

to exercise all the existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention. . . . Further, if a patentee is acquainted with any particular mode by which his invention may most conveniently be carried into effect, he ought to state it in his specification. . . . The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect.

The first question in this case will be whether you think the steam-engine was a useful invention; if it was of any use. I think if it was of different construction from any other steam-engine, and of any use to the public, then that is sufficient. Verdict for defendants on third, fifth, and sixth issues. Leave reserved.

Rule nisi to enter a verdict for plaintiffs on the fifth issue made absolute by the Court of Exchequer, and rule nisi to enter judgment for plaintiffs on the third and sixth issues, *non obstante veredicto*, discharged.

Per PARKE, B.—The first question in this case is whether the verdict for the defendants on the fifth plea ought to be set aside. The word ‘*manufacture*’ in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in *England*, either by the patentee himself or any other person. If it be construed to be the mode of ‘constructing the machine’ there has been no use or exercise of it in *England* in any sense which can be called public. The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed: and this makes the case, so far, the same as if they had been constructed by the inventor’s own hands, in his own private workshop, and no third person had seen them while in progress. The operation was disclosed, indeed, to *Morgan*, the plaintiff; but there is sufficient evidence that *Morgan* at that time was connected with the inventor, and designed to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is that *Morgan* paid for the machines with the privity of *Galloway*, on behalf of the *Venice and Trieste Steam Company*, of which he was the managing director; but there was no proof that he paid more than the price of the machines as for ordinary work of that description; and the jury

would also be well warranted in finding that he did so with the intention that the machine should be used abroad *only*, by this company, which, as it carried on its transactions in a foreign country, may be considered as a foreign company; and the question is, whether this solitary transaction, without any gain being proved to be derived thereby to the patentee or the plaintiff, be a use or exercise in *England* of the mode of construction, in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent. We think not.

Another question is, whether this patent, which suggests that certain inventions are *improvements*, is avoided if there be *one* which is not so. We feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person. It is on the same principle that a patent for two or more inventions when one is not new is void altogether, as was held in *Hill v. Thompson* (8 Taunt. 375) and *Brunton v. Hawkes* (4 B. & Ald. 541); for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant; and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis v. Marling* (10 B. & C. 22) this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed upon the attention of the Court, or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent; and besides the improvement by the introduction of the brush is not recited in the patent itself as one of the subjects of it, which may make a difference. We are therefore of opinion that the defendant is entitled to our judgment on the third issue. This view of the case makes it unnecessary to

consider the effect of the finding on the last issue as amended by the judge's notes, that *part* of this invention is not useful. It may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question whether the patent be void under the statute of monopolies. And we do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is, taken altogether, useful, though a part or parts may be useless, always supposing that such patent contains no false suggestion.

MORRIS *against* BRANSON, A.D. 1776. Bull. N.P. 76; }
1 Webs. Pat. Ca. 51. }

Patent for Addition to an existing Machine.

CASE for the infringement of a patent of 28th *March*, 1764, No. 807, to *J. Morris*, for a machine for a set of needles to be applied to a stocking frame for making oylet-holes.

At the trial, the question was whether an addition to an old stocking frame was the subject of a patent. LORD MANSFIELD said:—‘If the general question of law, viz., that there can be no patent for an addition, be with the defendant, that is open upon the record, he may move in arrest of judgment, but that objection would go to repeal almost every patent that ever was granted.’ There was a verdict for plaintiff with 500*l.* damages, which was acquiesced in.

MULLINS *against* HART and OTHERS, A.D. 1852. 3 Car. & K. 297.

Novelty of Invention.

CASE for the infringement of a patent for a method of manufacturing penholders.

At the trial, it appeared that, before the patent, defendants had manufactured penholders according to the method subsequently claimed by plaintiff, and that the penholders in question had been deposited in their warehouse for sale, but no sale was proved. JERVIS, C.J. held that there was sufficient evidence of publication to defeat plaintiff's claim of novelty in the invention. Verdict for defendants.

MUNTZ and OTHERS *against* VIVIAN and WALKER, A.D. 1840. }
2 Webs. Pat. Ca. 87. }

Practice in Patent Suits. Evidence of Infringement.

Suit to restrain from infringing a patent of 22nd *Oct.* 1832, No. 6,325, to *G. F. Muntz*, for ‘an improved manufacture of metal plates for sheathing the bottoms of ships.’

The specification stated:—‘I declare my invention to consist in making plates for sheathing of an alloy of zinc and copper in such

proportions and of such qualities as, while it enables the manufacturer to roll the metal into sheets less difficult to work, renders the sheathing less liable to oxidation than ordinary copper, though it oxidates sufficiently to keep the bottom of the vessel clean. I take that quality of copper known in the trade as “*best selected copper*” and that quality of zinc known in *England* as “*foreign zinc*,” and melt them together in the proportion of fifty per cent. of copper to fifty per cent. of zinc, and sixty-three per cent. of copper to thirty-seven per cent. of zinc, both which extremes and all intermediate proportions will roll at a red heat; but as too large a quantity of copper increases the difficulty of working the metal, and too large a quantity of zinc renders the metal too hard when cold, and not sufficiently liable to oxidation to effect in the best manner the intended purpose, I prefer the alloy to consist of sixty per cent. of copper to forty per cent. of zinc.’ The specification then described the operation of casting the ingots and rolling the sheets. *Claim*: ‘The manufacture of metal plates of an alloy of copper and zinc in such proportions as will enable the manufacturer to roll the said alloy while at a red heat into sheets fit for the sheathing of ships, and will be sufficiently ductile to dress close to the bottoms of such vessels, at the same time that it is more durable than copper sheathing and oxidates sufficiently to keep the said bottoms clean.’ On motion for an injunction it appeared that defendants manufactured sheets of an alloy of copper and zinc within the proportions specified, but they rolled them cold. SHADWELL, V.C. said that it was impossible not to see that the rolling hot was a material feature in the invention; and as the defendants did not roll hot he would not grant the injunction. No further proceedings were taken.

MUNTZ *against* FOSTER and OTHERS, A.D. 1843-4. }
 2 Webs. Pat. Ca. 92, 93, 96. }

Practice in Patent Suits. Evidence of Infringement. Novelty of Invention. Evidence of prior User. Sufficiency of Specification.

Suit to restrain from infringing the same patent. Defendants relied on the anticipation of the invention by the specification of a patent of 23rd *April*, 1800, No. 2,390, to *W. Collins*, which related to the manufacture of sheathing for ships by alloying zinc with other metals, and classified the sheathing as being red, yellow, or white. The specification described the yellow sheathing as containing more zinc than the red, and as having greater ductility, so that it would bear rolling at a low red heat. It stated:—‘100 parts of copper and 80 of zinc afford a good composition, but the proportions may be varied, and other metallic substances added, provided the

property of bearing mechanical pressure when heated is not destroyed.' It appeared that plaintiff had been in possession of his patent for eleven years, and there was no proof that *Collins's* invention had ever come into general use. Plaintiff relied on the extreme purity of the metals, as to which *Collins's* specification was silent, and defendants, on the other hand, alleged that *best selected* copper had been made extensively in the last century and in precisely the same manner as that referred to in plaintiff's specification. Defendants insisted that they worked under *Collins's* specification; but analysis showed that their sheathing was composed of copper and zinc of the greatest purity, and in the same proportions as those of plaintiff. KNIGHT BRUCE, V.C. granted an injunction and ordered an action at law. Appeal motion dismissed by the Lord Chancellor, with costs.

