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tion.

“a tapered hair or head brush,” and the method of manufacture to consist in cutting hair in lengths of about one inch and a quarter, and then mixing it by hand and shaking it together as unevenly as possible, and finally attaching the hairs so cut and mixed to the stock by means of wires. At the trial it appeared that the patented brushes had bristles of unequal length mixed indiscriminately together. Lord *Ellenborough*, C.J., held that the invention was improperly described, and said: “Tapering means gradually converging to a point. According to the specification the bristles would be of an unequal length, but there would be no tapering to a point which the description assumes. If the word ‘tapering’ be used in its general sense, the description is defective—there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical consideration can be removed.” After further evidence his Lordship advised the jury to find that it was not a *tapering*, but only an unequal brush, which they accordingly did. A rule for a new trial was refused.

Felton v.
Greaves.

In *Felton v. Greaves*, (1829) 2 Stark. N. P. 249, the plaintiff had obtained his patent for “a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments,” and it appeared that the invention, which was stated in the specification to consist in a machine for sharpening various cutting instruments by passing their cutting edges backward and forward in the angle formed by the intersection of two or more circular files in the manner explained, was suitable for sharpening knives, but it would not do for sharpening scissors. The files were stated to be in the form of cylinders, and at the trial it appeared in evidence that in order to adapt the instrument to the sharpening of scissors it was necessary to have one of them smooth, which the specification did not describe, and Lord *Tenterden*, C.J., on this ground directed a nonsuit.

Bainbridge v.
Wigley.

In *Bainbridge v. Wigley*, (1810) Parl. Rep. 192; 1 Carp. P. C. 270, the specification stated that the invention consisted in certain improvements in the English flute, whereby the fingering was rendered more easy and certain notes produced that were never before produced, whilst it appeared in evidence that, as a matter of fact, only one new note was produced. Lord *Ellenborough* held that this was fatal to the patent, the consideration on which it was granted not being truly set forth. The patentee had stated that, by his improvement, he gave new notes, when in fact he had given but one new note.

II. *The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.*

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The principle about to be discussed is closely allied to that which has been considered in the preceding pages. It is now proposed to demonstrate that ambiguous or misleading statements in essential particulars as to the nature of the invention, or the manner of carrying it out, even though *bonâ fide* on the part of the patentee render the grant invalid.

It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable, and if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. . . . It is certainly of consequence that the terms of a specification should express the invention in the clearest and most specific manner; so that the persons to whom it is addressed may be able to produce the thing intended, without the necessity of trying experiments, (c) and, as was pointed out by *Dallas*, L.C.J., (d) if the instrument contains an ambiguity in a material point that is a ground on which it may be avoided altogether.

Must be clear
and unequivocal.

In the case of a written contract or similar document, the Court is bound to find a meaning, but in the case of a specification the Court has no such duty, and, if the fact is that it is not possible to say that the language of the specification is unambiguous, and the point is pressed, the Court ought to declare the patent void, on the ground that the patentee has not complied with the condition of the grant. (e) Thus it is fatal for the patentee to state so many alternatives in different parts of the processes he describes, and generally to so frame his specification that it cannot be properly gathered what are the essential parts of his invention or what is the extent of his claim. (f)

Absolute or perfect precision in the language of the specification is impossible, and cannot therefore be required. It will be quite sufficient if the document is comprehensible to

Perfect precision in language is not possible.

(c) Per Ashurst, J., *Turner v. Winter*, (1787) 1 T. R. 602; 1 W. P. C. 77; but see p. 189.

(d) *Campion v. Benyon*, (1827) 6 B. Moo. 71; 3 Brod. & B. 5.

(e) See *Tubes, Ld. v. Perfecta*

Seamless Tube Co., Ld., (1902) 20 R. P. C. 101, judgment of Lord Davey; *Ackroyd and Best, Ld. v. Thomas*, (1904) 21 R. P. C. 737.

(f) *Klaber's Patent*, (1904) 22 R. P. C. 414.

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the ordinary workman in the trade to which the invention relates.

The following remarks of *Grove, J.*, are instructive upon this point:—

“ Every word I give will be open to exception, and no human being probably could criticise my language more than I could myself, if I were to sit upon it, because I am one of those who believe that there is no form of words which can be used with such accuracy as to exclude every other conclusion but the one which the speaker or the writer intends to express. I have never yet seen any form of words, even of moderate length, upon which a person reading it in an adverse spirit might not put a different conclusion from that which the author intends, and those who have written books, or have had to deal with drawing legal documents, or other matters of that sort, know how impossible it is to give any definition, or use any form of words, which may not be excepted to.” (*g*)

If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention, and if there is any studied ambiguity in it, so as to conceal from the public that of which the patentee is, for a term, enjoying the exclusive benefit, the patent itself will be completely void. (*h*)

Must not include what will not as well as what will answer.

A statement, or claiming clause, which is so indefinite as to include what will not answer the purpose in view as well as what will, in accordance with the principles above stated, be fatal to the validity of the grant. That is to say, if the specification, in describing any materials or ingredients which are necessary for the purpose of carrying out the invention, uses language wide enough to include what is unsuitable as well as what is suitable for the purpose, the ambiguity will be fatal. (*i*)

(*g*) *Philpot v. Hanbury*, (1885) 2 R. P. C. 38; see also *Boulton v. Bull*, (1795) Dav. P. C. 216; *Arkwright v. Nightingale*, (1785) Dav. P. C. 37; *Tubes, Ltd. v. Perfecta Seamless Tube Co., Ltd.*, (1902) 20 R. P. C. 96.

(*h*) Per *Tindal, C.J.*, *Galloway v. Bleadon*, (1839) 1 W. P. C. 521.

(*i*) *Ralston v. Smith*, (1865) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1857) 2 H. & N. 84; *Haworth v. Harcastle*, (1834) 1 W. P. C. 484; *Saunders v. Aston*, (1832) 3 B. & Ad.

881, 886; 1 W. P. C. 75 *n.*; *Kurtz v. Spence*, (1888) 5 R. P. C. 161; *Stevens v. Keating*, (1818) 2 W. P. C. 194; *Muntz v. Foster*, (1844) 2 W. P. C. 109; *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409; *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1070; *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 875; 15 R. P. C. 359; *Hattersley v. Hodgson*, (1903) 20 R. P. C. 591; but see 21 R. P. C. 517.

For example, in *Stevens v. Keating* (k) the Court of Exchequer upheld a verdict, given in the Court below for the defendant, on the question of the sufficiency of the plaintiff's specification. One of the patents in question in the action related to a method of making cement, by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlsh in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated: "Other alkalis and acids, besides those hereinbefore mentioned, will answer the purpose of my invention, though none that I have tried answer as well as the alkali and acid hereinbefore set forth;" and concluded with a claim for the process of mixing the powdered materials, alkalis, and acids, as described, and subsequently burning, heating, or calcining the same, for the purposes set forth. Pollock, C.B., in the Court of Exchequer, upholding the verdict below, pointed out in his judgment that only one alkali (potash) and one acid (sulphuric) were mentioned in the specification, but manifestly the inventor did not confine himself to them; if he did, the defendant would be entitled to a verdict, on the plea of no infringement, for he used neither. The learned Chief Baron continued thus:—

"To what extent, then, does the claim go beyond the alkali and acid named? If it be a claim of all acids and alkalis, it is clearly bad, as there are some that will not answer the purpose. If it be a claim of those only which will answer the purpose, it is clearly bad, in consequence of not stating those which will answer the purpose and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not; and this was expressly so determined by the Court of Queen's Bench in *R. v. Wheeler*, (1819) 2 B. & Ald. 345; where they say that a specification which casts on the public the expense and labour of experiment and trial is bad. In my view, therefore, this specification is defective."

In *Wegmann v. Corcoran* (l) the Court of Appeal upheld a decision of the Court below, which declared a patent for an improved machine or apparatus for treating or preparing

(k) 2 W. P. C. 175; 19 L. J. Ex. 57.

(l) (1879) L. R. 13 Ch. D. 66.

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meal void on the ground of the ambiguity of the language used by the specification. The patentee stated that the squeezing rollers of the improved machine were to have "a surface consisting of a material containing so much silica as not to colour the meal or flour," and went on to say that he preferred to make them of "iron coated with china, and finely turned with diamond tools." It was proved in evidence that there are two kinds of china—Oriental or Chinese china, containing 73 per cent. of silica, and very hard, and the china usually made in this country, containing only about 40 per cent. of silica, and much softer. The evidence also established that the first kind of china would answer the purpose, but the second would not, and that the invention was useful in milling operations. The Courts held that the specification was bad, as being ambiguous and inadequate, in so far as it did not state what kind of china was to be employed.

So also in *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (m) where the patentee directed that a certain process was to be carried out in "an autoclave," and it appeared that it was essential that the vessel in question should be of iron unenamelled, and it also appeared that at the date of the specification both unenamelled and enamelled autoclaves were in general use, and that it was first discovered during the trial of the action that the process could only be effected in an unenamelled autoclave, the specification was held to be fatally insufficient on the ground that it did not point out that the use of an unenamelled iron autoclave was an essential element of success.

It must not, however, be forgotten that the meaning of words is liable to change with the progress of science and discovery, and a term which, for the purpose of the specification, is sufficiently accurate, may, in future years, include that which will not answer the purpose the patentee has in view. In such a case the specification will be read with reference to the state of knowledge at the time it was prepared, and if the term used include nothing *then* known that would not answer, it will not be held to be ambiguous, though the use of the same term subsequently might be. (n) This is only equitable, for a patentee is not entitled to a

(m) (1897) 14 R. P. C. 875.

(n) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D.

156; 12 App. Cas. 410; 4 R. P. C. 449; *Crossley v. Beverley*, (1829) 3 Car. & P. 513; 1 W. P. C. 112.

monopoly of ingredients and materials which were unknown at the date of the specification, and which, viewed in the light of the knowledge at the date of the specification, would not be perceived to be the equivalents of materials mentioned, even though the language used be sufficiently wide to include them. (o) It would be manifestly unfair to hold that language which, by the advance of knowledge, has come to include more than the patentee contemplated should vitiate the grant.

Thus, for instance, when the directions given in a specification for the preparation of the article, which is the subject-matter of the patent, necessitate the use of a practically chemically pure substance, and, at the date of the patent, the person to whom the specification is addressed would, by using the knowledge of the period, obtain the substance sufficiently pure and would succeed, it is no valid objection to the utility of the invention and the sufficiency of the specification that, at a subsequent date, the same person using the *then* commercial article (*which has only come into existence as a commercial product after the date of the patent*) would fail. (p)

It is always a question for the jury, or the Court acting as a jury, to say whether or not the specification describes with sufficient accuracy the ingredients or materials which the patentee directs to be used, (q) but a patentee is not obliged, in referring to materials and ingredients, to enter into minute details as to them if they are known in commerce and can be readily procured under the names which he gives them. (r) The names of articles mentioned must be taken to be used in their ordinary commercial sense. (s)

The specification of *Medlock's* patent for improvements in the preparation of red and purple dyes directed the use of *dry arsenic acid* in a part of the process, and this was held by Lord *Westbury*, L.C., to refer to the ordinary arsenic acid of

(o) *Tetley v. Easton*, (1852) Macr. P. C. 77; 18 C. B. 643; 25 L. J. C. & P. 293; p. 353 *post*.

(p) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 324, 326.

(q) *Bickford v. Skewes*, (1837) 1 W. P. C. 214; *Derosne v. Fairie*, (1835) 1 W. P. C. 154; *Elliott v. Turner*, (1845) 2 C. B. 446; *Wallington v. Dale*, (1852) 7 Exch. 888.

(r) *MacIntosh v. Everington*, 2 Carp.

R. 180, 191.

(s) *Simpson v. Holliday*, (1864) 2 Newton, L. J. 118; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Stevens v. Keating*, (1847) 2 W. P. C. 183, 187; 19 L. J. Ex. 57; *Muntz v. Foster*, (1844) 2 W. P. C. 104; *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327; *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 710; (1887), 4 R. P. C. 449.

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commerce (which is dry to the touch, although it contains water of hydration), which would answer, and not to the anhydrous form, which would not answer; (t) but in a case where the specification directed the use of "the finest and purest chemical white lead," and it appeared in evidence that there was no substance known in the trade by that name, but that white lead only was known, the specification was held to be defective on the ground of ambiguity. (u)

E.g., propor-
tions.

In the case of an invention of a new use of known substances in new proportions, (x) the patentee in his complete specification is bound to state the most suitable proportions within his knowledge, (y) but he is not obliged to limit his claim to the precise proportions mentioned. (z) Though proportions of substances used may be of importance, yet if the proportions specified as an instance yield good and satisfactory results, the fact that different proportions yield results differing in utility is not a fatal objection to the sufficiency of the specification. (a) If on the true construction proportions are claimed which will not yield without further experiment and discovery the result aimed at by the patentee, the patent is bad for insufficiency of the specification. (b) On the other hand, if the specification on its true construction is limited to certain definite proportions of the ingredients used, then, no doubt, it is no infringement to use proportions outside the limits stated. (c)

In *The Patent Type Founding Co. v. Richards* (d) the patent was for "improvements in the manufacture of type," and the specification stated "the object of the invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin and twenty-five of antimony, but this may be to some extent varied; and when lead is also used I find that it must not exceed fifty parts in one hundred of the combined metals employed."

(t) *Simpson v. Holliday*, (1866) 5 N. R. 340; L. R. 1 H. L. 315.

(u) *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327.

(x) p. 80 *ante*.

(y) See p. 231 *post*.

(z) *The Patent Type Foundry Co. v. Richards*, (1860) 6 Jur. N. S. 39; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Gas Mantle Co.*, (1899) 17 R. P. C. 147; *Neilson v. Betts*, (1871) L. R. 5 H. L. 21.

(a) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 326.

(b) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Gas Mantle Co.*, (1899) 17 R. P. C. 147.

(c) *Ibid*.

(d) (1860), 6 Jur. N. S. 39; 1 Johns. 381; 2 L. T. N. S. 359.

Wood, V.C., overruled a demurrer on the ground that this specification was bad for uncertainty, and said:—

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“What I have to determine is whether this specification is so clearly and manifestly bad that no explanation by workmen or other experts . . . could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. . . . A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say ‘I limit my claim to these precise proportions.’ Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent. It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is that the specification is not void on the face of it.”

In *British Dynamite Co. v. Krebs*, (e) the patent the validity of which was in question was for “improvements in explosive compounds and in the means of igniting the same.” The specification stated: “This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe to use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into powder, which I call dynamite or *Nobel's* safety powder.” Objection was taken at the trial to the specification, on the ground that the above was not a sufficient statement of the quantity of the nitro-glycerine to be used. The Judge of first instance overruled the objection, but the Court of Appeal held it fatal to the validity of the patent. The House of Lords, however, held that, under the circumstances, the specification was sufficient upon the ground stated by Lord *Cairns*, L.C., thus (f):—

“Where you speak of a porous substance absorbing a fluid, if the porous substance is in one piece you naturally expect

(e) (1875-79), S. P. C. 88; 13 R. P. C. 190; cf. *Otto v. Linford*, (1881-82) per *Jessel*, M.R., 46 L. T. 40.

(f) 13 R. P. C. 192.

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that the absorption will continue up to the point where the porous substance can hold no more; and when the absorbing substance is, and is to continue, a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become, not a powder but a paste."

It is settled law that a person, to be entitled to the benefit of a patent, must disclose his secret and specify his invention in such a way that others of the same trade may be taught to do that for which the patent is granted, by following the directions in the specification, without any new invention or addition of their own. (g) And the specification ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have.

Test of
sufficiency.

In judging of the sufficiency of the specification, the proper criterion is whether a person to whom the specification is addressed, by using only the existing knowledge common to the trade at the date of the patent, would be able to exercise the invention without using information derived from any other source. (h) *Tindal, C.J.*, directing the jury in *Muntz v. Foster* (i) as to the sufficiency of the specification, used the following words: "People are not to go on and make experiments, at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the easy and certain procurement of the commodity for which the patent was granted; that is a question upon the evidence." And, in the language of *Jessel, M.R.*, "you are not to tell a man to make an experiment, but to tell him how to do the thing. (k)

When neces-
sity for experi-
ments renders
a specification
bad, and when
not.

If the specification be such that the persons to whom it is addressed are not able, by following its directions, to produce *any* beneficial result without the further necessity of performing experiments and trials involving invention, it is bad. It

(g) Per Buller, J., *R. v. Arkwright*, (1785) Dav. P. C. 106; 1 W. P. C. 66, and note.

(h) Per Alderson, B., *Morgan v. Seaward*, (1836) 1 W. P. C. 173, 174; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710; 4 R. P. C. 463; *British Dynamite*

Co. v. Krebs, (1875) G. P. C. 88; 13 R. P. C. 190; *Neilson v. Harford*, (1841) 1 W. P. C. 371; *Rex v. Arkwright*, (1785) 1 W. P. C. 66.

(i) (1844) 2 W. P. C. 109.

(k) *British Dynamite Co. v. Krebs*, (1875-79) G. P. C. 90.

may not, however, be bad if a beneficial result can be obtained by strictly carrying out the directions given, though further experiments may be necessary to obtain the result in a higher degree, (l) provided that the patentee has given the best means known to him of carrying out the invention. (m)

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If the specification contain language which is calculated to mislead the public into performing experiments which the patentee knows must fail, such language will be a fatal defect in the specification. Thus, in *Crompton v. Ibbotson* (n) a patent for "improvements in dyeing and finishing paper," was held bad on this ground. The specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of any suitable material, but I prefer it to be made of linen warp and woollen weft." One of the witnesses for the plaintiff admitted that as to the conducting medium he had tried several things, but he was not aware that anything would answer the purpose except the material which the patentee said he preferred, and the plaintiff was nonsuited. The Court of King's Bench refused to set the nonsuit aside, Lord Tenterden, C.J., pointing out that the patent was obtained for the discovery of a proper conducting medium and that the plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in the specification, whilst he said that the cloth might be of any suitable material, and merely that he preferred the particular kind in the specification mentioned. Other persons, misled by this statement, might be induced to make experiments, which the patentee knew would fail. The public, therefore, had not the full and entire benefit of the invention. In *Winter v. Turner* (o) a patent was held void (*inter alia*) on the ground of a similar ambiguity in the specification.

Leonhardt v. Kallé (p) indicates that the above two old cases would be differently decided by the Courts now. The invention consisted in the production of various colouring matters fast to alkali by the action of suitable oxidisable substances and free alkalies upon a certain substance under heat. It was objected that the specification was ambiguous and misleading on four points, viz. : (a) because it showed no means

(l) *Neilson v. Harford*, (1841) 1 W. P. C. 295, 318; *Macnamara v. Hulse*, (1842) Car. & M. 471; 2 W. P. C. 128 n.; *Otto v. Linford*, (1881) 46 L. T. N. S. 39; *Edison v. Holland*, (1889) 6 R. P. C. 243.

(m) p. 231 *post*.

(n) (1828) 6 L. J. (O. S.) K. B. 214.

(o) (1787) 1 T. R. 602; 1 W. P. C. 77.

(p) (1895) 12 R. P. C. 103.

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of ascertaining which oxidisable substances were not suitable; (b) because the proportions in which the various alternative oxidisable substances were to be used were not stated; (c) nor how the process could be varied to produce the several shades of colour mentioned; (d) the specification entirely failed to state the chemical nature of the compound, the product of the process. *Romer, J.*, who tried the case, held that upon the facts all these objections failed, and as to some of them remarked that if they were held valid they would render it practically impossible to draw a specification for an invention like that of the patentee that could be free from objection. The reasons for holding the objections invalid were, shortly:—

As to (a), It was unreasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out what could not give very useful results, or which might be disregarded. Having given numerous examples of different classes of oxidisable substances that could be used, he was entitled to say, as was true, that there were others which could be used. Following the directions of the specification and with such precautions as chemists would know how to use, oxidisable substances not expressly mentioned in the specification could be successfully used. As to (b), the patentee had given directions as to how to obtain the best results, in fact, with the different oxidisable substances specially mentioned which necessitated the use of the right proportions. He was not bound to enunciate any general theory. With regard to oxidisable substances not specifically mentioned, chemists would have no difficulty in ascertaining into which example or examples given any such unmentioned oxidisable substance fell, and in applying the directions given as regards the said example or examples. As to (c), the patentee had pointed out which colours his dyes produced; and also the colours that were produced from his process were rightly stated by the limits given in the specification. A person wanting to use the dyes could test the examples given without difficulty. Shades of colour vary infinitely, and are almost impossible to describe. The patentee was not bound to take every oxidisable substance and define what shade of colour it would produce. As to (d), this was an unfair objection, and the patentee was not bound to state anything of the kind, which, as a matter of fact, having regard to the state of chemical

knowledge, it would have been impossible for him to do with any certainty.

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III. *The complete specification must be intelligible to ordinary workmen possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.*

The often repeated statement to the effect that the specification is insufficient unless it be comprehensible to the "ordinary workmen" in the trade to which the invention relates is apt to lead to great confusion, if it be not clearly borne in mind that the "ordinary workman" is to be regarded as a person of very different knowledge and skill according to the nature of the field of invention with which the patentee in a particular case is dealing. Thus, if the invention is merely the construction of a mechanical combination of parts for a purpose readily understood—*e.g.*, a bicycle—then the "ordinary workman" is, no doubt, a mechanic used to the construction of machines; but if the invention is the production of something by a process, or series of processes, to understand which the highest scientific knowledge and attainments are requisite, the "ordinary workman" then becomes a highly trained scientific person, who may be called upon to give the necessary instructions to his less highly instructed and skilful subordinates to enable the process to be carried out by them—*e.g.*, if the invention relates to the production of a chemical product by a process, or series of processes to the understanding of which a knowledge of the most recent developments of chemical theories and ascertained facts is indispensable, then the "ordinary workman" becomes a highly trained chemist, who may be properly called upon to bring his special knowledge of the particular branch to which the invention relates into play, for the purpose of giving minute directions to his less skilful subordinates so as to enable them to perform the operations necessary to the carrying out of the process, which they, by their lack of knowledge, may not be able to fully appreciate.

Meaning of
"ordinary
workman."

If the above remarks be borne in mind, some of the statements of the law in the following pages, which might

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otherwise be considered conflicting, will at once appear in perfect harmony.

Statement of
the law as to
"ordinary
workman" in
a particular
case by Parke,
B.

In *Morgan v. Seaward* (*q*) Alderson, B., told the jury that a specification is addressed to all the world: and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification, and the specification should be such as to enable a workman of *ordinary skill* to make the machine. (*r*) Parke, B., in *Neilson v. Harford*, (*s*) alluding to an invention relating to a machine, laid down the law in the following terms:—

“ You are not to ask yourselves the question whether persons of great skill—a first-rate engineer or a second-class engineer—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed—it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity on the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, whatever its shape was, according to the terms of this specification, then I think that this specification is good, and that the patent may be supported so far as it relates to that.”

The same by
Jessel, M.R.

The following passage, from the judgment of *Jessel*, M.R., in *Plimpton v. Malcolmson*, (*t*) in reference to patents for mechanical inventions, has been approved of in subsequent cases as a correct statement of the law as to whom a complete specification must be intelligible (*u*):—

“ It is plain that the specification is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But there are various kinds of people who know something about it. If it is a

(*q*) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

(*r*) See also *Gibson v. Brand*, (1842) 1 W. P. C. 631; *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327; *Beard v. Egerton*, (1849) 8 C. B. 165; *Bickford v. Skewes*, (1839) 1 W. P. C. 218.

(*s*) (1841) 1 W. P. C. 295; 8 M. &

W. 806; 11 L. J. Ex. 20.

(*t*) (1875) L. R. 3 Ch. D. 531, 568; 44 L. J. Ch. 257.

(*u*) *Edison v. Woodhouse*, (1887) 4 R. P. C. 79; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 242; *Bray v. Gardner*, (1887) 4 R. P. C. 400, 406; *Edison v. Holland*, (1889) 6 R. P. C. 243.

mechanical invention you have first of all scientific mechanics of the first-class, eminent engineers; then you have scientific mechanics of the second-class, managers of great factories, great employers of labour, persons who have studied mechanics. . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and, still more, from imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. This is what I would say of the two first classes, which I call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. . . . It will be a bad specification if the first two classes only understood it, and if the third class do not.” (x)

Complete
Specifica-
tion.

It is sufficient if the complete specification define the invention so that an ordinarily skilful workman can carry it out. (y) Thus, *Maule, J.*, in reference to the specification of an invention relating to photography, said:—

The same by
Maule, J.

“If so much nicety of description is required it would be impossible to draw a specification at all. It is enough if it be so explicit as to enable a man of ordinary, competent skill, and willing to learn, to perform the operation. A competent workman must be taken to know the known properties of iodine, of silver, and of nitric acid, or else the specification should have included a statement of the properties of each of these substances.” (z)

Every inventor capable of sustaining a patent for his invention adds, it is clear, something to what was known before, and it is submitted that the ordinary skilled workman, to whom it may be supposed that his specification is addressed, must in

Sufficiency of
specification
when the in-
vention can
only be appre-
ciated by
persons of
great skill and
knowledge.

(x) See also *Neilson v. Harford*, (1841) 1 W. P. C. 314.

(y) *Wallington v. Dale*, (1852) 7 Exch. 838; 23 L. J. Ex. 49.

(z) *Beard v. Egerton*, (1846) 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 30;

see also *Otto v. Linford*, (1881) 46 L. T. N. S. 35; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710, 713; 4 R. P. C. 449; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241, 253.

Complete
Specification.
—

most cases be interpreted to mean a person having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and a reasonably competent skill in the practical mode of doing what was then known: (a) but in cases where the invention relates to a subject which only appeals to and can only be appreciated by persons of great skill and knowledge in some particular department of science, then the ordinary skilled workman must be interpreted to mean a person possessed of the greatest skill and knowledge. (b)

If it appear in evidence that a person possessed of the highest scientific knowledge might be left in doubt as to the exact meaning of a direction contained in the complete specification, whereas a person possessing merely ordinary knowledge on the subject has no difficulty in interpreting the invention, the patent will be upheld with respect to the sufficiency of the specification. (c)

Specifications
are not ad-
dressed to
persons igno-
rant of the
subject-matter.

The specification, in fact, is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufacture to which it relates. (d)

Thus, Lord *Loughborough*, in *Arkwright v. Nightingale*, (e) stated that a specification is addressed to persons having skill in the subject, and not to men of ignorance, and if it be understood by those whose business leads them to be conversant in such subjects it is sufficient. And in *Ree v. Arkwright*, (f) a case in which the patent called in question related to a mechanical invention, *Buller, J.*, said, that if the specification be such that mechanical men of common understanding can comprehend it, so as to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

(a) See *Edison v. Holland*, (1889) 6 R. P. C. 243, 280.

(b) See p. 217 *ante*; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875, judgment of Willes, J.

(c) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) 12 App. Cas. 710; 4 R. P. C. 449.

(d) *Huddart v. Grimshaw*, (1803) 1 W. P. C. 85, 87; *Bickford v. Skewes*,

(1837) 1 W. P. C. 218; *Hornblower v. Boulton*, (1799) Dav. P. C. 221, 228; *Edison v. Holland*, (1889) 6 R. P. C. 243, 277, 278, 280; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875.

(e) (1785) Dav. P. C. 39; 1 W. P. C. 60.

(f) (1785) Dav. P. C. 61; 1 W. P. C. 64.

When it is said that the meaning of the specification is that others may be taught to do the thing for which the patent is granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no sort of specification would, probably, enable a ploughman, utterly ignorant of the whole art, to make a watch; and a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions. (*g*)

Complete
Specifica-
tion.
—

The patentee must not leave the description of the way in which the invention is to be performed in such a state that persons desirous of carrying it out would find that they had virtually to solve a problem before they could do so. The person reading the specification is called upon to bring to bear, in interpreting the specification, all the existing knowledge common to the trade; and he must not be called upon to exercise anything more. The specification must be drawn in such a manner as not to call on a person reading it to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. (*h*) For example, if the proper dimensions of a part necessary to effect the patentee's object are a matter of calculation, the person to whom the specification is addressed may be called upon to make the calculation. (*i*) There is the authority of the House of Lords (*k*) for the proposition that a person to whom the specification may be supposed to be addressed must be taken to have a knowledge of prior specifications (and *sic*, other documents) relating to the same subject-matter, even though only recently published; and the actual ignorance of one or more eminent scientific witnesses of a particular specification is unavailing to prove that the knowledge of others was equally defective. (*l*)

Person to
whom the
specification
is addressed
is presumed
to possess all
the existing
knowledge
common to the
trade, but not
more.

In *Turner v. Winter*, (*m*) it appeared that in carrying out the invention in dispute it was necessary that during the process the materials used should be fused, though the specification only alluded to calcination. The specification

(*g*) Per Lord Ellenborough, C.J., in *Harmar v. Playne*, (1809) Dav. P. C. 318; 11 East, 181.

(*h*) *Morgan v. Seaward*, (1837) 1 W. P. C. 174.

(*i*) *Scott's Patent*, (1902) 19 R. P. C. 273.

(*k*) *King, Brown & Co. v. Anglo-American Brush Corporation*, (1892) 9 R. P. C. 313.

(*l*) See judgment of Lord Watson, 9 R. P. C. 320; cf. p. 153 *ante*.

(*m*) (1787) 1 T. R. 602; 1 W. P. C. 77.

Complete
Specification.
—

mentioned the use, as an alternative for other substances, of *fossil salt*, but it appeared at the trial that *fossil salt* was a generic term, including several species, and that *sal gem* was the only species of it which would answer the purpose. The patent was declared void, the specification not being intelligible, in so far as it did not state the degree of heat necessary, and the particular species of fossil salt which would answer the purpose.

If the specification be not intelligible to the public to whom it is addressed, the patentee will not have fulfilled the obligation which the law imposes upon him of telling the public for what it is that he claims the invention. (n) And in the words of Lord *Eldon*, L.C., "in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the time for which it was granted is at an end." (o)

If the specification is not sufficiently explicit to enable others to practise the invention, then it defeats one of the objects for which it was required—viz., "that useful novelties may be given to the public, of which, at the end of the term granted to the patentee, they shall have the full benefit." (p)

If the patentee use a word inaccurately, but from the context it is perfectly clear in what sense he intends it to be understood, such an inaccuracy will not be an objection which could be successfully urged against the validity of the specification. (q)

A specification which discloses in one set of words both the nature of the invention and the mode of performing it is sufficient. (r)

All that is necessary is that the specification shall be intelligible to the persons to whom it is addressed, and enable them to perform the invention; and a specification so intelligible will not be vitiated by the fact that it contains slight mistakes and errors which any workman of ordinary skill and experience would perceive and correct. (s)

(n) *Neilson v. Thompson*, (1841) 1 W. P. C. 283.

(o) *Newbury v. James*, 2 Mer. 446, 451; 1 Carp. P. C. 367.

(p) *Holmes v. London and North Western Ry. Co.*, (1852) Macr. P. C. 13, 16; *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312, 340.

(q) *Derosne v. Fairie*, (1835) 1 W.

P. C. 154, 157; *Minter v. Mower*, (1835) 1 W. P. C. 141; see also *R. v. Metcalf*, (1817) 1 W. P. C. 141 n.; 3 Car. & P. 611.

(r) *Edison v. Holland*, (1889) 6 R. P. C. 280.

(s) *Simpson v. Holliday*, (1864) 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Otto v. Linford*, (1881)

Errors in the
specification
and their
effect.

But this last statement must be understood as referring only to errors which appear on the face of the specification, or the drawings therein referred to, or which would be at once discovered and corrected in following out the instructions given, for such errors cannot possibly mislead; (t) and it must not be understood as a correct statement of the law where errors are discoverable only by experiment and further inquiry. The proposition, moreover, is not true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describe several processes or several combinations of machinery, and affirm that they will all produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman. (u)

Complete
Specifica-
tion.
—

A workman is not to be called upon to correct any error unless there is something to correct it by. (æ) Thus, in the case of *Hinks'* patent for the paraffin lamp the drawing did not show, and the letterpress did not describe, a certain small opening in the second burner which was necessary to the effective working of the lamp. *Jessel, M.R.*, held this to be a fatal defect which a workman could not be called on to remedy. In the case of an invention the whole merit of which is very small indeed, if people are told how to do things better they must be told properly, without the necessity for invention or much trouble. (y)

Objections to the working of a patent are not usually allowed when a patent has stood for a long time the test of inquiry. (z)

The objection to the sufficiency of a specification, on the ground that it made use of *French* expressions, such as *vis de*

46 L. T. N. S. 35; *Morgan v. Seaward*, (1836) 1 W. P. C. 176; *Derosne v. Fairie*, (1835) 1 W. P. C. 157; 1 W. P. C. 42 n. 41; *Gandy v. Reddaway*, (1883) 2 R. P. C. 52; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Hopkinson v. St. James's Electric Light Co.*, (1892) 10 R. P. C. 46; *Miller v. Searle*, (1893) 10 R. P. C. 106.

(t) p. 202 *ante*.

(u) See remarks by Lord Westbury, L.C., in *Simpson v. Holliday*, (1864) 13 W. R. 577; 5 N. R. 340; 35 L. J.

Ch. 811; L. R. 1 H. L. 315; p. 202. *ante*.

(æ) *British Dynamite Co. v. Krebs*, (1875) G. P. C. 190; 13 R. P. C. 190; *Hinks v. Safety Lighting Co.*, (1876) 4 Ch. D. 615; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

(y) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 615; 46 L. J. Ch. 185.

(z) *Betts v. Neilson*, (1871) L. R. 5 H. L. 121; per Lord Westbury, L.C.

Complete
Specifica-
tion.

pression, vis de répulsion, and vis de réaction, for different screws, and centimètres for inches, was taken in Bloxam v. Elsee, (a) but was not sustained, as it appeared that, although these terms would not be understood by English mechanics, yet a skilful workman could construct the machine by the aid of the drawings annexed to the specification, Abbott, C.J., saying: "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if by a comparison of the words and drawing the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

The use of the word "discolour," as meaning "discharge the colour," being a bad translation of the French word "discolour," has been held not to be of sufficient importance to upset a specification. (b)

Effect of
statements
rendering
experiments
necessary.

A specification will be sufficient which contains directions enabling a person having a reasonably competent knowledge and skill of the subject to make the article described without further invention, though it may be necessary for him to make some trial and experiment before succeeding; (c) but a specification which does not contain sufficient information to enable this to be done without the necessity for experiments, involving the exercise of the inventive faculty of the experimenter, is absolutely fatal to the validity of the patent. (d)

It is to be observed that what in one particular case, having regard to the nature of the invention and the public to whom the specification may rightly be supposed to be addressed, is a mere affair of practice before being able to succeed, ought in another particular case to be regarded by the Court as a matter of experiment, the necessity for which is fatal to the patent on the ground of insufficiency of the specification. Thus *Wills, J.*, has stated that, in his opinion, a chemical patent dealing with

(a) (1825) 1 Car. & P. 558; 6 B. & C. 169.

(b) *Tetley v. Easton*, (1852) *Newton, L.J.*, vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293; but see *Bradford Dyers' Association v. Bury*, (1900) 18 R. P. C. 161; 19 R. P. C. 1.

(c) *Edison v. Holland*, (1889) 6 R. P. C. 243; *Haskell Golf Ball Co. v. Hutchison*, (1905) 22 R. P. C. 493.

(d) *Liardet v. Johnson*, (1778) 1 W. P. C. 53; *R. v. Arkwright*, (1785) 1 W. P. C. 70; *Neilson v. Harford*, (1845) 1

W. P. C. 317; *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607; *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055; *Pooley v. Pointon*, (1885) 2 R. P. C. 167; *Hutchison v. Patullo*, (1888) 5 R. P. C. 351; *Elkington v. Clark*, (1888) 5 R. P. C. 327; *Gaulard and Gibbs's Patent*, (1888) 5 R. P. C. 535; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531; 45 L. J. Ch. 505; *Simpson v. Holliday*, (1886) L. R. 1 H. L. 315; *The Lifeboat Co. v. Chambers*, (1891) 8 R. P. C. 418.

very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes. (e)

Complete
Specifica-
tion.

