

The second point is a more technical one, and is founded upon the principle which is thus stated in *Pickering v. McCullough*, 104 U. S. 310.

“In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. * * * It [the combination] must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions.”

The defendant says that the object of this improvement was so to construct a porcelain extension lamp fixture that the lamp and shade could together be raised or lowered at the will of the operator, and would remain in position at any desired point; that a device for removably securing the shade to the ring contributes nothing to this result, and does not enter into the combination so as to keep or cooperate with the other elements.

I am of opinion that, in view of the nature of these questions,—the first more particularly,—it is proper that an injunction should not be granted.

EMERY and another v. CAVANAGH.

(*Circuit Court, S. D. New York. June 4, 1883.*)

PATENTS FOR INVENTIONS—PUBLIC USE.

Public use of an invention, unless by the patentee himself, for profit, or by his consent or allowance, will not work a forfeiture of his title, as forfeiture is not favored unless it clearly appears that the use was solely for profit, and not with a view of further improvements or of ascertaining its defects, or for any other purpose of experiment in reducing the invention to practice.

In Equity.

Wm. A. Macleod and George Harding, for plaintiff.

Wm. S. Lewis and Lucien Birdseye, for defendant.

SHIPMAN, J. This is a bill in equity to restrain the alleged infringement of letters patent, granted February 10, 1874, to N. J. Simonds and E. R. Emery, for improved machinery for moulding heel-stiffenings for boots and shoes. The plaintiffs are the owners of the patent, and John R. Moffitt is one of their licensees. The defendant was licensed by Mr. Moffitt to use two machines made in accordance with his patent of June 20, 1876. This license was revoked on August 7, 1878, but the defendant continued to use the machines. The alleged infringement in this suit consists in the use by the defendant, since the revocation of his license, in the two Moffitt machines, of the devices claimed in the first and fourth claims of the Simonds and Emery patent. The infringement of the Moffitt patent is the subject of another action, which was tried at the same time with the present suit. The claims of the Simonds patent, which are said to have been infringed, are as follows:

"(1) The combination of the divided mould, *i, i*, and form, *n*, substantially as described and shown. (4) In combination with mould, *i, i*, the cans, *a', a'*, substantially as described and shown."

The testimony left no doubt in my mind that the devices named in these two claims were present in the Moffitt machines, and that the Simonds and Emery patent was valid. The defendant's attack upon the novelty of the invention, and upon the existence in the Moffitt machines of those portions of the invention which were claimed in the first and fourth claims, was neither vigorous nor successful. He however insisted with earnestness that the invention had, with the consent of the inventor, been in public use more than two years before June 30, 1873, the date of the application for a patent.

The patentees filed a caveat, dated December 9, 1870, setting forth their invention as it was then conceived. On December 20, 1871, the caveat was renewed. Between the fall of 1870 and the expiration of the renewed caveat the patentees were constantly experimenting, at great expense, upon the machine as finally perfected, and upon machines which should accomplish the same result by different kinds of moulds, but finally came back to the device described in the caveat, a marked feature of which was a divided mould. During this period they used the machine in the condition in which it was from time to time, incidentally for profit, but the witness, whose testimony is hereafter referred to, says: "It was his (Simonds') idea to keep the machine as much from view as possible, and be courteous to visitors."

Mr. Stackpole, a witness called by the defendant, was a machinist in Simonds' employ for five years, commencing about the beginning of 1870, and worked upon this machine. "He saw four years of experimenting on the machine." These experiments finally resulted in the adoption of substantially the original model of 1870, but, meantime, the machine had been changed in the auxiliary parts. Meanwhile it made counters freely, which were sold, but no machines were made which were sold, or were used by others, or were licensed, and the machine could only be tested by the making of counters upon it. Until about the time of the expiration of the renewed caveat, the invention had not reached a position of perfection or of completion where the inventors thought that it was fit, or where it probably was fit, to be patented. "Public use of an invention, unless by the patentee himself, for profit, or by his consent or allowance, will not work a forfeiture of his title, as such forfeiture is not favored unless it clearly appears that the use was solely for profit, and not with a view of further improvements, or of ascertaining its defects, or for any other purpose of experiment in reducing the invention to practice." *Jones v. Sewall*, 3 Cliff. 563; *Pitts v. Hall*, 2 Blatchf. C. C. 229; *Elizabeth v. Pavement Co.* 97 U. S. 126.

Let there be a decree for injunction and an accounting.

SCHILLINGER v. GREENWAY BREWING CO.

(Circuit Court, N. D. New York. July 11, 1883.)

1. PATENTS FOR INVENTIONS—REISSUED PATENT No. 4,364 SUSTAINED—SCHILLINGER PAVEMENT.

Reissued letters patent No. 4,364, granted to John J. Schillinger, May 2, 1871, for an "Improvement in Concrete Pavements," compared with British patents No. 7,489, of 1837, to Claridge, No. 350, of 1852, to Chesneau; No. 2,659, of 1855, to Coignet; No. 771, of 1856, to De La Haichois; No. 7,991, of 1839, to D'Harcourt; No. 9,737, of 1843, to Austin; and United States patents No. 56,563, July 24, 1866, to Huestis; and No. 5,475, March 14, 1848, to Russ,—and sustained as a patentable invention, not anticipated by said patents.

2. SAME—INFRINGEMENT.

The Schillinger patent was infringed by the pavement of defendant, and an injunction, and an account of profits and damages, should be decreed.

3. SAME—INVALID CLAIM IN REISSUE.

The invalidity of a claim in a reissue does not impair the validity of a claim in the original patent which is repeated and separately stated in the reissue.

In Equity.

Duell & Hey, for plaintiff.

John L. King, for defendant.

BLATCHFORD, Justice. This suit is brought for the infringement of reissued letters patent No. 4,364, granted to John J. Schillinger, May 2, 1871, for an "improvement in concrete pavements;" the original patent, No. 105,599, having been granted to him, July 19, 1870. The specification of the reissued patent, reading in the following what is outside of brackets and including what is in italics, and omitting what is inside of brackets, says:

"Figure 1 represents a *plan of my [pavement in plan view.] pavement.* Figure 2 is a vertical section of the [pavement.] *same.* *Similar letters indicate corresponding parts.* This invention relates to [pavements for sidewalks and other purposes; and consists in combining with] *a concrete pavement which is laid in sections, so that each section can be taken up and relaid without disturbing the adjoining sections.* With the joints of *this sectional concrete [pavements,] pavement are combined* strips of tar paper, or equivalent material, arranged between the several blocks or sections in such a manner as to produce a suitable tight joint, and yet allow the blocks to be raised separately without affecting [or injuring] the blocks adjacent thereto. In carrying out my invention I form the concrete by mixing cement with sand and gravel, or other suitable [materials] *material*, to form a [suitable] plastic [composition] *compound*, using about the following proportions: One part, by measure, of cement; one part, by measure, of sand; and from three to six parts, by measure of gravel; [using] *with* sufficient water to [make] *render* the mixture plastic; but I do not confine myself to any *definite* proportions or materials for making the concrete composition. While the mass is plastic I lay or spread the same [upon] *on* the foundation or bed of the pavement either in molds or between movable joists, of the proper thickness, so as to form the edges of the concrete blocks *a, a,* [etc. When the block *a* has been formed, I take strips of tar paper, *b,* of a width equal or almost equal to the height of the block, and place them up against the edges of the block in such a manner that they form the joints between such block and the adjacent blocks,] *one block being formed after the other. When the first block has set, I remove the joists or partition between it and the block next to be formed, and then I form*