Per LORD LYNTHURST, L.C.—As to the infringement, it is said that the defendants work according to *Collins's* specification, and carefully abstain from working according to the specification of the plaintiff. The analysis proves that their compound consists, not of ordinary copper and zinc, but of those metals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the invasion is plain and direct. If they were purified in the course of the process, this, I think, would constitute a colourable invasion of the plaintiff's invention.

Action at law in pursuance of the order of the Court. The pleas are not stated in the report, but defendants denied the infringement, the novelty of the invention, the sufficiency of the specification, and that the invention was the subject-matter of a patent. Issue.

At the trial, defendants relied on the defences indicated, but the report gives no summary of the evidence. TINDAL, C.J. directed the jury:—If the defendants had actually made some small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent; but you must ask yourselves whether the making of a quantity which amounts to 10 tons, I think, and of which the cost would be something like the sum of between 700*l.* and 800*l.*, could have been made for any other purpose at the time than the purpose of sale. If such were the case, there is no doubt that would be an infringement of the patent.

His Lordship then discussed the nature of the invention and said:—I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal, as there would be in discovering an unknown quality which a natural earth or stone possessed. We know, by cases that have been determined, that where such unknown qualities have, from the result of experiments, been

applied to useful purposes of life, such application has been considered as the proper ground of a patent.

His Lordship next examined the evidence of prior user, and continued:—I do not think that the circumstance of showing that in the long time that has passed before us, in the different and I may say infinitely varying combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose—it does not appear to me that such destroys the patent.

His Lordship finally considered the sufficiency of the specification and said:—People are not to go on and make experiments at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the easy and certain procurement of the commodity for which the patent was granted. There is an objection that the invention cannot be made in one or two of the different proportions of zinc and copper which are specified. If such is the fact, if the specification is not only difficult to understand, but is actually false and incorrect in that particular, there would be an end at once of the patent.

The only further objection is, that *hot rolling* is made an essential part of the plaintiff's invention, and is not new. I cannot understand that if the invention consists of various parts, *i.e.*, of the compound of the plates, and he states as he goes along that it will roll hot—and the subject of it is to make an alloy for sheathing—the rolling of it hot, that being known before, will invalidate the patent. I cannot think it will do so. Verdict for plaintiff.

MURRAY *against* CLAYTON, A.D. 1872–3. L.R. 7 Ch. 570;]
I.R. 15 Eq. 115; 21 W.R. 498.]

Evidence of Infringement. Mechanical Equivalents. Practice in carrying out decree for Injunction. Breach of Injunction.

Suit to restrain from infringing a patent of 8th June, 1866, No. 1,581, to *C. H. Murray*, for 'improvements in machinery for making bricks.'

The specification stated:—'This invention of improvements in machinery for making bricks relates more particularly to the mechanical appliances for cutting the clay, as it passes out of the exit aperture, into bricks of the desired shape and dimensions.' To this end a strip of clay sufficient to form from eight to twelve bricks was first cut off from a slab delivered by the kneading machine by means of a vertical

wire attached to a reciprocating frame. The lump, so separated, was next pushed by a series of separate pistons against a row of fixed vertical wires and divided into bricks. The pistons carried the bricks beyond the dividing wires and deposited them on a tray so that they could be removed without any handling. The machine was described by reference to drawings. *Claim*: 'The arrangement and construction of parts herein set forth for cutting clay into bricks. I claim particularly cutting the clay into the form of bricks by forcing the clay forwards by means of a pushing board against a series of fixed wires, so arranged that the clay is forced past the wires on to a movable board provided with handles, so that twelve or any convenient number of bricks may be removed at the same time.'

Defendants relied upon an anticipation of the invention by a machine for making bricks patented on 6th *Jan.* 1863, No. 49, by *J. G. Dahlke*. This machine was constructed with a set of rollers covered by an endless belt for bringing the stream of clay, as expressed by a moulding machine, upon a frame. Between the belt and the frame a knife or wire passed so as to sever a rectangular slab, and the frame carrying this slab was then moved in a transverse direction, thereby passing the clay between wires which divided it into bricks by severing portions in lines perpendicular to the first cut. Defendants further relied on a machine made by themselves and exhibited at their works in 1861, being an improvement on a machine invented by one *Sachsenberg*.

The alleged infringement consisted in the use of a brick-making machine in which the lump of clay for making eight to twelve bricks was first cut off by a wire mounted on a guide having a centre of motion below the table, so that the wire swept out a part of a circle instead of moving vertically. The clay was then placed opposite a frame carrying a series of vertical wires which divided it into bricks, the wires being carried through the clay by the movement of the frame.

BACON, V.C. dismissed the bill with costs; but the Lords Justices, on appeal, reversed this decision and granted a perpetual injunction.

Per JAMES, L.J.—I am of opinion that the plain meaning of the specification is that the plaintiff claims the machine. The claim is not to any particular part. It is a claim for the entire machine, produced by the arrangement and construction of the parts set forth.

That, then, being the claim, let us see whether it has been in any manner anticipated. It is quite clear to my mind that the invention of *Dahlke* is a thing so substantially different in its principle and all its details from that of the plaintiff, that if it were made to-day for the first time it could not be considered as an infringement of the plaintiff's

patent. We now come to deal with the machine which the defendants say was used in their works. We have seen it worked here in Court, and no doubt in one sense it is an efficient machine; it does cut off the three bricks, but that is all that it does. There is nothing whatever to countervail the evidence that it is practically quite useless. I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines.

His Lordship then referred to *Crane v. Price* (4 M. & G. 580) and said:—No doubt this case has been questioned, and if I may be permitted to say so, with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, is simply because I could not see how the word ‘combination’ could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other judge has ever questioned the principles upon which that case was decided and which are thus laid down in the judgment of the Court delivered by Chief Justice Tindal:—‘We are of opinion, that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent.’ His Lordship then stated his reasons for differing from the learned Vice-Chancellor and said:—We have now to determine whether the defendants’ machine is an infringement of the plaintiff’s patent,—whether it is a reproduction of the plaintiff’s machine with colourable alterations, with the use of what have been called ‘*mechanical equivalents*.’ It appears to me that the defendants have simply made a transposition, that is, that instead of moving the clay against the wires, they have made the wires move against the clay. That is exactly the case of a colourable variation.

I am of opinion that there should be a decree for a perpetual injunction, with the usual consequential direction as to the account to be taken.

(L.R. 15 Eq. 115.) Defendants being ordered to file an affidavit stating the number of brick-cutting machines made by them since the date of the patent, ‘and the names and addresses of the persons to whom the same respectively have been sold, and the names of the agents concerned in the transactions,’ filed an affidavit containing

only a statement of the number of machines made since the patent, and took out a summons to vary the order by omitting the above clause marked with inverted commas.

Order varied by striking out so much of the clause as required the names of the agents to be given. No costs to either side.

Per BACON, V.C.—The decree is in the plainest possible terms. It directs an inquiry as to what compensation is to be paid by the defendants in respect of the damage sustained by the plaintiff by reason of the defendants' infringement of the plaintiff's letters patent. As a matter of course, in prosecuting that inquiry, the plaintiff is entitled to have from the defendants the fullest possible discovery. Among other things the plaintiff is entitled to that which the order gives him—the names and addresses of persons to whom machines were sold; and if the order had stopped there I should have thought that no objection could successfully have been made to it. Then follow these words—'and the names of the agents concerned in the transactions,' of which I can make no sense, and which do not seem in the slightest degree necessary for working out the right which the plaintiff has under the decree.