The following passage from the judgment of *Lindley, L.J.*, in *Edison v. Holland*, (f) illustrates the point that, though trial may be necessary before success is attained, yet the specification may be sufficient:—

“If a person is told to carbonise a thread, and for want of thought or practice he takes a porous crucible for the purpose, and does not protect his thread, and fails, when, if he had packed this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instructor, if a little thought and consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that a workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad if it does not tell him which tool to use. . . . If a patentee says that something must be done which a reasonably competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand.”

IV. *The complete specification must particularly describe and ascertain the nature of the invention and in what manner the same is to be performed.*

This was specially enacted by the Act of 1883, s. 4; but before that statute the public had a Common Law right to a fair, full, and true description; (g) and it was laid down by *Ashurst, J.*, (h) that it is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable, and that it is of consequence that the terms used should express the invention in the clearest and most specific manner. *Buller, J.*, (i)

Now a statu-
tory as well
as a common
law requisite.

(e) *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 891.

(f) (1889) 6 R. P. C. 282.

(g) *R. v. Arkwright*, (1785) Dav. P. C. 61; *Macfarlane v. Price*, (1816)

1 Stark. N. P. 199; 1 W. P. C. 74 n.; *Gibson v. Brand*, (1842) 1 W. P. C. 640.

(h) *Turner v. Winter*, (1787) 1 W. P. C. 77; 1 T. R. 602.

(i) *Ibid.*

Complete
Specifica-
tion.
—

declared that where attempts were made to evade a fair patent he was strongly inclined in favour of the patent, but when the discovery is not fully made the Court ought to look with a very watchful eye to prevent any imposition on the public.

In *Hastings v. Brown*, (*k*) a patent granted for “certain improved arrangements for raising ships’ anchors and other purposes” was upset on the ground that the language used in the specification was ambiguous. The patent related to a windlass, the drum of which was grooved in a V form, the sides of the V groove being scalloped or recessed into a series of shell-like indentations, which formed a hold for the links of a chain cable, and the words used in the specification to describe the object of the invention were, “the scallop shell is upon a new plan, intended to hold, without slipping, a chain cable of any size, as shown by the opening form of the scallop at the top and bottom of Figure 2.” The drawing referred to (*l*) merely showed an indented V groove. It was established in evidence that before the date of the patent no cable-holder was known which would hold chains of different sizes, and the invention claimed by the pleadings as a novelty was the application of a single windlass to different sizes of chain cable. It was also established that a windlass, capable of holding a chain cable of a given size, was no novelty. The defendant’s case was that the patent was void because the language used in the specification left it doubtful whether the claim was for holding a chain of a given size or for holding chains of different sizes. The jury gave a verdict in favour of the patent. The Court of Queen’s Bench subsequently, however, directed a nonsuit to be entered, on the ground that the specification was bad, Lord Campbell, C.J., saying:—

“It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of the monopoly. This is not done by this specification. The claim is for an invention by which a single windlass may raise cables of different diameter, which is allowed to be a great improvement. But is that pointed out by the specification? The words are at best equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty; and the vice of the specification is that it does not

(*k*) (1853) 1 Ex. B. 450; 22 L. J. Q. B. 161.

(*l*) Fig. 2.

assert that more can be done by the invention. The title tells us nothing. The words of the specification are, 'a chain cable of any size.' 'A' applies to one only. At all events, the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing, which would do no more than that."

Complete
Specification.
—

It is a fatal defect if the specification does not disclose the object of the invention, and also how the same is to be effected. (m)

In *Kopp v. Rosenwald* (n) the Court of Appeal held that the claim was, when properly construed, for a process of making a new article, which depended upon the use of a braiding machine having a particular number of heads and spindles according to the number of strips of whalebone selected to compose the new article, and that, as the specification only gave a prescription which would be found useful in the case of two strips of whalebone, and was silent as to the number of heads and spindles required in other cases, the patent was void.

Lyon v. Goddard (o) is a case which illustrates the importance of clearly stating on the face of the specification the purpose for which a combination, which is the subject-matter of the patent, is designed and claimed. In that case, after a great deal of argument, which might have been rendered unnecessary by a more clearly drawn specification, it was finally decided by the House of Lords that, upon the true construction of the specification, the machine which was the subject of the patent was specially designed for use with high-pressure steam, and the claim was limited to its use with high-pressure steam for the purpose of disinfecting. The consequence was that a certain prior machine which could be used with low-pressure steam only was no anticipation of the plaintiff's invention, and so this ground of attack upon the patent failed.

Whilst, in order to support a patent, it is necessary that the patentee should fully disclose to the public what is the nature and object of the invention, and how the same is to be

Disclosure of
nature and
object of in-
vention and
how it is to

(m) p. 225 ante; *Allen v. Duckett*,
(1893) 10 R. P. C. 397.

(n) (1902) 20 R. P. C. 154.

(o) (1893) 11 P. O. R. 369.

Complete
Specifica-
tion.

Be performed
as far as
patentee's
knowledge at
the time ex-
tends is suffi-
cient.

carried out, (*p*) yet, if he make a full and fair disclosure *as far as his knowledge at the time extends*, he has done all that is required. (*q*)

Sirdar Rubber Co. v. Wallington, (*r*) is an illustration of the patent being declared bad expressly on the ground that the specification did not particularly describe and ascertain the nature of the invention and the manner in which it was to be performed. The reason why a full disclosure is required, is that a party who obtains a patent is bound clearly to define in his specification what it is he claims as his invention, in order that the public may know with certainty what they may, or may not, do without incurring the risk of an action for infringement of the patent, (*s*) and that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect. (*t*)

It is a condition, without the fulfilment of which the patent is void, that the patentee shall state the nature of his invention, in order that persons reading his specification shall know, and shall know with reasonable clearness and facility, what they are prohibited from using by the letters patent without permission or licence. (*u*)

In the case of patents for improvements on existing inventions the patentee must be specially careful to claim only the improvement and not the old invention. (*x*)

Sufficiency of
description
necessary,
when inven-
tion consists
of several
parts.

If the invention consists of more than one part, the specification must contain a full, accurate, and intelligible description of every such part, and the means of carrying it into effect.

Thus in *Morgan v. Seaward*, (*y*) Alderson, B., charging the jury in terms which have never been questioned, told them that the patentee had in his specification described two inventions, and that the patent would fail if either of them were insufficiently specified; for if a person run the hazard

(*p*) *Allen v. Duckett*, (1893) 10 R. P. C. 397; p. 225 *ante*.

(*q*) *Lewis v. Marling*, (1829) 10 B. & C. 22; 1 W. P. C. 496.

(*r*) (1905) 22 R. P. C. 257; 23 R. P. C. 132.

(*s*) Per Cresswell, J., *Gibson v. Brand*, (1841) 1 W. P. C. 627.

(*t*) Per Alderson, B., *Morgan v. Seaward*, (1836) 1 W. P. C. 174, 179.

(*u*) *Philpot v. Hanbury*, per Grove, J., (1885) 2 R. P. C. 33; see also

Fairburn v. Household, (1886) 3 R. P. C. 128, 263; *Rowcliffe v. Morris*, (1886) 3 R. P. C. 17.

(*x*) *Eades v. Starbuck Waggon Co.*, W. N. 1881, p. 160; p. 76 *ante*.

(*y*) (1836) 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153; see also *Reg. v. Wheeler*, (1819) 2 B. & Ald. 345; *Macnamara v. Hulse*, (1842) Car. & M. 471; *Stevens v. Keating*, (1847) 2 W. P. C. 175; 19 L. J. Ex. 57.

of putting two inventions into one patent, he cannot hold his patent, unless each can be supported separately. He told the jury this after having previously directed them that, in law, the patentee is required to state fairly to the public what the invention really is, in order that other persons may know what is the prohibited ground, and that the public may be made acquainted with the means by which the invention is to be carried into effect. The learned Baron also pointed out that it is of great importance to the public, and by law absolutely necessary, that the patentee should state in his specification not only the nature of his invention, but how that invention may be carried into effect. Unless he be required to do this, monopolies would be given for a term of years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect.

Complete
Specifica-
tion.
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V. *The complete specification need not describe any step or process which is necessarily implied.*

For instance, in the case of a specification of a newly invented chemical process, which directed that some particular chemical substance should be poured upon gold in a state of fusion, it would not be necessary that the specification should describe the obvious fact that, in order to carry out this direction, the gold would have to be put into a crucible and melted; nor would it be necessary to specify the manner in, nor the utensils with which the operation of putting gold into a state of fusion was to be performed, these being mere incidents with which every man acquainted with the subject must be familiar. (z)

Things neces-
sarily implied
need not be
specifically
described.

In *Crossley v. Beverley* (a) it was sought to upset a patent for an "improved gas apparatus," on the ground that the specification did not specify the use of a condenser, without which the apparatus would not work satisfactorily. Lord

(z) *Boulton v. Bull*, (1795) Dav. P. C. 162; 2 H. Bl. 498.

(a) (1829) 3 Car. & P. 513; 1 W. P. C. 106.

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Specifica-
tion.
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Tenterden, C.J., however, overruled this objection, holding that any workman capable of making a gas apparatus would know that he must put in a condenser, and the specification did not direct that the condenser should be left out.

In *Russell v. Cowley* (b) the specification of an invention for the manufacture of iron tubes without the use of a mandril was held sufficient, though it did not specifically state that the mandril was to be left out. The ground of the decision was that an ordinarily intelligent workman would, from the general purport of the specification, sufficiently understand that the mandril was to be omitted. (c)

VI. *The complete specification need not necessarily describe minutely any known thing to which it refers.*

Not necessary
to describe
a known thing
referred to.

For example, in the case of an invention which consists of an improvement on an existing machine, it would not be necessary for the patentee in the specification to enter into a minute description of the old machine, or the preparation of a known compound though the same is but little known and its manufacture difficult; (d) but it must not be forgotten that the language used must be such as will distinguish the invention from that which is old. (e)

In *Harmar v. Playne* (f) the patent related to improvements in machinery secured by previous letters patent. It was admitted by the defendant that the improvements for which the second patent was granted were included in the second specification, which gave a full and proper description of the whole machine in its improved state. It was objected, on the other hand, that the second specification did not, in any manner, point out or explain the improvements upon the former patented machine for which the second patent was granted, and, therefore, that it was insufficient. The Court of King's Bench, however, held the specification sufficient, Lord *Ellenborough*, C.J., remarking that the difficulty which pressed most was, whether this mode of making the specification was not calculated to mislead a person looking at it, and

(b) (1832) 1 W. P. C. 459.

(c) See also *Beard v. Egerton*, (1846) 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

(d) See *Badische Anilin und Soda Fabrik v. Leviustein*, (1887) 4 R. P.

C. 469.

(e) See 241 *post*.

(f) (1809) 14 Ves. 130; 11 East, 101; Dav. P. C. 311; see also *Tubes, Ld. v. Perfecta Seamless Tube Co Ld.*, (1902) 20 R. P. C. 77, 97.

induce him to suppose that the term for which the patent was granted might extend to preclude the imitation of other parts of the machine than those for which the new patent was granted, when he could only tell, by comparing it with some other patent, what were the new and what were the old parts; and if that might be done with reference to one, why not with reference to many other patents, so as to render the investigation very complicated?

Complete
Specifica-
tion.

It may not be necessary, in drafting a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and to apply to those the improvements, but it may be sufficient to refer generally to them; *e.g.*, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them.

VII. *The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.*

Thus, in Neilson's specification of his invention of an improved application of air in furnaces, the patentee stated that the form of the vessel in which the air was heated was quite immaterial, and the Court of Exchequer ruled that, on the evidence, the specification was sufficient in that particular. (g)

VIII. *The complete specification must describe the best method known to the patentee of performing the invention, and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection, prior to the date of filing the complete specification.*

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed, (h) and the description will not be sufficient unless it include the best means known to him at the time of filing the document. In fact, a man has no right to patent an invention and give the public only the humblest means

Specification
must extend to
the best of the
patentee's
knowledge.

(g) (1841) 1 W. P. C. 295, 328.

(h) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.

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Specifica-
tion.

that can be devised for carrying it into effect, and reserve to himself all the better part of it, and to box up his improvements, and to say to the world, "You are at liberty to perform my invention in this way, but it will be of very little use." (i) He must, on the other hand, put the public in possession of the discovery in as ample and beneficial a way as he himself uses it, (k) and place them in a position to derive the same benefit from it which he himself does. (l)

To use the words of *Gibbs*, C.J. : "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention; not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the knowledge of the patentee at the time; for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefits than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends, yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him." (m) And in the language of *Alderson*, B., "If a patentee is acquainted with any particular mode by which his invention may most conveniently be carried into effect he ought to state it in his specification." (n)

Thus in *Savory v. Price* (o) the patent was for the "invention of a neutral salt, under the name of *Seidlitz* powder," and the specification, to the misleading of the public, set out three distinct recipes for making the ingredients of the powder—viz., (1) Rochelle salt (*i.e.*, a double tartrate of

(i) *Tetley v. Easton*, (1852) Mac. P. C. 48.

(k) *R. v. Arkwright*, (1785) Dav. P. C. 61; 1 W. P. C. 64.

(l) *Turner v. Winter*, (1787) 1 T. R. 602; 1 W. P. C. 77; *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh. R. 211; *Wood v. Zimmer*, (1815) Holt, N. P. 57; *Tetley v. Easton*, (1852) Mac. P. C. 48; *Savory v. Price*, (1823) 1 Ry. & Mo. 1; 1 W.

P. C. 83; *Walton v. Bateman*, (1842) 1 W. P. C. 613; *Heath v. Unwin*, (1852) 2 W. P. C. 243; *Plimpton v. Malcolmson*, (1875) L. R. 3 Ch. D. 531, 582.

(m) *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh. R. 211.

(n) *Morgan v. Seaward*, (1836) 1 W. P. C. 174.

(o) (1823) Ry. & M. 1; 1 W. P. C. 83

potash and soda); (2) carbonate of soda; (3) tartaric acid— all of which were well-known substances before the date of the patent and readily procurable. The specification further and properly stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. The plaintiff was nevertheless nonsuited, *Abbott, C.J.*, saying:—

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Specifica-
tion.

“It is the duty of any one to whom a patent is granted to point out the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist’s shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported.”

It is evident that the patentee may not be in possession of the very best possible way of carrying out the invention. In that case the specification will not be bad if it turn out afterwards that it does not describe the best possible way of performing the invention; all that is necessary is that it should give the best method known to the patentee. (p) Neither is it incumbent on the patentee to describe all the possible advantages which may in future accrue from the improved use of his invention. He is only bound, under the statute and the patent law, to give the world the benefit of such information as he actually possesses. (q)

Patentee need not necessarily state the best way of carrying out the invention, but must state the best way known to him,

In the case of an invention made abroad it is the usual practice for the foreign inventor who is desirous of protection in this country to employ an agent to take out the patent for him, and the grant is made to the agent, who is therefore in law the patentee. (r) Under such circumstances the fact that

(p) *Neilson v. Harford*, (1841) 1 W. P. C. 317, 356; *The Househill Co. v. Neilson*, (1843) 1 W. P. C. 693; *Wood v. Zimmer*, (1815) Holt, N. P. 57; 1 W. P. C. 82 n.; *Savory v. Price*, (1823) 1 Ry. & Mo. 1; 1 W. P. C. 83; *Turner v. Winter*, (1787) 1 W. P. C. 81; *Morgan v. Seaward*, (1836) 1 W. P. C. 170; *Sturiz v. De la Rue*, (1828) 1 Carp.

Rep. 463; 5 Russ. 322; 1 W. P. C. 83; *Tetley v. Easton*, (1852) Mac. P. C. 76; *Derosne v. Fairie*, (1835) 1 W. P. C. 158; *Walton v. Bateman*, (1842) 1 W. P. C. 622; *Heath v. Unwin*, (1852) 2 W. P. C. 243.

(q) *Lyon v. Goddard*, (1893) 10 R. P. C. 345, judgment of Bowen, L.J.

(r) pp. 16-19 ante.

Complete
Specification.
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the foreign inventor was possessed of knowledge not in the specification will not render that instrument bad if it appear that the agent did not possess such knowledge, for the agent is the patentee, and it is only necessary that the specification should contain a description of the best means known to him of carrying out the invention (s). On the other hand, if the agent, the actual patentee, be possessed of knowledge not in the specification, it is no answer to an objection on the ground of insufficiency to say that the specification contains all the information which the agent received from the foreign inventor. (t)

If the specification do not describe everything which is necessary to the working of the invention to the best of the patentee's ability, it will not "particularly describe and ascertain the manner in which the invention is to be performed," as required by the Act of 1883. Hence the patentee must give the public every information which is necessary to enable them completely to perform every part of the invention, although it may be sufficient merely to refer in general terms to such things and processes as are old. And it also follows that if a material part, or anything which the patentee knows to be useful, is omitted, the specification will be insufficient.

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing it with tallow, and for want of that Lord *Mansfield* held it void. (u)

In the case of *Galloway's* patent for improvements in steam-engines and machinery for propelling vessels it appeared that a slight difference in the length of certain rods was a necessary feature in the successful working of the invention, and the specification did not state this fact. At the trial of an action (x) relating to this patent, *Alderson*, B., told the jury that the small necessary difference in the lengths of the rods ought to have been specified; and if it could not have been ascertained fully it should have been so stated. The small adjustment of the different lengths might have been made for the purpose of making the machine work more smoothly, and, if so, it was just as necessary that it should be so stated in the specification as it was that the tallow should be

(s) *Plimpton v. Malcolmson*, (1875)
3 Ch. D. 531, 582.

(t) *Wegmann v. Corcoran*, (1879) 13
Ch. D. 66; 41 L. T. N. S. 358.

(u) See *Liardet v. Johnson*, (1778)
1 W. P. C. 53.

(x) *Morgan v. Seaward*, (1836) 1 W.
P. C. 182.

mentioned in *Liardet v. Johnson*. The true criterion is this: "Has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him."

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Specifica-
tion.

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad, (y) for it is the duty of a patentee, possessed of a mode of carrying on his invention in a beneficial manner, to disclose the means of producing it in equal perfection and with as little expense and labour as he himself incurred. To enable the public, at the expiration of the monopoly, to perform the invention in the same way, and with the same advantages as himself, is the price which the grantee pays for the patent, and the specification is void if anything which gives an advantageous operation to the invention be concealed. Thus, in the case of *Wood v. Zimmer*, (z) a patent for a method of manufacturing verdigris was held void on the ground of the insufficiency of the specification, which did not disclose the fact that the patentee was accustomed to use *aqua fortis* in a boiler to facilitate the solution of copper, the evidence having established that the use of *aqua fortis* enabled the operation to be carried on in a much more satisfactory manner than the method described by the patent.

and must not
suppress any-
thing essential
thereto.

In the case of the *Hinks'* patent for the duplex lamp, the drawing attached to the specification did not show, and the letterpress did not describe, a certain aperture through which air was admitted to the second burner, and without which the lamp would not work. *Jessel, M.R.*, on this ground, held that the specification was bad. (a)

Examples.

In the case of *Mackelcan's* patent for improvements in floating docks, the patentee was unable to support his contention that his invention consisted in the use of *iron* for the construction of the floating dock described by the complete specification, because that document omitted all mention of

(y) *Lewis v. Marling*, (1829) 10 B. & C. 22; 4 Car. & P. 56; 1 W. P. C. 496; *Savory v. Price*, (1823) Ry. & M. 1; 1 W. P. C. 83; p. 202 *ante*.

(z) (1815) Holt, N. P. 58; 1 W. P.

C. 82 n.

(a) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

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Specification.
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the material of which the dock was to be constructed, and the patent was accordingly declared void, as it appeared that floating docks constructed of *wood* and of design similar to that described by the patentee were old. (b)

In *Derosne v. Fairie* (c) it appeared that it was desirable and necessary for the most beneficial working of the plaintiff's patented process for extracting sugar or syrup from cane juice and other substances containing sugar, and for refining sugar and other syrups, to remove all iron from the bituminous schistus used in the operation, and the complete specification did not state how this was to be done. The Court of Exchequer set aside the verdict given for the plaintiff, and directed a new trial, on the ground that there was no evidence to show that the process carried on with bituminous schistus in combination with any iron whatsoever would answer at all. The plaintiff had himself declared that in the bituminous schistus which he himself furnished the whole iron was extracted, and it appeared that it was admitted by counsel that the presence of iron would not only be disadvantageous but injurious. Further, without considering whether or not the patent would be avoided by the patentee keeping secret the means requisite to extract the iron from the bituminous schistus, it was clear that the patentee had not shown that what he had described in the patent could be used as so described without injury to the material going through the process. Under all the circumstances, the Court thought the plaintiff ought to have given some evidence to show that bituminous schistus, in the state in which it is found and known in *England*, could be used in the process with advantage; and, as he had not done that, the defendant was entitled to a nonsuit; but, at the same time, as it was alleged that the plaintiff might, on a new trial, supply the defect of proof as to the schistus by other evidence, the Court was desirous that the patent, if a good one, should not be affected by their judgment, and therefore they granted the new trial.

It was laid down by *Parke, B.*, to the jury in *Neilson v. Harford*, (d) that if the patentee knew that internal partitions in a certain cylinder, interposed between a blowing apparatus and a furnace, were useful, the omission to state that fact in

(b) *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52.

(c) (1835) 5 Tyr. 393; 1 W. P. C. 154.

(d) (1841) 1 W. P. C. 317, 321.

the specification would be a fatal defect. (e) And in *Re v. Arkwright* (f) it was proved that for the successful working of the defendant's spinning machinery it was necessary that the difference in the velocity of certain rollers should be adjusted, and the specification was silent on this point. *Buller, J.*, commenting on the evidence which the defendant adduced to show what his invention really was, used the following words: "The man that comes to give an account of the invention says, 'I had calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers and velocity, and it is left to people to find it out as chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

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Specifica-
tion.
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Though it is essential that all the processes described and claimed should be successful, (g) it is not necessary that all the processes described in a specification should prove equally successful, or of equal commercial value. The fact that persons to whom the specification is addressed have to try them to determine which is the best commercially, or that even the patentee himself does not know which is the best at the time, will not invalidate the patent. (h)

It is not requi-
site that all
processes
claimed shall
be equally
successful.

Lord *Herschell*, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik v. Levinstein* (i) after having pointed out the causes which may give a different commercial value to a given product at given times, continued—

"It was urged by the learned counsel for the respondents that a patentee is bound to disclose the means by which his invention may be carried into effect, and that, if he leaves this to be ascertained by experiments, his patent cannot be supported. This is, no doubt, correct. But I think the patent under consideration does show how the colouring matters are to be produced, and that what it leaves a skilled person of the class to

(e) See also *Macnamara v. Hulse*, (1842) Car. & M. 471; 2 W. P. C. 128 n.

(f) (1785) 1 W. P. C. 70.

(g) *Beard v. Egerton*, (1846-49) 19 L. J. C. P. 39; *Derosne v. Fairie*, (1835) 1 W. P. C. 165; *Cole v. Saqui*, (1883) 5 R. P. C. 491.

(h) *Otto v. Linford*, (1881) 46 L. T. N. S. 35; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) 4 R. P. C. 449; L. R. 12 App. Cas. 710; *Thomson v. Batty*, (1889) 6 R. P. C. 84, 97.

(i) (1887) 4 R. P. C. 466; L. R. 12 App. Cas. 710.

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Specifica-
tion.

whom the specification is addressed to discover, is, only, which of these colouring matters will best answer his purpose at any particular time. There is, in my opinion, no warrant for asserting that this invalidates the patent."

When an improved method discovered during the period of provisional protection should be included, and when it should not be included.

The question may arise as to whether, if an inventor, after having lodged a provisional, but before filing a complete specification, discover an improvement on the invention covered by such provisional specification, he must include a description of the improvement in his final specification (on the ground that the document would be insufficient without it, the improvement being the best means known to the patentee of performing the invention), or whether the improvement may form the subject-matter of a separate and further patent. In such a case it would appear that the real point to decide would be the nature of the improvement in question. It is submitted that, if the evidence establish this to be only a method or means of carrying out the invention covered by the provisional specification, the omission of a description of it would render the final specification bad on the ground that the document did not contain the best method known to the patentee of performing the invention. If, however, the improvement consist in an invention which is really distinct from that comprised by the provisional specification, it may be capable of forming the subject of a separate patent, (*k*) and a distinct claim to it *per se* in the final specification would be a fatal defect; for the claim to the improvement in that case would be a claim to an invention in respect of which the provisional specification gave no protection, and the patent therefore could not include it. (*l*)

Provisional protection is granted to the patentee for the express purpose of enabling him to bring the invention to a state of perfection, and it is only equitable that he should be compelled to disclose the latest and best information he possesses, so that the public may profit by it when the patent expires.

If the improvements made during the period of provisional protection be of such a nature as not to fall within the limits of the provisional, they must not be inserted in the final specification, as a claim to them would probably render the

(*k*) Edison v. Woodhouse, (1887) L. R. 32 Ch. D. 520.

(*l*) *Ibid.*: Crossley v. Potter, (1853) Mac. P. C. 240; Bailey v. Robertson,

(1878) L. R. 3 & 5 App. Cas. 1055; Penn v. Bibby, (1866) L. R. 2 Ch. 27; Siddell v. Vickers, (1888) 39 Ch. D. 105.

patent void; (*m*) moreover, the patentee, by a general claim, cannot include in his patent improvements of which he was ignorant at the date of the patent. (*n*)

Bailey, J., speaking at a time when the patent was granted before, and subject to, the filing of a final specification, said: "It is the duty of the inventor, if between the period of taking out the patent and enrolling the specification he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification." (*o*)

And *Tindal, C.J.*, speaking at a like period, declared that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification. (*p*).

A patentee filing a provisional specification which shows the nature of his invention is not bound to describe therein any mode of carrying it into effect; but if he does so, and before filing his complete specification discovers an improvement in such mode, he is bound to give to the public in his complete specification the benefit of what he has discovered as to the mode of carrying the invention into effect; and a statement in the complete specification of improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view to producing the same results, the substitution of mechanical equivalents, modifications and developments within the scope of the invention set out in the provisional specification will not invalidate a patent on the ground of disconformity between the provisional and complete specification. (*q*).

When a patentee explained the objection to his specification,

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Specifica-
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(*m*) pp. 190-199 *ante*.

(*n*) *Tetley v. Easton*, (1852) *Macr. P. C.* 77.

(*o*) *Crossley v. Beverley*, (1829) 1 *W. P. C.* 117; 3 *C. & P.* 513.

(*p*) *Jones v. Heaton*, 1 *W. P. C.* 404 *n.*; see also *Crossley v. Beverley*, (1829) 1 *W. P. C.* 117; *Woodward v. Sansum*, (1887) 4 *R. P. C.* 166; *Crampton v. Patents Investments Co.*,

(1888) 5 *R. P. C.* 397.

(*q*) *Woodward v. Sansum*, (1887) 4 *R. P. C.* 166; *Siddell v. Vickers*, (1888) *L. R.* 39 *Ch. D.* 92, 103; *Plimpton v. Malcolmson*, (1875) *L. R.* 3 *Ch. D.* 531, 580; *Moseley v. Victoria Rubber Co.*, (1887) 4 *R. P. C.* 241; *Crampton v. Patents Investments Co.*, (1888) 5 *R. P. C.* 382, 397; *Ward v. Hill*, (1903) 20 *R. P. C.* 189; see pp. 188-199 *ante*.

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tion.

that it did not contain all the knowledge he possessed relative to carrying out the invention, by saying that, at the date of the patent, he did not think a certain substitute for a method given equally good to that described, and that, though since the date of the patent he had actually patented the new method he had in fact returned to the original, the Court held that the patent was not invalidated. (r)

And when, during the interval between the filing of the provisional and complete specifications of an invention of an electric lamp with which comprised a carbon filament in combination with other parts, the patentee lodged a provisional specification of an invention for a method of making the carbon filament, the Court held that it was no objection to the validity of the patent for the first invention that the patentee did not in the complete specification filed in respect of it, disclose the method of making the filament which formed the subject of the invention disclosed by the second provisional specification. The decision was based on the ground that the method of manufacturing the filament did not form the basis of any claim made under the first patent. (s)

IX. *The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.*

No necessity
to state every
means of pro-
ducing a
desired result.

It is not necessary that the specification should state precisely every means that will produce a given effect. Thus the specification of *Bickford's* miners' safety fuse, which was formed of several strands of flax, hemp, &c., enclosing within the interior a small core of fine powder, stated: "I manufacture flax, hemp, cotton, or other suitable materials, spun, twisted, and countered, and otherwise treated in the manner of twine spinning and cord-making, by means whereof I embrace in the centre of my fuse a small portion or compressed cylinder or rod of gunpowder or *other proper combustible matter*, prepared in the usual pyrotechnical manner of firework for the discharging of ordnance." It appeared in the evidence, at a trial in which the sufficiency of the specification was in issue, that gunpowder was, in fact, the material used by the patentee; but, in the opinion of one witness, detonating powder would

(r) Thomson v. Batty, (1889) 6 R. P. C. 84, 100.

(s) Edison v. Woodhouse, (1887) L. R. 32 Ch. D. 520.

answer the purpose, but less effectively. The jury gave a verdict for the patentee on the issue of sufficiency, and a rule nisi for a new trial was discharged by the Court of Queen's Bench, who were of opinion that it was immaterial if other materials, not specified, but within the description given, would answer the purpose, and that it was certainly not necessary to specify all. (t)

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Specifica-
tion.
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If the specification state the best method known to the patentee of carrying the invention into effect, (u) it is not necessary to give every means of so doing. A general claim may not entitle the patentee to improvements of which he was ignorant at the date of the patent. (x)

X. *If the complete specification describes anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.*

The Act of 1883 (y) requires that the complete specification shall particularly describe and ascertain the invention; it is impossible to contend that a specification does this, if it describes things which are old as well as the novelty, which is the real invention, without distinguishing the one from the other. The point to be carefully borne in mind in considering the question is whether or not the claim amounts to a claim to anything which is old, in which case the specification will be bad, and the patent void, on the ground that the patentee has claimed something which lacks the essential feature of novelty. (z)

Distinct claim.
to something
old is fatal.

It is, however, to be observed that sometimes a claim may appear to include something which is old, whereas on the true construction of the specification it does not really amount to more than a statement that the invention is equally as useful for some purpose for which an alleged anticipation was useful as it is for the purpose which is the subject of the claim, and for which the alleged anticipation is wholly useless. Such a claim will not vitiate the patent, though it may be objectionable from the draughtsman's point of view as not being as clearly drawn as it might be. (a)

Claim may be
only appa-
rently for
something old.

(t) *Bickford v. Skewes*, (1838) 1 W. P. C. 211, 218.

(u) pp. 231-240 *ante*.

(x) p. 353 *post*.

(y) 46 & 47 Vict. c. 57, s. 5,

sub-s. 4.

(z) Chap. iii. *ante*, p. 251 *post*.

(a) See *Lyon v. Goddard*, (1891) 11 R. P. C. 361.

Complete
Specifica-
tion.

Claim to im-
provements on
old things, and
combinations
of old parts.

In the case of a patent for a combination which consists of new and old parts, if the combination is only claimed as a whole, it is not necessary to specify which of the parts are new and which old. (*b*)

An improvement on an existing machine may be the subject-matter of a new patent; (*c*) but if the specification does not distinguish clearly the improvement from the old parts, and claim only the new improvement, the patent will be void, for it cannot include both the addition and the old machine. (*d*)

And if, in the case of a combination patent, the combination as a whole is not new, but there is some particular improvement in some particular part, the specification will be insufficient if it claims the whole combination as new. It must condescend upon that which is improved, and specifically lay claim to that and that only. (*e*)

Thus, if a compensation pendulum were now for the first time invented, it would not do to patent improvements in clocks in general terms, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and combination. The patentee ought to say expressly: "I claim the invention of a compensation pendulum, and make it thus." (*f*)

A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent. (*g*) If a combination of a certain number of these parts existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specification will be bad if the claim includes the old combination separately. (*h*) If all the parts are old, the specification will be bad unless it claim only the new

(*b*) *Moore v. Bennett*, (1884) 1 R. P. C. 129, 142; *Foxwell v. Bostock*, (1864) 4 De G. J. & S. 298; *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Watling v. Stevens*, (1886) 3 R. P. C. 37; *Proctor v. Bennis*, (1887) 4 R. P. C. 333, 358; *Kaye v. Chubb*, (1888) 5 R. P. C. 641; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 328; *Patent Exploitation, Ltd. v. Siemens Brothers & Co., Ltd.*, (1901) 21 R. P. C. 546-47.

(*c*) p. 75 *ante*.

(*d*) *Rex v. Else*, (1785) 1 W. P. C. 76; *Bovill v. Moore*, (1815) 2 Coop.

Ch. Cus. 56; *Dav. P. C.* 561; *Potter v. Parr*, (1815) 2 B. & S. 216 *n.*; *Moore v. Bennett*, (1884) 1 R. P. C. 129, 143; *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Parke v. Stevens*, (1869) L. R. 8 Eq. 358, 366.

(*e*) *Moore v. Bennett*, (1884) 1 R. P. C. 129, 143; *Philpot v. Hanbury*, (1885) 2 R. P. C. 33, 39.

(*f*) Per James, V.C., *Parke v. Stevens*, (1869) L. R. 8 Eq. 358, 365.

(*g*) p. 75 *ante*.

(*h*) See *Bovill v. Moore*, (1815) per Gibbs, L.C.J., *Dav. P. C.* 404.

combination. (i) A patentee is required to set forth in the complete specification a true account and description of his invention, and it is necessary that he should state what his invention is—what he claims to be new, and what he admits to be old; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole, as new, then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turn out to be old, or the combination itself be not new. (k)

Again, if the specification describe both old and new parts without clearly making it appear that that which is old is not claimed, the patentee must be taken to lay claim to all, and the specification will be consequently bad. (l) But this rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new. (m)

In the case of an invention which is alleged to be an improvement on something which has been done before, it is necessary that the complete specification should state in what the improvement consists. If the invention be claimed as an improvement, and nothing is said of any previous use of which the thing proposed is an improvement, the patent may incur the risk of being construed as a claim of entire and original discovery. (n)

In *Holmes v. The London and North Western Railway Co.* (o) it appeared that the plaintiff had obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's

(i) *Lister v. Leather*, (1857) 3 Jur. N. S. 811; 8 E. & B. 1004; *Seed v. Higgins*, (1860) 8 H. L. Cas. 550; *Potter v. Parr*, 2 B. & S. 216 n.; *Kay v. Marshall*, (1837) 2 W. P. C. 71; *Moore v. Bennett*, (1884) 1 R. P. C. 129; *Proctor v. Bennis*, (1887) 4 R. P. C. 333, 358; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 328.

(k) Per Abinger, C.B., *Carpenter v.*

Smith, (1841) 1 W. P. C. 530.

(l) *Tetley v. Easton*, (1852) Macr. P. C. 48.

(m) Per Coleridge, J., Macr. P. C. 87.

(n) *Hill v. Thompson*, (1818) 1 W. P. C. 247; *Leggott v. McGeort*, (1893) 10 R. P. C. 429, 435.

(o) (1852) Macr. P. C. 4; 12 C. B. 831; 22 L. J. C. P. 57.

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tions.

patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument, and gave a verdict for the plaintiff, which was, however, ordered by the Court of Common Pleas to be entered for the defendant, on the ground that the specification was bad, as not distinguishing between the new and the old.

So in *Macfarlane v. Price* (p) the omission of a distinction between the new and old matters mentioned in the specification proved a fatal defect to the plaintiff's patent for "improvements in umbrellas," and in *Saunders v. Aston* (q) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification. (r)

Rule in
Foxwell v.
Bestock.

