

wished to have wired. He consulted Mr. Greenfield on the subject, and the latter describes what occurred at the supreme moment when the invention had its birth:

"Mr. Johnson asked me if I couldn't wire that cottage in a way so that the wires could be got at and repaired, if necessary, without tearing up any of the building, and I told him, 'Yes;' I thought that I could put in a system of tubing which could be used for race ways, if properly constructed, making a continuous channel; and he said, 'Greenfield, go ahead and do it,' which I did."

Most assuredly he did it: What else could he do? He had done substantially the same thing before in the Mills building, and he utilized his knowledge to suit the changed condition precisely as any other skilled electrician would have done after he was told what was wanted. The attempt to magnify this apparently simple exploit into an invention of surpassing excellence can be accomplished only by the substitution of theories based upon the imagination for facts based upon the evidence.

If a construction broad enough to cover the defendant's structures is placed upon the claims, they must be held invalid. If limited to a complete system of pipes extending continuously through the building "from supply to consumption," as shown in Fig. 1 of the patent, the claims may be upheld. But the defendant does not employ such a system, and in no event is the third claim infringed for the reason that the defendant does not use a pair of wires twisted together.

It follows that the bill must be dismissed.

SHAW v. ANDREWS et al.

(Circuit Court, S. D. New York. July 10, 1894.)

1. CONTRACTS—CONTEMPORANEOUS CONSTRUCTION BY PARTIES.

Evidence of the opinion of the parties to a contract as to its meaning, not carried into effect by any act, does not show such a contemporaneous construction as should govern its interpretation.

2. PATENTS—ASSIGNMENT FOR SHARE IN PROFITS OF ASSIGNEE.

An agreement for assignment of a patent, including claims for infringement and royalties, provided for the collection of royalties and suing of infringers by the assignees, and that they should manage the patent as they might deem best for the interest of all parties; that the assignor should be paid one-fourth of the net proceeds of the business; and also fixed a basis for prices of royalties. *Held*, that the assignor was entitled to share in the profits of the assignees from their own use of the patent, as well as in the royalties therefor.

In Equity. This was a suit by Jehyleman Shaw against William D. Andrews and others for an accounting for a share of royalties and profits under an assignment of a patent.

Thomas M. Wyatt, for plaintiff.

William Man, for defendants.

WHEELER, District Judge. The defendants were the owners of the patent to Green for driven or tube wells. *Eames v. Andrews*, 122 U. S. 40, 7 Sup. Ct. 1073. The plaintiff was the owner of patent

No. 101,774, dated April 12, 1870, for an improvement on such wells by connecting several together. On August 16, 1881, they entered into a written agreement that the plaintiff should assign his patent, including all claims for infringement and royalties remaining unpaid, to the defendants, and that they should "proceed to demand royalties from parties infringing, and endeavor to secure recognition of the said letters patent, and so manage the same as they may deem best for the interest of all parties concerned, and to bring suit or suits in the United States courts against parties infringing, for the purpose of establishing and sustaining the validity of said letters patent, if it appears to them to be good policy so to do; * * * advance the necessary means for conducting the said business and prosecuting any suits they may so bring, assuming and paying all the costs and expenses, and looking to the proceeds of the business for their remuneration;" "that all costs, charges, and expenses of whatever nature or kind incurred for and in the prosecution of the business aforesaid shall be first paid out of the proceeds, after which," the plaintiff should be paid quarterly one-fourth of the net proceeds, and the remaining three-fourths should belong to the defendants; that the "general basis for prices of royalties shall be for first-class wells, of two inches internal diameter, twenty-five dollars per tube, with such discounts for wells of less capacity, or wells used for fire purposes alone, for condensing or other special purposes, or for inferior water, as may be considered just and proper by" the defendants; and that the defendants should make no charges for their personal services. The plaintiff accordingly assigned his patent to the defendants, who collected royalties from various sources, and themselves put in water systems of tube wells for the city of Brooklyn and other places, using the devices of the plaintiff's patent, for which they received large sums. They have accounted to the plaintiff for all the royalties collected of other persons according to the agreement, and have overpaid him what would be due for royalties at \$25 each on the tubes of these systems put in by them, but have not accounted for the profits, if any, arising to them from the use of the plaintiff's invention patented in the patent assigned to them in putting in these systems. This suit is brought for an account of the whole. None is necessary unless the plaintiff is entitled to share in those profits. All appear at first, and while the systems were being put in, to have referred to the plaintiff's right as being to a share in the royalty on these tubes, and not in these profits. But no agreement to so treat them appears to have been made. No change in the course of business is shown to have been made by the defendants because of this treatment of his right by the plaintiff. The defendants did not make quarterly payments on that nor any basis according to the contract, and no settlement between the parties on that basis has been effected. This is relied upon in behalf of the defendants as such a contemporaneous construction of the contract in this respect that it should govern. But this view of the contract does not seem to have been carried far enough to amount to any practical construction. It remained in opinion, instead of being carried into effect by act.

The defendants insist, also, that they were, by the terms of the contract itself, to deal only with infringements and royalties, and that the plaintiff had no interest in the patent left to him beyond his one-fourth share in what might be realized from royalties, as such, and from infringements. The collection of royalties and suing of infringers were alone expressly provided for as things to be done by the defendants; but, in addition, they were generally to "so manage the same"—that is, the patent—as they might deem best for the interest of all. These water systems could not be put in but under, or by infringement of, this patent. As they held it, they could not be infringers of it, and putting in the systems by them while they so held it must have been under it, and a part of their management of it. This seems to be a part "of the business aforesaid," one-fourth of the net proceeds of which was to be paid to the plaintiff.

Let a decree be entered for an account.

NEW DEPARTURE BELL CO. v. HARDWARE SPECIALTY CO.

(Circuit Court, D. New Jersey. June 5, 1894.)

PATENTS—CROSS BILL IN SUIT FOR INFRINGEMENT.

In a suit to restrain infringement of certain patents, a cross bill alleged that defendant owned prior patents, which complainant infringed, and prayed an injunction and account. It also alleged that the patents of complainant and defendant were interfering patents, and prayed that complainant's patents be declared void; and it prayed that damages for the alleged infringements be set off. *Held*, that the cross bill must be stricken out, on motion, as not germane to the subject of the original bill.

This was a suit by the New Departure Bell Company against the Hardware Specialty Company for infringement of patents. Defendant answered the bill, and also filed a cross bill. Complainant moved to strike out the cross bill.

J. J. Jennings, for the motion.

J. C. Clayton, opposed.

GREEN, District Judge. The original bill of complaint was filed to enjoin the infringement by the defendant of letters patent No. 456,056, dated July 14, 1891, and letters patent No. 471,982, dated March 29, 1892. The defendant has duly answered the bill of complaint, setting up various defenses to the suit; and it has also filed a cross bill, in which it is alleged that it also owns certain patents, which antedate the patents of the complainant, and which the complainant is guilty of infringing, and prays an injunction and account. It also alleges that the patents of the complainant and of itself are interfering patents, and prays, under the statute in such case made and provided, that there may be a decree declaring the patents of the complainant void for the whole territory of the United States, and, finally, that whatever damages it may receive against the complainant because of its infringement of the last-named patents may be set off against any damages which the complainant may recover against it for its alleged infringement. The cross bill also