

claimer as to any part of the invention of the use of the hot-air blast which was covered by *Neilson's* patent. The specification expressly says:—‘I take the whole of the invention already well known to the public, and I combine it with something else.’ It was further argued that, in point of law, no patent can be taken out which includes the subject-matter of a patent still running and in force. No authority was cited to support this position; and the case (*Lewis v. Davis*, 3 C. & P. 502) in which Lord Tenterden held, that where an action was brought for an infringement of improvements in a former patent granted to another person, and still in force, the plaintiff must produce the former patent and specification at the trial, affords a strong inference that the second patent was good. The case also of *Harmer v. Playne* (11 East, 101) is a clear authority to the same point; and upon reason and principle there appears to be no objection. We think that judgment must be given for the plaintiff.

CROFTS *against* PEACH, A.D. 1836. 2 Hodge R. 110.

Inspection.

CASE for the infringement of a patent for making lace by machinery. Rule, to compel the production of a specimen of lace made by the patent machine, refused by the Court of Common Pleas. (Tindal, C.J., Park, Vaughan, Bosanquet, JJ.)

Per TINDAL, C.J.—The object of this application is to ascertain the evidence which the plaintiffs will produce at the trial. The defendants may plead that the invention is not new, if that is the fact. The specification gives the necessary information.

ROLL *against* EDGE, A.D. 1847–50. 9 C.B. 479.

Variance between the Title and Specification.

CASE for the infringement of a patent of 7th *March*, 1844, No. 10,096, to *A. A. Croll* and *W. Richards*, for ‘improvements in the manufacture of gas for the purpose of illumination, and in apparatus used when transmitting and measuring gas.’ Pleas: 2. *Non concessit*. 4. That the specification was insufficient. 6. That the invention specified was another and a different invention from that for which the patent was granted, whereby the patent became void. 7. That the invention was not an improvement in the manufacture of gas. Issue.

The patent related to improved methods:—(1) of manufacturing gas; (2) of setting and heating retorts; (3) of making retorts by pressing clay into moulds; (4) of measuring gas.

At the trial, it appeared that the specification as enrolled recited a patent for ‘improvements in the manufacture of gas for the purpose

of illumination, and in apparatus used *therein and* when transmitting and measuring gas;’ and it was contended, on behalf of the defendant, that the insertion of the words ‘*therein and*’ extended substantially the grant of the Crown, whereby the patent was rendered void. Verdict for defendant on 4th, 6th, and 7th issues; the jury discharged as to the other issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of Common Pleas.

Per MAULE, J.—The patent was properly described in the declaration as a patent for ‘improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas.’ A specification was enrolled, reciting the grant of a patent, with the additional words ‘*therein and,*’ interpolated between ‘used’ and ‘when.’ The insertion is slight as to the number of words, but it adds most materially to the meaning of the sentence, and extends substantially the grant of the Crown. The title did not profess to comprehend improvements in any apparatus used in making gas. The patentees, in representing to the Crown the nature of the invention which they had discovered, did not give the Crown notice that they claimed the exclusive use of any apparatus for making gas. When the body of the specification is looked at, one main part of the patentees’ claim consists of what may be, and probably is, a new mode of manufacturing clay retorts—an apparatus used in the manufacture, and not in the transmitting and measuring of gas. No patent at all has been granted to them for that. It seems to us that they have specified for a more extensive and a different patent from that which was granted to them. We therefore think the specification insufficient, and that the objection properly arises on the 6th plea. Probably, *non concessit*, or the 4th plea, would equally raise the defence.

CROMPTON *against* IBBOTSON, A.D. 1828. Dan. & L. 33.

Specification bad for misleading.

CASE for the infringement of a patent of 1st Nov. 1820, No. 4,509, to *T. B. Crompton*, for ‘improvements in drying and finishing paper.’ 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.’

At the trial, one of plaintiff’s witnesses 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.’ BAYLEY, J. nonsuited plaintiff.

Rule nisi to set aside the nonsuit refused by the Court of King's Bench.

Per LORD TENTERDEN, C.J.—The patent was obtained for the discovery of a proper conducting medium. The plaintiff found after repeated trials that nothing would serve the purpose except the cloth described in his specification, yet he says that the cloth may be of any suitable material, and merely that he prefers the particular kind there mentioned. Other persons, misled by the specification, may be induced to make experiments which the patentee knows must fail; the public therefore has not the full and entire benefit of the invention—the only ground on which the patent is obtained. In *Turner v. Winter* (1 T. R. 602) a patent was held void on the ground of an ambiguity in the specification like the present.

CROSSKILL *against* EVORY, A.D. 1848. 10 L.T. 459.

Practice in Patent Suits. Separate proceedings against Infringers.

Suit to restrain from infringing a patent of 8th *Sept.* 1841, No. 9,082, to *W. Crosskill*, for improvements in machinery for rolling and crushing land. It appeared that plaintiff had already brought two separate actions against infringers, and had in each case established the validity of his patent. LORD LANGDALE, M.R. nevertheless ordered an action at law, saying that he did not think he could bind the defendant by proceedings which had taken place between the plaintiff and other parties.

CROSSLEY *against* BEVERLEY, A.D. 1829. 3 Car. & P. 513; }
1 Russ. & M. 166 n.; 1 Webs. Pat. Ca. 106. }

Validity of Patent where Improvements are made before specifying. Sufficiency of Specification. Extent of Protection by Injunction.

CASE for the infringement of a patent of 9th *Dec.* 1815, No. 3,968, to *S. Clegg*, for an 'improved gas apparatus.' Plea: Not guilty. Issue.

The patent related to apparatus for 'extracting inflammable gas by heat from pit coal, tar, or *other substance* from which gas or gases capable of being employed for illumination can be extracted by heat.' It also related to a *water-meter* for measuring the supply of gas. The meter was formed of a hollow wheel, divided into chambers, and partly immersed in water. The flow of gas filled one chamber while another was being emptied, and caused the wheel to rotate on its axis, so as to record and measure the quantity of gas which passed through the apparatus.

At the trial, it appeared that gas could not be made from oil by the plaintiff's apparatus, although oil would produce an inflammable

gas. The inventor, Mr. *Clegg*, was called, and stated that he had invented some of the mechanical parts which were described in the specification at times subsequent to the date of the patent, but that during this interval he had in his mind a general idea of the whole apparatus. It was objected that the gas-making apparatus was incomplete for want of a condenser.

LORD TENTERDEN, C.J. said:—In reading this specification it is clear that the words ‘other substance’ coupled with the words ‘pit coal and tar,’ mean other substance *ejusdem generis*. One must understand this person to speak of things which were known and used at the time. He could not possibly mean oil gas; it had never been used because of the great expense. A workman who was capable of making a gas apparatus would know that he must put in a condenser. The specification does not tell you to leave it out. There is nothing in that. Verdict for plaintiff.

Rule for a new trial, on the ground that the specification was for an invention differing from that for which the patent was granted, refused by the Court of King’s Bench. (Lord Tenterden, C.J., Bayley, Littledale, JJ.)

Per LORD TENTERDEN, C.J.—It appears that the person’s mind was directed to the invention, and that in the interval between the taking out of the patent and the enrolling of the specification he perfects it in some of the mechanical parts. The question is, Will that make his patent void? No case has so decided, and it would be a very great hardship if it were so. Indeed, I do not see why any time is allowed to the inventor to prepare his specification, unless it be to allow him to mature the mechanical parts of the invention.

Per BAYLEY, J.—It is not only the duty of the inventor to state what he knew at the time of the patent, but the public have a right to be put in possession of all that he knows at the time of the specification.

(1 Russ. & M. 166, *n*.) Suit to restrain from infringing the same patent. It appeared that the patent was about to expire, and that defendant had accumulated a large stock of patented gas-meters, ready to be thrown on the market as soon as the monopoly was at an end. LORD LYNDHURST, L.C. granted an injunction to restrain the sale of such meters both before and after the term limited by the grant of the patent.

CROSSLEY *against* THE DERBY GAS COMPANY, A.D. 1829–38. }
4 L.J. Ch. 25; 3 Myl. & Cr. 428. }

Practice in Patent Suits. Extent of Protection granted to a Patentee.

Suit to restrain from infringing the same patent. It appeared

that the bill was filed on 28th *Nov.* 1829, and that the patent expired on 9th *Dec.* 1829. Injunction granted by the Vice-Chancellor, who directed the account to be carried back for six years from the date of filing the bill. On appeal, decree affirmed with costs.

Per LORD BROUGHAM, L.C.—It was objected that the Court would not interfere just on the eve of the expiration of a patent and grant an injunction which would only last a week. The point has never yet been decided; but I am of opinion that the Court would interfere, even after a patent has expired, to restrain the sale of articles manufactured previous to its expiration, in infringement of a patent right; and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy; thus reaping the reward of his improbus labour. The Court would, I say, in such a case restrain him from selling them even after the expiration of the patent.

The report in *Myl. & Cr.* refers to matters of computation in carrying out the order of the Court.

CROSSLEY and OTHERS *against* POTTER and OTHERS, A.D. 1853. }
 Macrory's Pat. Ca. 240. }

Subject-matter of a Patent. Sufficiency of Specification. Parol Evidence of Patentee.

CASE for the infringement of a patent of 28th *Dec.* 1842, No. 9,573, to *T. Thompson*, for 'improvements in weaving figured fabrics.' Plea 3. That the specification was insufficient. Issue.

The patent related to apparatus for inserting and withdrawing the wires used in weaving terry fabrics. The specification stated:—'The operation will be better understood by reference to the accompanying drawings, which represent *parts of a loom for weaving coach lace.* It then described the mechanism as applied to weaving coach lace,' and went on to say, 'I do not intend to confine myself to narrow goods only, as this improved means of weaving *may also be adapted to the production of carpets.*' *Claim* (in substance): The weaving of terry fabrics by means of tags or wires attached to moveable arms, such arms being shifted at intervals and made to introduce and withdraw the wires.

At the trial, it appeared that a loom, made as specified, could not be adapted for the weaving of carpets by a mere widening of the parts; also, that a carpet loom made by plaintiffs according to the patent had certain parts (alleged to be well known) added thereto, in order to make it available for carpet weaving. At the close of plaintiffs' case, POLLOCK, C.B. was of opinion that the action was not

maintainable, if, upon the evidence as it then stood, the jury should find that the invention, as specified, was not capable of coming into practical use for the weaving of carpets. To guide the jury the learned judge proceeded to discuss this evidence, observing:—‘The truth appears to me to be this, that the patent is very much like what has often been attempted, viz., to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. It is very true that patents are continually taken out for what are called *methods* or *processes*; but the real object of the patent, the real end that is secured by the statute, the matter that is alone mentioned in it capable of being made the subject of a patent, is a new manufacture; and everybody who takes out a patent under the name of a process, really takes it out for that which is the result of the process, for the thing that is manufactured, or the process by which it is produced. Whatever principle you have invented or applied, you must have it embodied in some machine or manufacture distinctly, in order that other ingenious and enterprising members of the community may distinctly know what it is they are prohibited from doing. This patent is taken out for the making of coach lace, carpets, and velvets of all sorts, and it must be competent to do all and every part of that work by the means stated in the specification; otherwise the patent is not good.

‘A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the introduction of other inventions adapted to the particular subject to which the invention may be applicable, cannot, in my judgment, be supported.’

The jury consulted together, but did not agree, and the case proceeded.

The patentee then was examined, and was asked what the invention was for which he had taken out a patent. Question objected to; but the learned judge ruled that it was admissible, and said:—‘The specification shows the invention that is specified, but there must be some mode of getting at the fact of what the invention really was. The specification cannot be conclusive evidence when it may be fraudulently prepared.’ It then appeared that *Thompson* was the inventor of a loom for weaving coach lace, and knew nothing about carpet weaving. Before specifying, he sold the patent to other parties, who drew the specification, and described the machinery as being applicable to the weaving of carpets as well as of coach lace.

POLLOCK, C.B. directed the jury:—The direction I shall give you is simply that, if you believe the evidence of Mr. *Thompson*,

your verdict should be for the defendants, who have merely used in carpet weaving something like what is described in the specification. In my mind the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing; and a jury will always take care that, if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius.

Verdict for defendants.

CROSSLEY *against* STEWART, A.D. 1863. 1 N.R. 426.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing a patent for the manufacture of looms. Plaintiffs interrogated defendant as to the sums of money received by the sale of looms made in infringement of the patent, and required discovery as to the names and addresses of the persons to whom such looms had been sold. It appeared by the answer that looms had been sold to persons residing at *Leipsic*, but no information was given as to their names and addresses. The answer being excepted to, Wood, V.C. said that the answer sought might lead to important discoveries by the plaintiffs in regard to the infringement of their patent. The interrogatory must be answered, except, of course, as to looms manufactured in foreign countries, and sold to persons residing there.

CROSSLEY and OTHERS (*Appellants*) *against* DIXON (*Respondent*). }
A.D. 1863. 10 H.L. Ca. 293. }

Estoppel of Licensee.

Suit to restrain from infringing certain patents. Appeal from an order of the Lords Justices. It appeared that respondent agreed verbally with appellants to be supplied by them with carpet looms constructed according to certain patents of which they were owners, and to pay royalties for the use of the inventions incorporated therein. Respondent afterwards used other carpet looms, upon which appellants claimed a royalty as embodying the patent inventions; and this user constituted the infringement complained of. Respondent denied—(1) that the agreement amounted to a licence; (2) that the patents were valid; (3) that there had been any infringement. Wood, V.C. made a decree in favour of appellants, directing an inquiry only on the question of infringement. The Lords Justices retained the decree, but ordered the appeal to stand over till after appellants had brought ‘any action they might be advised.’ On appeal to the House of Lords, the decree of the Vice-Chancellor was affirmed, with a verbal alteration limiting the

declaration under that decree, and the order of the Lords Justices was discharged, with costs.

Per LORD WESTBURY, L.C.—The agreement subsists at the present moment, and the respondent is using the machines which he so bought, and is recognising his relation as licensee of the appellants by paying the appellants the royalty, a payment that can be attributed to nothing but the patent rights, in respect of which these machines have been constructed.

Now the first contention on the part of the respondent is this, that, notwithstanding that relation continues, he is at liberty to deny the title of the appellants to the ownership of the inventions for the use of which he is thus paying a royalty. We are all very well aware that that is a proposition inconsistent with the law, as it would be equally inconsistent with the ordinary reason and good sense of mankind. But then it appears that the respondent has obtained from a different quarter other machines which are apparently, according to the evidence, identical in construction and principle with the machines supplied to him by the appellants; and in respect of the user of these latter machines, it is contended, on the part of the respondent, that he is at liberty to affirm that those machines are no invasion of the plaintiff's patent—(1) because he denies the validity of the patent; (2) because he affirms that the machines are different in construction and principle from the machines so made and supplied to him by the appellants. Now, my Lords, assuming that the second set of machines is identical in construction with the first, it would be impossible to hold that the obligation not to deny the appellants' patent right would not extend to the second set of machines so long as he continues to use the first set of machines, which is the fact at present. That is equally a question of law, and a question of ordinary principle.

The whole decree of the Vice-Chancellor is of course founded upon the continuance of the existing relation of licensor and licensee; for it is an idle distinction which is attempted to be set up by the respondent that he made an agreement and did not take a licence. But that licence being the foundation of the claim, and being of course determinable by the respondent at pleasure, I would submit that this general declaration ought to have been qualified by the introduction, after the words 'the defendant is not entitled,' of some such words as these, 'whilst he continues to use the machines bought of the plaintiffs under the agreement, or during the continuance of the agreement between the defendant and the plaintiffs.' But that alteration ought not, as I humbly submit to your Lordships, to affect the question of costs.

CURTIS and OTHERS *against* CUTTS, A.D. 1839. 8 L.J. Ch. 184; }
 2 Coop. Ch. Ca. 60. }

Practice in Patent Suits where Enjoyment of Patent is not exclusive.

Suit to restrain from infringing a patent for making wire cards. *Ex parte* injunction granted by the Vice-Chancellor, who declined, on the coming in of the answer, to dissolve the injunction. The answer denied the novelty of the invention and the enjoyment under the patent, which had been in force for nearly fourteen years, but admitted the infringement, and alleged that the specification was imperfect and fraudulent. On appeal, injunction dissolved, with liberty to bring an action.

LORD COTTENHAM, L.C. said:—The bill does not state such a case as to justify the granting of an injunction. The answer disputes the validity of the letters patent, and states that the alleged invention is not new, and that the specification is imperfectly set forth; on the other hand, the plaintiffs contend that there has been a long possession and enjoyment under the patent.

This Court gives credit, no doubt, to long enjoyment under letters patent, until it is proved that they are bad; but then there must be not only enjoyment, but exclusive enjoyment under them. (*Hill v. Thompson*, 3 Meriv. 622.) The allegations in the answer negative the exclusive enjoyment claimed by the plaintiffs. I think the right course is not to restrain the defendant, but to give the plaintiffs the opportunity to try the question at law.

The report in Coop. Ch. Ca. is the following:—‘The rule upon which the Court acts in granting an injunction where the validity of the patent alone is disputed, requires not merely that there shall have been possession and enjoyment under the patent, but that such possession and enjoyment shall have been undisturbed and exclusive. Here the answer negatives an exclusive possession of the privilege to make the machines. It states that since the patent was granted, persons not claiming under the patent have manufactured machines upon the principle sought to be protected by it. There is an end, therefore, of the case of exclusive possession and enjoyment.’

CURTIS *against* PLATT, A.D. 1863. 8 L.T. N.S. 657; 33 L.J. C.P. 255; }
 11 L.T. N.S. 245; 35 L.J. Ch. 852; L.R. 1 H.L. 337. }

Sufficiency of Particulars of Objections. Practice as to Costs where an Action is abandoned. Evidence of Infringement. Mechanical Equivalents.

Suit to restrain from infringing a patent of 10th Nov. 1854, No. 2,393, to *J. Wain*, for improvements in ‘mules.’ The particulars of objection alleged—(1) prior user of the invention by certain specified persons, and by others who were not specified; (2) prior

user by thirteen persons or firms, from A.D. 1825 downwards, giving merely the places of residence of the persons referred to; (3) prior publication in books, &c., with a general reference.

Wood, V.C. ordered defendant to furnish better particulars under the second and third heads only, and said that as to the first point, the Court would know perfectly well how to protect the plaintiff from the effect of a surprise. As to the second point, he was quite clear that the particulars ought to be amended. The object of having these statements reciprocally furnished by the parties, was that each might know what were the particular instances of breach, or of prior user, or publication, on which the other intended to rely. He felt sure that in this case the defendants would be able to give with more precision the date of user and the place of use of the machines to which they referred, and so far as these facts were concerned, they were bound to give the plaintiff all the information they themselves had. On the third point, they must, instead of giving a general reference, state the particular work or document, and the volume of that work in which the alleged prior publication was to be found. Costs to be costs in the cause.

(33 L.J. C.P. 255.) The report refers to the allowance of costs in preparing for the trial of an action for infringement of the same patent, where plaintiff discontinued before issue joined, and without having given notice of trial. The master, in taxing defendant his costs, refused to allow such as were incurred in preparing for trial.

Rule nisi for the master to review his taxation, discharged by the Court of Common Pleas. (Willes, Byles, Keating, JJ.)

(11 L.T. N.S. 245.) The report carries on the history of the suit. The patent related to improvements applicable to mules constructed according to a patent of 12th Oct. 1849, No. 12,805, to *R. Lakin* and *W. H. Rhodes*, and the object of the invention was to effect certain changes in the action of the mule without the intervention of an eccentric boss, and rods and levers, as described in the patent of *Lakin* and *Rhodes*. The specification described the apparatus by reference to drawings, and showed a solid shaft, running completely through a hollow shaft, called a *change* shaft, on which were cams intended to be rotated at certain periods. The solid shaft was the driver, and at the extreme end of it was placed a *catch* or clutch-box made in two halves, one half being attached to a spiral spring, and capable of sliding along the solid shaft but revolving with it, the other half being keyed to the hollow shaft. The action of the spring brought the two halves together, and the hollow or *cam* shaft would thereby rotate until they were separated. The intervals of separation or rest were produced by the pressure of a sliding pin,

moving in a hole bored through the boss of one half of the clutch-box, and sufficiently long to disengage the driving half when pushed against it. A disc or plate at the back of the driven half of the clutch-box was provided with two projecting circular inclines, intended to press the loose pin sufficiently to liberate the clutch-box. This plate had a large opening or slot in the centre to admit the hollow shaft, and could be moved vertically up and down through a small space by the action of a lever arm. The pin was shown in the drawing as resting on the lower incline, and forcing the clutch-box out of gear. The motion of the carriage then depressed the plate, and the pin fell off the incline, whereby the spring brought the two halves of the clutch-box together, and the cam shaft rotated, until the pin came upon the upper incline, and brought it to rest. After an interval the lever raised the plate, and the action was renewed.

Claims: 1. The novel construction, combination, and application of mechanism, as hereinbefore described, whereby one half of the clutch-box, hereinbefore and in the said specification of *Lakin* and *Rhodes* described, or any mechanical equivalent therefor, is connected with and acts upon cams for effecting changes in the action of the mule, direct, and without the intervention of such eccentric boss, and rods, levers, or other mechanical agents combined therewith, as are described by *Lakin* and *Rhodes*, in their said specification.

2. The arrangement and combination of the lever described, and the parts connected therewith, for causing the *catch* box to be put into gear, and also the means or mode described of giving motion to the *change* shaft.

It should be noted that the mechanism of the clutch-box, and of an incline with a pin for disengaging its two halves, was part of the patent of *Lakin* and *Rhodes*, whose specification showed the change shaft, on which were fitted two halves of a clutch-box. To the half which revolved loose an eccentric boss was fixed, and there was a sliding pin passing through the boss. During the revolution of the clutch-box this pin was brought against a fixed incline, and was forced outwards against the driving half of the clutch-box so as to press it away from engagement with the other half.

The alleged infringement consisted in the use of machinery constructed according to a patent of 13th *April*, 1860, No. 922, to *J. Platt*, for a method of giving intermittent motion to the cam shaft of mules. In this apparatus one half of a clutch-box rode loose upon the cam shaft, and the other half was capable of sliding on the shaft, but revolved with it. To this latter half was affixed a plate, having upon its face a number of recesses (four being shown), which gave the required changes. At the end of each recess was an incline. A

pin at one end of the arm of a rocking lever actuated by a tumbler, entered the recess, and ran up the incline as the shaft rotated. One half of the clutch-box was pressed against the other half by a spiral spring, which held the two parts together until the pin came upon the incline and separated them by the pressure caused thereby. The cam shaft then stopped in a definite position, determined by the end of the recess, and did not rotate again until the action of the tumbler withdrew the pin and allowed it to fall into the next recess, and to set up another period of rotation.

At the trial, before Wood, V.C. without a jury, his Honour found on the fifth issue—viz. whether defendant had infringed the patent of *Wain*—in favour of defendant, and on the remaining four issues as to the validity of the patent in favour of plaintiff. The cause came before the Lord Chancellor on motion by plaintiff, to alter the finding on the fifth issue, or for a new trial, with cross motion by the defendant as to the remaining issues. Decree affirmed; appeal dismissed with costs; cross appeal, by consent, dismissed without costs.

Per LORD WESTBURY, L.C. — For the efficient agency of this machine (*a mule*) it has been found necessary that there should be a shaft with cams upon it, and it has also been found necessary that there should be some means of arresting the shaft, staying the shaft once or twice, or even four times, during a single rotation, thereby producing breaks or pauses for spaces of time in the rotatory motion of the shaft. These pauses or breaks have been at various times attempted to be produced in various ways. Mr. *Roberts* had one mode, namely, by the operation of a wheel with spaces. That proving not adequate to the end, another mode was discovered of breaking the rotatory motion, producing pauses in the rotation by the operation of a clutch-box. The application of that to the shaft was made, as far as I am informed, in the first instance by the patent of *Lakin* and *Rhodes*. Mr. *Wain* then applied himself to what he denominates ‘an improvement upon the patent of *Lakin* and *Rhodes*.’ Now it has been vigorously contended before me, that I am not to take Mr. *Wain*’s invention as he himself describes it, and that I ought not to allow him to be limited to his own description of its being an improvement; that I ought to take his invention as containing in itself a new and original principle. I cannot so take it. I must take Mr. *Wain*’s patent as being specific mechanism, directed to a certain end that was previously well known, directed to facilitate a certain result, the benefit of which had long been discovered, directed to produce in a more simple and easy manner a particular operation of the clutch-box, which was itself only a means to an end. I cannot but think that in patents of this description the doctrine of mecha-

nical equivalents is not by any means applicable. The thing itself is nothing more than a particular agent for attaining a certain end, and if Mr. *Wain* was entitled to a patent for the particular agency by which he effected, in a more convenient manner, the opening and shutting of the clutch-box, any other person is on the same principle entitled also to a patent for the means of effecting the same result, provided those means are not a colourable evasion of Mr. *Wain's* patent, or provided those means do not embody Mr. *Wain's* patent with an improvement.

Mr. *Wain's* desire was to bring the clutch-box into action more than once during the rotation of the shaft. At a short distance from one of the discs of the clutch-box he put a plate upon the solid shaft, which plate was not fixed as the plate in *Lakin* and *Rhodes's* patent, but admitted of being moved upon the shaft vertically up and down. On that plate he raised not one incline, which *Lakin* and *Rhodes* had done, but two inclines. Upon this plate he in like manner, as in the case of *Lakin* and *Rhodes*, causes a moveable pin to rotate, but it does not rotate always in the same circle, but rather in the arcs of two circles, the circle being varied by the vertical elevation of the plate, which I have already described. The pin is brought into operation upon the clutch-box twice by means of two inclines. It is, in truth, nothing in the world more than a new arrangement of original elements, all of which were to be found in the patent of *Lakin* and *Rhodes*. Its merit consists in that new arrangement. I consider, therefore, the pin, the incline, and a plane which inclines upon it, to be common elements, out of which any inventor was at liberty to make or construct a machine at the time when *Wain's* patent was granted, and of necessity, therefore, at the time when *Platt's* patent was granted. Mr. *Platt*, although to a certain extent he avails himself of the same elements, yet puts them in a different combination, he makes their effect upon the clutch-box different, and he makes the result different. It has been urged upon me that Mr. *Wain's* invention is capable of, or might be made to produce, a result co-extensive and co-equal with *Platt's* invention. If it is so, all I can say is that Mr. *Wain* has not given to the world the benefit of a description of the mode by which that may be effected. I think it a very material thing, as the Vice-Chancellor also did, that, in comparing the two things together, the result and the work done by *Platt's* patent are double, and if double, doubly more beneficial than the work done by *Wain's* patent. Now the mode in which Mr. *Platt* effects the end desired has been by putting upon the shaft a rotating plane, which is bodily connected and joined on to the proximate disc of the clutch-box. Upon this rotating plane Mr. *Platt* has also put the inclines,

which were matters of common knowledge, but instead of having one incline, as in *Lakin* and *Rhodes'* patent, instead of having two inclines as in *Wain's*, he has four inclines. He divides the circle into four portions or arcs, and one incline is in each arc of that circle. Mr. *Platt's modus operandi* is this:—he arrests the rotatory motion of the plane by insertion of a projection at the end of the arm of a lever, which lever moves up and down, so as to present the arm which stops the rotatory motion of the plane successively. Being arrested, the pressure produced overcomes the lateral pressure of a helical spring coiled round the shaft, and the action of that spring being overcome, the pressure withdraws the disc of the clutch-box. When the pin is released the rotating plane resumes its rotatory motion, and there is produced a withdrawal of one disc of the clutch-box from the other four times, and the withdrawal by a force, by a combination of agents, and by a repetition of agency, which are different altogether from the force, the combination, and the agency of *Wain's*. It is said that is a colourable difference, because it is precisely the same thing whether you make the pin rotate upon a plane, or whether you make the plane rotate upon the pin. Now it is very well to cut off the case from all the *differentia*, and to present the case in that generic form without the specific differences that exist between the two agents; but this is a case of specific difference. It is the case of a particular mechanical combination; it is the case of certain well-known things being put together in such a manner as to produce the same result, and it is impossible for me to say that the combination which Mr. *Platt* has made is substantially the same combination that Mr. *Wain* has made. If the invention be, as I have already described, nothing more than a particular means to attain to a given result which is certainly well known, then the invention is for the means, and you can no more prevent the invention of one distinct set of means being interfered with, you can no more say that it interferes with the invention of another, than you could say originally that there ought not to be patents granted for the invention of distinct means to an end.

It is extremely desirable that when a beneficial idea has been started by one man he should have the benefit of his invention, and that it should not be curtailed or destroyed by another man simply improving upon that idea; but if the idea be nothing in the world more than the discovery of a road to attain a particular end, it does not at all interfere with another man discovering another road to attain that end, any more than it would be reasonable to say that if one man has a road to go to *Brighton* by *Croydon*, another man shall not have a road to go to *Brighton* by *Dorking*. They are roads and means

of attaining the end, and unless you can prove that one is a colourable imitation of the other, or unless you can prove that one bodily incorporates the other, with merely an addition, it is impossible to say they shall not be co-existent subjects of contemporaneous patents. I must therefore entirely affirm the judgment of the Vice-Chancellor.

(35 L.J. Ch. 852 ; L.R. 1 H.L. 337.) On appeal to the House of Lords, the decree was affirmed, and the appeal dismissed with costs. A cross appeal was also, by consent, dismissed without costs.

At the hearing a preliminary objection was taken that an appeal on the fifth issue, viz. whether the respondents had been guilty of infringement, was not permissible under the provisions of stat. 21 & 22 Vict. cap. 27, sect. 3; but LORD CHELMSFORD, L.C. said :—‘ The Court of Chancery knows no distinction between orders founded on questions of law and those upon matters of fact ; and the words of the third section applying generally to any orders made upon an application for a new trial, and there being nothing in the fifth section which can be considered as creating any distinction between the different kinds of trial, whether with or without a jury, the regular course of appeal in both cases must equally be open to both parties, and therefore the present appeal is not incompetent.’

His Lordship then discussed the question of infringement, and expressed his opinion that the decree ought to be affirmed.

Per LORD CRANWORTH.—It was said that *Wain* claims not only his own specific mechanism but also ‘ *any mechanical equivalent therefor.*’ And every part of *Platt’s* machine is, it was said, if not identical with, at all events only a mechanical equivalent for *Wain’s* machinery. There are, however, two answers to this argument. In the first place the claim as to mechanical equivalents, according to the fair construction of the specification, relates only to the clutch-box ; and, secondly, the principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case like the present, where the whole invention depends entirely on the particular machinery by means of which a well-known object is attained. If, indeed, the mechanical equivalent used was merely a colourable variation of that for which it was substituted the case might be different ; but here I see no ground for holding that any parts of *Platt’s* contrivances are mere colourable variations from those patented by *Wain*.

REX *versus* CUTLER, A.D. 1816. 1 Stark. R. 354.

Novelty of Invention.

Sci. fa. to repeal a patent of 6th Jan. 1815, No. 3,873, to *J. Cutler*, for ‘ improvements applicable to fire-places, stoves, &c.’

The patent related to a mode of feeding the fire in an ordinary open grate, by a supply of coal from below. The contrivance consisted in placing a coal-box with a moveable bottom below the grate and raising the bottom by means of a rack and pinion, so as to bring up the coals. The specification stated:—‘My invention doth consist in constructing fire-places and stoves in such manner that the fuel necessary to support combustion shall be given to the part in combustion at the lower part of, or beneath the same.’