Lord *Westbury*, L.C., in *Foxwell v. Bestock*, (s) laid down the rule, as following from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the general description of the entire machine; it must assign the *differentia* of the new combination.

If an improved machine is the result of several combinations, the claims may be so framed that the several combinations leading up to the one principal combination may be themselves divided into several parts in which each specific combination, A, B, and C, may be considered as a separate integer, and each such integer may in itself be the subject of a claim or separate letters patent, and also in their combination the several inventions, A, B, and C, may produce a total result which may also be the subject of a claim or separate letters patent. (t)

In *Lister v. Leather* (u) it was stated by Lord *Campbell*, C.J., and approved by the Court of Exchequer, that if the combination, the subject of the patent, was new and useful, though each of the parts which entered into it were old, still the combination might be the subject of a valid patent, and a patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has often been decided.

(p) (1816) 1 Stark. R. 199.

(q) (1832) 1 W. P. C. 75.

(r) See also *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52.

(s) (1864) 4 De G. J. & S. 298, 313.

(t) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 327.

(u) (1857) 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

Further, a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. Complete Specification.

The decisions in *Foxwell v. Bostock*, and *Lister v. Leather*, deserve careful consideration, and have formed the subject of judicial explanation and comment. First, *Foxwell v. Bostock* must not be taken as deciding that where there is a patent for a combination there must be a discovery or explanation of the novelty of each respective part, and that the specification must also show what is the novelty and what the merit of the invention. On the contrary, in the case of a patent for a combination the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which must be proved by evidence. And the claim to it is a sufficient description (x). The rule in *Foxwell v. Bostock*, when properly explained, really only means that when a claim is made to a general combination and arrangement of the different parts of a machine, if the combination is not new, but there is some particular improvement in some particular part of, or addition to, the parts previously combined, it will not do to claim the whole combination as new, but the patentee must condescend upon that which is improved. For example, if a machine exactly similar to another had been in long use in a particular trade, and some particular improvement, say, in the arrangement of a cog, or in the arrangement of some other portion of an old combination, which was new and useful, or an addition to the known machine, say, of the nature of a gridiron pendulum to a clock, had been made, the general combination remaining the same, then it would be a misdescription to describe it as a new combination, because the thing discovered would be a particular improvement upon a particular part or element of that combination, or an addition thereto, and the patentee must not claim the whole machine but he must indicate and claim the improvement or addition. (y)

If it is clear that the claim is for a combination, and nothing but a combination, there can be no infringement of the patent

(x) *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 576, 580; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333; *Kynoch & Co. v. Webb*, (1899) 17 R. P. C. 100; *British Shoe Machinery Co. v. Thompson*,

(1904) 22 R. P. C. 198.

(y) *Moore v. Bennett*, (1884) 1 R. P. C. 129, 143; *British Shoe Machinery Co. v. Thompson*, (1904) 22 R. P. C. 198; see pp. 75-80 *ante*.

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tion,
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unless the whole combination, or such combination of some or all other parts as amounts only to a colourable imitation, be used; (z) and it is in that way immaterial whether any or which of the parts are new. It might, however, be left open on the specification for the patentee to claim not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister v. Leather*; in such a case, in accordance with the true meaning of the rule in *Foxwell v. Bostock*, it would appear that the specification would be defective if, by merely giving a general description of the whole combination, it left in doubt what claim to parts in addition to the claim to the combination the patentee meant to assert. The specification must not mix up the real novelty with the old parts mentioned, and so render it necessary for a person reading it to get rid of a large portion by eliminating all that is old and commonplace, all that has formed the subjects of other patents and other improvements, before he is able to discover in what the new invention made by the patentee really consists. (a)

Bowen, L.J., commenting on the decision in *Foxwell v. Bostock*, and in reference to the fact that the case was discussed and distinguished by the House of Lords in *Harrison v. Anderston Foundry Co.*, (b) in a subsequent case, said:—

“When a combination and nothing more is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to be the true law as laid down in *Harrison v. The Anderston Foundry Co.*, without a reference to which case *Foxwell v. Bostock* ought not to be read, because it is possible to misread *Foxwell v. Bostock*, unless you correct your impression of it afterwards by the judgment of the House of Lords, *Harrison v. The Anderston Foundry Co.*” (c)

(z) *Clark v. Adie*, (1873) 2 App. Cas. 315, 320; p. 348 post.

(a) *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574, 579; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358, 365; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 328; *Proctor v. Bennis*, (1887) 4 R. P. C.

333, 350; *Moore v. Bennett*, (1884) 1 R. P. C. 129; *Kynoch & Co. v. Webb*, (1899) 17 R. P. C. 100; *British Shoe Machinery Co. v. Thompson*, (1904) 22 R. P. C. 177.

(b) (1876) L. R. 1 App. Cas. 574.

(c) *Proctor v. Bennis*, (1887) 4 R. P. C. 358; see also *Walling v. Stevens*,

The rule in *Foxwell v. Bostock*, (d) as explained in the foregoing pages, was adopted and applied by the House of Lords in the more recent case of *Kynoch v. Webb*, (e) where, reversing the Courts below, the House held the patent void on the ground that the patentee had not differentiated his invention from what was old and that, upon its true construction, the claim was not limited to the novel feature of the machine which was the real invention. In *British United Shoe Machinery Co. v. Thompson* (f) the Court decided that the rule in *Foxwell v. Bostock* did not apply to the circumstances of that case, because there the invention was a new arrangement and user of the constituent parts of a known machine in a particular way so as to produce a novel and useful result.

Complete
Specifica-
tion.
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Harmar v. Playne (g) at first sight appears an exception to the rule in *Foxwell v. Bostock*, but it is not so. It there appeared that a patent was taken out for a machine, and that the inventor afterwards discovered an improvement and obtained a second patent for the improved machine, describing in the specification the whole machine without distinguishing the improvement. The Court overruled the objection that the specification was bad, saying that the patentee had, in the second specification, recited the first, and that recital being in immediate comparison with the new specification, furnished in *gremis* of the new patent, the means of distinguishing the new from the old. The same point of view was adopted by the House of Lords in the more recent case of *Tubes, Ld. v. Perfecta Seamless Tube Co., Ld.* (h)

An apparent
but not real
exception to
the rule in
Foxwell v.
Bostock.

The marginal note in *Lister v. Leather*, if hastily read, is calculated to give colour to the erroneous conclusion that a claim for a combination or arrangement is a distinct claim for everything that is new and material, and goes to make up the combination. A careful consideration of the judgment, however, shows that there is really no warrant for this notion. What the decision really amounts to is a declaration that a valid patent, for an entire combination for a process, gives protection to each part thereof that is new and material for that process; which is really nothing more than saying, in

Claim to an
entire com-
bination for a
process pro-
tects all parts
new and mate-
rial for that
process.

(1886) 3 R. P. C. 153; *Keely v. Heathman*, (1890) 7 R. P. C. 343; *Peckover v. Rowland*, (1893) 10 R. P. C. 118, 234; *Patent Exploitation. Ld. v. Siemens Brothers & Co., Ld.*, (1904) 21 R. P. C. 516.

(d) p. 244 *ante*.

(e) (1899) 17 R. P. C. 100.

(f) (1904) 22 R. P. C. 177, 198.

(g) (1809) 11 East, 101; 14 Ves. 130; Dav. P. C. 311.

(h) (1902) 20 R. P. C. 77, 87.

Claims. other words, that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question is in every case a question of fact—is it really and substantially a part of the invention? (i) If a man is desirous of securing to himself protection by letters patent, in respect of not only the whole, but something less than the whole, of a new arrangement, construction, or combination of parts, he must clearly show that he claims that something less more specifically than by merely describing and claiming the whole. (k) If, on the other hand, the invention is for the combination only, and not any of the specific parts, the specification must make it clear that it is the combination, and not any of the specific parts, which is claimed. (l)

THE CLAIMING CLAUSES.

Distinct claiming clauses are in practice required, but are not absolutely necessary.

Previous to the passing of the Patents Designs and Trade Marks Act 1883, a distinct claim was not a necessary part of the complete specification, but it had long been the practice to insert one, in spite of the fact that it had been held that neither a claim nor a disclaimer was essential; and further, that that which appeared to be the invention, or part of it, would be protected though there were no distinct claim, and those matters which manifestly formed no part of the invention need not be disclaimed. (m)

The Act of 1883, however, expressly provides (n) that the complete specification must, in every case, end with a distinct statement of the invention claimed, but this provision is only in the nature of a direction, and a failure to comply with it will not invalidate the patent. (o) Consequently, it is no more necessary since the Act of 1883 than before it that the complete specification should end with a distinct claim, if what the patentee claims can be gathered from the specification;

(i) Per James, V.C., *Parkes v. Stevens*, (1869) L. R. 8 Eq. 365; *Clark v. Adie*, (1873) L. R. 10 Ch. 674; L. R. 2 App. Cas. 315.

(k) *Clark v. Adie*, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

(l) *Rowcliffe v. Morris*, (1886) 3 R. P. C. 17; *Murray v. Clayton*, (1872) L. R. 7 Ch. 570, 578; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229, 241; *Watling v. Stevens*, (1886) 3 R. P. C. 37; pp. 244-247 *ante*.

(m) *Lister v. Leather*, (1857) 8 E. & B. 1004; *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34, 54; *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 426.

(n) s. 4, sub-s. 5.

(o) *Siddell v. Vickers*, (1888) 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 148, 163, 389; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.*, (1902) 2 R. P. C. 77.

though it must not be forgotten that, independently of the provisions of sec. 5, sub-s. 5, of the Act of 1883, the specification may be so indefinite as to be bad, on the ground that the patentee has not fulfilled the obligation of properly describing the invention for which he claims the protection of the law. (p)

A "distinct statement" means something more than a separate paragraph. It should be a concise statement of the main features of the invention, something to which the reader may readily refer, and learn therefrom, without referring to the body of the specification, what are the characteristic features of the invention claimed. (q)

The claim is not to be considered as a description of the means of performing the invention, but it is introduced as a security for the patentee. It is evident that the patentee may in the specification have alluded to things which are not new, in his endeavour to describe the invention, and the manner of performing it; in such a case, the claim is introduced, not with the object of aiding the description, but so that the patentee may limit his claim to protection only to such matters as he can prove are his invention and new. (r) The real object is not to claim anything which is not mentioned by the specification, but to limit the claim, and, in the language of *James, L.J.*,

Claims.

Claim
operates as a
security for
the patentee.

"A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use. He describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says, 'But take notice, I do not claim the whole of that machine: I do not claim the whole of that *modus operandi*, but that which I claim is that which I am now about to state.' That surely is the legitimate object of a claim, and you must always construe a claim with reference to the whole of a specification." (s)

(p) *Siddeil v. Vickers*, (1888) 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 148, 163, 389; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.*, (1902) 2 R. P. C. 77.

(q) *Siddell v. Vickers*, (1888) 5 R.

P. C.; L. R. 39 Ch. D. 109; *Bancroft's Patent*, (1905) 23 R. P. C. 89.

(r) *Kay v. Marshall*, (1836) 2 W. P. C. 39.

(s) *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 426; see *Edison v. Woodhouse*, (1886) 32 Ch. D. 520; *Daw v. Eley*, (1867) 14 W. R. 126; L. R. 3 Eq. 496; *Russell v. Cowley*, (1835) 1

Claims.

A claim is by implication a disclaimer.

It is a frequent practice for a patentee in his specification to state that he does not claim such and such a thing described; but when a clear and distinct claim is made the patentee is not bound further to distinguish between what is claimed and what is disclaimed, for everything which is not included in the claim is thereby disclaimed. (t) And, consequently, if a patentee has described in his specification a number of distinct inventions which are all new and useful, but so related as probably to come within one patent, (u) and he has chosen to claim only one, he has thereby made a present of the rest to the public, and he can only be protected in respect of the one he has claimed. (x) Thus, where a patentee claimed a general combination, and also certain subsidiary parts, the House of Lords held that the claim to those specified subsidiary parts excluded the possibility of a claim for any other parts. (y) Again the omission to include an essential part in a combination claim may be fatal on the ground that the combination actually claimed is not useful, and is not subject-matter. (z)

Rules to be observed in drafting claiming clauses.

The following are the chief features to be observed in drafting claims:—

- I. The claim must not be too extensive, so as to embrace more than the patentee has invented.
- II. The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.
- III. If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.
- IV. A claim to something old, when that claim is not made *in gross*, but only as *appendant* to something new, will not vitiate the patent.
- V. A patent for the production of a new and useful

W. P. C. 465; Thomas v. Welch, (1866) L. R. 1 C. P. 192; Edison-Bell Phonograph Corporation v. Smith, (1894) 11 R. P. C. 401.

(t) Harrison v. The Anderston Foundry Co., (1876) 1 App. Cas. 574, 579; Easterbrook v. Great Western Ry. Co., (1885) 2 R. P. C. 201, 208; Lucas v. Miller, (1885) 2 R. P. C. 159; Hinks v. Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; United Telephone Co. v. Harrison, (1882) L. R. 21

Ch. D. 721, 741.

(u) See Vol. II. p. 8 *post*.

(x) Hinks v. Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; Jackson v. Wolstenhulmes, (1884) 1 R. P. C. 105; Fairburn v. Household, (1886) 3 R. P. C. 263; Parkinson v. Simon, (1895) 12 R. P. C. 406.

(y) Harrison v. Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574, 578.

(z) Weir v. Denny, (1894) 11 R. P. C. 657.

material will not be vitiated by a claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.

Claims.
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I. The claim must not be too extensive, so as to embrace more than the patentee has invented.

If the patentee lay claim to anything he has in fact not invented, (a) or not described, (b) he will thereby render his patent bad, notwithstanding that the specification may describe and claim things which are new and of which he was the undoubted discoverer. Thus, if the specification describe both a machine and a method of using it, and the evidence establish that the machine was old, but that the method was new, the patent cannot be supported, unless the claim is strictly limited to the method of using the machine. (c) Again, if the real invention be an ingenious new use of an old and known thing, and the claims are not limited to the new use, but are wide enough to definitely claim the old thing itself apart from the novel application, the patent is void. (d) So also a patent is void when upon the true construction of the specification the claim includes both a process and separately an apparatus for carrying it out, and one or other is old. (e) If the claim be for a process as carried out by an apparatus, the lack of novelty in the apparatus would no doubt be no objection to the validity of the patent, for there would then be no separate claim to it. (f)

Claim which extends to what patentee has not invented or described is fatal.

If the claim, upon a true construction, be for a method as distinct from an apparatus and the method be old, the patent is void; in this connection it is not unimportant to remember

(a) Chap. iii., p. 241 *ante*; *R. v. Elze*, (1785) 1 W. P. C. 76; *Thomas v. Foxwell*, (1858) 5 Jur. N. S. 37; 6 Jur. N. S. 271; *Crossley v. Potter*, (1853) Macr. P. C. 240; *Ralston v. Smith*, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1856) 2 H. & N. 84; *Saunders v. Aston*, (1832) 3 B. & Ad. 881; 1 W. P. C. 75; *Haworth v. Harcastle*, (1834) 1 W. P. C. 484; *Jordan v. Moore*, (1866) L. R. 1 C. P. 624; *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; *Bailey v. Robertson*, (1876) L. R. 3 App. Cas. 1655; *Cropper v. Smith*, (1884) 1 R. P. C. 81; *Gandy v.*

Reddaway, (1885) 2 R. P. C. 49; *Leadbeater v. Kitchin*, (1890) 7 R. P. C. 235; *Kynoch & Co. v. Webb*, (1899) 17 R. P. C. 100; *Dick v. Ellam's Duplicator Co.*, (1900) 17 R. P. C. 196, 200.

(b) *Monnet v. Bock*, (1897) 14 R. P. C. 777.

(c) *Hill v. Thompson*, (1817) 1 W. P. C. 232; *Tetley v. Easton*, (1852) 2 E. & B. 956.

(d) *Dick v. Ellam's Duplicator Co.*, (1900) 17 R. P. C. 196, 202.

(e) *Tolson v. Speight*, (1896) 13 R. P. C. 718; *Kynoch & Co. v. Webb*, (1899) 17 R. P. C. 100.

(f) *Tolson v. Speight*, (1896) 13 R. P. C. 721; p. 260 *post*.

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that references to drawings may be construed as for the purpose of illustration only, and not as having the effect of restricting the claim to a particular apparatus. (g) On the other hand, in some cases, the very contrary may be the effect of a reference to the drawings. (h) A claim which, *nominatim*, refers to a method may upon its true construction be confined to the method when carried out by a particular machine—*e.g.*, where the method involves the performance of a process which a novel machine, the subject of the other claims is expressly designed to effect, and the only instance of the performance of the process referred to in the specification is that effected by the use of the patented machine. (i)

If a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported. (k)

Hill's patent, for an invention of improvements in the smelting of iron, was rendered void because in the specification he claimed both the usefulness of lime in the process, and the use of a certain specified quantity, whereas it appeared in evidence that the use of lime for the purpose was not new. The patent was therefore declared void, although it might possibly have been good if the claim had been limited to the use of the specified quantity. (l)

Minter's patent for an improvement in the construction of chairs suffered from a like defect in the specification, and was consequently declared void by the Court when its validity was questioned. It appeared that a chair on the same principle as *Minter's* had been invented before the patent, but encumbered with additional parts, and, unfortunately for *Minter*, the claim in his specification included not only the chair as made by him, but also the former one, and covered, therefore, more than he had invented. In fact, it would, if upheld, have prevented the former inventor from continuing to make the same chair that he had made before *Minter's* discovery.

A claim to something which is useless for the purpose the patentee has in view is fatal. Thus a patent for extracting gold from ore by cyanide of potassium was held bad because the patentee claimed the use of all strengths of solution of

Claim to something useless for purpose in view is fatal,

(g) See *British Motor Traction Co. v. Friswell*, (1901) 18 R. P. C. 487.

(h) See *Hattersley v. Hodgson*, (1904) 21 R. P. C. 517; 23 R. P. C. 192.

(i) See *Gammons v. Battersby*, (1904) 20 R. P. C. 540; 21 R. P.

C. 322.

(k) *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239.

(l) *Hill v. Thompson*, (1817) 1 W. P. C. 232.

cyanide, whereas the evidence established that a weak solution alone would do, and a strong solution was utterly useless for the purpose the patentee had in view. (*m*)

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On the other hand, a patentee who discovers a valuable invention does not invalidate his patent by a claim for a second purpose less valuable than the main purpose, unless the second purpose has absolutely no utility, or has been anticipated, or required no invention. (*n*)

but not so a claim to something of limited utility.

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent; (*o*) but a claim must be very extensive indeed to justify the Court in saying, without evidence, that it is impossible to sustain a patent based upon it. (*p*)

If the patentee claims more than he has invented, he by so doing makes his patent null and void. But if he thinks he has invented more than he has in fact invented, and describes advantages arising from what is not, as well as what is, his own invention, it does not follow that the patent may not be a good one; for it can be sustained if the invention, as claimed, is so limited as not to cover things in prior use, though it does refer to advantages common to the use of old things and what the patentee has invented. (*q*)

Also an inventor is entitled to claim not only the use of an improved apparatus for the purpose for which he primarily designed it, but also its use for analogous purposes; and it is no objection to such a claim that there are some analogous purposes not mentioned to which the patentee's invention would not be applicable. (*r*)

If the complete specification describe any method of carrying out the invention which will not answer, and so lead the public to perform operations which must necessarily fail, the patent will be bad; (*s*) much more, then, if a distinct claim is made to any such useless method must the patent be void. If the specification claims a number of methods, and any one of them turns out to be bad, the whole patent will be void. (*t*)

(*m*) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1894) 11 R. P. C. 638; 12 R. P. C. 232, 256; see also p. 164 *ante*.

(*n*) See *Adamant Stone and Paving Co. v. Corporation of Liverpool*, (1896) 14 R. P. C. 11.

(*o*) *Neilson v. Harford*, (1871) 1 W. P. C. 355; *Arnold v. Bradbury*, (1871) L. R. 6 Ch. 706.

(*p*) *Arnold v. Bradbury*, (1871) L.

R. 6 Ch. 706; *Wyeth v. Stone*, 1 Story, 273.

(*q*) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 58.

(*r*) *Chadburn v. Meehan*, (1895) 12 R. P. C. 120, 134.

(*s*) p. 208 *ante*.

(*t*) *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.

Claims.

II. *The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.*

Purely speculative claims may prove fatal.

The law will allow a patentee to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but it will not allow him to claim that which is the mere subject of his speculation and imagination, or of his endeavouring to possess more than he is entitled to; and while the Court is bound to give as far as possible the fullest effect to an invention, it is also equally bound to oppose endeavours to make a patent embrace matters that were never in the head of the inventor. (u) Moreover, a claim which is general may not entitle a man to improvements of which he was ignorant at the date of the patent. (v)

In the language of *Pollock*, C.B., the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves especially to one good thing, and a jury will always take care that if that be the real invention no man under colour of improvement shall be allowed to interfere with that which is the offspring of their genius. (x)

Pollock, C.B., also, in a case where a patentee in his specification had described the use of atmospheric air in a particular way to charge a certain portion of his machinery, and stated: "If any gases or elastic media, other than atmospheric air, are used, with which to charge the case, I claim the sole right to do so," directed a jury that the patentee had, in point of law, no right to make such a claim, and that the law would not permit a patentee to claim more than he had invented. The learned Baron told the jury that a statement in the specification to the effect that the patentee proposed to construct a certain wheel of every variety of configuration, so long as it was constructed with a channel in the interior, would not do. It appeared that the defendant had used a wheel with *curved* hollow arms, and the patentee desired to treat this as an infringement of his wheel, in which the arms were not curved, but, as the curving of the arms was a further invention and improvement, the patentee's claim failed. To hold that it was good would be to reward a man who had rashly and ignorantly taken out a patent on a subject he

(u) *Tetley v. Easton*, (1852) Macr. P. C. 48, 76.

(v) p. 353 *post.*

(x) *Crossley v. Potter*, (1853) Macr. P. C. 256.

had not appreciated. (y) His Lordship's direction was, probably, unsound. (z)

If the patentee claims to perform an operation by the use of one or more of several substances, some of which will not answer, and the claim is so ambiguous that it may be read as including those which will not do as well as those which will do, the patent will be void. (a)

The following important cases may be given as illustrating this point (b) :—

Stevens v. Keating, (1847) 2 W. P. C. 181, was an action brought to restrain the infringement of two patents belonging to the plaintiff, one of which related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlsh in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated that "other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth;" and then claimed "the process of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning or calcining the same for the purposes hereinbefore set forth." It was proved at the trial that, though there were certain acids other than sulphuric that would answer, there were other acids that would not answer the purpose of the patentee at all; and *Pollock*, C.B., directed the jury that if the construction was that every acid was claimed, then all acids would not do, and the specification was bad; and if the construction was that some acids were claimed beyond sulphuric acid the patentee did not say whether that was claimed which would do or that which would not do, and to take it, as he in his second specification explained, he said, "I claim all that will succeed." No person can be allowed to take that course, and to say, "Whereas other substances will succeed, I claim all those substances that may succeed." (c) And his Lordship directed a verdict for the

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A claim which is so ambiguous that it may be read as including what will not answer the purpose in view as well as what will, is fatal.

Examples.
Stevens v. Keating.

(y) *Tetley v. Easton*, (1852) Macr. P. C. 48.

(z) See p. 353 *post*.

(a) *Stevens v. Keating*, (1847) 2 W. P. C. 181; *Tetley v. Easton*, (1852) Macr. P. C. 48; *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312; *Ralston v. Smith*, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1857) 2 H. &

N. 84; *Haworth v. Harcastle*, (1834) 1 W. P. C. 480; *Saunders v. Aston*, (1832) 13 B. & Ad. 881; 1 W. P. C. 75 n.; *Kurtz v. Spence*, (1888) 5 R. P. C. 161; *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671; 15 R. P. C. 421.

(b) See also other cases *ibid*.

(c) (1847) 2 W. P. C. 181.

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Hills v. London
Gas Light Co.

defendant on the issue of the sufficiency of the specification, which was upheld by the Court of Exchequer.

In *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409, the plaintiff in his specification claimed the use of "hydrated or precipitated oxide of iron" for the purification of gas. It was proved that some of the hydrated oxides of iron would not effect the purpose the patentee had in view. It was objected on behalf of the defendant that the claim included all hydrated oxides of iron, and was therefore bad. The Court of Exchequer, however, admitted that the language was not accurate, but, in its desire to uphold the patent, decided that the patentee meant to refer to such hydrated oxides as were precipitated.

In *Bailey v. Roberton*, (1878) L. R. 3 App. Cas. 1055, 1078, it was held by the House of Lords that a claim to the use of "the alkaline and earthy sulphites" in a specification under a patent for improvements in preserving animal substances would be bad, on the ground of ambiguity, where it appeared that some of the earthy sulphites are poisonous, and that some of the alkaline sulphites possess properties which render them unsuitable for the purpose the patentee had in view. Such a claim would be too wide and vague, and the specification ought to define more precisely the materials to be used, which, as a matter of fact in the particular case, it did.

In *Booth v. Kennard*, (1856) 2 H. & N. 84; 26 L. J. N. S. Ex. 23, 305, *Booth's* patent for "improvements in the manufacture of gas" was declared to be invalid, on the ground that the claim was a claim, not to any particular mode of manufacturing gas from seeds, but to the manufacture of gas from seeds however carried out.

III. *If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.*

If protection is desired for subordinate parts alone, they must be claimed separately.

It is evident that an invention may consist of any number of different parts—A, B, C, and D—of which A may be a totally new thing, and B may be a combination of things which in themselves are perfectly old, but which have never been combined in that particular way before, and C and D may be old parts. Now, in such a case, the inventor would in law be entitled to protection, both in respect of the whole invention, consisting of the combination A, B, C, and D, and also in respect of the subordinate inventions A and B; but he would not obtain such protection in respect of the subordinate parts

alone by laying claim to the combination of the four elements. He must, if he desire it, specifically claim protection in respect of the new subordinate integers of the larger invention. (d)

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In considering the above paragraph, the reader must be careful to notice that the integers of the supposed invention are perfectly distinct and separate from the combination A, B, C, D, as a whole. A claim to a combination will no doubt protect the patentee against the use of any of the elements of that combination, if the use of such elements, either alone or together with others, would amount to only a colourable departure from the patentee's specified combination; (e) and very little merit will do to support a claim to a subsidiary part of a great invention. (f)

Clark v. Adie is the leading case which illustrates the fact that a patentee who does not properly claim all he may be entitled to claim thereby loses protection in respect of subordinate parts which he might legitimately have claimed. It is the leading authority for the proposition that the patentee is not protected against the use by others of what he might have claimed, but what he has, upon a fair construction, whether from timidity or any other cause, in fact not claimed. The case may be epitomised from this point of view as follows:—

Patentee is protected only in respect of what he actually claims—not in respect of what he might have claimed.

In *Clark v. Adie*, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315, it was alleged that the defendant had infringed a patent for "improvements in apparatus for clipping or shearing horses," granted to one *Grayson*, but at the date of the action the property of the plaintiff, *Clark*, by purchase. The specification described the instrument or clipper by reference to drawings, and showed a fluted guide or comb-plate, with a straight edge, like a musical-box comb, the points of the teeth being tapered so as to be raised a little above the surface. A thin plate of steel, with V-shaped cutters, traversed to and fro over the comb, being guided by steerers working in rectangular slots, cut parallel to its edge. The drawings showed the cutter-bar in plan and section, the latter view representing it as somewhat arched or convex in the middle, so as to take its bearing only at the edges. The specification, however, did not allude by any words of description to this peculiarity of form. The two handles were

Clark v. Adie is the leading case on this point.

(d) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 320, 321; *Cropper v. Smith*, (1884) 1 R. P. C. 87.

App. Cas. 320; pp. 245-246 *ante*.

(f) *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

(e) *Clark v. Adie*, (1873) L. R. 2

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pivoted on a strong stem, set in a square hole in the comb-plate, and secured by a nut on the screwed end of the stud. One of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions, to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the comb could be regulated by means of nuts and washers. By the removal of the nuts on the stems and stud, the instrument could be readily taken to pieces.

The claim was in the following terms : "The general arrangement, construction, and combination of parts, whereby I am enabled to construct an apparatus for clipping and shearing horses and other animals, in such a manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animals : and whereby the shearing or clipping may be regulated to the exact extent required, without shaving the hair too closely, and, without injuring the animal, leaving a smooth surface without marks, the apparatus being capable of being taken to pieces and adjusted for sharpening or renewing the cutter-bar, or for other purposes, all substantially as herein specified and shown."

It appeared that the plaintiff had bought *Grayson's* patent in order to free himself from any interference in respect of a horse-clipper, made by himself but not patented, which incorporated the arched cutter-bar, the movement thereof parallel to the line of the comb, and the substitution of strong stems secured by nuts and washers instead of being screwed into the comb-plate, but which did not resemble *Grayson's* instrument in other respects.

The alleged infringement consisted in the making of horse-clippers in exact imitation of those brought out by *Clark*, as above stated, and it was contended that there had been infringement of *Grayson's* patent in four particulars—viz., (1) In the use of fixed stems which could not be shaken loose; (2) In applying nuts and washers to the tops of the fixed stems above the cutting plate so as to adjust the friction; (3) In forming the cutter-plate in an arch and thereby rendering it elastic; (4) In the mode of communicating motion to the upper or cutting plate, so as to bring it to the true line of cutting. It was argued that, although the defendant had not copied the whole of the apparatus patented, yet he had taken so much of that which was the pith and marrow of it as to make up a subordinate integral part of the invention, and that by taking such subordinate integer, which was in itself matter of protection, he had infringed the patent.

Bacon, V.C., decided the case in favour of the plaintiff, but

the Court of Appeal and the House of Lords both decided that the defendant, not having taken anything claimed by the patent, had committed no infringement.

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Lord *Cairns*, L.C., pointed out that the subordinate integer which was said to be protected, and which the respondent was alleged to have taken, was described as consisting of four different matters—viz., in the first place, what was called the fixed stems, springing from the under or comb-plate, which could not be shaken loose; in the second place, the nuts and washers applied to the top of those fixed stems, above the cutting plate, so as to adjust the friction; in the third place, the shape of the cutter-plate made in an arch, by which the bearing of the cutter-plate upon the comb-plate was better adjusted; and fourthly, the mode of communicating the motion to the upper or cutting plate, so as to bring it to the true line of cutting. In reference to the third of these items, his Lordship said that he had read with great care the specification of *Grayson*, and there was not a word in the letterpress of that specification, from beginning to end, which referred in any shape or form to the arching of the cutter-plate or to the advantage to be derived from that arching; and in answer to a suggestion of the appellant's counsel that the arch form of the cutter-plate was designed in order to bring into play elasticity as produced by the arching, his Lordship pointed out that the cutter-plate was adjusted and fitted to a solid rigid bolt at the back thereof, which restrained any elastic yielding, and stated that he was compelled in the first place to put aside altogether the idea of the advantage of the elasticity of the cutter-plate as an afterthought, which was in no way present to the mind of the patentee. It might be an advantage, but if it was an advantage it was an advantage which subsequent practice and experiment had brought to light, and it was not an advantage which appeared to suggest itself to the mind of the patentee when he made the specification.

In reference to the remaining three items which were alleged to produce the combination, his Lordship remarked that each of them was not, in itself, a new invention, but an old step well known in the making of a clipper, and said: "I have read and re-read, with the greatest anxiety, the specification in the present case. I cannot find from beginning to end of it any sentence or any number of sentences as to which, by any reasonable interpretation, you can say that they make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture, a thing to be protected by the patent." The House agreed with the conclusions arrived at by the *Lord Chancellor*, and decided in favour of the respondent.

Claims.

IV. *A claim to something old, when that claim is not made in gross, but only as appendant to something new, will not vitiate the patent.*

Subsidiary
claims to old
things.

A claim which is only subsidiary, even though the thing claimed is old, will not vitiate a patent if it is within the main claim or is only for one of the merits and advantages of the entire construction which the patentee has described, and does not enlarge the monopoly; but if the alleged subsidiary claim really enlarges the main claim and is for something old, then it will be fatal. (*g*)

A claim which is subsidiary to the main claim may be really surplusage as being consequentially protected by the main claim. The patentee should avoid the objection of surplusage in drafting the specification, as he may thereby place himself in an unnecessary position of difficulty should he be called upon to support his patent in a court of law. This will appear from the judgment of Lord *Hatherley* in *British Dynamite Co. v. Krebs* (*h*) quoted below. (*i*)

Leading cases.

The above stated principles, which are often of vital importance, are illustrated by the leading cases given in epitome as follows:—

British Dynamite Co. v. Krebs.

In *The British Dynamite Co. v. Krebs*, (1875) G. P. C. 88; 13 R. P. C. 190, it was sought to upset a patent for "improvements in explosive compounds, and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into a powder which I call *dynamite* or *Nobel's safety powder*. By this absorption of the nitro-glycerine in some porous substances it acquires the property of being in a higher degree insensible to shocks, and it can also be burned over fire without

(*g*) *Neilson v. Betts*, (1871) L. R. 5 H. L. 21; 40 L. J. Ch. 317; *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 286; 6 Ch. D. 412; *British Dynamite Co. v. Krebs*, (1875) G. P. C. 94; 13 R. P. C. 190; *Ehrlich v. Iblee*, (1888) 5 R. P. C. 437; *Parker v. Satchwell*, (1901) 18 R. P. C. 299.

(*h*) 13 R. P. C. 196; see also *Pneu-*

matic Tyro Co. v. Casswell, (1896) 13 R. P. C. 180.

(*i*) p. 262 *post*; see also *Thompson v. American Braided Wire Co.*, (1889) 6 R. P. C. 528; *Fawcett v. Homan*, (1896) 13 R. P. C. 398, in judgment of *Rigby, L.J.*, p. 410; *Van Berkel v. Simpson*, (1906) 23 R. P. C. 237.

exploding. The aforesaid safety powder or dynamite is exploded: *First*, when under close or resisting confinement, by means of a spark or any mode of ignition used for firing ordinary gunpowder. *Secondly*, without or during confinement by means of a special fulminating cap, containing a strong charge of fulminate, which is adapted to the end of a fuse and is strongly squeezed to the latter for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation. *Thirdly*, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off even when it is only partially confined.

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"*Claim*: I claim, as the invention secured to me by letters patent as aforesaid, the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth."

Fry, J., on trying the case, gave judgment for the plaintiff, with costs, but the Court of Appeal (*Jessel, M.R., James and Thesiger, L.JJ.*) reversed the order and dismissed the action, with costs, on the ground of the insufficiency of the specification and that the claim, in so far as it claimed the modes of firing the dynamite by special ignition set forth, claimed that which was not new. On appeal, however, to the House of Lords, the order of the Court of Appeal was reversed, and the order of *Fry, J.*, was restored, with costs to the appellants, on the ground that the specification was sufficient, and that the patentee did not claim the means of explosion *in gross*, but only as *appendant* to dynamite.

