Case Vs. Brown

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Appeal No. : 69 U.S. 320

Appellant : Case

Respondent : Brown

Judgement :

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SYLLABUS

A claim for a combination of several devices, so combined together as to produce a particular result, is not good as a claim for " *any mode of combining* those devices which would produce that result," and can only be sustained as a valid claim for the peculiar combination of devices invented and described. *Burr v. Duryee,* 1 Wall. 535, affirmed and applied.

Among the inventions of our country that have assumed great value -- especially in the regions of the West, where Indian corn in largely produced -- are those known as CORN-PLANTERS. The machine consists of a mechanism resembling somewhat, in external appearance and in section view, a high plough on wheels. It is drawn by a horse while a man walks behind and manages it. The object is to plant corn at spots, which spots shall be both equidistant and in rows.

The corn to be planted is placed in a hopper or sort of box, which is fixed in the body of the machine, and at proper intervals as the machine is drawn by the horse, the grains are permitted to enter and fall through a valve, *at the base* of a short vertical spout to the ground, another valve being at the top of the spout. If the grains were permitted to fall through the *full length* of the spout as the machine passed on by a valve at the *top only* of the spout, they would not reach the ground exactly under the place at which the valve was opened, inasmuch as in the interval of time that the grain was descending through the spout, the machine would have passed over a certain space of ground in being drawn along by the horse. But by employing two valves, one opening into the upper end of the spout from the hopper and one at the bottom of the spout in close proximity with the ground, correct dropping is insured, the forward motion of the machine being compensated for by the double valves.

A certain Jarvis Case had invented one of these corn planters, and took a patent for it in January, 1845. In *this* patent he limited his claim to the particular combination of parts which constituted his machine. In November, 1858,

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he surrendered his patent and obtained a reissue with a more expanded claim. That claim was thus:

"I claim, in combination with a corn planting machine that is constantly moved over the ground and drops the grain intermittently, *the so combining of two slides, one of which is at or near the seed hopper and the other at or near the ground,* or their equivalents, with a lever as that the operator or attendant on the machine can

open said slides at the proper time to deposit the seed and prepare a new charge by the double dropping herein specified."

The cut below shows in section the combination or arrangement.

image a:

A is the hopper which carries the corn, B the seed slide or valve leading from the hopper to the seed tube E, C is the seed cup in the seed slide, D is the cut-off in the hopper, E is the seed tube, F is the slide or valve to seed tube, G is the hand lever by which the tubes are opened and closed in the plaintiff's machine, H the recoil spring by which the slide valves B and the valve F are simultaneously closed when the hand is removed from lever G. [Footnote 1]

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In this machine of Case's, a lever G, of a peculiar form, was used, which, by being pressed down, effected two operations, *viz.:* it carried the charge of grain out of the seed box and dropped it into the tube E and it raised the slide F to let out the previously dropped charge. Thus, the same operation that planted one charge put the next succeeding charge in close proximity to the ground so that it had but a few inches to fall when the valve or slide F was opened.

About the same time that Case originally invented his machine, a person named Brown invented one also, and got a patent in May, 1855. The parties were independent inventors. In its essential features, Brown's machine differed from Case's in not employing a lever having a weight or a spring or automatic device to return it to its position and close the valves, although the same final result, namely, the simultaneous double dropping of the seed, was accomplished by one motion of the hand of the operator in both cases. The cut below will exhibit the combination and arrangement in this second invention.

image:b

A here represents the hopper carrying the grain, B the slide valve, and C the seed cup between the hopper and the seed tube E, and F the slide valve which permits the seed to pass from the lower end of the seed tube to the ground.

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G is the lever. When the upper end of this lever G is moved from the position shown in the drawing towards the hopper A, it is evident that the grain cup C would be carried over and discharged into the tube E, and the same movement of the lever G would move the slide valve F so as to permit the grain which it retained at its lower extremity to fall to the ground. *Each* movement of the lever, with this *double seed tube,* whether forward or back, produced a "drop."

Thus, a similar double dropping of grain was accomplished in this machine of Brown as was accomplished in the machine of Case, but there was no spring or automatic recoil arrangement attached to the lever G for restoring it to its former position, as it is on the plaintiff's machine. It required to be worked by hand in both directions.

Case now sued Brown in the Circuit Court of the Northern District of Illinois for infringing his reissued patent. The action was case. On this trial his counsel requested the court to charge the jury:

"That the plaintiff, in and by his patent, claims any mode of combining a valve in the seed tube, and a valve in the seed hopper, or their equivalents, with a lever, as that the operator may *by one operation or the application of one muscular force* carry a charge of corn from the seed hopper into the seed tube and arrest it at the lower valve, and *by the same operation or muscular force* let out from the lower valve and drop into the furrow a charge of corn, previously dropped and lying at the lower valve."

