City of Elizabeth v. Pavement Co.

97 U.S. 126
Supreme Court of the United States
1877

Appeal from the Circuit Court of the United States for the District of New Jersey. From the Syllabus: *Samuel Nicholson having, in 1847, invented a new and useful improvement in wooden pavements and filed in the Patent Office a caveat of his invention, put down in 1854, as an experiment, his wooden pavement on a street in Boston, where it was exposed to public view and traveled over for several years, and it proving successful, he, Aug. 7, 1854, obtained letters patent therefor. Held: that there having been no public use or sale of the invention, he was entitled to such letters patent.*

MR. JUSTICE BRADLEY delivered the opinion of the Court.

This suit was brought by the American Nicholson Pavement Company against the city of Elizabeth, N.J., George W. Tubbs, and the New Jersey Wood Paving Company, a corporation of New Jersey, upon a patent issued to Samuel Nicholson, dated Aug. 20, 1867, for a new and improved wooden pavement, being a second reissue of a patent issued to said Nicholson Aug. 8, 1854. The reissued patent was extended in 1868 for a further term of seven years. A copy of it is appended to the bill, and, in the specification, it is declared that the nature and object of the invention consists in providing a process or mode of constructing wooden block pavements upon a foundation along a street or roadway with facility, cheapness, and accuracy, and also in the creation and construction of such a wooden pavement as shall be comparatively permanent and durable, by so uniting and combining all its parts, both superstructure and foundation, as to provide against the slipping of the horses' feet, against noise, against unequal wear, and against rot and consequent sinking away from below. Two plans of making this pavement are specified. Both require a proper foundation on which to lay the blocks, consisting of tarred paper or hydraulic cement covering the surface of the roadbed to the depth of about two inches, or of a flooring of boards or plank, also covered with tar, or other preventive of moisture. On this foundation, one plan is to set square blocks on end arranged like a checker board, the alternate rows being shorter than the others, so as to leave narrow grooves or channel ways to be filled with small broken stone or gravel, and then pouring over the whole melted tar or pitch, whereby the cavities are all filled and cemented together. The other plan is, to arrange the blocks in rows transversely across the street, separated a small space (of about an inch) by strips of board at the bottom, which serve to keep the blocks at a uniform distance apart, and then filling these spaces with the same material as before. The blocks forming the pavement are about eight inches high. The alternate rows of short blocks in the first plan and the strips of board in the second plan should not be higher than four inches. The patent has four claims, the first two of which, which are the only ones in question, are as follows:

> "I claim as an improvement in the art of constructing pavements:"
>
> "1. Placing a continuous foundation or support, as above described, directly upon the roadway, then arranging thereon a series of blocks, having parallel sides, endwise, in rows, so as to leave a continuous narrow groove or channel way between each row, and then filling said grooves or channel ways with broken stone, gravel, and tar, or other like materials."
>
> "2. I claim the formation of a pavement by laying a foundation directly upon the roadway, substantially as described, and then employing two sets of blocks -- one a principal set of blocks that shall form the wooden surface of the pavement when completed, and an auxiliary set of blocks or strips of board which shall

> form no part of the surface of the pavement, but determine the width of the groove between the principal blocks, and also the filling of said groove, when so formed between the principal blocks, with broken stone, gravel, and tar, or other like material."

The bill charges that the defendants infringed this patent by laying down wooden pavements in the City of Elizabeth, N.J., constructed in substantial conformity with the process patented, and prays an account of profits, and an injunction.

The defendants˜ averred that the alleged invention of Nicholson was in public use, with his consent and allowance, for six years before he applied for a patent on a certain avenue in Boston called the Mill dam, and contended that said public use worked an abandonment of the pretended invention.

We do not think that the defense of want of novelty has been successfully made out. Nicholson's invention dates back as early as 1847 or 1848. He filed a caveat in the Patent Office in August, 1847, in which the checkerboard pavement is fully described, and he constructed a small patch of pavement of both kinds, by way of experiment, in June or July, 1848, in a street near Boston, which comprised all the peculiarities afterwards described in his patent, and the experiment was a successful one.

The˜ question to be considered is whether Nicholson's invention was in public use or on sale, with his consent and allowance, for more than two years prior to his application for a patent within the meaning of˜ the acts in force in 1854, when he obtained his patent. It is contended by the appellants that the pavement which Nicholson put down by way of experiment, on Mill Dam Avenue in Boston in 1848 was publicly used for the space of six years before his application for a patent, and that this was a public use within the meaning of the law.

To determine this question, it is necessary to examine the circumstances under which this pavement was put down and the object and purpose that Nicholson had in view. It is perfectly clear from the evidence that he did not intend to abandon his right to a patent. He had filed a caveat in August, 1847, and he constructed the pavement in question by way of experiment for the purpose of testing its qualities. The road in which it was put down, though a public road, belonged to the Boston and Roxbury Mill Corporation, which received toll for its use, and Nicholson was a stockholder and treasurer of the corporation. The pavement in question was about seventy-five feet in length, and was laid adjoining to the toll gate and in front of the toll house. It was constructed by Nicholson at his own expense, and was placed by him where it was in order to see the effect upon it of heavily loaded wagons and of varied and constant use, and also to ascertain its durability and liability to decay. Joseph L. Lang, who was toll collector for many years commencing in 1849, familiar with the road before that time and with this pavement from the time of its origin, testified as follows:

