IN RE WILLIAM DAVIS.

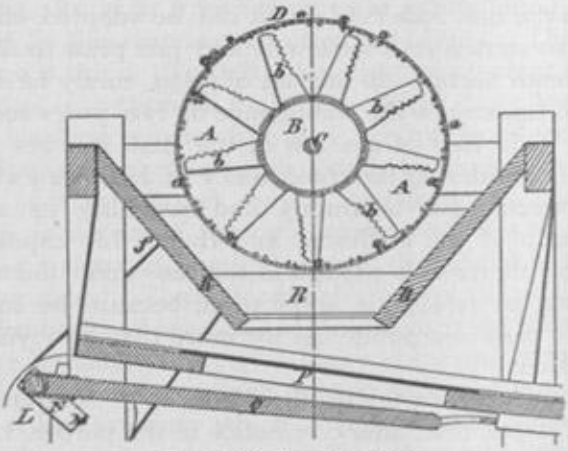
CLAIM MUST BE LIMITED TO THE EXACT INVENTION.—The law makes special requisition for clearness and definiteness of claims in the specifications for machines, by declaring that the applicant shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions, and shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.

SM.—A claim for the whole combination, without particularly specifying the changes in the construction and arrangement of the parts of the combination which are set out as the real invention in the specification: *Held*, To be too broad and indefinite.

(Before MORSELL, J., District of Columbia, April, 1859.)

STATEMENT OF THE CASE.

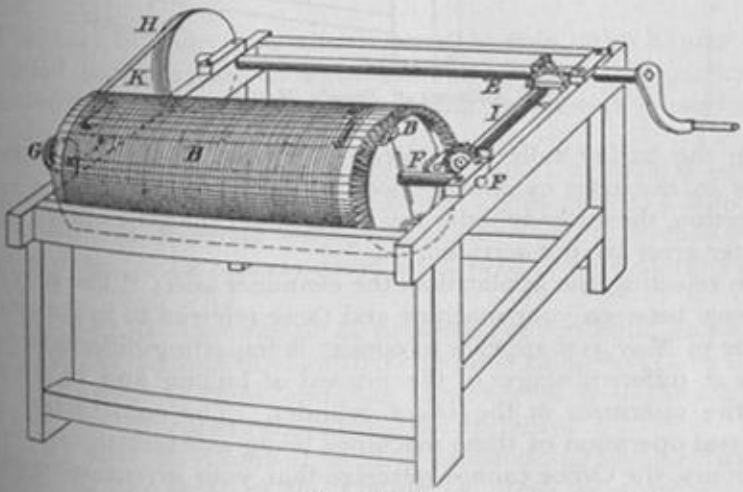
The alleged invention of the appellant will be readily understood from the cut below, taken from the drawing of a patent afterwards granted to him for the same invention (No. 24,104, May 24th, 1859).



Davis' Hominy Machine.

The machine is designed to reduce the shelled corn to the form of hominy or hulled corn, by first removing the outer cuticle or hull, and then breaking up the grain into particles of a predeter-