"That the plaintiff by his patent is not confined to the *peculiar means of returning the seed slide* which he has adopted in his said model. That his claim covers *any arrangement* to operate the valves and lever which will produce the result, although he may not in the other machine employ the rock shaft and weighted

lever, or any automatic element. He may employ some substitute for the automatic element, *so that he by one operation, or the application of a single muscular force* applied to the lever, drops from the lower valve and supplies a new charge to take its place *by the same operation or muscular force* so as aforesaid applied to the lever, combined with the valve at the seed tube and the valve at the seed hopper, or their equivalents. "

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[As bearing on the interpretation asked for by defendant and adopted by the court below, it is to be noted that on the question of the prior state of the art to the plaintiff's invention, the defendant proved at the trial that a seed planting machine had been invented and used to a limited extent and a description thereof filed in the patent office as early as 1852 by one Charles Finn in which was combined the two slides and lever for accomplishing the same final result as in the plaintiff's machine. A sectional drawing of Finn's machine is given below, in which the corresponding letters are used as in the other two plates.]

image:c

[A, being the hopper, B the slide valve, C the seed cup, E the seed tube, F the slide valve, and G the lever -- this arrangement agreed with the plaintiff's arrangement in nearly every respect in which the defendant's machine did, and differed from the plaintiff's in having no automatic recoil attachment to the lever, such as a weight or spring.]

The court below refused to charge as requested by the plaintiff, but charged in substance that the thing patented to him was a technical combination consisting of certain elements, and that to constitute an infringement, all these elements must be used by the defendant; that among these is that particular kind of lever G, described by the patentee,

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which is so combined with a weight or spring that when the valve has been opened by the hand of the operator moving the lever in one direction, the weight, acting through the lever and moving it in the reverse direction, causes the valves to close, and that unless the defendant's machine *employs a lever having the same mode of operation* -- that is to say the peculiar arrangement described by the patentee for moving it in the reverse direction, or some other arrangement which is a mere mechanical equivalent therefor -- the patent is not infringed.

The language of the court as quoted exactly was this:

"In order to constitute an infringement, the whole combination must be used, because he claims not the various parts, but the whole combination together. The plaintiff cannot claim what is called double dropping of corn -- that is, a *result* or an *effect.* He can only claim the double dropping by the particular mode which he has devised. Anyone can produce the same results by other and different modes and still not violate the claim of the plaintiff. In order to constitute a violation, there must be a use of the same methods substantially as those adopted by plaintiff. A mere change of form, for example, in the lever and its mode of operation, the adoption of some equivalent suggested by mere mechanical skill, would not prevent it from being an infringement; otherwise, if the change were one of substance and requiring the exercise of inventive power."

Thus, the charge made the case turn on the question whether the defendant employed in his machine, as one element of his combination, a lever having the same mode of operation as that of the plaintiff, to-wit, having two motions in opposite directions at every dropping, one produced by the hand of the operator to open the valves, and the other by an automatic arrangement to close them.

Of course the charge was in opposition to the plaintiff's request, and the jury having found a verdict for the defendant, the case was brought by writ of error to this Court.

MR. JUSTICE GRIER delivered the opinion of the Court.

The error alleged is the refusal of the court to give certain instructions, the substance of which, when extricated from the mass of verbiage with which it is encumbered, seems to be "that the plaintiff had a right to claim any mode of combining" the various mechanical devices in the improved machine which would produce the same effect or result as mere equivalents for those described in his patent. The court refused to give this instruction to the jury, but on the contrary instructed them in the language quoted

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in the reporter's statement. [Footnote 2] The instruction there quoted is a correct exposition of the law, and if it produced a verdict in favor of defendant, the plaintiff had no right to complain.

The plaintiff's original patent limited his claim, very properly, to the particular devices and combination of parts which constituted his improved machine. But as this claim was not broad enough to cover the improvement described in defendant's patent, the plaintiff surrendered his, and had it reissued with a more *expanded claim.* It is for the infringement of this reissued patent that the action is brought.

We have had occasion to remark in a late case [Footnote 3] on this new art of expanding patents for machines into patents for "a mode of operation," a function, a principle, an effect or result, so that by an equivocal use of the term "equivalent," a patentee of an improved machine may suppress all further improvements. It is not necessary again to expose the fallacy of the arguments by which these attempts are sought to be supported, though we cannot hinder their repetition.

Let the judgment be affirmed.

[Footnote 1]

This recoil spring, H, relieved the operator from replacing or pushing back the lever with his extended arm, a matter which, when to be performed many hundred

times a day, makes a large demand on muscular strength. *With* the recoil spring, *one* muscular effort did the work of two.

[Footnote 2]

Supra, p. <69 U.S. 325|>325.

[Footnote 3]

Burr v. Duryee, 1 Wall. 535; *See also* *McCormac v. Talcott,* 20 How. 405.