At the trial, it appeared that, before the patent, two manufacturers had publicly exhibited stoves in which the fuel was raised up from below. In one of these, a deep grate, filled with coals, was raised gradually above the level of a door or screen, and the combustion of the fuel was limited to the exposed portion of the grate.

LORD ELLENBOROUGH was of opinion that the principle on which the two grates were constructed, was identical with that described in the terms of the specification, which was for a mode of supplying fuel from below, and there was nothing predicated in the specification of raising the fuel from below the grate; it was merely for elevating a supply of fuel from below, and that the defendant had confined himself, by thus summing-up the extent of his invention, to the benefit of this principle. Verdict for the Crown.

REGINA *versus* CUTLER and OTHERS, A.D. 1847–9. 14 Q.B. 372, *n*; }
Macrory’s Pat. Ca. 124. }

Novelty of Invention. Misdirection by Judge. Subject-matter of a Patent.

Sci. fa. to repeal a patent of 6th Nov. 1841, No. 9,140, to *J. Cutler*, for ‘improvements in the construction of the tubular flues of steam boilers.’ Suggestions:—9. That the invention was not new; 10. That it was not the working of any manner of manufacture; 12. The like of the part thirdly claimed; 13. The like of the part fourthly claimed; 14. That the invention was of no use; 15. That the specification was insufficient. Traverse. Issue.

The patent related to the manufacture of welded iron tubes. The specification stated:—‘I take a strip of hammered iron or steel, bevil the opposite edges, and bend it into a cylindrical shape. At the mouth of the furnace I place the end of a draw bench, upon this bench I place two stops, and against these stops a die, or dies, or a pair of grooved rolls of the required size for the tube. A mandril is then passed through the die or the groove of the rolls.’ It went on to say that the tube was then heated to a welded heat, and was drawn either through the dies or grooved rollers, while supported within by the mandril. Another mode was by hammering on a mandril, and after-

wards drawing through dies or grooved rollers as before. The next part of the invention was a mode of coating an iron tube, made as described, with a tube of copper, or brass; but the specification stated:—‘I do not claim the making coated tubes as above described, this part of my invention relating to *the application of coated tubes* in constructing tubular flues for steam boilers.’ The manufacture of the several tubes, either coated or otherwise, was described by reference to drawings. *Claims*: 1. The mode of welding iron or steel tubes by drawing through dies or grooved rolls on mandrils. 3. The *application* of either iron or steel tubes, when coated with copper, brass, or other alloys of copper, in the construction of tubular flues of steam boilers. 4. (In substance) the application of welded iron or steel tubes, drawn through a circular hole or die, or between rollers, and over a mandril for the like purpose.

At the trial, evidence was given that the mode of making tubes by drawing through dies over a mandril was impracticable. The mode by drawing between grooved rollers and over a mandril had not been tried, but witnesses stated that in their judgment it was not practicable. Defendants called evidence in contradiction.

LORD DENMAN, C.J. directed the jury:—There is an objection that it is stated that the tubes may be made either by drawing them through dies or between grooved rollers, and it is said that the dies will not produce the effect. But, in my opinion, if either of these modes is practicable, and if it is proved to be useful and new, as to this part of the invention it seems to me that the patent will be good; and you are to form your opinion on the evidence—is it useful, is it new?

With regard to the third and fourth claims, in which the defendant claims the application of tubes on the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. I think Lord Abinger’s illustration is a striking one, and applicable to the present case—‘It is like sweeping a carpet of a new manufacture with an old broom.’ And, in general terms, I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent. The jury found that the whole of the invention was new and practicable.

Verdict for defendants.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Queen’s Bench. (Lord Denman, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD DENMAN, C.J.—The fifteenth suggestion was that the

specification did not particularly ascertain and describe the nature of the invention. The hammers to be applied to the iron tube are described, and on the bench are to be placed two stops for dies, or a pair of grooved rolls. A mandril is then pressed through the dies, or between the grooves of the rolls. On the trial, there was evidence that neither the dies nor the grooved rolls would do the work here assigned to them; and I told the jury that if either of those methods were proved to be satisfactory, the patent might be good, notwithstanding the imperfection of the other.

The case of *Lewis v. Marling* (10 B. & C. 22) had been quoted as establishing that doctrine. But the Court there only said that the claim of some part of a machine which turned out to be useless did not vitiate a patent. This is very different from describing a part of a machine as capable of co-operating in the work, when, in fact, it is incapable, even though at the same time other means are described, which might be effectually employed. For the reader of the specification, relying upon it, might use the former in constructing his machine, which would fail of its purpose from being too accurately made according to the patentee's instructions. The rule must, therefore, be absolute for a new trial.

Second trial of the same action. The pleadings were the same as before.

WIGHTMAN, J. directed the jury to find for the Crown on the 10th, 12th, and 13th issues, and said:—'The 3rd and 4th claims raise questions of law, whether what was claimed was a manufacture within the meaning of the statute. Now I entertain a strong opinion on this question, as to whether a mere application can be the subject of a patent; for when once you have got a material you may apply it as you think fit.' Verdict accordingly.

No further proceedings were taken.

CUTLER *against* BOWER, A.D. 1848. 11 Q.B. 973.

Pleading. Demurrer. Estoppel. Consideration for a Licence.

COVENANT on an indenture by which plaintiff covenanted to pay defendant a sum of money for the purchase of one moiety of a patent of 6th Nov. 1841, No. 9,140, to J. Cutler, for improvements in the tubular flues of steam boilers, the recitals of the deed stating the grant of the patent, and also the grant, by another indenture, of an exclusive licence to defendant to use the same. Defendant pleaded in several pleas that plaintiff was not the first inventor, that the invention was not new, and that the specification was insufficient, and the patent void. Replication: *estoppel*, by the indenture of

licence. General demurrer, and joinder. Judgment for plaintiff by the Court of Queen's Bench.

Per LORD DENMAN, C.J.—Many cases were cited upon the question *estoppel*, but we think it unnecessary to give any opinion on that question, as an objection was taken to the pleas of the defendant, which we think must prevail; and which, consequently, renders any question as to the validity of the replication immaterial.

The defence set up by the pleas is failure of consideration, that of the patent is invalid, and that the defendant is not bound by his covenant to pay the money, which appears by the deed to be the purchase money for a patent which, it is said, turns out to be worthless. But it appears to us that there are two decisive objections to this defence. The first is, that there not having been any eviction, the consideration does not wholly fail. And in the next place, the supposed defence could only be available in case the covenant upon which the action was brought was a dependent covenant, to be performed only if some condition is observed by the other party; but in this case the covenants of the plaintiff relating to the patent, and that of the defendant for payment of the purchase money, are wholly independent of each other; and each party may recover against the other for a breach of their respective covenants. There is no plea of fraud or eviction.

DANGERFIELD *against* JONES, A.D. 1865. 13 L.T. N.S. 142.

Novelty of Invention. Utility essential. Evidence of Infringement.

Suit to restrain from infringing a patent of 5th March, 1864, No. 561, to *W. Dangerfield*, for 'an improved mode of and apparatus for bending wood for the handles of walking sticks, umbrellas, and other purposes.'

The specification stated:—'The invention consists principally in a novel mode of applying heat to the wood for the purpose of softening the fibres, and then bending the stick and securing it by a clamp.' It then described the apparatus (by reference to drawings) as being a vice for holding a stick, placed close to a hollow mandril, round which the bending took place. A jet of gas was lighted inside the mandril, the heat of which set the fibres of the wood, so that the bending became permanent. The stick was, in the first instance, softened by moist sand, and was secured *in situ* on the mandril by a strip of steel. *Claim*: 'The application of a flame of gas or other combustible fluid, for softening the fibres of the wood while being bent, in combination with a clamping apparatus for securing the wood until its fibres are set.'

Defendants denied the validity of the patent, and alleged that

they had themselves, before the patent, adopted a mode of bending sticks round a solid mandril by the aid of a strip of steel and a jet of gas, the difference being that the flame played outside the steel band instead of inside the mandril.

Wood, V.C. granted an injunction and account, and said:—When it is stated that, because wood is bent by coachmakers and others in a variety of ways by the application of heat, you cannot have a patent for the application of heat to the bending of walking sticks, that is the same sort of reasoning which was pressed ineffectually upon the Court with reference to an invention for an improvement in navigation. It was said that the operation of a propelling power by presenting a screw surface to the action of water was nothing new, that it was like the action of a windmill with reference to the wind. That reasoning, however, did not succeed. If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit. A mere trifling matter or a thing of no value will not do, inasmuch as the whole theory of the patent law is based upon the assumption that it is something of real value. You must show that you have invented something useful—a new and useful improvement in manufacture.

DAVENPORT *against* RICHARD, A.D. 1860. 3 L.T. N.S. 503.

Practice in Patent Suits. Long Enjoyment of Patent.

Suit to restrain from infringing patents of 13th Nov. 1851, No. 13,809, to *W. Smith, W. Dickinson, and T. Peake*, and of 9th Dec. 1856, No. 2,916, to *T. Peake*, for improvements in the manufacture of chenille. It appeared that the patentees were the first to manufacture chenille by machinery. The first patent was assigned to plaintiff on 2nd June, 1852, and the assignment was not registered. An objection that the title was incomplete was overruled, stat. 15 & 16 Vict. cap. 83, sect. 35, not taking effect until 1st Oct. 1852. Wood, V.C. granted an injunction, with order for an action at law, and said that wherever there was reasonable *prima facie* case of infringement, the length of time for which the patentees had had the exclusive enjoyment of the invention, as in the present case for nine years, influenced the Court in granting an injunction. The specifications, as he conceived, were sufficiently precise, but that was a question of law which would be open for consideration hereafter.

DAVENPORT *against* JEPSON, A.D. 1862. 1 N.R. 173; 307.

Practice in Patent Suits. Injunction. Inspection.

Suit to restrain from infringing the patent of 1851, No. 13,809. Injunction granted by WOOD, V.C. On appeal, order affirmed.

Per KNIGHT BRUCE, L.J.—Though the motion before the Vice-Chancellor was only an interlocutory application, yet it was impossible to forget the recent Act of Parliament (25 & 26 Vict. cap. 42) prohibiting this Court from sending cases to be tried by a Court of Common Law, and consequently the defendant was entitled to have the question of the validity of the patent raised, even on this interlocutory motion. After an analysis of the evidence his Lordship said that, in his opinion, there was a valid patent which had been infringed, and that there was a case for an injunction.

Per TURNER, L.J.—After much consideration I have arrived at the conclusion that the Act (25 & 26 Vict. cap. 42) has not deprived this Court of any of its powers. It simply declares that this Court should not send away any case to be tried elsewhere. The powers of this Court are not limited by the Act, nor its procedure affected, yet to say that to grant injunctions on interlocutory motions in patent cases was no longer right, was to limit the powers of this Court and to alter its procedure.

The order made by WOOD, V.C. on motion in this cause is extracted *verbatim* in 1 N.R. 307, and provides, *inter alia*, for the mutual inspection of machinery by plaintiff and defendant.

DAVENPORT *against* GOLDBERG, A.D. 1865. 2 H. & M. 282.

Practice in granting issues in Patent Suits. Long Enjoyment of Patent.

Suit to restrain from infringing the same patent. It appeared that in 1860 plaintiffs filed a bill against a person named *Richard* for infringing their patent. An action at law was ordered, and plaintiffs were nonsuited by Hill, J. on the ground that the specification was insufficient; the nonsuit was set aside by the Court of Queen's Bench, and plaintiffs signed judgment and obtained a decree. Afterwards, in 1862, plaintiffs filed a bill against *Jepson*, when a decree was made for a perpetual injunction. In the present suit, defendant put in issue everything which had been contested in *Davenport v. Jepson*. On motion for a special jury to determine certain disputed questions of fact, WOOD, V.C. refused to grant issues on the questions of novelty and invention, but put the plaintiffs to prove the infringement before a jury, and said:—

No person is entitled to come here and say, 'I raise such and such a question and ask for a jury *ex debito justitiæ*,' although there

are certain classes of cases in which the course of the Court is, if the matter be new, not to decide important disputed questions of fact without the assistance of a verdict. On the question of infringement, I must take it that there is such a *bonâ fide* contest of fact on that point that I ought to send that question to a jury if the defendant desire it.

The case is reduced to this : that the plaintiffs have had thirteen years' user of this patent, twice disputed, and their right in each case established—once at law, and once in this Court. In what position would a patentee be placed if he is to try his right *ab initio* against every separate infringer *in infinitum*? That certainly is a view of his rights which has never been adopted by this Court. If the defendant thinks he can get rid of the patent, he had better proceed by *scire facias* to repeal or annul it : if he does not choose to take that course, but simply disregards it and stands on his defence, I must take the validity of the patent as already sufficiently established against him.

DAVENPORT *against* RYLANDS, A.D. 1865. L.R. 1 Eq. 302.

Practice in Patent Suits. Damages. Full Costs.

Suit to restrain from infringing the same patent. The bill sought an injunction, an account of all *chenille* manufactured by plaintiff's process without license, and an inquiry as to damages. It appeared that the bill was filed on 8th Nov. 1864, and that the patent expired on 13th Nov. 1865, before the hearing. Wood, V.C. granted an injunction, and inquiry as to damages, and said:—'I was somewhat impressed with the notion that in order to award damages at the hearing, the Court must have jurisdiction to grant an injunction. But I think that would be a narrow construction to put upon this beneficial Act (21 & 22 Vict. cap. 27). I think the sound view of the whole case is, that I ought to exercise the jurisdiction granted to me by the Act, that I ought to consider myself as having had jurisdiction at the time the bill was filed, for the purpose of ultimately giving relief pursuant to the Act, and therefore I shall direct an inquiry as to what damage the plaintiff has sustained ; and I shall give the plaintiff the costs up to the hearing.'

Application was then made for costs as between solicitor and client under stat. 15 & 16 Vict. cap. 83, sect. 43, which was opposed on the ground that the validity of the patent had not been in issue. Wood, V.C. granted the application, and said:—'The statute provides that the plaintiff shall have his full costs, unless the judge shall certify that he ought not. There are many circumstances under which it might be improper that the plaintiff should have costs.

The judge may think the first action to have been collusive, or he may think the case an improper one. Many instances may be suggested; but the object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the principle has been once established.'

DAW *against* ELEY, A.D. 1865. 2 H. & M. 725; L.R. 1 Eq. 38; }
L.R. 3 Eq. 496. }

Discovery. Admissibility of Evidence under Notice of Objections. Breach of Injunction. French and English Patents for the same Invention.

Suit to restrain from infringing a patent of 4th *Sept.* 1861, No. 2,203, to *F. E. Schneider*, for 'improvements in cartridges for breech-loading fire-arms, and in the machinery for manufacturing the same.' The bill interrogated defendants, requiring:—5. A description of all machines similar to plaintiff's made or used for six years before the date of the patent. 6. Asking for the names and addresses of all persons to whom they had sold breech-loading cartridges since 1st *Jan.* 1855, together with prices. 8. Requiring a statement of the size of the wire used in making their breech-loading cartridges, with the names of the persons from whom and the places from which they had purchased such wire, from *Jan.* 1855, to the present time. Defendants denied the novelty of the invention, and set forth that they had used a machine somewhat similar to that specified, but had discontinued the user before the date of the patent. They submitted that they were not bound to answer the interrogatories. Plaintiff excepted to the answer, but Wood, V.C. over-ruled all the exceptions, with costs, and said:—'Is the defendant in a patent case obliged to set out all the machines he has used before the date of the patent? The discovery is either wholly immaterial to the issue or else it is a defence for want of novelty. Are you entitled to ask them the names of the witnesses whom they intend to produce to establish their case? There is no valid distinction between that question and the interrogatory which has not been answered in this case. The 8th interrogatory is out of all rule. The plaintiff has no right to inquire into the defendants' case with intent merely to get at an answer to the question, "How are you prepared to prove your case?"'

(L.R. 1 Eq. 38.) At the hearing defendants tendered evidence of prior user not specified in the particulars of objection, the excuse being that such evidence had not come to their knowledge until after the cause was in the paper. Wood, V.C. refused to admit the evidence, and said:—'The statute is plain, and the objection to its admission is substantial and not merely technical. I cannot

conceive any more beneficial enactment than that contained in stat. 15 & 16 Vict. cap. 83, sect. 41, which directs that the place and the manner of the alleged prior user must be stated in the particulars of objections on which the defendant means to rely at the trial, but goes on to provide that, although it cannot be done in the course of the trial, it shall be competent for a judge at Chambers to allow the particulars to be amended on such terms as he shall think fit. In *Renard v. Levinstein* (13 W.R. 229) I gave the defendant leave, on payment of the costs occasioned by the application, to amend his particulars of objection, as the lesser of the two evils, being of opinion that I might do the plaintiffs themselves considerable injury if I were to refuse the application to amend, and thus occasion the expense and inconvenience of an application for a new trial. All I can do now is to shut out this evidence, leaving the defendants to make such application as they may be advised.'

(L.R. 3 Eq. 496.) The report carries on the history of the proceedings in this suit.

The patent related, *inter alia*, to the formation of a cartridge having a recess or chamber at the rear end for the reception of a percussion-cap. The cap was filled up with an anvil, formed of a short length of grooved wire, and was fired by the blow of a hammer. The anvil was supported by the base of the recess sufficiently for the ignition of the detonating charge, and the flame passed along the grooved sides of the anvil, and entered the body of the cartridge through an opening in the base of the recess. The drawings annexed to the specification showed a percussion-cap having an anvil with four grooves placed inside it, and showed also the construction of a cartridge with the chamber for the reception of the cap. The specification stated:—'It is not essential that the anvil should be cylindrical, or that it should have four longitudinal cuts or grooves formed in it, as shown, as it may be formed of other transverse sections, so long as it is made to fill as nearly as may be the cap, and has cuts or grooves formed in it.' *Claim*: 1. The manufacture of cartridges described with reference to figs. 3, 4, &c. (distinguishing the figures).

It appeared that in 1855 a central-fire cartridge was invented by one *Pottet*, a *Frenchman*, but was not patented in this country. *Pottet's* anvil consisted of a thin plate of metal placed inside a percussion-cap received into a recess at the base of the cartridge.

The case came on for hearing in *Nov.* 1865, when *BACON*, V.C. was of opinion that plaintiff's patent was not invalidated by reason of *Pottet's* invention, and gave judgment for plaintiff. The decree for an injunction was drawn up on 27th *Jan.* 1866.

About this date proceedings were instituted in *France* by defendants for the purpose of annulling a *French* patent of *Feb.* 1858, granted to *F. E. Schneider*, for central-fire cartridges, and upon which invention the *English* patent was founded. In *Feb.* 1866, *Schneider's* patent of 1858 was annulled by the tribunals in *Paris*, and in *June*, 1866, an appeal from this decision was dismissed by the Superior Court.

On 24th *March*, 1866, a patent for improvements in central-fire breech-loading cartridges was granted to *W. T. Eley* (No. 880). The specification stated:—‘This invention relates to improvements in central-fire breech-loading cartridges, according to which an anvil is placed in the percussion-cap of the cartridge in *two or more* parts, by means of which the flame from the percussion powder passes between the several parts of the anvil, as well as round the sides, before escaping through the hole in the centre of the chamber.’ The drawing showed an anvil formed of two thin strips of metal with pointed ends, placed in juxtaposition within the cap. The backs of the strips, which were in contact, were somewhat rounded, and there was abundant passage for the flame of the detonating powder.

Plaintiff now moved to commit defendants for a breach of the injunction of 1866. Defendants put in evidence an official copy of the judgment of *déchéance* of the *French* patent in 1866, and the judgment of rejection of appeal by the Superior Court. Motion refused, with costs.

Per Wood, V.C.—The *French* patent of *Schneider*, and all rights under it, are gone, and if it is identical with the *English* patent, it follows, as a necessary result, that the *English* patent is gone also. It comes, then, simply to the consideration of the two patents. Because certain parts of the *English* patent are identical with the *French* patent, it does not follow, as a necessary result, under stat. 15 & 16 *Vict.* cap. 83, sect. 25, that, when the *French* patent is determined, the rest of the *English* patent which is not identical is void also. The effect of that section is to strike out of the *English* patent that which, up to a certain time, the foreign patent has covered, but ceases any longer to cover. Now, upon the question of identity, I have no doubt. No difference can possibly be drawn between the two things. That being so, it does appear to me that the injunction terminates here from the moment that the *French* Court decides that the *French* patent has come to an end.

It is of comparatively little importance for me to consider whether or not there has been an actual infringement by the defendants. As in *Seed v. Higgins* (8 H.L. Ca. 550), where the

plaintiff was confined very narrowly to his exact specification, in consequence of the anterior invention of another; so here *Schneider*, in consequence of *Pottet's* previous discovery, must be confined to very narrow limits, viz., that of securing the anvil by the particular mode in which he has described it. The defendants have now taken *Pottet's* anvil and doubled it, and in doing so they have not pursued the plaintiff's course of action, but have deliberately rejected it. It appears to me that they have hit on a process by which they arrive at the same result without bringing themselves within those narrow limits to which the plaintiff must be confined. Upon the special merits, infringement or no infringement, this is not a case in which I ought to commit, or make an order equivalent to committal, by making the defendants pay the costs of this motion.

DE LA RUE and OTHERS *against* DICKENSON and OTHERS, }
 A.D. 1857. 7 E. & B. 738; 3 K. & J. 388. }

Evidence of Infringement. Subject-matter of a Patent. Sufficiency of Specification. Practice in Patent Suits. Discovery.

Suit to restrain from infringing certain patents, viz., of 17th *March*, 1845, No. 10,565, to *E. Hill* and *W. De la Rue*, and of 19th *Dec.* 1849, No. 12,904, to *W. De la Rue*, for 'improvements in the manufacture of envelopes.' Action at law in pursuance of order of the Court. Pleas: 1. Not guilty. And as to first patent: 4. That the invention was not the subject-matter of a patent. 5. That the specification was insufficient. And like pleas as to second patent. Issue.

The specification of the first patent stated the invention to consist:—(1) In improved machinery for cutting paper for the making of envelopes; (2) in arranging machinery for folding over the flaps of envelopes; and it described the folding machine (about which the contest arose) by reference to drawings. The envelope, or *blank*, was first creased by being pressed by means of a plunger into a hollow box, the platform at the bottom of which was lifted or depressed, as required. The specification stated that thus far the general character of the machine was not new. On the sides of the box were four folder flaps, shaped like the flaps of the envelope, but somewhat smaller in size. The plunger was so arranged that two opposite sides moved out of the way after the creasing, and allowed the folders to press down and fold two of the flaps; the same thing was then done with the two remaining sides of the plunger and the corresponding flaps, and the operation was complete. The folders came down in succession, each being moved somewhat in advance of its neighbour, so as to imitate the folding of an envelope by hand. *Claim*: 'The so arranging

machinery that the flaps of envelopes may be folded thereby as described.'

The specification of the second patent described one part of the invention as consisting in apparatus for applying to the flaps of an envelope the gum or cement necessary for causing three of the four flaps of the envelope to adhere together. The apparatus consisted of an endless revolving apron mounted on rollers, and running in one part of its course below the surface of some liquid gum in a reservoir. The apron was thus wetted with gum, and an instrument, having projecting surfaces of the size and shape of the parts of the flaps requiring to be gummed, dropped upon the apron, took away some gum, and transferred it to the envelope. *Claim*: 'The application of gum or cement to the flaps of envelopes by apparatus acting in the manner of surface printing, in contradistinction to the application of gum or cement direct from a fountain.'

At the trial, it appeared that the alleged infringement consisted in folding and gumming envelopes according to a patent of 28th Feb. 1849, No. 12,493, to *A. F. Rémond*. It appeared that defendants' plunger was furnished with four inclined planes, placed underneath its edges at different angles to the horizon. As soon as the plunger had creased the envelopes it was raised up, and four jets of air blew the flaps inward; the plunger now descended, and the inclined planes acted successively on each flap in the right order, so as to complete the folding, after which the envelope was discharged from the bottom of the box instead of from the top, as in plaintiffs' machine. As to the gumming, the case was, that defendants used an instrument with projecting surfaces, corresponding to the parts of the envelope requiring to be gummed, but they dipped the same directly into liquid gum, instead of deriving the supply from the surface of an apron. LORD CAMPBELL, C.J. directed the jury:— That there might be an infringement of the first patent by an apparatus for folding the flaps of envelopes, although the paper was not held down during the operation. Also, that a mode of applying gum to the flaps of envelopes after the manner of surface printing might be an infringement of the second patent, although the printing instrument took the gum directly from the reservoir. His Lordship also ruled that the questions of infringement were for the jury; and that there was sufficient evidence to go to the jury. The jury stated that, in their opinion, the folding machine and gumming apparatus of defendants were imitations of plaintiffs' two inventions. Verdict for plaintiffs. Leave reserved.

Rule nisi for a new trial discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, JJ.)

Per LORD CAMPBELL, C.J.—After carefully considering the specifications, we think that the claim in each is for described means of conducting a useful process, resulting in a valuable manufacture; and that the specification shows distinctly what portions of those means are claimed as new, and what portions are allowed to be old.

The defendants contend that the judge, at the close of the plaintiffs' case, ought to have determined by his own authority that there had been no infringement. We consider, however, that the doctrine contended for is contrary to principle, would render it impossible to administer the law of patents, and is by no means to be deduced from *Unwin v. Heath* (5 H.L. Ca. 505), or any of the other decisions referred to. There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, or of fact mixed with law, which the judge is bound to submit to the jury. There can be no doubt that such evidence was adduced by the plaintiffs.

The defendants, therefore, are confined to the contention that the verdict was against the evidence. The plaintiffs fold the flaps in succession by folding instruments most ingeniously actuated by cams. The defendants likewise use folding instruments, inserted in the inverted box of the plunger; and the stroke of the descending plunger, making these folding instruments, called projections, touch the different flaps in succession, folds them finally in the same manner, although not in the same order. Whether the two modes of folding by the cams and the plunger be essentially different or substantially the same, we think was a pure question of fact for the jury, and we cannot say that the jury were wrong in the conclusion at which they arrived. The folding being a material part of the plaintiffs' process of manufacturing envelopes, it is not necessary to determine whether their claim extended to the rest of the process: but we would observe that, generally speaking, as the manufacture which is the result of the process invented and patented is the ultimate object in view, the purpose of the patent laws is to protect all that is new in this process, if it be described, although not expressly claimed.

With respect to the patent of 1849, for gumming the envelopes, the jury expressed a clear opinion that the defendants' was a colourable imitation of the plaintiffs', and we think that this conclusion was fully warranted by the evidence. We are of opinion that the defendants might be guilty of infringement without using an intermediary surface, and that, without what is strictly called 'surface printing,' they might apply gum to the flaps of envelopes by operations acting *in the manner of surface printing*, in contradistinction to the application of gum direct from a fountain containing the gum.

(3 K. & J. 388.) While the action was pending defendants put in an answer to plaintiffs' interrogatories, which sought for an account of all envelopes and envelope-making machines in defendants' possession, as well as discovery as to the purchase or hire of such machines, and as to the stock of envelopes made therewith. Defendants admitted the possession and use of such machines, but denied infringement, and submitted that they were not bound to answer further. Exceptions were taken to the answer, but Wood, V.C. ordered them to stand over till the hearing, and said:—'The rule on which the plaintiffs rely, that a defendant electing to answer must answer fully, is no doubt a rule sufficiently well-established. In a patent case, if the plaintiff once establishes the fact of an infringement, his right to a decree involving full discovery of all matters of the nature of those here inquired after is clear; everything therefore showing, or merely tending to show, the fact of infringement, must, of course, be set forth in the answer, to the full extent of the interrogatories. But here all the discovery required by the interrogatories in question *assumes* the fact of infringement, and will be obtained under the decree at the hearing, as a matter of course, provided the fact of infringement be then established. While, on the other hand, if the fact be not established at the hearing, the whole of the discovery required will be utterly immaterial.'

DEROSNE *against* FAIRIE, A.D. 1835. 5 Tyr. 393; }
2 Cr. M. & R. 476; 1 Webs. Pat. Ca. 154. }

Sufficiency of Specification. Title of Patent.

CASE for the infringement of a patent of 29th *Sept.* 1830, No. 6,002, to *C. Derosne*, for 'improvements in extracting sugar and syrups from cane juice and other substances containing sugar, and in refining sugar and syrups.' Pleas: 3. That the specification was insufficient. 4. That no specification was enrolled. Issue.

The patent related to a process for freeing syrup of sugar from colouring matter by filtration through charcoal. The specification

stated:—‘The invention consists in a means of *discolouring* syrups of every description, by means of charcoal produced by the distillation of *bituminous schistus* alone, or mixed with animal charcoal, or even of animal charcoal alone.’ It then described the operation, and the precautions to be observed. It further referred to juices or liquids ‘*which had been baked* for extracting the sugar,’ and concluded by stating:—‘The carbonisation of bituminous schistus has nothing particular; it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it.’

At the trial, it was admitted that the patentee, who was a foreigner, had incorrectly used the word ‘baked,’ when he should have said ‘before crystallisation’—*i.e.* before the process was completed. He had also used the word ‘discolour’ in the sense of depriving of colour—‘*decolorer.*’ But the objections raised on these grounds were not pressed. It was not, however, made clear upon the evidence whether bituminous schistus was or was not capable of being purified from the sulphurets of iron with which it was admixed, so as not to impart colour to the solution. LORD ABINGER, C.B. directed the jury to find for plaintiff or defendant according as they were of opinion that the description of bituminous schistus was sufficient or insufficient, so that all the world could or could not use it. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the grounds, (1) of a variance between the title and specification (the title being for extracting and refining sugar, and the specification referring only to the removal of the colour); (2) that the specification was insufficient. Rule made absolute by the Court of Exchequer for a new trial on the second ground of objection. (Lord Abinger, C.B., Parke, Bolland, Alderson, BB.)

Per LORD ABINGER, C.B.—One objection to the plaintiff’s specification is rested on the ground that it does not set forth that double process which one would expect from the title of the patent. We do not think that the question necessarily arises at present, or that it calls for an ultimate decision, because we think, on consideration, that the double process or both the branches of the invention mentioned in the patent are sufficiently described in the specification. The word ‘improvements’ was relied on as being in the plural number, but that is of no consequence, because the plaintiff may mean every part of his process to be treated as an improvement, forming together a series.

Upon the main point, however, that respecting the bituminous

schistus, nothing that I have heard has removed my original impression that there was no evidence to show that this process, carried on with bituminous schistus in combination with any iron whatsoever, would answer at all. The plaintiff has himself declared that in that bituminous schistus which he himself furnished, the whole iron was extracted, and it appears that it was admitted by counsel that the presence of iron would not only be disadvantageous but injurious. I am therefore of opinion that, without considering whether or not the patent would be avoided by the patentee's keeping secret the means requisite to extract the iron from the bituminous schistus, he has not shown in this case that what he has described in the patent could be used as so described, without injury to the matter going through the process.

Under all the circumstances we think 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 this process with advantage; and as he has not done that, the defendant is entitled to a nonsuit; but at the same time, as it is alleged that the plaintiff may, on a new trial, supply the defect of proof as to the schistus by other evidence, we are desirous that the patent, if a good one, should not be affected by our judgment, and think it right to direct a new trial.

