WELSBACH LIGHT CO. v. BENEDICT & BURNHAM MANUF'G CO.

(Circuit Court, D. Connecticut. October 9, 1897.)

1. PATENTS—PRELIMINARY INJUNCTION—ACQUIESCENCE.
   General acquiescence in the validity of a patent is not of so much weight on the question of a preliminary injunction, when the patent is of a subordinate character, so that there has been little temptation to infringe until after it is supposed that the principal patent is no longer in force.
2. SAME—DOUBTFUL PATENTS—CLEAR INFRINGEMENT.
   The rule that, when infringement is clear, and the injury to complainant by refusing the injunction will be greater than the injury to defendant by granting it, some doubts as to the validity of the patent should be resolved in its favor, is not of great force when the alleged invention is of a subordinate or comparatively unimportant character, and the court has very serious doubts on the question of invention.
3. SAME—INCANDESCENT GAS LAMPS.
   The Welsbach patent, No. 409,530, for an improved incandescent gas lamp, designed to be used with the Welsbach incandescent hood, *held* invalid, on motion for preliminary injunction, as to claim 3, which is for a combination with a Bunsen burner of a shield suspended around the air inlets thereof, and as to claim 5, which is for a gas burner and a chimney support or gallery with a vertically adjustable rod supported by the gallery, and an incandescent hood suspended from the rod.

This was a suit in equity by the Welsbach Light Company against the Benedict & Burnham Manufacturing Company for alleged infringement of the Welsbach patent for an improved incandescent gas lamp. The cause was heard on a motion for a preliminary injunction.

John K. Beach and John R. Bennett, for complainant.
A. M. Wooster and M. B. Philipp, for defendant.

SHIPMAN, Circuit Judge. This is a motion for a preliminary injunction against the further infringement by the defendant of claims 3, 5, and 6 of letters patent No. 409,530, dated August 20, 1889, issued to Carl Auer Von Welsbach, assignor to the complainant, for an improved incandescent gas lamp. In 1885, the patentee had patented in England the well-known Welsbach hood or mantle, which was also subsequently patented in this country, and which was styled in his English patent "an illuminant appliance in the form of a cap or hood, to be rendered incandescent by gas and other burners, so as to enhance their illuminating powers." This invention underwent a most thorough investigation in the English courts, the patent was sustained, and the invention was declared by Mr. Justice Wills to have accomplished "what has long been a desideratum, what has been attempted before, but always with an utter want of success, and it was for the first time brought within the range of practical manufacture the production of a brilliant light by incandescence within an ordinary gas flame." The lamp which is the subject of the patent in suit was designed to hold and to heat this hood, and is, in its details, exceedingly well adapted to bring the Welsbach illuminant into successful use in houses, and also in places of business; but the patent was not limited to the use of any particular hood or mantle. Its claims to patentability are therefore liable to be disputed by pre-existing lamps which were made for the purpose of raising to incandescence some

other refractory material by means of a gas flame; and it appears from the "file wrapper and its contents" that this was fully understood by the inventor when the application was making its way through the patent office. The patent has never before been the subject of litigation. The Welsbach system of lighting has had great success in this country. Over two millions of lamps made under this patent have been sold, and neither patent was seriously infringed until the spring of 1897. About that time it was rumored that the hood or mantle patent had expired by reason of the expiration of a Spanish patent for the same invention, and forthwith infringement of each patent commenced. Suits for infringement of the hood patent are now pending in the Southern district of New York.

It is strongly urged that the public has admitted the validity of the patent in suit, and that the complainant's rightful possession of an exclusive right to make the brass part of the Welsbach lamp has been clearly acknowledged. It must be recollected that the Welsbach system consists of the brass lamp and the hood; that the latter is the important member of the system, and gives to it its success; that the brass part of the lamp is for the purpose of making the hood operative; and that, so long as the validity of the hood patent was admitted, there was little or no reason for an attempt to infringe the patent in suit. Acquiescence in the validity of this patent has not, therefore, the importance that it generally has, and which it had in the early and well-known case of Sargent v. Seagrave, 2 Curt. 553, Fed. Cas. No. 12,365. I am therefore compelled to examine the patent by the light which has been thrown upon it by the affidavits and the other papers which were presented upon the hearing of the motion. The patent contains six claims, which are as follows:

"(1) The combination of a burner tube, provided with a cap having a vertically projecting cone, 13, surrounded by an inner annular series of perforations, 14, and an outer annular series of radiating slots, 15, a hood of refractory incandescent material suspended above said burner cap, and a chimney surrounding said hood, substantially as described.

