Corning Vs. Burden

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SooperKanoon Citation : sooperkanoon.com/80419

Court : US Supreme Court

Decided On : 1853

Appeal No. : 56 U.S. 252

Appellant : Corning

Respondent : Burden

Judgement :

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Corning v. Burden

56 U.S. (15 How.) 252

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE NORTHERN DISTRICT OF NEW YORK

SYLLABUS

In a suit brought for an infringement of a patent right, the defendant ought to be allowed to give in evidence the patent under which he claims, although junior to the plaintiff's patent.

Burden's patent for "a new and useful machine for rolling puddler's balls and other masses of iron in the manufacture of iron" was a patent for a machine, and not a process, although the language of the claim was equivocal.

The difference explained between a process and a machine.

Hence it was erroneous for the circuit court to exclude evidence offered to show that the practical manner of giving effect to the principle embodied in the machine of the defendants was different from that of Burden, the plaintiff, that the machine of the defendants produced a different mechanical result from the other, and that the mechanical structure and mechanical action of the two machines were different.

Evidence offered as to the opinion of the witness upon the construction of the patent, whether it was for a process or a machine, was properly rejected.

Peter A. Burden, as assignee of Henry Burden, brought his action against Corning and Winslow for a violation of a patent granted to Henry as the original and first inventor and discoverer of a new and useful machine for rolling puddle balls or other masses of iron in the manufacture of iron.

What took place at the trial is set forth in the opinion of the Court. Under the instructions of the circuit court, the jury

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found a verdict for the plaintiffs, with one hundred dollars damages; upon which the defendants brought the case up to this Court by a writ of error.

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MR. JUSTICE GRIER delivered the opinion of the Court.

Peter A. Burden, who is assignee of a patent granted to Henry Burden, brought this suit against the plaintiffs in error for infringement of his patent. The declaration avers that Henry Burden was "the first inventor of a new and useful machine for

rolling puddle balls," for which a patent was granted to him in 1840, and that the defendants, Corning and Winslow, "made, used &c.;, this said new and useful machine in violation and infringement of the exclusive right so secured to plaintiff."

The defendants below, under plea of the general issue, gave notice that they would prove on the trial that Henry Burden "was not the first and original inventor of the supposed new and useful machine for rolling puddle balls &c.;," that the machine of the plaintiff, and the principle of its operation was not new, and that the common and well known machines called nobbling rolls, which were in use long before the application of Burden for a patent, embraced the same invention and improvements used for substantially the same purpose. And after setting forth many other matters to be given in evidence affecting the novelty of plaintiff's machine, the notice denies that the machine used by the defendant was an infringement of that patented by plaintiff, and avers that the machine used by them was described in a patent issued to the defendant, Winslow, in December, 1847, "for rolling and compressing puddlers' balls," differing in principle and mode of operation from that described in the plaintiff's patent.

To support the issue in his behalf, the plaintiff gave in evidence a patent to Henry Burden, dated 10 December, 1840, for "a new and useful machine for rolling puddlers' balls and other masses of iron in the manufacture of iron," and followed it by testimony tending to show the novelty and utility of his

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machine and that the machine used by the defendants was constructed on the same principles, and there rested his case.

The defendants then offered to read in evidence the patent of Winslow for his "new and useful improvement in rolling and compressing puddlers' balls." The plaintiff objected to this evidence as irrelevant, and the court sustained the objection and overruled the evidence. This ruling of the court forms the subject of defendant's first bill of exceptions.

The defendants then proceeded to introduce testimony tending to show want of originality in the plaintiff's machine, and also that the principle and mode of operation of the defendant's machine was different from that described in the plaintiff's patent, and finally called a witness named Hibbard. This witness gave a history of the various processes and machines used in the art of converting cast iron into blooms or malleable iron. He spoke of the processes of puddling, shingling, and rolling, and attempted to define the difference between a process and a machine. The introduction of this philological discussion seems at once to have changed the whole course of investigation, to the entire neglect of the allegations of the declaration and of the issues set forth in the pleadings in support of which all the previous testimony had been submitted to the jury. The defendant's counsel then proposed the following question to the witness: "Do you consider the invention of Mr. Burden, as set forth in his specification, to be for a process or a machine?" This question was objected to, overruled by the court, and a bill of exceptions sealed.