(21 W.R. 498.) Motion to commit defendant, *Clayton*, for breach of the injunction already granted. It appeared that defendant used a brick-making machine differing chiefly from that of plaintiff in that the bricks, when made, were transferred by the hand of a workman, and not automatically by the action of the machine itself. BACON, V.C. refused the motion, and the Lords Justices dismissed an appeal from this decision with costs.

Per JAMES, L.J.—Possibly the plaintiff is in a difficulty experienced by every patentee of a combination. We were of opinion that the plaintiff's combination of known parts had produced a new result, or an old result in a more economical and more perfect form, making better bricks and cheaper bricks than had ever been produced before. We thought the whole combination—the plate, the wires, and the movable board to which by mechanical pressure the whole mass of bricks and the clay divided into bricks was at once removed, so that the human hand had nothing whatever to do with it between the cutting and the board—that that whole combination was a meritorious invention; and possibly the result might show that he might have claimed a specification more particularly directed to some smaller combination than the combination of the three, but his combination was a combination of three parts. What the defendant is doing is a combination of two out of those three parts, with another part which consists in using the hand or human pressure for producing the same result; that is substituting human power for the mechanical

power which the plaintiff is using in an essential and material part of it, and I am of opinion that the Vice-Chancellor is right in saying that the defendant has not committed any breach of our injunction. The motion will be refused with costs.

NEEDHAM *against* OXLEY, A.D. 1863. 1 H. & M. 248; }
8 L.T. N.S. 604. }

Practice in Patent Suits. Particulars of Breaches. Certificates.

Suit to restrain from infringing a patent for machinery for expressing liquids or moisture from substances. The bill stated that, upon inspection of a machine supplied by defendant to the *Westminster Brewery*, plaintiff had ascertained that the only difference between defendant's machine and that of plaintiff consisted in the placing of wire gauze between certain cloths and slabs used in plaintiff's machine, and in boring holes in the said slabs.

A jury trial before the Court having been directed, plaintiff delivered particulars of breaches specifying:—A machine or filter press for yeast, constructed by defendant, and supplied by him to Messrs. *Thorne, Westminster Brewery*, and in use there. Also a machine or press for clay, constructed by defendant, and supplied by him to Messrs. *Granger & Co., Worcester*. And the like of other machines constructed by defendant for persons named in the particulars. Summons for better particulars, adjourned into Court, and refused with costs.

Per Wood, V.C.—The particulars, together with the bill, appear to me to give sufficient information. The object in having these particulars delivered is to give the defendant fair notice of what is the complaint against him, not to tie the plaintiff down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to; but I should be very sorry to introduce anything like special pleading into the practice of this Court, or to allow verbal criticism to interfere with a determination of the merits of the contest.

The jury having found a verdict for plaintiff on all the issues, application was made (1) that the machines found to be an infringement of the patent might be destroyed; (2) for an inquiry as to damages; (3) for a certificate for a special jury; (4) for a certificate as to the validity of the patent. *Wood, V.C.* said that he could not order the destruction of these machines; the patent being for a combination, the defendant might still use for other purposes the several parts of his machine. The machines should be marked in some way so as to enable the plaintiff at any time to follow them.

His Lordship refused an inquiry as to damages, as they were not asked for when they might have been conveniently assessed by the jury, and the plaintiff would be sufficiently compensated by receiving the profits made by the defendant on an account to be taken; and he further said that the costs of the suit would include the costs of the special jury. The certificate of validity would be given. Stat. 15 & 16 Vict. cap. 83 had only made provision for trials at common law; but he thought the same rule might be followed here.

NEILSON and OTHERS *against* HARFORD and OTHERS, A.D. 1841. }
 1 Webs. Pat. Ca. 295; 8 M. & W. 806; 2 Coop. Ch. Ca. 61. }

Novelty of Inventions. Sufficiency of Specification. Title of Patent.

In a suit (*Neilson v. Thompson*, 1 Webs. Pat. Ca. 275) to restrain from infringing a patent of 11th *Sept.* 1828, No. 5,701, to *J. B. Neilson*, for ‘an invention for the improved application of air to produce heat in fires, forges, and furnaces.’ LORD COTTENHAM, L.C. had dissolved an injunction granted by the Vice-Chancellor and had ordered an action at law with an account. Action accordingly. Pleas: 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent related to the application of the so-called *hot blast* to the smelting of iron. The specification stated:—‘A blast or current of air must be produced by blowing apparatus in the ordinary way. The blast so produced is to be passed from the blowing apparatus into an air vessel, and from that vessel by means of a pipe into the furnace. The air vessel must be kept artificially heated to a considerable temperature. It is better to be kept to a red heat, or nearly so, but so high a temperature is not absolutely necessary to produce a beneficial effect. The size of the air vessel must depend upon the blast, and on the heat necessary to be produced. *The form or shape of the vessel or receptacle is immaterial to the effect*, and may be adapted to the local circumstances or situation.’ There was no separate claim.

At the trial, defendants put in evidence the specification of a patent of 2nd *Jan.* 1828, No. 5,596, to *T. Botfield*, for a method of supplying air to a blast furnace, which showed an iron smelting furnace placed close beside a lofty chimney stack, and connected by horizontal air passages with a supplemental furnace. The chimney was adapted for the purpose of drawing air from the supplemental and through the smelting furnace. The air so drawn in would of necessity be heated, and it was stated that an ordinary blowing apparatus might also be employed to assist the draught. The alleged

infringement consisted in passing air through a series of arched pipes, and raising its temperature to 600° or 700° Fahr.

PARKE, B. directed the jury:—Half a century ago, or even less, within fifteen or twenty years, there seems to have been very much a practice with both judges and juries to destroy the patent right, even of beneficial patents, by exercising great astuteness in taking objections, either as to the title of the patent, but more particularly as to the specification, and many valuable patent rights have been destroyed in consequence of the objections so taken. Within the last ten years or more, the Courts have not been so strict in taking objections to the specification, and they have endeavoured to hold a fair hand between the patentee and the public; being willing to give to the patentee, on his part, the reward of a valuable patent, but taking care to secure to the public, on the other hand, the benefit of that proviso which is introduced into the patent for their advantage. If the patent be a good patent, and if the specification be free from the objections that are raised to it, and is to be understood in the sense claimed by the plaintiffs, . . . though unquestionably what the defendants have done is a great improvement upon what would be the species of machinery or apparatus constructed under this patent, it appears to me that it would be an infringement of it.

We come now to the specification. My impression of the meaning of this specification is, that the patentee claims the discovery of heating air in any vessel of any size, provided it is a closed vessel, and exposed to heat between the blowing apparatus and the furnace. He states the size and form of the vessel to be immaterial. My strong opinion is, that that clause is an incorrect statement, and an untrue one, and therefore my opinion certainly is, as at present advised, that that being clearly untrue vitiates this specification, and prevents the patent from being a good patent. Nevertheless I shall ask your opinion, whether, notwithstanding the introduction of that clause into the specification, such persons as would be likely to work under the patent would, by their own judgment and good sense, correct that error in the patent. You are not to ask yourselves the question whether persons of great skill—a first-rate engineer, or a second-class engineer, as described by Mr. *Furey*—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would upon a mere hint in the specification probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed—it is supposed to be addressed to a practical workman who brings the ordinary degree of knowledge and the ordinary degree of capacity to the subject.

