

Statement of the case.

TURRILL v. THE MICHIGAN SOUTHERN, &c., RAILROAD COMPANY.

1. Patents for inventions are not to be treated as mere monopolies, and therefore as odious in the law, but are to receive a liberal construction, and under a fair application of the rule that they be construed *ut res magis valeat quam pereat*. Hence, where the "claim" immediately follows the description, it may be construed in connection with the explanations contained in the specification; and be restricted accordingly.
2. Where a plaintiff, having a patent for an improved machine, his "improvement" consisting in certain pieces of mechanism *described*, having *peculiar characteristics described*; the pieces of mechanism being combined by means *described*, so as to produce a particular result *described*, an admission by him that pieces of mechanism in their general nature like his, and used for "various purposes," were older than his invention, is not an admission that these machines were the same as his; and the fact whether they were or were not, is a question for the jury, and not for the court.
3. The patent granted, September 9th, 1856, to Cawood for an "improvement in the common anvil or swedge-block, for the purpose of welding up and re-forming the ends of railroad rails when they have exfoliated or become shattered from unequal wear, occasioned by the inequalities of the road," &c., is a patent in which special devices are described as combined and arranged in a particular manner, and as operating only in a special and peculiar way for a special purpose, and to effect a special result. It is not a claim for any kind of movable press-block, combined and operating in any way with any kind of fixed block to accomplish any purpose, or effect any kind of result.

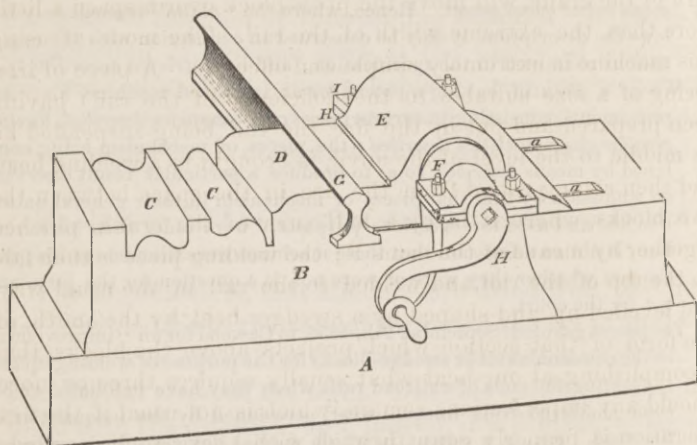
THIS was a writ of error to the Circuit Court for the District of Michigan. The action was trespass on the case brought against the Michigan Southern and Northern Indiana Railroad to recover damages for the alleged infringement of a patent; the defence having been want of originality in the invention.

The patent, which was granted originally to one Cawood, dated September 9th, 1856, was for "*a new and useful improvement in the common anvil or swedge-block, for the purpose of welding up and re-forming the ENDS of railroad rails when they have exfoliated or become shattered from unequal wear, occasioned by the inequalities of the road; six inches or so of the extreme end of the rail being frequently destroyed, while the remainder is perfectly sound.*"

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The schedule ran as follows :

"I do hereby declare that the following is a full, clear, and exact description of the construction and operation of the same, reference being had to the annexed drawings, making a part in this specification and giving a perspective view of the machine :



A, representing the bed-sill on which the anvil is placed ; B the anvil or swedge-block of cast iron ; C C recesses, or dies across the face, the shape of the side of the rail ; D solid block, making a part of anvil, with its side shaped to the side of the rail, while placed in its natural position ; E a movable press-block held down to anvil by dovetail tongues, on the anvil and grooves in the movable press-block, and operated by two eccentric cams, F, back and forth, in a longitudinal direction, to press the rail together while forming its end, and with sufficient travel to extricate the rail without altering its vertical position ; G a rail of the T form, in its position, between the press-blocks.

"I usually make my improved anvil and swedge-block of cast iron, between four and five feet long and sixteen inches across the face, with two forms or recesses C C at one end, right and left, of a form corresponding with the side of the rail. Close to these is cast a raised block D, nearly as high as the rail, and with its farthest edge also shaped to fit the side of the rail when it lays across the anvil in its natural position. Next this I attach to the face of the anvil, by dovetail tongues and grooves, or any