Per ALDERSON, B. — A specification must state one or more methods which can be followed, for the purpose of accomplishing and carrying into effect the invention. One of the methods stated in this case is the application of a filter, composed of charcoal, formed by the distillation or carbonisation of bituminous schistus. It must, therefore, be shown that the purpose will be accomplished by following that method. Certainly if any admission was made that the presence of iron would be a detriment to the operation, without confining that admission to its being a less perfect mode of exhibiting the experiment than would otherwise be the case, that undoubtedly would be a ground for a nonsuit.

DIXON *against* THE LONDON SMALL ARMS COMPANY, A.D. 1875. }
L.R. 10 Q.B. 130. }

Infringement by Sale for the Public Service. Rights of the Crown.

CASE for the infringement of several patents relating to the manufacture of rifled fire-arms. Referred to an arbitrator, who stated a case for the opinion of the Court of Queen's Bench. It appeared that plaintiff was managing director of a company engaged in the manufacture of the *Martini-Henry* rifle under certain patents. Defendants were also engaged in manufacturing fire-arms, and they

tendered for the supply, for the public service, of several thousand *Martini-Henry* rifles, upon terms (*inter alia*) that the contractors should be protected by the War Department against patentees in the manufacture of the arms to be contracted for. This tender was accepted by the Secretary of State for War, and the rifles were made and delivered accordingly. It was conceded that such manufacture and sale would have infringed the plaintiff's patent rights had the rifles been consigned otherwise than for the use of the Crown. The question raised, was whether plaintiff was entitled to recover against defendants for the infringement. Judgment for plaintiff by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Lush, Archibald, JJ.)

Per COCKBURN, C.J.—The Crown is not before the Court, as was the case in *Feather v. The Queen* (6 B. & S. 257). This is a case in which subject and subject are before the Court as litigants. One subject complains of his right having been invaded, which the other most undoubtedly has invaded, unless it has been done by a lawful command of the Crown. It is said that this is a matter which the Crown has power to authorise. That might be the case if the party manufacturing the article were the servant or the immediate agent of the Crown, and not an independent contractor; but here the defendants are independent of the Crown, they are not called upon to enter into this contract if they do not please, it is their own act and at their own option; and on these grounds I think they ought to pay the patentee compensation for the use of his invention.

Per MELLOR, J.—I was party to the judgment in *Feather v. The Queen*, and I may say that no member of the Court ever contemplated the extension of that doctrine beyond the limit there laid down.

Per LUSH, J.—The claim set up by the defendants is a right to infringe a patent and manufacture the patented article for their own profit, in order to enable them to sell the article when so manufactured to the Government. That is, I think, beyond the scope of the privilege which the Crown enjoys.

Per ARCHIBALD, J.—These are proceedings against a company who infringe the plaintiff's patent right, in order to carry out the contract to supply and deliver these rifles to the Crown. It is said that a part of the contract is, that they are to be supplied on the terms that the defendants are to be protected against the patentee. I do not myself consider that the indemnity is a part of the contract which is referred to in the special case; but even if it were, it would make no difference. No doubt if this contract stipulated that these persons were to be employed as servants of the Crown at a salary or wages, just as

if they were in the workshop of the Crown, that would be a different case. The rifles then would be manufactured by the Crown, and there would be a substantial difference between such a contract and the present; for this contract might have been performed by supplying articles manufactured long before the date of the contract. I do not think this case falls within the principle of *Feather v. The Queen*.

DOBBS *against* PENN, A.D. 1849. 3 Ex. R. 427.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 30th *June*, 1838, No. 7,716, to *W. Dobbs*, for 'improvements in the construction of racks and pulleys for window blinds.' Pleas: 1. That plaintiff was not the true and first inventor. 2. That the invention was not new. 3. That it was not the working of any manner of manufacture. Issue.

The patent related to a method of adjusting the tension pulley of a roller window blind by means of a screw clamp capable of sliding along a so-called *box* or *case*, which was, in fact, a slit tube. The specification described the contrivance by reference to drawings, and also the method of forming the slit tube by drawing a strip of thin metal through the hollow frustum of a cone, and afterwards through a draw-plate. *Claim*: 'The making such boxes or cases by means of drawing strips of thin metal through a cone and through a draw-plate, and the *adaptation* of tubes so made as boxes or cases for the slides of bell-pulls and other useful purposes; and further, the contrivance for fixing the stud of the pulley by means of a clamp and screw as above described.'

At the trial, defendant gave in evidence the specification of a patent of 15th *Jan.* 1810, No. 3,293, to *T. Bayley*, for the application of a screw (instead of a rack and spring) to the moveable slide in sliding pulleys for window blinds, closely resembling that of plaintiff, and consisting of a grooved frame, having a slide inside the groove, with a small covering plate, called an *escutcheon*, outside, the two pieces being clamped to the frame by a screw carrying on its spindle the tension pulley of the window blind. The specification stated:—
'I sometimes make my sliding pulleys without an *escutcheon*.'

An objection was raised that the application of drawn metal tubes to the 'cases' of window blinds and other useful purposes was not subject of a patent. PATTESON, J. left the case to the jury.

Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of Exchequer.

Per PARKE, B.—Two objections were made by my brother

Talfourd; one was, that the mode of making the slides of drawn metal could not be the subject of a patent, on which it is unnecessary for us to say anything; for the other, which was that part of the alleged invention was not new, is, we think, insuperable.

If the escutcheon be absent, the invention of *Bayley* differs from the plaintiff's in no one respect, except in the mode of attaching the screw to the slide by means of a nut, which is quite immaterial. We think there must be a new trial, as the part of the invention which relates to the screw is not new.

DOLLOND *against* ———, A.D. 1776. Cited 2 H. Bl. 470, 487; }
 Parl. Rep. 182; 1 Webs. Pat. Ca. 43. }

First Publisher of an Invention.

CASE for the infringement of a patent of 19th *April*, 1758, No. 721, to *J. Dollond*, for 'a new method of making the object-glasses of refracting telescopes.' The patent related to the construction of an achromatic object-glass, formed by the union of lenses of crown and flint glass respectively; whereof the crown glass lens was convex, the flint glass lens concave. The refractive power of the crown lens exceeded that of the flint lens, but its dispersive power (called *refrangibility*) was less. The specification stated:—'There remains a difference of refraction by which the image is formed, without any difference of refrangibility to disturb the vision.'

At the trial, it was proved that one *Dr. Hall* had made such glasses in 1720, but had not disclosed the secret. The patent was supported.

(2 H. Bl. 470.) In referring to this case BULLER, J. said:—'The objection to *Dollond's* patent was that he was not the inventor of the new method of making object-glasses, but that *Dr. Hall* had made the same discovery before him. But it was holden that as *Dr. Hall* had confined it to his closet, and the public were not acquainted with it, *Dollond* was to be considered as the inventor.'

DUDGEON *against* THOMSON, A.D. 1874. 30 L.T. N.S. 244.

Practice in Suits where the Enjoyment of Patent has been undisturbed.

Suit to restrain from infringing a patent of 7th *March*, 1866, No. 699, to *G. T. Bousfield* (a communication from abroad by *R. Dudgeon*), for 'an apparatus used in expanding boiler tubes.'

It appeared that in 1873 plaintiff obtained the affirmation by the Court of Session in *Scotland* of an interdict restraining defendant (who was proprietor of a like patent of later date) from using the patented invention. The question of novelty was not raised in these proceedings. JESSEL, M.R. granted an injunction until the hearing

of the cause, and said :—‘The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it ; or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result ; or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent. I shall grant the injunction asked for on all these grounds. The patent is *eight* years old, as old as the patent in *Betts v. Menzies* (3 Jur. N.S. 357), where it was said that where the patentee has had long enjoyment he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful. It has been urged that the question of novelty was not raised in *Scotland*, or was not decided, but that must have been because a plea of want of novelty was not put in ; or, if put in, was waived. I cannot regard the decision of the Court of Session on a patent for the *United Kingdom* as the decision of a foreign Court. Besides, the defendant *Thomson* was not in the ordinary position of an infringer asserting want of novelty, for he was the proprietor of a subsequent patent, which has been decided to be an infringement of the plaintiff’s patent, and so is in a worse position than an ordinary defendant who might have acted ignorantly.’

DUNNICLIFF and BAGLEY *against* MALLET, A.D. 1860. 7 C.B. N.S. 209.

Validity of Assignment of part of a Patent.

CASE for the infringement of a patent of 11th *June*, 1850, No. 13,122, to *J. D. Dunnicliff* and *J. W. Bagley*, for ‘improvements in lace and other weavings.’ The declaration recited the grant of the patent, and certain indentures of assignment whereby the interest in one portion of the patent became wholly vested in plaintiffs. Plea in abatement : Non-joinder of other parties jointly interested with plaintiffs in a distinct portion of the patent. Judgment for plaintiffs by the Court of Common Pleas. (Erle, C.J., Crowder, Byles, JJ.)

Per ERLE, C.J.—The main question is, whether an assignment of part of a patent is valid. I incline to think that it is. It is every day’s practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day’s practice by disclaimer to get rid of part of a patent which turns out to be old. Being, therefore, inclined to think that a patent, severable in its nature, may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action.

Per CROWDER, J.—I see no reason to doubt that an assignment of a separate and distinct part of a patent is valid. No authority has been cited to the contrary, and in practice these assignments are common.

EDGEBERRY *against* STEPHENS. 2 Salk. 447.

First Importer of an Invention.

‘A grant of a monopoly may be to the first inventor by the 21 Jac. I.; and if the invention be new in *England*, a patent may be granted, though the thing was practised beyond the sea before; for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or study, it is the same thing. Agreed by Holt and Pollexfen.’

THE ELECTRIC TELEGRAPH COMPANY *against* NOTT, A.D. 1846–7. }
11 Jur. 273; 2 Coop. Ch. Ca. 41; 4 C.B. 462. }

Practice in Patent Suits. Injunction. Considerations which guide the Court. Particulars of Infringement.

Suit to restrain from infringing three several patents—viz., of 12th *June*, 1837, No. 7,390; of 21st *Jan.* 1840, No. 8,345, to *W. F. Cooke* and *C. Wheatstone*, each, in substance, for improvements in giving signals at distant places by means of electric currents; and of 8th *Sept.* 1842, No. 9,465, to *W. F. Cooke*, for a like invention. Injunction refused, with leave to bring an action at law. On appeal to the Lord Chancellor, order affirmed.

Per LORD COTTENHAM, L.C.—I have not departed from the principles laid down by any of my predecessors, that where the application to the Court is to protect and assist a legal right, it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction; and that such caution is requisite for two reasons; first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court then has interfered without any authority whatever, the authority being merely derivative from the legal right, and in aid and protection of it; secondly, and principally, because in this Court there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction.

The doctrine as to the Court declining to interfere in general, until the legal right is established, is open to one exception. The exception is this: that where a patent has existed for some time,

and there has, during this time, been a user under the patent, it is an assertion of a title against all the world. If, during this time, the patent has been exclusively enjoyed, it is strong corroborative evidence of the validity of the patent. The Court has in such case assumed the validity of the patent. The Court has acted as if the patent were valid, supposing that there was nothing else in question but the validity of the patent—no question of infringement. The Court has given so much sanction to the right asserted by the patent as to aid and protect it, till the patent be proved to be invalid.

Three separate actions at law were then brought, one on each patent. It appeared that the alleged infringement consisted in the use of an apparatus combining the several inventions.

Rule nisi for particulars in writing of the alleged infringements discharged by the Court of Common Pleas. Costs to be costs in the cause.

Per WILDE, C.J.—It may be impossible for the plaintiffs to point out which of the several heads of invention they charge the defendant with having imitated; it may be that the invention consists in the combination only. Seeing, therefore, that that which is required must necessarily very much embarrass the plaintiffs, and not being satisfied that there is any probability of surprise on the defendant for want of it, or that they do not possess an adequate amount of information on the subject, though I entertain no doubt as to the power of the Court to grant it, I am of opinion that this is, at all events, not a case for the exercise of that power.

THE ELECTRIC TELEGRAPH COMPANY *against* BRETT and LITTLE, }
A.D. 1851. 10 C.B. 838. }

Evidence of Infringement. Limitation by Title of Patent. Construction of Specification. Infringement by pirating part of an Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 12th June, 1837, No. 7,390, to *W. F. Cooke* and *C. Wheatstone*, for 'improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through *metallic circuits*.'

The declaration recited the patent, and certain indentures of assignment of the same to plaintiffs, and alleged that defendants had used and counterfeited the invention. Pleas: 1. Not guilty. 12. That the invention was not a new manufacture within the statute. 14. That it was not an improvement in giving signals through *metallic circuits*. And other pleas putting in issue the title of plaintiffs. Issue.

The patent related to the so-called *Five-needle* Telegraph appa-

ratus, which was tried on the *Great Western Railway*, but was speedily abandoned, and gave place to other systems founded upon it. The specification described the apparatus by reference to drawings, and showed it to consist of five galvanometer needles, mounted on horizontal axes upon a board, and having twenty letters of the alphabet arranged thereon in a lozenge-shaped figure. The needles were caused to deflect either to the right or left, *between stops*, by the agency of electric currents, which were directed by suitable keys, and the convergence of any pair of needles upon a letter indicated that such letter was being signalled. The method of arranging the conducting wires, batteries, and recording apparatus was explained, and was substantially that which has existed ever since. The apparatus required six separate conducting wires, viz., one for each of the five needles, and a sixth, or *return wire*, to bring the current back to the primary station. The specification stated:—‘That, if required, duplicates of the same apparatus were to be provided at any intermediate places between the two termini, where simultaneous and like signals were required to be given.’ It then described the arrangement of the conducting wires, and stated that the apparatus before the operator, as well as the duplicates at the distant and intermediate places, would all exhibit the same signals at the same time.

Claims: 1. ‘We wish it to be understood that we make no claim to the application of the multiplying coils of conducting wires herein described (meaning thereby the galvanometer coils and magnetic needles), but the improvement in the adaptation of magnetic needles for giving signals consists in disposing the needles in vertical planes with fixed horizontal axes; making them heavier at one end than the other, so that they hang perpendicularly; and limiting the angular motion by stops against which the needles may rest in suitable inclining direction for pointing out on a vertical dial the signification of the signals.’ 2. (In substance.) The combining several needles so as to give signals by determinate angular motions. 5. (In substance.) The improvement whereby the complete apparatus for giving signals and sounding alarms, as described, may have duplicates of such apparatus at intermediate places between the two ends, all such duplicates operating simultaneously with each other.

At the trial, it appeared that the alleged infringement consisted in working under a patent of 11th *Feb.* 1847, No. 11,576, to *A. Brett* and *G. Little*, for improvements in electric telegraphs. In defendants’ apparatus, a light divided ring magnet was suspended on a fine centre parallel to a flat reel of coiled conducting wire, and was made to swing a little either to the right or left by electric currents, pro-

perly directed, and passing through the coil. In the act of swinging, the ring pushed indicating needles, centred on pivots, also to the right or left, and produced a result resembling that given by an ordinary galvanometer coil and needle. The signals consisted in combinations of movements of the indicating needles, to the right or left, and in this way a telegraphic communication could be kept up by a single wire, while intermediate stations could both send and receive signals. It having been discovered by *Steinheil*, subsequently to the year 1837, that a return wire was unnecessary, and that the earth would complete the circuit, defendants used no return wire, but buried the ends of short lengths of wire, at opposite termini, in the ground, and in this way worked with a circuit, part only of which was metallic, the remainder being the substance of the earth itself.

WILDE, C.J. left the case to the jury, who found :—3. That the magnetic ring and indicator used by defendants was a different instrument from plaintiffs' needles. 4. That the sending of signals to intermediate stations was plaintiffs' invention. 5. That the angular motions of needles in vertical planes and on horizontal axes in combination with stops was the invention of plaintiffs. Verdict for plaintiffs. Leave reserved.

Rule nisi for a new trial, or to set aside the verdict on these findings, discharged by the Court of Common Pleas.

Per CRESSWELL, J.—The first objection was, that the patent of the plaintiffs being described in the title as an 'Invention of improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through metallic circuits,' no infringement had been made by the defendants, or, indeed, could be made, as long as the circuit they used was not metallic throughout, but to a substantial extent *non-metallic*. Now the patentees, by their specification, do not make any claim to metallic circuits. What they claim is improvements in giving signals by means of electric currents transmitted through metallic circuits, and the improvements, as appears by the specification, consist entirely in the methods and instruments for using the electric current. The circuit used by the defendants is metallic in all that part which operates in giving signals, and it is no condition necessary to the existence of the improvements that the circuit should be metallic in any other part than that which contains the coils, and operates on the needles. It appears to us reasonable to hold that a claim for a patent for improvements in the *mode* of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known

at the time of the claim, so long as it remains identical with regard to improvements claimed, and their application.

The second objection was, in substance, that the plaintiffs' patent was for a system of giving signals by means of *several wires and converging needles* pointing to letters, whereas the defendants had used *one wire*, and had made signals by counting the deflection of a needle or needles, which was found by the jury to be a different system from that of the plaintiffs. This objection appears to us to be founded on a wrong construction of the specification, which, we think, shows the patent not to be for a system of giving signals, but for certain distinct and specified improvements comprehending those now in question, the system being described only for the purpose of explaining the improvements claimed.

Another objection was that the breach in the declaration, being that the defendants had used and counterfeited '*the invention*' of the patentees, was not supported by evidence of the use or counterfeiting of part only. But on looking at the specification, which explains what the invention is, it appears to consist of nine specified improvements; and the declaration, in speaking of the said invention, is to be considered as if it charged the using, &c., of the said nine improvements, and is sufficiently proved by showing that one of them has been used.

With regard to the objection as to the claim to the verdict (on the issue of not guilty) regarding vertical needles, on considering the finding of the jury with regard to defendants' instrument (finding 3), in conjunction with the claim in the specification, it may be doubtful whether the plaintiffs can claim the verdict on this ground. But it appears to us that the use of duplicate apparatus at intermediate stations, which the jury have found a new invention, and which was undoubtedly used by the defendants, entitles the plaintiffs to retain their verdict.

It was insisted also that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not a new manufacture. But we think that the patentees not only communicated the idea or principle that duplicate signals might be given, but showed how it might be done, *i.e.* by a duplicate apparatus at each station; and that this is a fit subject of a patent. If, as was mentioned on the argument, the defendants have intermediate stations to *send* as well as to *receive* communications, it is a very important improvement, for which the inventors may probably be entitled to a patent, though they may not be entitled to use it, unless by the licence of the patentees of the less perfect invention on which their own is grounded.

ELLIOTT *against* TURNER, A.D. 1845. 2 C.B. 446; 462, *n.*

Misdirection by Judge. Construction of Specification.

COVENANT on an indenture of licence by plaintiff to defendant for the manufacture of buttons according to a patent of 14th Dec. 1837, No. 7,508, to *W. Elliott*. The issue was, whether certain buttons made by defendant were made under the licence.

At the trial, it appeared that the specification stated:—‘The third part of my invention being the application (to the covering of buttons) of such fabrics only wherein the ground or face of the ground thereof is produced by a warp of *soft or organzine silk*, such as is used in weaving satin and the classes of fabrics produced therefrom.’ COLTMAN, J. directed the jury:—That unless the silk were organzine, it was not within the patent. Verdict for defendant.

Error brought on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Parke, Alderson, Rolfe, Platt, BB., Patteson, Williams, Coleridge, Wightman, JJ.)

Per PARKE, B.—The word *or*, in its ordinary and proper sense, is a disjunctive particle, and the meaning of the term ‘*soft or organzine*’ is, properly, either one or the other; and so it ought to be construed, unless there be something in the context to give it a different meaning, or unless the facts properly in evidence, and with reference to which the patent must be construed, should show that a different interpretation ought to be made. The learned judge should not have told the jury *absolutely* that soft and organzine silk were the same; he should have stated that the words were *capable* of being so construed if the jury were satisfied that at the date of the patent only *one* description of soft silk, and that organzine, was used in satin weaving; but otherwise, that the proper and ordinary sense of the words was to be adopted, and the patent held to apply to every species of soft silk as well as to organzine silk.

Second trial of the same action, and verdict for plaintiff.

ELLWOOD and OTHERS *against* CHRISTY and OTHERS, A.D. 1864–5. }
17 C.B. N.S. 754; 18 C.B. N.S. 494. }

Assignment by Executors before Registration of Probate. Account.

CASE for the infringement of a patent for an improved hat or helmet for hot climates. Plaintiffs also prayed a writ of injunction and account. It appeared that plaintiffs claimed under an assignment by the executors of the patentee under the circumstances following:—On 3rd Dec. 1862, probate of the will was granted; on 5th Feb. 1863, the executors assigned the patent to plaintiffs; and

on 10th *April*, 1863, they registered the probate, but delayed to register the assignment until 14th *April*, 1863.

At the trial, it was submitted that the executors had no title to convey at the time of making the assignment (see stat. 15 & 16 Vict. cap. 83, sect. 35), and that plaintiffs could not maintain the action. ERLE, C.J. over-ruled the objection. Verdict for plaintiffs. Leave reserved.

Rule for a new trial refused by the Court of Common Pleas. (Erle, C.J., Byles, Keating, JJ.)

Per ERLE, C.J.—There is nothing whatever in this point. If the plaintiffs had commenced their action before they had completed their title, by registering the probate, the case would probably have been different.

Motion for a rule, in the terms of that granted in *Walton v. Lavater* (8 C.B. N.S. 162), for an account ‘of all profits of which the plaintiffs have been deprived by means of the infringement in the declaration mentioned,’ and for payment of the same. Rule made absolute for an account of profits made by defendants by means of the infringement, from the date of registration of the assignment.

Per WILLIAMS, J.—It does not appear from the report of *Walton v. Lavater* that the Court absolutely sanctioned the amended form of rule. The matter was not contested.

Per WILLES, J.—We do not decide that the plaintiffs could not recover in the cause any damages they may have sustained. All we decide is that such damages can only be recovered at the hands of a jury, and not by means of an account taken before the master under stat. 15 & 16 Vict. cap. 83, sect. 42.

ELMSLIE *against* BOURSIER, A.D. 1869. L.R. 9 Eq. 217.

Infringement by Importation and Sale of Patented Articles.

Suit to restrain from infringing a patent for the manufacture of sheet tin. It appeared that defendant had consigned to a *London* agent several parcels of tinfoil, manufactured in *Paris*, according to the patented invention. Decree for injunction, and account as prayed, with an inquiry as to damages, and the costs of the suit; following the decree in *Betts v. Neilson* (L.R. 3 Ch. 429). But see the judgment of the House of Lords in *Betts v. Neilson* (L.R. 5 H.L. 27), where the decree for an account and inquiry as to damages was made alternative.

Per JAMES, V.C.—I am of opinion, in this case, that the obtaining from abroad and selling in this country an article manufactured according to the specification of a patent, is a violation of the privileges granted by the letters patent.

REX *versus* ELSE, A.D. 1785. Bull. N.P. 76; Dav. Pat. Ca. 144.

Novelty of Invention.

Sci. fa. to repeal a patent of 29th Oct. 1779, No. 1,235, to A. Else, for 'a certain new manufacture of lace, called *French* or wire-ground lace, which is much stronger than any hitherto invented.' The specification stated the invention to be 'mingling a fine thread of silk or other such material with thread, flax, hemp, cotton, which has usually been worked in a stocking-frame, which addition gives strength, firmness, and durability to the work. The manner of working the same is such as is common in making *open work*.' There was no separate claim.

At the trial, it appeared that, prior to the patent, silk and cotton thread had been used together and mixed upon the same frame for making lace. Defendant's counsel admitted this to be the fact, but said he could show that the mixed thread was inadequate for making lace.

BULLER, J. said:—'It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it; and therefore, as it has been proved that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void.'

Verdict for the Crown.

FEATHER, *suppliant*, against THE QUEEN, A.D. 1865. 6 B. & S. 257.

Right of the Crown to use a Patented Invention.

Petition of right, alleging that suppliant, R. B. Feather, was grantee of a patent of 26th Nov. 1852, No. 884 (in part disclaimed), for an invention of improvements in the construction of ships, and that the commissioners for executing the office of Lord High Admiral of the *United Kingdom* had infringed the patent right, by the construction and use of a ship for the service of the Crown called the *Enterprise*, to the damage of the suppliant of 10,000*l.* The Crown, after setting out the patent, specification, and disclaimer, demurred to the petition of right.

Judgment for the Crown.

The patent was in the usual form, and contained, *inter alia*, the clause that the letters patent should be 'taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of' the patentee. There was also a proviso, on the part of the Crown, that 'if the said R. B. Feather, his executors, administrators, or assigns, should not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be re-

quired, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding.'

Per COCKBURN, C.J.—On the demurrer to this petition of right two questions present themselves for our determination: first, whether, by the effect of the letters patent, the Crown is excluded from the use, except with the assent of the patentee, of the invention protected by the patent; secondly, whether, if the foregoing question be answered in the affirmative, a petition of right can be maintained by the suppliant against the Crown for the infringement of his patent right.

It is true that the patent gives to the patentee the sole privilege of making, using, exercising, and vending the invention; but, on the other hand, there are no express words to take away from the Crown the right of using the invention. The statute of James was only declaratory of the common law, and these grants of monopoly in respect of inventions are not by force of the statute, but by virtue of the prerogative. They are therefore subject to the rule of construction applicable to grants of this nature.

It appears to us that the assumption of a contract between the Crown and the patentee is altogether fallacious. The grant of the patent is simply an exercise of the prerogative, in which—the ground on which alone the grant of a monopoly is justifiable being that the invention shall be made available to the public—the Crown annexes as a condition of the grant that the true nature of the invention, and the manner in which it can be used, shall be fully and unreservedly disclosed. It was insisted that the concluding clause of the letters patent—namely, that such letters patent are 'to be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the grantee'—was strong enough to show that the stricter rule of construction usually prevailing with reference to grants from the Crown ought not to be applied to patents for invention. We, however, think that this clause ought not to have this effect. We think its true purpose and effect is that pointed out by Mr. *Hindmarch*, in his valuable work on patents, pp. 72, 73, namely, that of preventing the want of certainty which ordinarily exists in the description of an invention in a patent, prior to the specification, from avoiding the grant for uncertainty.

Another argument arising on the terms of the patent was founded,

on the clause which provides that the patentee shall supply the patented article, if required, for the service of the Crown, upon reasonable terms, which provision it was contended necessarily implied that the Crown could not itself have manufactured or prepared the article. We think that to give this clause by implication the operation for which Mr. *Bovill* contended, would be directly to violate the rule of construction, which, according to the authorities, should be applied to grants from the Crown, and which prohibits any effect being given by implication, adversely to the Crown, beyond what is clearly expressed in the grant.

The infringement of a patent right constitutes a tort or wrong, in the proper sense of the term; and, as no wrongful act can be alleged against the Crown, we are of opinion that, even if our decision on the first question had been in favour of the suppliant, a petition of right to the Crown would not be open to him as a means of redress.

FELTON *against* GREAVES, A.D. 1829. 3 Car. & P. 611.

Sufficiency of Specification. Title of Patent too large.

CASE for the infringement of a patent of 28th *June*, 1827, No. 5,512, to *J. Felton*, for 'a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments.' Plea: Not guilty. Issue.

The specification stated:—'My invention consists 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 manner explained.' Then followed a description and drawing, which showed two parallel circular files, with alternate ridges and hollows, the ridges of one fitting into the recesses of the other; the ridges only being files. The specification went on to say:—'The cylinders may be of steel or any other suitable metal or hard material.' *Claim*: 'The machine hereinbefore described for the purposes aforesaid.'

At the trial, it appeared that the machine was useful in the sharpening of knives, but that one of the rollers used for giving an edge to scissors ought to be smooth; also that if *Turkey* stones were used for both rollers, the machine could be applied for sharpening scissors. LORD TENTERDEN, C.J. was of opinion that the specification was bad, and said:—'I cannot find that the scissor sharpener is described as having the two rollers different. With respect to constructing the rollers with *Turkey* stone, I cannot find that it is anywhere stated in the specification that *Turkey* stones used on both sides will do for scissors.'

Plaintiff nonsuited.

FINNEGAN *against* JAMES, A.D. 1874. L.R. 19 Eq, 72.

Practice in Patent Suits. Particulars of Breaches ; and of prior User.

Suit to restrain from infringing a patent. Plaintiff filed interrogatories requiring defendants to set forth particulars specifying the names and addresses of the persons by whom, the places where, the dates at, and the manner in which plaintiff's invention was alleged to have been used before the date of the patent. Defendants having declined to furnish the required particulars, plaintiff filed exceptions.

At the hearing, defendants submitted that they ought not to be compelled to put in a further answer until particulars of breaches had been delivered.

JESSEL, M.R. allowed the exceptions, and said that he saw no reason why the practice as to furnishing particulars should be confined to cases in which the Court directed issues. In his opinion the practice at law ought to be followed as closely as circumstances would permit. The exceptions would be allowed ; but the plaintiff must deliver particulars of the breaches complained of, and the defendants would have fourteen days from the time of such delivery to put in a further answer. Costs to be costs in the cause.

FISHER *against* DEWICK, A.D. 1838. 4 Bing. N.C. 706 ; }
1 Webs. Pat. Ca. 264 ; Cited 8 Q.B. 1056. }

Notice of Objections. Title of Patent.

CASE for the infringement of a patent of 31st Dec. 1831, No. 6,208, to *W. Sneath*, for 'improvements in machinery for the manufacture of bobbin net-lace.' The defendant delivered a notice of objections, under stat. 5 & 6 Will. IV. cap. 83, sect. 5, stated in the most general terms, *e.g.*: 4. 'That if any part [of the improvements] were new, the same was useless and unnecessary, and not the ground of any patent at all.' 6. 'That the said improvements, or some of them, had been publicly and generally used long before the granting of the said letters patent.'

Rule nisi to rescind an order for better particulars discharged by the Court of Common Pleas. (Tindal, C.J., Park, Vaughan, Coltman, JJ.)

Per TINDAL, C.J.—The object of the statute was not to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of evidence. Under the 5th section, therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely. The present particulars are so vague that they can scarcely have been furnished with any other object

than to mislead. For instance, the objection that if any part be new, the same is useless and unnecessary: the defendant should have pointed out what part. That the improvements, or some of them, had been used long before: the defendant should have pointed out which. If he would, in the *Scotch* phrase, *condescend* upon the parts to which he objects, there would be an end of the difficulty.

The objections next came before TINDAL, C.J. at Chambers, on a summons for further amended particulars, but the questions raised were unimportant.

The report in the Q.B. series contains the following observation made by Pollock, A.G., in the course of his argument:—

‘In *Fisher v. Dewick*, tried before Coltman, J., the patent was for improvements in machinery for making bobbin net-lace. Sir J. Campbell, for the defendant, objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part of the process, and being useless where that addition was not wanted; and he said the title should have been “for a mode of making spots in bobbin net-lace.” But the learned judge overruled the objection; and the Court of Common Pleas supported his ruling; TINDAL, C.J. observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net-lace.’

FORSYTH *against* RIVIERE, A.D. 1819. Chit. Prerog. Cr. 182.

Priority of Invention.

CASE for the infringement of a patent of 11th *April*, 1807, No. 3,032, to *A. J. Forsyth*, for giving fire to artillery and fire-arms.