Another point is, whether the invention can be used beneficially, taking it in its simplest form. If in order to use it beneficially at all experiments were necessary, then the specification would be void. If the simplest form would be productive of benefit, it appears to me that the specification is good. If experiments are only necessary in order to produce the greatest beneficial effect, in that case, I think, the patent is not void.

The jury found:—That the shape and form of the vessel were material to the heating of the air, but that a person would not be misled by the misstatement in the specification. Verdict for defendant on fourth issue, and for plaintiff on remaining issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff on fourth issue made absolute by the Court of Exchequer. (Lord Abinger, C.B., Parke, Alderson, Rolfe, BB.)

During the argument ALDERSON, B. observed:—‘If you claim every shape, you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it. Then the rest is a question for the jury.’

It was contended that the objection to the specification taken by the learned judge at the trial—viz., ‘that it was calculated to deceive’—was not sufficiently raised by the notice of objections.

Per PARKE, B.—In the first place it was contended that the objection to the specification, on which I proceeded at the trial, was not sufficiently raised by the notice. But we all think it was. At *Nisi Prius* the only question for the judge is, whether the language of the notice fairly includes the objection taken.

Then we come to the question itself, which depends on the proper construction to be put on the specification. The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained; or conditionally, where those words or circumstances are necessarily referred to them. Taking then the construction of this specification on ourselves, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well known, the plaintiff had first invented a

mode of applying it by a mechanical apparatus to furnaces; and his invention then consists in this—the interposing a receptacle for heated air between the blowing apparatus and the furnace.

In this specification, after stating that air heated up to a red heat may be used, but that it is not necessary to go so far to produce a beneficial effect, he proceeds to state that the size of the receptacle will depend on the blast necessary for the furnace, and gives directions as to that. Then he adds, ‘the shape of the receptacle is immaterial to the effect, and may be adapted to local circumstances.’ It is this part of the specification which has raised the difficulty. At the trial, I construed this passage as meaning that the shape was immaterial to the degree of effect in heating the blast; and if this were so, the jury having, by their finding, negatived the truth and accuracy of this statement, the specification would be bad as containing a false statement in a material circumstance of a nature that, if literally acted upon by a competent workman, would mislead him and cause the experiment to fail. But my Lord and my brothers, after considerable hesitation, are of opinion that a construction may be reasonably put upon this clause which will support the patent; and though I myself still entertain great doubt whether such is the true construction, I am not prepared to say that it is not. His Lordship referred to the use of the word ‘*effect*’ in the specification as equivalent to ‘*beneficial effect*,’ and continued:—It is not unreasonable, we think, to construe the word ‘*effect*,’ in the sentence on which this question turns, in a similar way, and to hold it to mean an assertion by the patentee, that though the size of the vessel must be regulated as directed, yet the shape of the air vessel is immaterial to the effect; that is to say, any shape will produce a beneficial effect, and may be adapted to the local circumstances. Now, if this be so, it still casts upon him the necessity of proving, to the satisfaction of the jury, that any shape in which the air vessel could be reasonably expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery. We are bound, as to this point, by the finding of the jury, who have arrived at this conclusion of fact.

There is another point as to the title of the patent. The title is for the ‘*improved application of air*.’ Though that is ambiguous, it is sufficiently explained by the specification, and is not at variance with it, as was the case in *Rex v. Wheeler* (2 B. & Ald. 345).

On motion to revive the injunction in the several cases on this patent, LORD LYNTHURST, L.C. allowed the same, as being almost of course after judgment in an action at law, and said:—‘The whole question turns on the meaning of the word “*effect*” in the specifi-

cation, as to the sense in which that word was used by the patentee ; and I think that the construction put upon it by the Court of Exchequer is a reasonable and proper construction, and that it would be difficult, consistently with the rules of law, by which an instrument must be construed taking it altogether, to have put another construction on the instrument.'

NEWALL *against* WILKINS, A.D. 1851. 17 L.T. 20.

Practice as to Certificate for Costs.

CASE for the infringement of a patent, in which the validity of the patent came in question. Verdict for plaintiff. Counsel thereupon tendered the record of a former trial in which the patent was affirmed in order to obtain treble costs under stat. 5 & 6 Will. IV. cap. 83, sect. 3. It was objected that the record should have been given in evidence before verdict ; but LORD CAMPBELL, C.J. said :—' I shall admit the evidence, and it appears to me that the proper course has been pursued. The defendant's case ought not to be prejudiced by the admission of the evidence at the trial.'

NEWALL *against* WILSON, A.D. 1852. 2 De G. M. & G. 282.

Practice in Patent Suits. Injunction after long Enjoyment of Patent.

Suit to restrain from infringing a patent of 7th Aug. 1840, No. 8,594, to *R. S. Newall*, for 'improvements in wire ropes and in machinery for making such ropes.'

It appeared that the patent had been in force for twelve years, and had been the subject of four different suits, all of which had terminated favourably for the patentee. Also that, in 1850, defendant had incorporated a part of plaintiff's invention in a certain patent, but had not put the same to practical use. The validity of plaintiff's patent was now impeached on some new facts.

Injunction refused by ROMILLY, M.R. On appeal, the Lords Justices granted an injunction and ordered an action at law.

Per KNIGHT BRUCE, L.J.—The first question upon this motion is, whether the letters patent, on which the plaintiff grounds his case, have been shown to be bad in law. In my opinion they have not. Has there been enjoyment under it? Beyond all question there has during several years. While the patent has existed, the plaintiff's exclusive right has been actively asserted, and has in several instances been submitted to. There has been, I think, considering the various proceedings which have taken place, a sufficiency of enjoyment to bring the case within the principle enunciated by Lord Eldon in the well-known cases of *Hurmar v. Playne* (14 Ves. 130), and *Hill v. Thompson* (3 Meriv. 622).

Per LORD CRANWORTH, L.J.—It is clear that the plaintiff claimed exclusive enjoyment, and proceeded against parties who interfered with that enjoyment, and that those proceedings were always practically successful, and in one instance, at least, successful by being carried to the utmost extent. This seems to me to make out the case of exclusive enjoyment.

Looking at the defendant's specification, I cannot say that it is, of necessity at least, at variance with the plaintiff's patent; but I should be very slow to hold that a party was bound to proceed by *scire facias*, or that it is to be held that he has not had exclusive possession of his own patent because he does not proceed by *scire facias* to repeal other letters patent, if the other patentees do not act upon the latter.

NEWALL *against* ELLIOT and GLASS, A.D. 1858. 4 C.B. N.S. 269.

Evidence of Infringement. Variance between Complete and Provisional Specifications. Prior Experimental User.

Suit to restrain from infringing a patent of 14th *May*, 1855, No. 1,091, to *R. S. Newall*, for 'improvements in apparatus for laying down submarine telegraph wires.' The matters in dispute were referred to an arbitrator, who made an award, and further stated a case for the opinion of the Court.

