Seymour Vs. Mccormick

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Appellant : Seymour

Respondent : Mccormick

Judgement :

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Seymour v. McCormick

60 U.S. (19 How.) 96

ERROR TO THE CIRCUIT COURT OF THE UNITED

STATES FOR THE NORTHERN DISTRICT OF NEW YORK

SYLLABUS

The Act of Congress passed on the 3d of March, 1837, 5 Stat. 194, provides that a patentee may enter a disclaimer if he has included in his patent what he was not the inventor of, but if he recovers judgment against an infringer of his patent, he

shall not be entitled to costs unless be has entered a disclaimer for the part not invented.

It also provides that if a patentee unreasonably neglects or delays to enter a disclaimer, he shall not be entitled to the benefit of the section at all.

In 1845, McCormick obtained a patent for improvements in a reaping machine in which, after filing his specification, he claimed, amongst other things, as follows, *viz.:*

"2d. I claim the reversed angle of the teeth of the blade, in manner described."

"3d. I claim the arrangement and construction of the fingers, or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described."

These two clauses are not to be read in connection with each other, but separately. The first claim, *viz.,* for "the reversed angle of the teeth of the blade," not being new, and not being disclaimed, he was not entitled to costs, although he recovered a judgment for a violation of other parts of his patent.

Under the circumstances of the case, the patentee was not guilty of unreasonable neglect or delay in making the disclaimer, which is a question of law for the court to decide.

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The fact that a similar machine was in successful operation in the years 1829 and 1853 does not furnish a sufficient ground for the jury to presume that it had been in continuous operation during the intermediate time.

The fifteenth section of the patent act of 1836, which allows the defendant to give in evidence that the improvement had been described in some public work anterior to the supposed discovery of the patentee, does not make the work evidence of any other fact except that of the description of the said improvement.

This was a suit brought by McCormick against Seymour and Morgan for a violation of his patent right for reaping machines, which suit was previously before this Court and is reported in 57 U. S. 16 How. 480.

It will be seen by reference to that case that McCormick obtained three patents, *viz.,* in 1834, 1845, and 1847. The suit, as originally brought, included violations of the patent of 1845, as well as that of 1847, but the plaintiff, to avoid delay, proceeded then only in his claim for a violation of the patent of 1847, which consisted chiefly in giving to the raker of the grain a convenient seat upon the machine. When the case went back under the mandate of this Court, the claim was for the violation of the patent of 1845, that of 1847 being mentioned only in the declaration, and not brought before the court upon the trial, the main question being the violation of the patent of 1845.

McCormick's claim in the patent of 1845 was as follows, *viz.:*

"I claim, 1st, the curved or angled downward, for the purpose described bearer, for supporting the blade in the manner described."

"2d. I claim the reversed angle of the teeth of the blade, in manner described."

"3d. I claim the arrangement and construction of the fingers, or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described."

"4th. I claim the combination of the bow, L, and dividing iron, M, for separating the wheat in the way described."

"5th. I claim setting the lower end of the reel post, R, behind the blade, curving it at R2, and leaning it forward at top, thereby favoring the cutting, and enabling me to brace it at top by the front brace S as described, which I claim in combination with the post."

The fourth and fifth claims were those which were alleged to have been infringed.

The defendants pleaded the general issue, and gave notice of various prior inventions and publications in public works, which they designed to give in evidence in their defense. The last trial was had in October, 1854, when the plaintiff obtained

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a verdict for $7,750, and judgment was entered in June, 1855, for $10,348.30.

There were twenty exceptions taken in the progress of the trial, twelve of which were as to rulings upon points of evidence, which it is not material to notice. The remaining eight were to portions of the charge of the court to the jury.

The defendants, in addition to other matters of defense, alleged that the second claim was not new, and that as there had been unreasonable delay in the disclaimer of it, the plaintiff was not entitled to recover at all, and at all events was not entitled to recover costs.

Only such portions of the charge of the court to the jury will be here inserted as were the subjects of the opinion of this Court.