Verdict for plaintiff.

ABBOTT, C.J. held that if several simultaneously discover the same thing, the party who first communicates it to the public is entitled to the benefit of it.

FOXWELL *against* WEBSTER, A.D. 1863. 2 Drew. & Sm. 250; }
4 De G. J. & S. 77. }

Practice in Patent Suits. Consolidation of Suits against different Infringers.

Suit to restrain from infringing a patent (in part disclaimed) of 16th *Oct.* 1852, No. 413, to *C. T. Judkins*, for ‘improvements in machinery or apparatus for sewing or stitching.’ It appeared that plaintiff was assignee of the patent, and that he had filed 134 bills against separate defendants. Four motions were now made by four groups of defendants, amounting in the whole to seventy-seven, the substance being that the suits should be consolidated, and that either one suit selected by plaintiff should be prosecuted, and pro-

ceedings in the remainder stayed, or else that the validity of the pat. should be tried once for all, and the time for answering be enlarged, each defendant reserving his own defence on the ground of non-infringement. KINDERSLEY, V.C. dismissed the motion, but without prejudice to any application after answer, with a view to regulating the course of the proceedings, and said:—‘A patentee has no right to join as defendants any number of persons infringing, not even two. Now here the plaintiff has filed 134 bills against 134 different persons, who, he alleges, are infringing; and it is said, How can it be necessary to file so many bills? But it is a settled rule of this Court that if a person wishes to obtain an injunction he must not sleep upon his right; he must come to the Court speedily; and if in this case the plaintiff had proceeded against one or more of the persons alleged to be infringing, and had abstained from filing bills against the others, his remedy by injunction against them would have been prejudiced. It would be in vain for him to say that he was waiting the result of a trial against some others. The fact that there are 134 suits does not affect the duty of each defendant to answer the interrogatories addressed to him, and which will or may give the plaintiff the benefit of a decree. The defendants have come too soon.’

On appeal, LORD WESTBURY, L.C. suggested:—‘That the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every machine made, used, or sold by them, and whence obtained, and when used, and full discovery of the profits derived therefrom, undertaking also to pay a royalty in respect of each machine, if the validity of the patent and its infringement should be established.’ This course was agreed to, on condition that defendants would furnish verified models of every machine so made, used, or sold by them respectively. His Lordship then made an order directing an issue as to the validity of the patent (certain defendants being selected as representatives), the result to be binding on plaintiff and all parties to the motions. The trial to take place by consent before his Lordship without a jury. All particulars of objections to the patent under stat. 15 & 16 Vict. cap. 83, sect. 41, to be delivered within a fortnight.

FOXWELL *against* BOSTOCK, A.D. 1864. 4 De G. J. & S. 298.

Sufficiency of Specification. Obligation in specifying where the Patent is for an improved Machine. Validity of Disclaimer.

Trial before WESTBURY, L.C. without a jury, and under the order made in the previous case, of the issue as to the validity of plaintiff's patent.

The patent related to a form of sewing machine, wherein a single shaft with three cams upon it gave the three principal movements—viz., 1. The movement of the needle; 2. The movement of the shuttle; 3. The feed-motion of the cloth. And it was the disposition of these three cams upon one shaft which formed the invention.

The specification stated:—‘My invention relates to an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle, and of regulating the supply of thread so as to keep it at a proper tension, with a means of enabling the mechanism to accommodate itself to different thicknesses of thread.’ It then proceeded to describe the machine by reference to drawings, Figs. 1, 2, 3, giving side and front elevations and a plan of the entire machine, and showing the action of the cams. It also described the regulation of the supply of thread of different thicknesses, and the construction of a spring-presser for holding down the work. The drawings were incomplete.

Claim: ‘The combination and arrangement of the various parts of machinery for sewing or stitching with the use of a needle and shuttle, the methods of regulating the supply of thread to the needle and shuttle, the arrangement of accommodating the machinery to the different thicknesses of the thread or silk, and the means of preventing the material rising or missing the stitch when different thicknesses present themselves.’

On 15th *April*, 1853, plaintiff, *D. Foxwell*, being assignee of the patent, filed a disclaimer and memorandum of alteration, in which the several drawings were amended and corrected, so as to form sufficient drawings for the specification. The description of the machine was amended, as was also the description of the three subordinate improvements—viz., the method of supplying the thread, the arrangement for different thicknesses, and the means of preventing the material rising. But the amended *claim* was: ‘I claim as new and of my invention the combination and arrangement of the various parts of machinery for sewing and stitching, with the use of a needle and shuttle.’

An objection was taken that the patent was bad, on account of a variance between the provisional and complete specifications; but WESTBURY, L.C. thought the objection removed by disclaimer, and that, speaking generally, the provisional and complete specifications ought not so to differ that the nature of the invention described in the one should be materially different from that described in the other. His Lordship then proceeded to give judgment, and said:—‘The patent was granted for ‘improvements in machinery or apparatus for sewing or stitching,’ and by the original specifi-

cation they were described as consisting of ‘*an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle* ;’ and also, separately, of means for regulating the supply of the silk or thread, for accommodating the machinery to different thicknesses of thread or silk ; and, thirdly, for preventing the material rising, or the missing of the stitch. Then those three last-mentioned operations and the machinery for effecting them are treated in the original specification, and also by the disclaimer, as separate improvements, and as not forming part of that combination of machinery which is the principal subject of the patent. That patent and the original specification and disclaimer all assume this as being the case, and treat these three separate arrangements as being something which may be excised and eliminated without prejudice to the rest of the invention. But as the rest of the invention is the combination of machinery, those three parts could not have formed part of that combination, for if they had done so they could not have been disclaimed ; unless, indeed, the patent and the original specification had treated them both as separate inventions, and also as integral parts of the combination, which is not pretended by the plaintiff to have been the case ; and if it had been pretended could not have been maintained. The consequence, then, is this :—That the combination of machinery now described in the amended specification is different from the combination of machinery described in the original specification, and for which the patent was granted.

The question then arises—Is the patent void, or is the disclaimer void ? And to this question it is not easy to find an answer. There is no express enactment in stat. 5 & 6 Will. IV. cap. 83, that the disclaimer, if it transgresses the statutory limit, by extending the exclusive right, shall be void to all intents and purposes ; and unless it be so, it must remain enrolled with and always accompany the letters patent in the specification. It might be proper to hold that the disclaimer is inoperative for the excess only, where that excess is clearly distinguishable ; and this is the course which I have been most anxious to take in the present case. But I have found it impossible so to do.

It is, in my judgment, clear that the mechanical arrangements for effecting the auxiliary inventions are left intentionally in their corrected and amended form, as integral parts of that combination of machinery to which the patent, by the operation of the disclaimer, is intended to be confined. The result is, not only that the combination in the amended specification is different from the combination in the original specification, but also that there is no specification remaining of that invention for which the patent was granted.

But there is another and more material objection to the sufficiency of the specification. The patent is for 'improvements in machinery or apparatus for sewing or stitching,' and the specification describes the invention as consisting in 'an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle.' The words, '*improved arrangement,*' or '*improved combination,*' indicate the nature of the invention. But it is the duty of the patentee particularly to describe and ascertain his improvements in his specification, for it is the improvements which constitute the invention. The plaintiff's counsel contend that this is done by the drawings and the description of the drawings; but the drawings and the description thereof exhibit and describe an entire machine, and the composition and working of its several constituent parts, without in any manner indicating where the improvement lies, or in what it consists. It must follow that an accurate knowledge of the construction of all needle and shuttle machines, which were known and used in *England* at the date of this patent, is necessary, in order to discover the differences and novelties that existed in this improved combination. The law requires that the specification should be intelligible to a workman of ordinary skill and information on the subject. A new combination or improved arrangement of machinery, therefore, should be so described as that a person of ordinary knowledge on the subject may be able at once, on reading the specification, to perceive the invention, and the manner in which it is to be performed. It is not sufficient to say that a person possessed of all the knowledge existing at the time of the patent on the subject of sewing machines, will discern the improvement. That is more than the law requires.

The difficulty of the plaintiff arises entirely from the character which he has thought fit to give to his alleged invention, and the manner in which he has described it. His counsel had no difficulty at the bar in describing his improvement. They stated it to consist of an arrangement of three cams on one shaft, by the direct action of which the three principal motions in a needle and shuttle machine—viz., the needle movement, the shuttle movement, and the feed movement—are effected; and the plaintiff's evidence was directed to show that this arrangement formed the novelty and utility of the patent. But this clear and simple statement is not to be found anywhere in the specification. The argument is, that this is not necessary where the patent is for a combination. But I think that both on principle and authority it is most necessary that the specification should ascertain the improvement when the patent is for an improved—that is, for a new—combination. If a combination of machi-

nery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particular of the existing constituent parts of the machine, such improved arrangement or combination may be patented; but it would be contrary to the spirit of the patent law and of the decided cases to permit a patent to be taken out for a new combination, and the whole machine to be described and specified as a new invention, without in any manner distinguishing or marking the improvement by the introduction or addition of which the improved arrangement or the improved combination is in reality produced. The term, '*combination of machinery*,' which has become a favourite form of words with patentees, is nothing but an extended expression of the word '*machine*.' It is the word '*machine*' writ large; and as a patent for an improved machine, in the specification of which the improvement was not particularly stated and described, would hardly be attempted to be supported, so neither in my judgment can the patent for an improved arrangement or combination be supported, in the specification of which there is nothing to distinguish the new from the old. It is true that the case of *Harmar v. Playne* (11 East. 101) was held to be an exception to this rule, but *exceptio probat regulam*. In that case a patent was taken out for a machine; the inventor afterwards discovered an improvement, and he took out a second patent for an improved machine, and in the specification of that second patent he described the whole machine, without distinguishing the improvement; and the objection was that the specification was insufficient, and the patent bad; but inasmuch as in the second patent he had recited the first patent, and the specification under it, it was held that that recital being in immediate comparison with the new specification, furnished *in gremio* of the new patent the means of distinguishing the new from the old.

I must therefore lay down the rule, which is consistent with and in reality a mere sequence 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, to use a logical phrase, assign the *differentia* of the new combination. This obligation flows directly from the condition of the patent; it is part of the condition of the patent that the specification shall particularly describe and ascertain the invention. With that condition this specification, in my judgment, fails to comply. If the disclaimer

were treated as void, and the case were remitted to the original specification, I should be of opinion for the same reasons that that also was insufficient. I must therefore declare that the specification of this patent is insufficient, and that the patent is void in law.

His Lordship then ordered a stay of proceedings in all the causes, with costs against plaintiff, including the costs of the order, with liberty to defendants in the other causes to move to dismiss the respective bills against them for want of prosecution.

GALLOWAY and ANOTHER *against* BLEADEN, A.D. 1839. }
1 Webs. Pat. Ca. 521. }

Novelty of Invention. Prior experimental User.

CASE for the infringement of a patent of 18th *Aug.* 1835, No. 6,887, to *E. Galloway*, for 'improvements in paddle wheels for propelling vessels.' Pleas: 3. That the invention was not particularly described by the specification. 4. That the invention was not new. Issue.

The patent related to a mode of constructing the floats of paddle wheels so as to lessen their concussion with the water, and to diminish the drag of water behind the wheel. Each float was formed of a series of narrow bars placed at an angle to the radius of the wheel and arranged in a *cycloidal* curve. This curve was traced out by a point in the circumference of an imaginary circle, centred on the paddle shaft, and rolling on the surface of the water. The specification stated:—That the bars forming a paddle float would in this way enter the water at the same point, or very nearly so, whereby the amount of displaced water would be diminished, and the loss of power as well as the concussion consequent upon the use of the common radial float would be obviated. It further described the invention to consist in affixing the portions of floats or paddles according to the arrangements herein described.

At the trial, Mr. *Field*, the engineer, deposed that in 1833 he had made a model of a paddle wheel with divided floats placed in a cycloidal curve, and had exhibited the same at the Admiralty; that he had fitted a small steamer on the *Thames* with such a wheel; that it had answered well, but was taken off after a few weeks' trial; that in 1835 he had constructed an apparatus for experimenting with various paddle wheels, chiefly cycloidal wheels; that the experiments went on from *April* till *July*, 1835, no secrecy whatever being observed; on the contrary, persons were invited to come and see the trials.

TINDAL, C.J. directed the jury:—If there is a want of clearness in the specification so that the public cannot afterwards avail themselves of it; much more, 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, no doubt the patent itself would be completely void.

The main point in this case is, whether this improvement was new as to the public use and exercise thereof in *England*. A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to completion, but begins and ends in uncertain experiments, is not such an invention as should prevent another person, who is more successful and pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it; therefore the main point in this case is, whether all that is allowed to have been done by Mr. *Field* rested in experiment, and unsuccessful experiment, not conducted to its full result, or whether it was a complete discovery of that which now forms the subject-matter of the patent. Verdict for plaintiffs.

GAMBLE *against* KURTZ, A.D. 1846. 3 C.B. 425.

Evidence of Infringement. Novelty of Invention.

CASE for the infringement of a patent (in part disclaimed) of 14th *March*, 1839, No. 8,000, to *J. C. Gamble*, for 'improvements in apparatus for the manufacture of sulphate of soda, muriatic acid, chlorine, and chlorides.' Pleas: 1. Not guilty. 2. That the plaintiff was not the true and first inventor. 3. That the invention was not new. Issue.

The patent related to the manufacture of sulphate of soda. The specification described the apparatus by reference to drawings, and showed two decomposing chambers A, A, placed upon opposite sides of a central or finishing chamber B, but connected therewith by short passages. The operation consisted in placing equal weights of common salt and sulphuric acid in the chambers A, A, and exposing the material to a regulated temperature, which liberated a quantity of muriatic acid gas. The partially decomposed residuum was then pushed into the retort B, and roasted at a high temperature, until its conversion into sulphate of soda became complete. Receivers were also arranged for the condensation of the muriatic acid gas.

The specification stated:—'Instead of the brick furnaces hitherto employed I have found that *iron retorts* may be advantageously substituted.' *Claim*: 'I do not claim the exclusive use of iron retorts, but I claim as my invention iron retorts worked in connection with each other as above described. I claim the use of receivers so arranged that the acid can pass from one to the other.'

At the trial, it appeared that before the patent the common prac-

tice had been to use a single chamber only. But evidence was adduced of the user at *Berwick* of two chambers connected by an inclined spout about twelve feet long, through which the material was passed from one to the other for the final roasting. Similar evidence was given of prior user at *Manchester*. Defendant also put in evidence the specification of a patent of 13th Oct. 1836, No. 7,208, to *T. Lutwyche*, for an apparatus to be used in making sulphate of soda, consisting of a decomposing chamber with two floors on a different level for the two stages of the operation. The alleged infringement consisted in the use of two chambers, one of iron, the other of brick, connected by an opening, through which the materials were transferred from the one to the other.

Verdict for plaintiff on all issues except the second and third, as to which the jury found:—That the alleged invention of the use of two chambers, with separate furnaces, was not new, but that the plaintiff's mode of connecting them was new. Leave reserved.

Rule nisi to enter a verdict for defendant on second and third issues made absolute by the Court of Common Pleas.

Per COLTMAN, J.—We are clearly of opinion that the verdict for the plaintiff on the issue of not guilty must stand. The material of which the chambers are composed not being of the essence of the invention, the patent right might be invaded though the chambers used by the defendant were not of the material mentioned in the plaintiff's specification.

The other question depends upon what is the true nature of the plaintiff's claim as an inventor. It was contended that he claimed the use of two retorts in connection with the whole of the apparatus for condensing the muriatic acid gas. But the words of the specification are 'in connection with each other.' We can give no other meaning to this than that the plaintiff claimed, as part of his invention, the use of two chambers with separate furnaces, worked in connection with each other, so that the materials might be decomposed in one, and then removed to and roasted or finished in the other. The jury having found that the evidence did not establish this claim, the verdict on the special finding must be entered for the defendant.

GARDNER *against* BROADBENT, A.D. 1856. 2. Jur. N.S. 1041.

Affidavit of title in Patent Suits. Recent Patent.

Suit to restrain from infringing a patent. Motion to dissolve an *ex parte* injunction. It appeared that plaintiff had bought the patent, and his affidavit merely stated that the patent had been duly recorded, and that he believed it was valid. The patent had run for

little more than a twelvemonth. STUART, V.C. dissolved the injunction with costs, but without prejudice to the bringing of an action, and said:—‘When the plaintiff applied for an injunction, his affidavit ought to have stated clearly and distinctly that he believed that the patentee, from whom he purchased the patent, was the original and true inventor, and that he believed that the invention had not been practised at the time the patent was granted. That was necessary, because the injunction asked for was to protect a legal title, which legal title ought to be sworn to, and the facts supported before the Court. There was no law of this Court which prevented a patentee by the *recency* of his patent from applying for an injunction *ex parte*: and he wished it to be understood that the law of the Court was that laid down by Lord Eldon in the case of *The Universities of Oxford and Cambridge v. Richardson* (6 Ves. 689).’

GIBSON and CAMPBELL *against* BRAND, A.D. 1842.

1 Webs. Pat. Ca. 627 ; 4 M. & G. 179 ; 4 Scott N.R. 844. }

Evidence of Infringement. Novelty of Invention. Obligation in Specifying. Infringement by sale of Patented Articles. Patent for a Process.

CASE for the infringement of a patent of 19th Nov. 1836, No. 7,228, to *J. G. Campbell* and *J. Gibson*, for ‘a new and improved process or manufacture of silk, &c.’ The declaration alleged that defendant had directly and indirectly *made, used, and put in practice* the said invention. Pleas: 1. Not guilty. 2. That plaintiffs were not the true and first inventors. 3. That the invention was not new. Issue.

The patent related to a method of preparing and spinning silk waste in combination with wool or flax. The specification stated eight heads of invention, *e.g.*—1. Discharging the gum from silk waste. 2. Dyeing the material. 4. Spinning silk waste of long fibre in combination with flax of the same length of fibre. 6. The application of the improved process to the throstle machine on the principle of the long ratch for spinning silk waste. 7. Certain improvements in the throstle machine whereby its utility is augmented in spinning silk waste. *Claim*: ‘We restrict our claims to the eight general heads of invention before mentioned, all of which we believe to be new, and of great public utility.’

At the trial, evidence was adduced contradicting the novelty, both of the process and of the machinery.

It further appeared that defendant had ordered silk waste to be spun by certain parties in *England*, by a process similar to that patented, and had received and sold the silk so spun. TINDAL, C.J. directed the jury:—A man may publish to the world that which is

perfectly new in all its uses, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. It would not be sufficient to destroy this patent to show that learned persons in their studies had foreseen or had found out this discovery that is afterwards made public, or that a man in his private warehouse had by various experiments endeavoured to discover it and failed, and had given it up.

If the defendant has sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration.

The jury found for plaintiffs on all issues except the second and third, and as to these the finding was:—That the invention was not new, but was an improved process, and not a new combination.

Rule nisi to enter a verdict for defendant on the second and third issues made absolute by the Court of Common Pleas. (Tindal, C.J., Coltman, Erskine, Cresswell, JJ.)

Per TINDAL, C.J.—The proof that an order had been given by the defendant, in *England*, for the making of silk by the same process as the plaintiffs', which order had been executed in *England*, is enough to satisfy the allegation in the declaration—that the defendant made, used, and put in practice the plaintiffs' invention—though the silk was, in fact, made by the agency of others.

It is not necessary, on this occasion, to go into the question whether or not a patent can be supported for a *process* only. If the specification were properly prepared, it probably might be considered a fit subject for a patent. Lord C.J. Eyre seems to be of that opinion in *Boulton v. Bull* (2 H. Bl. 493). I confess I feel it impossible to apply the language of the specification otherwise than to a substantive claim to an invention of a new machine, or a new combination of the parts of an old machine; the jury, however, have by their special finding negatived both, and, upon the evidence, I see no reason to be dissatisfied with that finding.

Per COLTMAN, J.—I am not prepared to say that a new process may not be considered a manufacture within the meaning of the statute (21 Jac. I. cap. 3).

Per CRESSWELL, J.—A party who obtains a patent is bound clearly to define in his specification what it is he claims to be 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 an infringement of the patent. (See 4 Scott N.R. 490.)

GILLETT and ANOTHER *against* WILBY, A.D. 1839. 9 Car. & P. 334; }
1 Webs. Pat. Ca. 270. }

Evidence of Infringement. Practice as to Certificate for Costs.

CASE for the infringement of a patent of 21st Dec. 1836, No. 7,266, to *S. Gillett* and *J. Chapman*, for 'improvements in cabs.' Plea 2. That the alleged improvements were not new. Issue.

At the trial, it appeared that the specification described five improvements, and it was contended that plaintiffs were bound to show that all of them had been imitated, but COLTMAN, J. directed the jury:—The plaintiffs must make out to your satisfaction that the whole of the improvements were new, and that some of them have been pirated. It is not necessary that they should all have been used, but they must be shown to be all new; and if they are all new, and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all. Verdict for plaintiffs.

There being a plea that the invention was not new, the judge certified under stat. 5 & 6 Will. IV. cap. 83, sect. 3, that the validity of the patent came in question.

GILLETT *against* GREEN, A.D. 1841. 7 M. & W. 347; }
1 Webs. Pat. Ca. 271. }

Practice as to Certificate for Costs.

CASE for the infringement of a patent, where after verdict a certificate was given by the judge under stat. 5 & 6 Will. IV. cap. 83, sect. 3. On the trial of a second action for infringing the same patent, the above certificate was put in evidence, but no application was made to the judge to certify under stat. 3 & 4 Vict. cap. 24, sect. 2, that the action had been brought to try a right.

Rule to tax plaintiff his treble costs refused by the Court of Exchequer. (Parke, Alderson, Gurney, Rolfe, BB.)

Per PARKE, B.—It is said that the Lord Chief Baron has still the power of certifying; but that is not so: the statute expressly directs that the plaintiff shall not recover costs where the damages are under 40s., unless the judge shall 'immediately afterwards certify' that the action was brought to try a right, &c. It may even be a question whether the judge could grant the certificate after another cause had been called on.

GOUCHER *against* CLAYTON and OTHERS, A.D. 1864-5. }
 11 Jur. N.S. 107, 462; 34 L.J. Ch. 239. }

Estoppel. Construction of Specification. Evidence of Infringement.

Suit to restrain from infringing a patent (extended for three years) of 25th Nov. 1848, No. 12,343, to *J. Goucher*, for 'a machine for thrashing corn and other grain.' The patent related to an improved form of beater in thrashing machines. The specification stated:—'I construct a thrashing machine with grooves or channels in the surfaces of the beater, such grooves or channels being of suitable dimensions to allow the corn and straw to lodge therein and pass through, without being injured by the surfaces between and by which the corn is beaten out and separated.' The drawing showed the beater, constructed of six longitudinal bars, supported on arms or spokes, so as to form an open cylindrical frame. Each bar was of iron, bound round with iron wire in a spiral, the spaces between the convolutions of the wire forming the grooves or channels on the bar. The specification went on to say:—'I prefer that the roof should be perforated, so as to admit of the passage of grain and chaff.' *Claim*: 'My invention of a thrashing machine, in which the surface of the beaters is grooved or channelled, and the roof perforated, as above described.'

It appeared that in 1854 plaintiff took proceedings at law against a certain firm, *Clayton & Co.*, for infringing his patent. The firm submitted to a judgment in the action, and took a licence for five years (afterwards extended to seven years) to work under the patent. The present suit was instituted in 1864 against the same firm, but two new partners had entered the firm after the judgment at law. Defendants raised the issues of want of novelty and insufficiency of the specification. An objection was taken that defendants were estopped, both as having been licensees, and by reason of the judgment at law, from disputing the validity of the patent. Wood, V.C. said that he thought the defendants were not estopped from denying the validity of the plaintiff's patent, and in any case he could not prevent the defendants, who were not parties to the action at law, from setting up this defence.

A supplemental bill was also filed, and it appeared by the answer that defendants had sold two thousand of plaintiff's beaters since the expiration of the licence, and that many of them had been exported to *Austria*. Defendants also denied their liability to pay a royalty on any beaters supplied by way of renewal to thrashing machines.

At the hearing, Wood, V.C. decreed an account of all beaters furnished by defendants by way of renewal and for exportation,

and said:—‘It appears to me that what the plaintiff really claims is an improved beater for thrashing machines. He has not described the perforation of the roof as his invention, but all he says is, that he prefers the perforated roof. The defendants have made a number of these beaters without reference to any machine, to supply the foreign market in *Austria*. It was not contended that that had been done under the licence; but the argument has been upon the authorities, that the making of parts of an invention in this country, and the exportation of those parts, do not constitute an infringement of a patent for a complicated machine, because those single parts do not make the machine—the patented article—and the making of those parts in itself is lawful. That might be so in those cases where the whole patent was for a new combination of machinery, every part of the machinery being old. In the case I have before me, the beater is the whole thing claimed, as I have held on the construc’ion of the patent; and therefore the making of the beater is a distinct and plain invasion of the patent, and in that respect the plaintiff will be entitled to an account.

GREAVES *against* THE EASTERN COUNTIES RAILWAY COMPANY, }
A.D. 1859. 1 E. & E. 961. }

Practice as to Costs.

CASE for the infringement of a patent. Notice of trial was given and countermanded, whereupon defendants, after notice, entered a suggestion, and signed judgment. On taxation, the master disallowed all items relating to the particulars of objections which had been duly delivered under stat. 15 & 16 Vict. cap. 83, sect. 41.

Rule nisi for the master to review his taxation made absolute by the Court of Queen’s Bench. (Lord Campbell, C.J., Erle, Crompton, Hill, JJ.)

Per LORD CAMPBELL, C.J.—The defendants here would be clearly entitled, under the statute of *Gloucester*, to the costs of preparing these particulars and evidence in support of them. Then is there anything in stat. 15 & 16 Vict. cap. 83 to deprive them of these costs? I think not. Sect. 43 applies only to cases where there has been a trial: where there has been no trial, as in the present case, the law stands as it did before.

THE GROVER and BAKER SEWING MACHINE COMPANY *against* }
MILLARD, A.D. 1861–2. 8 Jur. N.S. 713. }

Estoppel of Licensee.

Suit to restrain from infringing a patent of 10th Aug. 1852, No. 14,256, to *E. J. Hughes*, for ‘improvements in sewing machines.’

Defendant, who was a licensee of the patent under plaintiff, withdrew from the jurisdiction of the Court, without answering the bill, whereupon plaintiff obtained an order to make the bill *pro confesso*.

At the hearing, it appeared that plaintiffs had, after the filing of the bill, failed to support the validity of the patent in an action at law; nevertheless, Wood, V.C., on the authority of *Smith v. Scott* (6 C.B. N.S. 771) and *Noton v. Brooks* (7 H. & N. 499), granted a perpetual injunction with costs, and made the decree absolute.

HALL *against* CONDER and OTHERS, A.D. 1857. 2 C.B. N.S. 22, 53.

Breach of Agreement. Estoppel.

Declaration for breach of an agreement which recited that plaintiff had *invented* a method for the prevention of boiler explosions and had obtained a patent for the same, and by which plaintiff made over to defendants one-half of the patent. Plea 2. That the invention was wholly worthless and of no public utility, and was not new, and that plaintiff was not the true inventor thereof. Demurrer and joinder. Judgment for plaintiff by the Court of Common Pleas. (Cockburn, C.J., Cresswell, Williams, JJ.)

Per WILLIAMS, J.—The plaintiff professed to have *invented* a method for the prevention of boiler explosions. It is not alleged that he was guilty of any fraud. Why should we assume that the plaintiff meant to assert that the patent was indefeasible, and that the defendants purchased on that understanding, rather than that each knowing what the invention was, and having equal means of ascertaining its value, they contracted for the patent, such as it was, each acting on his own judgment? We think that the latter was the true nature of the contract, and that there was no warranty, express or implied. Here the plaintiff was capable of fulfilling all he had contracted to. The defendants might have had all they contracted to receive, and were therefore bound to pay.

(2 C.B. N.S. 53.) Error brought in the Court of Exchequer Chamber. Judgment affirmed.

HALL *against* JARVIS and BOOT, A.D. 1822. 1 Webs. Pat. Ca. 100.

Subject-matter of a Patent. Evidence of Infringement.

CASE for the infringement of a patent of 3rd Nov. 1817, No. 4,178, to *S. Hall*, for 'a method of improving every kind of lace or net.' Plea: Not guilty. Issue.

The patent was for burning off the superfluous fibres from lace or net without injuring the fabric. The patentee described a system of rollers for feeding on the lace, and passing it rapidly over a series of gas jets placed in a line underneath a chimney, which drew the

flame of the gas through the meshes of the fabric, and removed the superfluous fibres. The chimney was required for creating a sufficient draught. The specification stated:—‘I do not *claim* the exclusive use of any apparatus or combination of machinery, except in connection with and in aid of the application of the flame of inflammable gas to the purposes above described.’

At the trial, it appeared that the flame of charcoal, paper, wood shavings, and common pit coal had been in use before the date of the patent for the purposes of singeing fibres from silk, cotton, or lace sleeves; but for this purpose the articles had been placed on a wooden sleeve-board, and the flame had not been drawn through the meshes, but simply projected upon the fabric by a pair of bellows, and it was objected plaintiff was not entitled to a monopoly of the use of gas flame. As to the infringement, it appeared that defendant, *Boot*, had a *gassing* machine on his premises, where the gas-fittings had been tampered with, and gas had been consumed in excess of that required for lighting purposes. Also that lace left with defendants had been dressed and returned in the state to which it would have been brought by the application of plaintiff’s process. Counsel for defendants having stated that he should prove that the flame of charcoal or oil had been previously forced through the interstices of lace by a pair of bellows, ABBOTT, C.J. said:—‘The proving that will not affect the question.’ His Lordship then said to the jury:—‘There can be no doubt, gentlemen, your verdict must pass against both the defendants.’

Verdict for plaintiff.

HANCOCK *against* BEWLEY, A.D. 1860. Johns. 601.

Rights of Joint Owners of a Patent. Account.

Suit to obtain an account of profits made by defendants in working certain patents relating to gutta-percha, which were vested by deed in trustees for plaintiff, together with defendant, *Bewley*, and two other persons. It appeared that plaintiff had, for several years, worked the patents on his own account, in competition with defendants. Wood, V.C. dismissed the bill, and said:—‘The plaintiff contends, as a general principle, that persons who are part owners of a patent are not individually entitled to work it on their own account, but are subject to render an account of profits in some shape to their co-owners; and he says that the defendants ought to account for their profits, and ought not to be allowed to continue working the patents for their own benefit. There is much to be said on this side of the question, but the plaintiff is debarred by his own acts from raising the contention.’

HARMAR *against* PLAYNE, A.D. 1807. 14 Ves. 130; 11 East. 101; }
 Dav. Pat. Ca. 311. }

Sufficiency of Specification. Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 29th *March*, 1794, No. 1,982, to *J. Harmar*, for ‘improvements in a machine for raising a shag on woollen cloths, and cropping and shearing them.’ The patent recited that *J. Harmar* had obtained letters patent on 20th *March*, 1787 (No. 1,595), for an invention of a machine for raising a shag upon woollen cloths; and further, that he had invented considerable improvements in the said machine. It was admitted that the improvements so referred to were included in the descriptive part of the specification of the second patent, but that the nature thereof would only appear by comparison of the two specifications.

