

UNITED STATES CIRCUIT COURT FOR THE NORTHERN DISTRICT OF
CALIFORNIA

Earl v. Southern Pac. Co.

75 F. 609 (1896) · Decided August 17, 1896

SUMMARY

The court denies the Southern Pacific Company's motion to dismiss for lack of personal jurisdiction in a patent infringement action, holding that jurisdiction may be obtained in a district where valid service can be made. It also rejects defendant Graham's jurisdictional objection because he had previously appeared in the court and was personally served in the district. Based on a prior adjudication sustaining the patent's validity, the court grants the complainant's motion for a preliminary injunction.

CASE DETAILS

COURT	United States Circuit Court for the Northern District of California
WRITING FOR THE COURT	Morrow
JURISDICTION	California
DECIDED	August 17, 1896
DISPOSITION	other
PROCEDURAL POSTURE	Plaintiff brought a patent-infringement suit in equity seeking a preliminary injunction. Southern Pacific Company and Robert Graham moved to dismiss for lack of personal jurisdiction based on their alleged nonresidence in the Northern District of California.
STANDARD OF REVIEW	On a motion for a preliminary injunction, a prior adjudication sustaining the patent creates a strong presumption in favor of patent validity. The defendant bears the burden of showing new evidence of such conclusive character that it probably would have produced a different result in the prior adjudication, with every reasonable doubt resolved against the defendant.
PRECEDENTIAL VALUE	published
PARTIES	Edwin T. Earl v. Southern Pacific Company, Robert Graham

TOPICS

- patent infringement
- personal jurisdiction
- injunctions
- civil procedure

PRACTICE AREAS

patent law

civil procedure

remedies

QUESTIONS PRESENTED

1. Whether the federal court had personal jurisdiction over Southern Pacific Company, a Kentucky corporation doing business in the Northern District of California, in a patent-infringement suit.
2. Whether the court had personal jurisdiction over Graham when he was not an inhabitant of the district but was personally served there.
3. Whether Earl was entitled to a preliminary injunction based on the prior adjudication sustaining the validity of the patent.

HOLDINGS

1. The court had jurisdiction over Southern Pacific Company because the statutory restriction requiring civil suits to be brought in the district where the defendant was an inhabitant did not apply to patent suits, and jurisdiction could be obtained in any district where valid service could be made.
2. The court had personal jurisdiction over Graham because he had previously submitted to the court's jurisdiction without objecting to residence and was personally served in the district in the present action.
3. A prior adjudication in the same circuit sustaining the validity of the patent after a bona fide contest is sufficient to support a preliminary injunction, unless the defendant presents new evidence so conclusive that it probably would have changed the result of the prior case.

KEY QUOTATIONS

"The only exception to this genera] rule seems to be where the new evidence is of such a conclusivo character that, if it liad been introduced in the former case, it probably would have led to a different conclusion." (611)

"It is clear that the presumptions must be in favor of the patent, and that it cannot be overthrown by a mere doubt." (612)

FACTUAL BACKGROUND

Earl held reissued letters patent relating to a ventilator and combined ventilator and refrigerator car. He previously prevailed against Robert Graham in an action at law involving the patent, obtaining a verdict and judgment. Earl alleged that Graham and Southern Pacific jointly used cars containing the patented invention in the Northern District of California and threatened to continue doing so. Southern Pacific was a Kentucky corporation, and Graham was personally served in the district.

PROCEDURAL HISTORY

Earl previously obtained a verdict and judgment against Graham in an action at law in the same court concerning the patent. He then filed this suit seeking to restrain the defendants from making, using, or selling cars and ventilators embodying the patented invention. The court denied both jurisdictional motions and granted Earl's motion for a preliminary injunction.

DISPOSITION

other

CASES CITED

- Southern Pac. Co. v. Denton, 146 U.S. 202, 13 S. Ct. 44
- In re Hohorst, 150 U.S. 659, 14 S. Ct. 221
- In re Keasbey & Mattison Co., 160 U.S. 221, 16 S. Ct. 273
- Smith v. Manufacturing Co., 67 F. 801
- Button Works v. Wade, 72 F. 298
- Putnam v. Bottle-Stopper Co., 38 F. 234
- Heysinger v. Rouss, 40 F. 584
- Eagle Manufg Co. v. David Bradley Manufg Co., 50 F. 193
- Edison Electric Light Co. v. Beacon Vacuum Pump & Electrical Co., 54 F. 687
- Macbeth v. Glass Co., 54 F. 173
- Woodard v. Stamping Co., 68 F. 717
- Johnson Steel Street Rail Co. v. William Wharton, Jr., & Co., 152 U.S. 252, 257, 14 S. Ct. 608
- Ladd v. Cameron, 25 F. 37
- Cantrell v. Wallick, 117 U.S. 689, 6 S. Ct. 970
- Edison Electric Light Co. v. Electric Manuf'g Co., 10 C.C.A. 106, 61 F. 834