The patent related to the stowage and paying out of submarine telegraph cables. The specification stated:—'This invention consists of apparatus combining and acting in the following manner. The cable is passed round a cone, or if it is a long cable round several cones, so that the cable in being drawn is prevented from kinking by means of the cone; and there is a cylinder on the outside which prevents the coil from shifting in its place. The cable passes over a pulley above the cone, and on to a break-wheel, round which it takes several turns to obtain sufficient holding, and from the break-wheel it passes over the stern of the vessel.' The drawings showed the cone, which was truncated and did not deviate much from the cylindrical form, together with the pulley overhead and the break-wheels. The specification went on to state:—'When the cable is to be laid I place over the cone an *apex* or top which is conoidal, as shown (the drawing showed a short conoidal head placed on the flat top of the truncated cone), and around this I suspend *several rings* of iron by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed. The two rings nearest the coil are lowered to about six and twelve inches respectively from the coil (the drawing showed four rings arranged

in gradations of size, the smallest being at the top, and acting as a mouth-piece for the exit of the cable, which was thus carried close over the conoidal top of the cone).’ *Claims*: 1. ‘Coiling the wire or cable round a cone. 2. The supports placed cylindrically outside the coil round the cone. 3. The use of rings in combination with a cone as described.’ The provisional specification said nothing about the rings or the use thereof, but gave a general description of the invention, which was copied *verbatim* in the complete specification, and is quoted above. (This invention consists, &c.)

It appeared, on the case, that before the patent the practice had been to coil submarine cables in oval or elliptical coils adapted to the form of the hold; that such coils were occasionally supported by stays where they did not abut against the sides of the vessel, and that, except in two instances, they had not been supported from inside. In one case guano bags had been placed inside the coil, and in the other a cylindrical core was introduced, but such external and internal supports were removed before laying the cable.

On 18th *Dec.* 1854, plaintiff contracted with the Government to lay a submarine cable between *Varna* and *Balaklava*. A vessel named the *Argus* sailed with a coil stowed as described in plaintiff’s specification, and the apparatus employed for laying the cable was the same as that specified, the whole operation being completed on 26th *April*, 1855.

It further appeared, that the alleged infringement consisted in the coiling by defendants in *May*, 1856, of a submarine cable about a cylindrical core placed in the hold of a vessel called the *Propontis*. The core had a rounded or hemispherical cover at the top, and the coil was supported by vertical supports arranged in a circle or outside cylinder. The cylinder with the hemispherical top assisted the paying out and diminished the tendency of the cable to kink, though not so perfectly as plaintiff’s apparatus. Defendants did not use any ring or rings as described in the specification.

The arbitrator found that plaintiff was the first to use an outside cylinder (that is, vertical supports arranged in a circle and fixed to the vessel,) in combination with a cone or internal cylinder about which the cable was coiled, the cable as it payed out passing up against the cylinder. He also made an award, declaring that the patent was not illegal or void, and directing compensation for the use of plaintiff’s apparatus on board the *Propontis*.

The questions raised by the special case for the opinion of the Court of Common Pleas were:—(1) Whether there was evidence of infringement; (2) Whether there was a fatal variance between the provisional and complete specifications, in that the former omitted.

all mention of the rings claimed by the latter document; (3) Whether there had been any publication of the invention before the patent; (4) Whether the patent was avoided by a user for profit before the grant. On all these points the Court gave judgment for plaintiff.

Per BYLES, J.—The substitution by the defendants of a cylinder having a *domed* or hemispherical top for the cone in the plaintiff's apparatus—both the plaintiff's and the defendants' apparatus being used for the same purpose and in nearly the same manner—is, in our judgment, not only evidence, but strong evidence, to support the arbitrator's finding.

The second objection was, that the provisional specification contained no mention of the rings claimed in the full specification. But the office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out; otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed the statute itself (15 & 16 Vict. cap. 83) indicates this distinction between the provisional and the final specification; for it calls the latter the *complete* specification, implying that the former is, or legally may be, in some respects executory and incomplete. Moreover, it enacts (sect. 6) that the provisional specification is to describe the *nature* of the invention, and no more; but when the statute comes to speak of the *complete* specification, its language is altogether different: it enacts (sect. 9) that the complete specification shall describe, not only the nature of the invention, but also the manner in which it shall be performed, and not only describe, but particularly ascertain it. We therefore think that the provisional specification in the case under consideration sufficiently describes the nature of the invention, though it does not enter into a detail of all the means by which it is to be accomplished.

The third objection was that the plaintiff's invention had been disclosed and published before the date of the letters patent. But a necessary and unavoidable disclosure to others, and as here appears, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable use of an invention previously ascertained to be useful, would be a publication. *In re Adamson* (25 L.J. Ch. 456). The answer to the third objection therefore depends on the fourth and last and main objection, which was this:—That the use of the apparatus for profit before the date of the letters patent, was a use which avoided the patent. The true question—looking at the decision of the arbitrator—seems to be this: Is an experiment performed in the presence of

others, which not only turns out to be successful, but actually beneficial in the particular instance, necessarily a gift of the invention to the world? We think it is not. In the case under consideration, experiments on dry ground are found to be indecisive. The decisive experiment still remains to be made on a large scale and in deep water. An opportunity presents itself in the course of a Government contract. The experimenter is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable. If indeed the plaintiff in the present case had on other and subsequent voyages used his apparatus, and unnecessarily delayed his application for a patent, he would have given his invention to the public.

NEWALL *against* ELLIOT and GLASS, A.D. 1863-4. 1 H. & C. 797; }
 10 Jur. N.S. 954. }

Evidence of Infringement. Variance between Complete and Provisional Specifications.

CASE against same defendants, for another infringement of the same patent. Pleas: 1. Not guilty. 2. *Non concessit*. 3. That plaintiff was not the true and first inventor. 4. That the specification was insufficient. 5. That the invention specified was not that for which the patent was granted. 6. That the invention was not new. 7. That it was not the subject-matter of a patent. Plaintiff joined issue on all the pleas, and further replied to 3rd, 4th, 5th, 6th, and 7th pleas, by way of estoppel, setting out the agreement for reference to an arbitrator as mentioned in the last case, and the award and judgment in favour of plaintiff on like issues then respectively raised. Issue: also demurrer to special replication, and joinder in demurrer. Judgment for defendants by the Court of Exchequer.

(10 Jur. N.S. 954.) At the trial, it appeared that the alleged infringements occurred on board three vessels, viz., the *Queen Victoria*, the *Rangoon*, and the *Malacca*, which were prepared for laying a submarine cable between *Rangoon* and *Singapore*. While these ships were being fitted for sea, Wood, V.C. granted an injunction to prevent their sailing. This injunction was dissolved by the Lords Justices, but an order for inspection was affirmed. From the evidence of plaintiff's witnesses who made the inspection it appeared that in the *Queen Victoria* a strong framework of upright pieces of timber formed a cylindrical core on which the cable was coiled, and the coil itself was surrounded by a firmly-supported casing of wood,

and held down at the top by other timbers. The *Queen Victoria* got ashore, and her cable was transferred to the *Rangoon*, in which vessel a *ring*, similar to those used by plaintiff in paying out, was found on the inspection. The *Rangoon* and *Malacca* laid down their cables between *Malta* and *Alexandria*, the internal supports of the cable being cut down during the paying out; and plaintiff contended that a *British* ship was a portion of *British* territory, and that there was infringement by what was done at *Malta* and *Alexandria* on board these vessels.

It further appeared that in 1854 a cable had been shipped on board the *Persia*, and was coiled in two coils round rectangular framings or cores, being supported on the outside in part by the sides of the vessel, and in part by strong upright supports. The jury found in answer to a question put to them by POLLOCK, C.B., that on board the *Persia* there had been used as an external support a series of uprights strongly fastened to the bottom of the deck, and placed cylindrically outside the coil, but that the apparatus was not used for paying out. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on first issue made absolute by the Court of Exchequer. Rule for a new trial suspended, and rule discharged on the other objections, viz., that the invention was not new, that it was not the subject of a patent, and that there was a variance between the complete and provisional specifications.