> "Mr. Nicholson was there almost daily, and when he came, he would examine the pavement, would often walk over it, cane in hand, striking it with his cane and making particular examination of its condition. He asked me very often how people liked it and asked me a great many questions about it. I have heard him say a number of times that this was his first experiment with this pavement, and he thought that it was wearing very well. The circumstances that made this locality desirable for the purpose of obtaining a satisfactory test of the durability and value of the pavement were that there would be a better chance to lay it there, he would have more room and a better chance than in the city, and besides

> it was a place where most everybody went over it, rich and poor. It was a great thoroughfare out of Boston. It was frequently traveled by teams having a load of five or six tons, and some larger. As these teams usually stopped at the toll house and started again, the stopping and starting would make as severe a trial to the pavement as it could be put to."

This evidence is corroborated by that of several other witnesses in the cause, the result of the whole being that Nicholson merely intended this piece of pavement as an experiment, to test its usefulness and durability. Was this a public use within the meaning of the law?

An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law. The effect of the law is that no such consequence will necessarily follow from the invention's being in public use or on sale, with the inventor's consent and allowance, at any time within two years before his application, but that if the invention is in public use or on sale prior to that time, it will be conclusive evidence of abandonment and the patent will be void.

But in this case it becomes important to inquire what is such a public use as will have the effect referred to. That the use of the pavement in question was public in one sense cannot be disputed. But can it be said that the invention was in public use? The use of an invention by the inventor himself or of any other person under his direction by way of experiment and in order to bring the invention to perfection has never been regarded as such a use. Curtis, Patents, sec. 381; Shaw v. Cooper, 7 Pet. 292.

Now the nature of a street pavement is such that it cannot be experimented upon satisfactorily except on a highway, which is always public.

When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors.

In either case, such use is not a public use within the meaning of the statute so long as the inventor is engaged in good faith in testing its operation. He may see cause to alter it and improve it, or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And though during all that period he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment, and no one would say that such a use, pursued with a bona fide intent of testing the qualities of the machine, would be a public use within the meaning of the statute. So long as he does not voluntarily allow others to make it and use it and so long as it is not on sale for general use, he keeps the invention under his own control and does not lose his title to a patent.

It would not be necessary in such a case that the machine should be put up and used only in the inventor's own shop or premises. He may have it put up and used in the premises of another, and the use may inure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor and for the purpose of enabling him to test the machine and ascertain whether it will answer the purpose intended and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experimental use, and not a public use within the meaning of the statute.

Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist mill, or a carding machine,

customers from the surrounding country may enjoy the use of it by having their grain made into flour or their wool into rolls, and still it will not be in public use within the meaning of the law.

But if the inventor allows his machine to be used by other persons generally, either with or without compensation, or if it is with his consent put on sale for such use, then it will be in public use and on public sale within the meaning of the law.

If, now, we apply the same principles to this case, the analogy will be seen at once. Nicholson wished to experiment on his pavement. He believed it to be a good thing, but he was not sure, and the only mode in which he could test it was to place a specimen of it in a public roadway. He did this at his own expense and with the consent of the owners of the road. Durability was one of the qualities to be attained. He wanted to know whether his pavement would stand and whether it would resist decay. Its character for durability could not be ascertained without its being subjected to use for a considerable time. He subjected it to such use in good faith for the simple purpose of ascertaining whether it was what he claimed it to be. Did he do anything more than the inventor of the supposed machine might do in testing his invention? The public had the incidental use of the pavement, it is true, but was the invention in public use within the meaning of the statute? We think not. The proprietors of the road alone used the invention, and used it at Nicholson's request, by way of experiment. The only way in which they could use it was by allowing the public to pass over the pavement.

Had the City of Boston, or other parties, used the invention by laying down the pavement in other streets and places with Nicholson's consent and allowance, then, indeed, the invention itself would have been in public use within the meaning of the law; but this was not the case. Nicholson did not sell it nor allow others to use it or sell it. He did not let it go beyond his control. He did nothing that indicated any intent to do so. He kept it under his own eyes and never for a moment abandoned the intent to obtain a patent for it.

In this connection it is proper to make another remark. It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it. In England, formerly, as well as under our Patent Act of 1793, if an inventor did not keep his invention secret, if a knowledge of it became public before his application for a patent, he could not obtain one. To be patentable, an invention must not have been known or used before the application; but this has not been the law of this country since the passage of the act of 1836, and it has been very much qualified in England.

Lewis v. Marling, 10 B. & C. 22. Therefore, if it were true that during the whole period in which the pavement was used, the public knew how it was constructed, it would make no difference in the result.

It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed by the policy of the law; but this cannot be said with justice when the delay is occasioned by a bona fide effort to bring his invention to perfection or to ascertain whether it will answer the purpose intended. His monopoly only continues for the allotted period, in any event, and it is the interest of the public as well as himself that the invention should be perfect and properly tested before a patent is granted for it. Any attempt to use it for a profit, and not by way of experiment, for a

longer period than two years before the application would deprive the inventor of his right to a patent.~

The decree of the circuit court therefore must be reversed with costs, and the cause remanded to said court with instructions to enter a decree in conformity with this opinion, and it is

So ordered.