The counsel for the defendants then offered to prove by this witness

"that the practical manner of giving effect to the principle embodied in the machine used by the defendants was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden's machine, that the principles of the two machines, as well as the practical manner of carrying out those principles, were different, and that the machine used by the defendants produced, by its action on the iron, a different mechanical result on a different mechanical principle from that produced in Mr. Burden's machine."

To the introduction of this testimony the plaintiff's counsel objected, and it was overruled by the court and, at the defendant's instance, a bill of exceptions sealed.

The defendant's counsel then proposed to prove

"that the machine used by the defendants differed in point of mechanical structure and mechanical action from the machines described in the plaintiff's specification."

This testimony was also overruled, and exceptions taken.

After some further examination of witnesses, the learned judge

announced his intention of instructing the jury in the three following propositions, upon which the defendant's counsel declined to give further testimony, and excepted to his instructions.

"1. The letters patent to Henry Burden, which have been given in evidence by the plaintiff, are for a new process, mode, or method of converting puddler's balls into blooms by continuous pressure and rotation of the ball between converging surfaces, thereby dispensing with the hammer, alligator jaws, and rollers, accompanied with manual labor, previously in use to accomplish the same purpose. And the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention as above specified by the process, mode, or method above mentioned."

"2. The machines for milling buttons, milling coin, and rolling shot which have been given in evidence by the defendants do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them, were substantially different from those of the said letters patent."

"3. That the machine used by the defendants is an infringement of the said letters patent if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although its mechanical construction and action may be different from those of the machines described in the said letters patent."

As the first instruction of the court contains the most important point in the case, and a decision of it will dispose of most of the others, we shall consider it first in order.

Is the plaintiff's patent for a process or a machine?

A process, *eo nomine,* is not made the subject of a patent in our act of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called "processes." A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores, and numerous others are usually carried on by processes, as distinguished from machines. One may discover a new and useful

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improvement in the process of tanning, dyeing &c.;, irrespective of any particular form of machinery or mechanical device. And another may invent a labor-saving machine by which this operation or process may be performed, and each may be entitled to his patent. As, for instance, A has discovered that by exposing India rubber to a certain degree of heat in mixture or connection with certain metallic salts he can produce a valuable product or manufacture; he is entitled to a patent for his discovery as a process or improvement in the art, irrespective of any machine or mechanical device. B, on the contrary, may invent a new furnace or stove or steam apparatus by which this process may be carried on with much saving of labor and expense of fuel, and he will be entitled to a patent for his machine as an improvement in the art. Yet A could not have a patent for a machine or B for a process, but each would have a patent for the means or method of producing a certain result or effect, and not for the result or effect produced. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

But the term "process" is often used in a more vague sense, in which it cannot be the subject of a patent. Thus, we say that a board is undergoing the "process" of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine as distinguished from a process.

In this use of the term. it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

It is by not distinguishing between the primary and secondary sense of the term "process" that the learned judge below appears to have fallen into an error. It is clear that Burden does not pretend to have discovered any new process by which cast iron is converted into malleable iron, but a new machine or combination of mechanical devices by which the slag or impurities of the cast iron may be expelled or pressed out of the metal when reduced to the shape of puddlers' balls. The machines used before to effect this compression were tilt hammers

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and alligator's jaws, acting by percussion and pressure, and by nobbling rolls with eccentric grooves which compressed the metal by use of the inclined plane in the shape of a cyclovolute or snail cam. In subjecting the metal to this operation by the action of these machines, more time and manual labor is required than when the same function is performed by the machine of Burden. It saved labor, and thus produced the result in a cheaper, if not a better, manner, and was therefore the proper subject of a patent.

In either case, the iron may be said, in the secondary sense of the term, to undergo a "process" in order to change its qualities by pressing out its impurities, but the agent which effects the pressure is a machine or combination of mechanical devices.

The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and therefore correctly states the nature of his invention.