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other convenient manner, what I call a movable press-block E, with a similar but reverse-shaped edge, laying opposite the other so as to inclose the rail between the two, as in the jaws of a vice. This block I work by two eccentric cams F on a shaft, which is attached to the anvil by two standards H H, with bearings I I, either cast on or bolted to the edge of the same, so that half a turn of the crank will move the press-block over a space a little more than the extreme width of the rail. The mode of using this machine is extremely simple and effective. A piece of iron (being of a size suitable to the deficiency of the rail) having been prepared and put in the fire, the rail being suspended by its middle to the level of the anvil, is brought to a welding heat, and then swung round from the fire in the space between the two blocks, where it is, by a half turn of the crank, pinched together by means of the cams F; the welding-piece is then laid on the top of the rail and welded to the rail in the usual way, and levelled up and shaped by a swedge, held by the smith, of the form of that section which projects above the blocks, thus accomplishing at one heat what usually requires three or more. Should any imperfections remain, which is not usual if the first operation is properly gone through with, they can be removed by proper hand swedges after placing the rail in the recesses C C for that purpose."

The claim was thus:

"I do not claim the anvil-block nor its recesses; but what I do claim as my invention, and desire to secure by letters patent, is the movable press-block E, having its edge formed to the side of the rail G, in combination with another block D, with its edge of a similar but reversed form (the movable blocks to be operated by two cams, F, or in any other convenient manner), *for the purpose of pressing between them a T, or otherwise shaped rail; thereby greatly facilitating the difficult operation of welding and renewing the ends of such rails after they have been damaged, in the manner herein described and set forth.*"

Having put the patent in evidence, shown an assignment of it to the plaintiff, and otherwise made out a *prima facie* case, the plaintiff rested. The defendants then introduced models of certain machines, for the purpose of showing that

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the invention was not original. The models thus introduced were of the following machines: 1st. Of an angle-iron machine. 2d. Of an anchor machine. 3d. Of a bayonet machine. 4th. Of a machine patented in England to one Church.

On most or all of these, *movable and fixed blocks were used*; but it remained a question to be solved by inspection, whether the *forms* of these blocks and the *manner* in which they were combined, and the *means* by which they were moved and held, were or were not adapted to the welding up and re-forming the ends of railroad rails when exfoliated or shattered from unequal wear. The plaintiff, however, *admitted*, his admission being according to the bill of exceptions taken and sealed in the case, exactly in these words, "*that movable press-blocks, in combination with faces of various shapes, and used for various purposes, were older than the alleged invention of Cawood, the patentee.*"

The evidence being closed, the plaintiff requested the court to charge the jury "that the invention patented consisted of the movable press-block and the block D, in combination with the anvil or swedge-block B, described in said specification." This instruction the court refused; and charged essentially as follows:

"In the view which the court takes of the case, *there will be no question of fact for you to decide.* According to the construction which the court has heretofore given to the patent, and which it now repeats, the patentee claims as his invention the movable press-block *E*, having its edge formed to the side of the rail *G*, in combination with another block *D*, the movable blocks to be operated by two cams, or in any other convenient manner. The specification shows that the block *D* is fixed and to be a part of the anvil or swedge-block, in combination with which, as well as with the fixed block, the movable block is to be used. Movable press-blocks in *such* combinations, with faces of various shapes, and used for various purposes, it is clearly proved and *frankly admitted*, are greatly older than the alleged invention of the patentee. The models exhibited in evidence of the 'angle-iron machine,' the 'anchor machine,' the 'bayonet ma-

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chine,' and those made from the descriptions contained in the English patent of Church, are only some of the examples of their use and application. The patentee therefore claims that of which he is not the inventor. This fact is fatal to the patent, and entitles the defendant, *as matter of law, to your verdict.*

"If it be said that the claim is for the shape of the faces of the blocks, and the uses to which they are to be applied, the answers are :

"1st. A mere change of form is not a patentable subject.

"2d. The use of a machine or invention for a new purpose is also not patentable.

"3d. It was the duty of the patentee to describe clearly what he claims as his invention, so that it might be distinguished without doubt or difficulty from everything else to be used in connection with it. This has not been done. If the limited construction here under consideration be deemed the correct one, still this objection would be fatal, and your verdict the same. We are, however, satisfied that the true construction is the more comprehensive one, and that patentee claims the movable block in combination with the fixed one, and that the shape and proportions of the cheeks are only incidents and matters of detail."

The plaintiff took exceptions to the following among other parts of the charge :

First. To so much as stated that "the movable press-blocks in such combination, with faces of various shapes, and used for various purposes, being greatly older than the alleged invention of the patentee, was fatal to the patent, and entitled the defendant, as a matter of law, to the verdict of the jury."

Second. To so much as stated that, "in the view which the court takes of the case, there would be no question of fact for the jury to decide."

The chief question, therefore, in error was, whether the court had or had not decided a question of fact; and so withdrawn the case improperly from the jury; and this chief question involved, as a previous one, the question whether the court had or had not rightly construed the patent?