Earl *Cairns, L.C.*, speaking on the question of the extent of the claim, made the following instructive observations (13 R. P. C. 193): "I will assume that the modes of firing by special ignition, or some of them, were known before the date of the patent, and therefore that if the patentee claimed them as independent inventions (inventions, if I may use the expression, *in gross*), his claim would be too large and his patent void. But is that what he here does or means to do? It is to be observed that the mere manufacture of an explosive substance, such as dynamite, would not, *per se*, have constituted an invention, or, at all events, a useful and practical invention, which could be protected by a patent. An explosive substance like dynamite would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . I look upon the means of explosion, even assuming them to be known as applicable to the other substances, to be part and parcel of the invention, which the patentee was bound to give to the public as a complete invention, and I

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understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed, under this patent, to claim them for any other purpose. In other words, he claims, in the first claim, the dynamite, the substance itself; and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the use of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

Lord *Hatherley* upon the same point spoke as follows (13 R. P. C. 196):—

"The patentee having, as I have said, discovered a material which will not go off at a moment's notice, it is necessary to show that it will go off somehow or other. And in order that you may know how it will go off the patentee must tell you how to set it off. If he has discovered it he is bound to tell you the best way of doing it. Mr. *Nobel* accordingly tells you that one mode, amongst other modes, is by a percussion cap. That is a mode which has been used for exploding gunpowder and other things, but which, he said, he found would explode this new material called 'dynamite.' Having described his invention, he says in his claim at the end: 'I claim as the invention secured to me by Letters Patent as aforesaid the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth.' It is a mode of 'special ignition.' He claims the mode of manufacturing safety powder or dynamite and the 'modes of firing the same,' that is the dynamite. The worst that can be said in the way of objection to this is that there is surplusage. The objection of surplusage must be admitted to be one which ought, no doubt, to be very carefully avoided by a patentee. The most that can be said adverse to the patent here is that the patentee might have been quite content to sit still and say: 'Now I have shown you how to make the dynamite. I have shown you what the dynamite is, and I have shown you how to set it off; that is the invention,' without mentioning the firing in the claim. But then, as was well urged by the learned counsel in argument, it cannot be said that this claim deprives any human being, past, present, or to come, of any possible right they might otherwise acquire, because they could not acquire any right in the dynamite without laying themselves open to an

infringement of the letters patent in respect of the use of the dynamite. It is the firing of the dynamite, and only dynamite, in this peculiar mode that is claimed; and you must make use of the patentee's dynamite before you can explode it. He says, 'I am not going to tell you a useless thing. If I did not tell you how to ignite it, you might say that my dynamite is useless, because when it is put in a quarry it will not go off at all, and so I tell you here is my dynamite, and here is my means of igniting it; if you are willing to pay me for it I will hand over to you the full benefit of my invention, first the mode of making the material itself, and then the mode of setting it off.'"

Claims.

In *Plimpton v. Spiller*, (1875) 4 Ch. D. 286; 6 Ch. D. 412, *Plimpton v. Spiller*. it appeared that *Plimpton's* specification for the roller skate stated that the invention related to an improvement in attaching the rollers or runners to the stock or footstand of a skate whereby the rollers or runners were made to turn or cant by the rocking of the stock or footstand so as to assume radii of a circle, and facilitate the performing with ease gyrations or evolutions without taxing unduly the muscles of the foot or ankles. The specification then went on to describe the construction of the skate as a whole, including a description of a mode of attaching the runners and making them reversible, and the two claims were: (1) Applying rollers or runners to the stock or footstand of a skate, as described, so that the said rollers or runners may be cramped or turned, so as to cause the skate to run in a curved line, either to the right or left, by the turning, canting, or tilting of the stock or footstand. (2) The mode of securing the runners and making them reversible as above described. It was held by the Court of Appeal that the want of novelty in the method included in the second claim would not vitiate the patent, as this only amounted to a claim to one of the merits and advantages of the entire construction which the patentee had described, and not in any way to a claim which would enlarge the monopoly secured under the first claim.

In *The United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, one of the questions in issue was whether the claim in the plaintiff's patent, which was in the words, "In an instrument for transmitting electric impulses by sound, a diaphragm or tympan of mica, substantially as set forth," amounted to a claim for the mica diaphragm or tympan in all instruments for transmitting electrical impulses by sound, in which case it would be bad, as being merely a claim to the application of an old thing to a particular purpose, without the use of any ingenuity in that application; or whether it was a claim only to the mica diaphragm or tympan in the particular instrument for transmitting electrical impulses by

United Telephone Co. v. Harrison.

Claims.

sound described in the specification. *Fry, J.*, was of opinion that the claim related only to the mica diaphragm in combination with the rest of the instrument, and that the specification was good in regard to that objection. This ruling was upheld by the Court of Appeal, consisting of *Jessel, M.R., Lindley and Bowen, L.JJ.*

Some subordinate claims are fatal.

It is important to bear in mind that the above statements of the law merely relate to the construction of the specifications in certain particular cases. When there are separate claims for different combinations, the first being for a general combination and the others for combinations of some of the integers which constitute the general combination, it is not right to say that the smaller claims are only to be considered as pointing out what the patentee considers material. On the contrary, when there are more than one separate claim, the first of which is for a general combination, the others may be separate and independent claims for subordinate combinations which will render the patent void if those subordinate parts or combinations are old. (l)

V. *A patent for the production of a new and useful material will not be vitiated by a further claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.*

Claim to a use of a new material may be good though the use in itself is not subject-matter.

Thus, in *Betts v. Neilson*, (m) it was objected (*inter alia*) to *Betts'* patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," that the manufacture of capsules from the patented material was not the subject-matter of a patent. (n)

The specification claimed, *First*: "The manufacture of the new material, lead combined with tin on one or both of its surfaces, by rolling or mechanical pressure, as herein described. *Secondly*: The manufacture of capsules of the new material of lead and tin combined by mechanical pressure as herein described."

Wood, V.C., the Lords Justices, Lord Chancellor *Chelmsford*, and the House of Lords, all separately held that the objection to the validity of the patent on the ground of the second claim

(l) *Cropper v. Smith*, (1884) 1 R. P. C. 88, 90, 91; *Murchland v. Nicholson*, (1893) 10 R. P. C. 417; *Electric Construction Co. v. Imperial Tramways*

Co., (1900) 17 R. P. C. 537, 549, 552.

(m) (1868) L. R. 3 Ch. 429; 5 H. L. 1.

(n) See p. 80 *ante*.

was invalid, and awarded the plaintiff damages in respect of infringements committed by the defendant. Construction.

Lord *Westbury*, addressing the House of Lords, said :—

“The last objection to the patent is one of a very material character ; it is this : that after having described the process and the material, and claiming the material as the result of the process, so that the material is not claimed independently of the process, nor the process independently of the product, the specification concludes with a claim of the manufacture of capsules out of the material. But the manufacture of capsules out of the material would be one purpose only to which the material could be applied ; and if a claim to the material can be substantiated by the patent the specification of a particular use of it, comprehended in the general uses claimed, cannot for a moment be accepted as a ground for vitiating the patent.”

CONSTRUCTION OF THE SPECIFICATIONS.

During the course of proceedings in which the validity of a patent is contested, it usually becomes necessary to decide, first, whether or not the specification is sufficiently explicit in its directions to enable a person to whom it is addressed to perceive what is the exact invention covered by the patent, and how to carry that invention into practical-operation ; and, secondly, what is the true construction to be put on the language of the specification when its meaning is dubious, and more than one interpretation is possible. The determination of the first question, which is one of fact, is for the jury, if there be one, otherwise for the Judge acting as a jury. (o) The determination of the second question is one of law, and is in all cases for the Court alone. (p) The Judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result. (q)

Construction of the specifications is usually necessary in legal proceedings.

Sufficiency is a question for the jury : construction is for the Court.

(o) *Walton v. Bateman*, (1812) 1 W. P. C. 621 ; *Beard v. Egerton*, (1846) 8 C. B. 165 ; 19 L. J. (N. S.) C. P. 36 ; *Hill v. Thompson*, (1817) 1 Web. P. C. 237 ; *Bickford v. Skewes*, (1837) 1 Q. B. 938 ; *Neilson v. Harford*, (1841) 1 W. P. C. 370 ; *Wallington v. Dale*, (1852) 7 Exch. 888 ; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358 ; L. R. 5 Ch. App. Cas. 36.

(p) *Hill v. Evans*, (1862) 31 L. J. Ch.

460 ; *Neilson v. Harford*, (1841) 1 W. P. C. 370 ; *British Dynamite Co. v. Krebs*, (1875) G. P. C. 91 ; 13 R. P. C. 190 ; *R. v. Wheeler*, (1850) 2 B. & Ald. 315 ; *Seed v. Higgins*, (1860) 8 H. L. Cas. 561 ; *Bovill v. Pimm*, (1856) 11 Ex. 740.

(q) Per *Cresswell, J.*, *Beard v. Egerton*, (1849) 19 L. J. (N. S.) C. P. 38 ; see also *Neilson v. Harford*, (1841) 1 W. P. C. 370.

Construction.

Test of
sufficiency.

The "ordinary workman" test (*r*) is the proper one to employ for the purpose of settling the question of sufficiency, as is manifest from the following words of Lord *Lindley*, then Lord Justice *Lindley*, taken from the judgment of the Court in *Edison and Sir v Electric Lighting Co. v. Woodhouse.*(*s*) "If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court, and not for a workman, to construe the specification; but, if a workman says it is sufficient guide to him, and the Court believes him, the Court must hold, as regards clearness of description, the specification is, in point of law, sufficient." (*t*)

When the language used in a claiming clause, either directly or by reference to the body of the specification, is dubious, the point of construction should, logically, be determined before the other issues raised in the action are gone into; but for obvious reasons this course is rarely practicable under the present practice. (*u*)

Interpretation
of language
used in speci-
fications.

The Court in construing specifications gives to their language the ordinary meaning, unless there are circumstances to show that any word or expression is a term of art, and would be understood by the person to whom the specification may be supposed to be addressed in a particular sense. It is a well-established rule that the Court will receive and consider evidence as to the exact sense in which the patentee intended a word or expression to be understood, and will give full effect to such meaning in the construction of the specification. (*x*)

The Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate. (*y*)

In construing specifications it is often important to remember that human language is, after all, an imperfect instrument for the embodiment of human thought. Both the

(*r*) See p. 217 *ante*.(*s*) (1887) 4 R. P. C. 108.(*t*) See also per Halsbury, L.C., *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.*, (1902) 20 R. P. C. 95, 96.(*u*) *British Motor Syndicate v. J. E. H. Andrews*, (1899) 16 R. P. C. 586, 587; 18 R. P. C. 93.(*x*) *British Dynamite Co. v. Krebs*, (1875) G. P. C. 91; 13 R. P. C. 190;*Clark v. Adie*, (1873) L. R. 2 App. Cas. 436; *Neilson v. Harford*, (1811) 1 W. P. C. 313; *Elliott v. Turner*, (1845) 2 C. B. 446; *Walton v. Potter*, (1841) 1 W. P. C. 595; *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 581.(*y*) Per Pollock, B., *Kaye v. Chubb*, (1887) 4 R. P. C. 299.

context and the subject-matter dealt with must often modify and expound the meaning of a word—*e.g.*, it would be an intelligible distinction to say that Mont Blanc was a flat mountain compared with Monte Rosa, which is a sharp peak, though Mont Blanc is not flat and Monte Rosa is not sharp, in the sense of the word sharp, when a knife or razor is spoken of. (z)

Construc-
tion.

It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes requiring the aid of the light derived from surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words in technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described, are all matters of fact, upon which evidence may be given, and contradictory testimony may be adduced, between which it is for a jury to decide. (a)

Technical
terms.

The Court ought to construe the specification like all written instruments, taking the words, and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification which is addressed, not to the world at large, but to a particular class—for instance, skilled mechanics, possessing a certain amount of knowledge—it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanics, and to see what the words of the specification mean when applied to such a subject as skilled mechanics would know, and then to say what the words of the specification mean when applied to such a subject-matter. (b)

The patent for the preparation of Lanolin (c) affords a good instance of the application of this principle. In that case one of the alternative processes for the further purification of raw Lanolin described was dissolution by a *solvent*, and amongst other solvents specifically mentioned was methylated spirit. The defendants contended that this was not a useful solvent,

(z) See per Halsbury, L.C., Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd., (1904) 21 R. P. C. 494.

(a) Hill v. Evans, (1862) 31 L. J. Ch. 460.

(b) Per Lord Blackburn, Clark v. Adie, (1873) L. R. 2 App. Cas. 436; see

also Betts v. Menzies, (1862) 10 H. L. Cas. 117; Simpson v. Holliday, (1866) 13 W. R. 577; L. R. 1 H. L. 315; Edison v. Holland, (1888) 5 R. P. C. 474.

(c) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1894) 11 R. P. C. 93, 261.

Construc-
tion.

as, though it might dissolve impurities and so be useful as a purifier, it did not dissolve except with difficulty the pure cholesterine fats, and they said that according to the strict wording of the specification a person would gather that all the raw Lanolin was to be dissolved. *Romer, J.*, decided at the trial that, upon the evidence adduced as to the scientific meaning of the word *solvent* and upon the true construction of the specification, the solvent referred to was to be used as a purifier according to its known properties, and no one would imagine that in every case it was essential to dissolve the whole of the raw Lanolin, and the Judge being satisfied that it could be used usefully as a purifier, though not so efficaciously as some of the other solvents specifically mentioned, the objection against the validity of the patent therefore failed. The patent was also upheld by the Court of Appeal.

Even in cases where it is sought to establish that an invention described in a specification is not new by reason of the existence of a prior specification, which, it is alleged, describes the same invention, the Court will not, without evidence, assume that words or terms of art, which are common to the two specifications, bear in each the same meaning, but will receive and consider evidence on the point. (*d*)

Variations in
meaning.

It is impossible to predict, of two documents framed at different periods, that the terms of art common to the two had the same signification, and indicated the same identical thing at the date of each respectively, for terms of art are liable to constant change of meaning with the progress of science and invention; and the cases establish that the identity of signification between two written documents containing the same description must belong to the province of evidence, and not to the province of construction. (*e*)

Spirit in which
specifications
should be
construed.

The former practice of construing specifications very strictly against the patentee and in favour of the Crown, which was indulged in by Judges who had not freed themselves from the general prejudice against monopolies of all kinds and did not accept the view that patents for useful inventions are to be encouraged on the ground of public policy, drew from Lord

(*d*) *Thomas v. Foxwell*, (1858) 5 Jur. N. S. 37; *Robertson v. French*, (1803) 4 East, 135, 136; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117, 152; *Hill v. Evans*, (1862) 6 L. T. N. S. 70; *Neilson v. Harford*, (1841) 8 M. & W. 806; 1 W. P. C. 331; *Hills v. The London*

Gas Light Co., (1857) 5 H. & N. 312; *Jupe v. Pratt*, (1837) 1 W. P. C. 144; *Walton v. Potter*, (1841) 1 W. P. C. 585; *Steiner v. Heald*, 6 Exch. 607.
(*e*) *Betts v. Menzies*, (1862) 10 H. L. Cas. 152.

Tenterden, C.J., (*f*) the remark: "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them;" and from *Barry, L.J.*, (*g*) the comment following: "I would wish to have made some observations upon the propositions of law and the authorities which have been so strongly pressed upon us, but which, in my opinion, seem to indicate, on the part of the source from which they emanate—I do not mean counsel at the bar, I mean the cases that were cited—a seeking for technical reasons for defeating the protection that a man is entitled to for the results of his industry, his skill, and his talent, rather than to promote any interest of the public. It seems to me that we hear a great deal too much about the danger of monopoly, and allowing the public to be deprived of the benefit of inventions. It seems to me that we ought rather to endeavour to give the public the benefit of an invention by protecting the inventor when he has invented something good."

Construc-
tion.

It is now a rule of construction accepted by the Courts that nothing is to be intended either in favour of a specification or against it, but that it is to be dealt with just as it appears, and a true and right and fair construction is to be put upon every allegation and every fact connected with it, such construction being neither a benign nor a strict one. (*h*)

Nothing is to be intended either in favour of a specification or against it.

It may at one time be the interest of the patentee to endeavour to induce the Court to put a wide construction on the specification, so that it may be held to include and claim a particular thing, which an alleged infringer uses, and at another time it may be to the advantage of the patentee to obtain a narrow construction, so that the specification may be held not to include something which is old. (*i*) Whether it is for the interest of one side or the other, it is the duty of the Court to fairly construe the specification, neither favouring the one side nor the other: neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent, if

(*f*) *Huddart v. Grimshaw*, (1803) 2 B. & Ald. 377.

(*g*) *Dowling v. Billington*, (1890) 7 R. P. C. 203.

(*h*) *Stevens v. Keating*, (1847) 2 W. P. C. 187; *Russell v. Cowley*, (1832) 1 W. P. C. 465; 1 Cr. M. & R. 864; *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 581; *Young v. Rosenthal*, (1884) 1 R. P. C. 33; *Westinghouse v. The Lancashire*

and *Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229.

(*i*) *Stevens v. Keating*, (1847) 2 W. P. C. 194; *Downes v. Falcon Works*, (1886) 3 R. P. C. 70; *Kaye v. Chubb*, (1887) 4 R. P. C. 289; *Hutchinson v. Patullo*, (1887) 4 R. P. C. 329; *Gosnell v. Bishop*, (1888) 5 R. P. C. 151, 158; *Ellington v. Clark*, (1888) 5 R. P. C. 319, 327.

Construc-
tion.

it is said that the patent is void, nor putting an unfair gloss or construction upon it in order to extend the patent, and make it take in something which might be thought to be an unhandsome taking of the fruits of his invention from the patentee, if it is not really an infringement of the patent. (*k*) The Courts endeavour to hold a fair hand between the patentee and the public, being willing to grant to the patentee on his part the reward of a valuable patent, but taking care to secure to the public, on the other hand, the benefit of the provision that the patentee must clearly define both the invention and the method of performing it. (*l*)

Construction
must be logi-
cal, fair, and
impartial.

The construction of the specification must be logical, fair, and impartial. It is proper for the Courts, seeing that patents for a limited period operate as an encouragement to the production of useful inventions, of which the public get the benefit after the monopoly is expired, to endeavour, if it can fairly and honestly be done, to support the patent, and to adopt a construction of the specification which will give it validity when it can fairly be interpreted so as to achieve this result. (*m*)

Doctrine that
patentee would
not intend to
claim any-
thing which
would render
the patent
void.

The adoption of such a construction, though it supports the validity of the patent, not unfrequently tells against the plaintiff on the question of infringement. (*n*)

It is a proper assumption to make that a patentee would not be so absurd as to claim anything which would render his grant void; for instance, anything which he knew, or which he was aware everybody else knew, to be old; and the Court will avoid such an absurdity if by any legitimate construction of the words used it can do so. (*o*)

Thus in *Neilson v. Harford* (*p*) on a motion being made to the Court of Exchequer to enter a verdict for the plaintiff on the issue of sufficiency of the specification, the question arose as to the proper construction to put on the statement that "the shape of the receptacle is immaterial to the effect, and

(*k*) Per Lord Blackburn, *Dudgeon v. Thompson*, (1877) L. R. 3 App. Cas. 53; see remarks of Tindal, C.J., *Haworth v. Harcastle*, (1834) 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

(*l*) *Neilson v. Harford*, (1841) 1 W. P. C. 310.

(*m*) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 612; 46 L. J. Ch. 185; *Plimpton v. Spiller*, (1876) L. R. 6 Ch. D. 422; *Russell v. Cowley*, (1832) 1 Cr. M. & R. 864; 1 W. P. C.

460; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 297, 307; *Morris v. Young*, (1895) 12 R. P. C. 463.

(*n*) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671.

(*o*) *Clark v. Adie*, (1873) L. R. 3 Ch. D. 142; *Electric Construction Co. v. Imperial Tramways Co.*, (1900) 17 R. P. C. 547.

(*p*) (1841) 1 W. P. C. 331.

may be adapted to the local circumstances." The invention consisted in the application of hot air to the blast furnace, and the receptacle above referred to was the chamber in which the air was to be heated before being passed into the furnace. The jury in the Court below had found that the shape and form was material to the effect—*i.e.*, to the extent of beneficial effect—produced, not to producing some effect, for some beneficial result would be produced from any shape, but as to producing the extent of beneficial effect the form and shape was material. If the proper construction of the patentee's statement was that the shape of the receptacle was immaterial to the degree of effect in heating the blast, in the face of the finding of the jury, the specification would be bad as containing a false statement in a material circumstance, of such a nature that, if literally acted upon by a competent workman, it would mislead him and cause the experiments to fail. *Parke, B.*, who tried the case in the Court below, was at first of opinion that this was the proper construction, but in the Court of Exchequer he concurred in the opinion of the other Judges, that from the context of the specification, taken as a whole, the word "effect" might reasonably be construed to mean "beneficial effect," and that such meaning ought to be adopted, as it would support the patent. This latter being the proper construction, and the jury having found as a matter of fact that any shape in which the air-vessel could reasonably be expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery, the Court was of opinion that the verdict ought to be entered for the plaintiff on the issue of sufficiency, and consequently the patent was upheld on this point.

Again, in *Oxley v. Holden* (*q*) the question was as to the true meaning in the specification of the words, "I claim the metal fittings and the mode of applying the same described herein as the second part of my invention." If these words meant that the patentee claimed separately the metal fittings themselves and the mode of applying them, the evidence showed that the metal fittings had been anticipated and published; but if the true construction was that the claim was for the metal fittings and the mode of applying them, as one part of the invention, then the patent would be good as regarded novelty. The Court of Common Pleas thought that from the context of the specification the patentee intended

Construc-
tion.

(*q*) (1860) S C. B. N. S. 666; 30 L. J. C. P. 68.

Construc-
tion.

Limit to doc-
trine of con-
struction
according to
patentee's
intention.

the latter construction, and he must have intended the patent to be valid. This construction was the more probable, and to support the first construction it would have been necessary to assume on the part of the patentee extreme ignorance in respect of the metal fittings, or extreme confusion in describing particular metal fittings.

The doctrine that the patentee intends his patent to be a good one must not be pushed too far in construing the specification. In the above case what the patentee was held to have intended turned out to be favourable to the validity of the patent, and the Court took into consideration the fact that he must have intended it to be valid, though that did not alone decide the Judges in adopting the construction they did. Independently of this fact the construction adopted was the more probable. The specification should be construed rather by trying to see what it says than by what the draughtsman meant, for frequently the draughtsman's object is to be as vague as possible without endangering the patent. (r) What is put in the form of a claiming clause may in reality only be the statement of a method of carrying out the invention and not a claim at all. When this is so, the patentee will be protected against his own folly in not putting the description into the body of the specification instead of in the form of a claiming clause. (s)

Thus the argument of absurdity cannot be used in favour of the patentee if the wording of the specification is perfectly clear. (t)

It will not do to argue that a great part of that which is covered by the patent is old and therefore bad, but some little part is new and therefore good, and that the Court ought consequently to confine the patent to that which is good. (u) The utmost extent to which the doctrine can be pushed in favour of the patentee is the conclusion that when two or more constructions are equally tenable the Court will adopt the one which will give validity to the patent, in preference to all others. (v)

Court is not
astute to find
flaws.

The Court will construe the specification so as to support

(r) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 320.

(s) *Per Kekewich, J., Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 164, 181.

(t) *Cropper v. Smith*, (1881) 1 R. P. C. 90; *Clark v. Adie*, (1873) L. R. 2

App. Cas. 423, 437.

(u) *Clark v. Adie*, (1873) L. R. 3 Ch. D. 142.

(v) *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 307; *Needham v. Johnson*, (1881) 1 R. P. C. 58; *Vorwerk v. Evans*, (1890) 7 R. P. C. 167, 265.

the patent, if it can be fairly done, (y) and will not be astute to find flaws in small matters in a specification with a view to overthrow it. (z) Where any expression is ambiguous, the Court will endeavour to give effect to the intentions of the patentee. (a)

Construc-
tion.

In *Palmer v. Wagstaffe* (b) the plaintiff obtained an injunction against the defendant, restraining the infringement of a patent for "improvements in the manufacture of candles." The second claim was, "the mode of manufacturing candles by the application of two or more plaited wicks as herein described." The evidence of infringement was the production of a candle purchased by the plaintiff at the defendant's manufactory which was identical with those made by the plaintiff according to his process. It was not proved, however, that the defendant's candle had been made according to the patented process, and therefore, in order to support the verdict in the Court below, it became necessary for him to contend that his patent was for the candle, and not merely the process of producing it. The Court of Exchequer, however, made absolute a rule *nisi* to enter a verdict for the defendant, on the ground that the patent was for the method and not the candle, and consequently infringement had not been proved. *Pollock, C.B.*, and *Parke, B.*, both agreed that a specification should be construed as the patentee intended, and that, if any expressions were ambiguous, the Court should give effect to the intention; but the Court must not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.

It is sometimes contended that Judges should put a benevolent construction on the specification, so as to support the patent for the encouragement of inventors; but the true rule of construction is that the language of the specification should not be subjected either to a benign interpretation or to a strict one, (c) but should be construed like all written instruments

Doctrine of
benevolent
construction.

(y) p. 270 *ante*; *Russell v. Cowley*, (1832) 1 W. P. C. 457; 1 Cr. M. & R. 861.

(z) *Otto v. Linford*, (1881) 46 L. T. N. S. 35, 39; *Plimpton v. Spiller*, (1876) L. R. 6 Ch. D. 422.

(a) *Russell v. Cowley*, (1832) 1 W. P. C. 470; *Palmer v. Wagstaffe*, (1854) 9 Exch. 494, 501. The above paragraph was referred to with approval by *Kay, L.J.*, in *Edison-Bell Phono-*

graph Corporation v. Smith, (1894) 11 R. P. C. 400, and the principles therein involved were applied in that case.

(b) (1853) 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

(c) *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Needham v. Johnson*, (1884) 1 R. P. C. 58; see p. 104; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 307.

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impartially according to its true meaning, (*d*) unless the language is ambiguous, (*e*) the Courts then adopting a construction which will support the patent in preference to one which will not, where this can fairly and honestly be done. (*f*)

In *Boulton v. Bull* (*g*) it was attempted, in the Court of Common Pleas, to upset a patent, on the ground that a certain Act of Parliament, by which the original period of the duration of the monopoly was extended, purported to deal with a different kind of invention to that comprised by the patent. The Court was equally divided, so no judgment was given. But *Eyre*, C.J., was of opinion that the patent could be supported, on the ground that—(1) it was not for an abstract principle, but for a practical embodiment of a principle; (2) the Act and specification were referable to the same thing; and, when taken with their correlation, they were perfectly intelligible; and in his desire to reward the patentee he declared that he would, if necessary, resort to the exposition of the word “engine” in the body of the Act to mean a “method,” in order to support the patent, “*ut res magis valeat quam pereat.*” *Pollock*, C.B., in another case, (*h*) said: “I agree that we are to construe the specification ‘*ut res magis valeat quam pereat,*’ but still we are bound to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter, which may very much control the judgment to be given.”

True limits to
the doctrine.

The true limits within which the doctrine of benevolent construction may be applied in favour of the patentee are, it is submitted, clearly defined in the two following extracts from judgments of Sir *George Jessel*, M.R., and the late Lord *Bowen* respectively:—

In *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607, 612, *Jessel*, M.R., said: “I am anxious, as I believe every Judge is, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections

(*d*) *Clark v. Adie*, (1875) L. R. 2 App. Cas. 436; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117; *Simpson v. Holliday*, (1864) 13 W. R. 577; L. R. 1 H. L. 315; *Edison v. Holland*, (1888) 5 R. P. C. 474.

(*e*) *Parkinson v. Simon*, (1895) 12 R. P. C. 406, 407; *Patents Exploita-*

tion, Ltd. v. Siemens Brothers & Co., Ltd., (1904) 21 R. P. C. 549.

(*f*) pp. 269, 270 *ante*.

(*g*) (1795) D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

(*h*) *Thomas v. Foxwell*, (1859) 6 Jur. N. S. 272.

or on mere cavillings with the language of their specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use; but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him, whether or not it was an invention unknown to himself." (i)

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tion.

In *Cropper v. Smith*, (1884) 1 R. P. C. 89, *Bowen*, L.J., stated the duty of the Court in the following terms, which were quoted with approval by *Lindley*, L.J., in the subsequent case of *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson & Co.*, (1894) 11 R. P. C. 271:—

"We were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as *Coke* and *Shepherd's Touchstone*, to the effect that the interpretation of a written document ought to be benevolent or benign. *Verba debent intelligi cum effectu ut res magis valeat quam pereat*. Now that is only a caution against excessive formalism, it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is, as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by

(i) See also *Plimpton v. Spiller*, *Linford*, (1881) 46 L. T. N. S. 39; (1877) L. R. 6 Ch. D. 422; *Otto v. Cropper v. Smith*, (1881) 1 R. P. C. 89.

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their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole document. It is almost always coupled with another maxim, which seems to be nearly the same thing in another shape: *Verba intentioni debent inservire*. You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly can never be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing a document."

If a claim can be read in two ways—one claiming something that has the merit of novelty, and the other claiming something which would show the patentee to be ignorant of all the ordinary appliances used to affect a particular purpose, it is the duty of the Judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction which makes the patent utterly absurd; (*k*) but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were not new at the date of the patent, and were generally thought to be old, the Court is not, therefore, to narrow down the claim so as to exclude the old matters. Such a proceeding would be contrary to the decisions, and would afford a very simple precedent for saying that no patent is to be upset on the grounds of novelty. (*l*) In the words of Lord *Hatherley*, "the Courts will not alter the construction in order to save a patent where the patentee has himself explained his meaning in the claiming clauses." (*m*)

In construing a claim, however, if there is nothing else in the matter, it is the duty of the Judge to adopt that construction which makes sense of the patent instead of that which makes it useless. (*n*) And there is, as there ought to be, a bias between different constructions in favour of the real

(*k*) *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 422; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 98; *Cropper v. Smith*, (1884) 1 R. P. C. 81; *Haworth v. Hardcastle*, (1834) 1 W. P. C. 484; *Needham v. Johnson*, (1884) 1 R. P. C. 58; *Morris v. Young*, (1895) 12 R.

P. C. 463.

(*l*) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 433, 437.

(*m*) *Clark v. Adie*, (1877) 2 App. Cas. 431.

(*n*) Per. *Jessel*, M.R., *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 422.

improvement and genuine invention to adopt that construction which supports an invention. (o) Construc-
tion.

It may be pointed out that the considerations above discussed affect the question of the benevolent construction of the specification, a document prepared by the patentee himself, and that this is a different question to that of the benevolent construction of the grant contained in the actual letters patent, which by its express terms is to be considered in the most beneficial sense for the advantage of the patentee. Benevolent
construction of
the grant.

Where a word is used in a specification in a popular sense, it is not to bear its strict mathematical meaning—*e.g.*, a patentee in his specification referred to a certain comb-plate “being cut with teeth pointed like a comb, and in parallel portions.” It was objected that the teeth, if pointed, could not be parallel, but the House of Lords adopted the view of Lord Cairns, that the patentee explained in the clearest way that he used the word in a popular and not in a mathematical sense, and that the word must be construed in that sense. (p) Word used in
a popular
sense is not
construed
according to
its exact
meaning.

The claiming clauses of the specification are construed with reference to the title, (q) and with reference to the whole of the specification. (r) Claims are
construed
with reference
to the whole
specification,
and after a
consideration
of it.

The claims are not to be read as isolated sentences, but they must be interpreted by a reference to the body of the specification of which they form a part. (s) Consequently, a claim which, isolated, would be bad as being too extensive, may, when explained and narrowed down by a reference to the specification, be perfectly valid. (t) On the other hand, the effect of narrowing down the generality of a claim by the particularity of the descriptive part of the specification may be to invalidate the patent. (u)

It is not right for the Court which has to construe the claim

(o) Per Jessel, M.R., *Otto v. Linford*, (1881) 46 L. T. N. S. 39.

(p) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 426.

(q) *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; *Newton v. Vaucher*, (1851) 6 Exch. 859; 21 L. J. Ex. 305.

(r) *Neilson v. Harford*, (1841) 1 W. P. C. 312, 373; *Lister v. Norton*, (1886) 3 R. P. C. 203; *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 426; *Wegmann v. Corcoran*, (1876) L. R. 13 Ch. D. 65, 77; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Kaye v. Chubb*, (1888) 5 R. P. C. 641; *Leadbitter v. Kitchin*,

(1890) 7 R. P. C. 233; *Parkinson v. Simon*, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403.

(s) *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Parkinson v. Simon*, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403.

(t) *Arnold v. Bradbury*, (1871) L. R. 6 Ch. 706; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Kay v. Marshall*, (1835) 2 W. P. C. 36; *Beard v. Egerton*, (1849) 8 C. B. 165, 215.

(u) See *Corrigall v. Armstrong, Whitworth & Co., Ltd.*, (1905) 22 R. P. C. 268.

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to look first at the claim and then at the full description of the invention; but the proper course is for the Court first to read the description of the invention in the body of the specification, so as to be prepared to understand what the inventor is about to claim, and then determine whether the claim really goes further than what is described. (x)

Thus, in the case of *Newton v. Vaucher* (y) it was material to decide whether the patentee claimed the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether he did not also claim the application of soft metal in the case of stuffing-rods for the purpose of excluding air, water, or other fluid. On reading the title and specification with reference to each other, the Court was convinced that the claim was confined to bearings in cases where there is pressure with motion, and adopted that construction accordingly.

Again, in *Montgomerie v. Paterson*, (z) the patent was for the discovery and preparation of a diastasic mixture and its application to or mixture with a batch of bread or other food, so as with the aid of heat to convert flour into maltose and predigest the food. The claim was "the mode and means and combination of mixtures with the special preparation of malt-extract herein distinguished for manufacturing or making bread and biscuits substantially in the new or improved manner herein described." The defendant contended that this claim was wholly unintelligible, but that, construed in the most favourable sense, it amounted merely to a claim for the combining, or for the mode of combining (1) the described special mixture with (2) certain other described mixtures forming the bulk of the batch; and further, that if this combination involved no difficulty it had no merit, and was therefore not patentable, and if it did involve difficulty the mode of performing the operation was not described sufficiently to enable it to be successfully performed. The Courts, however, held that, looking at the specification as a whole, it could be gathered what the patentee meant—*i.e.*, he did not claim the mere combining of his special mixture (*i.e.*, the separate mixture in which the diastase was produced) with the various

(x) *Arnold v. Bradbury*, (1871) L. R. 6 App. Cas., judgment of Lord Hatherley, L.C., p. 712; *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 389, judgment of Esher, M.R., pp. 395, 396; *Tubes, Ltd.*

v. Perfecta Seamless Steel Tube Co., Ltd., (1900) 17 R. P. C. 588.

(y) (1851) 6 Exch. 859; 21 L. J. Ex. 305.

(z) (1891) 11 R. P. C. 221, 633.

mixtures which he suggested as suitable for the dough forming the rest of the batch. What he did claim was the mode described of preparing the various mixtures forming the dough or bulk of the batch (a mode perfectly well described) and then the combining of those mixtures with his special or separate mixture, the mode of preparing which latter was also well described. The claim so read possessing novelty and utility, the patent was upheld.

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tion.

In *Leonhardt v. Kallé*, (a) the subject-matter of the patent was the production of various colouring-matters fast to alkali by the action of suitable oxidisable substances, and free alkalies upon a certain substance under heat. It was objected that the claim was too general, as it stated that oxidisable substances other than those specifically mentioned could be used, and this would include zinc dust, the action of which on the certain substance was already known, and further, because whilst claiming colouring matters the specification did not indicate the processes necessary to produce particular shades. But *Romer, J.*, who tried the case, held that this objection failed because the claim, read with the body of the specification, was limited to an oxidation by the zinc dust further—*i.e.*, more complete—than that already known; and the patentee having pointed out the limits of colours his process could produce, it was not incumbent on him to attempt the almost impossible task of defining shades of colour. A chemist would have no difficulty in selecting any shade he might require.

In *Erans and Taunton, Ltd. v. Hoskins and Sewell, Ltd.*, (b) the invention was the arrangement of the coiled supporting springs of a wire mattress in an oblique or diagonal position, and in opposite directions from the centre of each end, in such a manner as to direct the tension from all the springs on to the middle portion of the wire-mesh. The defendants did not dispute that the plaintiffs' arrangement would produce the result desired, when the network of the mattress was diagonal, but they contended that with a network of square-pattern made movable on its points of contact the diagonally arranged springs would not direct any strain on the centre, and, inasmuch as the specification stated that forms of network other than the diagonal one shown in the drawings could be used, the claim covered the square form with which the invention was useless. The Court decided that the

(a) (1895) 12 R. P. C. 103.