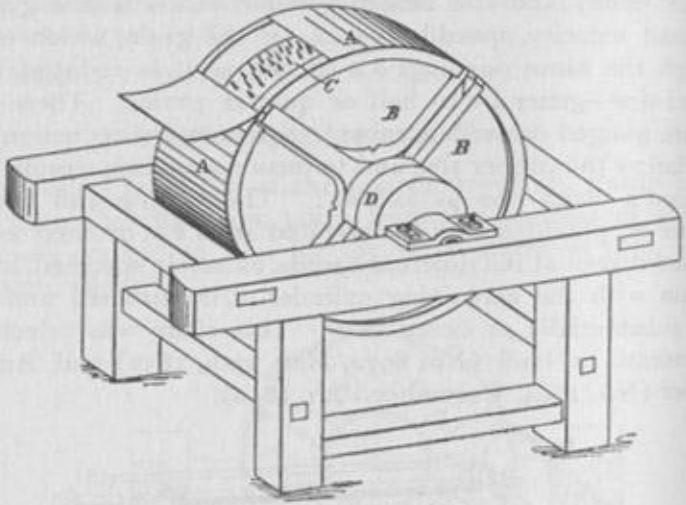
mined size. The corn is fed into the outer cylinder *A*, which is revolved at a given speed. The inner cylinder *B*, carrying serrated beater arms *b b* (not shown) is revolved in the opposite direction. The shaft of the inner cylinder is provided with two belt pulleys (not here shown) of different diameters. In the first part of the operation the inner cylinder is revolved at a comparatively slow rate of speed by means of the larger pulley, so that the beaters act upon the corn with just sufficient force to remove the hulls, which pass out through the openings *a a* in the outer cylinder. When the hulls are removed, the belt is shifted to the smaller pulley, and the beater cylinder, which is thus given an increased velocity, speedily breaks up the grain, which escapes through the same openings *a a* as fast as it is reduced to the desired size—generally to half or quarter grains. These openings are gauged or predetermined, to prevent the reduction of the grain below the proper size and to insure a uniform result. The applicant's claim was as follows: "The hulling and breaking cylinder *B*, provided with the serrated arms *b b*, or their equivalent, and driven at the different speeds, as herein specified, in combination with the containing cylinder *A*, constructed and operating substantially as described." This claim was rejected on the patents to Hull (No. 8972, May 25th, 1852) and Andrews & Piper (No. 1894, December 10th, 1840).



Hull's Machine.

Statement of the case.

In Hull's hominy machine the cylinders revolve in opposite directions, as in the appellant's machine, the inner one faster than the outer, and the beater arms (not shown) are serrated. The two cylinders, however, are geared up together, so that their speed of rotation cannot be altered at will with reference to each other. The outer cylinder is covered with wire gauze, coarse enough to permit the escape of the hulls but not the reduced grain. It was not proposed by this machine to first remove the hulls and then reduce the grain by altering the speed of the beater cylinder.



Andrews & Piper's Huller.

In the barley huller of Andrews & Piper there are no openings in the outer cylinder. Both cylinders revolve in the same direction, the outer cylinder revolving faster than the other. The beater arms are not serrated.

In rejecting the application, the examiner said: "The only difference between your machine and those referred to in the official letter of May 31st appears to consist in imparting different velocities at different stages of the process of hulling and in the size of the apertures in the outer cylinder. The construction and general operation of these machines being substantially the same as yours, the Office cannot perceive that your invention contains

a sufficient degree of novelty to entitle you [to] a patent, which must again be refused."

Upon appeal, the report of the board of examiners, which was adopted by the Commissioner as his decision, was as follows:

COMMISSIONER'S DECISION.

The main feature of the alleged invention consists in accelerating the speed of the hulling or breaking wheel after the machine has been in operation a short time. This change of speed is claimed in connection with certain peculiarities of construction, &c. The applicant does not, however, limit himself to any particular mode of changing the speed of the breaking wheel, nor does he undertake to fix or define the speed at which the breaking wheel should be run when of any particular size, but leaves the whole matter to be determined by experiments and practical trials on the part of the operator.

As it regards the machine used by the applicant, we do not perceive that it differs materially from those to which reference has been made, and consequently, so far as we can discover, it presents no point of novelty on which to base a patent. Great stress, however, is laid on the fact that the speed of the breaking wheel is to be changed during the process of hulling, &c., and that by such change of speed great and important results are produced.

This may be true; but, when viewed in this light, it must be regarded in the nature of a process, and as such (no particular machinery or speed of machinery being relied on) it ought to have been claimed.

We do not wish, however, to be understood as expressing an opinion favorable to the renewing of the application in a different form, since we entertain very great doubt whether even a very limited claim to the process could be allowed in view of the cases cited.

If, however, the case should be presented in this light, an examination might disclose the fact that the same thing has been done by various other persons, and that, too, long prior to the alleged invention and discovery thereof by the applicant.

It may also be observed in this connection that a claim to accelerating the speed of the hulling or breaking wheel was re-

Reasons of appeal.

fused to the applicant on an appeal to the Commissioner in 1856.

The claim in the present application seems to differ from the one then refused, in this: In the 1856 application the claim seems to be based on the change of speed alone, while in the present application the change of speed is claimed in connection with certain alleged peculiarities of construction, &c. The model is the same one, however, which was furnished in the former application.

