

Burr Vs. Duryee

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Court : US Supreme Court

Decided On : 1863

Appeal No. : 68 U.S. 579

Appellant : Burr

Respondent : Duryee

Judgement :

Burr v. Duryee - 68 U.S. 579 (1863)

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Burr v. Duryee

68 U.S. (1 Wall.) 579

APPEAL FROM THE CIRCUIT COURT

FOR THE DISTRICT OF NEW JERSEY

SYLLABUS

The "Boyden machine" does not infringe the patent of A. B. Taylor. The practice of reissuing patents for the purpose of interpolating abstract generalizations so as to cover subsequent inventions made by others is condemned.

Bill in chancery, by which the complainant charged that the defendants were using a certain machine for the manufacture of hat bodies, which infringed a patent originally granted in 1856 to a certain A. B. Taylor, and subsequently, in 1860, reissued, for hardening the bodies of hats by means of rollers while on the perforated cone upon which they had been formed, with a contrivance to give them the reciprocating motion required in the operation of being hardened. In the original patent of Taylor, of 1856, the claim was limited to his "*arrangement*" for hardening the body in a dry state, by "*machinery operating substantially as set forth.*" The complainant, who had purchased this patent, afterwards, however, saw the machine known as Boyden's, and more particularly described in the preceding case. He then (1860) surrendered his patent and obtained a reissue, in which he altered his claim of invention from an "arrangement of machinery" to a claim for a "vibrating concave surface."

The difference between the invention as claimed in the original patent, and as subsequently set forth, as well as the general nature of his invention and claim, will appear more minutely by the setting them out *seriatim*.

" *Original Patent, 1856* "

"The object of my improvements is to harden the bat sufficiently to permit it to be removed from the perforated cone without the application of water, and to facilitate the removal of the bat from the cone without requiring the latter to be taken from its position in the machine. These improvements consist in a mechanical process of hardening the bat before it is removed from the cone, and in facilitating the removal of the bat from the cone by means of a blast of air forced through the cone. There are also various improvements in the arrangement and construction of the machinery devised by me, as will hereinafter more fully appear."

" *Claim* "

"What I claim as my invention and desire to secure by Letters Patent, is the arrangement for hardening the hat body in a dry state, by *machinery operating substantially as herein set forth.* "

" *Reissue, 1860* "

"My said invention, which relates to the hardening of the bat on the pervious cone on which it is formed, and while the fibers constituting the bat are held to the surface of the cone by the pressure of the surrounding air, consists in combining with a perforated cone, on which the bat of the fibers is held by the pressure of the surrounding air, a *vibrating concave surface, held by pressure, so as to act on the convex surface of the bat as it is vibrated*, by means of which combination a large segment of the bat, along its entire length, is acted upon at once by the concave surface, while, by the rotation, every part of the circumference is brought, in succession, under the hardening operation."

" *Claim* "

"What I claim as my invention is, the combination *of a vibrating concave surface*, substantially as described, with an exhausted pervious cone, on which the bat of flocculent fibers is held by the pressure of the surrounding air, *substantially as and for the purpose specified.* "

The argument was chiefly upon the points, how far the reissue was for a principle or function as distinguished from a machine, and how far such a patent was valid; and also, whether the reissue was or was not for the same thing granted in the original patent; matters discussed much more fully in the principal case.

MR. JUSTICE GRIER delivered the opinion of the Court.

After the observations made in the preceding and principal case, it is not necessary to make further remarks on the art of extending patents. It may be ranked "*INTER INGENUAS ARTES*," and may have the claim of novelty, if not of usefulness.

In this case, the invention of Taylor was the application of pressure by means of rollers, with a contrivance to give them the reciprocating motion necessary to this process of hardening. He was not the inventor of the conical cover used in hardening hat bodies formed on a cone, nor of rubbing them by a reciprocating

motion, but merely of a certain combination of devices of produce a certain effect. Both the operation and the result were well known, and the invention consisted only of the devices combined to perform the operation and produce the result. It was open to every other person to make any other combination of devices to perform the operation, which was not a mere colorable adoption of the patentee's combination. The original specification of Taylor is drawn with sufficient care and

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judgment to cover all the patentee knew he had invented, and the whole machine as described therein.

A comparison of the devices used in the two machines would be unintelligible without models or drawings. The Taylor patent is but for a form, or rather a combination of known devices, to perform a certain operation and produce a certain desirable effect. The combination used by Boyden is not a mere colorable or substantial adoption of the same combination of devices. It has as much claim to originality as that of Taylor; but it has a vibrating concave surface of cloth, pressing against the cone. Accordingly, the reissued patent to Taylor, or rather to Burr, got up after an examination of Boyden's machine, contained this interpolation in the description of his invention, "*A vibrating concave surface held by pressure,*" &c.; and the claim extended to the "combination of a vibrating concave surface;" then follow the words, "*substantially as described.*" In a contest with a previous patent, the last words can be called in to qualify the first, and narrow it down to the peculiar combination of devices described; while, in assaulting a new combination, for the purpose of suppressing it, the claim may be stretched to cover every machine having a "concave vibrating surface," by calling all the other parts "equivalents."

It is plain that this interpolation of an abstract generalization, to render the specific description of the concrete machine more elastic, was suggested by an examination of the Boyden machine. If the same construction be given to the claim of Taylor, as it would necessarily invoke in a contest with preceding inventions, to save it from the charge of being too broad, the Boyden machine would be properly

pronounced as no infringement; on the contrary, such a construction of it as would include the Boyden machine, would make it void for being too broad. It matters little on which horn of this dilemma the case be put, the result must necessarily be the same.

Decree affirmed with costs.

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