

Wood Vs. Underhill

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Court : US Supreme Court

Decided On : 1847

Appeal No. : 46 U.S. 1

Appellant : Wood

Respondent : Underhill

Judgement :

Wood v. Underhill - 46 U.S. 1 (1847)

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Wood v. Underhill

46 U.S. (5 How.) 1

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE SOUTHERN DISTRICT OF NEW YORK

SYLLABUS

In order to obtain a patent, the specification must be in such full, clear, and exact terms as to enable anyone skilled in the art to which it appertains to compound and use the invention without making any experiments of his own.

If the patent be for a new composition of matter, and no relative proportions of the ingredients are given, or they are stated so ambiguously and vaguely that no one could use the invention without first ascertaining, by experiment, the exact proportion required to produce the result, it would be the duty of the court to declare the patent void.

But the sufficiency of the description in patents for machines, or for a new composition of matter, where any of the ingredients do not always possess exactly the same properties in the same degree, is generally a question of fact to be determined by the jury.

Where a patent was obtained for a new improvement in the mode of making brick, tile, and other clay ware, and the process described in the specification was to mix pulverized anthracite coal with the clay before moulding it, in the proportion of three-fourths of a bushel of coal dust to one thousand brick, some clay requiring one-eighth more, and some not exceeding half a bushel, this degree of vagueness and uncertainty was not sufficient to justify the court below in declaring the patent void.

The court should have left it to the jury to say, from the evidence of persons skilled in the art, whether the description was clear and exact enough to enable such persons to compound and use the invention.

It appeared that in the year 1836, Wood took out amended letters patent for "a new and useful improvement in the mode of making brick, tile, and other clay ware," and filed the following specification of his invention:

"Be it known that I, the said James Wood, have invented a new and useful improvement in the art of manufacturing bricks and tiles. The process is as follows:"

"Take of common anthracite coal,

unburnt, such quantity as will best suit the kind of clay to be made into brick or tile, and mix the same, when well pulverized, with the clay before [it] is moulded; that clay which requires the most burning will require the greatest proportion of coal dust; the exact proportion, therefore, cannot be specified, but in general three-fourths of a bushel of coal dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding a half-bushel. The benefits resulting from this composition are the saving of fuel, and the more general diffusion of heat through the kiln, by which the whole contents are more equally burned. If the heat is raised too high, the brick will swell and be injured in their form. If the heat is too moderate, the coal dust will be consumed before the desired effect is produced. Extremes are therefore to be avoided. I claim as my invention the using of fine anthracite coal or coal dust with clay for the purpose of making brick and tile as aforesaid, and for that only claim letters patent from the United States."

"JAMES WOOD"

"Dated 9 November, 1836"

In July, 1842, he brought a suit against the defendants in error, for a violation of this patent.

And at the trial the defendant objected to the sufficiency of the specification

"because no certain proportion for the mixture is pointed out, but only that such quantity of coal must be taken as will best suit the kind of clay to be made into brick or tile, but that clay which requires most burning will require the greatest quantity of coal dust; the exact proportion cannot, therefore, be specified; but in general three-fourths of a bushel of coal dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding half a bushel, so that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay, and the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal dust with clay for the purpose of making brick, without any practical rule as to the

proportions, which is too vague and uncertain to sustain a patent,"

which objection was sustained by the court. The plaintiff excepted. And the verdict and judgment being against him, the case was brought here upon this exception.

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MR. CHIEF JUSTICE TANEY delivered the opinion of the Court.

The question presented in this case is a narrow one, and may be disposed of in a few words.

The plaintiff claims that he has invented a new and useful improvement in the art of manufacturing bricks and tiles, and states his invention to consist in using fine anthracite coal, or coal dust, with clay, for the purpose of making brick or tile, and for that only he claims a patent. And the only question presented by the record is whether his description of the relative proportions of coal dust and clay, as given in his specification, is upon the face of it too vague and uncertain to support a patent.

The degree of certainty which the law requires is set forth in the act of Congress. The specification must be in such full, clear, and exact terms as to enable anyone skilled in the art to which it appertains to compound and use the invention -- that is to say, to compound and use it without making any experiments of his own. In patents for machines, the sufficiency of the description must, in general, be a question of fact to be determined by the jury. And this must also be the case in compositions of matter, where any of

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the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree.

But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be

void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident on the face of the specification that no one could use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. And if the specification before us was liable to either of these objections the patent would be void and the instruction given by the circuit court undoubtedly right.

But we do not think this degree of vagueness and uncertainty exists. The patentee gives a certain proportion as a general rule -- that is, three-fourths of a bushel of coal dust to one thousand bricks. It is true he also states that clay which requires the most burning will require the greatest proportion of coal dust, and that some clay may require one-eighth more than the proportions given, and some not more than half a bushel instead of three-fourths. The two last-mentioned proportions may, however, be justly considered as exceptions to the rule he has stated, and as applicable to those cases only where the clay has some peculiarity and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms, and the notice of the variations, mentioned in the specification, would seem to be designed to guard the brickmaker against mistakes into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture.

It may be indeed that the qualities of clay generally differ so widely that the specification of the proportions stated in this case is of no value, and that the improvement cannot be used with advantage in any case or with any clay without first ascertaining by experiment the proportion to be employed. If that be the case, then the invention is not patentable, because, by the terms of the act of Congress, the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable anyone skilled in the art to compound and use it. And if, from the nature and character of the ingredients to be used, they are not susceptible of

such exact description, the inventor is not entitled to a patent. But this does not appear to be the case on the face of this specification. And whether the fact is so or not is a question to be decided

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by a jury upon the evidence of persons skilled in the art to which the patent appertains. The circuit court therefore erred in instructing the jury that the specification was too vague and uncertain to support the patent -- and its judgment must be

Reversed.

ORDER

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States of the Southern District of New York, and was argued by counsel. On consideration whereof it is now here ordered and adjudged by this Court that the judgment of the said circuit court in this cause be and the same is hereby reversed with costs, and that this cause be and the same is hereby remanded to the said circuit court with directions to award a *venire facias de novo*.

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