One part of the charge was as follows, *viz.:*

"The claim in question is founded upon two parts of the patent. As the construction of that claim is a question of law, we shall construe it for your guidance. In the fore part of the patent we have a description of the blade, and of the blade case, and of the cutter, and of the mode of fastening the blade and the blade case and the cutter, and of the machinery by which the arrangement is made for the cutter to work. We have also the description of the spear-shaped fingers and of the mode by which the cutter acts in connection with those fingers. Then, among the claims are these:"

" 2. I claim the reversed angle of the teeth of the blade in manner described."

" 3. I claim the arrangement of the construction of the fingers, or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and

for the purpose described."

"Now it is insisted, on the part of the learned counsel for the defendants that this second claim is one simply for the reversed angles of the sickle teeth of the blade. These teeth are common sickle teeth, with their angles alternately reversed in spaces of an inch and a quarter, more or less. The defendants insist that the second claim is merely for the reversed teeth on the edge of the cutter, and that the reversing of the teeth of the common sickle as a cutter in a reaping machine was not new with the plaintiff, and that if it was new with him, he had discovered it and used it long before his patent of 1845. The defendants claim that Moore had discovered it as early as 1837 or 1838, and it would also seem that the plaintiff had devised and used it at a very early day after his patent of 1834 -- that is, the mere reversing of the teeth. But, on looking into the plaintiff's patent more critically, we are inclined to think that when the plaintiff says, in his second claim, 'I claim the reversed angle of the teeth of the blade, in manner described,' he

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means to claim the reversing of the angles of the teeth *in the manner previously described in his patent.* You will recollect that it has been shown in the course of the trial that in the operation of the machine, the straw comes into the acute-angled spaces on each side of the spear-shaped fingers, and that the angles of the fingers operate to hold the straws, while the sickle teeth, being reversed, cut in both directions as the blade vibrates. The reversed teeth thus enable the patentee to avail himself of the angles on both sides of the spear-shaped fingers, whereas, if the sickle teeth were not reversed in sections, but all ran in one direction like the teeth of the common sickle, he could use the acute angles upon only one side of the fingers, because the cutter could cut only in one direction. We are therefore inclined to think that the patentee intended to claim by his second claim the cutter having the angles of its teeth reversed, in connection with the angles thus formed by the peculiar shape of the fingers. And, as it is not pretended that any person invented that improvement prior to the plaintiff, the point relied on in this respect by the learned counsel for the defendant fails."

The other parts of the charge which were excepted to by the counsel for the defendants were thus specifically mentioned.

To so much of the charge of the court as instructed the jury, in substance, that the plaintiff, in his patent of January 31, 1845, did not claim the reversed angle of the teeth of the blade as a distinct invention, but only claimed it in combination with the peculiar form of the fingers described in the same patent, the defendant's counsel excepted.

The defendant's counsel requested the court to instruct the jury that if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of that fact by the testimony of Moore on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then, in judgment of law, he has unreasonably delayed filing his disclaimer, and the verdict should be for the defendants.

The court declined so to instruct the jury, and the defendant's counsel excepted to the refusal.

The defendant's counsel further requested the court to instruct the jury that if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of that fact by the testimony of Hiram Moore on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then it was a question of fact for them to decide whether the plaintiff had or had not unreasonably delayed the filing of a disclaimer,

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and, if they should come to the conclusion that there had been such unreasonable delay, their verdict should be for the defendants.

The court refused so to instruct the jury, and the defendant's counsel excepted to the refusal.

The defendant's counsel requested the court to submit to the jury the question under the evidence in the case whether the plaintiff did or did not claim, in his

patent of January 31, 1845, the reversed angle of the teeth of the blade, independent of any combination.

The court refused to submit that question to the jury, and the defendant's counsel excepted to the refusal.

The defendant's counsel also asked the court to instruct the jury that, from the facts that Bell's machine operated successfully in 1829 and that it operated well also in 1853, they were at liberty to infer that it had operated successfully in the intermediate period or some part of it.