"(2) The combination, with a burner tube, 5, and gallery, 8, having lugs, 23, and set screws, 24, located on a laterally extended portion of the gallery body, of the chimney, 19, the hood, 20, and the vertically adjustable rods, 21 and 22, substantially as described.

"(3) The combination of a vertically perforated thimble having a gas inlet, a perforated disk supported by said thimble, a Bunsen burner having lateral air inlets, and a shield located around the burner air inlets, substantially as described.

"(4) The combination of a Bunsen burner having lateral air inlets, a ring shrunk onto the burner tube above the air inlets, and a shield suspended from said ring and surrounding the air inlets of the burner, substantially as described.

"(5) The combination, with a gas burner and a chimney gallery, of a vertically adjustable rod supported by the gallery, and an incandescing hood suspended from said rod above the burner, substantially as described.

"(6) The combination, with a gas burner, a chimney, and an incandescing hood suspended in said chimney, of a gallery having converging ribs, 8a, arranged at intervals, substantially as described."

The defendant's burner does not have the vertically projecting cone, 13, of claim 1, nor the vertically adjustable rods, 21 and 23, of claim 2, and its shield is not suspended as required in claim 4. It does plainly infringe claims 3, 5, and 6, and the question upon this motion

is whether the validity of those claims can be so clearly ascertained that an injunction ought to issue. Claim 3 is the one of importance. It relates to the parts of the gas burner which produce the necessary smokeless and almost nonluminous hot flame. The patentee used, as is stated in the claims, the Bunsen burner, which had been for many years before the date of his invention a well-known form of gas burner for heating purposes, and which is said to have been invented by the chemist Bunsen. In this burner, gas and air are permitted to enter through different orifices or openings into the same tube or mixing chamber, where the mingling takes place; and when the gas is ignited it has become thoroughly mixed with the air, so that "all parts of the flame are supplied with sufficient oxygen to insure the immediate combustion of the carbon." The same general system of independent orifices for the admission of air and gas into a mixing chamber is used in most of the lamps for heating refractory material to incandescence. Claim 3 names four elements, as follows: (1) A vertically perforated thimble, having a gas inlet. This thimble is threaded for attachment to the gas fixture. (2) A perforated disk, secured to the upper end of the thimble, "to divide the gas supply into jets, and facilitate the mixture with the supply of air." (3) A Bunsen tube, having lateral air inlets. (4) A shield located around the air inlets, which the specification says may be used "if desired." This shield also has air inlets in a casing around the inlets of the burner tube, so that the supply of air can be regulated and modified. Divers earlier patents were introduced by the defendant to show either that these various elements were well known, and had been in some way combined before, or else were in such common use that their combination was not a patentable one, but I have directed my attention to what is disclosed in the proceedings in the patent office, in the specification, and in the patent to Charles Clamond, No. 282,053, dated July 31, 1883, to which reference was made by the patent office. The patentee, on October 15, 1888, asked for the allowance of the following, as claim 3:

"The combination, with a Bunsen burner having lateral air inlets, of the shield, 6a, suspended around said burner air inlets, substantially as described."

The existing claims 3 and 4 were claims 4 and 5 in this application. The office rejected claim 3, as applied for, by reason of the Clamond patent, and rejected claims 4 and 5 because they were modifications of the same general construction of burner. The applicant canceled claim 3, "though it is not believed to be met by the patent to Clamond cited, but to facilitate allowance of the remaining claims"; and said of claims 4 and 5 that the former covers "a combination including a shield located around the burner air inlets, while the latter is for a combination embracing a ring shrunk into the burner tube above the air inlets, and a shield suspended from said ring, and surrounding the air inlets of the burner." The claims as they now stand were then allowed. Thus the rejection of a claim for a Bunsen burner and a shield around the air inlets was acquiesced in, and the present claim 3 was allowed, because it included the combination of a Bunsen burner, shield, thimble, and perforated disk. The question is whether the claim describes anything more than a Bunsen burner plus a shield;

