IN RE COLE.

Case No. 2,974.

{1 MacA. Pat. Cas. 539.}

Circuit Court, District of Columbia. Oct., 1857.

PATENTS—NOVELTY—UTILITY.

{Where each one of the features of an improvement, separately considered, strongly resembles 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 results of the parts, and accomplishes the desired result of manufacture with a saving of material and of operative force, it amounts to something more than "placing known means in a certain position;" and, if a positive benefit will result to the trade, the novelty of the invention should not be too vigorously questioned, especially as, if there be real patentable novelty, a refusal to grant the patent would work irremediable injury, and, if the combination be not substantially new, the fact of the patent will not prevent the public from using it.}

{Appeal from the commissioner of patents.

{Application of Richard H. Cole for letters patent for an improved machine for making metallic nuts. From a decision of the commissioner of patents rejecting the application, the applicant appeals.

{The patent was subsequently issued to the applicant, October 27, 1857, and is numbered 18,499.}

Z. C. Robbins, for appellant.

MERRICK, Circuit Judge. The claim of the applicant in this case lies so close upon the line 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 parts of the specification, may, I think, fairly be determined to amount to a claim for an 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 consider 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.

[NOTE. A patent was subsequently issued to the applicant, October 27, 1857, and is numbered 18,499.]

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