no obstacle to the free insertion of the pin within the guard, but affords just enough resistance to its being withdrawn therefrom to hinder accidental displacement. The language of the Jenkins patent, and an inspection of the pin made in accordance therewith, show that the "small obstruction" in the guard of the pin does not perform the same function, and is in no proper sense the resilient, spring tongue of the De Long hook. It has no appreciable spring movement. It is not depressed when the point of the pin is inserted, and it does not spring back, thereby holding the point of the pin within the recess. The change in structure from Rodgers to De Long may seem slight, and, now that we see it, simple; but this is no sufficient reason for denying invention or patentability, where a beneficial change, embodying a new and better mode of operation, has been produced. It must also be remembered that numerous patents on hooks were taken out between the invention of Rodgers, in 1839, and of De Long, in 1889, and that it did not occur to any one engaged in developing this branch of the art to make the change which is found in the De Long device. This circumstance strongly tends to prove that such a modification of the Rodgers pin would not be obvious to one skilled in the art, and that, therefore, it called for the exercise of the inventive faculty. If we add to this the further circumstance that most of these prior efforts were failures, and that none of them met with more than moderate success, and contrast this with the great utility, extensive public use, and marked commercial success of the De Long hook, I think these considerations are sufficient to resolve any doubt on the question of patentability in favor of the patentee. Washburn & Moen Manuf'g Co. v. Grinnell Wire Co., 24 Fed. 23; Manufacturing Co. v. Haish, 4 Fed. 900; Reiter v. Jones & Laughlin, 35 Fed. 421; Wilcox v. Bookwalter, 31 Fed. 224; Hitchcock v. Tremaine, 9 Blatchf. 550, Fed. Cas. No. 6,540; Watson v. Stevens, 2 C. C. A. 500, 51 Fed. 757; Loom Co. v. Higgins, 105 U. S. 580; Consolidated Safety-Valve Co. v. Crosby, etc., Valve Co., 113

U. S. 158, 5 Sup. Ct. 513; *Magowan v. Packing Co.*, 141 U. S. 332, 12 Sup. Ct. 71; *The Barbed-Wire Patent*, 143 U. S. 275, 12 Sup. Ct. 443, 450.

Decree for complainants.

DAVIS ELECTRICAL WORKS et al. v. EDISON ELECTRIC LIGHT CO. et al.

(Circuit Court of Appeals, First Circuit. February 9, 1894.)

No. 83.

PATENTS—INFRINGEMENT—REPAIR AND RECONSTRUCTION—ELECTRIC LAMPS.

It is reconstruction, and not merely repairing, to make a hole in the bulb of an Edison incandescent electric lamp, (patent No. 223,898,) in which the carbon filament has been destroyed by use, and put in a new filament having its ends inserted in platinum sleeves, close the hole by fusing a piece of glass over it, and then exhaust the air. 58 Fed. 878, affirmed.

Appeal from the Circuit Court of the United States for the District of Massachusetts.

This was a bill in equity brought by the Edison Electric Light Company and the Edison General Electric Company to enjoin the Davis Electrical Works, Leonard L. Davis, and Charles F. Wittemore from infringing the Edison incandescent electric lamp patent No. 223,898, issued January 27, 1880. A preliminary injunction was granted below, (58 Fed. 878,) and defendants appeal to this court under the seventh section of the judiciary act of March 3, 1891. The matter complained of was that defendants were engaged in replacing the carbon filament of Edison lamps, after the original filament had been destroyed by use. This, complainants alleged, was a reconstruction of the lamp, amounting to infringement of the patent; while defendants claimed that it was mere repairing, which they were entitled to perform. The process, as described by the court below, was as follows: "The defendants first break off the tip of the glass bulb of the lamp, and ream out a hole about one-half inch in diameter. The broken filament is then removed. The new filament, having its ends cemented into platinum sleeves, is then inserted into the glass chamber, the sleeves being pushed down over the two platinum leading-in wires, and compressed upon them. A tube of glass, made into the shape of a tunnel, is heated, and placed over the hole in the lamp chamber. This tube is fused into the open end of the bulb, which brings it into the condition of the ordinary lamp bulb just prior to exhaustion. The air is then exhausted, and the bulb sealed."

John L. S. Roberts and John Lowell, for appellants.

F. P. Fish, Richard N. Dyer, and W. K. Richardson, for appellees.

Before PUTNAM, Circuit Judge, and NELSON and WEBB, District Judges.

PUTNAM, Circuit Judge. In this case the circuit court, on the 13th day of December, 1893, entered an order for a preliminary injunction, and for a writ of injunction to issue accordingly. From that order the defendants below, in accordance with the seventh section of the act establishing this court, took an appeal, which came on to be heard on the 18th day of January, 1894. It does not appear that a supersedeas was obtained or asked for.

A preliminary question was made at the bar touching the nature