Per POLLOCK, C.B.—I think there is nothing in the objection that the specification discloses a different invention from the provisional specification. The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee, when he applied for the patent, to give some notion of what his invention was. An application was made to me when I was Attorney-General ‘for an improvement in locomotion.’ I refused it, as too wide, and I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention.

The patentee of a combination is bound to state what parts of the combination he claims to be new, or what parts of the combination he has taken from that stock of knowledge which is common to all mankind. On the present occasion the introductory words are:—‘This invention consists of apparatus combined and acting in the following manner.’ Then he describes how it acts. Then he says, ‘I claim as my invention, *first*, coiling the wire or cable round a cone.’ In that he was perfectly right. ‘*Second*, the supports placed cylindrically outside the coil round the cone.’ The jury found that what he professed to do by the second part of his invention had been done

before on board the *Persia*. I think if he claimed the supports placed cylindrically outside the coil round the cone, no other person could use a 'core.' I use the term to avoid the use of either 'cone' or 'cylinder.' No other person could use a cylindrical support all round any core, if that was originally his invention; and he does not claim it as round the cone—he claims it round whatever is used for the purpose of supporting the coil of wire. His Lordship added that in his opinion the verdict ought to be entered for the defendants upon the question of novelty as well as that of infringement.

Per BRAMWELL, B.—First of all, as to what took place in *Malta*, I am clearly of opinion, without going into any elaborate consideration of how far the vessel of a country is the territory of a country, the doctrine cannot be carried so far as to make anything done on board an infringement of letters patent, which are in their terms limited to the *United Kingdom*, the *Channel Islands*, and the *Isle of Man*. We have to consider whether the defendants have made what the plaintiff has patented. To my mind it is clear they have not; because it must be conceded that, independently of intention, they have not done it; and surely intention cannot make what they have done an infringement in making the plaintiff's apparatus, which, without that intention, would not be an infringement.

One point was pressed by Mr. *Cleasby*, which I confess I have great difficulty in understanding, that this is not the subject of a patent because the thing is not prepared and vendible—because, for the convenience of buyer and seller, instead of being ready made and afterwards fitted up in the ship, it is fitted into the ship by the owner of the ship, or the user of the ship, when he uses it. I confess I am unable to understand that. It seems to me to be an argument equally good to say that you could not have a patent for a smoke-jack, because the size of the smoke-jack depends upon the size of the chimney, and because it is more convenient that it should be put up by a country smith.

NEWTON *against* THE GRAND JUNCTION RAILWAY COMPANY, A.D. 1850. }
5 Ex. R. 331. }

Novelty of Invention. Evidence of Infringement.

CASE for the infringement of a patent of 15th *May*, 1843, No. 9,724, to *W. E. Newton*, for 'improvements in the construction of boxes for the axles of carriages, and for the bearings or journals of machinery (a communication).' Pleas: 1. Not guilty. 2. That the invention was not new. 3. That the specification was insufficient. Issue.

The patent related to a method of lining the bearings of revolv-

ing axles in machinery. The specification stated that the inner part of the boxes for the support of gudgeons or axles were to be lined with a compound metal composed of fifty parts tin, five antimony, and one copper. To prepare the boxes for this composition they were to be cast with projecting rims or fillets along their edges and ends, the object being to keep the soft metal lining in its place, and the interior of the boxes was to be cleaned or tinned in the usual manner. In boxes thus prepared, the heating and abrasion, which were so apt to occur in boxes ordinarily constructed, did not take place, and their durability was consequently increased. (The explanation being that the soft metal was incompetent to take up the motion of heat by friction.) *Claim* (in substance): The constructing the boxes within which the journals or axles of machinery run with rims or fillets along their edges and at their ends as herein set forth; and lining such boxes with a metallic composition of which tin is the basis for the purpose herein described.

At the trial, it appeared the alleged infringement consisted in rubbing a stick of tin on the interior of a brass bearing while heated, so as to deposit a lining of the soft metal on the surface of the brass. The layer so formed was left thick at the middle and fined off at the edges, but no ridge or fillet was employed to confine the tin within the bearing. CRESSWELL, J. directed the jury:—That they must take the whole of that for which the patent was granted, including the fillets within the outer case, as well as the lining with tin and the soft metal, and say whether the invention was new. Also, that if a patent was granted for a new combination of several things known before, that did not prevent any one from using those parts which were old. That it was for the jury to say whether the part here used by the defendants was substantially the same thing as the plaintiff's invention. Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Pollock, C.B., Alderson, Rolfe, BB.)

Per POLLOCK, C.B.—It appears to me that in substance what the patentee claims is the lining of these boxes with an alloy of tin, having certain provisions, partly mechanical and partly chemical, for keeping the lining in its place. That the mode adopted by the plaintiff is partly chemical it is impossible to doubt, because he first tins the inside before the alloy is introduced; and the evidence was that by means of that tinning the alloy is made to unite with the hard metal, which it would not otherwise do. Therefore I think the jury were correctly told they were to consider whether the invention as a whole was new, not whether it was new as to every part.

It was argued that the same criterion is to be applied to the

question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty you take the entire invention; and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But in considering the question of infringement all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies, and if he has used that part for the purpose for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement.

Per ALDERSON, B.—In considering whether the invention is new, the proper mode is to take the specification altogether and see whether the matter claimed *as a whole* is new. Now the whole which may be new as claimed, may consist in some degree of old parts and in some degree of new parts. The question of novelty, however, will depend on whether the whole taken together is new, though it may in part consist of old parts, provided the patentee does not claim the old parts, but only the combination of them and the new.

Then as to the infringement, there, undoubtedly, the question is altogether altered. A person cannot infringe that part of the patent which is old, because the public cannot be prevented from using that which they had before used in that state. If the invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent that is an infringement of it.

Per ROLFE, B.—The defendants' counsel discussed and scanned the language of the specification in the same sort of spirit as if it were a plea or replication specially demurred to. That is not the spirit in which a specification should be inspected. The proper mode is to construe it and see what is the good sense of it, and whether that which the patentee claims as his invention is there distinctly and clearly explained.

NEWTON *against* VAUCHER, A.D. 1851. 6 Ex. R. 859.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That the plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the invention was not a manufacture within the statute. Issue.

At the trial, the specification of a patent of 8th *Sept.* 1838, No. 7,800, to defendant, *J. U. Vaucher*, was put in which related to a method of packing the pistons of hydraulic engines by soft

metallic packing. The metal packing was composed of forty parts of tin, sixty of zinc, and four of antimony, and was cast in grooves running round the pistons. It was contended, on the part of defendant, that plaintiff's invention was comprised in the above description, and that his patent was therefore void for want of novelty. PLATT, B. was of the contrary opinion, and left the case to the jury.

Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Parke, Alderson, Platt, Martin, BB.)