The patent law requires that "every patent shall contain a short description or title of the invention or discovery, indicating its nature and design," &c.; The patent in question recites that

"Whereas Henry Burden, of Troy, New York, has alleged that he has invented a new and useful machine for rolling puddle balls or other masses of iron in the manufacture of iron, which he states has not been known or used before his application, has made oath that he is a citizen of the United States, that he does verily believe that he is the original and first inventor or discoverer of the said machine"

&c.;

The specification declares that his improvement consists in "the employment of a new and useful machine for rolling of puddlers' balls;" again he calls it "my rolling machine," and describes his "machine as consisting of a cast iron cylinder," &c.; In fine, his specification sets forth the "particulars" of his invention in exact accordance with its title in the patent and in clear, distinct, unequivocal, and proper phraseology.

It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms which might be construed to mean either a process or machine. In such case, the construction should be that which is most favorable to the patentee, *"ut res magis valeat quam pereat."* His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect, or result of his machine would certainly endanger if not destroy its validity. His claim cannot change or nullify his previous specification with safety to his patent. He cannot describe a machine which will perform a certain function and then claim the function itself and all other machines that may be invented to perform the same function.

We are of opinion, therefore, that the learned judge of the court below erred in the construction of the patent and in his first proposition or instruction to the jury. And as the second and third instructions are based on the first, they must fall with it. Taking the bills of exception to rejection of evidence in the inverse order, it is clear that the last two rulings, being founded on the erroneous construction of the patent, are of course, erroneous. The testimony offered was directly relevant to the issues trying, and should have been received.

The refusal of the court to hear the opinion of experts as to the construction of the patent was proper. Experts may be examined as to the meaning of terms of art on the principle of *"cuique in sua arte credendum,"* but not as to the construction of written instruments.

It remains only to notice the first bill of exceptions, which was to the rejection of the defendant's patent.

This is a question on which there may be some difference of opinion. In some circuits it has been the practice, when the defendant has a patent for his invention, to read it to the jury without objection; in others it is not received, on the ground that it is irrelevant to the issue, which is a contest between the machine of the defendant and the patent of the plaintiff, and that a posterior patent could not justify an infringement of a prior one for the same invention.

By the patent act of 1793, any person desirous of obtaining a patent for an alleged invention made application to the Secretary of State and received his patent on payment of the fees and on a certificate of the Attorney General that his application "was conformable to the act." No examination was made by persons qualified to judge whether the alleged invention was new or useful or had been patented before. That rested wholly on the oath of the applicant. The patent act of 1790 had made a patent *prima facie* evidence, but this act was repealed by that of 1793, and this provision was not reenacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful, and the plaintiff was bound to prove these facts in

order to make out his case. But the Act of 4 July, 1836, introduced a new system and an entire change in the mode of granting patents. It provided for a new officer, styled a Commissioner of Patents, to "superintend, execute, and perform all acts and things touching and respecting the granting and issuing of patents &c.;" The Commissioner was authorized to appoint a chief clerk and three examining clerks, machinist, and other officers.

On the filing of an application, the Commissioner is required

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to make or cause to be made an examination of the alleged invention in order to ascertain whether the same had been invented or discovered by any other person in this country prior to the application or whether it had been patented in this or any foreign country, or had been on public use or sale, with the applicant's consent, prior to his application, and if the Commissioner shall find that the invention is new and useful or important, he is authorized to grant a patent for the same. In case the decision of the Commissioner and his examiner is against the applicant and he shall persist in his claim, he may have an appeal to a board of examiners, to consist of three persons appointed for that purpose by the Secretary of State, who, after a hearing, may reverse the decision of the Commissioner in whole or in part. By the act of 1839, the Chief Justice of the District of Columbia was substituted to the board of examiners.

It is evident that a patent thus issued after an inquisition or examination, made by skillful and sworn public officers appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be and generally is received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right, and if so it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor arising from a like investigation of the originality of his

invention and the judgment of the public officers that his machine is new and not an infringement of the patent previously granted to the plaintiff. It shows at least that the defendant has acted in good faith and is not a wanton infringer of the plaintiff's rights and ought not therefore to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial, but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat.* The parties should contend on an equal field and be allowed to use the same weapons.

We are of opinion therefore that the court erred in refusing to permit the defendants' patent to be read to the jury.

The judgment of the circuit court is therefore

Reversed and a venire de novo awarded.

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ORDER

This cause came on to be heard on the transcript of the record, from the Circuit Court of the United States for the Northern 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.*