Statement of the case.

IN RE RICHARD H. COLE. APPEAL FROM REFUSAL TO GRANT PATENT.

METALLIC NUTS—CONSTRUCTION OF CLAIM.—A claim for "the preliminary shaping of the end of the metallic bar to make it correspond on all sides save one with the cross section of the finishing die box, by which the necessity of cutting off by the punch of more than one side of the nut to be formed is prevented, and from which results a very great saving of metal in manufacturing many-sided nuts at the same time, at a considerable saving of power, as produced in operating the machine. But this I only claim when the said preliminary shaping of the exterior portion of a nut is accomplished immediately in front of the mouth of a die box, substantially in the manner herein set forth"—construed to be for a combination of the parts specified, arranged, and operating, as described in the specification, to accomplish the desired result, and *held* to be patentable.

NOVELTY—RULE IN DOUBTFUL CASES.—On an application for a patent it is not proper to question too vigorously the novelty of the invention. The applicant is entitled to the benefit of the doubts that arise upon this subject, for the reason that if his application is unjustly refused it will work an irremediable injury, whereas, if it should appear that the invention is not new, that fact may be established in other proceedings before the courts.

CONSTRUCTION OF CLAIMS.—In the initiatory stages of an application the claims should be most liberally construed in favor of the applicant.

(Before MERRICK, J., District of Columbia, October, 1857.)

STATEMENT OF THE CASE.

The invention claimed by the appellant in this case is an improved machine for making metallic nuts, the essential features of which consist of a pair of compressing jaws arranged in line with and immediately in front of the mouth of the die box. These jaws seize the heated metallic bar, which is compressed and shaped to correspond on all sides save one with the cross section of the die box, so as to obviate the necessity of cutting off by the punch of more than one side of the nut to be formed. The essence of the invention was alleged to be the described relation and combination of the preliminary shaping jaws, the punch, and the die box. To accomplish the purposes of the invention, the shaping jaws must not only give the exterior shape to the nut blank, but it is necessary that they should do their work exactly in front of the die box, so as to accurately position the blank between the die box and the punch.

Statement of the case.

In his application as originally filed the claim was more broadly drawn to cover the preliminary shaping of the end of the metallic bar to correspond on all sides save one with the cross section of the finishing die box. The claim was in the following language: "What I claim as my invention, and desire to secure by letters-patent, is the preliminary shaping of the end of the metallic bar to make it correspond on all sides save one with the cross section of the finishing die box, by which the necessity of cutting off by the punch of more than one side of the nut to be formed is prevented, and from which results a very great saving of metal in manufacturing many-sided nuts at the same time, at a considerable saving of power, as produced in operating the machine."

This claim was rejected on references, and the claim was amended to express the limitation above referred to. This amendment was as follows: "And then adding to such claim the following qualifying clause, to wit: 'But this I only claim when the said preliminary shaping of the exterior portion of a nut is accomplished immediately in front of the mouth of a die box, substantially in the manner herein set forth.'"

This claim was rejected on the general ground that the vibrating jaws for shaping, which characterize Cole's machine, are common appendages to machines for making various articles of hardware, such as axes, spikes, spoons, &c., and are employed for giving a preliminary or finishing shape or compression to the article. In this view the claim was held to cover, not the jaws nor the use of them, but merely the new location in which they performed their well-known functions, *i. e.*, in front of the die box. More particular reference was given to the patent of Robert Griffith for improvements in nut machines, dated October 30th, 1855, No. 13,720.

The Commissioner in his report gave the following account of the Griffith patent: "In Griffith's patent, which was given as a reference, this shaping [the preliminary shaping] is performed by two plates of suitable configuration, as shown at Fig. 5 of the second sheet of drawings. The devices are for making several nuts at one operation; the pressing plates move up and down between two sets of cutters and punches in boxes, and the nuts are pressed or shaped, perforated, and then cut asunder and dis-

charged. The function is performed between two sets of die boxes, and consequently in front of them, to the full extent and meaning implied in Cole's claim."

The patent issued to Cole, in accordance with this decision, October 27th, 1857, No. 18,499. The claim was not further amended, as suggested in the decision.

MERRICK, J.