Argument for the plaintiff in error.

Mr. B. R. Curtis, for the plaintiff in error :

1. *As to the construction of the patent.* The claim is not one of *any kind* of movable press-block, combined and operating in *any way*, with *any kind* of fixed block, to accomplish *any purpose*. But it is a claim of *such* a movable press-block as is described, and *such* a movable fixed block as is described, arranged as described, and combined and operating in the particular way described, for the purpose of effecting the particular result indicated.

The patentee declares the sole *purpose* of the invention to be, "welding up and re-forming the ends of railroad rails, when they have become exfoliated or shattered;" and in describing the manner of constructing and using the machine, he shows it *to be designed for that purpose, and for that purpose only*. At the conclusion of the claim, he again declares the object of the machine to be "the difficult operation of welding and renewing the ends of *such rails*" (*i. e.* railroad rails), "after they have been damaged."

So far as respects *the result* to be effected, it is clearly shown to be, that single, special, and peculiar result of so placing and holding railroad rails, as greatly to facilitate the operation of renewing the ends of such rails by welding.

It is equally clear, that what the patentee intended to include in his claim was not *any* press-block or *any* fixed block, but *the* press-block and *the* fixed block which he has described.

I. Because the patentee, at the beginning of his specification, after stating that he has invented a new and useful improvement, says: "And I do hereby declare that *the following is a full, clear, and exact description of the construction and operation of the same.*" When he comes to make his claim, it is but just to the patentee to believe that he does not intend to claim as his own anything which is entirely outside of what he has described as his invention.

II. Because the language of the claim itself is not extended to *any* movable or *any* press-block, but is clearly limited to "*the* movable press-block E" "and *the* block D"—thus identifying the two elements of the combination, as being such a press-

block and such a raised fixed block as he had previously described, and had shown on the drawings by the designation of those letters.

Nor is the mode of arranging, combining, and operating these elements, which was intended to be claimed, left in any doubt. The patentee, in the specification, declares "that the following is a full, clear, and exact description of the *construction and operation* of the same." He gives also a clear description of his particular mode of arranging, combining, and operating the movable and the fixed block. And when he arrives at the claim, after saying he claims the movable block, in combination with the fixed block, he adds, "*in the manner herein described and set forth.*" Specifications are entitled to a liberal construction;* though there is no necessity for any special liberality here.

Then the blocks E and D, and the described mode of arranging, combining, and operating them, *have peculiar characteristics*. The specification says of block D that it is a "solid block, *making a part of the anvil*, with its side shaped to the side of the rail, while placed in its natural position." And again, "*Close to these (i. e. close to the recesses C C in the 'improved anvil')* IS CAST a raised block D, *nearly as high as the rail, and with its farthest edge also shaped to fit the side of the rail*, when it lays across the anvil in its natural position." It thus appears that this block D is a solid projecting part of the "improved anvil;" it is cast with it; as the specification declares, it is "a solid block, making a part of the anvil." Its outer face is shaped to correspond with one side of the rail when laid upon the anvil; and its office is, not merely to resist the pressure exerted on the rail by the movable block, *but to resist the force exerted upon the rail by the hammer in welding, and thus preserve the shape of the rail*. Three characteristics are here set forth, and each is essential to enable the block D to perform its appropriate functions in the combination.

The specification describes block E as a movable press-

* *Winans v. Denmead*, 15 Howard, 341, and cases there cited.

Argument for the plaintiff in error.

block, held down to the anvil by dovetail tongues on the anvil, and grooves on the movable press-block. Again. "Next this (*i. e.*, next the block D), *I attach to the face of the anvil*, by dovetail tongues and grooves, or in any other convenient manner, what I call a movable press-block E, with a similar but reverse-shaped edge, lying opposite the other, so as to inclose the rail between the two, as in the jaws of a vice." Here, too, are three characteristics, and each is also essential to enable the block E to enter usefully into the improved combination.

Then as respects the described mode of combining and working the blocks D and E. The specification declares that the block D is cast on and makes part of the anvil; and that the block E is held down to the anvil by dovetailed grooves and tongues. The two blocks are thus kept in certain relations to each other by and through the anvil, which thus forms one of the essential means of combining and operating them. They are connected with the anvil; and through that connection they are enabled to operate in combination, each performing its appropriate function, in harmony with the other, and their combined operation produces the specific desired result of holding and so supporting the rail on the anvil that it can be welded without destroying its peculiar form.