On motion for injunction, LORD ELDON, L.C. ordered the hearing to stand over for the parties to agree upon a case to be stated for the opinion of a Court of law, and said:—‘I do not say that a case might not exist, where possession might be distinctly proved, and yet there might be such strong doubt whether the specification was not bad in law, that the Court would *brevi manu* interfere, and put an end to the injunction; and if I am to decide upon the inclination of my own opinion, where the practice is differently represented, and considerable doubt may be raised in argument, I think it is difficult to support this specification. The question to be tried will be, whether a patent for a machine with a due specification having been granted, and a subsequent patent being granted for improvements, it is competent in law to represent in the specification that the latter patent was granted, not for improvements, but for the machine; carrying forward that idea, and describing the new invention as one entire machine; not as improvements, contradistinguished from the original machine. I adhere to the law as I stated it in the case of *Cartwright v. Eamer*’ (cited 14 Ves. 131).

The question for the opinion of the Court of King’s Bench (Lord Ellenborough, C.J., Bayley, Le Blanc, JJ.) was, whether the proviso in the letters patent of 29th *March*, 1794, had been duly performed by the enrolment of the specification thereof. Answered in the affirmative.

LORD ELLENBOROUGH, C.J. said:—‘The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted, when he can only tell by comparing it with some other patent what are the new and what are the old parts;

and if this may be done by reference to one, why not by reference to many other patents, so as to render the investigation very complicated? I feel impressed by the observation of my brother Le Blanc, that the trouble and labour of referring to and comparing the former specification with the latter would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference indeed must often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of this nature.'

Cited, *Foxwell v. Bostock* (4 De G. J. & S. 298).

HARWOOD and ANOTHER *against* THE GREAT NORTHERN RAILWAY }
 COMPANY, A.D. 1860. 2 B. & S. 194; 222; 11 H.L. Ca. 654. }
Subject-matter of a Patent. New use of an old thing.

CASE for the infringement of a patent of 16th *March* 1853, No. 651, to *C. H. Wild*, for 'improvements in fishes or fish-joints for connecting the rails of railways.' Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the specification was insufficient. 4. That the invention was not new. 5. That it was not the subject-matter of a patent. Issue.

The provisional specification stated:—'In securing the joints of rails it has been found advantageous to attach pieces of iron to each side of the rails by means of bolts and nuts, and such pieces of iron are commonly called fishes. My invention consists in forming a recess or groove in one or both sides of each fish, so as to reduce the quantity of metal at that part, and to be adapted to receive the square heads of the bolts which are thus prevented from turning round when the nuts are being screwed on.' The specification described the invention by reference to drawings, and showed the grooved fish secured by bolts and nuts at the joint of two rails, the bolts having square heads fitting into the recess, and the nuts being kept clear of the groove by means of a washer. *Claim 1*: 'The constructing fishes for connecting the rails of railways with a groove adapted for receiving the heads of the bolts or rivets employed for securing such fishes, and the application of such fishes for connecting the rails of railways in the manner hereinbefore described.'

At the trial, it appeared that before *Wild's* patent the bolts for fish-joints had been made with squared necks or with squared heads fitting into corresponding recesses, but had never been made with a groove along the outer surface for the double purpose of receiving the square heads of the bolts and of rendering the fish lighter for equal strength of metal. Also, that in the year 1847, a timber bridge

of considerable span, known as the *Hackney Bridge*, had been constructed by Mr. *Brunel* on the *South Devon Railway*. In this bridge horizontal beams of timber were laid from each pier and were united at the centre by scarf joints. Channel iron bars were laid underneath the beams along their whole length and across the joints for the purpose of giving additional strength, and these bars were secured by bolts with square heads fitting into the groove of the channel iron. A piece of plate iron was also laid for some feet along the upper surface of the beams and covered the joint, being secured by the bolts which held the channel iron. It further appeared that in other timber bridges constructed by Mr. *Brunel*, beams of timber had been laid horizontally upon each other, and that channel iron bars had been employed for strengthening such beams, being bolted along the under side by square-headed bolts passing through the beams and secured by nuts; the groove of the iron bar effecting the double purpose of preventing the heads of the bolts from turning round and of giving greater additional transverse strength with the same weight of metal. The jury found:—1. That the channelled irons upon railway bridges, independent of the *Hackney Bridge*, were used before the patent for the double purpose of obtaining increased strength and preventing the bolt-heads from turning round, but that they were not used for the purpose of fishing. 2. That the fastening of the scarf joint at the *Hackney Bridge* was a fishing of that joint, but that the use of the channelled iron arose from its being already there for fastening together the beams and the iron, and was not adopted by Mr. *Brunel* with reference to the special advantages in fishing contemplated by *Wild's* patent. COCKBURN, C.J. directed a verdict for plaintiffs. Leave reserved.

Rule nisi to enter a verdict for defendants on the ground that the invention was not the subject-matter of a patent, or for a new trial on the ground of misdirection with respect to the use of grooved iron in the *Hackney Bridge*, discharged by the Court of Queen's Bench. (Cockburn, C.J., Hill, Blackburn, Crompton, JJ.)

Per COCKBURN, C.J.—It appears to me that *Wild* was entitled to take out a patent for his invention. It is true that the use of grooved plates of iron, with bolts with heads and screws, the heads of the bolts being fixed in the groove, had previously been applied to the purpose of connecting and fastening timbers placed vertically upon one another, or placed horizontally side by side. *Wild*, however, proposed to apply the contrivance to what is called *fishing*, that is, the fastening timbers placed together in a wholly new and different position—viz., longitudinally, end to end, in contact with each other. In this case I think the purpose for which these things had been used

is sufficiently distinct to warrant us in holding that *Wild's* invention may be the subject of a patent. The second point is, whether by the previous user of this mechanical contrivance there has been an anticipation of *Wild's* invention, which prevents him from sustaining his patent. On this part of the case the question is, whether the accidental use of a piece of machinery (forming part or the whole of a mechanical contrivance which may be applied afterwards to some ulterior purpose), without any intention of producing the result, is such a user of the invention as prevents a patent from being taken out by another person; and this turns upon what is the meaning of stat. 21 Jac. I. cap. 3, sect. 6. Clearly the statute means what others have invented, and used *knowingly*, for the same purpose for which the person who afterwards comes forward as the inventor, and obtains a patent, intends to use it. I go the length of saying, that even if this had been done upon a railway, it would not have prevented a subsequent patent from being taken out.

Per BLACKBURN, J.—A man cannot be said to ‘use’ a manufacture in the sense in which the word must be understood in the statute of James, and as it would be ordinarily understood, when accidentally, and without any knowledge or intention, he produces that which, if it were knowingly and intentionally done, and for the purpose of trade, would be a manufacture.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Channell, Wilde, BB., Williams, Willes, and Byles, JJ.), judgment reversed, and rule made absolute to enter a verdict for defendants upon the pleas denying the novelty of the invention and that it was the subject-matter of a patent.

Per WILLES, J. (in delivering the judgment of the Court)—In our opinion, quite independent of the use of the grooved iron for fishing in the *Hackney Bridge*, the use of grooves in pieces of iron for holding materials together by means of bolts and nuts had been given to the world, together with all its advantages, before the date of *Wild's* patent; and *Wild's* alleged invention was a mere application of that old contrivance in the old way, to an analogous subject, without novelty or invention in the mode of applying such old contrivance to the new purpose. And an application such as this does not make a valid subject-matter for a patent. See *Tetley v. Easton* (2 C.B. N.S. 706); *Brook v. Aston* (8 E. & B. 478, s.c. in error 28 L.J. Q.B. 175.)

On appeal to the House of Lords, the judges were summoned, and Williams, Blackburn, Keating, Shee, JJ., and Channell, Piggott, BB. attended. Two of the learned judges (*viz.*, Blackburn, Shee, JJ.) were of opinion that the verdict should be for plaintiffs, and

that there should not be a new trial, but the remaining four judges were of the contrary opinion. Judgment of the Court of Exchequer Chamber affirmed, and appeal dismissed with costs.

Per LORD WESTBURY, L.C.—The question is simply this: whether the channelled iron, which was undoubtedly a fish (and one of the objects of the channel was to receive the square heads of the bolts and prevent their turning), is not in truth substantially the same thing as a grooved plate with a recess hollowed out in its own plane, instead of a hollow being effected by flanges placed on either side of the plate. Regarding the patent as limited to a claim for fishes of a particular configuration, I cannot for a moment doubt that the channelled iron, having the same object and being capable of the same application, substantially involves the fish-plate made with a grooved hollow in the manner which I have attempted to describe.

No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions referred to in the opinions of the four learned judges who concur in the second opinion delivered to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner that was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied.

HASSALL *against* WRIGHT and OTHERS, A.D. 1870. L.R. 10 Eq. 509.

Right to sue on a Licence before Registration.

Suit to restrain from infringing a patent granted to defendant *Wright*. It appeared that on 5th *Feb.* 1867, *Wright* granted by deed an exclusive licence to plaintiff for the use of the invention. The deed was not registered (see stat. 15 & 16 Vict. cap. 83, sect. 35) until *May*, 1870, after delivery of notice of motion in the suit. In *Jan.* 1870, *Wright* licensed other parties, who were made co-defendants in the suit, and their licence was not registered. A preliminary objection was taken that the non-registration of the deed of *Feb.* 1867 was a bar to plaintiff's right to sue. MALINS, V.C. overruled the objection, and said:—'It is quite true that in the Court of Queen's Bench it has been decided that where the assignee of a patent sues at law (before the registration of the assignment) for the infringement of the patent a third person, not the grantor, he is unable to maintain his suit; because the Act of Parliament says,

that until the assignment is registered the original patentee must be deemed to be the owner of the patent. . But even there the Court of Queen's Bench reserved the question of right as between the grantor and grantee; they do not say there is no title, they assume that he may be entitled to maintain a suit on having his title perfected. That is the express language of Lord Campbell in giving judgment, and he says it is not necessary to decide the question whether the registration relates back. I should say, under the circumstances here, it has relation back, and gives a title to the licensee *ab initio*.'

HASTINGS *against* BROWN, A.D. 1853. 1 E. & B. 450.

Sufficiency of Specification.

CASE for the infringement of a patent of 21st Dec. 1844, No. 10,446, to *C. Johnstone*, for 'certain improved arrangements for raising ships' anchors and other purposes.' Plea 5. That the specification was insufficient. Issue.

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. The specification stated:—'That the scallop shell was 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, figure 2, merely showed an indented V groove. *Claim*: 'The new form of scallop shell (as shown in figure 2) in conjunction with the arrangements hereinbefore described.'

At the trial, it appeared that before the date of the patent no cable holder was known which would hold chains of different sizes, and the invention claimed as a novelty was the application of a single windlass to different sizes of chain cable. It also appeared that a windlass capable of holding a chain cable of a given size was not new. It was contended, on behalf of defendant, that the specification was insufficient, it being doubtful whether the claim was for holding a chain of a given size, or for holding chains of different sizes. LORD CAMPBELL, C.J. left the case to the jury.

Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, JJ.)

Per LORD CAMPBELL, C.J.—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. That 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 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. The specification therefore is bad, and there must be a nonsuit.

Per COLERIDGE, J.—The law is admitted. If the specification upon a fair interpretation be equivocal, it is insufficient. The specification does not say that the windlass, framed as described, will hold cables of different sizes: yet it is necessary to show that this was in the patentee's mind. If it was, the expression is strange. It is very doubtful whether the words could mean that; but at all events they bear the other meaning equally well.

HAWORTH *against* HARDCASTLE, A.D. 1834. 1 Bing. N.C. 182; }
1 Webs. Pat. Ca. 480. }

Utility of Invention. Construction of Specification.

CASE for the infringement of a patent of 19th April, 1823, No. 4,780, to *W. Southworth*, for 'an apparatus adapted to facilitate the drying of calicoes.' Plea: Not guilty. Issue.

The specification stated:—'My invention consists in the application of certain machinery to perform the operation of hanging wet calicoes over a series of staves in a drying-house, and of removing the same after they have been dried;' and went on to say, 'I arrange the rails or staves near to the upper part of the drying-house.' It then described the operation of hanging the cloths in loops upon rails, and of taking them up again, and referred to drawings which showed a travelling carriage containing the cloths and running on beams through the whole length of the drying-house. *Claim* (in substance): The application of the machinery described for drying calicoes, which machinery is adapted by means of revolving and traversing cylinders situated over a series of stationary rails or staves arranged in drying-houses in such manner that the calicoes may be caused to hang down in long loops upon the staves: the said machinery being adapted for taking up and removing the said calicoes after being dried.

At the trial, it appeared that rails for drying cloths, similar to those mentioned in the specification, were in common use before the date of the patent; also, that the machine failed in taking up certain cloths stiffened with clay. It was contended, on behalf of defendant, that the patentee had claimed the invention of the rails or bars, which were old, whereby the patent became void; also, that the invention was of no use. ALDERSON, J. left the case to the jury. The jury found:—That the invention was new, and useful upon the whole, but that the machine was not useful in some cases for taking up goods. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Common Pleas. (Tindal, C.J., Park, Gaselee, Alderson, JJ.)

Per TINDAL, C.J.—After stating that the machine was useful upon the whole, the expression that, in some cases, it was not useful to take up the cloths, appears to us to lead rather to the inference that, in the generality of cases, it is found useful; and if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. We think that the patentee does not claim, as part of his invention, either the ‘rails and staves,’ or the placing them at the upper part of the building. The use of the rails and staves for this purpose was proved to have been so general before the granting of this patent, that it would be almost impossible, *à priori*, to suppose that the patentee intended to claim what he could not but know would have avoided his patent. There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent.

HAYNE and ANOTHER *against* MALTBY, A.D. 1789. 3 T.R. 438; }
1 Webs. Pat. Ca. 291. }

Estoppel.

Declaration, for breach of covenant, setting out so much of the recitals of the deed as stated that plaintiffs were the assignees of a patent for a machine to be fixed to a common stocking-frame for making point-net, and averring that plaintiffs had granted permission to defendant to use one stocking-frame with the patent invention attached thereto. Pleas: 3. Setting out the patent, that no specification was enrolled. 4. That the invention was not new. 5. That it was not discovered by the patentee. Demurrer and joinder.

Judgment for defendant by the Court of King's Bench. (Lord Kenyon, C.J., Ashurst, Buller, Grose, JJ.)

Per LORD KENYON, C.J.—The plaintiffs, pretending to derive a right under the patent, assigned to the defendant part of that right on certain terms; and notwithstanding that the facts now disclosed show that they have no such privilege, they still insist that the defendant shall be bound by his covenant, though the consideration of it is fraudulent and void. But it is said the defendant is estopped in point of law from saying that the plaintiffs had no privilege to confer; but the doctrine of estoppel is not applicable here. The person supposed to be estopped is the very person who has been cheated and imposed upon.

HEATH *against* UNWIN, A.D. 1842–43. 10 M. & W. 684; }
2 Webs. Pat. Ca. 216. }

Evidence of Infringement. Use of Chemical Equivalents.

CASE for the infringement of a patent of 5th April, 1839, No. 8,021, to *J. M. Heath*, for 'improvements in the manufacture of iron and steel.' Plea: Not guilty. Issue.

The patent related to the use of carburet of manganese in the manufacture of cast steel. The specification stated:—'I declare the nature of my invention to be (4) the use of carburet of manganese in any process whereby iron is converted into cast steel. I propose to make an improved quality of cast steel by introducing into a crucible bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matters along with from *one to three per cent.* of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot mould in the usual manner.' *Claim 4*: 'The employment of carburet of manganese in preparing an improved cast steel.'

At the trial, it appeared that the object of the invention was to render *cast steel* more easy to weld and more malleable than it had hitherto been. Shortly after the enrolment of the specification, plaintiff proposed to substitute portions of coal tar and black oxide of manganese for the carburet of manganese, and sent to defendant, who was his agent at *Sheffield*, small parcels of these materials to be called '*Heath's composition*' and supplied to the manufacturers at a reduced rate. Defendant, however, soon ceased to act as agent for plaintiff, and began to manufacture cast steel with coal tar and black oxide of manganese. This was the alleged infringement for which the action was brought.

It further appeared that carburet of manganese was formed by

exposing a mixture of carbon and oxide of manganese to a high temperature. LORD ABINGER, C.B. said :—‘ The materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet itself, the use of such materials in the said composition is a new discovery or invention, and not within the letters patent. Further, there is no sufficient evidence of the formation of carburet of manganese during the process adopted by the defendant, that is, of the use of carburet of manganese in the manufacture of steel within the meaning of the specification.’

Plaintiff nonsuited.

HEATH *against* UNWIN, A.D. 1844. 2 Webs. Pat. Ca. 218 ; }
13 M. & W. 583. }

Evidence of Infringement. Use of Chemical Equivalents.

Second action between the same parties for the infringement of the same patent. Plea: Not guilty. Issue.

At the trial, it appeared that the invention enabled manufacturers to produce malleable *welding cast steel* suitable for cutlery from low-priced *British* iron, which had not been done before; that prior attempts to use oxide of manganese had failed, because the manganese caused the melting-pots to give way; that as soon as plaintiff found out that the separate elements of carburet of manganese—viz., carbon and manganese—would answer as well as the compound substance, he supplied them in that form. Also, scientific chemists deposed that carburet of manganese was formed from carbon and oxide of manganese in the melting-pot at a temperature below that at which steel fused, and it was estimated that the ingredients used by defendant, as mentioned in the former case, gave about *one-half per cent.* of carburet of manganese for combination during the fusion of the metal.

Witnesses for defendant deposed that black oxide of manganese was commonly used for cleansing iron ores; also that they had used carbon with this oxide as an experiment, and occasionally in the course of trade, before 1839. Also, that crucibles for melting steel were made of clay and coke dust, so that carbon was always present when oxide of manganese was used. PARKE, B. directed the jury:—If they (viz., two of the witnesses) used the oxide and carbon only by way of experiment, that would not affect the novelty of the invention; but if they used them in the regular course of their trade before the date of the plaintiff's patent, then his invention cannot be new. The jury found:—That defendant had infringed; and that, although he might not have used *one per cent.* of carburet, the words in the specification, from *one to three per cent.*, gave a latitude as to the quantity to be used. Verdict for plaintiff.

Rule nisi to enter a verdict for defendant on first issue made absolute by the Court of Exchequer. (Parke, Alderson, Gurney, Rolfe, BB.)

Per PARKE, B.—There was no intention to imitate the patented invention; and we do not think the defendant can be considered to be guilty of an indirect infringement, if he did not intend to imitate at all. (But see observations of the same learned judge in the next case.)

HEATH *against* UNWIN, A.D. 1850. 2 Webs. Pat. Ca. 228; }
12 C.B. 522; 5 H.L. Ca. 505. }

Evidence of Infringement. Use of Chemical Equivalents discovered after grant of Patent.

Third action between the same parties for infringement of the same patent. (Issue directed by the Court of Chancery.) Plea: Not guilty. Issue.

At the trial, CRESSWELL, J. ruled (see previous case):—That the use of oxide of manganese and carbonaceous matter was not an infringement of the patent. Verdict for defendant.

Error on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Platt, B., Wightman, Erle, Crompton, JJ.; *dissentientibus* Alderson, B., Coleridge, J.)

Per CROMPTON, J.—I think there was abundant evidence from which the jury might have found that the carburet was first formed in the crucible from the materials, so as to be in the distinct state of carburet before the use of it in the manufacture of steel commenced, and that after its formation it was used as a carburet of manganese in the process of converting the iron into steel; and I think from such a state of facts it was competent for the jury to find that the patent had been infringed by the defendant.

Per ERLE, J.—I am of opinion that a patent for the use of a substance is infringed by the use of a chemical equivalent for that substance, known to be so at the time of the use, if used for the purpose of taking the benefit of the patent and of making a colourable variation therefrom. If the patent was for the use of soda in a process, and, by subsequent analysis, sodium and oxygen were discovered to be the elements of soda, the use of sodium and oxygen in the patented process for the purpose of being equivalent to soda in that process, would appear to me to be an infringement, although the analysis of soda was subsequent to the patent.

Per ALDERSON, B.—There is no evidence that oxide of manganese and carbon were known to be, at the time of the specification—which time and not the time of the use is the material time to look at—

exactly and under all circumstances an equivalent in chemistry to carburet of manganese. The plaintiff did not then know it, nor did any one else then know it. If they know it now, it is in consequence of a new discovery alone, for which no patent has been taken out, and no specification enrolled. I apprehend that nothing is an equivalent now which would not have been one immediately after this specification was enrolled. The knowledge of the equivalents must be the knowledge the world had before these experiments, now called infringements, were first made.

Appeal to the House of Lords, when the judges were summoned, for the purpose of stating their opinion on the following question (in substance):—Whether there was evidence for the jury of an infringement of the patent by the use of oxide of manganese and carbonaceous matter in the manufacture of cast steel? Crowder, Crompton, Williams, Erle, Cresswell, Wightman, JJ., and Platt, B., answered in the affirmative; and Maule, J., Pollock, C.B., Parke, Alderson, BB. answered in the negative.

Per CROMPTON, J.—If a new process of which the patentee and all others were ignorant at the time of the specification is found out afterwards, the exercise of such new process may be an infringement, provided it is substantially the same with or includes the patented invention. The knowledge or intention of the party infringing is now most properly admitted to be immaterial.

Per CRESSWELL, J.—The claim being general, and the evidence in support of the action tending to show that the defendant had used carburet of manganese in the manufacture of steel by causing it to be first formed in the pot and afterwards mixed with the steel, I think the case is not one where an equivalent has been used, but the thing itself; and if the thing itself was used, although the defendant was not aware of it, he has still infringed the patent.

Per PARKE, B.—In delivering the judgment of the Court of Exchequer in a former stage of this case, I stated the opinion of the Court to be that there would be no indirect infringement if the defendant did not intend to imitate at all. That part of the judgment has been justly objected to in *Stevens v. Keating* (not reported as to this point), and no doubt we were in error in that respect. There may be an indirect infringement, as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.

THE LORD CHANCELLOR then delivered the judgment of the House of Lords.

Per LORD CRANWORTH, L.C.—There is no evidence whatever tending to prove that, at the date of the patent, it was known to

persons acquainted with the subject of manufacturing steel, that coal tar and oxide of manganese would be chemical equivalents for the carburet of manganese claimed by the plaintiff. Indeed, it is obvious that the discovery of such equivalents was made after the use of the carburet, as a distinct metallic substance, had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent.

On the short ground that the invention claimed is the use of a particular metallic substance—namely, carburet of manganese—in certain definite proportions, according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement, and so that the ruling of the learned judge at the trial was correct.

HEATH *against* SMITH, A.D. 1854. 3 E. & B. 256.

Prior User of the Patented Invention.

CASE, brought by the administratrix of the patentee, for infringement of the same patent (extended for seven years). Plea 4. That the invention was not new, but had been publicly used in *England* before the date of the patent. Issue.

At the trial, it appeared that before the patent five firms had practised a process identical with that patented. The operation had been conducted openly by three of the parties, but secretly by the other two. All the five firms had sold the steel so manufactured in the usual way of business. ERLE, J. expressed his opinion that, if this evidence was believed, the invention was not new; and, the truth of it being admitted, his Lordship directed a verdict for defendant on the fourth issue, and for plaintiff on the remaining issues. Verdict accordingly.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—This was not a mere experiment; a perfect manufactured article was produced for profit by hundreds of tons. As to two of these firms, it appeared that they did not disclose the method, but the other three firms made no attempt at concealment, but carried on the trade just like any other handicraft by which bread was to be earned; all the workmen and other persons successively employed knew of the method.

Per ERLE, J.—As to secrecy, three of the firms practised no concealment whatever. That of itself is ground enough for discharging the rule. I should, however, be disposed to go further. If one party

only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid. But for the purpose of the present case, it is enough to say that there has been an user without any concealment.

LORD CAMPBELL, C.J. added:—I wish it to be clearly understood that if we had held this patent valid, the five firms would all have been liable to an action for exercising the invention after the patent had been taken out. Now see what that comes to. If any man makes a discovery and uses it without taking out a patent, and does not announce it by sound of trumpet or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery, and takes out a patent for it. That would be the consequence of the principle for which the plaintiff is driven to contend.

HIGGS *against* GOODWIN, A.D. 1858. E. B. & E. 529; 27 L.J. Q.B. 421.

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent (in part disclaimed) of 28th April, 1846, No. 11,181, to *W. Higgs*. Title (after disclaimer), ‘Treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes.’ Pleas: 1. Not guilty. 3. That the undisclaimed part of the invention was not new. 4. That it was not the subject-matter of a patent. Issue.

The patent related to a method of precipitating, by means of hydrate of lime, the solid animal and vegetable matter held in suspension in sewage water. The specification described the arrangement of tanks and apparatus, and stated:—‘For the purpose of precipitating the animal and vegetable matter contained in the sewage water, I prefer to employ hydrate of lime which, so far as I know, is the cheapest and most effective chemical agent for effecting this purpose.’ *Claim*: ‘The precipitation of animal and vegetable matter from sewage water by means of the chemical agent hereinbefore described.’

At the trial, it appeared that the alleged infringement was committed by the Local Board of Health at *Hitchin*, who separated the greater part of the organic matter from sewage water by filtration, and afterwards deodorised the liquid by the admixture of hydrate of lime. The refuse sediment was not sold, but was carted away by persons who were paid for removing it. ERLE, J. directed the jury:—That if the chemical agent was applied with a knowledge that it would precipitate the matter left in the sewage water, the

board must be considered to have applied it for that purpose, although their object was to deodorise, and not to precipitate; and that they had, in that case, infringed the patent, although the greater part of the sewage matter had been separated by filtration from the water before the hydrate of lime was used. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial, on the grounds that the invention was not the subject-matter of a patent, and that there was no evidence of infringement. During the argument, LORD CAMPBELL, C.J. said:—‘There may be a patent for producing by precipitation a saleable article, but if that be so, there is no infringement.’ Also ERLE, J. said:—‘The intention to produce profitable matter is of the essence of the patent.’ Rule made absolute by the Court of Queen’s Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—There is no evidence of infringement.

Per CROMPTON, J.—As to the objection that the patent is void for want of novelty, I am much inclined to say that the patent may be supported. Here is a process producing a new result, that is, manure in a particular form. It can hardly be said that there cannot be a patent for that.

HILL *against* THOMPSON and FORMAN, A.D. 1817–18. 8 Taunt. 375; }
3 Mer. 622; 1 Webs. Pat. Ca. 232. }

Practice in Patent Suits. Novelty of Invention. Evidence of Infringement.

Suit to restrain from infringing a patent of 26th July, 1814, No. 3,825, to *A. Hill*, for ‘an invention of improvements in the smelting and working of iron.’

The patent related to a process of manufacturing bar iron, free from the defect of being *cold short*, by the use of lime. The specification stated:—‘And my improvements do further consist in *the use and application of lime to iron*, subsequently to the operations of the blast furnace, whereby that quality in iron, from which the iron is called “cold short,” is sufficiently prevented, and by which such iron is rendered more tough when cold.’ The proportions of lime, mine-rubbish, and slags, to be admixed for the blast furnace, were then described, and the further treatment by lime in the refinery and puddling furnaces was detailed. The specification contained no separate claim, but again stated:—‘I do further declare that *I have discovered* that the admixture of lime will sufficiently prevent that quality in iron from which the iron is called “cold short,” and will render such iron more tough when cold; and I do for this purpose add a portion of lime, to be regulated by the quality of the iron to be operated upon.’

LORD ELDON, L.C. ordered an action at law, with an account, and said:—‘The principle upon which the Court acts in cases of this description is the following: Where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a Court of law, before it will grant him the benefit of an injunction.’

Action at law in pursuance of the order of the Court. Plea: Not guilty. Issue.

At the trial, it appeared that the alleged infringement consisted in the manufacture of pig-iron, by mixing cinders with mine-rubbish, and in the application of quicklime in the subsequent processes. But it also appeared that defendants did not work by plaintiff’s specification, but used different proportions. Evidence was adduced of the user of lime for making pig-iron from slags and mine-rubbish before the patent. Verdict for plaintiff.

Rule nisi to enter a nonsuit made absolute by the Court of Common Pleas. In granting the rule the Court were of opinion that a book, *Aikin’s Dictionary*, which lay open on the table during the trial, should be considered as having been made use of at the trial, both parties having referred to it. This book was published in 1807, and contained the following passage:—‘*Rinman* says, that cast-iron, which by the common treatment would yield cold-short bar, may be made to afford soft malleable iron by fusing it with a mixture of equal parts of lime and scoria.’

Per DALLAS, J.—The application of lime in some way, for the purpose proposed, instead of being a secret unknown before, was as public as it could be rendered by a work of extensive circulation, and had been more or less in actual use in this country, so that the present patent would in effect operate as an abrogation of vested and existing rights. On this part of the case I will only further remark, that if any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void. In every view of the subject, therefore, the claim to invention and novelty fails.

Motion to revive the injunction. Defendants having stated their intention to move for a new trial, the motion was ordered to stand over. Account as before.

Per LORD ELDON, L.C.—In his directions to the jury, the judge has stated it as the law on the subject of patents—first, that the invention must be novel; secondly, that it must be useful; and, thirdly, that the specification must be intelligible. I will go further, and say, that not only must the invention be novel and useful, and the specification intelligible, but also that the specification must not attempt to cover more than that which, being both matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add that, if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled. On the other hand, there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials.

HILLS *against* LAMING, A.D. 1853. 9 Ex. R. 256.

Estoppel of Licensee.

Declaration for breach of covenant in a deed which recited that plaintiff was grantee of certain patents for improvements in purifying coal-gas, and by which he had given permission to defendants to work the same on certain terms. Pleas: 1. That the said patents were not, nor was either of them, a good and valid patent. 2. That the inventions, &c., were not, nor was either of them, new. 3. That the plaintiff was not the first inventor of the alleged inventions. Demurrer, on the ground that defendant was estopped from questioning the patents. Joinder. Judgment for plaintiff by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, BB.)

PARKE, B. said:—‘The case is similar to that of *Bowman v. Taylor* (2 Ad. & E. 278).’

HILLS *against* THE LONDON GAS COMPANY, A.D. 1857–60. }
27 L.J. Ex. 60; 5 H. & N. 312. }

Misdirection by Judge. Variance between Deposit Paper and Specification. Sufficiency of Specification. Subject-matter of a Patent. Title after disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 28th Nov. 1849, No. 12,867, to *C. F. Hills*, the amended title being

‘an improved mode of purifying coal-gas.’ Plea 1. That the invention was not new. Issue.

The patent related to a method of purifying coal-gas from sulphuretted hydrogen. For this purpose *sesqui-oxide of iron* was mixed with sawdust so as to become porous, and was placed upon perforated shelves in a closed chamber; the gas under purification was passed through the mixture, which arrested the sulphuretted hydrogen and formed free sulphur and water. *Thus, $Fe_2 O_3 + 3 H S = 2 Fe S + 3 H O + S$* . As soon as the material had absorbed all the sulphuretted hydrogen which it could take up (or when it became black), a current of fresh air was drawn through the purifying chamber, whereby a second chemical change was effected. The black proto-sulphide of iron became again the red sesqui-oxide, and sulphur was deposited. *Thus, $2 Fe S + 3 O = Fe_2 O_3 + 2 S$* . The material could be used some fifteen or twenty times before it became over-clogged with free sulphur.