(b) (1904) 21 R. P. C. 675.

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answer to the argument was that the patentee had not claimed such an unworkable method of carrying his invention into effect; he described an arrangement for a diagonally directed strain to the centre of the bed, and showed in his drawings a proper way of doing it, and when he said that other patterns of linkwork would do, he obviously meant meshes which will carry diagonal strains. The evidence was that there are a very large number of meshes of patterns which will carry diagonal strains, and any engineer would say which mesh would carry diagonal strains and which would not. In the opinion of the Court, therefore, the patentee had not claimed a square mesh as carrying out his invention.

So if the claim is for the use of a whole class of articles, and only one kind will do, but the evidence shows that although the words of the claim do on the face of them claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, then the claim might be construed as being for that part which an ordinary workman would take, and not for that part which an ordinary workman would not take. (c) It is always a question of evidence whether or not the ordinary workman, using only common knowledge, would eliminate the members of the class which would not do. (d) In one case, where it was not discovered till the actual trial of an action upon the patent that one member of a class could not be used with success, the patent was held void. (e)

Distinct effective meaning is, if possible, to be given to each claim.

When there are several claims, a distinct effective meaning must, if possible, be given to each, for the rule is that each part of the specification should be effectively construed, and if several claims mean the same thing they cannot be said to be effective. (f) If, however, it is not possible to give a distinct effective meaning to all the claims, the fact that some are redundant does not invalidate the patent. (g)

Essence of an invention may be protected though the claim does not specifically mention it.

The claims should specifically refer to all that is of the essence of the invention in respect of which the patentee desires to be protected. If, however, some essential feature is not directly mentioned in the claims, though the thing

(c) *Gandy v. Reddaway*, (1885) 2 R. P. C. 52; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107.

(d) *Ibid.*
(e) *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875.

(f) *Parkinson v. Simon*, (1894) 11 R. P. C. 502; *Jordan v. Moore*, (1866)

L. R. 1 C. P. 624; see *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 232, 257; *British Shoe Machinery Co., Ltd. v. Hugh Cloughon, Ltd.*, (1906) 23 R. P. C. 321.

(g) *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1892) 9 R. P. C. 55.

described necessarily possesses that essential feature, the claim is sufficient and the use of the essential feature in question would be an infringement. (h) Thus, in *Tweeddale v. Ashworth*, (i) one essential element in the success of the patentee's contrivance for an improved flat and fastener for securing carding cloth thereon, was that the material should be stretched at the same time and by the same operation as completed the machine. Though this was not directly mentioned in the claim, it followed as a consequence from the thing claimed and described. The House of Lords held the patent valid, but that the defendant had not infringed, as he had not taken this essential feature in question. In the subsequent case of *Tweeddale v. Howard*, (j) the Court held that upon the facts the defendant had infringed, because he had adopted by a mere colourable imitation the essential element of the patentee's contrivance. In *Tweeddale v. Ashworth*, (k) Lord Halsbury, L.C., said: "Now, my Lords, looking to the patent itself and the specification, I am unable to give any other construction to the patent here than that which involves the particular thing, with its own particular incidents, which is therein described; and I think that the fallacy of the argument which has been ingeniously suggested to us is this: It is said that there is no claim for the stretching. If by that is meant that there is in the claim no such word as 'stretching,' I agree the word 'stretching' does not occur; but what there is in the claim is this—there is a claim for a thing which is described and illustrated by the description in the letterpress and by the illustration which is given in the drawing, and both the letterpress and the drawing describe a machine, and describe the mode of manufacturing the machine, which, of itself, necessarily involves, as one of the merits of the invention, the power of stretching the material at the same time and by the same operation as completing the machine. That, I believe, is the merit of the invention, and a very material merit of the invention, and it appears to me that, that being one of the important elements forming

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(h) See pp. 340-369 *post*; and *Ashworth v. English Card Clothing Co., Ltd.*, (1903) 20 R. P. C. 797; *Tweeddale v. Ashworth*, (1892) 9 R. P. C. 127; *Proctor v. Bennis*, (1887) 4 R. P. C. 333; *Automatic Weighing Machine Co. v. National Exhibitions Association*, (1891) 8 R. P. C. 350, 351; 9 R. P. C. 41; *Incandescent Gas Light Co.,*

Ld. v. De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 330; *Bunge v. Higginbottom & Co., Ltd.*, (1902) 19 R. P. C. 193; *Hattersley v. Hodgson*, (1905) 21 R. P. C. 517; 23 R. P. C. 192.

(i) (1892) 9 R. P. C. 127.

(j) (1896) 13 R. P. C. 522.

(k) (1892) 9 R. P. C. 127.

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the substance of the invention, it is one which the defendants have in no way invaded."

Again, in *Boyd v. Horrocks*, (l) the House of Lords, upon the same principle, held that, though a claim in question was for an arrangement which attained an old result in a similar way to an alleged anticipation, it was not limited to the particular form of parts specified, but involved the possession of a certain essential and novel feature, by the taking of which the defendant had infringed the patent. (m)

And in *Aktiebolaget Separator v. Dairy Outfit Co.*, (n) the Court of Appeal held in reference to a claim worded as follows: "In centrifugal separators or creamers the combination of the conical plates, c' with the rotating drum or bowl, a substantially as described," the *sine qua non* of the invention as claimed was the rigidity of the conical plates in the form of a solid block. In consequence of this construction the claim was held to have been infringed by a defendant who left out the suitable means described for forming the separator of conical plates into a solid block in the bowl, and used a block solid in itself but with inclined narrow radial passages intersecting it through which the cream and milk flowed, when centrifugal force was applied to the bowl, in the same manner as in the patented mechanism.

Principle of introducing claim by implication is employed with great caution.

It must be remembered that the Courts, in all cases, only apply this principle of introducing, by implication, a claim not expressly contained in a specification with the greatest possible caution. (o)

Frequently claiming clauses end with such words as "*substantially as described*," or "*substantially as and for the purpose hereinbefore described*," which are usually introduced with the object of limitation. Whether such words have any or what effect depends in each case upon the construction of the specification as a whole. (p)

(l) (1892) 9 R. P. C. 77.

(m) *Moore v. Thompson*, (1890) 7 R. P. C. 325; and *Gormally and Jefferey Manufacturing Co. v. North British Rubber Co.*, (1898) 15 R. P. C. 245, are other decisions of the House of Lords involving the application of this principle.

(n) (1898) 15 R. P. C. 327.

(o) *Muirhead v. Commercial Cable Co.*, (1895) 12 R. P. C. 39, 56.

(p) For instances see *Young v. Rosenthal*, (1883) 1 R. P. C. 33; *Westinghouse v. Lancashire and Yorkshire*

Ry. Co., (1884) 1 R. P. C. 241; *Lawrence v. Perry*, (1885) 2 R. P. C. 183; *Easterbrook v. Great Western Ry. Co.*, (1885) 2 R. P. C. 208; *United Telephone Co. v. Bassano*, (1888) 3 R. P. C. 295; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 232; *Parkinson v. Simon*, (1895) 12 R. P. C. 403; *Brooks v. Lamplugh*, (1897) 15 R. P. C. 33; 16 R. P. C. 41; *Marshalls, Ltd. v. Chambers Patents Manufacturing Co., Ltd.*, (1901) 18 R. P. C. 403.

In the following cases the words

The complete specification must be construed without calling in the aid of the provisional to explain or enlarge its meaning; (q) though the Court may look at the provisional specification for the purpose of ascertaining the real object of the invention claimed in the complete. (r)

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of description, by reference to the knowledge of the world existing at the date of the patent; and the Court, for purposes of construction, will not take notice of any subsequently acquired information, but will endeavour to divest itself of such knowledge, and place itself in the position of the person to whom the specification may have been supposed to be addressed at the date of the patent; (s) and generally the prior history of the art and the surrounding circumstances are matters to which the Court gives due weight, when necessary, (t) in arriving at the true construction of the specification and what it includes and excludes. (u)

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Provisional cannot be called in aid to construe complete specification.

Specification is construed with reference to public knowledge at the date of the patent.

printed in italics were interpreted with reference to the rest of the specification in each case:—

As above described.—Plating Co. v. Farquharson, (1879) Griff. 191; Barber v. Grace, (1817) 1 Ex. 122; Hinks v. Safety Lighting Co., (1876) L. R. 4 Ch. D. 607.

As above set forth.—Bray v. Gardner, (1887) 4 R. P. C. 403.

Substantially as set forth.—United Telephone Co. v. Bassano, (1886) 3 R. P. C. 315; Patents Exploitation, Ltd. v. Siemens Brothers & Co., Ltd., (1901) 21 R. P. C. 547.

As described and illustrated.—Fairburn v. Household, (1886) 3 R. P. C. 267.

Other substances.—Crossley v. Beverley, (1829) 9 B. & C. 63; Bickford v. Skewes, (1841) 1 Q. B. 948; 1 W. P. C. 218.

Any mechanical equivalent.—Curtis v. Platt, (1863) L. R. 3 Ch. D. 137 n.

Analogous.—Brown's Patent, Griff. L. O. C. 1.

More or less.—Plating Co. v. Farquharson, (1879-83); Griff. P. C. 187, 190.

Or.—Simpson v. Holliday, (1864) 20 Newton's Lond. Journal (N. S.) 108; Elliot v. Turner, (1845) 2 C. B. 446; 15 L. J. C. P. 49; Hills v. London Gas Light Co., (1860) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409.

Causing.—British Motor Syndicate v. J. E. H. Andrews & Co., (1899) 16 R. P. C. 577; 18 R. P. C. 85.

Float.—In a weaving patent, Lister v. Dix, (1898) 16 R. P. C. 89.

Should.—W. T. Glover & Co. v. American Steel and Wire Co., (1902) 19 R. P. C. 110.

Sharp.—Leeds Forge, Ltd. v. Deighton's Patents, Ltd., (1904) 21 R. P. C. 487.

Plastic.—Patents Exploitation, Ltd. v. Siemens Brothers & Co., Ltd., (1904) 21 R. P. C. 541; Patents Exploitation, Ltd. v. American Electrical Novelty and Manufacturing Co., Ltd., (1905) 22 R. P. C. 316.

(q) Mackelcan v. Rennie, (1862) 13 C. B. N. S. 52.

(r) Parkinson v. Simon, (1894) 11 R. P. C. 502.

(s) Badische Anilin und Soda Fabrik v. Levinstein, (1887) L. R. 12 App. Cas. 710; 14 R. P. C. 449; Edison v. Woodhouse, (1887) 4 R. R. P. 94; Boyd v. Horrocks, (1892) 9 R. P. C. 295; King Brown v. Anglo-American Brush Corporation, (1892) 9 R. P. C. 313, 317, 319, 321; Nobel's Explosives Co. v. Anderson, (1894) 11 R. P. C. 523; Jandus Arc Lamp and Electric Co., Ltd. v. Johnson, (1900) 17 R. P. C. 361, 376; Welsbach Incandescent Gas Light Co. v. New Incandescent (Sunlight Patent) Gas Lighting Co., (1900) 17 R. P. C. 23; see also p. 220 ante.

(t) See pp. 285, 469 post.

(u) See Pneumatic Tyre Co., Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co., (1898) 16 R. P. C. 58, 55.

Construc-
tion.

Thus in *Nobel's Explosives Co. v. Anderson*, (x) the question was whether the term "soluble" nitro-cellulose as used in the specification included a form of nitro-cellulose which the defendant at a later date claimed to use in the manufacture of an explosive as "insoluble" nitro-cellulose. The evidence was conflicting, but it was decided that the term "soluble" nitro-cellulose at the date of the plaintiff's patent did not, according to the meaning attributed to it then by chemists, include the form of nitro-cellulose used by the defendant and described by him as "insoluble," and so there was no infringement.

and with
reference to
what it would
lead the person
to whom it is
addressed to
do.

Moreover, in determining the sufficiency of the specification, the Court will not take cognisance of what the patentee says he intended, but only of what the ordinary intelligent workman, to whom the specification may be supposed to be addressed, says it would lead him to do. (y)

In *Badische Anilin und Soda Fabrik v. Levinstein*, (z) a question arose as to the meaning of the term "*Naphthylamine*," in the specification of the plaintiff's patent for "improvements in the production of colouring matters suitable for dyeing and printing," taken out in 1878. All the amines are capable of existing in three different isomeric modifications. At the date of the action, which was 1883, two of the isomeric naphthylamines known as alpha- and beta-naphthylamine respectively, were generally known. It was also established in evidence that, though these two isomers were known at the date of the patent, the beta-naphthylamine was only known to the highly trained organic chemists acquainted with the latest discoveries of the day, and it had not found its way into use in the arts. The question really was, would the direction to use "*Naphthylamine*," taking into account only the state of public knowledge at the date of the patent, lead the public to use the alpha isomer which would answer, and not the beta isomer which would not answer.

Pearson, J., in the Chancery Division, (a) upheld the patent, but in the Court of Appeal it was declared void on the ground of insufficiency of the specification. *Bowen and Fry, L.JJ.*, thought that the specification being addressed to highly skilled experts—"advanced students of organic chemistry"—the

(x) (1891) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(y) *Kaye v. Chubb*, (1887) 4 R. P. C. 289; see p. 217 *ante*.

(z) (1883) L. R. 24 Ch. D. 156; L.

R. 29 Ch. D. 366; L. R. 12 App. Cas. 710; 2 R. P. C. 73; 4 R. P. C. 419.

(a) L. R. 24 Ch. D. 156; 29 Ch. D. 384, 406, 411.

term "*naphthylamine*" would include both isomers, and therefore be bad for ambiguity. Whilst *Baggallay*, L.J., drew a distinction between different classes of literature, and concluded that in the knowledge of practical men at the date of the patent the term "*naphthylamine*" would mean only the *alpha-naphthylamine*, and this view was finally adopted by the House of Lords, (b) who supported the patent, thus upholding the decision of *Pearson*, J., and reversing that of the Court of Appeal. (c)

Construc-
tion.

The doctrine that the specification is to be construed to mean what an ordinary workman would understand it to mean must not be pushed too far. It is only applicable when there appears to be an ambiguity. If the Court is clear as to the meaning of a specification it will not accept the evidence of a workman, or anybody else, on the point, but will construe it as it is bound to do according to its own view. In the words of *Esher*, M.R., the doctrine is applicable "only when a particular description of work mentioned in the specification, or something to be done, appears to be ambiguous. If you read it without knowledge it appears to be ambiguous, but then it is said: 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literary accuracy there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done. That does not apply to this case, for it is not suggested that any one of the many things which have been added to this instrument by this invention is described in any ambiguous way whatever."

Limit to the
latter canon
of construc-
tion.

In *Clark v. Adie*, (d) the question arose as to how far the Court is justified in looking at antecedent publications for the purpose of construing a specification in dispute, but the House of Lords did not admit the evidence, on the ground that there was no ambiguity in the specification involved, and refused to

Effect of
publications on
construction of
specifications.

(b) L. R. 12 App. Cas. 710.

(d) (1873) L. R. 2 App. Cas. 423,

(c) See opinion of Lord Halsbury, 431.

L.C., L. R. 12 App. Cas. 714.

Construc-
tion.

lay down any general rule, and so far none has been stated. Lord *Cairns*, L.C., however, pointed out that it might be open to the patentee or licensee to refer, in launching his case, to the state of manufacture up to, and at the time, when the patent was granted.

In *Westinghouse v. Lancashire and Yorkshire Railway Co.*, (e) *Denman*, J., held that it was necessary to look at the state of knowledge at the time of the publication of the specification in order to decide whether a particular claim was a claim to a combination, or a claim to several distinct inventions: (f) and in *Couchman v. Greener*, (g) Lord *Esher*, M.R., said that if there be any doubt on the construction of the plaintiff's patent you may look at former patents for the purpose of seeing what is the proper construction of the plaintiff's patent: and in *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.* (h) the Lords Justices expressly construed the specification, for the purpose of fixing the ambit of the claim, by the aid of prior knowledge as disclosed by the prior specifications cited in the particulars of objections, though the construction at which they arrived was not upheld by the House of Lords. On the other hand, *Manisty*, J., in a case between licensor and licensee, in the absence of ambiguity in the licensor's specification or necessity for explanation, refused to admit evidence of the state of public knowledge at the date of the plaintiff's patent. (i) And *Farwell*, J., also in an action between licensor and licensee refused to admit prior specifications in evidence on the question of construction on the ground that the language used was perfectly plain and in nowise of a special nature requiring any skilled explanation, and, further, since the invention, in fact, was not a particular improvement on a prior invention, his lordship rejected the argument that the occurrence of the word "improvement" in the title gave the right to refer to prior specifications as an aid to construction. (k)

Prior public knowledge as disclosed by antecedent specifications, or otherwise, does undoubtedly in one sense affect the question of construction. Thus it is a well-established canon that, if two constructions are possible, the Court will adopt that which will support the patent in preference to one which

(e) (1884) 1 R. P. C. 98, 101.

(f) See also *Ellington v. Clark*, (1888) 5 R. P. C. 325.

(g) (1884) 1 R. P. C. 197, 199.

(h) (1902) 19 R. P. C. 285

(i) *Crosthwaite v. Steel*, (1889) 6 R. P. C. 190.

(k) *Jandus Arc Lamp and Electric Co., Ltd. v. Johnson*, (1900) 17 R. P. C. 370.

will not, (l) and with this object in view the Courts do consider the state of public knowledge at the date of the patent. (m) When, however, the Court construing a claim, as it must do, like any other written instrument, comes to the conclusion that it unequivocally includes what is old, it is not competent to the patentee to call in aid common knowledge as a reason why the Court should limit the claim by excluding that which was old and known. (n)

Construction.
—

The law provides that both the provisional and complete specifications are to be accompanied by explanatory drawings, if required. (o) Such drawings are part of, and are to be read with, the specification to which they are attached, and of which they form a part as much as the letterpress. In the words of *Abbott, C.J.*: (p) "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient." (q)

Drawings in relation to construction.

Drawings are subsidiary to the verbal part of the specification, and not the verbal part to them, and a patentee is not allowed to rely on an ambiguous drawing as being a description of a material part of his invention when there is no reference whatever to such material part in the body of the specification. (r) Moreover, the Act of 1883 only says the specification must be accompanied by drawings, if required, not that it must have them in every case; and it is no objection to a specification that it has no drawings annexed to it, if it sufficiently describes the invention. (s) Nor is it an objection that the drawings are roughly executed, if they are sufficient with the verbal part of the specification to enable a competent person to use the invention. (t)

(l) p. 270 ante.

(m) See pp. 270-272 ante.

(n) See pp. 273, 276 ante; *Kynoch & Co. v. Webb*, (1899) 17 R. P. C. 108; *Electric Construction Co. v. Imperial Tramways Co.*, (1900) 17 R. P. C. 545, 546.

(o) 46 & 47 Vict. c. 51, s. 5, sub-s. 3 and 4.

(p) *Bloxam v. Elsee*, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. T. (O.S.) Q. B. 93; see

also *Milles v. Scarle*, (1893) 10 R. P. C. 106.

(q) See also *Hattersley v. Hodgson*, (1904) 21 R. P. C. 517; 23 R. P. C. 192.

(r) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 315; P. O. R.

(s) Per Rook, J., in *Boulton v. Bull*, (1795) D. P. C. 188, 189.

(t) Per Gibbs, C.J., in *Bovill v. Moore*, (1815) D. P. C. 369; see also *Hinks v. Safety Lighting Co.*, (1876) L. R. 4. Ch. D. 607; 46 L. J. Ch. 185.

Construc-
tion.

On the point as to how far the drawings may aid the description in the specification, the following observations of Lord *Blackburn*, made in reference to a case in which the drawing was ambiguous, are instructive: (u) "The next thing as to which there is said to be an infringement is the plate being made with a curve, so that it is elastic. . . . Now we have to look at *Grayson's* patent in order to see whether that merit is claimed in any part. It is admitted that throughout the whole of the letterpress there is never an allusion to any curved or elastic plate at all; but in one of the figures, No. 2, in profile, there does appear a curved plate, and it is said that the fact that there appears a curved plate upon that figure is enough to indicate that in the description of his invention *Grayson* described that curved plate, and claimed it as part of his invention. Now, I will not stop to inquire how far a mere picture may be a description of an invention and help the letterpress. It may be so to some extent—how far, I do not stop to inquire. But upon that drawing there is represented a curved plate with a curved bolt attached to it in a way which, if it were carried out according to the drawing, would prevent the elasticity. . . . Whatever you may say about the picture being part of the description, and so bringing the curved plate within your invention, when the only drawing which shows a curved plate shows that curved plate in a position in which it would not give elasticity, it seems to me to be quite plain that you cannot say that the advantage resulting from a curved plate was contemplated as being included in the invention at all." (x)

If the drawing is unambiguous and not merely illustrative but is put forward as descriptive of the invention and the claim is for a thing shown and described, the fact that there is no reference in the letterpress to an essential feature which is shown on the drawing will not invalidate the patent on the ground of insufficiency of specification, nor will it exclude the essential feature in question from the claim. (y)

Correction of
errors by other
parts of the
specification.

The specification is to be read as a whole, and if one part corrects what is evidently a slight error contained in another part, it is proper to make the correction, and the presence of such an error will not vitiate the specification; (z) but the

(u) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 338.

(x) See also *Otto v. Linford*, (1881) 46 L. T. N. S. 40.

(y) *Hattersley v. Hodgson*, (1904) 21

R. P. C. 517; 23 R. P. C. 192.

(z) *Totley v. Easton*, (1852) Macr. P. C. 47; *Wegmann v. Corcoran*, (1879) L. R. 13 Ch. D. 65.

provisional and complete specifications cannot be read together in order that the provisional shall supply an omission from the complete specification of a statement which is material to the validity of that document; (a) in other words, the complete specification must itself completely describe the nature of the invention, and in what manner it is to be performed, and if it omits to do either the one or the other, or does the one or the other erroneously, it will be no answer to say that the omission may be supplied by a reference to the provisional.

Construc-
tion.

An error in the drawings or on the face of the specification which a competent workman would at once perceive and correct will form no substantial objection; (b) but the public to whom the specification is addressed, are not to be called upon to exercise any invention in supplying its defects, and unless there is something in the document itself by which the error can be corrected it will be fatal. (c)

It cannot be contended that errors on the face of the specification, or in the drawings, which would at once be made apparent and corrected in following out the directions given, tend in any way to mislead; on the other hand, errors which are discoverable only by experiment and further inquiry are absolutely fatal to the specification, on the ground that the public are not to be misled into performing experiments which must fail. It is, moreover, a fatal defect if the specification contain any erroneous statements, amounting to a false suggestion, even though such error would be at once observed by a workman possessed of ordinary knowledge of the subject. (d)

(a) Mackelcan v. Rennie, (1862) 13 C. B. N. S. 52; p. 186 ante.

(b) Otto v. Linford, (1861) 46 L. T. N. S. 40; Morgan v. Seaward, (1836) 1 W. P. C. 174; Simpson v. Holliday, (1865) 13 W. R. 578; 12 L. T. N. S. 93; Derosne v. Fairie, (1835) 1 W. P. C. 157; Gandy v. Reddaway, (1833) 2 R. P. C. 52; Edison v. Woodhouse, (1887) 4 R. P. C. 107; Hopkinson v. St. James's Electric Light Co., (1892)

10 R. P. C. 46; Miller v. Searle, (1893) 10 R. P. C. 106.

(c) British Dynamite Co. v. Krebs, (1875) G. P. C. 90; 13 R. P. C. 190; Hinks v. Safety Lighting Co., (1876) L. R. 4 Ch. D. 616; United Telephone Co. v. Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; Muntz v. Foster, (1844) 2 W. P. C. 108.

(d) Simpson v. Holliday, (1864) 5 N. R. 340; see also p. 202 ante.

CHAPTER VI.

REVOCAION OF LETTERS PATENT.

THE PETITION.

Effect of grant
of letters
patent.

LETTERS PATENT for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition (*a*) they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity, if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied. (*b*)

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all his Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves. (*c*) As we have seen, the justification for making the grant is the consideration that the patentee is the first to give the public a knowledge of the invention and the means of making practical use of it. (*d*)

It is evident that, if a grant of letters patent for an invention be made, which is in fact void, so long as the grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

Validity may
be questioned
by defendant
in an action for
infringement.

We shall see hereafter that in the event of a patentee bringing an action against any member of the public in respect of any act alleged to be an infringement of his rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which in law render it void, so as to obtain the declaration of the Court on the point, which, if found in the defendant's favour, is a complete answer to the action. (*e*)

(*a*) Vol. II. p. 23.
(*b*) Vol. II. p. 1 *ante*.
(*c*) p. 105 *ante*.

(*d*) p. 105 *ante*.
(*e*) p. 401 *post*.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement. For instance, where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has long provided a means to enable an aggrieved member of the public to obtain the repeal of a void patent. Formerly the procedure was by *scire facias*; but now it consists in the presentation of a petition to the Court, under sec. 26 of the Act of 1883, (*f*) for the revocation of the patent.

The
Petition.

A member of the public may have an interest in obtaining a revocation.

Under the old practice, if two persons had obtained patents for the same invention the Courts would not interfere between them, but left them to determine their rights by *scire facias*, (*g*) for which proceeding the presentation of a petition for revocation has been substituted by the Act of 1883. (*h*)

Petition for revocation substituted for the old procedure by *scire facias*.

Notwithstanding the statutory provision of procedure by petition for revocation of a patent, it may be that the Court would, under special circumstances, entertain and adjudicate upon a request for a declaration of invalidity; (*i*) but there is no precedent which justifies an action for a declaration of invalidity as against a petition for revocation, whether the patent is current or has expired at the date of the proceedings. (*k*)

Declaration of invalidity.

The presentation of a petition for revocation of a patent, as did the prosecution of a *scire facias*, entails expense on the part of the person presenting it, and in order that the public may not be put to the trouble or cost of resisting an unlawful patent, the Crown imposes a condition on the grantee of every letters patent for an invention. This condition is a proviso in the letters patent to the effect that, if at any time during the term for which the patent is granted it be made to appear to the King, his heirs, or successors, or any six or more of his Privy Council, that the grant is contrary to law, or prejudicial, or inconvenient to his Majesty's subjects

Conditions of letters patent.

(*f*) Vol. II. p. 213 *post*.
 (*g*) *Copeland v. Webb*, (1862) 11 W. R. 134; 1 N. R. 119; *Baskett v. Cunningham*, (1762) 2 Eden, 137.
 (*h*) s. 26.
 (*i*) See *Leeds Forge Co., Ltd. v. Clayton & Sons, Ltd.*, (1905) 22 R. P.

C. 325; *Alexander Turnbull & Co., Ltd. v. Cruikshank*, (1905) 22 R. P. C. 521; *North Eastern Marine Engineering Co., Ltd. v. Leeds Forge Co., Ltd.*, (1905) 23 R. P. C. 96.
 (*k*) See *ibid.*

The
Petition.

in general, or that the invention is not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within the realm, the letters patent shall forthwith determine and be void to all intents and purposes. (*l*)

There is no instance in modern times of the determination of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign. (*m*)

Under sec. 3 of the Patents Act, 1902, the Privy Council has power to revoke patents which are not worked in the United Kingdom. This statutory provision was probably necessary to give the Privy Council power to enforce the condition mentioned in the grant in view of sec. 2 of the Statute of Monopolies, which declared that patents should be tried according to the common law and not otherwise. (*o*)

Revocation in part of the United Kingdom is applicable to the whole.

The Act of 1883 defines the term "patent" as meaning letters patent for an invention (*p*) which have effect throughout the United Kingdom and the Isle of Man, (*q*) and therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Revocation may be obtained in England, Scotland, or Ireland.

The words of sec. 26 of the Act of 1883, (*r*) which establish the proceeding by petition are: "Revocation of a patent may be obtained on petition to the Court," and it is submitted that in view of the evident contemplation by the Act of proceedings in England, Scotland, and Ireland, (*s*) the "Court" must be taken to mean in England his Majesty's High Court of Justice in England; (*t*) in Scotland, any Lord Ordinary of the Court of Session; (*u*) and in Ireland, the High Court of Justice in Ireland. (*x*)

Power of the Court of the County Palatine of Lancaster to revoke a patent on petition.

Before the Chancery of Lancaster Act, 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to

(*l*) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

(*m*) See Hindmarch on Patents, p. 432. See also Remb. 98, 223.

(*n*) Universities of Oxford and Cambridge *v.* Richardson d'Ewes, (1802) 652; 6 Ves. 712; judgment of Lord Eldon, L.C., Matthey's Patent, Darcy *v.* Allin, (1602) Noy. R. 183.

(*o*) See *Badische Anilin und Soda Fabrik v. Thompson*, (1904) 21 R. P. C. 473.

(*p*) s. 46. (*q*) s. 16.

(*r*) Vol. II. p. 213 *post*.

(*s*) See s. 26 (4) (a) (b).

(*t*) 46 & 47 Vict. c. 57, s. 117.

(*u*) *Ibid.* s. 111.

(*x*) *Ibid.*

entertain a petition for revocation, but it would appear that it has jurisdiction to do so now. (*y*)

The
Petitioner.

In Scotland, proceedings for revocation of a patent are in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only; and service of all writs and summonses in the action must be made according to the forms and practice existing at the commencement of the Act of 1883. (*z*)

Action of
reduction in
Scotland.

In Ireland, all parties have their remedies under or in respect of a patent as if it had been granted to extend to Ireland only. (*a*)

Revocation in
Ireland.

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to his Majesty's Principal Secretary of State for the War Department, and in respect of which such Secretary of State has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller his opinion that, in the interests of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret. (*b*)

Improvements
in munitions
of war.

THE PETITIONER.

It is to be noticed that sec. 26 sub-s. 4 of the Act of 1883 authorises various persons to present a petition for the revocation of a patent; but, whereas by sec. 109 the proceeding for revocation in Scotland is further limited, the only persons entitled to initiate proceedings for the revocation of a patent in Scotland are the Lord Advocate and persons having an interest, with his concurrence.

Persons who
are entitled to
take proceed-
ings for revo-
cation.

The Act of 1883, by sec. 26 sub-s. 4, (*c*) authorises the following persons to present a petition for the revocation of a patent:—

- (1) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (2) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(*y*) 53 & 54 Vict. c. 23, s. 3; Proctor v. Sutton Lodge Chemical Co., (1888) R. P. C. 184.

(*z*) 46 & 47 Vict. c. 57, s. 109.

(*a*) 46 & 47 Vict. c. 57, s. 110.

(*b*) *Ibid.* s. 44 (9) (1) (3).

(*c*) Vol. II. p. 213 *post.*

The
Petitioner.

- (3) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.
- (4) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.
- (5) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

With regard to (3) the power of presenting a petition for the revocation conferred on "any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims" (*d*) relates only to cases of fraud, and will not be extended to cases of mistake, notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent rights. (*e*) Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it, or any part of it, was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the inventor might be advised to present as a person claiming to be the first and true inventor. (*f*)

If the petitioner is qualified under (3), (4), or (5), he presents his petition as of right; any other person must obtain the fiat of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, authorising the presentation.

When once the petitioner has a *locus standi* to present the petition he can impeach the patent on any lawful ground he

(*d*) *supra*.

(*e*) *In re Avery's Patent*, (1887) L.

R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*f*) *Ibid*.

chooses. Consequently, if he is qualified to present the petition without the fiat on any one ground, he does not need the fiat if he wishes to add other grounds. (g) The
Petitioner.

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General or the Lord Advocate, as the case requires, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi*. (h) But any person who presents a petition under any one of the above clauses is, as above stated, if he proves his right to do so, entitled to impeach the patent on any other lawful ground. (i) Fiat of the
Attorney-
General where
necessary.

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to lodge the following papers at the Law Officers Department Royal Courts of Justice. Procedure to
obtain the fiat
of the Attor-
ney-General.

1. Memorial to the Attorney-General asking for his authority and stating all the circumstances.
2. Statutory declaration on judicature paper verifying the statements in the memorial, and stating that there are no pending proceedings in the United Kingdom wherein the issues proposed to be raised by the petition or particulars of objections could be determined.
3. Two copies on brief paper of the proposed petition, and of the particulars proposed to be delivered with it, and prints of specifications and copies of documents referred to in the memorial, petition, or particulars. (k)
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of course; (l) neither does a petitioner under the present practice obtain the fiat as of right, for the Attorney-General grants or

(g) Morgan's Patent, (1887) 5 R. P. C. 186.

(h) *In re Avery's Patent*, (1887) L. R. 36 Ch. D. 307, 322; 4 R. P. C. 152, 322; see p. 296 *post*.

(i) Morgan's Patent, (1888) 5 R. P. C. 186.

(k) For forms, see Appendix.

(l) 1 W. P. C. 671 *n.*; *R. v. Prosser*, 14 Beav. 306.

The
Petitioner.

refuses it at his discretion; though it is usual for the Attorney-General to exercise his discretion in favour of the petitioner when there is anything like a *prima facie* case. (m)

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties be heard before him.

Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees; (n) so likewise where an action for infringement of the patent had been commenced but abandoned. (o) Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary. (p) Where the applicant was a licensee under the patent notice was directed to be given to the patentee; (q) so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of first instance and the hearing of an appeal; (r) and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month. (s)

Attorney-
General may
grant his fiat
nunc pro tunc.

The Attorney-General has authority to grant the fiat *nunc pro tunc*. Thus in cases where the fiat is necessary to give the petitioner a *locus standi* and the petition comes on for hearing without it, the practice is to grant an adjournment in order to allow the petitioner an opportunity of obtaining the fiat *nunc pro tunc*. (t)

Costs of pro-
ceedings
necessary to
obtain Attor-
ney-General's
fiat.

The Act of 1883 gives the Attorney-General power to award the costs of proceedings before him, (u) including a petition for his fiat, which is heard out; but it does not give him any authority over the costs of a petition presented to him praying

(m) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 533.

(n) *Gaulard and Gibbs' Patent*, Griff. P. C. 320.

(o) *Bothwell's Patent*, Griff. P. C. 320.

(p) *Bell and Coleman's Patent*, Griff. P. C. 320; see also *In re Young's Patent*, P. M. J. 2nd series, vol. vii.

p. 44.

(q) *Martin's Patent*, Griff. P. C. 320.

(r) *Watling's Patent*, Griff. P. C. 320.

(s) *Siddell's Patent*, Griff. P. C. 320.

(t) *Dodge's Patent*, (1895) 12 R. P. C.; *Jameson's Patent*, (1902) 19 R. P. C. 246.

(u) s. 38.

for the grant of his fiat when that petition is subsequently abandoned. (x)

Grounds
for Revo-
cation.

GROUNDS FOR REVOCATION.

A patent may be revoked on any ground on which previous to the Act of 1883 it could have been repealed by *scire facias*. (y) Grounds on which patents are revoked.

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute. (z)

(1) When the King by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.

(2) When the King granteth anything that is grantable upon a false suggestion, the King by his prerogative, *jure regio*, may have a *scire facias* to repeal his own grant.

(3) When the King doth grant anything which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

It was laid down by another well-known authority (a) that the grounds on which a patent could be repealed by *scire facias* were: "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent." (b)

Thus a patent may be revoked on the grounds that the patentee was not the true and first inventor, that the alleged invention is not proper subject-matter, or lacks the essential elements of utility or novelty, or that the specifications are defective, or on any one of those grounds singly. It may also be revoked on the ground that it was obtained in fraud of the rights of the petitioner. (c) Also where the specification directs a certain thing to be done, which turns out to be not only unnecessary, but also disadvantageous and useless, the patent may be revoked on the ground of false suggestion. (d)

(x) Martin's Patent, Griff. P. C. 320. P. C. 124; R. v. Arkwright, (1785) 1 W. P. C. 66.
 (y) 46 & 47 Vict. c. 57, s. 26 (3).
 (z) p. 88. (c) p. 294 ante; p. 300 post.
 (a) Webster on the Law and Practice of Letters Patent for Inventions, p. 32. (d) Owen's Patent, (1899) 17 R. P. C. 68.
 (b) See R. v. Cutler, (1847) Macr.

