

Garratt *v.* Seibert.

This is a motion to dismiss the writ of error for want of jurisdiction.

Upon looking into the record, we find that the only claim set up by the plaintiffs in error was founded upon the act of Congress known as the Bankruptcy Act; and that the decision of the Supreme Court of the State was against the claim.

The case is within the very words of the act of February 5, 1867, giving to this court jurisdiction to review the decisions of the state courts; and the motion must be denied.

Mr. J. H. Parsons and *Mr. P. Phillips* for the motion. *Mr. T. J. Durant* and *Mr. C. W. Hornor* opposing.

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ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF CALIFORNIA.

No. 35. October Term, 1873. — Decided March 23, 1874.

If the subject of a patent is a combination of several processes, parts or devices, the use of any portion of the combination less than the whole is not an infringement.

The second claim in the patent granted to Nicholas Seibert for an improvement in lubricators for steam-engine cylinders, does not embrace the heating apparatus and the combination devised for preparing tallow for use in the lubricator, which is covered by the first claim in the patent.

THIS was an action at law for alleged infringement of letters patent, dated February 14, 1871, granted to Nicholas Seibert for an improvement in lubricators for steam-engine cylinders. The case is stated in the opinion.

MR. JUSTICE STRONG delivered the opinion of the court.

If the true construction of the patent be, as the plaintiffs in error contend, that the patentee's second claim is for a combination of all the devices mentioned in the specification, there was error in the instruction given to the jury by the Circuit Court. It is undoubtedly the law, that if the subject of a patent is a combination of several processes, parts or devices, the use of any portion of the combination less than the whole cannot be an infringement. There may indeed, be a patent for a combination of many parts, and at the same time for an arrangement of some of the parts constituting another combination, but still a part of the larger; yet, if there be no patent for the constituents, they are open to the public for use in

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combination, provided all the elements of the patented combination be not employed. It is therefore needful to inquire what are the elements of the combination which is protected by the patent.

The specification describes it as a new and useful improvement in lubricators for steam-engine cylinders, and describes it largely, if not principally, by reference to the accompanying drawings. It consists in the arrangement of several constituents, no single one of which is claimed to be new. These parts are a condensing-pipe connecting the steam-pipe with the lubricator; a reservoir for water, the product of condensed steam; a cup or vessel for oil or other lubricating material, placed vertically and somewhat lower than the water reservoir, but connected with it by a pipe leading from near its lower extremity to the bottom of the reservoir, and having near its upper end a pipe leading to the cylinder and valve chests, with a check-valve at the oil vessel and a stop-cock between it and the cylinder; a waste cock at the bottom of the oil vessel; a screw plug at its top, through which the lubricating material may be supplied; and a regulating valve by which the flow of water from the water reservoir into the oil vessel can be controlled. To these is added a glass tube with a sliding-gauge, arranged so as to stand vertically and parallel with the oil vessel, and connected with it at either extremity, its purpose being to indicate the amount of oil used. The operation of these devices thus arranged is described to be the following: The condensed water in the water reservoir, being higher and heavier than the oil in the oil vessel, forces itself under the oil in both that vessel and the glass tube, and causes it to pass out through the pipe leading to the cylinder and valve-chest into the steam-pipe, thus lubricating the valves and cylinders. These are all the devices necessary for the improved lubricator claimed to have been invented by the patentee, and such is their arrangement. The thing discovered and embodied in a practical combination was that by feeding a column of condensed water under the lubricant contained in a vessel the lubricant might be forced upward and outward, through a discharge pipe, into the cylinder, and upon the bearings of the engine, and that its flow might be controlled by a regulating valve. To embody this principle, nothing more than the devices we have mentioned is needed, and no other device is employed by the patentee. Those mentioned, arranged as they are, constitute a lubricator, and with a fluid lubricant they are sufficient.

But as it might be desired sometimes to use tallow, the patentee

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devised another combination, of different devices, by which steam can be conducted from the steam-chest of the engine into an annular space between two concentric vertical tubes located in the vessel containing the oil or tallow, the purpose being to reduce the tallow to a fluid condition, so that it can be forced by the upward pressure of the water through the discharge-pipe into the cylinder and valve-chest. It is for this combination the first claim of the patent is made, and the second claim is for the improved lubricator, consisting of the parts described in the specification, constructed and arranged substantially as specified.

It is upon the construction of this second claim that the parties are at issue, and the question to be decided is, whether the combination for heating tallow is a material part of the combination constituting a lubricator, which is the subject of the second claim. Upon the answer to this question depends the solution of the further question, whether a party not claiming under the patentee can use the lubricator, without the heating arrangement, and be guilty of no infringement.

The Circuit Court was of opinion, and so instructed the jury, that the second claim covers only the combination which makes the lubricator, without the heating apparatus, and does not embrace the combination devised for preparing tallow for use in the lubricator. Was this instruction erroneous? It must be admitted the specification is obscure, and that the second claim has not the precision which it should have. But while it is impossible to determine with entire certainty what the patentee intended to assert in his second claim, we cannot say that a wrong construction was given to it by the court. The combination which primarily and essentially constitutes a lubricator, is independent of any heating or melting arrangement. It can be used by itself and accomplish all the purposes of a lubricator. Every part of it contributes to the embodiment of the principle of the invention. The other combination designated in the first claim is no necessary part of it. Nor is its purpose the same. Though it may be used in connection with the devices, that, combined, constitute a lubricator, its design is only to prepare solid substances for use in the other combination. Its principle is to accommodate the lubricator proper to the use of tallow. And the patentee appears to have considered it as not essential to the successful operation of his lubricator. He begins his description of it by specifying its primary element as a cock to regulate the admis-

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sion of steam from the steam-chest into the oil vessel "*when tallow is used.*" Of course, when tallow is not used it has no office. It would seem, therefore, not to be an unreasonable construction of the second claim of the patent to hold that it embraces only the combination which makes up a complete lubricator. And that it does not comprehend the heating arrangement, which may or may not be used in connection with it.

It follows that the exception of the plaintiffs in error to the charge of the circuit judge cannot be sustained. The judgment is

Affirmed.

Mr. M. A. Wheaton and *Mr. Thomas T. Everett*, for plaintiffs in error. *Mr. Edmund L. Goold*, *Mr. A. H. Evans*, *Mr. Charles T. Botts* and *Mr. W. W. Boyce* for defendant in error.

STITT *v.* HUIDEKOPHER.

ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE
WESTERN DISTRICT OF PENNSYLVANIA.

No. 47. October Term, 1873.—Decided October 28, 1873.

Under the circumstances, the court allows an amendment of the record, on the certificate of the court below, without issuing a writ of *certiorari*.

MOTION for *certiorari*. The case is stated in the opinion.

MR. JUSTICE CLIFFORD delivered the opinion of the court.

The motion for *certiorari* is denied. But the court, in view of the circumstances, and on the authority of the case *Woodward v. Brown and Wife*, 13 Pet. 1, allow an amendment to be made in the transcript by the entry of the judgment in the following words: "May 18, 1871. Judgment on the verdict." It appearing by the certificate of the clerk of the Circuit Court that the judgment was so entered on that day and before the granting of the writ of error, and that the words aforesaid were inadvertently omitted by the clerk of the Circuit Court in preparing the transcript.

Mr. M. C. Kerr, *Mr. G. W. Guthrie* and *Mr. E. S. Golden* for plaintiff in error. *Mr. Walter D. Davidge* for defendants in error.

After announcing its decision on this motion, the court heard argument on the same day on the merits. The case is reported 17 Wall. 384.