Claims (in substance): 1. The purifying of coal-gas from sulphuretted hydrogen, &c., by ‘passing it through the *precipitated or hydrated oxides of iron*, from whatever source obtained,’ and made into a porous material by being mixed with sawdust, &c. 2. Repeatedly renovating or re-oxidising the said purifying materials by the action of air, whenever they cease to absorb sulphuretted hydrogen, so that they may be used over and over again to purify the gas.

At the trial, defendants put in evidence the specification of a patent of 4th Nov. 1847, No. 11,944, to *R. Laming*, for improvements in purifying coal-gas, one part of which related to the use of carbonates of iron for this purpose. A witness deposed that the oxide of iron employed by plaintiff was formerly known as carbonate of iron, and was commonly sold under that name. Also that carbonate of iron could only be preserved in sealed vessels, as it changed to the hydrated sesqui-oxide on exposure to the air. Thereupon, POLLOCK, C.B. said he was satisfied that the carbonate of iron described by *Laming* was the same substance as the oxide of iron referred to by the plaintiff, and directed a nonsuit.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Exchequer. (Pollock, C.B., Martin, Bramwell, Channell, B.R.)

(5 H. & N. 312.) New trial of the same action. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the specification was insufficient. 5. That the invention was not the subject-matter of a patent. 6. That the invention specified was different from that for which the patent was granted. Issue.

At the trial, it appeared that all precipitated oxides of iron, which were necessarily artificial, were competent to absorb sulphuretted hydrogen from coal-gas at ordinary temperatures; but that the native hydrated oxides of iron could not be practically used for this purpose. Defendants relied on the specification of *Laming's* patent already mentioned, where the material employed was *chloride of calcium*, produced by decomposing muriate of manganese, iron, or zinc; the specification stating:—‘The oxides or carbonates which result are useful for the purification of the gas, and need not be removed.’

The defendants also put in evidence (1) the specification of a patent of 29th *July*, 1840, No. 8,577, to *A. A. Croll*, for (*inter alia*) improvements in purifying coal-gas. The material employed for absorbing sulphuretted hydrogen was *black oxide of manganese*, which substance was renovated, from time to time, by roasting it in an oven at a red-heat. The specification stated:—‘The same effect may be produced by the application of the oxides of zinc and the oxides of iron, and treated precisely in the same way as above described.’

It further appeared that the deposit paper, left with the law officer, stated the fifth particular of invention as being ‘for absorbing sulphuretted hydrogen, and other gases, into porous bodies, and renovating them again, either by heat, or taking off the atmospheric pressure.’ The jury found:—That the whole invention, and each part, was new, and that, whether aptly described in the deposit paper or not, it was the plaintiff’s invention. Verdict for plaintiff.

Rule to enter a verdict for the defendants on the sixth issue refused by the Court of Exchequer. (Pollock, C.B., Bramwell, Watson, BB.)

Per POLLOCK, C.B.—The Queen’s grant, in terms, includes the invention specified. It may be that the Attorney-General may say the Crown has been deceived in this matter, but I do not think any one else can.

Rule nisi to enter a verdict for defendants discharged by the Court of Exchequer (Pollock, C.B., Bramwell, Watson, Channell, BB.), and rule for a new trial on the ground that the verdict was against the evidence also discharged. (Watson, Bramwell, BB.; *dissentiente* Pollock, C.B.)

Per BRAMWELL, B.—Upon the argument before us Mr. *Grove* has put forward a consideration not adverted to at the trial. He said:—‘It is true that *Croll* said *oxides of iron*, and it may be that he meant *all oxides*. Take it to be so, that is not such a statement as precludes invention and discovery by the plaintiff, because there are many oxides, the hydrated and anhydrous, the natural and artificial, some of which will and some will not answer the purpose, and therefore it

is a matter of invention and experiment to see which will.' We concede to Mr. *Grove's* argument, that upon the mere comparison of these two instruments, *Croll* has not anticipated the plaintiff, so as to preclude him as a matter of law from being the discoverer of this invention.

The next question is upon the patent of *Laming*. Now *Laming* specifies for the use of chloride of calcium; he claims chloride of calcium, and says he uses it with the oxide of iron, which is produced in the preparation of the chloride. We cannot say, as a matter of law, that *Laming* anticipated the plaintiff. The question was left to the jury, and they have found a verdict for the plaintiff.

The next objection was that the plaintiff's specification was insufficient on this ground. He says, 'I use the hydrated or precipitated oxides.' It was said that included all hydrated oxides, and, inasmuch as some of the native hydrated oxides would not do, the plaintiff's specification was bad. It appears to us, upon looking at the specification, that the plaintiff uses those as equivalent expressions, because he says 'hydrated or precipitated,' and that oxide of iron may be conveniently 'prepared' for those purposes, and so on, and consequently he means such hydrated oxides as are precipitated.

Then it is said that the mere application of the hydrated oxide of iron to absorb sulphuretted hydrogen from coal-gas is not the subject of a patent, that property of it being previously well known. With that we do not agree. If a man were to say, 'I claim the use of hydrated oxide of iron for the purifying of coal-gas,' without saying how it was to be applied, it is possible the objection might be well founded; but here the plaintiff says, 'I claim it in the manufacture of gas in the way I have described,' and he shows how it may be used. Therefore this objection fails.

The sixth objection, that the title as amended by disclaimer is not such as to include the invention of the plaintiff, appears to me to be an unfounded one, and was not much pressed in the argument.

HILLS *against* EVANS, A.D. 1861-2. 31 L.J. Ch. 457;]
4 De G. F. & J. 288.]

Evidence of prior Publication. Sufficiency of Specification. Account or Alternative Action for Damages.

Suit to restrain from infringing the same patent. Defendant relied on the patents of *Croll* and *Laming* before referred to, and put in the specification of a patent of 12th *June*, 1806, No. 2,941, to *E. Heard*, for obtaining inflammable gas from pit coal. Injunction granted with costs.

Per LORD WESTBURY, L.C.—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, and requires generally the aid of the light derived from what are called surrounding circumstances. It is therefore an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents)—that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide.

His Lordship then commented on the judgment of Lord Cranworth, L.C., in *Bush v. Fox* (5 H.L. Ca. 707), and stated his conclusion, as borne out by the uniform practice at *Nisi Prius*, to be:—That although the construction of the specification clearly is matter of law, yet if there be two specifications to be compared in order to arrive at a question of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact and not a question of law. His Lordship continued:—I was extremely desirous to ascertain in the course of the argument if any clear rule had been laid down on the subject of what shall be the nature of the antecedent publication which shall be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it. Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent—viz., such a knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use.

I have now to examine the general specifications, which, it is alleged, contain the plaintiff's invention. The first specification is

that of *Heard*, and the patent was granted in the year 1806. The proposition of the patentee is that all oxides of iron possess an affinity for sulphuretted hydrogen; he does not limit himself to 'oxides of iron,' for he says, 'iron, manganese, zinc, copper, lead,' &c. With regard to the greater number of these substances, the proposition is clearly, from the evidence, untrue, and therefore there is here what I have denominated apparent generality, giving no specific knowledge, no practical rule of application, but furnishing suggestions which might give a direction to inquiry. That is not such information as will be sufficient to support a patent. It adds nothing to the real stock of practical knowledge of mankind, and ought not to derogate from the validity and the benefit of a subsequent invention.

The next specification is that taken out by Mr. *Croll* in the year 1840. Mr. *Croll* says that the third part of his invention consists in the application of black oxide of manganese to remove sulphuretted hydrogen from coal-gas, and he describes a mode of restoring its purifying powers, by roasting it in an oven to expel the sulphur. He proceeds to say that 'the same effect may be produced by the application of the oxides of zinc and oxides of iron, and heated precisely in the way described.' This, therefore, is a proposition that 'the oxides of iron,' that is, 'all the oxides of iron,' may be applied in a manner which will admit of the same effect being produced. Now it is an admitted fact that that proposition is untrue; it is a clear result, therefore, that the proposition would only mislead the individual who relied upon it. It requires further invention and discovery to modify and restrain it within the true limits of fact.

I now come to the specification of *Laming*. The specification of *Laming* speaks of a particular agent in the purification of coal-gas—viz., chloride of calcium; and it describes a mode of producing that purifying agent, which would leave a residuum in which would be found hydrated oxide of iron, the application of which is the patented invention of the plaintiff. With regard to this residuum all that Mr. *Laming* says is:—'In such cases the oxides or carbonates which result are useful for the purification, and need not be removed.' His only proposition is that it is not detrimental to the use or agency of the chloride of calcium, but will rather assist and promote its operation. But that is a perfectly different thing from the discovery that the hydrated oxide of iron altogether superseded and rendered unnecessary the chloride of calcium.

I cannot find in any one of these patents a clear, distinct, and definite indication of the admittedly beneficial discovery which was afterwards made by the plaintiff.

The last subject of argument was, whether the plaintiff's specifica-

tion was itself open to a similar objection, viz., in using words in a sense too general for the actual truth. The particular words are in the plaintiff's specification, that he makes use of 'hydrated or precipitated oxides,' and it is said that 'precipitated' is there opposed to 'hydrated,' and that there are some hydrated oxides that would not answer the purpose, and that therefore the plaintiff's specification is bad for too great generality, and for inaccuracy. This objection was met in the Court of Exchequer by treating the word 'precipitated' as narrowing and correcting the generality of the word 'hydrated.' I prefer rather to rest upon the explanation, that if the word 'hydrated' be taken by itself, and be considered as including more than 'precipitated oxides,' it must still be confined to those hydrated oxides that are artificial, and there is no proof or suggestion that there is any known artificial hydrated oxide that will not answer the purpose.

Upon every ground therefore I arrive at the conclusion that the plaintiff's patent must be held to have been conclusively established at law. I grant the injunction as prayed in the third paragraph of the prayer. Considering the case as falling altogether under the provisions of the statute of 1852 (15 & 16 Vict. cap. 83, sect. 43), I direct the plaintiff's costs of the whole suit to be taxed as between solicitor and client, save that part of the bill which is founded on the agreement of *November*, 1860, and except the costs of the application to the Lords Justices and the hearing before them, as to which I give no costs to either party. That will be the whole of the decree, unless the plaintiff prefers, instead of the account, to have liberty to bring an action at law for damages, which he may take in lieu of the account. If not, I direct the account as prayed.

HILLS *against* THE LIVERPOOL GAS COMPANY, A.D. 1863. }
 9 Jur. N.S. 140. }

Evidence of Infringement.

Suit to restrain from infringing the same patent by the use of a certain natural product found in *Ireland*, and known as *bog-ochre*. It appeared that the substance in question contained a large proportion of native hydrated oxide of iron, and that, when applied to the purification of gas, it absorbed sulphuretted hydrogen, and could be revived by the action of atmospheric air as described in plaintiff's specification. WOOD, V.C. granted an injunction, but the LORD CHANCELLOR varied the order so as to restrain defendants from using bog-ochre in any other than its native or primitive state, and directed an account of all profits made by the user of such material in any other than its native state.

Per LORD WESTBURY, L.C.—With many of the observations of the Court of Exchequer in *Hills v. London Gaslight Company* (5 H. & N. 312) I cannot concur, but I do concur in the conclusion, that by the terms hydrated or precipitated oxides the plaintiff intends to denote such oxides only as were artificially prepared or obtained. But this is not the character of bog-ochre as it is primarily employed by the defendants. The ochre is used by the defendants as dug from the bog, and even if it be a hydrated oxide of iron formed by precipitation, it is clear that it is a native, that is, a naturally formed oxide, and whilst used in that state must, by the very condition by which the plaintiff's patent was supported, be held not to be included in the plaintiff's specification. I cannot grant an injunction to restrain the defendants from using bog-ochre in its natural state. The more material question still remains. The principal impurity from which it is desirable to cleanse the gas is sulphuretted hydrogen. The plaintiff discovered that when the sulphuret of iron is exposed to the atmosphere in such a manner as to cause the atmospheric air thoroughly to permeate and pervade the mass, the sulphur is driven off and precipitated, the iron is re-oxidised by taking up new oxygen from the air, and thus a new hydrated oxide is, by this application of a natural agent, artificially obtained. This new oxide I hold to be an oxide artificially prepared and obtained, although it is the result of the natural properties of the air, because those properties are guided and directed to this end by human agency and design. I hold that whilst the defendants employ the *bog-ochre* in its natural state, they use a native oxide of iron, which, whether it be hydrated only, or hydrated and precipitated, is not within the plaintiff's patent, and no injunction can be granted against the use of it; but when they use the ochre after it has been re-oxidised, they use a material which is within the plaintiff's patent, being an artificial hydrated oxide; and this I restrain them from employing.

HOFFMAN *against* POSTILL, A.D. 1869. L.R. 4 Ch. 673.

Practice as to Interrogatories in Patent Suits.

Suit to restrain from infringing a patent for a brick-kiln. Defendant filed interrogatories referring to certain specifications of prior patents—*e.g.*, 'Are not those sliding doors colourable variations of, or a mechanical equivalent for, the divisions or walls with openings (as referred to in a specification mentioned) between each compartment in the kiln?' 'Is there not, *therefore*, in this arrangement a continual reciprocal action of the kilns or oven?' By the 11th interrogatory the plaintiffs were questioned as to proceedings taken by them in *Saxony* for the infringement of their patent. By the 12th interrogatory

they were required to set forth a certain correspondence relating to their patent. By the 14th interrogatory to set forth descriptive particulars of the alleged infringements. Plaintiffs denied the similarity of the improvements referred to, and declined to answer more fully, or to give further particulars of infringement. Exceptions over-ruled by JAMES, V.C. Appeal to the Lords Justices, when the order was discharged, except so far as it over-ruled the exceptions relating to the 11th and 12th interrogatories.

Per SELWYN, L.J.—A certain latitude must always be allowed in seeking discovery, and accordingly we have examined these exceptions with reference to the general rule, that the person who is bound to answer must answer fully. The fallacy of the argument which has been addressed to us is apparent, because it depends mainly upon these two propositions. *First*, that wherever there is a question relating to a matter of fact, and that question is so stated as to refer to any of the subject-matters of a specification or other written document, then the plaintiffs are not bound to answer. I think that is erroneous. The *second* proposition is this, that the discovery sought relates exclusively to the case made by the plaintiffs against the defendant in this suit. If it could be shown that it was not material to the case of the defendant, then, of course, it would be a good objection to the interrogatory; but, in truth, the case of the defendant is that the plaintiffs' patent is invalid, and everything that is material to show that is part of the defendant's case, and he is entitled to discovery as to all the matters of fact which are or may be material to his case.

Take, for instance, the question—'Are not those sliding doors, &c.' It is, in my judgment, a question of fact whether they are mechanical equivalents for the other contrivance which is there mentioned. That being so, I think the defendant was entitled to an answer to that question. I will take one other instance—'Is there not, *therefore*, in this arrangement, &c.' It is quite true that the word 'therefore,' as used in that sentence, does connect the question with what is mentioned in the specification, but it is nevertheless a question of fact, and a question which, in my judgment, the plaintiffs are bound to answer.

Per GIFFARD, L.J.—The defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent, or that what the plaintiffs allege to be an infringement is not an infringement. It is almost impossible, where you have antecedent publications or patents, which are alleged to destroy the novelty of the succeeding patent, whether it be in examining the parties by interrogatories or in examining witnesses, to avoid the

necessity of referring to these documents, and asking a variety of questions respecting them, some of which are more proper for the Court, but many of which are absolutely essential in order to enable the Court to come to a proper conclusion as to the legal effect of the different specifications.

HOLLAND *against* FOX, A.D. 1854. 1 C. L. R. 440; }
 3 E. & B. 977. }

Particulars of Objections. Account.

CASE for the infringement of a patent for improvements in manufacturing umbrellas. The particulars of objections delivered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 41, stated prior user of the invention 'at *Sheffield, Birmingham, and London.*'

Rule nisi for further and better particulars made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—We are all of opinion that this particular is illusory. The names of persons are not required to be stated by the Act, but the manufactory or place where the invention has been used may be described by name or other description.

(3 E. & B. 977.) The cause proceeded to trial, and plaintiff had a verdict with 40s. damages. Plaintiff then obtained a rule absolute in the first instance ordering defendant to account for all articles made in breach of the patent before and since the commencement of the action (see stat. 15 & 16 Vict. cap. 83, sect. 42).

Rule nisi to discharge the above rule. It appeared on the affidavits that after the issuing of the writ a negotiation took place between the parties respecting a licence, and that in *July*, 1853, defendant had notice to account for profits, but that he continued to use the invention and to make profits thereby until two days after the trial—viz., 17th *Dec.* 1853, when he ceased the manufacture. Rule, so far as it ordered an account of profits, accruing after notice as above, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—All the loss which the plaintiff sustained prior to the commencement of the action, and all the loss for which damages could have been given to him by the jury, must be considered to be compensated by the sum, however small, which they awarded to him. Objection is made that we have now no jurisdiction to order any account, the words of stat. 15 & 16 Vict. cap. 83, sect. 42, being, 'It shall be lawful for the Court in which such action is pending,' and the defendant arguing that this action is no longer pending in this Court. But we think the action is pending till final

judgment has been pronounced and entered up. The defendant having admitted that, after being charged with the infringement of the plaintiff's patent, and *after notice* that he would be held liable to account for the profits, he did make large profits by continuing to infringe the plaintiff's patent; and as no part of such profits could have been awarded by way of damages to the plaintiff; we think that the defendant may be considered as trustee of these profits for the plaintiff, and we order that the defendant render an account of these profits, and pay over the amount to the plaintiff.

HOLMES *against* THE LONDON and NORTH-WESTERN RAILWAY }
COMPANY, A.D. 1852. 12 C.B. 831; Macrory's Pat. Ca. 4. }

Sufficiency of Specification. Novelty of Invention. The Specification must distinguish what is new.

CASE for the infringement of a patent of 28th *Jan.* 1841, No. 8,818, to *W. C. Harrison*, for 'an improved turning-table for railway purposes.' Pleas: 1. Not guilty. 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent was for a turn-table, constructed so that the weight of the load bore upon a central pin, instead of being supported by rollers at the edge of the table. Previously it had been the practice to support the platform on a set of friction rollers placed near the periphery, and there was a central pin, not bearing any part of the weight, but merely acting as a guide to keep the structure in its place. The object of *Harrison's* invention was to diminish the resistance of friction. The platform was a rigid trussed table, and its whole weight was thrown upon a central pivot. There was (1) an upright post resembling a crane post and terminating in a pivot which supported the table; (2) a massive ring, called a roller case, encircling the base of the post and carrying friction rollers; (3) *vertical suspending rods* to attach the roller case to the table; (4) oblique struts or support arms carried from the ring to the outer edge of the table. The specification described the whole apparatus as constituting the invention, and stated that the oblique arms would transfer all the stress from the outer side of the plate through the arms on to the suspending rods, and bring the weight directly on to the top of the post, the effect being that the table would move very much more lightly and easily than with the rollers round the circle in the ordinary manner. *Claim*: 'The improved turning-table hereinbefore described.'

At the trial, the defendants put in evidence the specification of a patent of 18th *Dec.* 1840, No. 8,745, to *E. R. Handcock*, which related to a turn-table pivoted on a central post. In this construction

(1) a coned pivot threw the weight of the table upon an upright central post; (2) a cylindrical shell or jacket encircled the post, and rotated on loose friction collars; (3) oblique stay bars were carried from the bottom of the jacket to points near the periphery of the table. The specification stated that the effect of these stay bars was to give a general support and stability to the platform. The patentee had, however, failed to see the importance of connecting the cylindrical jacket rigidly with the plate, and there was consequently no equivalent for the vertical suspending rods, and nothing analogous to a trussed beam.

JERVIS, C.J. directed the jury:—I think you will agree with me that the pivot is old; the radiating arms are old; the roller case is the same as the bottom of the jacket in *Handcock's* turn-table; that the rollers are the same as the collars, or equivalent to them; but that the suspending rods are new and useful, and that upon the evidence they are useful in equalising the pressure; and therefore the combination of three old things and one new one, A, B, C, and D, forms a new quality E, therefore there will be a novelty. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on fourth issue made absolute by the Court of Common Pleas. (Jervis, C.J., Maule, Williams, Talfourd, JJ.)

Per JERVIS, C.J.—The jury found that the post, the arms, and everything except the suspending rods was old. In order to make his specification good, either for an improvement of an old machine, or for a new combination, *Harrison* should have said:—‘My principle is to suspend the revolving platform on a post, with braces, arms, and supports;’ and then going through *Handcock's* patent and describing all that is old, he should have gone on to say—‘To this I add suspending rods for the purpose of bringing the bearing on to the centre of the table.’ No one can read this specification without seeing that the patentee supposes the arms to be new, as well as the suspending rods. In short, that all is new except the table, the rails, and the catches, which, by means of the suspending rods, he converts into a new and improved suspended turn-table. That being so, he clearly does not, in my opinion, comply with the rule which requires the patentee distinctly to state what is new and what is old. In my judgment the specification is insufficient.

Per MAULE, J.—I am of the same opinion. All these parts are described together without making any distinction between the one and the other; all are described indiscriminately as comprising the invention. The true meaning of the specification is that there is as much novelty in one part as in another. No doubt *Harrison* drew

his specification without reference to *Handcock's* patent, and *bonâ fide* believing that the whole of what he was describing was his own invention. It is equally plain that the whole was not his invention.

HONIBALL *against* BLOOMER, A.D. 1854. 2 Webs. Pat. Ca. 199; }
 10 Ex. R. 538. }

Novelty of Invention. Prior Public Use.

CASE for the infringement of a patent of 15th Aug. 1838, No. 7,774, to *W. H. Porter* (extended for six years), for 'improvements in anchors.' Plea: That the patentee was not the true and first inventor. Issue.

The specification stated:—'My invention relates to a mode of constructing the arms of an anchor, and applying them to the shank by means of an axis.' The drawing showed the shank with two cheeks for receiving the arms, made of sufficient strength to hold a pin or axis, which was secured *in situ* by a split cotter. The end of the shank was marked *a*, the arms were marked *d*, the pin was *e*, and there were two horns or projections on the outside of each arm respectively marked *f*. The specification concluded by saying:—'I am aware that anchors have been made with arms capable of movement in the shank. I do not, therefore, claim the same generally.' *Claim*: 'The mode of constructing and combining the parts *a, d, e, f*, as above described.'

At the trial, one *Logan* was called, who deposed that in 1826 he had made an anchor identical in construction with *Porter's* anchor. That he sold the same for use in a steam-vessel called the *William Huskisson*, in the ordinary way of business, and that after ten years it was returned to him by a certain steam-boat company.

MARTIN, B. said:—'I think if that anchor of Mr. *Logan's* was sold in the regular way of business, although it turned out a failure, as possibly it may have been, this patent cannot be supported. I think myself that if it was really an experiment, that if Mr. *Logan* had put this anchor, having invented or manufactured it, on board a steam-boat for the purpose of trying whether it would answer, and it did not answer, and then it was returned on that ground, then I do not think that would interfere with the patent.' Plaintiff nonsuited.

The first particular in the notice of objections was thus proved, but plaintiff made no application to the judge for a certificate under stat. 15 & 16 Vict. cap. 83, sect. 43. On taxation, the master allowed the costs of the witness called in support of the first objection, as being part of the costs in the cause, but he refused to allow the costs of the remaining objections.

Rule nisi for the master to review his taxation discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.)

HORNBLOWER and MABERLY *against* BOULTON and WATT (*in error*), }
 A.D. 1799. 8 T.R. 95; Dav. Pat. Ca. 221. }
Sufficiency of Specification.

CASE (being the sequel of the proceedings in *Boulton & Watt v. Bull*) brought by defendants in error, against plaintiffs in error, for infringement of *James Watt's* patent of 1769, No. 913. Plea: Not guilty. Issue. Verdict for plaintiffs below, and judgment by the Court of Common Pleas. Error brought in the King's Bench. Judgment for defendants in error.

Per LORD KENYON, C.J.—The principal objection made to this patent by the plaintiffs in error is, that it is a patent for a philosophical principle only, neither organised nor capable of being organised, and if the objection were well founded in fact it would be decisive; but I do not think it is so. No technical words are necessary to explain the subject of a patent; as Lord Hardwicke said upon another occasion—There is no magic in words. The questions here are: Whether, by looking at the patent, explained as it is by the specification, it does not appear to be a patent for a manufacture? and: Whether the specification is not sufficient to enable a mechanic to make the thing described? The jury have not indeed answered those questions in the affirmative in terms, but they have impliedly done so by finding a general verdict for the plaintiffs below. By comparing the patent and the manufacture together, it evidently appears that the patentee claims a monopoly for an engine or machine, composed of material parts, which are to produce the effect described, and that the mode of producing this is so described as to enable mechanics to produce it.

I have no doubt in saying that this is a patent for a manufacture, which I understand to be something made by the hands of man.

HORTON *against* MABON, A.D. 1862–3. 12 C.B. N.S. 437; }
 16 C.B. N.S. 141. }

Subject-matter of a Patent.

CASE for the infringement of a patent of 2nd *Jan.* 1851, No. 13,436, to *J. Horton*, for 'improvements in the construction of gas-holders.' Plea 3. That the invention was not a new manufacture. Issue.

The patent related to a method of constructing the water cup, or hydraulic joint, which connects the several portions of a telescopic gas-holder. Instead of forming this joint, or water trough, by riveting strips of plate iron to lengths of angle iron, the patentee employed lengths of rolled channel iron which were curved to the circular form of the gas-holder. *Claim 3*: 'The mode herein shown

and described of constructing the hydraulic cups or joints of gas-holders in which the top or bottom of the hydraulic joint or valve is formed of plates of iron made or bent into a cup shape, so as to admit of the joint being attached to the gas-holder without the necessity of employing angle iron and double sets of rivets.'

At the trial, it appeared that rolled channel iron was in common use before the date of the patent. ERLE, C.J. directed the jury:— That the invention was not the subject-matter of a patent. Verdict for defendant. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of Common Pleas. (Erle, C.J., Willes, Byles, Keating, JJ.)

Per ERLE, C.J.—This is in fact a claim for the application of double angle iron to the formation of hydraulic joints to telescopic gas-holders. It appears that those who had heretofore constructed telescopic gas-holders formed the hydraulic joints by riveting two pieces of angle iron to a plate which formed the top or bottom of the cup. It was perfectly apparent and palpable that double angle iron would answer the same purpose, and save two rows of rivets, and consequently much additional labour. The whole claim of the patentee therefore amounts to this—he informs the manufacturers of gas-holders that by the use of an article well known in the iron trade much labour and expense may be spared. This clearly is not the subject of a patent. It is nothing more than the application of a known instrument to purposes analogous to those to which it had before been applied. This is not a claim for a new article, or for an improved article, but only for a cheaper way of using known materials.

(16 C.B. N.S. 141.) On appeal to the Court of Exchequer Chamber (Cockburn, C.J., Crompton, Blackburn, Mellor, JJ., Martin, Channell, Pigott, BB.), judgment affirmed.

THE HOUSEHILL COMPANY *against* NEILSON, A.D. 1843. }
 1 Webs. Pat. Ca. 673; 9 Cl. & F. 788. }

Misdirection by Judge as to prior Public User.

Appeal to the House of Lords, from a judgment of the Court of Session in Scotland, disallowing a bill of exceptions tendered by appellants, who were defenders in the Court below. The action was brought for the infringement of a *Scotch* patent for the application of the *hot-air blast* in smelting iron, granted to *J. B. Neilson*.

Exception 11. In so far as the Lord Justice Clerk directed the jury, in point of law, that the proof of prior use of the patent invention (1) must be public, (2) must have been continued, not abandoned, (3) must have continued to the time when the patent was granted,

not to the very exact period, but that it must have been known and used as a useful thing at the time.

(Webs. Pat. Ca. 718, *n.*) During the argument LORD LYNDHURST, L.C. observed:—‘If the machine be published in a book distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed books without reference to anything that has been done.’ And LORD BROUGHAM said:—‘It must not be a foreign book, but published in *England*.’

Judgment reversed upon the eleventh exception, and affirmed upon the others. *Venire de novo*. No costs to either side.

Per LORD LYNDHURST, L.C.—I never heard it before questioned that the notorious public use of an invention before the granting of the letters patent, though it may have been discontinued, is sufficient to invalidate the letters patent.

Per LORD CAMPBELL.—When we come to the eleventh exception, I most sincerely regret that we are bound to allow it. To suppose there may have been a prior use of the invention, of the perfected invention, for which the letters patent are granted, and that such prior use, publicly known, will not vitiate the patent, if it has been abandoned but a few weeks before the date of the patent, strikes us in this part of the country with astonishment. That certainly is not the law as we have ever understood it.

HUDDART *against* GRIMSHAW, A.D. 1803. Dav. Pat. Ca. 265; }
1 Webs. Pat. Ca. 85. }

Evidence of Infringement.

CASE for the infringement of a patent of 25th *April*, 1793, No. 1,952, to *J. Huddart*, for ‘a new mode of making great cables and other cordage so as to attain a greater degree of strength by a more equal distribution of the strain upon the yarns.’ Plea: Not guilty. Issue.

The patent related to a method of twisting yarns into a strand in such a manner that each separate yarn should bear the same strain. Hitherto, it had been the practice to stretch a number of yarns side by side before twisting them into a strand, whereby some of the yarns took one position and some another, those near the outside being in a state of tension while those in the inside were puckered up. The specification stated:—‘The substance of this invention is the making of strands in which all the yarns shall be disposed in concentric cylindrical layers about a centre yarn. Each yarn is passed through a corresponding hole in a register plate. The holes are on the

circumferences of concentric circles round a central hole, and the yarns are then passed through a cylindrical tube. The strand thus formed is drawn forward by a screwing motion through the tube.' In this manner each yarn was retained in the position determined by the register plate, and a strand was formed of a series of concentric layers under equal tension, each ready to bear its due share of any tensile strain.

At the trial, Mr. *J. Rennie*, the engineer, deposed that, upon experiment, a piece of the patent rope bore a load of seventeen and a quarter tons and broke all at once, whereas a piece of common rope of the same size bore only about eight and a half tons, and snapped on the outside first, and so on successively towards the centre; he should have no difficulty in constructing the necessary machinery for making a rope upon Mr. *Huddart's* plan by looking at the patent and specification. In order to prove the alleged infringement plaintiff produced a piece of rope made by defendant. Mr. *Rennie* dissected the piece of rope, and found the external yarn to be two inches longer than the strand, the second shorter than the first, the third half an inch shorter than the second, and expressed his belief that the rope in question had been made on Mr. *Huddart's* method. Defendant called no witnesses.

LORD ELLENBOROUGH, C.J., directed the jury:—Mr. *Rennie* says, I know of no other mode than Mr. *Huddart's* for producing this effect, and in proportion as that is deviated from, the strands will be worse; this piece of rope (the defendant's) exhibits to the eye that regular gradation of length in the different shells which he should expect to find in Mr. *Huddart's* invention. I should state that this is certainly what is called *primâ facie* evidence of its having been made by that method, when one sees it agree in all its qualities; when it is produced with a rope actually made upon Mr. *Huddart's* plan, it is *primâ facie* evidence, till the contrary is shown, that it was made upon his method, and therefore, supposing this patent in full force and a valid one, it is reasonable, fair evidence, in the absence of contrary evidence, to presume that it was made that way. Upon cross-examination, he says it would be a lucky hit if such a rope was made without the perforated plate; it could not be done otherwise than by chance.