or, in other words, whether the combination as claimed contained anything which is not a part of a Bunsen burner when in actual use. The apparent contention of the complainant is that the perforated disk, which is a very thin plate, and contains three minute holes, is an addition to, or is such a modification of, the ordinary Bunsen burner that it can be considered a distinct member of the combination, and that this improvement is valuable. The specification says "that the number and size of the perforations in the disk * * * can be varied as required according to the quality of the gas." It says also that "it is advantageous to cause the combustible gas used for the burner to issue through a hole or holes in a very thin sheet-metal plate, such as the perforated disk, 2, and not through a plate of from one to one and one-half millimeter in thickness, as in the ordinary Bunsen burner." It thus appears that neither the size nor the number of the perforations was regarded as of patentable importance. It furthermore appears that a perforated plate, or some other contracted orifice for the transmission of gas, was a part of an ordinary Bunsen burner, and that a thin plate was regarded as preferable to the one in general use, but that a thin plate was not designated, either in the specification or in the claims, as a part of the patented invention. After reading the specification, and the history of the patent upon its journey through the patent office, claim 3 seems to me to have been an attempt to magnify the combination of one of the common forms of an old burner and a shield into a novel combination of several elements, and thus to be patentable.

Claim 5 is for a combination of a gas burner, not necessarily a Bunsen burner, and a chimney support or gallery with a vertically adjustable rod supported by the gallery, and an incandescing hood suspended from the rod. When this very simple means of suspending the hood is looked at in the complainant's lamp, there seems to be nothing of an inventive character in the combination.

Claim 6 is for a chimney gallery or support having converging ribs, in combination with a gas burner, chimney, and incandescing hood suspended in the chimney. The important part of this combination, as appears from the specification, is the converging ribs of the chimney gallery. This is a matter of mechanical detail, which is not material, and which can, apparently, be changed without difficulty; and I should not think it worth while to issue an injunction in the present stage of this case merely for an infringement of this claim.

The complainant pressed its equities for an injunction by reason of the deliberate conduct of the defendant in entering into a contract to make the brass portion of the Welsbach lamp with notice of the complainant's possession of a patent, and after it had made these lamps for the complainant for eight or nine years; and presented the proposition that, when infringement is clear, some doubts should be resolved in favor of the patent, especially when injury to the complainant by a refusal will be greater than the injury to the defendant will be by granting the injunction. The force of these propositions in a case proper for their application is acknowledged, but their applicability depends upon the strength of the doubts. For example, the hood patent, which is the most important part of the Welsbach sys-

tem, has been respected in this country for many years, and the unique character of the invention, and its importance as a great aid to domestic comfort, have been universally recognized. Upon a motion for a preliminary injunction against the infringement of the patent in this country, even if there had been no adjudication in England, a court would naturally think that doubts in regard to validity were overborne by the weight of the considerations which have been mentioned. But this patent has not that distinctive kind of character, and, while I know that the issuance of an injunction would be a serious advantage to the complainant in its efforts to protect its business and prevent an onslaught upon it, yet, when I have so serious doubts as I have in regard to the validity of the contested claims of the patent, I do not think that I ought to enjoin against their infringement. Such an interference with the business of one manufacturer, in order to strengthen the position of another, pending an attack upon the validity of its patent, though it is being attacked by its old friends, seems to me an undue stretch of the power of a court of equity. The motion is denied.

THE R. R. RHODES.

THE R. R. RHODES v. FAY.

(Circuit Court of Appeals, Sixth Circuit. October 5, 1897.)

No. 453.

1. SALVAGE—AMOUNT OF COMPENSATION—REVIEW ON APPEAL.
   The allowance of salvage is an act involving judicial discretion, and the award will not be set aside as too large unless so excessive as to shock the conscience of the appellate court.
2. SAME.
   An award of $3,500 to a Lake steamer, worth, with her cargo, $40,000, for drawing off with some danger to herself another steamer, worth about $70,000, from rocks upon which she had gone fast, and was in a very dangerous position, *held* not excessive; the salving steamer having been detained about 16 hours on her voyage.
3. SAME—ELEMENTS DETERMINING COMPENSATION—SUBSEQUENT STORM.
   In a suit for salvage for rescuing a stranded vessel from a reef where she would have been in great danger in a storm, evidence that a severe storm did in fact occur within a short time after the rescue is not entirely irrelevant, as it illustrates the imperative necessity the stranded vessel was in of losing no time in getting of.
4. SAME—CONTRACT FOR SERVICE.
   A mere request for aid made by the master of a vessel in distress to the master of another vessel does not prevent the service rendered from being a salvage service, or reduce the claim merely to one for services rendered under a contract.

