

This was a suit in equity by Allen H. Rowe against the Blodgett & Clapp Company for alleged infringement of a design patent for a horseshoe calk.

W. E. Simonds, for complainant.
L. P. N. Marvin, for defendant.

TOWNSEND, District Judge. To this bill in equity for infringement of patent No. 26,587, granted to complainant February 2, 1897, for a design for a horseshoe calk, defendant demurs on the ground that said design "is the product of mere mechanical skill, not amounting to a patentable invention." The defendant, in his brief, cites a number of patents, and asks the court to take judicial notice thereof, and thereupon to hold that the configuration claimed in the patent in suit is lacking in originality and beauty. The court has no personal knowledge as to these matters, and does not understand that, in a hearing on a demurrer, it is its duty to investigate the prior art. As a matter of fact, the writer supposed that the ordinary horseshoe calk was an integral part of the horseshoe, hammered to a point by a blacksmith. It is perhaps possible that evidence might be introduced to show that said design was patentable, as a "new and original shape or configuration of an article of manufacture." The demurrer is therefore overruled.

PELZER v. GEISE. SAME v. ACME GAS FIXTURE & METAL CO. SAME
v. BUCK. SAME v. HORN & BRANNEN MFG. CO.

(Circuit Court, E. D. Pennsylvania. June 25, 1898.)

Nos. 37-39, 41.

PATENTS—PRELIMINARY INJUNCTION—EFFECT OF PRIOR DECISIONS.

The circuit court and the circuit court of appeals for the Third circuit held that several claims of an original patent were invalid. Thereafter the circuit court of appeals in the Second circuit, after duly considering such prior decision, sustained the validity of a reissue of the patent. *Held* that, in a subsequent suit in the circuit court of the Third circuit on the reissue, the court, on motion for a preliminary injunction, would regard the decisions in the Second circuit sustaining the reissue as controlling upon it.

These were four suits instituted by complainant, Pelzer, against different defendants for alleged infringement of a patent for improvements in electrical fixtures. The causes were heard on motions for preliminary injunction.

Richard N. Dyer, for complainant.

Hector T. Fenton, Theodore F. Jenkins, and Samuel Gustine Thompson, for respondents.

DALLAS, Circuit Judge. The above-stated cases are suits upon reissued letters patent No. 11,478, granted March 12, 1893, to Luther Stieringer, for an improvement in electrical fixtures. The original (No. 259,235) was dated June 6, 1882, and was applied for March 15, 1882. A motion for a preliminary injunction has been made in each case. These motions were argued at the same time,

and may be disposed of together. The defenses are not, in some particulars, precisely identical, but the point which has been chiefly relied upon is common to all the cases, and presents the only question which, on full consideration of the proofs, seems to me to be a serious one.

In the case of *Maitland v. Archer & Pancoast Co.*, 72 Fed. 660, the circuit court for the Southern district of New York sustained the first claim of the reissued patent here sued upon, and in the case of *Maitland v. Manufacturing Co.*, 29 C. C. A. 607, 86 Fed. 124, the circuit court of appeals for the Second circuit also upheld that claim. It is contended that the peculiar circumstances under which these decisions were rendered make the general rule, which would require them to be followed, inapplicable. The learned counsel for the defendants in the present suit against the Horn & Brannen Manufacturing Company conceded (as must necessarily be conceded) that a prior adjudication, made in a contested case, and after a full and final hearing, must be regarded, upon a motion for preliminary injunction, as decisive, or at least as *prima facie* controlling, with respect to the validity of the patent; but it is insisted that this case is an exceptional one, for the reason about to be referred to. When the original patent to Stieringer was before the court of appeals for this circuit in the case of *Maitland v. Gibson*, 11 C. C. A. 446, 63 Fed. 840, several of the claims of that patent were held to be invalid, and it is now argued that the courts in the Second circuit, either disregarded or misunderstood that prior judgment. If this were plainly evident, it would, I think, be incumbent upon this court to adopt as authoritative the decision of the court of appeals for this circuit. But this is not plainly evident. In both of the courts of the Second circuit the decision in this one was fully considered, and the question whether or not they properly interpreted it is one which, in my opinion, should be left for determination by the court which made it. The fact that the judgment of the court of appeals for the Third circuit was in accord with that of this court, as it is now constituted, should not, I think, induce me to enter upon an inquiry as to the purport and scope of that judgment. The courts of the Second circuit did not overlook it, and for the present purpose it is, I think, incumbent upon me to accept their conclusion, which is certainly not manifestly erroneous, without cavil or criticism. The application of the rule of comity, as it is called, is not, however, to be extended to anything more than was actually adjudged; and, as only the first claim of the reissue was passed upon, there will be a decree in each of these cases for a preliminary injunction so far as respects that claim, but not as to any of the others.

TABER BAS-RELIEF PHOTOGRAPH CO. et al. v. MARCEAU et al.

(Circuit Court, N. D. California. May 17, 1898.)

No. 12,258.

1. PATENTS—IMPROVEMENTS—CONSTRUCTION OF CLAIMS.

Where the parties to a suit are operating under different patents, each of which is for a mere improvement in a well-known art, each must be confined to the precise method mentioned in its claims.

2. SAME—INFRINGEMENT.

Infringement is determined, not by the result accomplished, but by the means employed in attaining that result.

3. SAME.

The only material difference between two patents for producing embossed pictures or photographs was that in one the picture was transferred to the block, and then carved out therein, while in the other the outline was cut on the block, and the picture then carved out, following a picture set up in front of the carver. *Held*, that there was no infringement, each patent being for a mere improvement.

4. SAME—EMBOSSSED PHOTOGRAPHS.

The Taber patent, No. 556,591, for improvements in methods of producing embossed photographs, is not infringed by the process described in the Marceau patent, No. 567,748, for a process of producing photographs in relief.

This was a bill in equity by the Taber Bas-Relief Photograph Company and others against Theodore C. Marceau and others for alleged infringement of a patent covering a method of producing embossed photographs.

John H. Miller, for complainants.

John L. Boone, for defendants.

MORROW, Circuit Judge. This is a suit in equity for infringement of letters patent No. 556,591, dated March 17, 1896, issued to Freeman A. Taber, for "improvements in methods of producing embossed photographs." It is conceded that the patent was assigned to the Taber Bas-Relief Photograph Company, and that the Taber Photographic Company is the licensee of the former. The only party defendant is Theodore C. Marceau, the other defendants being fictitious parties. The defendant, Theodore C. Marceau, denies, in his answer, any infringement of the Taber patent, but admits that he has been engaged in the production and sale of photographs in bas-relief, and in that connection avers that he is the inventor and patentee of a novel process and method of producing such photographs, which is protected by letters patent No. 567,748, dated December 15, 1896, issued to him, for a "process in producing photographs in relief." At the hearing the complainants introduced the letters patent under which they claim an infringement, and several exhibits, to illustrate their method of producing embossed pictures or photographs. They also introduced the deposition of a witness as expert testimony in their behalf. The defendant presented no evidence, beyond introducing in his behalf the file wrapper of his patent. No specific act of infringement has been shown. In fact, the question of infringement resolves itself into a consideration of whether or not the defend-