Verdict for plaintiff.

HULL *against* BOLLARD, A.D. 1856. 1 H. & N. 134.

Evidence admissible under Particulars of Objections.

CASE for the infringement of a patent for a mill-stone. Plea 2. That the invention was not new. Issue.

The particulars of objections (stat. 15 & 16 Vict. cap. 83, sect. 41)

stated:—‘That the improvements, &c., were not new, and that the same had been generally known, and *publicly used in corn-mills*, for many years previously.’

At the trial, the defendant tendered evidence of prior user at certain mills in *Cheshire*. MARTIN, B. received the evidence. Plaintiff nonsuited.

Rule nisi for a new trial, on the ground that this evidence was inadmissible, discharged by the Court of Exchequer. (Pollock, C.B., Martin, B.) During the argument POLLOCK, C.B. said:—‘The substance of the particulars is that the invention has been used generally all over *England* in corn-mills for grinding corn. It cannot be said that it does not in some degree point out both place and manner, though if there had been an application for better particulars, I should not have held it sufficient.’

Per POLLOCK, C.B.—We are of opinion that if the evidence is within the literal meaning of the words of the particulars, however general the statement, the evidence should be received at the trial. If the particulars are too general, it is the business of the parties who mean to object to them to bring the case before a judge at chambers, and procure an order for better particulars. It is true that the statute (15 & 16 Vict. cap. 83, sect. 41) contains a proviso that the *place* or *places* at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars, not containing such statement, from being available, if not objected to on that ground before the trial.

HULLETT *against* HAGUE, A.D. 1831. 2 B. & Ad. 370.

Novelty of Invention.

CASE for the infringement of a patent of 27th Nov. 1828, No. 5,718, to *W. E. Kneller*, for ‘improvements in evaporating sugar.’ Plea: Not guilty. Issue.

The patent related to a method of evaporating water from a solution of sugar, by blowing air into the liquid. The specification showed an apparatus consisting of a large horizontal pipe, placed near the surface of the liquid, from which a number of small blowing tubes radiated downwards in different directions. Two things were described as essential to the invention—1. That a stream of air should issue from each blowing tube at the same time. 2. That the ends should be all in the same horizontal plane, whereby the fluid would exert the same pressure at each orifice.

At the trial, defendant put in evidence the specification of a patent of 9th May, 1822, No. 4,674, to *R. Knight* and *R. Kirk*, for a similar apparatus, consisting of a set of perforated pipes, coiled or

otherwise, shaped and accommodated to the nature and form of the vessel. The pipes might be replaced by a shallow metallic vessel, in the nature of a colander. Verdict for plaintiff.

Rule nisi to enter a nonsuit refused by the Court of King's Bench.

Per LORD TENTERDEN, C.J.—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. It is evident that the object of the two patents is the same. But the mode of effecting that object is different.

JONES *against* PEARCE, A.D. 1832. 2 Coop. Ch. Ca. 58; }
1 Webs. Pat. Ca. 121, 122. }

Evidence of Infringement. Unsuccessful Experiments. Practice in Patent Suits. Injunction. Account.

Suit to restrain from infringing a patent of 11th Oct. 1826, No. 5,415, to *T. Jones*, for 'improvements in wheels for carriages.' Motion for injunction ordered to stand over till after trial of action at law. Account in the meantime.

Action at law, in pursuance of the above order. Plea: Not guilty. Issue.

The patent related to the application of the suspension principle to the wheels of carriages, whereby the weight pressing on the axle was hung from the upper part of the rim of the wheel, instead of being supported by the spokes from below in the usual manner. *Claim*: 'Substituting suspending rods, made of iron or other suitable metal, in lieu of spokes, by which suspending rods I hang the weight or load from that part of the wheel which happens to be uppermost, and prevent any support by the rods under the axle-tree.'

At the trial, it appeared that a pair of wheels on the suspension principle had been made for Mr. *Strutt* in 1814, and applied to a cart used for carrying stones on the public roads. As to the infringement, plaintiff's foreman deposed that he saw at defendant's premises a pair of gig-wheels, made like plaintiff's on the suspension principle. PATTESON, J. directed the jury:—If this wheel, constructed by Mr. *Strutt's* order in 1814, was used openly in public, so that everybody might see it, and the use had continued up to the time of taking out the patent,* undoubtedly that would be a ground to say that the plaintiff's invention was not new. But if you are of opinion that Mr. *Strutt's* invention was an experiment, that he found it did not answer, and ceased to use it altogether, and abandoned it as useless,

* See observations on this direction in *Carpenter v. Smith*, *supra*, page 73.

and nobody else followed it up, and that the plaintiff's invention which came afterwards was his own invention, and remedied the defects of Mr. *Strutt's* wheel, then there is no reason for saying that the plaintiff's patent is not good. It seems the defendant has constructed a wheel on the suspension principle; that alone would not make it an infringement of the plaintiff's patent, because the suspension principle may be applied in various ways; but if you think it is applied in the same way, then the want of two or three circumstances in the defendant's wheel which are contained in the plaintiff's specification would not prevent his recovering in this action for infringement. It would be quite a different thing if it was shown that the defendant had his communication long before with Mr. *Strutt*, and had taken up Mr. *Strutt's* invention, and had constructed something like it without any knowledge of the plaintiff's patent, and had actually borrowed it from Mr. *Strutt's*, which was good for nothing; it would be the hardest possible thing to say that this was an infringement of the plaintiff's patent.

In reply to a question from the jury, the learned judge further said:—The terms of the patent are, 'without leave or license, make, &c.' Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model.

Verdict for plaintiff.

JONES *against* BERGER, A.D. 1843. 5 M. & G. 208; }
1 Webs. Pat. Ca. 544. }

Sufficiency of Notice of Objections.

CASE for the infringement of a patent for improvements in manufacturing starch. The notice of objections, under stat. 5 & 6 Will. IV. cap. 83, sect. 5. alleged:—3. That the invention had been used before the date of the patent, 'by persons engaged in finishing lace at *Nottingham* and elsewhere.'

Rule nisi to amend the above particulars made absolute by the Court of Common Pleas. (Tindal, C.J., Erskine, Maule, Cresswell, JJ.)

Per TINDAL, C.J.—With regard to the third objection, I think if the words, 'and elsewhere,' are struck out, that there will be no objection to its present form. The patent in this case is for making starch generally, and the notice of objections does limit the user to a particular class of persons, namely, those engaged in the trade of lace-making, in a particular place—*Nottingham*; and it is quite as open to the plaintiff as it is to the defendant to make inquiries in that place among that class of persons.

JONES *against* LEES, A.D. 1856. 1 H. & N. 189.

Pleading. Demurrer. Covenant in a Licence.

COVENANT. The declaration, after setting out so much of the recitals in the deed as stated that plaintiff had invented certain improvements in slubbing and roving machines, and had obtained a patent for the same, averred that plaintiff had granted a licence to defendant to use the invention, and that defendant had covenanted not to make or sell any slubbing or roving machines without the invention applied thereto. Plea (in substance): That the invention was worthless, by reason whereof defendant was unable to use or vend the invention, or to use the licence, wherefore he made and vended machines without the invention applied. Demurrer, and joinder.

During the argument, it was contended that the covenant was void, as being in restraint of trade. Judgment for plaintiff by the Court of Exchequer. (Pollock, C.B., Alderson, Bramwell, BB.)

Per POLLOCK, C.B.—Our judgment must be for the plaintiff. The plea is substantially a plea to the damages only. Then, with respect to the declaration, it would be a very mischievous decision if we were to hold that a contract which, it may be presumed, was reasonable at the time it was entered into, might be construed as a contract in restraint of trade, because something more useful than the subject-matter of it had been invented.

JORDAN *against* MOORE, A.D. 1866. L.R. 1 C.P. 624.

Subject-matter of a Patent.

CASE for the infringement of a patent of 2nd Nov. 1849, No. 12,824 (extended for seven years), to *J. Jordan*, for ‘certain improvements in the construction of ships.’ Plea 4. That the invention was not a manufacture for which letters patent could by law be granted. Issue.

The patent related to the construction of ships with an iron frame and an external covering of wood. The specification stated:— ‘For carrying out my *first* improvement, a suitable iron frame is to be constructed, to which an external covering of timber planking for the sides, bilges, and bottoms will be fastened by means of rivets, bolts, or any suitable fastening. I make no claim to the shape of the iron used in the frame, as it may be constructed of angle iron, T iron, flat or bar iron, or iron of any suitable shape. The vessel may have one or more thicknesses of timber planking. For carrying out my *sixth* improvement, to construct an iron frame adapted to an external covering of timber planking for the sides, bilges, and bottoms, and for a timber keel, timber stem, and timber stern-post,

I make an iron plate form the keel-plate, laid the whole length of the bottom of the vessel, and continued up the stem and stern. To this plate I fasten the keel, stem, and stern post, made of timber, as described (previously). Across the keel-plate iron ribs are to be fastened, and floorings of iron are to be fastened to the iron ribs. On the top of the flooring I place the keelson, made with plate and angle iron, in the form of an inverted arch, to keep the ends of the vessel from drooping.' The drawings attached to the specification showed the construction of the frame-work, as covered with timber planking, described under the sixth head.

Claims: 1. 'The construction of ships with an *iron frame*, combined with an external covering of timber planking for the sides, bilges, and bottoms. 6. The construction of iron frames for ships adapted to an external covering of timber planking for the sides, bilges, and bottoms, as described.'

At the trial, it appeared that before the date of the patent the construction of ships with a combination of wood and iron was well known; that frames partly of iron and partly of wood had been coated with iron; and that iron coating had been placed on iron frames. Several specifications of prior patents were put in.

BYLES, J. left it to the jury to say whether at any time before the date of *Jordan's* patent any ship had been constructed with a complete iron frame, and an external coating of timber planking for the sides, bilges, and bottoms. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant, on the ground that the invention comprised under the first claim was not the subject-matter of a patent, made absolute by the Court of Common Pleas. (Erle, C.J., Willes, Byles, Keating, JJ.)

Per BYLES, J.—It was contended by the counsel for the defendant that the expression, 'iron frame,' in the first claim, was not confined to an iron frame such as that specified in the sixth claim, but comprehended whatever might, according to the ordinary use of language, be called 'an iron frame' for a ship. And on a careful consideration of the specification, we are of that opinion. The first claim is, according to our construction, a claim for planking with timber any iron frame of a ship.

Then arises the main question in the cause—iron and wood being both of them materials long used for the construction of the frame and coating of vessels—can the application of wooden planking to the iron frame of a vessel (without any peculiarity in the nature of that planking) be the subject of a patent. We think it cannot. It is not only the substitution of one well-known and analogous material for another, that is, wood for iron, to effect the same pur-

pose, on an iron vessel, but it is the application of the same old invention—viz., planking with timber, which was formerly done on a wooden frame—to an analogous purpose, or rather the same purpose, on an iron frame. In this view of the case the recent decision of the House of Lords in *Harwood v. Great Northern Railway Company* (35 L.J. Q.B. 27) appears to us to be in point, and decisive for the defendant.

JUPE *against* PRATT, A.D. 1837. 1 Webs. Pat. Ca. 145.

Construction of Claim.

CASE for the infringement of a patent of 11th *March*, 1835, No. 6,788, to *R. Jupe*, for ‘an improved expanding table.’ Plea 3. Setting out the specification, and averring that it was insufficient. Issue.

The patent related to the construction of an expanding table, made in segments, which opened out by diverging from one common centre, the intermediate space being filled up by the insertion of additional pieces or leaves. The specification contained twenty-three drawings, illustrating various methods of subdividing tables, and of moving the segments in grooved guides, which radiated from a centre; and concluded by stating:—‘I do not claim the various parts of the table separately; nor do I confine myself to the precise manner of moving the sections of the surface of the table. But I declare that my invention consists in constructing the same so that the sections of which the unexpanded table is composed may diverge from a common centre, and the table be enlarged by inserting leaves in the openings caused by the divergence as herein described.’

At the trial, defendant called no witnesses, but it appeared that, before the date of the patent, one *Gillow* had invented an expanding telescopic table which opened out in one line, the intermediate space being filled by leaves. The alleged infringement consisted in dividing a table into four parts, and applying *Gillow’s* construction for expanding it.

Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of Exchequer. (Lord Abinger, C.B., Bolland, Alderson, BB.)

During the argument ALDERSON, B. said:—‘You cannot take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other

modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention.

‘I should entertain great doubt whether anything more is claimed here than an expanded table, and whether the contrivance is any part of the invention.’

KAY *against* MARSHALL, A.D. 1836–41. 1 Myl. & Cr. 373; }
 2 Webs. Pat. Ca. 36; 1 Beav. 535; 5 Bing. N.C. 492; }
 8 Cl. & F. 245. }

Practice in Patent Suits. Demurrer. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 26th *July*, 1825, No. 5,226, to *J. Kay*, for ‘new and improved machinery for preparing and spinning flax,’ &c.

The patent related to a process of macerating flax and spinning it at a short reach when in a wet state. The specification, however, stated:—‘My invention consists in new machinery for macerating flax, and in improved machinery for spinning the same.’ The drawing showed a set of cans, perforated for the admission of water, and placed in a trough of water before an ordinary flax-spinning frame. These cans were filled with rovings of flax, which were left to soak for several hours, and the wet sliver was then led between ordinary retaining and drawing rollers before being spun. The specification stating:—‘I place the drawing rollers only two and a half inches from the retaining rollers, and this constitutes the principal improvement in the said spinning machinery.’ *Claim*: ‘What I claim as my invention in respect of new machinery for preparing flax are the macerating vessels and the trough of water; and in respect of improved machinery for spinning flax, I claim the placing of the retaining and drawing rollers nearer to each other than they have ever before been placed, say, within two and a half inches from each other, for the purpose aforesaid.’

The bill stated the grant of the patent, and that plaintiff had duly enrolled a specification wherein he had described and ascertained the nature of his invention. Demurrer for want of equity. SHADWELL, V.C. ordered the demurrer to stand over, with liberty to plaintiff to bring an action. On appeal to the Lord Chancellor the order was discharged, and the demurrer over-ruled.

Per LORD COTTENHAM, L.C.—Upon the face of the bill the plaintiff alleges that he did by his specification do all that his patent required him to do. What follows is merely the *claim*, not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an inven-

tion. It is introduced (particularly in the case of a patent for an improvement) lest the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification as containing the description be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description.

Feigned issue at law in pursuance of the order of the Court. Verdict for plaintiff, with an endorsement on the *postea* to the effect that, before the patent, flax, hemp, and other fibrous substances were spun with machines with slides whereby the reach was varied according to the length of staple or fibre. That in cotton spinning the reach varied from seven-eighths of an inch to an inch and a quarter, in flax spinning from four to nine inches, and in worsted from five to fourteen inches. That before the patent it was not known that flax could be spun by maceration at two and a half inches.

On application, LORD LANGDALE, M.R. stated a case for the opinion of the Court of Common Pleas, who (Tindal, C.J., Vaughan, Bosanquet, Erskine, JJ.) certified that plaintiff's patent was not valid in law.

Per TINDAL, C.J.—The patentee, in describing the new and improved machinery for spinning which constitutes one part of his patent, informs the public that he places the drawing rollers only two and a half inches from the retaining rollers, and that this constitutes the principal improvement in the said spinning machinery. Now, whether a patent can by law be taken out for placing the retaining rollers and the drawing rollers of a spinning machine (which machine was itself known and in use before), within two inches and a half of each other, under the circumstances stated in the case, is the real question between the parties; and we think it cannot. The application of a reach of two and a half inches to the spinning of flax, when in a state of maceration, by which the fibre of flax will not hold together beyond that distance, does not appear to us to be any new invention or discovery, but is merely the application of a piece of machinery, already known and in use, to the *new* macerated state of flax. And if a patent taken out for that object separately would be invalid, so also a patent taken out for an invention consisting of two distinct parts, one of which is the precise object, would be void also. If part of what is claimed is not properly the subject of a patent, or is not new, the whole must be void.

The case now came on to be heard on further directions, when the bill was dismissed with costs. On appeal to the House of Lords, judgment affirmed with costs.

Per LORD COTTENHAM, L.C.—All the variation which the plaintiff introduced into the ordinary spinning machine, which he claims as his invention, is fixing the rollers at two and a half inches distance from each other. It is not, as was argued at the bar, one invention, viz., the macerating of flax, and using flax so macerated with a particular machine. Another mode has been adopted of macerating the flax. If the patent be good so far as the spinning machine is concerned, the existence of the patent deprives the defendants and all the rest of the world of the right of using the ordinary spinning machine in the form in which they had a right to use it before the patent was granted. That is not the object of the patent: if the plaintiff has discovered any means of using the spinning machine which the world had not known before, the benefit of that he has a right to secure to himself by means of a patent; but if this mode of using the spinning machine was known before—and the endorsement upon the *postea* states that it was known before—then the plaintiff cannot deprive others of having the benefit of that which they enjoyed before.

LANG *against* GIBBORNE, A.D. 1862. 31 Beav. 133.

Evidence of prior Publication.

Suit to restrain from infringing a patent for a self-registering target constructed in such a manner that an electric current should indicate the particular segment struck by the bullet. It appeared that four copies of a book by *V. du Moncel*, published in *France*, and containing an account of a like invention by one *De Brettes*, had been sold in *London* before the date of the patent. One of these copies was purchased for the library of the University of *Cambridge*. Injunction refused. Costs reserved.

Per ROMILLY, M.R.—I am of opinion that a publication takes place when the inventor of any new discovery, either by himself or by his agents, makes a written description of it and prints it in a book and sends it to a bookseller's to be published in this country. I think that as soon as the work is offered for sale in the public shop of a bookseller in this country, that becomes a publication of the invention. Here I have it proved that a public library in one of the large universities of *England* had actually bought the book. [His Honour then examined the evidence, and came to the conclusion that *De Brettes'* invention was identical with that of the plaintiff.] The real and only question is whether the fact of *V. du Moncel's* book

having been sent to this country and publicly exposed for sale in an ordinary bookseller's shop, and bought by several persons, and among others by a public library, amounts to a publication of the invention here; because so long as it remained in *France* it was not a publication. I have already expressed my opinion, and it follows that I cannot treat this as a valid patent.

LAWES *against* PURSER and OTHERS, A.D. 1856. 6 E. & B. 930.

Pleading. Demurrer. Consideration for a Licence.

Action for money payable by defendants to plaintiff on account of royalties under an agreement for the use of a certain patent. Plea: That the patent was void, and that defendants had a right to make and sell the articles without plaintiff's permission. Demurrer, and joinder. Judgment for plaintiff by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—I am of opinion that the defendants, not denying that they have used the invention under the agreement, cannot set up this defence. No fraud is alleged, no renunciation of the permission, warning the plaintiff that the defendants meant to claim to use the invention in their own right, is averred. I think it would be contrary to all principle to hold this plea good.

Per WIGHTMAN, J.—It is clear that the agreement has been acted upon; and the defence is that, the patent being invalid, there is, as it is said, no consideration; but it seems to me that the defendants had, in fact, all that they bargained for. It may very well be that the discovery that the patent was invalid was only made at the time of the plea pleaded; and it is clear to me that enjoyment by permission of the patentee, while the patent was supposed to be valid, is consideration. The point is very nearly the same as that in *Taylor v. Hare* (1 B. & P. N.R. 260).

Per ERLE, J.—It is my opinion that the defendants are bound by their promise, they having had the consideration they bargained for.

LEWIS and ANOTHER *against* DAVIS, A.D. 1829. 3 Car. & P. 502.

Subject-matter of a Patent.

CASE for the infringement of a patent of 15th *Jan.* 1818, No. 4,196, to *J. Lewis, W. Lewis, and W. Davis*, for 'improvements in shearing machines for shearing woollen and other cloths, the same being further improvements on a patent obtained by *J. Lewis* for an improved shearing machine, dated the 27th *July*, 1815.' Plea: Not guilty. Issue.

The patent related to a method of shearing cloth by a triangular

steel cutting wire bent round a cylinder in the form of a spiral. The specification described the machine by reference to drawings, whereof one showed the cylinder and cutting wire adapted for shearing cloth from list to list. It also stated:—‘A narrow strip of plush is fixed on the surface of the cylinder parallel to the cutting wire to answer the purpose of a brush for raising up the wool which is to be shorn off the cloth; or, instead of the plush, bristles may be inserted into the cylinder.’ There were flat springs and a steel bar for directing and pressing the cloth against the cutting edges. *Claims*: 1. ‘The application of the flat springs and bar for directing and pressing the cloth to be shorn against the cutting edges. 2. The application of the triangular steel wire on the cylinder. 3. The application of a proper substance fixed on the cylinder to brush the surface of the cloth to be shorn. 4. The described method of shearing cloth from list to list by a rotatory cutter.’

At the trial, LORD TENTERDEN, C.J. required the production of the previous patent of 1815. It appeared that the alleged infringement consisted in making a machine with rotatory cutters for shearing from list to list, but that defendant had not infringed any of the first three claims of invention; also that the old method of shearing from list to list was by machinery carrying shears. It further appeared that rotatory cutters for shearing lengthways, or from end to end, were not new at the date of the patent, and evidence was adduced to show that plaintiffs’ improvements were useful.

LORD TENTERDEN, C.J. directed the jury:—It is not material whether a machine made under the patent of 1815 is useful or not, as it is shown that the plaintiffs’ machine is highly useful. The case stands thus: it appears that a rotatory cutter to shear from end to end was known, and that cutting from list to list by means of shears was also known. However if, before the plaintiffs’ patent, the cutting from list to list and the doing that by means of rotatory cutters were not combined, I am of opinion that this is such an invention by the plaintiffs as will entitle them to maintain the present action.

Verdict for plaintiffs. In the ensuing term a rule for a new trial was moved for and refused.

LEWIS and ANOTHER *against* MARLING, A.D. 1829. 4 Car. & P. 52, 57; }
10 B. & C. 22; 1 Webs. Pat. Ca. 490. }

Partial failure of Utility. Novelty of Invention.

CASE for the infringement of the same patent. Plea: Not guilty. Issue.

At the trial, it appeared that when two or more cutting wires were fixed on the cylinder, the brush described in the previous abstract

was not required and was not used. Also that, in 1811, a specification had been enrolled in *America* for a machine to shear cloth from list to list by rotatory cutters; that a model of this machine was brought to *England*, and there exhibited to three or four persons; that workmen were employed to construct a machine from the *American* specification, but that no such machine was ever completed. Also that the manufacturer who commenced to construct the *American* machine had become a purchaser of plaintiffs' machines.

It was objected that the patent was void by reason of claiming the plush for raising the wool, which was useless. LORD TENTERDEN, C.J. over-ruled the objection. Verdict for plaintiffs with 200*l.* damages.

(10 B. & C. 22.) Rule for a new trial, on the grounds (1) that the brush was of no use, (2) that shearing from list to list by rotatory cutters was not new, refused by the Court of King's Bench. (Lord Tenterden, C.J., Bayley, Parke, JJ.)

Per LORD TENTERDEN, C.J.—As to the objection on the ground that the application of a brush was claimed as part of the invention, it does not appear that the patentee says the brush is an essential part of the machine, though he claims it as an invention. I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful. Several of the cases already decided have borne hardly on patentees; but no case has hitherto gone the length of deciding that such a claim renders a patent void, nor am I disposed to make such a precedent.

I told the jury that if it could be shown that the plaintiffs had seen the model or specification, that might answer the claim of invention; but there was no evidence of that kind, and I left it to them to say whether it had been in public use and operation before the granting of the patent. They found it had not, and I think there is no reason to find fault with their verdict.

Per PARKE, J.—The patent is for several things, one of which then supposed to be useful is found out not to be so; but there is no case deciding that a patent is on that ground void, though cases have gone the length of deciding that if a patent be granted for three things, and one of them is not new, it fails *in toto*. The prerogative of the Crown as to granting patents was restrained by the statute 21 Jac. I. cap. 3, sec. 6, to cases of grants 'to the true and first inventors of manufactures, which others at the time of granting the patent shall not use.' The condition, therefore, is that the thing shall be new,

not that it shall be useful ; and although the question of its utility has been sometimes left to a jury, I think the condition imposed by the statute has been complied with when it has been proved to be new. There was no evidence of the use of such a machine [as the plaintiffs'] before the grant of the patent, and there is no case in which a patentee has been deprived of the benefit of his invention because another also had invented it, unless he had also brought it into use.

LISTER and DONNISTHORPE *against* LEATHER, A.D. 1858. 8 E. & B. 1004.
Evidence of Infringement. Protection of part of a new Combination. Sufficiency of Particulars of Objections.

CASE for the infringement of patents (each in part disclaimed) of 20th *March*, 1850, No. 13,009, to *S. C. Lister* and *G. E. Donnisthorpe*, and of 2nd *Feb.* 1852, No. 13,950, to *S. C. Lister* and *T. Ambler*, for 'improvements in combing wool.' Pleas (as to patent of 1850): 1. Not guilty. 3. That plaintiffs were not the true and first inventors. 4. That the invention was not new. 5. That the specification was insufficient. And like pleas as to patent of 1852. Issue.

The particulars of objections (see stat. 15 & 16 Vict. cap. 83, sect. 41) alleged prior publication of the invention by the specifications of divers patents, stating only the names of the patentees. On order for better particulars, defendant amended by further stating that the patents relied on had been granted 'to plaintiffs and each of them respectively, between 1st *Jan.* 1840, and 20th *March*, 1850.' At the trial, ERLE, J. ruled that this was not a sufficient compliance with the order, and refused to admit in evidence the specification of a patent granted to plaintiffs in 1849. The Court of Queen's Bench supported this ruling.

The patents related to improvements on a patent of 25th *Feb.* 1846, No. 11,103, to *J. Heilmann*, for a new method of combing wool. According to *Heilmann's* patent, the fleece of wool as fed into the combing machine was detached and broken asunder while being nipped or held either between bars or between a delivering roller and a guide plate. Each end of the portion was combed successively, the long and short fibres being separated ; the long ones being united into one sliver and the short ones into another, and so passed out ready for drawing and roving.

The specification of the patent of 1850, No. 13,009, stated that one part of the invention consisted of improvements in arranging apparatus by which the mode of preparing wool by taking hold of, drawing out, detaching and strengthening by mechanical means, successive small quantities of fibrous material, as described in a previous patent of 1849 (No. 12,712), might be more advantageously

carried into effect. It described the machine by reference to drawings, and showed a series of gill combs for bringing forward the wool. A tuft was then drawn out by the nipping action of a bar upon an endless travelling apron and was cleaned by combing at one end. A porter brush detached the half-cleaned tuft and deposited it on a comb, which speedily became filled with wool ready to be drawn off and deposited in a cleaned state on a travelling apron, the noil and dirt being left on the opposite side of the comb. There was no separate claim.

The specification of the patent of 1852 stated:—‘Fifthly, our invention relates to transferring wool from one set of carrying combs to another.’ It then showed an arrangement of link work, consisting of a short revolving crank and a reciprocating arm connected by a link which was produced beyond its point of connection with the crank and carried a comb. By the revolution of the crank this comb swept to and fro through a given space, and lifted a tuft of wool from one fixed comb and deposited it upon another. *Claim*: ‘The various improvements herein described in the processes of preparing and combing wool and other fibrous materials.’

At the trial, it appeared that plaintiffs had purchased *Heilmann’s* patent of 1846, and had amended the specifications (of 1850 and 1852) with the intention of disclaiming any portions of that invention which might be contained therein.

The alleged infringement of the patent of 1850 consisted in the transferring a half-cleaned tuft by means of a porter instrument on to a comb for the purpose of drawing it off and completing the combing according to plaintiffs’ process.

The alleged infringement of the patent of 1852 consisted in the use of a comb rotating on a cylinder which lashed into the feed during its ascent, detached a tuft, and deposited it on another comb by its descent during each revolution.

The patent of 1849, No. 12,712, was tendered in evidence under the notice of objections; but ERLE, J. refused to admit it, being of opinion that the amended notice before referred to was not a sufficient compliance with the order for better particulars.

Verdict for plaintiffs.

Rule nisi for a new trial, on twenty-one grounds of objection, discharged by the Court of Queen’s Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—The object of the manufacture is to remove the noil, or dirt, and short fibres from wool, and to make the long fibres into a sliver, from which the thread is spun; and this object was originally effected by a lashing process, at first by hand, and then by a series of mechanisms improved by inventors; then with a

nipping process instead of lashing invented by *Heilmann* in 1846; and his process was followed by improvements by other inventors down to the process claimed by the plaintiffs as their invention in 1850. In this process a tuft is detached from the lap of wool by nipping, and the tail half of the tuft is cleaned in detaching; then this tuft is placed in such a position that by drawing off the head half is also cleaned and a good sliver is procured. The process combines five movements of the wool to be made in a certain order—viz., 1. carrying in; 2. detaching; 3. transferring; 4. depositing; 5. carrying out—each producing a certain change, and the total of the changes resulting in a product of a good sliver from uncombed wool; and the mechanism combines all the subordinate mechanisms that make these movements in their order. The patent is for the whole combination of mechanism for performing the whole process as described in the specification.

In respect of this invention (*Heilmann's*) two questions were raised, one of fact for the jury, that is: Was the plaintiffs' invention, taken as a whole, substantially the same as *Heilmann's*? and one of law for the Court, in respect of *Heilmann's* nipping process. With respect to the plaintiffs' invention being substantially the same as *Heilmann's*, the jury saw the two machines, and thought them substantially different; and we have also considered them and do not think that the jury have come to a wrong conclusion. Then was there misdirection in respect of this issue? The jury were told in the common form on this point, 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. In this there was no misdirection.

With respect to the issue on the infringement of the patent of 1850, the evidence was that the defendant used *Crabtree's* machine in which a tuft was detached by a comb lashing into feed carried in by porcupine rollers, and was cleaned as to its tail half by carding surfaces. This part of the process was said to be substantially different from the part of the plaintiffs' process relating to the first half of the tuft. But with respect to the transferring the tuft, so half cleaned by a porter instrument, and placing it on a comb for carrying it out, the evidence for the plaintiffs was strong to show that this material part of the process used by the defendant was identically the same with that specified by the plaintiffs in 1850; and that the combination of mechanism used by the defendant for performing this part of the process was substantially the same as that described in the plaintiffs' specification in 1850. The law was laid down that the plaintiffs' patent was for the whole combination, for the whole process as speci-

fied; but that the defendant might be guilty of an infringement without using that whole combination for that process. Objections have been raised to this part of the summing-up in many shapes; the substance of all being, that the taking of a part is either no infringement of a patent for a whole, or, if it is, the patent for the whole is void unless every part is new. But all the points made for the defendant here were made and over-ruled in the three cases which decide that a patent for a whole combination may be infringed by taking a part, provided it is a new and a material part, of the combination. His Lordship then proceeded to comment on the cases (*Sellers v. Dickinson*, 5 Ex. R. 312; *Newton v. Grand Junction Railway*, 5 Ex. R. 331; *Smith v. London and North-Western Railway Company*, 2 E. & B. 69.) and continued:—We cite these cases at length because the principle in all is the same as that laid down to the jury in the present case, and they establish 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, without any express claim of particular parts, and notwithstanding that parts of the combination are old.