But the court held and charged that, there being no evidence respecting it except at the trial of it in 1829 and the trial of it in 1853, the jury could not infer anything on the subject, and refused to charge as requested. The defendant's counsel excepted to the refusal, and also excepted to the charge in this respect.

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MR. JUSTICE NELSON delivered the opinion of the Court.

The suit was brought by McCormick against Seymour and Morgan, for the infringement of a patent for improvements in a reaping machine granted to the plaintiff on the 31st June, 1845. The improvements claimed to be infringed were 1st, a contrivance or combination of certain parts of the machinery described, for dividing the cut from the uncut grain, and 2d, the arrangement of the reel post in the manner described, so as to support the reel without interfering with the cutting instrument.

In the course of the trial, a question arose upon the true construction of the second claim in the patent, which is as follows: "I claim the reversed angle of the teeth of the blade in manner described." This claim was not one of the issues in controversy, as no allegation of infringement was set forth in the declaration. But it was insisted on the part of the defendants that the claim or improvement was not new, but had

before been discovered and in public use, and that under the ninth section of the Act of Congress passed March 3, 1837, the plaintiff was not entitled to recover cost, for want of a disclaimer of the claim before suit brought, and that if he had unreasonably neglected or delayed making the disclaimer, he was not entitled to recover at all in the case.

The ground upon which the defendants insisted this claim was not new was that it claimed simply the reversed angle of the teeth of the blade or cutters. The court below was of opinion that, reading the claim with reference to the specification in which the instrument was described, it was intended to claim the reversed angle of the teeth in connection with the spear-shaped fingers arranged for the purpose of securing the grain in the operation of the cutting -- the novelty of which was not denied.

The majority of the Court is of opinion that this construction of the claim cannot be maintained and that it is simply for the reversed angle of the cutters, and that there is error, therefore, in the judgment in allowing the plaintiff costs.

In respect to the question of unreasonable delay in making the disclaimer as going to the whole cause of action, the Court is of opinion that the granting of the patent for this improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in correcting the claim, and that, under the circumstances, the question is one of law. This was decided in the case of *The Telegraph,* 15 How. 121. THE CHIEF JUSTICE, in delivering the opinion of the Court, observed that

"the delay in entering it the disclaimer is not unreasonable, for the objectionable claim was sanctioned by the head of the office; it has been held to be valid by a circuit court, and differences of opinion in relation to it are found to exist among the Justices of this Court. Under such circumstances, the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

Several other questions were raised in the case, which have been attentively considered by the Court and have been overruled, but which it cannot be important to notice at large, with one exception, which bears upon the fifteenth section of the patent act of 1836.

Bell's reaping machine was given in evidence, in pursuance of a notice under this section, with a view to disprove the novelty of one of the plaintiff's improvements; a description of it was read from "Loudon's Encyclopaedia of Agriculture," published in London, England, in 1831. In addition to the description of the machine, it appeared in the work that the

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reaper had been partially successful in September, 1828 and 1829.

It also appeared, from the evidence of Mr. Hussey that he saw it in successful operation in the harvest of 1853.

The court was requested on the trial to instruct the jury that from the facts that Bell's machine operated successfully in 1829 and in 1853, they were at liberty to infer that it had operated successfully in the intermediate period, which was refused. Without stating other grounds to justify the ruling, it is sufficient to say that the only authority for admitting the book in evidence is the fifteenth section of the act above mentioned. That section provides that the defendant may plead the general issue and give notice in writing, among other things, to defeat the patent "that it the improvement had been described in some public work anterior to the supposed discovery thereof by the patentee." The work is no evidence of the facts relied on for the purpose of laying a foundation for the inference of the jury sought be obtained.

The judgment of the court below is affirmed, with the qualification, that on the case being remitted to the court below, the taxation of costs be stricken from the record.

MR. JUSTICE GRIER dissented.

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, excepting that part embracing the taxation of costs in the circuit court, be and the same is hereby affirmed with costs. And it is further ordered and adjudged by this Court that this cause be and the same is hereby remanded to the said circuit court with directions to strike from the record the taxation of costs in this cause.