But, first, the block E must be moved on the anvil; and these means of motion must be such *that the entire face of the block E shall be kept parallel with the entire opposite face of the block D*, so as to exert the same pressure on every part of both faces of the rail. And second, the means of movement must be such, that when the block E has been advanced to its forward position, so as to grasp the rail and press it against the block D, *the machinery shall hold E rigidly in position*, not allowing it to be forced at all out of its position, otherwise the heavy blows necessary to weld the iron would destroy the shape of the rail. And a third result is, to produce the desired backward and forward movements and this rigidity, by simple and sufficient means, readily worked, either by hand or power.

Argument for the plaintiff in error.

All these necessities are met by means of the tongues and grooves, and the two eccentric cams, which cams, by a half revolution of a crank, advance the entire face of the block E parallel to the opposite face of the block D, until the rail is grasped, thus exerting the same pressure on every part of both faces of the rail, holding E rigidly in that position by the strength of the machine, so as perfectly to support every part of the rail against the force of the welding hammer, and by reversing the crank half a revolution, relieving the rail and placing the blocks E and D in position to receive another rail on the anvil.

What is the thing patented? The thing patented is described by *its title* to be "a new and useful improvement in the common anvil or swedge-block, for the purpose of welding up and re-forming the ends of railroad rails when they have ex-foliated or have become shattered," &c. By the *description* which the patentee declares describes "*his improvement*," it appears to be *an improved anvil*; one of the parts of which is the block D, having the characteristics before described; another part of which is the block E, having the characteristics before described; and these two parts are combined and operated in the manner described to produce the effects indicated.

The result of the whole is, that the patentee claims to have taken the common *anvil* or swedge-block, and to have *improved* it by his new combination; and that the combination consists in this, viz.: That he has raised on the anvil a block D, making a part of the anvil, having a face upon it suited to receive the side of the rail, and press equally on it so as not only to grasp but support every part of that face of the rail, under the blows of the welding hammer; that he has combined with this projecting block D, which is part of the anvil, another block E, which is at the same time attached to the anvil and is movable thereon; that this block E is so attached to the anvil *as to be effectually a part of it when the anvil is used as an anvil, to resist the welding blows of the hammer, and to be movable when the objects to be accomplished require it to be moved*; that while this block E is thus an effectual part of

Argument for the plaintiff in error.

the anvil, it is also an effectual and sufficient support of the rail while undergoing the welding blows of the hammer; and in combination with the block D, not only grasps the rail and holds it on the anvil, but supports every part of the two faces of the rail, and keeps them from being forced out of shape by the blows upon the upper surface of the rail in welding its parts.

2. It is obvious that to compare any prior machine with this machine, it is necessary to see if any prior machine was adapted to accomplish the same, or an analogous result, by substantially the same means. Perhaps this is not the strictest possible abstract statement of the true inquiry. This is a patent *for means*, and viewed abstractly, the sole inquiry is, whether the *patented means* are substantially the same as previously existing means. But the application of the patent law rarely admits of such abstraction of means from ends. A new use of an existing machine is not patentable. A modification of an existing machine, whereby it is rendered capable of a new use, is patentable. One of these propositions is just as true as the other. Neither proposition can be safely applied, without careful regard to the facts of the case it is to govern. And, without going upon debatable ground, it is safe to assert, that if there was no prior machine which could accomplish *the same, or an analogous result, by the use of substantially the same means*, the machine is new, under our patent law. The practical results of inventions afford the reasons for the patent laws. They are designed to encourage progress in the useful arts; and therefore to disregard the practical results attained by a patentee would be to lose sight of the final cause of the system. And it is also true, and the more one is conversant with this peculiar subject the more impressed he will be with the truth, that means and ends are inseparably connected, and that it is not one of the cases ordinarily arising under the patent law *that a new and highly useful end has been attained by the application of means already well known and before applied to an analogous end*. It is a possible case; and therefore I stand on this proposition, *that if there was no machine, prior to that of the patentee,*

Argument for the plaintiff in error.

which could accomplish the same useful purpose, or one substantially analogous to it, by the use of substantially the same means, then his patent is valid. Now, in looking at the rulings excepted to, two well-settled rules are to be kept in mind :

I. The question whether any machine, proved, or admitted to have existed before the patentee's invention, was substantially the same as the thing patented, was a question of fact for the jury.

II. The patent is *primâ facie* valid, and the burden of proof is on the defendant. Consequently the defendant was required by law to satisfy the jury, not only that the machine he relies on did exist before the patentee's invention, but that some one of them could accomplish the same useful purpose, or one substantially analogous to it, by the use of substantially the same elements, combined and arranged in substantially the same manner as he described and claimed in his specification.