The claim of the applicant in this case lies so close upon the lime which divides the new from the old in the arrangement of machinery to produce a better result in manufactures; or, rather, to be precise, comes so near to the principle of exclusion, on account of analogous use, that I have found great practical difficulty in placing him beyond the rule of exclusion. And did I construe the claim he has preferred to comprehend as much as the Office has considered it to comprehend, I should feel obliged to affirm the judgment of rejection; and indeed that construction is itself so far from unreasonable that if the recent decisions upon this branch of law did not warrant, especially in the initiatory stages of an application, very large latitude for benignant interpretation, I should be further constrained to say that the construction placed upon the claim by the Office was itself correct. But the claim, upon looking to all the parts of the specification, may, I think, fairly be determined to amount to a claim for the improvement in the combination of machinery for the manufacture of metallic nuts by a preliminary shaping of the end of the heated metallic bar out of which the nut is to be made, so as to make it conform on all sides, save one, with the cross-section of the die box of the machine into which it is to be thrust by the punch, and this preliminary shaping to be further effected by means of an attachment to nut-making machines of vibrating jaws, to be operated and adjusted by the combination thereof in the way detailed in the specification, immediately in front of, and exactly opposite to, the mouth of the die box, by means of which the necessity of cutting off, by the punch, of more than one side of the nut is prevented, and all waste of metal from the sides of the bar is prevented, and power in operating the machine is saved.

His invention is therefore limited not merely to a preliminary

shaping of the bar by compression. This was no novelty. And as the claim stood and was construed before any amendment, it was well rejected. Nor is the invention limited only to a preliminary shaping in front of a die box irrespective of the especial agency by which, and of the extent to which, that shaping is accomplished, for without that additional limitation it would fall within the objection taken by the Office of substantial identity with Griffith's machine. So, also, unless we regard the precise extent of this preliminary shaping connected with the especial benefits flowing from the order of its arrangement in the process of manufacture, it would be obnoxious to the objection of analogous use of the vibrating jaws in machines for making axes, spikes, &c., so forcibly urged in the written statements from the Office. But the difference between this machine and Griffith's, both in the character and the adjustment of the compressing agency, and the extent of the preliminary shaping—that being effected here on all sides of the bar save one, and there no less than two sides, afterwards demanding a severing appliance—appears to furnish a distinction in the result produced. And in the machines for axes, &c., the vibrating jaws, although used for proximate shaping of the particular articles, are not shown to be combined in the same way, so as to give an absolute finish to the shape of the article in certain of its proportions at an important stage of the manufacture, nor so as to determine the precise amount of metal used; or, to vary the expression, to act as an ultimate and rigorously exact measure of form, size, and density. In each one of the features of the improvement, separately considered, there is strong resemblance to the known things and known results to which it has been assimilated; but when considered as a whole, the combination differs from each and all in the specific result of the parts; and appearing by the united action to accomplish the desired result of manufacturing a uniform-sized and perfect nut with a saving of material and of operative force, it amounts to something more than "placing known means in a certain position;" the process seems thereby to be substantially modified and improved and the trade to have derived a positive benefit.

Under all the circumstances, I am disinclined to question too rigorously the novelty of this invention, especially when I con-

sider that if there be real patentable novelty in the combination, a refusal to grant a patent would operate irremediable injury; whereas, if it be not substantially new, the patent will not prevent the public from the use of the combination; but being only *prima-facie* evidence in his favor, a jury of the country could protect a party charged with infringement upon evidence given that there is no novelty. Giving, then, to the applicant the full benefit of my doubt, as also of the most favorable interpretation of his claim, I am of opinion that there is error in the decision of the Office. Perhaps in concluding this opinion it may be allowed that I suggest to the applicant to amend his specification before the emanation of a patent, so as to make the language of his claim accord unequivocally with the intention which I have ascribed to the terms used therein.

Z. C. Robbins, for the appellant.

IN RE ALONZO HEBBARD. APPEAL FROM REFUSAL TO GRANT PATENT.

INVENTION--ICE PITCHER—COMBINATION.—In an ice pitcher, the combination of an interior lining of porcelain or glazed ware to resist the action of acids, an outer metallic shield and an interposed elastic non-conducting material, to prevent the fracture of the porcelain and intercept the rays of heat: *Held*, Not to be anticipated by a double-walled pitcher composed entirely of metal, in which the intervening air space was not designed, and did not in fact operate, as a non-conducting medium.

EQUIVALENTS—ADDITIONAL EFFECTS.—If the change introduced by the appellant constitutes a mechanical equivalent in reference to the means used by a patentee, and besides being such an equivalent it accomplishes some other advantages beyond the effect or purpose accomplished by the patentee, such further advantages may make it a patentable subject as an improvement upon the former invention.

SAME—NEW COMBINATION—OLD PURPOSE.—The rule that an old device or combination applied to a new purpose is not patentable does not apply to the case when a new combination is applied to an old purpose.

(Before MORSELL, J., District of Columbia, October, 1857.)