Grounds
for Revo-
cation.

Parke, B., delivering the judgment of the Court of Exchequer in a case where a patent was upset on the ground of false suggestion, said—

The question is “whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one, which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself, as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of land or tenements from the Crown is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person. (e) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson* and *Brunton v. Hawkes*; for although the statute invalidates a patent for want of novelty, and consequently by force of the statute, the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it.” (f)

Recitals in the
letters patent.

Under the present practice, all letters patent contain a recital to the effect that the patentee has represented to the Crown that he is in possession of an invention of which he is the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief; (g) and a further recital to the effect that the patentee has by and in his complete specification particularly described the nature of his invention. (h)

Distinction
between a
false repre-
sentation re-
cited in the
patent and a
false state-
ment in the
specification.

The distinction between a false representation made by the patentee and recited in the letters patent and a false statement, as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as

(e) *Travell v. Carteret*, 3 Lev. 135; *M. & W.* 544; 1 W. P. C. 196.
Alcock v. Cooke, (1829) 5 Bing. 340. (g) Appendix.
 (f) *Morgan v. Seaward*, (1837) 2 (h) *Ibid.*

affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. (i)

Grounds
for Revo-
cation.

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result and the later patentee shows a different way of dealing with knowledge common at the date of the first patent. (k) If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle, if the method apart from the principle is not subject-matter—*i.e.*, is not an invention. (l)

Inventions
with the same
objects.

In a case (m) where revocation of a patent for “improvements in the preparation of foods for infants and invalids” was sought, on the ground that the petitioner had for many years previous to the date of the patent, been manufacturing foods by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, *Kay, J.*, in giving judgment for the petitioner said—

“This is an application to recall a patent. It is made under the statute of 1883, which provides that a petition for revocation of a patent may be presented by, among other people, ‘any person alleging that he or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.’ Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked.”

(i) See 1 W. P. C. 42 n.

(l) See p. 51 *ante*.

(k) *Walker v. Hydrocarbon Syndicate, Ltd.*, (1885) 2 R. P. C. 3.

(m) In the Matter of Haddan's Patent, (1885) 2 R. P. C. 219.

**Grounds
for Revoca-
tion.**

Cases of revoca-
tion on the
ground that
the patent was
obtained in
fraud of the
petitioner's
right.

Under the following circumstances patents have been revoked on the ground that they were obtained in fraud of the rights of the petitioner. Where it appeared that the petitioner and respondent had jointly put in a provisional specification, which had been allowed to lapse, and the respondent had thereupon, without the knowledge of the petitioner, obtained the patent for the invention of which the petitioner was the first and true inventor. (*n*) And where the evidence showed that experiments finally resulting in the invention were not made by one of two separate petitioners under the direction of the patentee as the patentee contended, but by the other separate petitioner assisted by the first petitioner, and the patentee, not being the true and first inventor, had obtained the patent in fraud of the latter petitioner's rights. (*o*) And also where the petitioner was a workman in the employ of a company, one of the directors of which had asked him to invent a tap which would produce certain desired results, and the petitioner worked up the invention, made drawings and models, and perfected the tap in all details and was paid for overtime work on the models. (*p*) This last case may be contrasted with another in which the facts were that the petitioner had merely suggested to the patentee a want which was hitherto unsatisfied, but had not given any indication as to the means of supplying it, and the petition consequently failed. (*q*)

A fresh patent may be granted to the petitioner when he succeeds on the ground that the original patent was obtained in fraud of his rights, but not when he succeeds on any other ground.

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent will be revoked, and a fresh patent may be granted to the petitioner, (*r*) bearing the same date as the revoked patent, and terminating on the expiration of the term for which the revoked patent was granted, (*s*) but such a patent will not be granted as matter of course; the Comptroller-General has a discretion in the matter. (*t*)

Where the petitioner succeeds on the ground that the patent was obtained in fraud of his rights it is proper for the Court,

(*n*) Gale's Patent, (1891) 8 R. P. C. 438.

(*o*) Norwood's Patent, (1895) 12 R. P. C. 214; see also Avery's Patent, (1887) 4 R. P. C. 152; L. R. 36 Ch. D. 307; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99; Marshall and Naylor's Patent, (1900) 17 R. P. C. 556.

(*p*) Marshall and Naylor's Patent, (1900) 17 R. P. C. 553.

(*q*) Jackson's Patent, (1905) 22 R.

P. C. 384.

(*r*) 46 & 47 Vict. c. 57, s. 26 (8); Avery's Patent, (1887) L. R. 36 Ch. D. 326; 4 R. P. C. 152, 322; Marshall and Naylor's Patent, (1900) 17 R. P. C. 556.

(*s*) 46 & 47 Vict. c. 57, s. 26 (8).

(*t*) Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

in addition to making an order for the revocation of the patent, to grant a declaration to the effect that the respondent was not the true and first inventor of the invention; that the petitioner was the true and first inventor thereof; and that the respondent obtained the invention from him, and obtained the grant of the letters patent in fraud of the rights of the petitioner. (u)

When fraud is alleged, it is incumbent upon the petitioner to give strict proof of it, and if he fails to do so the petition cannot succeed. (x)

When the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent. (y)

PRACTICE.

Every petition for the revocation of a patent must be presented in the name of the person making the allegations in respect of which the revocation is sought, such person, when necessary, being duly authorised by the fiat of the Attorney-General; (z) and all persons having an interest in the patent must be made respondents. (a)

Under the old practice it was not competent for two persons to have a *scire facias* for the same patent, (b) and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other. (c)

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition the name of the assignee may, on payment of a sum into Court, be substituted for that of the patentee as respondent. (d)

The petitioner is required to deliver with his petition Particulars of objections.

(u) Marshall and Naylor's Patent, (1900) 17 R. P. C. 553.

(z) Jameson's Patent, (1902) 19 R. P. C. 251.

(y) Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent, (1898) 15 R. P. C. 99.

(z) p. 295 ante.

(a) *Re Avery's Patent*, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(b) *R. v. Neilson*, (1842) 1 W. P. C. 673.

(c) *R. v. Betts*, (1850) 15 Q. B. 510; L. J. Q. B. 13, 53.

(d) *Re Haddan's Patent*, (1885) 2 R. P. C. 218.

Practice. particulars of the objections on which he means to rely. (e) These particulars may be, from time to time, amended by leave of the Court or a Judge, (f) and no evidence will, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars have not been delivered. (g)

In a case of *scire facias*, though particulars of objection were not specially requisite, ambiguous charges were not allowed. Thus it was held that a suggestion in the words "the grant is prejudicial and inconvenient to our subjects in general" was too vague, and the Court refused to hear evidence on this issue. (h) Again, after a verdict had been given for the Crown it was held to be no ground for granting a new trial that the patentee could bring further evidence, if there was no allegation of surprise, or the discovery of further evidence. (i)

Certificate as to particulars not necessary.

In an action for infringement it is necessary for the successful party to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such particulars may be allowed on taxation; (k) but this does not seem necessary in the case of a petition for the revocation of a patent, and it would appear that the Court or a Judge has no power to give such a certificate. (l)

Interrogatories.

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement. (m)

Service of the petition,

All persons interested in the patent ought to be made respondents and served with the petition. (n)

out of the jurisdiction.

The Act of 1888 does not, however, provide any special procedure for the service of the petition out of the jurisdiction. It is therefore sufficient if such notice is given as is required by natural justice. (o)

In *Drummond's Patent* (p) it appeared that the patentee was resident and domiciled in Scotland. After a copy of the petition, together with the particulars of objection, was

(e) 46 & 47 Vict. c. 57, s. 26 (5). For a form of particulars of objection to be delivered with a petition for the revocation of a patent, the reader is referred to *In the Matter of Haddan's Patent*, (1885) 2 R. P. C. 218: and further detailed information, relative to particulars of objections, will be found at pp. 412-426 *post*.

(f) 46 & 47 Vict. c. 57, s. 26 (6).

(g) *Ibid.* (5).

(h) *R. v. Arkwright*, (1785) 1 W. P. C. 64 *n*.

(i) *Ibid.* 64, 74.

(k) 46 & 47 Vict. c. 57, s. 29 (6).

(l) *Ibid.* s. 26; *Gaulard and Gibbs' Patent*, (1888) 5 R. P. C. 525, 537; *Waterhouse's Patent* (1905) 23 R. P. C. 64.

(m) *Haddan's Patent*, (1884) 54 L. J. Ch. N. S. 126; 51 L. T. N. S. 190; W. R. (1884) 192.

(n) *Avery's Patent*, (1887) L. R. 3 Ch. D. 307; 4 R. P. C. 152.

(o) See *King & Co.'s Trade Mark*, [1892] L. R. 2 Ch. 463.

(p) (1889) 6 R. P. C. 756.

delivered to him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction.

In *Goerz and Hough's Patent* (q) the respondents were both domiciled out of the jurisdiction, and on an application for directions as to service, North, J., pointed out that the respondents could not be served at all, but that the proper thing for the petitioner to do was to follow the procedure adopted in *Drummond's Patent* above referred to. The Judge also stated that he could not authorise the petitioner to do anything, but that if he (the Judge) was satisfied that the respondents had had proper notice he might proceed in their absence.

In *Hirschfeld's Patent*, (r) on motion for directions as to service of the petition on a foreigner resident abroad, leave was given to the petitioner to send to the respondent by registered letter a copy of the petition, together with a notice that the petition had been ordered to go into the witness list. The respondent did not appear, and the patent was revoked in his absence.

In *Kay's Patent* (s) one of three respondent joint patentees was out of the jurisdiction, and the petition had been duly served on the other two within the jurisdiction. On motion for directions, it was ordered that the petition should go into the witness list; but unless the third patentee appeared by counsel on notice given to him (t) it should not come on for hearing without leave; and liberty was given to either party to apply.

In *Allison's Patent* (u) the foreign owners being resident abroad, and solicitors who had appeared for them in an action against the petitioners declining to undertake to appear, the petition, upon an application for directions, was ordered to go into the witness list and the petitioners were directed to give notice to the solicitors, and, by registered letter, to the owners abroad, with a copy of the petition.

(q) (1895) 12 R. P. C. 370.

(r) (1895) 11 R. P. C. 514.

(s) (1894) 11 R. P. C. 279.

(t) As in *King & Co.'s Trade Mark*,
9 R. P. C. 350.

(u) (1900) 17 R. P. C. 297.

- Practice.** The Court will not compel a respondent out of the jurisdiction to give security for costs, since he does not appear before the Court in consequence of his own application. (v)
- Respondent out of the jurisdiction cannot be compelled to give security for costs.** Respondent has the right to begin at the hearing.
- At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has, by statute, the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent. (x)
- Petition is an action and tried like other actions.** In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *prima facie* case. (y)
- A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *vivâ voce* evidence—if either of the parties desires to have it so determined. (z)
- Form of order.** The proper form of order upon a successful petition varies according as the Court finds that all or only some of the claiming clauses of the specification are bad. (a) Sometimes the Court by the order imposes conditions with regard to future actions brought upon the specification, if amended. (b)
- Mode and date of trial.** If it is desired to have the petition tried with witnesses the proper course is to make an application, on the day on which the petition is returnable, that the petition should go into the witness list, at or after a named date, to be tried on oral evidence. (c) The parties, when arranging the date, should be careful to fix a date by which they are likely to be ready for trial, otherwise the petition may be struck out, though it may be set down again without the necessity of serving a fresh petition. (d)
- Discovery and inspection.** The day on which the petition is returnable and comes into the list is the proper time for the parties, or either of them, if they want discovery or inspection, or anything else, to say so, and the petition ought not to be put into the witness list until it is effective for hearing. (e)
- Trial on affidavit evidence.** When the petition is to be tried by the Court on affidavit evidence, it is proper for the party who has the right to begin

(v) *Miller's Patent*, (1894) 11 R. P. C. 55; *La Société Anonyme Trade Mark*, (1893) 10 R. P. C. 290.

(x) 46 & 47 Vict. c. 57, s. 26 (7).

(y) *R. v. Cutler*, *Macr. P. C.* 124, 133, 134.

(z) *In re Gaulard and Gibbs' Patent*, (1886) L. R. 34 Ch. D. 396.

(a) See Vol. II. p. 83.

(b) See Vol. II. pp. 95-99.

(c) *Miller's Patent*, (1894) 11 R. P. C. 55; *Borrowman's Patent*, (1902) 19 R. P. C. 160.

(d) See *Borrowman's Patent*, (1902) 19 R. P. C. 160.

(e) *Scott's Patent*, (1902) 276.

to file his evidence in chief first, and if there is any cross-examination of any of the witnesses of either side such cross-examination ought to be brought before the Court at the trial. (f) Practice.

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. (g) Trial with assessor.

Unless the Court otherwise decide, the petition is, by statutory provision, heard without a jury. (h) Trial without a jury.

To suit the convenience of the parties to the petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes. (i) Trial at assizes.

Again, if there is an action for infringement of the patent pending, an order may be obtained for the hearing of the petition at the same time as the trial of the action. (k) If there is a pending appeal in an action on the patent, an order may be obtained, in a proper case, for the postponement of the hearing of the petition till after the determination of the appeal. (l) Hearing at same time as an action for infringement.

As a rule joint petitioners must appear by the same counsel, but in *Norwood's Patents* (m) two joint petitioners were, under the peculiar circumstances of the case, allowed to appear separately, and one conducted his case in person. (n) Joint petitioners must appear by same counsel.

Where the respondent consents, an order for revocation with costs will be made when the petition comes on for directions. (o) Judgment for revocation should be pronounced in open Court and not, even by consent, in Chambers. (p) Revocation when respondent consents.

When the respondent does not appear the patent may be revoked at once on the petition coming on and the production of affidavits verifying the service and the grounds of revocation stated in the petition. (q) And since petition is the only way open to a member of the public to obtain the revocation Revocation when respondent does not appear.

(f) *Gale's Patent*, (1891) 8 R. P. C. 438.

(g) 46 & 47 Vict. c. 57, s. 28.

(h) *Ibid.*

(i) R. S. C. O. 36, r. 8; In the Matter of *Edmond's Patent*, (1889) 6 R. P. C. 355.

(k) *Edge's Patent*, (1890) W. N. 149.

(l) *Hitchcock's Patent*, (1903) 20 R. P. C. 767.

(m) (1895) 12 R. P. C. 214.

(n) *Norwood's Patents*, (1895) 12 R. P. C. 219, 221.

(o) *Sleight's Patent*, (1893) 10 R. P. C. 447; *Rendell's Patent*, (1894) 11 R. P. C. 277; *Wilkinson's Patent*, (1894) 11 R. P. C. 298.

(p) *Clifton's Patent*, [1904] 2 Ch. 357; 21 R. P. C. 515.

(q) *Hirschfeld's Patent*, (1894) 11 R. P. C. 514; *Vaisey's Patent*, (1894) 11 R. P. C. 523; *Ingram's Patent*, (1896) 13 R. P. C. 446; *Cerckel's Patent*, (1898) 15 R. P. C. 500; *Partridge's Patent*, (1903) 20 R. P. C. 459; *Lee's Patent*, (1906) 23 R. P. C. 233.

Practice. of a void patent, costs will be given against a respondent patentee who does not appear. (r) Also costs will be given against a respondent who abandons his case. (s)

No estoppel against an unsuccessful defendant to an action for infringement.

There is no estoppel against a petitioner for revocation who has been an unsuccessful defendant to an action for infringement of the patent brought at the instance of the respondent. The reason of this is, that the petitioner on the petition appears as a member of the public, and consequently there is no *res judicata* between him and the respondent in that capacity. (t) And this fact will materially influence the Court of Appeal in exercising its discretion to allow fresh evidence of invalidity upon the appeal of an unsuccessful defendant to an action for infringement. (u)

Old practice as to nonsuits and postponements of actions for infringements pending a *scire facias*.

Under the old practice, the fact of a *scire facias* pending was a ground for refusing a nonsuit on an objection to a patent in an action for infringement. (x) Where a *scire facias* was sued out after a verdict in an infringement action, and a rule obtained to show cause why a nonsuit should not be entered, the Court refused to extend the time for this rule until after the hearing of the *scire facias*. *Tindal*, C.J., pointed out that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objections taken at the trial of the cause. (y) So also the Court refused to deprive the plaintiff in an action for infringement of his Common Law right to try where a *scire facias* had been set down. (z) As a general rule, the plaintiff had a right to have his cause go on to trial, according to the ordinary course of business, but there might be special circumstances upon which the Court might see fit to interpose. (a)

Where, in a case in the Common Pleas, an action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, the Court suspended judgment upon the rule for a new trial, and ordered the trial of the

(r) *Wallace's Patent*, (1895) 12 R. P. C. 444; *Simmon's Patent*, (1895) 12 R. P. C. 446.

(s) *Dodge's Patent*, (1895) 12 R. P. C. 448.

(t) *Deeley's Patent*, (1895) 12 R. P. C. 192, 199; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 533; *Lewis and Stirkler's Patent*, (1897) 14 L. R.

24, 35.

(u) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530, 533.

(x) *Haworth v. Hardcastle*, (1834) 1 W. P. C. 485.

(y) *Ibid.* 486 n.

(z) *Muntz v. Foster*, (1843) 2 W. P. C. 93 n.

(a) *Ibid.*

other action to be postponed until after the trial of the *scire facias*; (b) and in another action in the Common Pleas, where it appeared that the defendants had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench, and the defendant in the Common Pleas gave notice of trial *by proviso*, the Court upon the application of the plaintiff made a rule absolute for postponing the trial. (c)

In *Walker v. The Hydrocarbon Syndicate* (d) an application for the postponement of an appeal in a petition for revocation, on the ground that the petitioner could not be found at the hearing, and for leave to adduce further evidence, was refused.

The respondent may, if he thinks fit, on obtaining the leave of the Court or a Judge, during a proceeding for the revocation of his patent, apply at the Patent Office for leave to amend his specification by way of disclaimer—*i.e.*, a mere disclaimer and not an amendment amounting to a correction or explanation, (e) and a postponement of the hearing may be granted to allow of this being done. (f)

If a petitioner succeeds in obtaining the order of the Court for the revocation of a patent he must forthwith leave at the Patent Office a copy of such order, and the purport of it will be duly entered in the Register of Patents, (g) but the Patents Act, 1883, (h) and the Patent Rules, 1903-5, do not deprive the Court of its power to stay proceedings on an order pending an appeal; (i) and it is submitted that in all cases the order should, in view of questions which may arise as to its effect, be suspended until the disposal of an appeal or an application to amend the specification if the respondent asks for such suspension. (k)

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled, (l) but recent legislation has not provided for the

(b) *Patteson v. Holland*, Hindmarch Patents, p. 293.

(c) *Smith v. Upton*, (1843) 6 M. & G. 251.

(d) (1886) 3 R. P. C. 253.

(e) *Owen's Patent*, (1898) 43 S. J. 43.

(f) 46 & 47 Vict. c. 57, s. 19; Vol. II. p. 209.

(g) P. R. (1890) r. 74.

(h) ss. 18 and 19.

(i) *Armstrong's Patent*, (1897) 14 R. P. C. 755; *Owen's Patent*, (1899) 17 R. P. C. 79.

(k) See Vol. II. p. 83.

(l) *R. v. Newton*, Hindmarch on Patents, p. 427; *R. v. Eastern Archipelago Co.*, (1853) 4 De G. M. & G. 199.

Practice.

Fresh evidence on appeal from order for revocation.

Amendment of specification pending proceedings for revocation.

Stay of proceedings on order for revocation pending an appeal.

Practice. delivering up of a patent which has been revoked by a decision of the Court.

Effect of an order for revocation.

The judgment of the Court itself is a revocation of the patent, and the practice now is for the Comptroller to register the judgment. If this judgment of revocation is reversed by a Court of Appeal, the judgment of that Court is then entered on the register, and the patent is resuscitated again. (*m*) It is proper for the Court to stay proceedings on the order for revocation pending an appeal. (*n*)

It is to be noticed that a decision of the Court in an infringement action against the validity of the patent does not absolutely annul the patent, since it is not an order for the revocation of the patent; (*o*) and it is open to a patentee by amendment of the specification to remove the ground on which the Court has held the patent to be bad; and, if there is sufficient subject-matter left, he may thus make the patent perfectly valid, (*p*) though it may still be liable to attacks by petition for revocation on the ground that what is left is, in fact, not subject-matter. (*q*)

Costs.

The Act of 1883 does not contain any special provision as to the costs on the hearing of a petition for revocation, but the Court, acting under its general jurisdiction, awards the costs of the petition at its discretion, (*r*) but does not include the costs (if any) occasioned by an application to the law officer for his fiat to present the petition. (*s*)

(*m*) *Deeley v. Perks*, (1896) 13 R. P. C. 586, 587; *Armstrong's Patent*, (1897) 14 R. P. C. 755.

(*n*) *Armstrong's Patent*, (1897) 14 R. P. C. 755; *Deeley v. Perks*, (1896) 13 R. P. C. 586, 587.

(*o*) *Deeley's Patent*, (1894) 11 R. P. C. 75; *Deeley v. Perks*, (1896) 13 R. P. C. 581; [1896] A. C. 498.

(*p*) Vol. II. p. 65.

(*q*) *Deeley's Patent*, (1895) 12 R. P. C. 192; 13 R. P. C. 581.

(*r*) In the Matter of *Haddan's Patent*, (1885) 2 R. P. C. 218; In the Matter of *Edmond's Patent*, (1889) 6 R. P. C. 358.

(*s*) *Rendell's Patent*, (1894) 11 R. P. C. 279.

CHAPTER VII.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

PART I.—GENERAL.

SEC. 32 of the Patents, Designs, and Trade Marks Act of 1883 enacts that:— Sec. 32 of Act of 1883,

“Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.”

The principle embodied in this enactment seems to have been recognised by *Malins*, V.C., as early as 1871, (a) though the conclusion at which the learned Judge arrived—viz., that at that date the Court would restrain a patentee from issuing circulars threatening legal proceedings against alleged infringers unless he would undertake to commence proceedings to assert the validity of the patent—appears to have been based on the erroneous assumption that there is no presumption at law in favour of the validity of a patent which has not been declared void. (b) It was subsequently held by

(a) *Rollins v. Hinks*, (1872) L. R. 13 Eq. 355; *Axman v. Land*, (1874) L. R. 18 Eq. 330.

(b) Judgment of Jessel, M.R., *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 520, 523.

General. *Jessel, M.R.*, and affirmed on appeal, (c) that no such principle at that date existed, and that a patentee was, in the absence of *mala fides*, justified in giving notice that his rights were being infringed without following up such notice by an action for the alleged infringement.

Slanderous statements made by patentee may be restrained apart from s. 32 of Act of 1883.

The Court has and always had power, by injunction, to restrain any person from making slanderous statements calculated to injure the business of another person, whether the statements complained of are oral or written, (d) and damages for the slander of title may be obtained upon proof of the absence of privilege and the existence of express malice on the part of the slanderer. (c)

Cases within either of the saving clauses of s. 32 of Act of 1883 are governed by the law in existence before the Act of 1883.

It is to be noticed that the foregoing section of the Act of 1883 does not apply to cases which are within either of the saving clauses—that is to say, to cases where the alleged manufacture, use, sale, or purchase to which the threats related are in fact an infringement of any legal rights of the person making such threats, and to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within either of the saving clauses of sec. 32 of the Act of 1883 are still governed by the law as it existed prior to the Act. (f)

Statement of such law.

The law thus referred to as applicable to such cases was, and is, that a patentee was not liable for issuing circulars or other threats warning persons against using articles which he alleged were infringements of his patent, provided that he issued such notices *bonâ fide* and in the belief that the articles in question were really infringements. (g) Moreover, a patentee was not liable to be restrained by injunction from continuing to issue notices that the articles complained of were infringements, unless such statements were proved to be untrue, so that the further issue of them would not be *bonâ fide*, and would damnify the person threatened. (h)

(c) *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

(d) *Loog v. Bean*, (1884) L. R. 26 Ch. D. 306; *Thomas v. Williams*, (1880) L. R. 14 Ch. D. 864; *Beddow v. Beddow*, (1878) L. R. 9 Ch. D. 89; *Saxby v. Easterbrook*, (1878) L. R. 3 C. P. D. 339; *Thorley's Cattle Food Co. v. Massam*, (1877) L. R. 6 Ch. D. 582; *Riding v. Smith*, (1877) L. R. 1 Ex. D. 91.

(e) *Ibid.*; *Montgomerie v. Paterson*,

(1894) 11 R. P. C. 221, 633.

(f) *Temler v. Stevenson*, (1897) 15 R. P. C. 24.

(g) *Wren v. Wield*, (1869) L. R. 4 Q. B. 730; *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; *Sharp v. Brauer*, (1886) 3 R. P. C. 193; *Skinner v. Shew*, (1893) L. R. 1 Ch. 413.

(h) *Burnett v. Tate*, (1883) 45 L. T. N. S. 743; *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 390; *Sugg v. Bray*, (1885) 2 R. P. C.

Though the patentee was entitled to issue notices containing statements that articles being sold by others were infringements of his rights, if such statements were made with reasonable and probable cause, (i) an action would lie if the statements were not simply allegations of infringements, but went on to allege, as matters of fact, assertions which were not true. A question of infringement is one of law, and, in the words of *Bramwell*, L.J., (k) "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts."

In some cases the patentee makes threats against persons making, using, selling, or purchasing articles which he considers to be infringements of his patent rights, as a means of protecting his own property; on the other hand, sometimes such threats are circulated maliciously, and *malâ fide*, with the intention of injuring the trade of the person against whom they are made.

Before the Act of 1883, it was held that if a statement as to infringement was made by the patentee in defence of his own property, although it injured and was untrue, it was a privileged statement; it was a statement that the defendant had a right to make, unless, besides its untruth, and besides its injury, express malice was proved—that is to say, want of *bona fides* and the presence of *mala fides*. (l) In other words, if such a statement was made *bonâ fide*, though the party affected might be able to prove *damnum*, he could not at Common Law establish *injuria*, and consequently, it being merely a case of *damnum sine injuria*, he could not saddle the patentee with the commission of any tort. (m) It was also held that there was no obligation on the part of a person, who had issued notices stating that the acts of another were an infringement of his patent rights, to follow up such statements with an action for infringement against the person mentioned, for he might desist, and render such action unnecessary, or he might not be worth suing at all. (n)

If the plaintiff in an action to restrain the issue of threats Plaintiff
intending to
rely on the old

224; *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 40; 49 L. J. Ch. 812. As to Interlocutory Injunctions see *Dredge v. Parnell*, (1896) 13 R. P. C. 392.

(i) Per Baggallay, L.J., *Halsey v. Brotherhood*, (1881) L. R. 19 Ch. D. 390.

(k) *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 22.

(l) Per Coleridge, L.C.J., *Halsey v.*

Brotherhood, (1881) L. R. 19 Ch. D. 388; *Sugg v. Bray*, (1885) 2 R. P. C. 243; see also *Skinner v. Shew*, (1893) L. R. 1 Ch. 413.

(m) *Commercial Development Corporation, Ltd. v. Castner-Kellner Alkali Co.*, (1897) 14 R. P. C. 939.

(n) *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 518.

General.

law must disclose his case as to *mala fides*.

of legal proceedings intends to rely on the old law and not on sec. 32 of the Act of 1883, he should disclose his case as to *mala fides* in his affidavits in support of his motion for an injunction. (o)

Law altered by Act of 1883.

The Act of 1883 has completely altered the law with regard to cases within sec. 32 in favour of the public, for it provides that if a person claiming to be a patentee, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability, in respect of any alleged manufacture, use, sale, or purchase of the invention, and does not with due diligence commence and prosecute an action for the infringement of his patent, he is liable to be sued by the person or persons who are aggrieved by such threats, and an injunction restraining the continuance thereof may be obtained, and damages awarded against him, if it turns out that the alleged manufacture, use, sale, or purchase was not, in fact, an infringement of any of his legal rights. (p)

Bona fides of the patentee immaterial when s. 32 of Act of 1883 applies.

If the case is within sec. 32 and a person aggrieved brings an action against the patentee to restrain the issue of threats of legal proceedings, or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, the question of the *bona fides* of the patentee does not affect the case one way or the other. (q) The only defence open to the patentee, if he has not at the date of the action with due diligence commenced and prosecuted an action for infringement of his patent, is to show that the allegations contained in the threatening notices were, in fact, true. (r) Thus an injunction was granted where the defendant refused to bring an action for infringement or to test the validity of his patent which was put in issue by the plaintiff. (s) The burden of proof that the patentee's statements are untrue lies, *prima facie*, on the plaintiff, (t) as it did before the Act of 1883, (u) though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true. (x)

(o) *English and American Machinery Co. v. Gare Machine Co.*, (1894) 11 R. P. C. 631.

(p) p. 309 *ante*.

(q) *Kurtz v. Spence*, (1888) 5 R. P. C. 161; *Herrburger v. Squire*, (1888) 5 R. P. C. 581; *Skinner v. Shew*, (1893) L. R. 1 Ch. 413.

(r) *Crampton v. Patents Investment Co.*, (1888) 5 R. P. C. 382; 6 R. P. C. 287; *Automatic Weighing Machine Co. v. Combined Weighing and Measuring Machine Co.*, (1889) 6 R. P. C. 120.

(s) *Willoughby v. Taylor*, (1894) 11 R. P. C. 45.

(t) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363; *Barney v. United Telephone Co., Ltd.*, (1885) 2 R. P. C. 173.

(u) *Burnett v. Tate*, (1882) 45 L. T. N. S. 743; *Anderson v. Liebig's Extract of Meat Co.*, (1881) 45 L. T. N. S. 757, 759.

(x) *Challender v. Royle*, (1887) L. R. 39 Ch. D. 435; 4 R. P. C. 363.

A person who merely holds an agreement for an assignment of the patent upon terms does not possess legal rights of which the acts referred to in a threat could be an infringement; (y) neither, it would appear, does a patentee who has obtained leave under sec. 19 of the Act of 1883 in a pending action for infringement or a petition for revocation of the patent, for the fact of asking for leave to amend amounts to an admission that the patent is bad without amendment of the specification, and he is not, therefore, entitled to issue threatening notices till the amendment is actually made. (z) In such a case an injunction restraining the issue of the threats may be obtained upon motion in the pending proceeding. (a)

Person Aggrieved.
 Equitable assignee, or a patentee who has obtained leave to amend under s. 19 of Act of 1883, does not possess legal rights of which acts complained of in a threat could be an infringement.

It would appear doubtful whether the section applies in the case of threats made by a licensee or other person having only a limited interest in the patent. It must be remembered that a mere licensee cannot sue alone for an infringement of the patent, and it is doubtful whether an exclusive licensee can do so, (b) because the term "patentee" as used in the Act means the person for the time being entitled to the benefit of the patent, (c) and it is doubtful whether this term would be held to include an exclusive licensee. (d) If an exclusive licensee cannot justify an action for the infringement of the patent, he cannot avail himself of the proviso, and it is submitted, therefore, in such case the section could not be held to apply.

Threats by a licensee.

Person aggrieved.—The right of action conferred by sec. 32 of the Act of 1883 is given to "any person aggrieved." In founding the action, therefore, it is always necessary to consider whether the proposed plaintiff is really a person aggrieved. When threats are made against the customers of the person who supplies or agrees to supply the articles in respect of which the threats are made, that person is a person aggrieved and may bring the action, (e) and he is none the less a "person aggrieved" because he has a binding contract with his customer which he might have enforced, if minded so to do. (f) Also if the threats are made against the plaintiff's

Who is a person aggrieved.

(y) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277.

(z) *Fuseco Vesta Co. v. Bryant and May* (No. 2), (1887) 4 R. P. C. 191.

(a) *Ibid.*

(b) Vol. II. p. 156.

(c) 46 & 47 Vict. c. 57, s. 46.

(d) *Barnett v. Barrett's Screw Stopper Bottling Co.*, (1884) 1 R. P. C. 9.

(e) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277; *Colley v. Hart*, (1898) L. R. 44 Ch. D. 179; 7 R. P. C. 101; *Skinner v. Shew*, (1893) L. R. 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

(f) *Hoffnung v. Salsbury*, (1899) 16 R. P. C. 375.

What is a
Threat?

licensee the plaintiff is a person aggrieved. (g) In one case an injunction was granted where the threat was addressed to a person manufacturing for the plaintiff, but the point whether the plaintiff was a person aggrieved does not appear to have been argued. (h)

The evil which
s. 32 of the
Act of 1883
was intended
to guard
against.

What is a Threat?—In considering the question what are threats within the meaning of sec. 32 of the Act of 1883, it is well to bear clearly in mind what the evil was which the enactment of the section was intended to guard against. Before the section became law, a person aggrieved by the issue of threats of legal proceedings, or liability, at the instance of a person claiming to be the patentee of an invention in respect of which the threats were made, could only obtain the injunction of the Court restraining such threats and damages in respect of them, if he was able to discharge the *onus* which was upon him of proving that the threats were issued *malâ fide* and without reasonable excuse. This *onus* of proof, which was upon the party aggrieved, almost nullified the remedy by injunction because of the extreme difficulty of proving that the patentee had put forward his assertion of patent rights maliciously and without just cause or excuse. The threat of a patent action is well calculated to paralyse the business of persons aggrieved, and in the words of *Bowen, L.J.*, (i) “the Legislature desires that threats of patent actions shall not hang over a man’s head—that the sword of Damocles, in such a case, should either not be suspended or should fall at once, and it is with that view that the section seems to be framed.” The object of the Legislature, therefore, was to prevent persons claiming to be patentees from issuing *any* kind of threat the result of which might be to paralyse a man in his trade by having an action on a patent suspended before his eyes without the opportunity of determining the suspense at once and bringing the question to a speedy and immediate issue. (k) Upon this view of the evil which the section was designed to guard against, the Court of Appeal have held that the words “*or otherwise*,” as used in the section, are not to be construed *ejusdem generis* with “*circulars*” and “*advertisements*,” but that, on the contrary, the words “*circulars*” and “*advertisements*” enlarge the meaning of the words “*or otherwise*” so as to include within the section all threats of whatsoever kind made

Effect of the
words “*or
otherwise*” as
used in s. 32 of
the Act of
1883.

(g) *Kensington and Knightsbridge
Electric Lighting Co. v. Lane Fox
Electrical Co.*, (1891) 8 R. P. C. 277.
(h) *Webb v. Levinstein*, (1898) 15

R. P. C. 78.

(i) *Skinner v. Shew*, [1893] 1 Ch.
425.

(k) *Ibid.*

in respect of any alleged manufacture, use, sale, or purchase of an invention by a person claiming to be the patentee thereof. (*l*)

What is a Threat?

Threats within sec. 32 may, as above stated, be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter, (*m*) in a private letter, (*n*) and in a letter written without prejudice, (*o*) or in answer to an inquiry as to whether the patentee considered a certain article an infringement of his patent, (*p*) are actionable. Further, a statement made by the patentee, or on his behalf, though it does not contain any direct reference to the patent, may, nevertheless, amount to a threat within the section. Thus, where the defendant wrote to probable customers of the plaintiff that they must not be surprised if he, the defendant, applied for an injunction against the plaintiff to restrain him from selling the articles in question, the Court held that such statement amounted to a threat in respect of the patent, and granted an injunction in the terms of the section. (*q*) It is submitted that the Court has power under this section to restrain oral statements which contain threats of legal proceedings against, or liability on the part of, persons aggrieved by allegations made by the patentee to the effect that they have infringed his patent. (*r*)

Nature of threats which have been held to be within s. 32 of the Act of 1883.