With respect to the infringement of the patent of 1852: the comb of the defendant rotated on a cylinder, and in ascending lashed into the feed and detached a tuft, and in descending deposited it on a carrying-out comb. The plaintiffs' comb performed precisely the same action and with the same effect. As to the last half of the process, namely, that relating to the head of the tuft, the variation of form was that the plaintiffs' comb did by oscillation what the defendant's comb did by rotation with two semi-axial turns. The jury found for the infringement; and we see no valid objection either to their finding or to the summing-up. Another ground for a new trial was the rejection of the office copy of the plaintiffs' specification in 1849 tendered by the defendant. After a summons, a judge made an order on defendant to give the names and dates of the specifications of the plaintiffs intended to be used, or that they should be excluded. The defendant then gave notice for all the plaintiffs' specifications between 1840 and 1850, and contended at the trial that this was a compliance with the order. The judge ruled that it was not. On this ruling we see no mistake of law.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Williams, Willes, JJ., Martin, Bramwell, Watson, BB.), judgment affirmed.

Per WILLIAMS, J.—It was argued before us, on behalf of the appellant, that, if a patent be taken out for a combination of *a*, *b*, and *c*, it could not be infringed by using a combination of *b* and *c*

only. We are of opinion that the answer to this inquiry turns altogether upon what *a*, *b*, and *c* are, how they contribute to the object of the invention, and what relation they bear to each other. Cases may possibly be suggested where the use of *b* and *c* might not be an infringement of the patent; but more easily cases may be put where the use of *b* and *c* would be an infringement of the patent. Whether in this case it was so or not would depend on the facts of the case, and may be more a question of fact for the jury than of law for the Court of Appeal. But the facts are not before us, and we think the Court was right in deciding that the use of a subordinate part of the combination might be an infringement of the patent if the part so used was new (by which we understand new in itself, or in its effect, not merely in its application) and material.

It may be that a combination is not distinctly and expressly claimed in either of these patents. But neither a claim nor a disclaimer is essential to a specification; that which appears to be the invention, or a part of it, will be protected, though there be no claim; and those matters which manifestly form no part of the invention need not be disclaimed.

LISTER *against* EASTWOOD, A.D. 1864. 9 L.T. N.S. 766.

Infringement by User of part of a Combination.

CASE for the infringement of two patents for combing wool, viz., of 20th *March*, 1850, No. 13,009, and of 24th *Feb.* 1851, No. 13,532. The cause was tried before Erle, C.J., when the jury found for defendant.

Rule for a new trial—on the ground of misdirection by the learned judge in telling the jury that, if defendant had taken a new and material part of plaintiff's combination, it was necessary that the part so taken should be used for precisely the same purposes in order to constitute it an infringement of the plaintiff's patent—refused by the Court of Common Pleas.

Per WILLIAMS, J.—The Chief Justice proceeded to tell the jury that in order to constitute an infringement the defendant must not only have taken a new and material part of the combination, but must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect. We are of opinion that this was a correct exposition of the law. It is true that in the judgment of the Court in *Lister v. Leather* (8 E. & B. 1004) this qualification of the doctrine was not superadded in express terms, but it appears to us to flow inevitably from the principles on which that doctrine was founded.

LOSH *against* HAGUE, A.D. 1838. 1 Webs. Pat. Ca. 200.

Subject-matter of a Patent. New use of an old thing.

Suit to restrain from infringing a patent (in part disclaimed) of 31st Aug. 1830, No. 5,989, to *W. Losh*, for 'improvements in the construction of wheels for carriages *to be used on railways.*' Injunction granted by SHADWELL, V.C., plaintiff undertaking to bring an action at law.

Action accordingly. Plea 3. That plaintiff was not the true and first inventor. Issue.

The specification stated:—'The spokes, the rims or felloes, and the tires of wheels constructed according to my improvements, are to be made wholly of malleable iron.' *Claim 3*: 'The making the wheels of carriages to be used on railways with wrought-iron spokes, having elbow bends at the outer ends to form feet, which ends are joined by welding either to a complete ring of wrought-iron, around which a hoop of wrought-iron tire is to be fixed, or else to a hoop of wrought-iron tire made of sufficient strength in manner hereinbefore described.'

At the trial, defendant put in evidence the specification of a patent of 24th Sept. 1808, No. 3,169, to *J. Paton*, for 'improvements in the construction of wheels for carriages,' which stated:—'1. Instead of making my wheels of wood I make the stocks or naves of wrought-iron. 2. In place of wood spokes I insert spokes made of wrought-iron. 5. I make the *fillys*, or the external circle that the tire fixes on, of iron or other metal, and make them and the spokes of one solid piece, or fix the *fillys* to the spokes with rivets, screws, and nuts.'

LORD ABINGER, C.B., directed the jury:—It does appear to me that Mr. *Losh* claims a wrought-iron circumference as part of the *modus operandi* of making his wheel. If you are of that opinion, if you think he substantially claims the wrought-iron periphery as part of his improvement, and you think that that wheel with the wrought-iron periphery has been made before, and made substantially in the same manner, the defendant will be entitled to your verdict.

The learned counsel has stated to you that Mr. *Losh* has taken out his patent to use his wheels on railways. He says the wheels made by Mr. *Paton*, or by the other workmen who were called as witnesses, were never applied to railways at all. There is some nicety in considering that subject. The learned judge then discussed the case of *Hall v. Jarvis* (1 Webs. Pat. Ca. 100), and continued:—That was the application of a new contrivance to the same purpose; but it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a

new object—that is a very different thing. In the case the learned counsel put, he says, if a surgeon goes into a mercer's shop and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he, seeing that, would have a right to take out a patent in order to apply the same scissors to cutting a sore, or a patient's skin. I do not quite agree with that law. I think if the surgeon had gone to him and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet by putting a knob at the end,' that would be quite a different thing and he might get a patent for that; but it would be a very extraordinary thing to say, that because all mankind have been accustomed to eat soup with a spoon, a man could take out a patent because he says you might eat peas with a spoon. The law on this subject is this: that you cannot have a patent for applying a well-known thing which might be applied to fifty thousand different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with, if the scissors were never invented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that? I must own, therefore, that it strikes me, if you are of opinion that this wheel has been constructed by the persons who have been mentioned long before the plaintiff's patent, that although there were no railroads then to apply them to, and no demand for such wheels, yet the application of them to railroads afterwards by Mr. *Losh* will not give effect to his patent. That is my opinion on the law, and on that I am bound to direct you substantially.

Verdict for defendant on third issue.

MCCORMICK *against* GRAY, A.D. 1861. 7 H. & N. 25.

Evidence of Infringement. Novelty of Invention.

CASE for the infringement of a patent of 7th Dec. 1850, No. 13,398, to *R. A. Brooman*, for 'improvements in agricultural machines' (a communication from abroad). Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 6. That the invention was not a new manufacture within the statute. Issue.

The patent related to a form of reaping machine provided with a gathering reel for bringing the straws into position, and having also holding fingers and a cutting blade. The specification stated:— 'The fingers hold the straws from yielding with the lateral action of a cutting blade; and for better accomplishing this object they are formed of a shape like a spear-head, which causes the straws to slide into the spaces between them, and, as the inclined edges of the roots of the fingers form an acute angle with the edge of the knife, the

cutting through of the straws is sure to be effected by the reciprocating movement of the knife blade.' A drawing attached to the specification showed the cutting blade, which was a strip of steel having serrated teeth formed either upon a straight or an indented edge. *Claim*: 'The construction of reaping or grain cutting and gathering machines, according to the improvements described; that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed.'

At the trial, it appeared that the alleged infringement consisted in making and selling knives or cutting blades similar to those of plaintiff. Defendant put in certain volumes of the *Franklin Institute*, containing the specifications of prior patents for improvements in reaping machines. Verdict for plaintiff, subject to a case stated.

The questions for the opinion of the Court were:—1. Whether the publications referred to in the notice of objections entitled the defendant to a verdict on the second and sixth issues. 2. Whether the making and selling by defendant of the knives or pieces of steel was an infringement of the patent. Judgment for defendant by the Court of Exchequer. (Pollock, C.B., Martin, Bramwell, Channell, BB.)

Per POLLOCK, C.B.—I am of opinion that our judgment ought to be for the defendant. I agree with the observation of my brother Martin that the plaintiff's invention is substantially an embodiment of the machine for cutting grain mentioned in the 10th volume of the *Franklin Institute*, published in the year 1845. It seems to me that the description of that machine is sufficient to render the subject-matter of the plaintiff's patent not a new invention; at least it shows that the plaintiff ought not to have claimed each of the three materials—viz., the holding fingers, the cutting blades, and the gathering reels. It may be that if a person made a reaping machine with a cutting blade like the plaintiff's, that would be an infringement of his patent; but a blade is not, in my judgment, a machine, and the making it will do no harm to the plaintiff until it is adapted to a reaping machine.

Per MARTIN, B.—If our judgment depended on the question whether the making by the defendant of the cutting blade was an infringement of this patent, I should not be prepared at present to concur. However, it is not necessary to express an opinion on that point, because it is clear that this patent is void for want of novelty.

Per BRAMWELL, B.—There is no difference between making a thing with one intent and another. If a man may do a thing, he may do it with whatever intent. If the blade is used in some machine not the same as that described in the patent, the patent is not infringed. I am satisfied that the defendant is entitled to a verdict on the plea of not guilty.

Per CHANNELL, B.—I do not understand that the patentee claims the invention of cutting blades *simpliciter*, but only when placed in a machine of this description. That being the construction which I put on the specification, it seems to me that there has been no infringement of the patent.

MACFARLANE *against* PRICE, A.D. 1816. 1 Stark. R. 199.

A Specification must distinguish the new from the old.

CASE for the infringement of a patent of 29th Dec. 1808, No. 3,189, to *M. McGregor* and *W. Macfarlane*, for ‘improvements in umbrellas.’ Plea: Not guilty. Issue.

The patent related to the construction of folding umbrellas, and the specification contained several drawings, whereof one represented the contrivance pirated, being a method of inserting a stretcher into a whalebone socket. There was no distinction drawn as to what was new or what was old. Plaintiff nonsuited.

LORD ELLENBOROUGH, C.J. said:—‘The patentee in his specification ought to inform the person who consults it, what is new and what is old. He should say, “My improvement consists in this;” describing it by words if he can, or if not by reference to figures. But here the improvement is neither described in words nor by figures; and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. Then it is said that the patentee may put in aid the figures; but how can it be collected from the whole of these in what the improvement consists?’

MACKELCAN *against* RENNIE, A.D. 1862. 13 C.B. N.S. 52.

Sufficiency of Specification.

CASE for the infringement of a patent of 8th Sept. 1857, No. 2,338, to *G. J. Mackelcan*, for ‘improvements in floating docks.’ Plea: That the specification was insufficient. Issue.

The patent related to the construction of a floating dock intended to be sunk sufficiently for the reception of a ship, and then floated so as to lift the ship out of the water. The provisional specification stated:—‘I construct a pontoon or vessel of *iron* framing,

sheeted over entirely with *plate iron* so as to form an air-tight chamber, subdivided into compartments.' The complete specification stated:—'Having in a provisional specification described the nature of my invention, I will now proceed particularly to describe the same;' and went on to explain the arrangement of parts and the method of employing the dock, but said nothing about its being constructed of iron. *Claim*: 'The arrangement and combination of all the parts of my floating dock as represented and described.'

At the trial, it appeared that floating docks constructed of timber were well known before the patent, and that plaintiff's invention consisted in constructing such docks of iron. There being, however, no mention of iron in the complete specification, ERLE, C.J. ruled that the provisional specification could not be prayed in aid for the purpose of supplying a defect in the complete specification, and plaintiff was nonsuited.

Rule for a new trial, moved for by plaintiff in person, on the ground of misdirection, refused by the Court of Common Pleas. Plaintiff submitted that the drawings annexed to the specification sufficiently showed to the eye of an engineer that the structure was intended to be of iron, it being impossible that the geometrical lines employed could have any other meaning.

Per WILLIAMS, J.—The plaintiff in this case had obtained a patent for 'improvements in floating docks.' In the course of the trial, it appeared that the construction of floating docks was not novel. The plaintiff then alleged that his invention did not consist in the construction of floating docks, but in the application of iron so as to form air-tight and water-tight chambers.

The Lord Chief Justice was of opinion, that, inasmuch as there was no mention of iron in the complete specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and in what manner it was to be carried into effect; and accordingly he directed a nonsuit to be entered. We are all of opinion that he was quite right in so doing. The complete specification, taken by itself, confessedly did not make any such claim as suggested. It has, however, been urged by the plaintiff, that, if it be read with the provisional specification, it will be found substantially to contain that claim. But even if the specification can be so read (which we do not admit) we are of opinion that it discloses no such claim, and therefore that the nonsuit was right. We think it right to add that it must not be inferred that the Court entertains an opinion that the alleged invention, even if it were appropriately claimed, could properly be the subject of letters patent. We wish not to be supposed to sanction such a notion.

MACNAMARA *against* HULSE, A.D. 1842. Car. & M. 471; }
 2 Webs. Pat. Ca. 128, n. }

Novelty of Invention. Sufficiency of Specification.

CASE for the infringement of a patent of 15th *March*, 1837, No. 7,324, to *R. Macnamara*, for ‘improvements in paving roads.’ Pleas: 2. That plaintiff was not the true and first inventor. 4. That the specification was insufficient. Issue.

The specification stated:—‘My invention consists in an improved method of cutting or forming stone *or other suitable material*, for paving roads;’ and described the blocks by reference to figures which showed that the upper surface of a block was rectangular, and that the sides were bevelled in two halves; the angle of the bevel not being stated. *Claim*: ‘The mode of forming stones to the figure shown for the purpose of producing better paving of roads as described.’

At the trial, defendant put in evidence the specification of a patent of 10th *Nov.* 1825, No. 5,287, to *J. J. A. McCarthy*, for paving blocks which had two bevels inwards and two bevels outwards on the same side, one over the other, whereby it was apparent that plaintiff’s block could be made from *McCarthy*’s block by cutting it into two halves along the angle of the bevel, and placing the pieces end to end. The alleged infringement consisted in the use of single bevelled blocks; two of defendant’s blocks, when placed in juxtaposition, making one of the patented blocks.

At the trial, LORD ABINGER, C.B. observed:—‘It will be for the jury to say whether any particular angle of the bevel is essential, or whether any angle whatever is useful or beneficial. If the specification leave it to experiment to determine what is the proper angle, it is not good; but if any angle is a benefit, it will do.’ And his Lordship finally said:—‘I think that the words “any other suitable material” include a wood pavement, though probably the plaintiff never contemplated it. You can make the plaintiff’s block by cutting *McCarthy*’s block into two, and you can make the defendant’s block by cutting *McCarthy*’s block into four, and there is an end of the originality. I think so, and probably the jury think so too.’

Verdict for defendant on the second issue: the jury discharged as to the other issues.

MANTON *against* PARKER, A.D. 1814. Dav. Pat. Ca. 327; }
 1 Webs. Pat. Ca. 192, n. }

Total failure of Utility.

CASE for the infringement of a patent of 6th *July*, 1803, No. 2,722, to *J. Manton*, for a ‘new invented hammer for the locks of fowling-pieces.’ Plea: Not guilty. Issue.

The specification stated that the object of the invention was to let the air out of the barrel while ramming down the wad. For this purpose the part next the touch-hole was hollowed out so as to form a receiver and was perforated with a small hole; also the seat of the hammer was grooved, 'so as to let the air pass through but not the powder.' The receiver thereby filled with powder, and the gun was less liable to hang fire.

At the trial, it appeared, from experiments made in Court, that powder passed through the perforated lip as well as air. Plaintiff nonsuited.

THOMPSON, C.B. said:—'The powder passes through the same hole as the air. It seems to me, therefore, that the utility of this invention and the purpose of this patent wholly fail.'

MATHERS *against* GREEN, A.D. 1865. 34 Beav. 170; L.R. 1 Ch. 29.

Rights of Co-patentees.

Bill for the purpose of enforcing plaintiff's rights in two patents, viz., of 20th Dec. 1861, No. 3,201, and of 31st Dec. 1861, No. 3,263, each granted to *T. Green, W. Green, and R. Mathers*, for 'improvements in lawn mowing machines.'

Plaintiff contended that the intention, at the time of taking out the patents, was that the three grantees should have a joint interest therein. This was denied by defendants, and there was conflicting evidence as to the facts. ROMILLY, M.R. was of opinion that plaintiff was entitled to all such rights as flowed from his being one of three joint owners of each of the patents, and ordered defendants to account for one-third of any profits arising therefrom. On appeal to the Lord Chancellor the bill was dismissed with costs.

Per LORD CRANWORTH, L.C.—Where a grant of a patent has been made to two or more as joint inventors, it is dangerous for any Court to allow one of the grantees to set up a title against the others, founded on mere parol evidence, or inference from doubtful contract. The grantee who, in such a case, claims an exclusive right ought to obtain written evidence on the subject.

The right conferred is a right to exclude all the world, other than the grantees, from using the invention. But there is no exclusion in the letters patent of any one of the patentees. There is no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there then any implied contract where two or more persons jointly obtain letters patent that no one of them shall use the invention without the consent of the others, or if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine.

REX versus METCALF, A.D. 1817. 2 Stark. R. 249.

Variance between Title and Specification.

Sci. fa. to repeal a patent of 30th Sept. 1816, No. 4,065, to *J. Metcalf*, for ‘a tapered hair or head brush.’

The specification stated:—‘I cut hair in lengths about one inch and a quarter long, which I mix with my hands by shaking it together as unevenly as possible.’ It went on to describe the mode of attaching to the stock, by means of wires, the hairs so cut and mixed.

At the trial, it appeared that the patented brushes had bristles of unequal lengths mixed indiscriminately together. *Scarlett*, for defendant, suggested that by compressing the bristles in each tuft of hairs the effect would be to make them converge to a point, and that the brushes were known by the description ‘tapering’ in the trade; but LORD ELLENBOROUGH, C.J. said:—‘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, which did not remove the difficulty, LORD ELLENBOROUGH advised the jury to find that it was not a tapering but only an unequal brush. Verdict for the Crown.

Rule for a new trial refused by the Court of King’s Bench.

REGINA versus MILL, A.D. 1850–1. 10 C.B. 379; 14 Beav. 312.

Admissibility of Disclaimer in Evidence. Title of Patent after Disclaimer.

Sci. fa. to repeal a patent of 29th June, 1846, No. 11,266, to *W. Mill*, for ‘improvements in instruments used for writing and marking, and in the construction of inkstands.’

The patent was for a variety of improvements. *Claims* 1, 2, 3, 4, referred to pencils and penholders; *claim* 5, to pens; *claim* 6, to ‘a particular mode of notching pens;’ *claims* 7 and 8, to instruments for marking devices, &c.; *claims* 9, 10, and 11, to inkstands. After issue joined defendant filed a disclaimer, under stat. 5 & 6 Will. IV. cap. 83, sect. 1, of the 5th, 6th, 7th, and 8th claims of invention.

At the trial, it appeared that the 6th claim of invention was not new; but the disclaimer, excising that claim, was tendered in evidence. WILDE, C.J. doubted whether it was admissible, and directed a verdict for the Crown. Leave reserved.

Rule nisi to enter a verdict for defendant, on the ground that the disclaimer was admissible in evidence, and sufficient, when admitted,

to sustain the patent, made absolute by the Court of Common Pleas. (Jervis, C.J., Maule, Williams, Talfourd, JJ.)

Per JERVIS, C.J.—I think that upon the true construction of stat. 5 & 6 Will. IV. cap. 83, sect. 1, the disclaimer is to be read as part of the patent and specification, as from the time when the patent is granted.* Reading the disclaimer with the specification, we find that the defendant has obtained letters patent for three kinds of invention, upon which he founds eleven different heads of claim. Some of these turn out not to be new. These the defendant disclaims; and, reading the disclaimer with the specification, it will appear that no claim is made in respect of those parts. But it is said, that, if this be so, the patent is void, for the patent is granted for three things, and there is a specification which only covers two of them.† But, assuming that the patent stands for the first five claims and the last three, it seems to me that the specification complies with the title. The title is ‘for improvements in instruments used in writing and marking, and in the construction of inkstands,’ and the specification, as amended by disclaimer, describes improvements in instruments used in writing and marking,—viz., pens and pencils, and improvements in the construction of inkstands.

Per MAULE, J.—The spirit of the Act (5 & 6 Will. IV. cap. 83) seems to be this,—that where there are objections that go only to a small and insignificant part of a patent, which, if sustained, would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer. Then, inasmuch as a party against whom an action may have been brought for an infringement, may, by means of such disclaimer, be deprived of a good defence, that difficulty is met by the proviso. But, in the case of a *scire facias*, the proviso not applying, the general spirit of the enactment prevails, which is, that where a disclaimer has been allowed by the competent authority, and has been duly enrolled, it is to have the same validity as if it had formed part of the original specification. In *scire facias*, the patentee is passive. The prosecutor complains of the badness of the patent; all he wants is that it may be cancelled or amended; and that may be a sufficient reason for excepting the case of a *scire facias* out of the proviso.

(14 Beav. 312.) Application for liberty to sue on a bond for securing costs to defendant in the previous case. It appeared that the prosecutor continued the proceedings after disclaimer by the patentee, and that he ultimately failed. Order made to give leave to

* See now stat. 15 & 16 Vict. cap. 83, sect. 39, restricting actions for infringements committed before disclaimer.

† The special instruments for marking devices being omitted.

bring an action on the bond to recover costs subsequent to the disclaimer.

Per LORD LANGDALE, M.R.—I think that after the disclaimer the prosecutor was bound to know that the patent was good, and ought then to have discontinued the action. From that period he ought therefore to pay the costs in the action.

MINTER *against* WELLS, A.D. 1834. 1 Cr. M. & R. 505; }
1 Webs. Pat. Ca. 127. }

Subject-matter of a Patent.

CASE for the infringement of a patent of 9th Nov. 1830, No. 6,034, to *J. Minter*, for ‘an improvement in the construction of chairs.’

The patent related to a reclining chair, the seat and back being constructed of two levers in combination, so arranged that a pressure on the back was counterbalanced by the weight on the seat, whereby a person could rest with the back at different inclinations. *Claim*: ‘The application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair as above described.’

At the trial, it appeared that a self-adjusting leverage had not been before applied to the construction of chairs. ALDERSON, B. directed the jury:—The plaintiff, in order to establish his right, must show that the invention is new and that it is useful, and that the specification is such that an ordinary workman could make a machine which would answer the purpose which the patent was intended to accomplish. Verdict for plaintiff.

Rule nisi to enter a nonsuit, on the ground that the patent was bad as claiming a principle in mechanics, refused by the Court of Exchequer. (Lord Lyndhurst, C.B., Parke, Alderson, Gurney, BB.)

Per LORD LYNDHURST, C.B.—Every invention of this kind must include the application of some principle; and here the application of the principle of the lever to the construction of a reclining chair constitutes the machine, the invention of which the plaintiff claims. He does not, as it is asserted, claim the principle in the summing-up of his specification, but he claims the invention of applying that principle in a certain manner and by certain machinery.

MINTER *against* WILLIAMS, A.D. 1835. 4 A. & E. 251.

Exposure for Sale.

CASE for the infringement of the same patent. The declaration set out the letters patent whereby the Crown granted to plaintiff the

sole privilege to 'make, use, exercise, and vend' the said invention, and forbade all persons to 'make, use, or put in practice' the same without his license, and alleged that defendant did without license 'expose to sale divers chairs' in breach, &c. General demurrer and joinder. Judgment for defendant by the Court of King's Bench. (Patteson, Williams, Coleridge, JJ.)

Per PATTESON, J.—It cannot be doubted, notwithstanding the authorities referred to, that there is a great distinction between vending and exposing to sale.

Per COLERIDGE, J.—The count alleges that the defendant, without the plaintiff's license, 'exposed to sale' divers chairs intended to imitate and resemble, and which did imitate and resemble, his invention. Do these words necessarily import the *vending* spoken of in the granting part of the patent? I certainly think not. A mere exposure to sale—that is, with intent to sell, or for the purpose of selling—is not only not equivalent to a sale, but, as regards the patentee, may be attended with wholly different consequences.

MINTER *against* MOWER, A.D. 1837. 6 A. & E. 735; }
1 Webs. Pat. Ca. 138. }

The Claim must not go beyond the Invention.

CASE for the infringement of the same patent. Plea 2. That the plaintiff was not the true and first inventor. Issue.

At the trial, it appeared that one *Browne* had, before the patent, invented a chair on the same principle, although encumbered with additional parts. The finding of the jury was:—That *Browne* was the inventor of the machine, and found out the principle, but not the practical purpose to which it was now applied, and that the plaintiff made that discovery. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit made absolute by the Court of King's Bench. (Lord Denman, C.J., Patteson, Williams, JJ.)

Per LORD DENMAN, C.J.—The specification thus concludes:—'What I claim as my invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair as above described.' Now it was perfectly clear, upon the evidence, that this description applies to *Browne's* chair, though that was encumbered with some additional machinery. The specification therefore claimed more than the plaintiff had invented, and would have actually precluded Mr. *Browne* from continuing to make the same chair that he had made before the patentee's discovery. We are therefore of opinion that the patent cannot be sustained.

MOREWOOD and ANOTHER *against* TUPPER and ANOTHER, A.D. 1855. }
 3 C. L.R. 717. }

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent of 4th *May*, 1843, No. 9,720, to *E. Morewood* and *G. Rogers*, for ‘an improved process for coating metals.’ Plea: Not guilty. And several other pleas. Issue.

The patent related to the manufacture of so-called galvanised iron plates, being in fact iron plates coated with zinc. The specification described the operation by reference to drawings, and showed a pot for holding fused metal with a pair of rollers completely immersed below the surface thereof. The plate of iron was introduced between the rollers and was immediately bent upwards by a third roller placed close to the mouth of the first pair, the result being that it came out above the surface of the molten metal, and was easily removed. The specification stated:—‘In place of using two rollers, one roller, or simply a bar, may be used for causing the plates as they are introduced below the metal to be ensured descending to the same extent.’ *Claim 2*: ‘The mode of coating iron or other metal by causing sheets or other suitable surfaces thereof to pass between rollers in contact with metal kept molten in a suitable pot, and also the causing sheets of metal to be passed under a bar placed below the surface of molten metal as above described.’

At the trial, it appeared that the alleged infringement consisted in the use of a bath of molten zinc, having a bar placed across it dipping two or three inches into the molten metal. Sal-ammoniac was placed on one side of the bar, and sand, &c., on the other side, and the plate to be coated was dipped into the bath on the sal-ammoniac side, passed below the bar, and removed on the other side. POLLOCK, C.B. directed the jury:—‘That if the bar was placed simply for the separation of the fluxes, there was no infringement. Verdict for defendants on the issue on not guilty. Leave reserved.’

Rule nisi for a new trial, on the grounds of misdirection and of the verdict being against evidence, made absolute by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Martin, BB.)

Per POLLOCK, C.B.—‘There was some evidence of cases of long plates so passed by the defendants as to make it doubtful whether complete immersion would always take place if the partition were away. We think such cases would be strong evidence from which a jury might, and perhaps ought, to find that to be an infringement of the plaintiffs’ patent; for there the partition effects both the separation of the fluxes, and also complete submersion, which latter was, in truth, one of the main objects of the plaintiffs’ patent. This, per-

haps, was not left with sufficient distinctness to the jury; and we think there ought to be a new trial to ascertain whether there has been an infringement in that class of cases. Then the question arises, whether it can be established affirmatively that the bar alone, placed below the surface of the molten metal, may properly be the subject of a patent? We cannot all of us at present come to the conclusion that this is clearly the subject of a patent, or that it is not. In such a case we ought to grant a new trial.

MORGAN *against* FULLER, A.D. 1866. L.R. 2 Eq. 296, 297.

Practice in Patent Suits. Amendment of Issues. Particulars of Objections.

Suit to restrain from infringing a patent for improvements in carriages. The replication was filed, and an order made for the trial of certain issues, when defendant sought to amend by adding further issues of fact not suggested by the answer. Application refused with costs.

Summons adjourned from chambers for further and better particulars of objections, the objections alleging:—1. Prior user of the invention ‘by carriage builders *generally* throughout Great Britain.’ 2. Prior user ‘by carriage builders *generally*.’ 3. Prior user ‘by various carriage builders, *in or near London, in or near Liverpool, Manchester, Southampton, and in or near* various other of the principal towns of *Great Britain*,’ and ‘amongst other carriage builders by Messrs. *Thorn, of Great Portland Street, London*.’ 4. Prior user of the mode described in the specification in ‘various mechanical combinations applied to various matters and purposes.’ 5. That ‘parts’ of the combination claimed had not been invented by the plaintiff. 6. That ‘parts’ of the said combination, if so invented, were not particularly described. Order made. Costs to be costs in the cause.

Per Wood, V.C.—Applying the principle of *Fisher v. Dewick* (4 Bing. N.C. 706) to this case, the first objection must go out altogether. The second must go also, as being, if possible, worse than the first. With regard to the third, there is no doubt a reasonable and intelligible objection stated, but it is too general, and I should be disposed to tie the defendant down to specify the sort of carriage in which the alleged prior user took place if he could not give the name of the manufacturer. This would bring the case in conformity with *Jones v. Berger* (5 M. & G. 208). The fourth objection is also too vague. Objections 5 and 6 must also be struck out as not being specific enough to raise distinct issues.

The real object is to secure to both parties a fair trial, and with that view I must allow this motion.

MORGAN and ANOTHER *against* SEAWARD and OTHERS, A.D. 1835-7. }
 2 M. & W. 544; 1 Webs. Pat. Ca. 167. }
Inspection. Novelty of Invention. Sufficiency of Specification. Failure of Utility
in part of Invention.

Suit to restrain from infringing a patent of 2nd *July*, 1829, No. 5,805, to *E. Galloway*, for 'improvements in steam-engines and in machinery for propelling vessels,' &c.

The patent related:—(1) To a method of obtaining rotatory motion in a steam-engine. (2) To a method of feathering the floats of paddle-wheels.

Ex parte injunction dissolved, order for action at law, and an account. Plaintiffs and their witnesses to be at liberty to inspect at all seasonable times, and with notice, the paddle-wheels or machinery relating to paddle-wheels.

Action at law in pursuance of this order. Pleas: 2. That the specification was insufficient. 3. That the invention was not an improvement in steam-engines. 5. That it was not new, and that the patentee was not the true and first inventor. 6. That it was of no use to the public. Issue.

At the trial, it appeared that before the date of the patent one *Curtis* made for plaintiff, *Morgan*, two pair of paddle-wheels on the construction afterwards patented by *Galloway*. The workmen employed were under an injunction of secrecy, and no strangers were admitted to see the wheels. After a short time the wheels were taken to pieces, and sent abroad for the use of the *Venice* and *Trieste* Steam Company, of which *Morgan* was managing director. The wheels were sold to the company, but the vendor's name did not transpire. *Morgan* and *Curtis* then employed an attorney, who solicited the patent, which was granted to *Galloway* and assigned to *Morgan*.

ALDERSON, B. directed the jury:—The plaintiffs complain of the defendants for infringing their patent. Upon that subject the question would be simply, whether the defendants' machine was only colourably different, that is, whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. You are to look to the substance and not to the mere form, and if it is in substance an infringement, you ought to find that it is so. If in principle it is not the same, but really different, then the defendants cannot be said to have infringed the patent.

The specification ought to be framed so as not to call upon 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. You may call upon him