As to the admission of the plaintiff. Upon such an admission as was made, the patent cannot be declared void, as a conclusion of law, unless it is a conclusion of law that after movable press-blocks, in combination with faces of various shapes, had been used for various purposes, *there was no field of invention left unoccupied* ; or if any such field was left, *that the claim of the patentee is not within that field*.

Now the first of these is manifestly not a conclusion of law. The law cannot determine it to be impossible to make a new combination to produce a new and useful effect because the principal elements have already been combined. A patent for a combination is for an entirety, formed out of the described elements, combined and arranged by the described means and operating in the described manner, to produce the described effect. Though all the elements had previously been combined in *some* way, to produce *some* effect, yet if the patentee modified one or more of the elements, to suit his new design, and combined the elements by different means, and so as to operate in a different way, to produce a new and useful result, it is a new combination and the subject of a patent.

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It is manifestly possible there was a field of invention which could be occupied by a combination of the same elements used here, provided the patentee should modify those elements to adapt them to his new use, and should combine and operate them in a different way, so as to produce a new and useful result; *and it must be a question of fact and not of law whether he has so done.* If he has, he has made a patentable invention; and as a patent has been granted to him, after examination by the proper public officers, it is presumed he has made an invention, until the contrary is shown. Notwithstanding the admission, as there was a field of invention left, he is presumed to have occupied that field, *unless upon the fair construction of his claim it appears he has passed out of that field, and included something which, by his admission, appears to be old.* But it has already been shown that this claim cannot be so construed.

As to the models introduced by the defendant. Though on several of them movable and fixed blocks were used, we assert that on inspection it is obvious that the forms of those blocks, the manner in which they were combined, and the means by which they were moved and held, were not adapted to the new design of the patentee. But if all this should be denied, still *it is a question of fact whether he has done this.* How is the court to say, *as matter of law*, that a machine for holding and supporting rails, under a welding hammer, is substantially the same as a machine for making bayonets, or angle-irons, or anchors? The patent raises a presumption that they are not the same, and without the aid of the jury, how has this presumption been overcome? Yet, upon the introduction of these models, and upon the admission of the plaintiff, as given in the reporter's statement, the court did instruct the jury, *as matter of law, that the patent was void.* The instruction took the entire case from the jury, and no further instruction could be given to them, except the direction, which was given, that the defendant, *as matter of law*, was entitled to their verdict.

This instruction excepted to raises the question whether upon the introduction by the defendants of the models men-

Argument for the plaintiff in error.

tioned in the bill of exceptions, and the admission therein stated to be made by the plaintiff, it *was a conclusion of law* that the thing patented was substantially the same as was exhibited in either of the said models, or as was embraced in that admission; or whether there was still matter of fact to be passed on by the jury. If the claim is construed to be for *such* a press-block as is described, and *such* a fixed block as is described, combined and arranged in the manner described, to produce the effect described, no amount of evidence concerning *the existence* of prior machines could remove from the jury the question whether either of these machines *included this thing claimed by the patentee*. This is a distinct and substantive question, which could arise only after the prior existence of the other machines had been shown to and passed on by the jury.

Now upon this distinct and substantive question, as there does not appear to have been any evidence of experts, it was for the jury, upon an examination and comparison of the prior machines, to find whether either of them embraced the particular combination described and claimed by the patentee; and upon this question the burden of proof was upon the defendant.

The admission of the plaintiff "that movable press-blocks, in combination with faces of various shapes and used for various purposes, were older than the alleged invention," dispensed indeed with the production of evidence of the prior existence of those machines; but the question of fact still remained, *whether either of them included the particular combination described and claimed by the patentee*. It is true that if he had claimed a machine not distinguishable from *any other* having a press-block, in combination with a face of some shape, and used for some purpose, then his admission would have conclusively proved, not only the prior existence of such machines, *but their identity with the thing claimed*; and therefore, though it is not very clearly expressed in any part of the bill of exceptions, it would seem that the court *did give this broad construction to the claim*,—holding it in effect to be a claim of a movable and a fixed block, without regard to any

Argument for the plaintiff in error.

modification made by the patentee of those elements to fit them for his special use, and without regard to the particular manner in which the patentee had combined them so as from the whole to produce a new result, and without regard to the degree of utility of that result. But it has been shown that this is not the true construction.

