

be interpreted by its own terms. "But when a patent bears on its face a particular construction, inasmuch as the specification and claim are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of the parties to a contract has always been regarded as of some importance in its interpretation." So, all that was said in *Fay v. Cordesman*, 109 U. S. 420, 3 Sup. Ct. Rep. 236, is that, if the patentee specifies any element as entering into the combination, he makes such element material, and the court cannot declare it to be immaterial. It is his province to make his own claim, and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is filled by an equivalent device or instrumentality. There is nothing in any of these cases inconsistent with what had been previously regarded as well settled, or to lead one to believe that it was the intention of the court to debar the patentee from his right to pursue an infringer, who has endeavored to avoid his patent by the use of a well-recognized mechanical equivalent. We think, therefore, that we are bound to look to the state of the art at the time this patent was applied for to determine the limitations upon the claim in question.

Under the first clause of plaintiffs' patent as amended, there are none of the so-called "anticipations" which are worthy of serious consideration, except that of *Craney*, which undoubtedly resembles *Rodebaugh's* device in all its important particulars. There is a fixed standard, A, corresponding to plaintiffs' standard, B, a guide-bar, B, answering to the reciprocating shaft, D, and the same lever, E, though in one it is a "T" lever and in the other an eccentric; a connecting bar, D, performing substantially the same functions as the connecting strap, F, of the *Rodebaugh* patent, and a projecting or horizontal arm, C, which answers the purpose of plaintiffs' arm, G, projecting from the upper end of the reciprocating shaft. All these elements perform substantially the same functions as the corresponding elements of the *Rodebaugh* patent. There are, however, three distinctions in the two devices which it becomes necessary to notice before determining finally the question of anticipation:

1. In the use of a "T" lever, instead of an eccentric. This fact is relied upon by the plaintiffs as constituting the improvement which distinguishes the *Rodebaugh* patent, not only from that of *Craney*, but from all the others which are claimed as anticipations. But the testimony, even of plaintiffs' expert, indicates very strongly that for the purpose of driving the teeth of the dog into the log, a "T" lever performs the same function, and in as effectual a manner, as an eccentric. The operation of the two is precisely the same. Indeed, a model was exhibited in which an eccentric and a "T" lever were used to move coincidentally the same connecting rod, and their operation was shown to be practically identical. The one difference suggested is that eccentrics are not affected by back pressure,—a distinction which is strenuously denied by defendants' experts,—while the lever may be moved backward and forward,

unless it is locked. This, however, is of no importance, as it is always intended that the lever operating the dog shall either be locked or held in place by a weight upon the end of the lever. We are clear in our opinion that there is no invention in substituting one for the other.

2. There is in the Rodebaugh patent a rearrangement of the entire combination of the Craney patent, by placing the lever and locking device midway between the upper and lower ends of the standard, instead of at the bottom, and using it to depress the upper dog, instead of raising the lower dog into the log. We do not understand, however, that the rearrangement of an old combination, where each element of the combination operates practically as before, is patentable, unless a new or greatly improved result is gained. *Woodward v. Dinsmore*, 4 Fish. Pat. Cas. 163, 169. The variations of the Rodebaugh patent from that of Craney are scarcely greater than those of defendants' device from that of Rodebaugh, and it is entirely clear to our mind that defendants' device differs from that of Rodebaugh only in the rearrangement of the combination, by which a connecting rod, operated by a thrust, and articulating with the movable shaft at the bottom, is substituted for the connecting strap, F, operating by tension, and articulated with the reciprocating shaft at the top by means of the arm, G. In this particular the case is much like that of *Ives v. Hamilton*, 92 U. S. 426.

3. The feature of the Rodebaugh patent, by which the lever, when the dog is locked, assumes a perpendicular position against the standard, out of the way, is not found in the Craney patent, and is probably the novel arrangement which obtained from the patent-office the allowance of his first claim as amended. Now, this is either a mechanical equivalent for a lever which locks horizontally, or it is not. If it be such an equivalent, then it is anticipated by the Craney patent, but if it be not such equivalent, and be a patentable improvement upon the Craney patent, then it is not infringed by the defendants, since they do not use this feature of the claim. There was undoubtedly considerable mechanical ingenuity shown by Rodebaugh in readjusting the various elements of the Craney combination, and perhaps some improvement in its mechanical operation, and we think his device approaches very near the border line of invention; but upon the point which has been most earnestly pressed upon our attention, that the eccentric is a patentable improvement over the "T" lever,—and the plaintiffs' case was practically put upon this ground,—we have not been able to adopt their view.

ON APPLICATION FOR REHEARING.

(March 13, 1889.)

JACKSON, J. I concur fully in the conclusion reached by the district judge, that the Rodebaugh patent of October 16, 1877,—letters patent No. 196,102, was anticipated by the patent issued to Thomas Craney,—No. 150,534,—dated May 5, 1874; that in so far as the Rodebaugh improvement differs from that of the Craney patent nothing more than mechan-

ical skill was involved and exercised. I am further of the opinion that said Rodebaugh patent was anticipated by the patent of Ely,—No. 163,309,—dated May 18, 1875.

2. If the Rodebaugh patent could be held valid, it would, in view of the action of the department, as shown by the file-wrapper and contents, have to be limited to the precise mechanism and construction therein described, and, as thus limited, it is not infringed by the machine used by the defendants. Rodebaugh's original claim was broad enough to have covered the machine as used by defendants. It was "(1) the eccentric lever, E, E¹, and connecting strap, F, combined with the vertical shaft or bar, D, carrying the dog-head, substantially as described, and for the purpose specified." This claim was rejected by the patent-office on reference to said Ely patent, No. 163,309, in which is found an eccentric lever operating on the vertically reciprocating bar, which carries the dog, and capable of locking the bar in any position it may be set. Upon the rejection of this broad claim Rodebaugh was compelled to present the new claim now shown in claim 1 of the letters patent issued to him, which cannot by any construction, or under any rule of doctrine of equivalents, be enlarged so as to cover or embrace what was previously rejected. It must manifestly be limited to the specific device therein described, in which the dog-head is locked when the eccentric lever has been moved through the half circle, or 180 degrees of the circle, of its action, and brought into a perpendicular position with the standard or shaft. The defendant's lever is differently constructed, having its greatest locking capacity when in a horizontal position, and losing this locking capacity entirely when carried to the position of the perpendicular at which the Rodebaugh lever makes its most effective lock. I am clearly of the opinion that the application for rehearing should be denied, and that complainants' bill should be dismissed, with costs.

BOYD v. JANESVILLE HAY TOOL Co.¹

(Circuit Court, W. D. Wisconsin. November 9, 1888.)

1. PATENTS FOR INVENTIONS—ANTICIPATION—HAY ELEVATOR.

Letters patent to John M. Boyd, No. 300,687, dated June 17, 1884, are void for want of novelty, being anticipated by prior patents.

2. SAME—PATENTABILITY.

Mere differences of form and mechanics, which do not involve invention, are not patentable.

(Syllabus by the Court.)

In Equity.

This was a bill for infringement of letters patent of the United States No. 300,687, to John M. Boyd, for hay elevators. The defendant man-

¹ Publication delayed by failure to obtain copy of opinion at time of delivery.