The question may arise as to how far a person who has issued threats within the meaning of sec. 32 of the Act of 1883, and brought himself within the proviso by, with due diligence, commencing and prosecuting an action for infringement, is justified in continuing the threats whilst the action is pending. In this connection there is the authority of *Kekewich, J.*, in *Fenner v. Wilson*, (*s*) for the proposition that, quite apart from sec. 32 of the Act of 1883, a plaintiff in a pending action for infringement may, on motion in the action, be restrained from issuing advertisements warning the public that they are

Continuation of threats by a person within the proviso of s. 32 of Act of 1883 pending action.

(*l*) *Skinner v. Shew*, [1893] 1 Ch. 413; *Bishop v. Inman*, (1900) 17 R. P. C. 755.

(*m*) *Duffield v. Waterloo*, (1886) 3 R. P. C. 46; *L. R.* 31 Ch. D. 638; *Crompton v. The Patents Investment Co.*, (1888) 5 R. P. C. 393; *The Combined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 502; *Edlin v. Pneumatic Tyre and Brooks Cycle Agency*, (1893) 10 R. P. C. 312; *Hoffnung v. Salsbury*, (1899) 16 R. P. C. 377; *Engels v. Hubert Unchangeable Eylet Syndicate*, (1902) 19 R. P. C. 201.

(*n*) *Walker v. Clarke*, (1887) 4 R. P. C. 113; *Burt v. Morgan*, R. P. C. 278.

(*o*) *Kurtz v. Spence*, (1888) 5 R. P. C. 173.

(*p*) *Skinner v. Shew*, [1893] 1 Ch. 413; but see *Beven v. Welsbach Incandescent Gas Light Co., Ltd.*, (1902) 20 R. P. C. 69.

(*q*) *Douglass v. Pintsch's Patent Lighting Co.*, (1896) 13 R. P. C. 673.

(*r*) *Kurtz v. Spence*, (1888) 5 R. P. C. 161, 172, 173.

(*s*) (1893) 10 R. P. C. 283; see also *Goulard v. Lindsay*, (1887) 4 R. P. C. 189.

What is a
Threat?

liable in damages for using the subject-matter of the plaintiff's patent, if such advertisements amount to statements that the pending action must succeed. The injunction is granted on the ground that the issue of such advertisements may prejudice the defendant, and so be an interference with the even course of justice; (t) and in such a case the order ought not to contain any undertaking as to damages, since, though subject to appeal, it is not obtained on interlocutory proceedings in the true sense. (u) It is submitted that there is at least great doubt upon the question of fact as to whether such a warning by a patentee could be an interference with the course of justice and as such a contempt of Court in respect of which the Court should issue an injunction. (v) The Court of Appeal, in *Fenner v. Wilson*, without expressing any opinion on the proposition of law above formulated, stated that they could not consider the advertisements complained of in that case as amounting to contempt of Court. (x) In *De Mare's Patent* (y) it was pointed out by *Byrne, J.*, that if, and so far as, threats might but for the section have been held, by reason of their being threats, to fall within the rule of the Court in reference to comment upon public proceedings, the section may have made a change in the case of a person who has brought himself within the proviso by with due diligence commencing and prosecuting an action for infringement. The learned Judge expressed himself to be clearly of opinion that the section was never meant, to a greater extent than possibly as above stated, to justify any public discussion on the merits of pending litigation.

Bonâ fide
notice by plain-
tiff to cus-
tomers of
defendant in an
infringement
action.

The plaintiff in a pending action for infringement is entitled to give *bonâ fide* notice to the defendant's customers that, by dealing in the goods supplied by the defendant, they expose themselves to the risk of actions by the plaintiff, and that, in the event of the plaintiff succeeding against them in such actions, they are liable to pay damages and costs and to have their goods which were so purchased destroyed by order of the Court. (z)

(t) *Fenner v. Wilson*, (1893) 10 R. P. C. 283; *Goulard v. Lindsay*, (1887) 4 R. P. C. 189.

(u) *Fenner v. Wilson*, (1893) 10 R. P. C. 287.

(v) See *Haskell Golf Ball Co. v. Hutchison*, (1904) 21 R. P. C. 497.

(x) *Fenner v. Wilson*, (1893) 10 R. P. C. 287.

(y) (1899) 16 R. P. C. 530.

(z) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1897) 14 R. P. C. 180; see also *Dunlop Pneumatic Tyre Co. v. New Seddon Pneumatic Tyre and Self-closing Tube Co.*, (1897) 14 R. P. C. 332; *Nähmaschinen Fabrik v. Singer Manufacturing Co.*, (1893) 10 R. P. C. 310; *Dunlop Pneumatic Tyre Co., Ltd. v. Clifton Rubber Co., Ltd.*, (1902) 19 R. P. C. 527.

The question whether a threat, to be actionable under sec. 32 of the Act of 1883, must be not merely a warning about something that is going to be done, but must be a threat about an act done—*i.e.*, whether it must be a threat of legal proceedings in respect of an alleged actual manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase, cannot be said to have been, as yet, definitely decided by the Courts. There are expressions in the judgments delivered by the Court of Appeal, especially in that of *Bowen, L.J.*, in *Challender v. Royle*, (a) which, if read apart from the particular case, support the view that a threat in respect of a proposed manufacture, use, sale, or purchase, would not be a "threat" within the meaning of the section; but in the later case of *Johnson v. Edge*, (b) the Court of Appeal without deciding the point, which was not necessary to the decision of that case, expressed grave doubts as to whether upon the true construction of the section it does exclude intended infringements which have not actually taken place, and as to whether the language used by *Bowen, L.J.*, in the judgment above referred to is to be taken to mean that, in all cases, such intended infringements are so excluded. It is submitted that the first part of the section should be construed as correlative with the proviso; and that consequently all threats of legal proceedings or liability in respect of any alleged past or future manufacture, use, sale, or purchase of an invention issued by or on behalf of a person claiming to be the patentee of such invention, are threats within the section, if the person claiming to be a patentee is in a position when the threats are issued to found an action for the infringement of his patent upon the past or future Acts referred to therein. A patentee may found an action upon a threatened infringement, even though no actual infringement has taken place. (c) And, it is submitted, sec. 32 must be interpreted as including any threat made by the patentee in respect of any alleged intended infringement, when the person threatened has actually done something which the patentee is justified in construing as an expression of an intention to infringe.

What is a Threat?

Question whether threat to be actionable under s. 32 of Act of 1883 must relate only to an act done, or whether it may relate to something proposed to be done.

Sec. 32 of the Act of 1883, according to this view of its construction, does not in any way limit the right of every

General warning to infringers issued by a patentee.

(a) (1887) L. R. 36 Ch. D. 425.
 (b) (1892) 9 R. P. C. 142; see also judgment of Kekewich, J., in *Kurtz v. Spence*, (1888) 5 R. P. C. 171; and

of Day, J., in *Willcoughby v. Taylor*, (1894) 11 R. P. C. 52.
 (c) See p. 384 *post*.

The
Proviso.

patentee to issue a general warning to infringers, and to advise the public that the patent to which he is entitled, and under which he claims, is one which he intends to enforce. (d) It must, however, be remembered that what at first sight appears to be a justifiable general warning may, in view of the peculiar circumstances of a particular case, well be construed as a threat directed against a particular individual, and so actionable under the section. (e)

In the event of a patentee obtaining an injunction and damages against a manufacturer, he is entitled to warn purchasers from the manufacturer not to pay the purchase-money to him, and that, if the manufacturer fails to pay the damages, he (the plaintiff) will claim from the purchasers. (f)

Use of a thing
simpliciter as
distinguished
from use in a
particular
manner.

If the use *simpliciter* of a certain apparatus does not amount to an infringement of the patent, but the use of that apparatus in a particular manner does amount to such an infringement, the patentee cannot escape liability for issuing threats to the users of such apparatus, unless he makes it perfectly clear that what he complains of is not the use *simpliciter*, but the use in the particular manner specified. (g)

Threat not
withdrawn.

A threat which is not withdrawn is considered as continuing. (h)

The Proviso.—Sec. 32 of the Act of 1883 provides that the remedy created by the section shall not be applicable, if the person making the threats complained of, with due diligence, commences and prosecutes an action for infringement of his patent.

Nature of
infringement
action which
will secure
the benefit
of the proviso.

The question naturally arises, By whom and against whom and when must such an action be commenced and prosecuted, so as to bring the case within the proviso?

The proviso will not be satisfied unless the action for infringement is brought by the person making the threats—*e.g.*, an action brought by the equitable or legal assignee of the defendant to the threats action will not do. (i) Also the proviso will not be satisfied unless the action for infringement is in respect of the patent to which the threats relate, but, if

(d) *Johnson v. Edge*, (1892) 9 R. P. C. 142; *Challender v. Royle*, (1887) 2 R. 36 Ch. D. 428; *Crowther v. United Flexible Metallic Tubing Co., Ltd.*, (1905) 22 R. P. C. 549.

(e) *Johnson v. Edge*, (1892) 9 R. P. C. 142, 148; *Bishop v. Inman*, (1900) 17 R. P. C. 760.

(f) *Cropper v. Smith*, (1883) L. R.

24 Ch. D. 305, 312.

(g) *Burt v. Morgan*, (1887) 4 R. P. C. 278.

(h) *Driffeld v. Waterloo*, (1886) L. R. 31 Ch. D. 638, 643.

(i) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277.

several patents relate to the same general subject-matter, it is not necessary that the patentee bring the action in respect of all such patents. (*k*) When the threat complained of was issued subsequently to the determination of one action of infringement adversely to the patentee, the proviso is satisfied by the commencement and prosecution with due diligence of a fresh action of infringement against another alleged infringer. (*l*)

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It is not always possible for the defendant to a threats action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee of a rival machine would necessarily be a person aggrieved if threats were made against him; but if such person does not manufacture and sell, but only licenses the manufacture and sale of such rival machine, there would be no means of bringing an action for infringement against him.

It would appear that what the words of the proviso point at is a case where some act has been done which can be tested whether or not it is an infringement. The words, "if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats," clearly point to an act done or contemplated which has been alleged to be, but as a matter of fact is not, an infringement of the patent of the person issuing the threat, and the mere fact that, where the owner of a rival patent is the aggrieved person, it is in many cases impossible that an action for infringement should be brought against him, precludes the notion that the action mentioned in the proviso must be confined to an action against the aggrieved party. (*m*) On the contrary, the proper view seems to be that the proviso will be satisfied if an action for infringement of the patent be honestly brought and diligently prosecuted against any person to whom the threats complained of are applicable; (*n*) and probably also if an action for infringement is commenced and prosecuted with due diligence against a person to whom the threats cannot be said to relate at all; (*o*) but there is authority for saying that an action commenced against a third party in respect of

(*k*) *Temler v. Stevenson*, (1897) 15 R. P. C. 24.

(*l*) *Waite and Saville, Ltd. v. Johnson Die Press Co., Ltd.*, (1900) 18 R. P. C. 1.

(*m*) See p. 313 *ante*.

(*n*) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Day v. Foster*, (1890) 7 R. P. C. 54.

(*o*) See *Lycett Saddle and Motor Accessories Co., Ltd. v. J. B. Brook & Co., Ltd.*, (1904) 21 R. P. C. 656.

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infringements totally different to those alleged against the plaintiff to the threat action is not an action for infringement within the meaning of sec. 32, (*p*) though there is authority pointing the other way, (*q*) and it would appear to be clear that if the article referred to in the threat is of a class which would come into the account in the event of the infringement action succeeding the proviso is satisfied. (*r*)

If the action for infringement be brought, not against the party aggrieved, but against a third party, and if that action be not prosecuted with due diligence, or, if it be collusive, or if it be settled and the threats subsequently continued, (*s*) then, no doubt, the person claiming an injunction to restrain threats would be entitled to contend that the case was within the section, and that such an infringement action did not bring it within the proviso. (*t*) Thus, in a case where the defendant had commenced an action for infringement against the plaintiff, and undertook to prosecute it with due diligence, the Court refused an injunction to restrain the issue of a threatening circular, which, however, was granted subsequently, on the ground that the defendants were not, as a matter of fact, prosecuting their infringement action diligently. (*u*)

An action against licensees for royalties in respect of articles which the defendant alleges were manufactured under another patent and not under the licence is an action for infringement within the meaning of sec. 32 of the Act of 1883. (*x*)

A counterclaim in an action commenced under sec. 32 of the Patents Act, 1883, is sufficient to bring the case within the proviso, if on the facts the issue of infringement is raised with due diligence. (*y*)

Due diligence. In considering the question whether an action for infringement has been commenced and prosecuted with due diligence, so as to bring the case within the proviso of sec. 32, it must be noticed that the section is silent on the point whether it is

(*p*) *The Combined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 502; L. R. 42 Ch. D. 665; 58 L. J. Ch. 709; per Smith, L.J., *Skinner v. Perry*, (1892) 10 R. P. C. 8.

(*q*) *Lycett Saddle and Motor Accessories Co., Ltd. v. J. B. Brooks, Ltd.*, (1901) 21 R. P. C. 656.

(*r*) *Ibid.*

(*s*) *Engels v. Hubert Unchangeable Eylet Syndicate*, (1902) 19 R. P. C. 201.

(*t*) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425, 439; 4 R. P. C. 363; see also *Engels v. Hubert Unchangeable Eylet Syndicate*, (1902) 19 R. P. C. 201.

(*u*) *Household v. Fairburn*, (1884) 1 R. P. C. 109; 2 R. P. C. 142.

(*x*) *Day v. Foster*, (1890) 7 R. P. C. 54.

(*y*) *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Edie Chain, Ltd.*, (1899) 16 R. P. C. 330.

necessary that the action for infringement must be commenced before or after the action for threats. It has been held that, if a threatened action for infringement be commenced and prosecuted with due diligence, there is no ground upon which an action under sec. 32 can be commenced at all. (2)

Moreover, an action for infringement commenced before the issue of the threats complained of is sufficient to bring the case within the proviso of sec. 32, if the alleged infringements are the same as those forming the subject of the threats, and it is not necessary that the action for infringement should be one in which the issue of validity can be contested. (a)

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of threats, account must be taken of the time that has elapsed since the threats complained of were first issued and the infringement action was commenced, and not of the time since the defendant first became aware that the plaintiff was doing the acts which are alleged in the threatening notices to be an infringement of the defendant's right. (b)

There is no rule as to the length of time within which a patentee must bring an infringement action in order to escape liability in respect of threatened proceedings. (c) If delay in bringing the infringement action were caused by negotiations between the parties, it would no doubt be held that the conditions of the proviso were satisfied. (d) But where the defendants in a threat action did not commence an action for infringement till over two months after the threats complained of were issued, and then only issued writs against two persons, not the plaintiffs in the threat action, and subsequently entered a counterclaim in the threat action alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence; (e) and where the defendants had issued a writ out of Court, but had expressed an intention not to serve it, and first raised the issue of infringement by way of counterclaim,

(2) *Day v. Foster*, (1890) 7 R. P. C. 54, 60.

(a) *Ibid.* 54; *Berliner v. Edison-Bell Consolidated Phonograph Co.*, (1899) 16 R. P. C. 336.

(b) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435, 437; 4 R. C. P. 363; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 502; *Haskell Golf Ball Co. v. Hutchison*, (1904) 21 R.

P. C. 497.

(c) *Colley v. Hart*, (1890) 7 R. P. C. 101, 106.

(d) *Edlin v. Pneumatic Tyre and Brooks Cycle Co.*, (1893) 10 R. P. C. 311.

(e) *Herrburger v. Squire*, (1888) 5 R. P. C. 581; 6 R. P. C. 194; but see *Challender v. Royle*, (1887) L. R. 36 Ch. D. 437.

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a jury found that the infringement action commenced under such circumstances was not commenced with due diligence. (*f*)

It has been held that an action commenced and subsequently discontinued by consent is not an action prosecuted with due diligence, so as to entitle a defendant in a threat action to exemption from liability; (*g*) though this decision would appear to be wrong in view of the fact that subsequent cases have decided that an action which is abandoned because the defendant gives in, and desists from the infringement, or because the plaintiff is advised that the action must fail, is an action for infringement prosecuted with due diligence. (*h*) Moreover, it cannot be contended that an action for infringement to come within the meaning of the proviso of sec. 32 of the Act of 1883 must be prosecuted down to a successful result; on the contrary, the action may be within the proviso though it is discontinued, or judgment is against the plaintiff, (*i*) or it was originally in respect of several patents and was dropped in respect of some of them. (*k*)

The fact that a patentee, who has commenced an action for infringement against a person subsequently claiming an injunction restraining the continuance of threats, has not applied for an interlocutory injunction, is not evidence that he has not prosecuted his action with due diligence. (*l*)

An action commenced to obtain an injunction to restrain the defendant from passing off his goods as and for the plaintiffs, and tardily after the issue of the writ in an action under sec. 32 amended to an infringement action, is not commenced and prosecuted with due diligence. (*m*)

A jury has held that a delay of several months in taking up an order for inspection which, if acted upon, would have led to the discontinuance of the action on the ground of non-infringement amounted to a lack of prosecution with due diligence. (*n*) On the other hand, Lord *Alverstone*, L.C.J., in a case where delays amounting to eighteen months had

(*f*) *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Eadie Chain, Ltd.*, (1899) 16 R. P. C. 318.

(*g*) *Crompton v. Patents Investment Co.*, (1888) 5 R. P. C. 382, 393; but see *Colley v. Hart*, (1890) 7 R. P. C. 101.

(*h*) *Colley v. Hart*, (1890) 7 R. P. C. 101, 108, 110; *English and American Machinery Co. v. Gare Machinery Co.*, (1894) 11 R. P. C. 627. As to continuation of threats after an action for infringement has been settled, see p.

326 *ante*.

(*i*) *Colley v. Hart*, (1890) 7 R. P. C. 101, 109, 110; *English and American Machinery Co. v. Gare Machinery Co.*, (1894) 11 R. P. C. 627.

(*k*) *Temler v. Stevenson*, (1897) 15 R. P. C. 24.

(*l*) *Anderson v. Liebig's Extract of Meat Co.*, (1881) 45 L. T. N. S. 757.

(*m*) *Johnson v. Edge*, (1892) 9 R. P. C. 142.

(*n*) *Bishop v. Inman*, (1900) 17 R. P. C. 749, 756, 759.

occurred in the various steps of an infringement action, and there was pending, on the application of the defendants in that action, an application for leave to obtain evidence abroad, held that, under the circumstances, there had been no want of due diligence. (o)

Pleadings.
Issues.

PART II.—PRACTICE.

Pleadings.—Specimens of the pleadings in an action under sec. 32 of the Act of 1883 will be found in the Appendix. (p) The action for breach of the statutory right created by sec. 32 of the Act of 1883 lies against individuals, and also against a corporation. (q)

Pleadings.

Issues.—In any action brought under sec. 32 of the Act of 1883 to restrain threats of legal proceedings, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate; (r) and it is therefore open to the plaintiff to prove, in either of two ways, that he has not infringed any legal right of the defendant. Either he may say, “The patent is valid, but I have not infringed it;” or he may say, “The patent is invalid, and, therefore, I have not infringed any legal right of the person making the threats.” (s) That is to say, in order to act on the above-mentioned section, the Court must be satisfied, at the hearing of the action, that the articles in respect of which the threats were made are not “an infringement of any legal rights of the person making such threats.” The question, therefore, whether the patent of the person making the threats is a valid patent must come into consideration, if the plaintiff in the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee. (t)

Issues of infringement and also validity of the patent may be raised.

It would appear to be the more correct course for the plaintiff not to plead the invalidity of the defendant's patent in the statement of claim, but to leave the defendant to raise

Practice in pleading.

(o) *Voelker Incandescent Mantle v. Welsbach Incandescent Gas Light Co.*, (1901) 18 R. P. C. 494.

(p) Vol. II. p. 404 *post*.

(q) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, (1889) L. R. 42 Ch. D. 669; *Fusco Vesta Co. v. Bryant and May*, (1887) 4 R. P. C. 194; *Kensington and Knightsbridge Electric Lighting Co. v. Lano Fox Electrical Co.*, (1891) 8 R. P. C.

277; L. R. (1891) 2 Ch. 579.

(r) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Kurtz v. Spence*, (1887) 4 R. P. C. 427; *Herrburger v. Squire*, (1888) 5 R. P. C. 589.

(s) Per Charles, J., *Herrburger v. Squire*, (1888) 5 R. P. C. 589.

(t) See judgment of Cotton, L.J., *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363.

Parti-
culars.

the issue in the defence. The plaintiff is at liberty to deny the validity in the reply, and to deliver particulars of objections therewith, and such further pleadings as may be necessary are allowed. (*u*) It is, however, competent to the plaintiff, if he is so minded, to raise the issue of the validity of the patent by a denial in the statement of claim. (*x*)

The burden of proof of the fact of infringement is on the defendant. (*y*)

Particulars of
breaches.

Particulars.—The defendant may be ordered to furnish particulars of breaches, pointing out how the acts complained of are infringements of his patent, and pointing out, by reference to pages and lines of the specification, which parts of the invention therein described he alleges have been infringed; (*z*) and the plaintiff, if he denies the validity of the defendant's patent, may be required to deliver to the defendant particulars of his objections. (*a*)

If the defendant is the owner of more than one patent, it is proper that he should deliver particulars of the patents on which he relies to support the threats before the plaintiff delivers his particulars, which may be confined to the patents mentioned in the defendant's list. (*b*)

If the plaintiff pleads non-infringement of any legal right of the defendant, and the defendant, though not admitting the plea, does not allege infringement of any particular legal right, the plaintiff cannot claim particulars showing in what respect the defendant alleges the infringement of his legal rights, or in what respect he does not admit that the plaintiff does not infringe his (the defendant's) alleged legal rights. (*c*)

Particulars of
objections.

The defendant is entitled to particulars of objections before he delivers his defence if invalidity is pleaded in the statement of claim. (*d*)

When the plaintiff alleges that the threats were made by the

(*u*) *Dowson Taylor v. Drosophore Co.*, (1895) 12 R. P. C. 95; see *Kopp v. Rosenwald*, (1902) 19 R. P. C. 208; 20 R. P. C. 154.

(*x*) *Willoughby v. Taylor*, (1894) 11 R. P. C. 47.

(*y*) *Ungar v. Sugg*, (1889) 6 R. P. C. 337.

(*z*) *Wren v. Weild*, (1869) L. R. 4 Q. B. 213; *Union Electrical Power and Light Co. v. Electrical Power Storage Co.*, (1888) 5 R. P. C. 329; *Law v. Ashworth*, (1890) 7 R. P. C. 86;

Hoffnung v. Salsbury, (1899) 16 R. P. C. 378.

(*a*) *Union Electrical Power and Light Co. v. The Electrical Power Storage Co.*, (1888) 5 R. P. C. 329; *Smith v. Laing*, (1890) 7 R. P. C. 148.

(*b*) *Ibid.* Particulars of breaches and objections are discussed more fully at pp. 395 and 412 *post*.

(*c*) *Dowson Taylor v. Drosophore Co.*, (1894) 11 R. P. C. 653.

(*d*) *Law v. Ashworth*, (1890) 7 R. P. C. 86.

defendant's agents, he may be compelled to give particulars of the names of such agents. (e)

Inter-locutory Injunction.

Interlocutory Injunction.—In cases where the defendant brings an infringement action which satisfies the conditions of the proviso of sec. 32 of the Act of 1883, it is the usual course for the Court, on motion by the plaintiff for an interlocutory injunction, to make no order except that the threats action be stayed until the trial of the infringement action or further order, and that the costs of the threats action be costs in the infringement action; and the defendant usually gives an undertaking to prosecute the infringement action diligently, and disclaims any intention of issuing new threats in the mean time. (f) In the event of the defendant not prosecuting the infringement action with due diligence, the plaintiff has thus an opportunity of moving again. (g)

Usual course where defendant brings an action for infringement.

An injunction to restrain threats of legal proceedings or liability in respect of alleged infringement of a patent will not, as a rule, be given on an *ex parte* application, and there does not appear to be any reported case in which this has been done, though no doubt, under very special circumstances, the Court might do so, if the interests of justice would not be otherwise satisfied.

It is usual to allow short notice of motion to be given in the ordinary way: (h) but when threats are issued by an agent in this country at the instigation of a foreigner abroad, and the agent appears, though the foreign patentee has not been served, the practice is for the Court to grant an *ex parte* injunction against the foreigner, his servants, and agents. The order indicates that the agent defendant appears, and it is directed in particular against him as agent. The plaintiff should give an undertaking to accept short service of notice to dissolve the injunction. (i)

In an action to restrain threats under sec. 32 the Court will not grant an interlocutory injunction unless it is satisfied that the plaintiff has made out a *prima facie* case to the effect either that he has not infringed the defendant's patent or that the patent is void; and, unless there is such a *prima facie*

Prima facie case of non-infringement or invalidity is essential without which the Court does not consider the balance of convenience to the parties.

(e) *Dowson Taylor v. Drosophore Co.*, (1894) 11 R. P. C. 536.

Dowson Taylor v. Drosophore, (1895) 12 R. P. C. 95.

(f) *Mackie v. Salvo Laundry Co.*, (1892) 9 R. P. C. 465; *Edlin v. Pneumatic Tyre and Booth's Cycle Agency*, (1893) 10 R. P. C. 316; *English and American Machinery Co. v. Gare Machinery Co.*, (1894) 11 R. P. C. 628;

(g) *Ibid.*
(h) *Wilson & Co. v. Walter E. Church Engineering Co., Ltd.*, (1885) 2 R. P. C. 175.

(i) *Overton v. Burns*, (1896) 13 R. P. C. 455.

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locutory
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case, the Court does not take into consideration the balance of convenience to the parties. (*k*)

Cotton, L.J., commenting in the Court of Appeal on a decision (*l*) to the effect that the Court has power to grant an interlocutory injunction in a threat action, though it is not proved that the plaintiff has not infringed the defendant's patent, and also on the suggestion that the question whether an interlocutory injunction should be granted depends upon the balance of convenience to the parties, said (*m*)—

“It is very true that in all cases of interlocutory injunction the Court does consider, and ought to consider, the balance of convenience and inconvenience in granting or refusing the injunction. But there is another very material question to be considered: Has the plaintiff made out a *prima facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, although I quite agree that the Court ought not, on an interlocutory injunction, to attempt finally to decide the question whether the Act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of those two points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction, merely on the ground that it cannot do the defendant any harm. Injunctions ought to be granted only on a case made out entitling the plaintiff to that particular remedy.”

If the Court is satisfied, on a motion for an interlocutory injunction, that the plaintiff has made out a *prima facie* case of non-infringement, it will grant the interlocutory injunction restraining the defendant until the trial of the action from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or

(*k*) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1; *Barney v. United Telephone Co.*, (1885) L. R. 28 Ch. D. 394. In *Engels v. Hubert Unchangeable Eylet Syndicate*, (1902) 19 R. P. C. 201, Byrne, J., granted an interlocutory injunction though the point as to *prima facie* case does not

appear to have been taken on behalf of the defendant; the judgment went on the ground that there was no pending action for infringement to satisfy the proviso of sec. 32 of the Patents Act, 1883.

(*l*) *Walker v. Clarke*, (1887) 4 R. P. C. 111; *Challender v. Royle*, (1887) L. R. 36 Ch. D. 428; 4 R. P. C. 363.

(*m*) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 436; 4 R. P. C. 363.

purchase of his invention. (n) On the other hand, where the Court is of opinion that the plaintiff, by his affidavits, fails to raise a probable case of non-infringement, and that there is a conflict of testimony on the question, an injunction will be refused. (o) The Court, in deciding whether the defendant has made out a *prima facie* case of infringement, takes into consideration the fact whether or not he has commenced an action for infringement, and, if he has not done so, this fact is evidence against him. (p)

Damages.

When there is a question as to whether the alleged threat is really a threat within the section which would be better decided at the trial, and the defendant denies any intention of making threats, this circumstance induces the Court to order the motion to stand to the trial, with liberty to the plaintiff to bring it on again in the interval upon two days' notice. (q)

Other considerations on motion for interlocutory injunction.

Where (r) it appeared that the defendants were only exclusive licensees for a limited area of the patent referred to, and that the patentee had commenced an action for infringement against the plaintiff, in which the defendants were to be made co-plaintiffs, the Court ordered the motion for an injunction restraining the further issue of the circular to stand over till after the hearing of the infringement action. (s)

Another circumstance which may influence the Court to grant an interlocutory injunction is the probable incapacity of the defendant to satisfy the plaintiff's claim if ultimately defeated. (t)

Damages.—Damages are only awarded when the plaintiff shows that he has really suffered loss owing to the defendant's conduct. (u) Moreover, the defendant is only liable for damage directly caused by the threats. He is not liable for damage resulting from the mere rumour of legal disputes or legitimate general statements, or by threats unauthorised by him, though he may be liable in respect of a falling off in the plaintiff's general business traceable to the threats in respect of a particular article dealt in by the plaintiff. (x)

Damages to be recoverable must result directly from the threat.

(n) *Colley v. Hart*, (1888) 6 R. P. C. 17.

(o) *Barney v. United Telephone Co.*, (1885) 2 R. P. C. 173.

(p) *Colley v. Hart*, (1889) 6 R. P. C. 17.

(q) *Douglass v. Pintsch's Patent Lighting Co.*, (1895) 13 R. P. C. 60.

(r) *Barnett v. Barrett's Screw Stopper Bottling Co., Ltd.*, (1884) 1 R. P. C. 9.

(s) See also *Combined Weighing and*

Advertising Machine Co. v. Automatic Weighing Machine Co., (1889) 6 R. P. C. 502.

(t) p. 438 *post*.

(u) *Driffield v. Waterloo*, (1886) L. R. 31 Ch. D. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(x) *Ungar v. Sugg*, (1891) 8 R. P. C. 385; 9 R. P. C. 113, in which the principles on which damages for threats ought to be assessed are discussed.

Certificates. When it can be shown that the plaintiff has lost a contract in consequence of the threats the measure of damage is the loss of profit, (*y*) and the fact of breach is sufficient to entitle the plaintiff to an inquiry as to damages, notwithstanding that he might have enforced his contract, if so minded. (*z*)

Similarly, if the effect of the threats was to compel the plaintiff to accept a contract at a lower price than he would otherwise have obtained, the damage is the difference between the price which the plaintiff would but for the threats have obtained and the price actually accepted. (*a*)

If the Judge is able to assess the damages at the trial it is right that he should do so instead of sending the case to an inquiry. (*b*)

Can a certificate of validity be given in an action to restrain threats?

Certificate of Validity.—It is submitted that an action which is in the form of one to restrain the issue of threats under sec. 32 of the Act of 1883, but in which the validity of the patent is put in issue and decided in favour of the patentee, is an “action for infringement” within the meaning of sec. 31, and that the Court has, therefore, jurisdiction to give a certificate of validity under that section. The authorities, however, appear to be in conflict. (*c*) It is submitted that the object of the Legislature in framing sec. 31 was to protect patentees, who have once established the validity of their patents in expensive litigation, from being unduly harassed by having the same question raised against them again by the parties to different proceedings; and that the section ought not to be so construed as to limit it to cases in which the action is one for infringement in the ordinary sense, and to exclude cases in which the action, though in substance one for infringement, is not so in mere form.

Is certificate as to particulars necessary on taxation?

Certificate as to Particulars.—It does not appear to have been definitely decided whether or not in order for a successful party in an action under sec. 32, in which the questions of infringement and validity of the patents were in issue, to be entitled to the costs of his particulars, it is necessary for him to obtain the Judge’s certificate under sec. 29, sub-s. 6 of the

(*y*) *Skinner v. Perry*, (1894) 11 R. P. C. 406.

(*z*) *Hoffnung v. Salsbury*, (1899) 16 R. P. C. 375.

(*a*) See *Alfred Appleby’s Twin Roller Chain, Ltd. v. Albert Eadie Chain, Ltd.*, (1899) 16 R. P. C. 318, 324.

(*b*) *Ungar v. Sugg*, (1892) 9 R. P. C. 113; *Herrberger v. Squire*, (1887) 5

R. P. C. 596; 6 R. P. C. 194; *Kurtz v. Spence*, (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

(*c*) *Kurtz v. Spence*, (1885, 1888) 5 R. P. C. 184; *Crompton v. The Patents Investment Co.*, (1888) 5 R. P. C. 404; *Herrburger v. Squire*, (1888) 5 R. P. C. 595.

Act of 1883, to the effect that such particulars delivered by him were proven or reasonable and proper. (d) It is submitted that an action under sec. 32, in which the issues of infringement and validity of the defendant's patent are properly raised, whether or not the defendant counterclaims for damages, is in all but mere form an action for the infringement of the patent and that the term "action for infringement" as used in sec. 29 should be construed as including such an action, with the result that the Court has jurisdiction to grant the certificate in a threats action, and that, on taxation, no costs should be allowed in respect of any particular which has not been duly certified by the Court. It is to be observed that the submission is the other way in the case of a petition for the revocation of a patent, for sec. 26 of the Act of 1883 is confined expressly to the practice in cases of revocation of a patent upon petition, whereas sec. 28 refers to "an action or proceeding for infringement or revocation of a patent," and sec. 29 commences "In an action for infringement of a patent," and makes no reference to proceedings for revocation upon petition. Secs. 26 and 29 contain analogous directions as to the delivery of particulars and confining the evidence to them, but sec. 26 does not contain the clause which is in sec. 29, having reference to the certificate. (e)

Breach of
Injunction.

Breach of Injunction.—It is submitted that a defendant, who is restrained from issuing threats of legal proceedings by an injunction which follows the terms of sec. 32 of the Act of 1883, does not commit any breach by circulating threats made by a third party, provided that such circulation is not a mere cloak to conceal threats really made by the defendant. (f)

Scope of
injunction.

No doubt the Court would, if it thought fit, so word the injunction as to include the circulation, by the defendant, of threats made by a person or persons other than himself.

In a case where an undertaking had been given practically in the terms of the section, and subsequently an action for infringement had been brought, the Court, upon motion for sequestration against the defendant company and attachment of its directors, decided that the bringing of the infringement action was no breach of the undertaking. (g)

There is no precedent for the extension of the injunction by

(d) Willoughby v. Taylor, (1894) 11 R. P. C. 28, 33.
R. P. C. 45.

(e) p. 302 ante.

(f) See *Ellam v. Martyn*, (1898) 16 C. 69.

(g) *Beven v. Welsbach Incandescent Gas Light Co., Ltd.*, (1902) 20 R. P. C. 69.

Costs.
 — the Court so as to include assignees of the defendant's patent, and in one case (*h*) an application for such extension was expressly refused. Under some circumstances the issue of threats by an enjoined defendant's assignee would amount to a contempt of Court. (*i*)

Ordinary jurisdiction of the Court applies.

Costs.—The general costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction.

It is the duty of the defendant to a threat action who brings a cross-action for infringement to endeavour by arrangement to avoid causing unnecessary costs by trying the same action in two different forms. (*k*)

Where the plaintiff obtains judgment with costs the Master will, on taxation, tax in favour of the defendant any issues upon which he has been wholly successful; (*l*) but see above as to costs of particular breaches and objections.

(*h*) *Engels v. Hubert Unchangeable Eylet Syndicate*, (1902) 19 R. P. C. 204.

(*i*) See *ibid.* For usual form of injunction see *Mountain v. Parker*, (1903) 20 R. P. C. 774.

(*k*) *Combined Weighing Machine*

Co. v. Automatic Weighing Machine Co., (1889) 6 R. P. C. 367, 502; *Colley v. Hart*, (1890) 7 R. P. C. 101, 108, 189.

(*l*) *Herrburger v. Squire*, (1888) 5 R. P. C. 596; *Longbottom v. Shaw*, (1888) 5 R. P. C. 502.

CHAPTER VIII.

ACTION OF INFRINGEMENT.

GENERAL.