The rule laid down by the court, that "it was the duty of the patentee to describe clearly what he claims as his invention, so that it might be distinguished *without doubt or difficulty* from everything else," seems hardly consistent with that liberality in the construction of claims, which has been often announced by this court, as due to the nature of the subject, and just to inventors, and which has been so constantly applied by the Circuit Courts in administering the patent laws.* It is a rule which would destroy a very considerable proportion of meritorious patents. But still it might be applied to this specification and leave it valid. For, when it is borne in mind that each of the blocks is carefully described, both in words and by references to the drawings; that the manner of combining and operating them is also carefully and distinctly shown; that the new and useful result is also clearly described, and that the manner in which each part operates in the production of that result is pointed out and exhibited, and that the claim is for "the press-block E, having its edge formed to the side of the rail G, in combination with another block D, with its edge of a similar but reversed form (the movable blocks to be operated by two cams, or in any other convenient manner), for the purpose of pressing between them a T or otherwise shaped rail, thereby greatly facilitating the difficult operation of welding and renewing the ends of such rails, after they have been damaged, *in the manner herein described and set forth*;" it would be doing violence to the clearly expressed intention of the patentee to hold that he has made a broad claim of press-blocks, and faces however formed, combined in any way, for any use.

* *Corning v. Burden*, 15 Howard, 269; *Winans v. Denmead*, 15 Id., 311, and cases there cited.

Mr. Keller, contra:

1. The construction of the claim given by the court below is the true construction of the patent. The prayer to charge, when taken in connection with the charge, leaves no doubt as to the construction which was given to the claim of the patent by the court below. The court was requested to charge that "the invention patented consisted of the movable press-block, and the block D, in combination with the anvil or swedge-block B, described in said specification." The court refused so to charge, but did charge that the patentee claimed as his invention the combination of the fixed with the movable block or jaw, operated by two cams, or in any other convenient manner. And although the court, in the charge, did say that the specification shows that the stationary block or jaw is to be a part of the anvil or swedge-block, and to be used in that combination, nevertheless it is clear that the court refused to consider the anvil as one of the elements of the combination claimed by the patentee. The court below also clearly excludes, from the invention claimed, the shape and proportions of the jaws, holding that these were merely incidental to the use to which the machine was applied.

Now this construction is the true construction, because:

1. The Patent Act of 1836 (§ 6) requires the patentee to give not only a full, clear, and exact description of the manner of making, constructing, and using his invention, but that he shall also "particularly specify and point out the part, improvement, or combination which he claims as his invention."

This provision is based on the presumption that in giving a full, clear, and exact description of the manner of making and constructing a machine, the applicant, unavoidably, will be required to describe many things well known in the arts prior to his invention; hence the necessity for the other provision of the same section, which requires that out of all which he has thus described he shall specify and point out the part, improvement, or combination which he claims as

Argument for the defendant in error.

his invention. In view of this provision the court could not include in the claim of a combination any element not named in the claim, however clearly such part may be presented in that portion of the specification which describes the manner of making, constructing, and using the machine.

II. The elements, which constitute the combination claimed by the patentee, are not only in terms the movable press-block, with its edge formed to the side of the rail, and the stationary block, with its edge of a similar but reversed form; but the better to exclude all other things from the combination intended to be claimed, the patentee has stated that the things so claimed, in combination are "for the purpose of pressing between them a T or otherwise-shaped rail." And although the machine, as an entirety, is stated to be for the general purpose of welding up and re-forming the ends of railroad rails, such general purpose will not justify the introduction of the anvil as one of the elements in the combination claimed, in the absence of all mention of the anvil in the claim, because the purpose specified in the claim, and the office assigned to the combination claimed, is that of pressing or griping the rail, and the anvil performs no office—suberves no duty—in pressing the rail, and it is the duty specified in the claim, and not the use for which the entire machine is designed, which is to control in the construction of the claim.

III. That the patentee did not intend to include the anvil as one of the elements of the combination claimed, appears in the fact that, in the descriptive part of the specification, he designates the several parts by letters of reference to the drawings,—the anvil by the letter B, the stationary press-block by the letter D, and the movable press-block by the letter E—and that in specifying the combination which he claims as his invention, he designates the parts by the same letters, and the letter B does not appear in the claim.