Appeal from the District Court of the United States for the Western District of Michigan.

On the night of Saturday, the 11th of August, 1894, about 11 o'clock, the steamer R. R. Rhodes, laden with a cargo of 1,827 tons of iron ore, while going at her full speed of 9½ miles an hour, ran upon a rocky reef off the north end of the South Fox Island, in Lake Michigan. She remained fast, and at her bow drew 15 inches of water less than before she was stranded. Her keel

and planking were so injured that, after she was towed into Chicago, it cost over $4,000 to repair them. The reef was from three-quarters of a mile to two miles from shore, and the navigation in its vicinity was dangerous, because, while the water was deep enough in places, there were many bowlders on the bottom, ranging from those of a small size to others of many feet in circumference. As soon as the master ascertained her condition, he got an anchor out lakeward to prevent the steamer from drifting further on to the rocks and the shore, and the crew was immediately set to work jettisoning the cargo. On Sunday morning, the 12th of August, the mate was sent in a small boat to the nearest point of land, whence, by a sailing vessel, chartered for the purpose, he proceeded to Northport, 28 miles distant, where he telegraphed for the assistance of a wrecking steamer at Mackinac, 100 miles distant. About 3 o'clock on Sunday afternoon, the steamer Westcott, bound from Escanaba to Elk Rapids, sighted the Rhodes 8 miles away, changed her course, and, running towards her, discovered her condition. The master of the Rhodes, who had signaled the Westcott as she came nearer, requested her to render assistance. The Rhodes had no towlines, and the Westcott used a comparatively new one of her own, 9 inches in thickness and 700 feet in length. The Westcott stopped about 1,000 feet distant from the Rhodes. The Rhodes' master then came out in a small boat, and persuaded the master of the Westcott that she might safely approach the Rhodes, and that there was water enough on the starboard side of the Rhodes to permit her to go alongside. For two hours the Westcott attempted to swing the Rhodes off the rocks by the use of the towline, but did not succeed. She then went alongside the Rhodes, and sent aboard the Rhodes half her crew to assist in lightering. This was necessary, because the crew of the Rhodes were very tired from the hard labor of the previous night and day. After about 100 tons had been lightered, the Westcott again gave the Rhodes the towline, and, after two hours of hard work, succeeded in pulling or swinging her off the reef. The Rhodes kept her machinery moving. When the Rhodes had been pulled from the reef, it was discovered that she had broken off the buckets or blades of her screw, leaving nothing but a round hub, with which she was able to make no progress through the water. In her helpless condition, it became necessary for the Westcott to tow her from the reef to Northport, 28 miles away. The work of pulling the Rhodes off the reef and towing her to Northport delayed the Westcott in reaching her destination at Elk Rapids about 16 hours. The Westcott was a vessel 187 feet long, 32 feet beam, and having a cargo at the time of this occurrence of about 750 tons of iron ore, and worth, hull and cargo, $40,000. She drew a little more than 14 feet. The draft of the Rhodes was 15 feet 2 inches forward, and 15 feet 5 inches aft. She was 50 or 60 feet on the reef, about amidships. The lake was calm at the time of the stranding, but the air was filled with smoke from forest fires; and though it cleared sufficiently to enable the Westcott to see the Rhodes on the afternoon of Sunday, the 12th, the air continued smoky until Northport was reached, on Monday morning, about 8 o'clock. The place where the Rhodes ran aground was off the usual course of steamers some 3 or 4 miles. It was near the middle passage frequented only by steamers going across Lake Michigan from Escanaba to Elk Rapids, and was out of view of the passage through which the great majority of the Lake steamers passed. The men upon the Rhodes had descried a steamer of the Anchor Line a little earlier in the afternoon, some three or four miles away, which failed to hear, or, at all events, failed to respond to, the Rhodes' signals of distress. On Tuesday morning, a northwest wind, reaching the proportions of a gale, came up, which probably would have rendered the Rhodes a total loss had she still been upon the reef. It was contended by the counsel for the Rhodes that the reason why more vessels were not seen from Saturday night, after she stranded, until Sunday afternoon, was because the smoke prevented, and not because the vessels were not frequently passing within a reasonable distance of the reef. After the Rhodes reached Northport, she was towed by the Marquette from Northport to Chicago, the Marquette delaying the trip until after the gale of Tuesday abated. The towline of the Westcott was very much weakened and its value much lessened by the strain to which it was necessary to subject it in jerking the Rhodes off the reef. There was no written opinion delivered by Judge Severens, who heard the case in the district court, but he entered a decree in favor