Per PARKE, B.—The only question is, whether the plaintiff's invention is contained in the defendant's, and is old, and that question must depend upon a comparison between the specifications of the plaintiff's patent of 1843, and of the defendant's of 1838. The specifications are to be read in connection with their titles. After the date of the defendant's patent it was discovered that soft metal could be used beneficially, not merely for the purpose of excluding air and water, but that it produced this remarkable effect, that where there was pressure upon it, friction was in a great degree diminished. I think the discovery by the person under whom the plaintiff claims is not merely the discovery of a new principle, but of a new principle embodied in a new machine. Then, that being so, if the plaintiff claims a patent for that new principle embodied in a new machine, and that only for the purpose of diminishing friction, and the application of it is only to cases where there is pressure as well as motion, that patent is perfectly good; but if he has also claimed in it the application of soft metal to all cases of stuffing, to exclude fluids of every description, his patent in that respect is for an old invention and is void. The question is now reduced to that single point. I entertained some doubt during the argument whether the plaintiff's patent is simply for the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether it is not also for the application of soft metal in cases of stuffing rods for the purpose of excluding air, water, or other fluid. If the determination of the question depended solely upon the specification, and the title of the patent were not read, I should have been inclined to think that the plaintiff claimed both; but if the specification and the title be read together (and the specification is always taken to be an exemplification of the thing for which the patent is obtained), it is clear that the plaintiff's claim is confined to bearings in cases where there is pressure with motion. Had it not been for the title of the patent, by which the plaintiff appears to me to confine his invention to bearings, there would be strong reason to contend that he applied it also to cases in which rods or bars were to slide. But

reading the specification in conjunction with the title, I think the plaintiff's patent does not extend so far, and consequently that it is not void upon that ground.

Per ALDERSON, B.—The plaintiff, by his specification, describes a mode of forming a lining of soft metal which bears the pressure, and which endures swift motion upon its surface without the evolution of heat by friction, and this he does by rims of hard metal with soft metal between the rims. It seems to me to be a very reasonable subject-matter for a patent, and that it is essentially different from the defendant's patent.

Per MARTIN, B.—It is obvious, from his (the defendant's) specification, that he never had the least idea that soft metal would be of the slightest utility in diminishing friction.

NICKELS *against* HASLAM, A.D. 1844. 7 M. & G. 378; }
8 Scott N.R. 97. }

Variance between Title of Patent and Specification.

CASE for the infringement of a patent of 10th *Feb.* 1842, No. 9,252, to *C. Nickels*, for 'improvements in the manufacture of plaited fabrics.' Plea: Setting out the specification and averring that no other had been enrolled, whereby the patent was void. General demurrer, and joinder.

The patent related to a method of manufacturing plaited fabrics in stripes alternating with ordinary woven fabric. The specification stated:—That the warp should be wound on two warp beams, whereof one was lightly and the other heavily weighted. *Claim*: 'The mode of weaving plaited fabrics by dividing the warp into separate parts, and causing them to be delivered at different speeds as the weaving with the weft proceeds.' This was the only improvement specified.

It was objected that the specification did not support the title; but the Court of Common Pleas (Tindal, C.J., Coltman, Cresswell, JJ.) gave judgment for plaintiff.

Per TINDAL, C.J.—Here the objection is only to the title, as describing the patent to have been granted for improvements in a certain manufacture, whereas the specification discloses only one improvement. This is certainly a most subtle objection; if the term improvement had been used, it would have been *nomen collectivum*, and would have covered any number of improvements. I cannot see why the variance, if it be one, should vitiate the patent, the objection being merely to the title of the patent without fraud upon the Crown or detriment to the public.

NOTON and OTHERS *against* BROOKS, A.D. 1861. 7 H. & N. 499.

Estoppel of Licensee.

Action for non-payment of royalties for the use of a patent. Pleas: 3. That the alleged invention was not a new manufacture, by reason whereof the patent was void. 4. That the patentees were not the true and first inventors, by reason, &c. Demurrer, and joinder. Judgment for plaintiffs by the Court of Exchequer. (Pollock, C.B., Bramwell, Channell, Wilde, BB.)

During the argument POLLOCK, C.B. said:—‘The defendant agrees to pay the plaintiffs a royalty, if they will allow him to use their patented invention, and he does use it; how then can he turn round and say that it is worthless? The plaintiffs claim the remuneration for the permission to do that which the defendant has done. So long as the term of the patent lasts, if the defendant chooses to work under it, he must pay the stipulated price.’

Also BRAMWELL, B. said:—‘The consideration for the promise to pay is the permission to use the invention.’

OLDHAM *against* LONGMEAD, A.D. 1789. Cited 3 T.R. 439, 441.

Estoppel.

Per LORD KENYON, C.J.—In the case of *Oldham v. Longmead*, the patentee had conveyed his interest in the patent to the plaintiff, and yet in violation of his contract he afterwards infringed the plaintiff’s right, and then attempted to deny his having any title to convey; but I was of opinion that he was estopped by his own deed from making that defence.

ORMSON *against* CLARKE, A.D. 1862–3. 13 C.B. N.S. 337; }
14 C.B. N.S. 475. }

Subject-matter of a Patent.

CASE for the infringement of a patent of 19th *Sept.* 1857, No. 2,441, to *H. Ormson*, for ‘an improvement in the manufacture of cast tubular boilers.’ Pleas: 1. Not guilty. 7. That the invention was not a manufacture within the statute. Issue.

The invention related to a mode of constructing tubular boilers after a pattern well known at the date of the patent—viz., a boiler by one *Weeks*, which consisted of a row of vertical tubes terminating at the top and bottom in two horizontal hollow rings; the rings being cast with sockets, and the tubes being put in afterwards. In the patented boiler, the lower ring, the upright tubes, and part of the upper ring were cast in one piece. The specification stated:—‘My invention consists in causing the upright tubes and the lower

hollow ring (which connected the tubes together at their lower ends) to be all cast at one time, and thus to form one casting.'

Claim: 'The casting a boiler, such as is described, in one piece.'

At the trial, ERLE, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

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

Per ERLE, C.J.—Tubular boilers, such as those in question, are perfectly well known, and have long been used for the heating of horticultural buildings. The product therefore is not new; the only novelty is the casting in one piece that which used formerly to be cast in several pieces. I am of opinion that that is not the subject for which a patent can be taken out. The new mode probably requires more skill in the workman than the old one; but there is no claim for any novelty in the process of casting.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Crompton, Blackburn, Mellor, JJ., Martin, Bramwell, Channell, BB.) judgment affirmed.

Per POLLOCK, C.B.—I think it is extremely likely that this is a very useful improvement, and if the patent had been taken out for an improved mode of casting tubular boilers in one piece, probably it might have been sustained. The only question reserved for us is, whether there could be a patent for a boiler cast in one piece as described. We are all clearly of opinion that that is not the subject of a patent.

OXLEY *against* HOLDEN, A.D. 1860. 8 C.B. N.S. 666.

User by offering patented articles for sale. Construction of Specification. Effect of Provisional Specification when abandoned.

Action to recover royalties payable under an agreement for the use of a patent of 10th April, 1858, No. 776, to J. Oxley, for 'improvements in the doors and sashes of carriages.' Pleas: 2. Never indebted. 3. That the patent was void, whereby defendant obtained no advantage under the agreement. Issue.

The patent related:—(1) to the application of elastic pads for preventing the windows of carriages from rattling; (2) to a mode of holding a window by metal fittings, consisting of a pin and a slotted plate. The specification described the invention by reference to drawings, and stated:—'I have shown my invention as applied to railway carriage doors and window fittings, although equally applicable to the doors and windows of any other carriages, or in any

position where windows and doors are subject to jar and vibration.'
Claims: 1. 'The construction of elastic pads as herein described. 2. The mode of applying vulcanised indiarubber or elastic material to sliding window frames. 3. The metal fittings and the mode of applying the same described herein.'