It was not for two hundred years after the Statute of Monopolies became law that the popular prejudices against patent privileges disappeared, and Judges began to determine questions arising between patentees and the public in a fair and impartial spirit. Formerly the Courts were only too ready to seize on any slight defects to declare a patent null and void. They were, no doubt, actuated by the deep-seated prejudice which was extremely general in the public mind, and which was the direct outcome of the monstrous oppression practised by means of patent grants before the statute of James I.

Former spirit of interpretation of letters patent.

The Courts now recognise the principle laid down by Lord Eldon, L.C., (a) that the patent may be considered as in the nature of a bargain between the public (represented by the Crown) and the patentee, and the specification, therefore, must be construed on the same principle of good faith as that which regulates all other contracts. Consequently, all questions which arise between patentees and the public are determined between the parties without any bias or strained construction put upon the law or patent in favour of either.

Modern spirit of interpretation.

The privilege conferred by letters patent for an invention, which is created by the law, (b) would be of no practical use to the grantee if he did not possess legal remedies against persons found to have invaded it.

It is open to a patentee, whose exclusive privilege is being invaded, to bring an action for infringement against the offending party, and so vindicate his right by a proceeding in which, if he succeeds, he may be entitled, not only to an

Remedies for infringement.

(a) *Cartwright v. Eamer*, (1807) cited and approved 14 Ves. 131, 136; *Tubes, Ld. v. Perfecta Seamless Tube Co., Ld.*, (1902) 20 R. P. C. 95, 96. A patent is,

of course, not actually a contract: it is a royal grant, see *Feather v. Queen*, (1865) 6 B. & S. 257.

(b) Vol. II. pp. 104, 105.

General
 —————
 injunction of the Court restraining a continuance of the wrongful acts, but also to an account of profits made by the infringer, or damages against him, and the costs of the litigation, together with destruction of the infringing article. A patentee is also entitled to sue in one and the same action for the recovery of royalties from a defendant alleged to be a licensee, or in the alternative for the usual relief consequent on infringement. (c)

Secret use of
 an invention.

A secret use by the patentee of an invention before the date of letters patent will not, at any rate if there has been no profit derived therefrom, invalidate the patent subsequently obtained. (d) The question suggests itself, Can a patentee who has obtained letters patent for an invention, by an injunction of the Court, prevent another man from continuing what before the date of the patent had been the secret use of the invention? It is submitted that he could not do so, for the patent under such circumstances is invalid because the requirements of the sixth section of the Statute of Monopolies are not satisfied, in that it cannot be said that the invention is one which falls within the class "which others at the time of making such letters patent and grants shall not use." (e) The prior secret user would no doubt be required to establish a very strong case, for the Courts would be inclined to the conclusion that an alleged prior secret use was merely experimental and incomplete, in which case it would not invalidate the subsequent patent for the completed invention. (f)

The man who uses an invention and keeps the method of performing it a secret really inflicts a hardship on the public, for, if he never discloses it, the public may have no further advantage of it beyond that which the secret user chooses to give. It is open to the secret user, if he be the true and first inventor, to obtain a patent and enjoy the exclusive privilege of using the invention during the term for which it is granted. (g)

If any person has *openly* practised an invention before the date of subsequent letters patent, he clearly cannot be prevented from continuing to do, after the patent, that which he did before it, since the patent is bad in law on the ground of lack of novelty. (h)

(c) *Wilson v. Union Oil Mills Co.*,
 (1892) 9 R. P. C. 57.

(d) pp. 125, 135 *ante*.

(e) p. 136 *ante*.

(f) p. 121 *ante*.

(g) pp. 125, 135 *ante*.

(h) p. 126 *ante*.

Beside the remedy of an action for infringement, patentees are entitled, in common with other persons, to bring an action at common law against any one who sells or otherwise passes off goods manufactured by himself or another in such a manner as to induce the purchasing public to believe that such goods are manufactured by the patentee or his nominees, when, in fact, they have not been so manufactured. It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name, (*i*) word, (*h*) mark, or device (*l*) upon the spurious articles themselves, or upon the wrappers in which they may be wrapped, (*m*) or by using any other means to deceive the public into purchasing goods as the goods of the patentee when they are really not so. (*n*)

General.

Sale of goods
in fraud of a
patentee.

A plaintiff who succeeds in showing that the defendant has sold goods in a manner calculated to make the public believe that they were, contrary to the actual fact, purchasing the manufacture of the plaintiff, is entitled to an injunction against the defendant, and also to an account or damages. (*o*) And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff. (*p*)

Further, a person selling goods in a manner which induces the purchaser to believe that he is buying the goods of another is liable to an action, notwithstanding the fact that he in a sense makes no actual misrepresentation. Thus, in a case where it appeared that the plaintiff made and sold goods which he was accustomed to mark with the words "Sykes' patent," and the defendant (who was of the same name as the plaintiff) made and sold similar goods to the retailers which he also marked with the words "Sykes' patent," and the patent right had expired, the defendant was restrained by the injunction of the Court, on the ground that he was selling his goods as and for those manufactured by the plaintiff; and this notwithstanding the fact that he did not himself

(*i*) *Ransome v. Bentall*, (1834) 3 L. J. N. S. 161; *Singer Manufacturing Co. v. Loog*, (1880) L. R. 18 Ch. D. 395, 422.

(*h*) *Knott v. Morgan*, 2 Keen, 213; *Wotherspoon v. Currie*, L. R. 5 E. & I. App. 508; *Ford v. Foster*, L. R. 7 Ch. App. 611; *Siegert v. Findlater*, L. R. 7 Ch. D. 801.

(*l*) *In re Worthington*, L. R. 14 Ch. D. 8; *Orr Ewing v. Johnson*, L. R. 13

Ch. D. 434; L. R. 7 App. Cas. 219; *Seixo v. Provezende*, L. R. 1 Ch. App. 192.

(*m*) *Blofield v. Payne*, 4 B. & A. 410; *Blackwell v. Crabb*, 36 L. J. Ch. 501; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130.

(*n*) See *Reddaway v. Banham*, (1896) A. C. 204.

(*o*) See *post*.

(*p*) *Blofield v. Payne*, 4 B. & A. 410.

General. represent his goods to be of the plaintiff's manufacture. (q)
 ——— A rule *nisi* for a new trial was refused by the Court of
 King's Bench. (r)

On the other hand, any person who becomes acquainted with the process of making an article which is merely a secret, and not the subject of an existing patent, is entitled to manufacture it; and, if the name of the first manufacturer has become descriptive of the article apart from its origin, any person is entitled to describe it by such name, provided he does not so use the name as to lead the public to believe that they are buying goods made by such original manufacturer. (s)

Patentee may sue in one action in respect of infringement and passing off.

A person is liable to be sued in one and the same action both for the infringement of a patent or copyright, or in the alternative for passing off his goods as and for those of the plaintiff. (t)

Different causes of action against different persons must not be joined, but where the action is limited to a cause of action resulting from the joint conduct of two persons, they may be joined as defendants. (u)

Security of public against illegal patents.

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection:—

First: Any member of the public against whom proceedings are taken by the patentee is entitled to show that the patent in question is void, (v) and so defeat the action, for there can be no infringement of an invalid patent; and, unless the patent has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement. (x)

Secondly: Any person entitled as of right so to do, or authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, may obtain the revocation of an illegal patent on petition to the Court. (y)

Thirdly: Every patent contains a proviso to the effect that it shall forthwith determine and be void to all intents and

(q) *Sykes v. Sykes*, 3 B. & C. 541; cf. *Turton v. Turton*, (1889) L. R. 42 Ch. D. 128.

(r) 3 L. J. N. S. 161.

(s) *Massam v. J. W. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574; 14 Ch. D. 748.

(t) *Lees v. West London Cycle Works*, (1892) 9 R. P. C. 300; *Hewett v. Nurse*, (1900) 17 R. P. C. 264; *Chameleon Patents Manufacturing Co.*

v. Marshalls, (1900) 17 R. P. C. 527; *Parker v. Satchwell*, (1903) 18 R. P. C. 299; *Poulton v. Kelley*, (1904) 21 R. P. C. 392.

(u) *Saccharin Corporation, Ltd. v. D. T. J. Lyle & Sons, Ltd.*, (1904) 21 R. P. C. 604.

(v) But see p. 406 *post*.

(x) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 37.

(y) p. 293 *ante*.

purposes, if at any time during the term for which it is granted it be made to appear to the King, his heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial or inconvenient to the subjects in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within this realm. (z)

Infringe-
ment.

INFRINGEMENT.

A person invades the exclusive rights of a patentee and commits an infringement when, without the licence of the owner for the time being of the patent, he directly or indirectly during the lifetime of the patent uses the art or invention which is the subject of the patent, and applies it in any way for his own profit or benefit, otherwise than for the purpose of *boná fide* experiment.

Definition of
infringement.

There is no infringement unless that which is protected by the patent—*i.e.*, that which is claimed—is taken without the leave and licence of the patentee. (a)

Thus in a recent case it was held that a claim for a process for stiffening incandescent gas mantles, which was limited upon its proper construction to the use of suitable materials which set by cooling, was not infringed by the use of other suitable materials which set by evaporation. (b)

Sometimes it is open to a patentee to claim more than he actually does claim, *e.g.*, he may be in a position to claim both a process and a machine, (c) or a result, (d) but he prefers to limit his claim to the one or the other and not to make it wide enough to include both. There are obvious dangers in making too wide a claim and there are obvious disadvantages in making it narrower than the patentee is obliged to do, having regard to the validity of the patent. (e)

Patentee may
fix the ambit
of his claim.

(z) Vol. II. p. 373.

(a) *Bradford Dyers Association v. Bury*, (1901) 19 R. P. C. 1; *Bunge v. Higginbottom & Co., Ltd.*, (1902) 19 R. P. C. 187; see p. 339 *post*.

(b) *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 757.

(c) See *Peters v. Owen*, (1899) 16

R. P. C. 83.

(d) *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1897) 14 R. P. C. 311, 312.

(e) *Ibid.*; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 17 R. P. C. 146.

Infringe-
ment.

It must also be remembered that what is not embraced by the claim is to be considered as disclaimed, and, consequently, open to all the world. (*f*)

Also, if a patentee in his specification points away from the use of a certain thing, he cannot complain of its adoption by an alleged infringer. (*g*)

No infringe-
ment of the
equity of a
patent.

Formerly there used to be an idea that it was possible to infringe upon the equity of a statute. If it were not possible to show that the words of the statute had been infringed, it was contended that the equity had been invaded; and, similarly, by a confusion of ideas a notion was prevalent that there might be an infringement of the equity of a patent. There is, however, no sound principle of this kind in the patent law; that which is protected is that which is specified and claimed, and that which is held to be an infringement must be an infringement of that which is specified and claimed, though it may not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding. (*h*)

Intention and
its effect.

It is not material to consider the intention of a person who commits an infringement of a patent; (*i*) evidence of intention may be material for the consideration of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, an infringement is committed. (*j*) An infringer is liable for what he does, not for what he intends; (*k*) and there may be an indirect infringement, as well as a direct one, though the intention of

(*f*) *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 581; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 741; *Jackson v. Wolstenholmes*, (1884) 1 R. P. C. 108; *Lucas v. Miller*, (1885) 2 R. P. C. 159; *Easterbrook v. G. W. Ry. Co.*, (1885) 2 R. P. C. 208; *Ticket Punch Register Co. v. Colley's Patents*, (1896) 12 R. P. C. 171; *Nobel's Explosives v. Anderson*, (1894) 11 R. P. C. 128, 525, 526; *Davies v. Townsend*, (1899) 16 R. P. C. 497; *Ashworth v. English Card Clothing Co.*, (1901) 18 R. P. C. 367; 20 R. P. C. 790; *Pilkington v. Massey*, (1904) 21 R. P. C. 709.

(*g*) *Nobel's Explosives Co. v. Anderson*, (1895) 12 R. P. C. 164; *Morris v. Young*, (1895) 12 R. P. C. 466.

(*h*) *Dudgeon v. Thomson*, (1874) 30

L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C. See also per Smith, L.J., *Ticket Punch Register Co. v. Colley's Patents*, (1895) 12 R. P. C. 185; *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1889) 14 R. P. C. 311, 312; p. 432 *post*.

(*i*) *McCormick v. Gray*, (1861) 7 H. & N. 25, 39; 31 L. J. Ex. 42; *Heath v. Unwin*, 15 Sm. 552; *Stead v. Anderson*, 2 W. P. C. (1847) 156; 4 C. B. 834; *Seed v. Higgins*, (1858) 5 Jur. N. S. 540; 8 E. & B. 771; *Young v. Rosenthal*, (1884) 1 R. P. C. 29, 39.

(*j*) 2 W. P. C. 227 *n*.

(*k*) *Stead v. Anderson*, (1847) 2 W. P. C. 156; 4 C. B. 834; *Newall v. Elliott*, (1864) 10 Jur. N. S. 954; *Nobel's Explosives Co. v. Jones*, (1882) L. R. 8 App. Cas. 12, 13.

the party be perfectly innocent, (*l*) and even though he may not know of the existence of the patent itself, (*m*) or that the thing he was dealing with was an infringement. (*n*) Neither is it a sufficient answer to a motion to commit, for breach of an injunction, to say that the defendant did not intend to infringe; (*o*) nor is ignorance a valid defence. (*p*)

Infringe-
ment.

Evidence of intention may be of some value to a jury in dealing with the question whether an infringement has taken place or not; (*q*) and also the Court takes it into account when deciding whether to grant or refuse an injunction, (*r*) and how to deal with the cost of the action. (*s*)

Jessel, M.R., in a case of infringement of copyright, stated that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, nor omission or neglect which would induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. (*t*)

On the other hand, where the defendant was a retail dealer who unwittingly sold articles which were an infringement of the plaintiff's patent, *James*, V.C., held that he was not liable for the costs of an action to restrain the infringement, if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more. (*u*) And, adopting the same principle, Lord *Hatherley*, in a trade-mark case, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery, and gave all information in their power immediately on being informed

(*l*) *United Telephone Co. v. London, &c., Telephone Co.*, (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; *Adair v. Young*, (1879) L. R. 12 Ch. D. 13.

(*m*) *Heath v. Unwin*, (1854) 2 W. P. C. 228, 315; 5 H. L. C. 505; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Young v. Rosenthal*, (1884) 1 R. P. C. 39; *Saccharin Corporation, Ltd. v. Reitmeyer*, (1900) 17 R. P. C. 612.

(*n*) *Walton v. Lavater*, (1860) 8 C. B. N. S. 162; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Geary v. Norton*, (1846) 1 De G. & S. 9; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302.

(*o*) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286, 288.

(*p*) *Upmann v. Forrester*, (1883) L.

R. 24 Ch. D. 231; *Wittman v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Walton v. Lavater*, (1860) 8 C. B. N. S. 162; *Geary v. Norton*, (1846) 1 De G. & S. 9; *Young v. Morris*, (1894) 11 R. P. C. 617.

(*q*) *Heath v. Unwin*, (1845) 2 W. P. C. 227 *n.*; see above.

(*r*) p. 488 *post*.

(*s*) p. 512 *post*.

(*t*) *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 501; see also *Upmann v. Forrester*, (1883) L. R. 24 Ch. D. 231.

(*u*) *Betts v. Wilmott*, (1870) 18 W. R. 946; *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595; see also *Jenkins v. Hope*, (1895) 13 R. P. C. 57.

**Infringe-
ment.**

Act done under subsequent patent is an infringement of a prior patent for the same invention.

Necessity for a determination of the exact invention protected.

thereof, were not liable to the costs of an action brought to restrain the sale of such cigars. (v)

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an infringement of that which bears the earliest date; (x) and if an invention is shown to be new and useful, the fact that it is much more useful with a subsequent improvement affords no ground for infringing the original invention by using it with the subsequent improvement; (y) neither can the infringer escape liability on the plea that the later patent was unsuccessfully opposed before the Comptroller by the plaintiff in the action. The proceedings before the Comptroller are irrelevant and immaterial to the action. (z)

In determining whether an act complained of is really an infringement of a patent or not, it is always most important to ascertain from the specifications what is the exact invention protected. If this invention is taken by the defendant, an infringement is committed, and it will not save the defendant from the consequences that, though he has taken the invention, he has dressed it up colourably, added something to it, or taken something away from it, provided that of the whole it can be said that the machine or process is either the plaintiff's or differs from it only colourably. (a) Thus in a chemical case, where the plaintiff claimed the use of a mixture of hydrocarbons obtained according to a defined process and distilling over between 170° and 200° C. for the purpose of preparing artificial musk, the use for the same purpose of one specific hydrocarbon boiling when pure at 200° to 202°, but small quantities of which would distill over from the

(v) *Upmann v. Elkan*, (1871) L. R. 7 Ch. App. Cas. 130.

(x) *Saxby v. Hennett*, (1873) L. R. 8 Ex. 210.

(y) *Thomson v. Batty*, (1889) 6 R. P. C. 84, 100.

(z) *Ticket Punch Register Co. v. Colley's Patents*, (1893) 12 R. P. C. 1, 15.

(a) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34; *Minter v. Wells*, (1834) 1 W. P. C. 134; *Stevens v. Keating*, (1847) 2 W. P. C. 181; *Muntz v. Foster* (1843) 2 W. P. C. 95; *Walton v. Potter*, (1841) 1 W. P. C. 585; *Gamble v. Kurtz*, (1846) 3 C. B. 425; *Trotman v. Wood*, (1864) 16 C. B. N. S. 479; *Hayward v. Pavement Light Co.*, (1884) 1 R. P. C. 207; *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61; *Walker*

v. Hydrocarbon Syndicate, (1885) 2 R. P. C. 8; *Sugg v. Bray*, (1885) 2 R. P. C. 233; *United Telephone Co. v. St. George*, (1886) 3 R. P. C. 321; *Richardson v. Castrey*, (1887) 4 R. P. C. 265; *Ellington v. Clark*, (1888) 5 R. P. C. 135, 319; *Wenham v. May*, (1887) 4 R. P. C. 303; *Proctor v. Bennis* (1887) 4 R. P. C. 333; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 198, 437; *Garrard v. Edge*, (1889) 6 R. P. C. 372, 563; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 528; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, (1889) 6 R. P. C. 121, 367; *Shaw v. Jones*, (1889) 6 R. P. C. 328; *Winby v. Manchester, &c., Steam Tramways Co.*, (1889) 6 R. P. C. 359, 365; 7 R. P. C. 30.

mixture produced by the patentee at the temperature indicated by him was held to be within the legitimate scope of his claim. (b)

The use of the word "colourable" or "colourably" in reference to an infringement is highly inappropriate, and apt to lead to great confusion, as connecting the idea that a patent may be infringed though the invention is not identically or substantially copied, if it is forgotten that the real question always is, Has the property of the patentee been taken? (c) The identity of the invention may be disguised, but there is no infringement unless what the infringer does is to take identically and substantially the patentee's invention. So a patent may be infringed by a colourable imitation, though there would be no infringement in the use of a mechanical or chemical equivalent. (d)

The question of infringement is really a mixed one of law and fact. (e) It is the duty of the Court to construe the specification and claims together, (f) and thus to ascertain what is the invention protected by the patent; and this question must be determined by the Court independently of a jury, expert, or other witness. This is a rule which is often lost sight of by counsel in examining witnesses. (g) Expert evidence may, however, be relied on to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of any differences between the plaintiff's invention and the alleged infringement, (h) as also the relative importance of the different parts of the invention, in order to ascertain whether the substance has been appropriated. (i) It is the duty of the Court to construe the specification quite apart from what the defendant has done.

Infringe-
ment.

Objection to
the use of the
word "colour-
able" or
"colourably."

Right way to
consider the
question of
infringement.

(b) *Fabriques de Produit's Chemique de Thann et de Mulhouse v. Lafitte*, (1899) 16 R. P. C. 61.

(c) See note (a), p. 338 *supra*.

(d) *Tweedale v. Howard and Boulough*, (1896) 13 R. P. C. 536, in conjunction with *Tweedale v. Ashworth*, (1892) 9 R. P. C. 121; also *Scott v. Hull Steam Fishing Co.*, (1897) 14 R. P. C. 143, in conjunction with *Scott v. Hamling*, (1897) 14 R. P. C. 123; *Tweedale v. Ashworth*, (1900) 17 R. P. C. 625; also p. 354, *post*.

(e) p. 265 *ante*; *Seed v. Higgins*,

(1860) 8 H. L. C. 555; *Curtis v. Platt*, (1866) 35 L. J. Ch. 852.

(f) p. 277 *ante*.

(g) *Brooks v. Steel*, (1896) 14 R. P. C. 47; pp. 458, 467 *post*.

(h) *Brooks v. Steel*, (1896) 14 R. P. C. 47.

(i) *Clark v. Adie*, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 302; *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 765; pp. 343, 458, *post*.

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ment.

The first canon of construction is that the specification must be construed, like all other written instruments or business documents, as if the Court had to construe it the day after it was published; and the Court is bound to construe the specification as if it had to be construed before the defendant was born, if the patent was before that time. (*k*)

Importance of
ascertaining
the principle
of the inven-
tion protected.

In this connection it is always most important to consider what is the principle of the invention. (*l*) The reader must observe that the word "principle," when thus used, is not intended to signify any of those first principles or laws of nature which cannot be the subject of a valid patent, (*m*) but is intended to mean a practical application of one or more of those first principles which is properly denominated an art by means of which articles of commerce may be manufactured; and an art of this description is that which must necessarily be the subject of every valid patent. (*n*) Thus, in the case of *Watt's* steam-engine, *Watt* invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. Whenever it can be shown that any act done without the sanction of the patentee comes, in this sense of the word, within the principle of the invention, the act is an infringement of the patent, for it necessarily implies that the art invented by the patentee has been used contrary to the prohibition in the grant. The law intends a patent to reward the patentee for his invention by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege by making some mechanical variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be frustrated, for no one would pay the patentee a profit for the patented article, if he could obtain an article substantially the same at a cheaper rate. (*o*)

(*k*) *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 523, judgment of Esher, M.R.

(*l*) *Chamberlain and Hookham v. Mayor, &c., of Bradford*, (1903) 20 R. P. C. 684; *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 765; *Sadow v. Szalay*, (1903) 21 R. P. C. 33, 333; 23 R. P. C. 6; *Lambert Co. v.*

International Phonograph Indestructible Record Co., Ltd., (1904) 21 R. P. C. 285; *Thomson v. Moore*, (1889) 6 R. P. C. 426, 450.

(*m*) p. 43, *ante*.

(*n*) p. 24, *ante*.

(*o*) *Hindmarch on Patents*, pp. 493, 494; *Thomson v. Moore*, (1889) 6 R. P. C. 426, 450.

Thus, when a principle in the above sense is invented and the infringer takes the principle and alters the details, and yet it is obvious that he has taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing, the Court can look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor. (*p*) In another class of cases, although a certain principle is common to a variety of manufactures, the subject-matter of the patent is really the particular mechanical mode by which that common principle is carried into effect, (*q*) and such patents are only infringed when the particular mechanical mode which is the subject-matter of the patent is copied.

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ment.

Adoption of
the principle
of the inven-
tion protected,
though details
differ, is an
infringement.

Crossley v. Beverley (*r*) may be given as an example of the point under discussion. In that case it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patented machine, the principles applied in the plaintiff's machine and in the defendant's being the same. The plaintiff accordingly obtained a verdict.

Baron *Alderson*, in a subsequent case, commenting on *Crossley v. Beverley*, said: "There never was a more instructive case than that. I remember very well the argument put by the Lord Chief Baron, who led the case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve. The scientific men, all of them, said the moment a practical scientific man has got that principle in his head he

(*p*) *Tweedale v. Ashworth*, (1892) 9 R. P. C. 126; *Moor v. Thomson*, (1890) 7 R. P. C. 325; *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 170; *Sellers v. Dickinson*, (1850) 5 Ex. R. 312, 324, in which cases the infringement was quite outside the speci-

fication, but not the invention; see also p. 280 *ante*.

(*q*) Per *Halsbury*, L.C., *Tweedale v. Ashworth*, (1892) 9 R. P. C. 126; *Curtis v. Platt*, (1863) L. R. 3 Ch. D. 135 n.

(*r*) (1829) 1 W. P. C. 106.

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can multiply without end the forms in which that principle can be made to operate." (s)

In short, if the pith and marrow—*i.e.*, substance—of the patentee's invention be taken, an infringement is committed, and such a taking is none the less actionable because the infringer has added something to the invention which constitutes an improvement. (t) Further, it is not proper for the Court to determine the question whether or not the substance of an invention has been taken upon a consideration of the specification alone. In addition to a consideration of the specification, the Court must also regard the evidence as to existing knowledge on the subject at the date of the patent, and as to the operation of the machine or process. (u)

It rarely happens that an infringer takes the identical thing described and claimed by the patentee. He usually modifies it or dresses it up with some additional matters. Nevertheless, if he has taken the substance or pith and marrow of the patentee's invention he is guilty of an actionable infringement, (v) and this notwithstanding the fact that everything done by the patentee since the date of the patent may be an improvement upon it. The question is whether the defendant has taken the substance or pith and marrow of the plaintiff's

(s) *Jupe v. Pratt*, (1837) 1 W. P. C. 146; see also *Chamberlain and Hookham v. Mayor, &c., of Bradford*, (1903) 20 R. P. C. 684.

(t) *Erlich v. Ihlee*, (1888) 5 R. P. C. 437; *Hayward v. Hamilton*, (1881) Griff. P. C. 115, 124; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740, 756; *Cannington v. Nuttall*, (1871) L. R. 5 E. & I. App. 205; 40 L. J. Ch. 739; *Neilson v. Harford*, (1841) 1 W. P. C. 310; *Russell v. Ledsam*, (1847) 14 M. & W. 579; *Bateman v. Gray*, (1853) Macr. P. C. 102; *Saxby v. Clunes*, 43 L. J. Ex. 228-241; *Thorn v. Worthing Skating Rink Co.*, (1877) L. R. 6 Ch. D. 415; *Plimpton v. Spiller*, (1875) L. R. 4 Ch. D. 286; *Curtis v. Platt*, (1863) L. R. 3 Ch. D. 135 n.; 35 L. J. Ch. 852; *Spencer v. Ancoats, &c., Co.*, (1889) 6 R. P. C. 46; *Thompson v. Batty*, (1889) 6 R. P. C. 81; *Thompson v. Moore*, (1889) 6 R. P. C. 428; 7 R. P. C. 325; *Wilson v. Barbour*, (1888) 5 R. P. C. 245, 675; *Nordenfelt v. Gardner*, 1 R. P. C. 61; *Automatic Weighing Machine Co.'s cases*; *Boyd v. Horrocks*, 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; *Montgomerie v. Paterson*, 11 R. P. C. 221, 633; *Wenham Gas Co. v. Champion Gas Lamp Co.*,

8 R. P. C. 373; 9 R. P. C. 49; *Actien Gesellschaft für Cartonnagen Industrie v. Schroeder*, 13 R. P. C. 466; *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 301, 559; *Proctor v. Bennis* (1877) L. R. 36 Ch. D. 740; *Clark v. Adie*, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315; *North British Rubber Co. v. Macintosh*, (1894) 11 R. P. C. 477; *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; *Lane v. Herold*, (1892) 9 R. P. C. 447; *English and American Machinery Co. v. Union Boot and Shoe Co.*, (1894) 11 R. P. C. 137, 367; *Chamberlain and Hookham v. Mayor, &c., of Bradford*, (1903) 20 R. P. C. 684.

(u) See *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 745, which contradicts the view expressed by Esher, M.R., in *Lyon v. Goddard*, (1893) 10 R. P. C. 341, and by Wills, J., in *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896), 13 R. P. C. 330; *Morris v. Young*, (1895) 12 R. P. C. 456, 461.

(v) See note (t) *supra*.

invention as claimed in his specification; and this invention may be infringed although the defendant uses it in conjunction with an improvement which is not within the ambit of the patentee's claim, (y) for in the pertinent words of Lord Bowen, "the superadding of ingenuity to robbery does not make the operation justifiable." (z)

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ment.

The relative importance of the different parts of the patentee's combination or process is a question to be settled by evidence. (a) The fact, if such be the case, that the patentee in the specification attaches an undue importance to the use of something, handicaps him, no doubt, in a contest as to infringement, but has no further weight, and the Court is free to exercise its own judgment in weighing this fact with others when dealing with the question of infringement. (b)

Relative im-
portance of
parts is a
question to
be settled by
evidence.

Though a claim to a process may mention *nominatim* the use of a specific thing, it may be none the less infringed by the adoption in the process specified of a manufacturing equivalent for the specific thing mentioned, when such specific thing is not of the essence of the invention—*e.g.*, the substitution of a depositing tank for the centrifugal separating machine mentioned in the claim for the patented process for the manufacture of lanolin. (c)

With regard to the true way in which to determine what is important and what is of subsidiary consequence in reference to the patentee's invention, the following passage from the judgment of Wills, J., in *Incandescent Gas Light and Coke Co. v. De Mare Incandescent Gas Light System*, (d) may be quoted with great advantage as dealing with some of the older cases on the subject:—

"It is contended by the defendants that what is important and what is of subsidiary consequence can only be gathered from the specification itself. I am satisfied that that neither is, nor can be, the law. Certainly *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34, which is cited as an authority to that effect,

(y) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34.

(z) *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1890) 9 R. P. C. 56.

(a) *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 765; *infra*.

(b) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 331; judgment of Wills, J.; but see *Bunge v. Higginbottom*, (1901) 18 R. P. C. 201,

judgment of Kekewich, J., which appears to conflict with the above judgment of Wills, J., and also with the dictum of Vaughan Williams, L.J., at 19 R. P. C. 193.

(c) *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson*, (1893) 11 R. P. C. 93, 261; see also *Aktiebolaget Separator v. Dairy Outfit Co.*, (1898) 15 R. P. C. 327.

(d) (1896) 13 R. P. C. 330.

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says nothing of the kind. 'Additions and subtractions,' says Lord *Cairns*, 'may exist, and yet the thing protected by the specification may be taken notwithstanding.' There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be infringement notwithstanding 'slight variations.' (e) 'So again,' says *Cotton*, L.J., (f) 'omissions and additions may be very material in considering whether, in fact, the machine of the defendant is an infringement of the combination which the plaintiff claims.' Omissions and additions may even be improvements, but that fact 'does not enable you,' says *Bowen*, L.J., 'to take the substance of the plaintiff's patent.' (g) 'If the instrument patented,' says Lord *Cairns*, 'consists of twelve different steps producing in the result the improved clipper, an infringer who had taken eight, nine, or ten of those steps might be held by the tribunal judging of the patent to have taken the substance, the pith and marrow of the invention, although there are one, two, three, four, five steps which might not actually have been taken.' (h) In such a case, as far as the specification went, the patentee would, under ordinary circumstances, treat the whole of the twelve steps as essential parts of his combination, and, so far as the specification went, there would be nothing to indicate that any one of them was not indispensable or was of less importance than the others. In *Proctor v. Bennis* there was nothing to indicate that the patentee thought the parts of his combination omitted or varied by the defendant of anything but cardinal importance. How was the question suggested by *Cotton*, L.J., whether the variations were 'slight' to be ascertained, except by evidence as to the relative importance of the variations in question as compared with the patented combination as a whole? 'There is, or may be,' says *James*, L.J., and *Mellish*, L.J., 'an essence or substance of the invention underlying the mere accident of form: and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated

(e) *Cotton*, L.J., in *Proctor v. Bennis*,
(1887) L. R. 36 Ch. D. 740-754.
(f) *Ibid.* p. 756.
(g) *Proctor v. Bennis*, (1887) L. R.

36 Ch. D. 756.

(h) *Clark v. Adie*, (1873) L. R. 2
App. Cas. 315-320.

form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.' (i) Drop the word 'combination,' which is perfectly immaterial as regards the principle, and every word is applicable to the present case. Mr. *Bousfield* says I am not entitled to take this as an accurate statement of the law, as the case went to the House of Lords, and no such doctrine is, as he contends, enunciated by the Law Lords. This, however, is a mistake. Lord *Cairns* expressly says: 'I am quite satisfied with the judgment of the learned Lords Justices, and I should have been content to rest the decision of this case upon that judgment, but for its importance.'" (k)

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In each case the substance of the invention and the principle of the machine and not the mere form are to be looked to. If what the defendant does is in principle not the same but really different there is no infringement; (l) and the question always is, not whether the substantial part of the process or combination said to be an infringement has been taken from the patentee's specification, but the very different one, whether what is done or proposed to be done takes from the patentee the substance of his invention as claimed. "A process might be wholly gathered from a specification and nowhere else, and yet be no infringement if it did not take substantially the thing invented." (m)

Substance and principle of the invention is always the important question.

Thus a person may be entitled to take the pith and marrow in one sense of the patentee's invention; (n) what he is not entitled to do is to take its substance. The term "pith and marrow" used by Lord *Cairns* and many Judges since is, as *Wills, J.*, has pointed out, not so good a one to use as "substance of the invention," for it is very easy to misapply it, and it would be very likely to mislead a jury. To quote *Wills, J.*, again: "'Pith' is a great deal less than the substance of the vegetable structure of which it is part, and 'marrow' is a great deal less than the substance of the

Though it may be lawful to take the pith and marrow in one sense of a patented invention, it is never lawful to take its substance without licence.

(i) *Clark v. Adie*, (1873) L. R. 10 Ch. App. 667-675.

(k) (1877) L. R. 2 App. Cas. 326; see also *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 765.

(l) *Morgan v. Seaward*, (1836) 1 W. P. C. 171; *Ferranti v. British Thomson-Houston Co., Ltd.*, (1902) 19 R. P. C. 147; 20 R. P. C. 145; see also p. 280 *ante*.

(m) Per *Wills, J.*, *Incandescent Gas Light Co. v. De Mare Incandescent*

Gas Light System, (1896) 13 R. P. C. 330; see also *Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre and Capon Heaton, Ltd.*, (1897) 15 R. P. C. 74. 237; 16 R. P. C. 77; *Allen v. Abraham Pyatt & Co.*, (1898) 15 R. P. C. 723; 16 R. P. C. 135.

(n) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1896) 13 R. P. C. 345; *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1897) 14 R. P. C. 303.

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animal structure of which it is part. Metaphors are very apt to mislead, as they are seldom close enough to the things to which they are applied." (o)

The "pith and marrow" of the *Welsbach* process of gas illumination is the construction of a mantle or skeleton of materials which will incandesce when subjected to the heat of a flame, but the "substance" of the invention claimed in the *Welsbach* specification is moulding the illuminant into shape by a certain chemical process of reduction from salts of substances mentioned by the patentee or substances substantially the same as those, with the necessary consequence that the skeleton is homogeneous throughout. It has been held that it is no infringement of this claim to produce a mantle which will incandesce, by a process consisting in first forming a mantle of alumina and zinconia homogeneous throughout and strong, but giving little incandescence, and secondly, coating this with a thin layer of oxide of chromium, which incandesces well, and is not a substance substantially the same as those mentioned and claimed by the patentee. In such a structure the illuminant is not (as in the *Welsbach* process) that portion of a homogeneous mantle which is exposed to the flame, but a foreign substance laid on in a thin film and quite absent from the bulk of the skeleton. Though this is an appropriation of the pith and marrow of the *Welsbach* invention, it is not such a taking of the substance of it as will constitute an infringement of the claim. The patentee did not and could not claim the formation of a skeleton by other means and of other substances than those pointed out in the specification, or by means substantially identical and apart from the contemporaneous formation of the illuminants, and so the Court was reluctantly compelled to hold that there was no infringement. (p)

On the other hand, it has been held that to vary by omission and alteration the non-essential details of the chemical process claimed in the *Welsbach* specification, but at the same time to produce an illuminant which is homogeneous throughout, though in a form of a fringe of threads instead of a mantle as described in the specification, is to take the substance of the *Welsbach* invention and so to commit an infringement. (q)

(o) Per Wills, J., *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. O. 332.

(p) *Incandescent Gas Light Co. v.*

Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 345.

(q) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 301, 559.