of J. J. Fay, Jr., for salvage of $3,500. The estimates of the value of the Rhodes varied from $60,000 to $85,000 and upward. It is suggested by counsel that the court below fixed the value at $70,000, and the salvage at 5 per cent. thereof.

Harvey D. Goulder (S. H. Holding, of counsel), for appellant.

C. E. Kremer, for appellee.

Before TAFT and LURTON, Circuit Judges, and SAGE, District Judge.

TAFT, Circuit Judge (after stating the facts). We do not think that we ought to disturb the decree of the district court in this case. The action of the court in allowing salvage is one involving judicial discretion, and an appellate court will not set aside the result of the exercise of that discretion by the trial court unless it has been manifestly abused,—unless, as Chief Justice Marshall expresses it, in The Sybil, 4 Wheat. 98, the award of the district court is so grossly excessive as to shock the conscience of the appellate court. The Comanche, 8 Wall. 448; Hobart v. Drogan, 10 Pet. 108; The Phœnix, 8 U. S. App. 626, 10 C. C. A. 506, and 62 Fed. 487; The Connemara, 108 U. S. 359, 2 Sup. Ct. 754; The Florence, 38 U. S. App. 32, 18 C. C. A. 240, and 71 Fed. 527. The only point for discussion in the case, therefore, is whether the allowance by the court below was grossly excessive, and not whether, if we had been sitting in the trial court, we would have fixed a somewhat less amount.

There was ample evidence to justify the court in finding that the situation of the Rhodes was perilous. The record does not disclose the exact length of the Rhodes, but it is apparent that considerably less than one-third of the vessel was grounded upon the reef, and that this was about amidships. The witnesses for the libelant testify that she was hogged or bent so that her bow and stern sagged below her middle. Whether this be true or not, it is certain that, as she lay there, a heavy wind from the northwest would have destroyed her. It is also apparent that, in the thick and smoky condition of the atmosphere, the prospect of being relieved by other vessels was by no means bright. It is true that a telegram had been sent to a point 100 miles away for the wrecking steamer, but this could not have been done until the afternoon of Sunday, and it does not appear whether such a steamer was to be had. With all the effort which was made by the crews of both vessels to lighter the Rhodes, they succeeded in throwing overboard but 100 tons of the ore in something less than 24 hours. It is not at all clear that, if they had been dependent upon getting the steamer off by lightering her, they would have succeeded in doing so before Tuesday's storm was upon them. It is true that it was in a season of the year in which storms were not usual; but it is also true that storms sometimes occurred at that season, as the storm of Tuesday abundantly proved, and that they are not so exceptional at that time as to justify excluding them from a mariner's calculation when their occurrence would have been so disastrous as in this case. It is to be noted that it did not need a dangerous storm to imperil the hull and cargo of the Rhodes in her then condition. It needed only a heavy wind, as the captain of the

Rhodes, in his evidence, fully admits. So much for the peril which the Rhodes was in.

The Rhodes was upon a dangerous reef. Navigation in that vicinity by the Westcott, loaded with iron ore, drawing 14 feet, backing, maneuvering, and running ahead at full speed, as she was obliged to in order to accomplish the release of the Rhodes, was not by any means free from danger to herself. We think it very probable that nothing but the prospect of a substantial reward would have induced the captain of the Westcott to run the risks which he certainly did run in going to the relief of the Rhodes. The Westcott and her cargo were worth about $40,000. The presence of the bowlders upon the bottom of the lake and on and about the reef is abundantly established by the evidence. It also appears that in her maneuvers the Westcott actually did touch bottom several times, if the testimony of two or three of her witnesses is to be credited. In this state of the record, while we might, perhaps, have fixed a lower amount were this the original hearing, we are clearly of opinion that in the hearing upon appeal we should not do so. It is suggested that the amount allowed as salvage to the Westcott is nearly or quite as much as the profits she would have earned in an entire season. This may be true, but we do not see why this circumstance should change the allowance if, as the court must have found, in order to earn this salvage, she put herself and her cargo in jeopardy.