IV. As the movable and the stationary press-blocks are specified in the claim in terms indicated by letters of reference, and perform the whole duty for which the combination is claimed, and as the anvil is not specified in terms in

the claim, nor indicated by letter of reference, and can perform no duty in the purpose for which the combination is claimed, by no rule of construction can the anvil be introduced as one of the elements of the combination claimed.

v. The anvil or swedge-block, described and represented in the patent, could not be claimed in combination with the press-blocks, because it has no mechanical relation to, or dependence upon them. The anvil or swedge-block is indicated in the drawings by the letter B. It has recesses or dies formed in its upper face, in shape the reverse of the sides of the rail, so that when a rail is out of shape it can be laid in either of these recesses or dies, and hammered into shape. Now, in the specification, after describing the manner in which the ends of a rail are to be re-formed when gripped between the stationary and the movable press-blocks, the patentee says: "Should any imperfections remain, which is not usual if the first operation is properly gone through with, they" (the imperfections) "can be removed by proper hand swedges, after placing the rail in the recesses C C for that purpose." From this it will be seen that the anvil or swedge-block B, with its recesses C C, has no mechanical combination with, or relation to the press-blocks. It makes no part of an organized mechanism. It is simply a swedge-block or anvil of the usual construction, placed in convenient proximity to the press-blocks, so that if it should become necessary to swedge the sides of the rail it can be done conveniently. One might as well say that an improvement on an ordinary vice could be claimed in combination with an ordinary blacksmith's anvil, if used in the same shop and placed at a convenient distance, so that a piece of iron, after being forged, could be conveniently put in the vice to be filed.

2. The court below said rightly that, in the view which it took of the case, "there could be no question of fact for the jury to decide."

No exception was taken to that part of the charge in which the court below stated that "movable press-blocks in such combinations, with faces of various shapes, and used for

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various purposes, it is *clearly proved and frankly admitted*, are greatly older than the alleged invention of the patentee."

In view of the ruling of the court on the questions of law, there was but one material question of fact in the case, and that was whether, prior to the alleged invention by the patentee, similar combinations of press-blocks with faces of the required shapes were known and used in the United States, or patented or described in any printed publication in this or any foreign country. And that fact having been conceded by the plaintiffs, the case was left to stand alone on questions of law. It was, therefore, the duty of the court to direct the jury to render a verdict for the defendant.*

Mr. Justice CLIFFORD delivered the opinion of the Court.

I. Patentee describes his invention as a new and useful improvement in the common anvil or swedge-block, for the purpose of welding up and re-forming the ends of railroad rails, when they have exfoliated or become shattered from unequal wear, occasioned by the inequalities of the road. Having made out a *prima facie* case, the plaintiffs rested, and the defendants then introduced certain models of machines, for the purpose of showing that the patentee was not the original and first inventor of his improvement. Models of machines so introduced were the following, to wit: *First*, a model of an angle-iron machine. *Secondly*, a model of an anchor machine. *Thirdly*, a model of a bayonet machine. *Fourthly*, they also introduced a copy of an English patent granted to one Church, with the specifications and drawings annexed, and the statement in the bill of exceptions, in regard to all those machines, is that they were known prior to the invention of the patentee in this case. Bill of exceptions also states, and it is important to observe the fact, that in addition thereto the defendants also adduced evidence to show, and that it was admitted by the plaintiffs,

* Parks v. Ross, 11 Howard, 373; Morgan v. Seaward, Webster's Patent Cases, 170.

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that movable press-blocks, in combination with faces of various shapes and used for various purposes, were older than the alleged invention of patentee. Other evidence, it is stated in the bill of exceptions, was also introduced by the defendants, for the purpose of showing that the patentee was not the original and first inventor of the machine for which he obtained the patent; but the evidence is not given, and it is not perceived that the statement is of any importance at the present time.

II. Charge of the court is given entire in the record; but in the view taken of the case, it will only be necessary to refer to so much of it as relates to the construction of the patent, and the effect of the admission made by the plaintiffs. Construction of the patent, as given by the court, was that the patentee claimed as his invention the movable press-block, having its edge formed to the side of the rail in combination with the block D, the movable blocks to be operated by two cams, or in any other convenient manner. "Specification shows," said the court, "that the block D is fixed and is a part of the anvil or swedge-block, in combination with which, as well as with the fixed block, the movable block is to be used." Such is the substance of the charge so far as respects the construction of the patent; but the court added, in the same connection, that "movable press-blocks in such combination, with faces of various shapes and used for various purposes, it is clearly proved and frankly admitted, are greatly older than the alleged invention of the patentee;" and in support of that proposition of fact, the presiding justice referred to the several models given in evidence by the defendants, and to the description contained in the English patent, as examples of their use and application. Following those references, and in connection therewith, the court told the jury that "the patentee, therefore, claims that of which he is not the inventor, and this fact is fatal to the patent, and entitles the defendants, as matter of law, to your verdict." Exceptions were seasonably and duly taken to all that portion of the charge of the court. Principal complaint against the charge is that the court decided a

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question of fact which belonged to the jury, and which should have been submitted to their determination under proper instructions.