Now, whether the change of the claim be regarded as merely an attempt to avoid the force of the Commissioner's decision in the 1856 application or not, is immaterial, since we do not find anything in the machine on which to base or allow a patent; and we must therefore recommend that this application be finally rejected.

The reasons of appeal were as follows:

REASONS OF APPEAL.

That the Commissioner of Patents is in error, in that he declares that the inventor does not "undertake to fix or define the speed at which the breaking wheel should be run when of any particular size, but leaves the whole matter to be determined by experiments and practical trials on the part of the operator."

Second. That the Commissioner of Patents has failed to comprehend the nature of the invention, wherein he says: "As it regards the machine used by the applicant," he does "not perceive that it differs materially from those to which reference has been made, and consequently," so far as he can discover, "it presents no point of novelty on which to base a patent;" and therefore erred in rejecting the application from such imperfect knowledge and comprehension of the invention.

Third. That the Commissioner of Patents erred in his conclusion from the statement in the specification concerning the importance of the change of speed given to the breaking cylinder during the act of making hominy; that "this may be true, but, when viewed in this light, it must be regarded in the nature of a process, and as such (no particular machinery or speed of machinery being relied on) it ought to have been claimed."

Fourth. That the Commissioner of Patents is in error, in that he does "not find anything in the machine on which to base or allow a patent."

Davis filed a new application for the same invention shortly after the decision on April 21st, 1859, and a patent issued to him May 24th, 1859, No. 24,104, with the following claim: "What I claim as my invention, and desire to secure by letters-patent, is providing the outer cylinder *A* with apertures *a a*, gauged to such a size as, while serving to discharge the hulls, also to perform the additional function of discharging the hominy as soon as reduced to the desired degree of fineness, in combination with the inner cylinder *B*, when the same is driven at the specific speeds, as herein described, for the purposes specified."

MERRICK, J.

The applicant having in his specification described the improved machine in all its parts and the manner in which it should be operated, defines his claim of novelty as follows: "What I claim as my invention, and desire to secure by letters-patent, is the hulling and breaking cylinder *B*, provided with the serrated arms *b b* or their equivalents, and driven at the different speeds, as herein specified, in combination with the containing cylinder *A*, constructed and operating substantially as described." The patent law makes especial requisition for clearness and definiteness of claim in the specifications for machines, by declaring that the applicant shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions, and shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery. It would be difficult, with this rule prescribed by the statute, to conclude, from reading the specification and claim of the applicant in this case, that the only points of novelty asserted by him for his improved machine are the adjustment of the size of the holes of the outer cylinder so as to permit the due escape of the hominy, when in the progress of the operation the grains of corn are successively broken to the requisite size, and the change, by means of the requisite adjustment of parts of the ma-

chinery, of the velocity of movement of his cylinder from one certain rate of revolution to another certain rate of revolution, at proper stages in the process of manufacture. These points of novelty are not set forth and claimed particularly and specifically as the matter of his discovery, but his claim is for the whole combination of the machinery and manner of operating it at different degrees of velocity. The claim is therefore too broad, and was properly rejected by the Office as disclosing no novelty upon the references given to Hull's machine and the barley-hulling machine of Andrews and Piper. Considering, therefore, that the second reason of appeal cannot be sustained, in view of the references given, and that the first and third do not present proper matter of inquiry upon a specification framed in such general terms, and not making claim of novelty for that upon which these supposed errors are assigned, and the fourth reason being identical with the second, I am of opinion, and accordingly certify to the Hon. S. F. Shugert, Commissioner of Patents, that there is no error in the decision of the Office upon the claim in the shape in which it is now submitted. Whether it may be so amended as to present patentable novelty, is a question upon which I cannot pass judgment upon the present appeal; and I further, therefore, certify that the judgment of the Commissioner is affirmed, and the application for a patent must be denied.

J. S. Brown, for the appellant.

SAMUEL B. ELLITHORP, APPELLANT,

vs.

T. J. W. ROBERTSON, APPELLEE. INTERFERENCE.

Decision in Ellithorp *v.* Robertson (*ante*, p. 585) affirmed.

(Before MORSELL, J., District of Columbia, April, 1859.)

MORSELL, J.

The points decided by me on the 28th of September, 1858, in a case of appeal from the decision of the Commissioner of Patents