An exception was taken to the libel in its mention of the storm which took place on Tuesday. We think this exception was not well taken. It was conceded that the condition of the Rhodes would have been practically hopeless had the storm found her on the reef, and the reference to it in the libel and the consideration of it by the court were justified as illustrating the very imperative necessity she was under of losing no time in getting out of her predicament. Such a storm was considered in The Neto and Cargo, 15 Fed. 819, and was thought not to be of particular weight in the case of The Emulous, 1 Sumn. 207, Fed. Cas. No. 4,480; but we do not understand that the court held in the latter case that the evidence was entirely irrelevant. The storm certainly showed that such a change in the weather was not impossible at that season.

The main ingredients to assist the court in determining the amount of salvage are stated by the supreme court of the United States, speaking by Justice Clifford, in the case of The Blackwall, 10 Wall. 1, 14, as follows:

> (1) The labor expended by the salvors in rendering the salvage service. (2) The promptitude, skill, and energy displayed in rendering the service and saving the property. (3) The value of the property employed by the salvors in rendering the service, and the danger to which such property was exposed. (4) The risk incurred by the salvors in securing the property from the impending peril. (5) The value of the property saved. (6) The degree of danger from which the property was rescued.

Having due regard to such of these factors as were present in this case, we cannot find the allowance excessive.

Something has been said by counsel in argument and in the brief indicating a desire to have this court establish a rule for fixing sal-

vage upon the Lakes different from that which obtains upon the high seas; and reference was made to a decision by Judge Baxter, in Mattingly v. Cotton, 2 Flip. 288, Fed. Cas. No. 9,294, in which he points out the great differences between cases of salvage upon the Western rivers and those upon the high seas. The difference recognized is a mere absence from cases of salvage on the rivers of some of the factors which increase the amount of the salvage on the high seas. It is quite certain that the dangers of salvors upon the Lakes are more like the dangers upon the high seas than those upon the Western rivers; but we do not think it profitable to attempt to lay down any general rule distinguishing salvage upon the Lakes from that on the high seas. Each case must be determined by its own circumstances. In the present case we hold that the court might reasonably have found impending peril for the steamer salved, and real danger to the steamer and cargo of the salvor, and that the amount allowed by the court below was not so manifestly excessive as to justify us in disturbing it.

Another point made by the counsel for the appellant is that there was a contract for services made between the captain of the Rhodes and the captain of the Westcott, and that this should not be treated as a salvage case, but only as a suit for services upon a contract. The evidence does not bear out this claim. The language upon which it is based was the mere request for aid by the captain of the stranded vessel to the captain of the vessel then about to aid her. A mere request for aid, without any discussion as to terms, certainly cannot exclude the right to salvage. If so, then all signals of distress must exclude it, for they are certainly requests for aid. The decree of the district court is affirmed.

THE H. E. RUNNELS.

JENKS SHIP-BUILDING CO. v. WALLACE & CUNNINGHAM TRANSIT CO.

(Circuit Court of Appeals, Sixth Circuit. October 5, 1897.)

No. 450.

SALVAGE—AMOUNT OF COMPENSATION.

An award of $2,450 to a steam barge, worth, with her cargo, about $80,000, for going to the rescue of another barge loaded with coal, which was on fire in the Great Lakes, *held* not excessive, where the risk to the rescuing vessel was considerable, and the value of the vessel and cargo saved amounted to $15,000.

Appeal from the District Court of the United States for the Eastern District of Michigan.

This was a libel in admiralty by the Wallace & Cunningham Transit Company against the steamer H. E. Runnels, whereof the Jenks Ship-Building Company was claimant, to recover compensation for salvage services. The circuit court rendered a decree for libelant in the sum of $2,450, and the claimant has appealed.