III. Whether that complaint is well founded or not depends very much, if not entirely, upon the construction to be given to the patent. Patents for inventions are not to be treated as mere monopolies, and, therefore, odious in the eyes of the law; but they are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor. (*Ryan v. Goodwin*, 3 Sum. C. C. R., 520.)

Claim of the patentee in this case is not for the anvil-block nor its recesses, as is expressly stated by him in his specification. On the contrary, what he claims as his invention is the movable press-block, having its edge formed to the rail, in combination with another block, which is described as a fixed block, and whose edge is of a similar but reversed form, for the purpose of pressing between them the railroad rail. Shape of the rail is immaterial, except that the inner face or edge of the respective blocks must be so made and formed as to fit the respective sides of the rail to be repaired. Statement of the claim is, that the movable blocks may be operated by two cams, or in any other convenient manner, and the representation is that the machine will greatly facilitate the operation of welding and renewing the ends of such rails, after they have been damaged in the manner herein described and set forth. Taking the description of the machine as set forth in the specification, it consists of the following elements: *First*, a bed-sill, on which the anvil is placed. *Secondly*, the anvil or swedge-block of cast iron, usually four or five feet long, and sixteen inches across the face. *Thirdly*, a solid block cast with and making a part of the anvil, nearly as high as the rail when it is laid across the anvil in its usual position. *Fourthly*, a movable press-block, attached to the face of the anvil by dovetailed tongues and grooves, having an inner edge or face shaped to fit the opposite side of the rail so as to inclose the rail between

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the two, as in the jaws of a vice. Press-block, as before remarked, is worked by two eccentric cams, which serve to advance the press-block upon its dovetailed tongues and grooves parallel to the opposite face of the fixed block. When the press-block has been thus advanced so far as to bring its face in contact with one side of the rail, the cams and the tongues and grooves hold the press-block in position, and the rail is firmly grasped between the inner faces of the two blocks. Inventor then goes on to describe the mode of using the machine, which he says is extremely simple and effective, and sufficient has already been remarked to show that his representation is correct, without reproducing the description. Immediately following that description, is the claim of the patent, as heretofore given, which need not be repeated.

IV. Evidently, the claim must be construed in connection with the explanations contained in the specification, and when viewed in that light, it is quite clear that it should receive a more restricted construction than was given to it in the charge of the court. Special devices are described as combined and arranged in a particular manner, and operate only in a special and peculiar way for a special purpose, and to effect a special result. Obviously, it is not a claim for any kind of movable press-block, combined and operating in any way with any kind of fixed block, to accomplish any purpose or effect any kind of result. Giving that construction to the claim, then indeed it would be true that the plaintiffs, when they admitted that movable press-blocks, in combination with faces of various shapes and used for various purposes, were older than the invention of the patentee, did admit away their whole case, and, if viewed in that light, would be equally true that there was no question of fact to be submitted to the jury. But such is not the true construction of the patent, as is obvious from every one of the explanations of the specification. Invention was of such a movable press-block as is described, having its edge formed to the side of the rail in combination with such other block as is described, with its edge of similar but reversed form arranged

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as described, and combined and operating in the particular way described, for the special purpose of effecting the described result.

When viewed in that light, it is equally clear that the charge of the court was erroneous, because there was an important question of fact which should have been left to the jury, whether the machines introduced by the defendants or any of them, or any of the prior movable press-blocks, as is shown in the admission, were substantially the same as the machine of the patentee. American authorities, at least, hold that every such question is one for the jury, and upon that ground alone we have come to the conclusion that the judgment in this case must be reversed.

Judgment of the Circuit Court is accordingly reversed, with costs, and the cause remanded with direction to issue a

NEW VENIRE.

ROOSEVELT v. MEYER.

Where a certificate, coming up with the record from the highest court of law or equity of a State, certifies only that on the "*hearing*" of the case a party "*relied upon*" such and such provisions of the Constitution of the United States, "*insisting*" that the effect was to render an act of Congress void, as unconstitutional, which said claim, the record went on to say, "was overruled and disallowed by this court," and the record itself shows nothing except that the statute which it was argued contravened these provisions, was drawn in question, and that the decision was in *favor* of the statute, and of the rights set up by the party relying on it; no writ of error lies from this court to such highest State court under the twenty-fifth section of the Judiciary Act of 1789.

MR. ROELKER, of counsel for the defendant in error in this case, moved the court to dismiss the writ of error for want of jurisdiction: the case being thus:

The Judiciary Act of 1789 (§ 25) provides that this court may review the judgment of the highest court of a State in cases "where is drawn in question the construction of *any clause of the Constitution*, or of a . . . *statute of . . . the United*