At the trial, it appeared that on 17th *March*, 1858, plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages (No. 549). On 10th *April*, 1858, he obtained provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The application of 17th *March* was thereupon abandoned, and that of 10th *April* was carried to completion. It further appeared that defendant had made about half a dozen of the studs and plates, and that his traveller had offered them for sale to divers persons, but had not sold any. BYLES, J. directed the jury that this was in point of law as much a user of the patent as if there had been an actual sale of the articles. The jury found:—That the elastic pads were new; that the stud and plate was old, but that its application in the way described was new; and that defendant manufactured the patented articles for sale and offered to sell them. Verdict for plaintiff, damages 50*l.* Leave reserved.

Rule nisi to enter a verdict for defendant on the grounds, (1) That the metal fittings were claimed apart from the mode of applying them, and were not new. (2) That the specification went beyond the title. (3) That the filing of the provisional specification of 17th *March*, 1858, amounted to a dedication of the invention to the public, and rendered the subsequent patent void. And for a new trial on the ground of misdirection by the judge in telling the jury that the exhibition of patented articles for the purpose of obtaining orders, though none were obtained and no articles sold, was a user of the patent. Rule discharged by the Court of Common Pleas.

Per ERLE, C.J.—The principal objection depends upon the construction to be put upon these words: 'I claim the metal fittings and the mode of applying the same described herein as the second part of my invention.' If the true construction is that the metal fittings are claimed separately from the mode of applying the same, the patent is void for want of novelty, the jury having found that the metal fittings by themselves are old, but that the mode of applying them is new. Then, are the metal fittings claimed separately? We think not. In respect of the first part of the invention, consisting of elastic pads, and the mode of applying them, the patentee has subdivided his invention into a claim for the pads, and a separate claim for the mode of applying them. If he had meant the

same with respect to his second invention he would naturally have used the same form. If 'the metal fittings' are taken to mean all metal fittings consisting of two plates adjusted with stud and slot, such a claim would be futile, as plates so adjusted are notoriously old. The patentee must have intended that the patent should be valid.

The second ground of objection was, that the specification claimed more than the patent. The invention specified and claimed is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages.

The third objection was, that the provisional specification relating to the elastic pads, delivered in on the 17th of *March*, rendered in operative the provisional specification delivered in on the 10th of *April*, and therefore rendered void the patent granted on the 10th of *October* and founded on the specification of the 10th of *April*, which was either void *ab initio* or became void on the 17th of *September*, when, it is contended, the invention specified on the 17th of *March*, and afterwards abandoned, became dedicated to the public. But we are of opinion that a provisional specification abandoned does not become public by abandonment. The statute (15 & 16 Vict. cap. 83, sect. 29) authorises the publication; but, until that event, it is not public.

Furthermore, although the first provisional specification may afford an objection either to receiving a second patent for the same invention or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment, making the patent void if it is so granted.

All the objections to the validity of the patent, in our opinion, fail. It therefore becomes unnecessary to consider whether the relation between the parties to the licence created any obstacle against the defendant as to disputing the validity of the patent.

PALMER *against* COOPER, A.D. 1853. 9 Ex. R. 231.

Evidence admissible under Particulars of Objections.

CASE for the infringement of a patent for 'improvements in the manufacture of candles by gymping their wicks.' Plea: Not guilty. Issue. The particulars of objections, delivered under stat. 15 & 16 Vict. cap. 83, sect. 41, alleged prior user of candles having gymped wicks, by Messrs. *Palmer*, of *London*, by *Joseph Morgan*, of *Manchester*, and other persons similarly described.

At the trial, evidence of prior user of candles with *coiled* wicks was tendered, and objected to on the ground that the user of this kind of candle had not been specified in the notice, and that the place of user was not mentioned therein. POLLOCK, C.B. admitted the evidence. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial on the ground of the improper reception of evidence made absolute by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.) On the argument of the rule it was contended that the particulars of breaches could be called in aid of the particulars of objections; but PARKE, B. said:—‘The plaintiff’s particulars allege a user *after the date of the patent*.’

Per PARKE, B.—The 41st section peremptorily requires that the particulars of objection should state where the invention was used, and in what manner it was used or published before the date of the patent.

Per ALDERSON, B.—There is no statement whatever of the place in these particulars, although in one of them the parties are named, and the manner in which the invention had been used.

PALMER *against* WAGSTAFFE and ANOTHER, A.D. 1853. 8 Ex. R. 840; }
9 Ex. R. 494. }

Sufficiency of Particulars of Objections. Evidence of Infringement.

CASE for the infringement of a patent (in part disclaimed) of 25th March, 1840, No. 8,445, to *W. Palmer*, for ‘improvements in the manufacture of candles.’ Plea: Not guilty. Issue.

The particulars of objections under stat. 15 & 16 Vict. cap. 83, sect. 41, alleged prior user of the invention by plaintiff and other persons mentioned at certain places specified, ‘and by candle makers generally in *London* and the vicinity thereof.’

Rule nisi for better particulars discharged by the Court of Exchequer. (Alderson, Platt, Martin, BB.)

Per ALDERSON, B.—A defendant may rely either on a specified user by certain persons named, or on a general user by all persons at a particular place. In the former case, if he proves a user by any one of the persons named, that will support his objection; but, if he rests his case on a general user, proof of a user by one person will not do. In fact, the plaintiff has no reason to complain of the generality of the statement, for the more general it is, the more the defendant must prove under it.

The specification related (after disclaimer) to a mode of manufacturing candles by the application of two or more wicks arranged so as to bend outwards in definite directions during the burning, and stated:—‘I have observed that in consuming *plaited* wicks of candles,

that surface of the wick where the strands proceed upwards from the outer edges towards the centre is the direction towards which the wick bends.' Then followed a description of a method of placing the wicks *in situ* in the empty mould, with the proper side outwards, by the aid of a wire. *Claim 2.* 'The mode of manufacturing candles by the application of two or more plaited wicks, as herein described.'

At the trial, plaintiff produced a candle, purchased at defendants' manufactory, in which the wicks bent outwards during the burning. POLLOCK, C.B. left it to the jury to say whether the candle made by defendants was an infringement of plaintiff's patent. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on the issue raised by the plea of not guilty made absolute by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, Martin, BB.)

Per POLLOCK, C.B.—I think that a patent or specification should be construed in the sense in which the patentee intended, and that, if any expressions are ambiguous, we should endeavour to give effect to the intention, and moreover that every patent should be expounded favourably to the patentee. Taking the patent to be for the mode of making the candle, if any other person can discover a method of producing the same effect by a totally different means, he has a right to do so. That being the case, the plaintiff was bound to give some evidence that the defendants had infringed the patent by making a candle in the same way.

Per PARKE, B.—I agree that in construing a patent a fair and liberal construction ought to be put upon it, and that we must look to what the real intention of the inventor was. With respect to this patent, the only conclusion which I can come to is that the plaintiff claims the particular mode of making the candle, not the candle itself. Then the only question is, whether the simple production of a candle with a plaited wick, which turns outwards, is of itself evidence of an infringement of the plaintiff's patent. I am of opinion that it is not, and that some evidence ought to have been given that the defendants' mode of making the candle was an infringement of the plaintiff's.

PARKES *against* STEVENS, A.D. 1869–70. L.R. 8 Eq. 358; }
L.R. 5 Ch. 36. }

Subject-matter of a Patent. Evidence of Infringement. Sufficiency of Specification.

Suit to restrain from infringing two patents, viz., of 26th June, 1862, No. 1,876, and of 10th Oct. 1865, No. 2,615, each to *J. Parkes*, for 'improvements in lamps.' Trial before the Court without a jury

on the following issues:—1. Whether the invention was new. 2. Whether it was useful. 3. Whether it was the subject of a patent. 4. Whether the specification was sufficient. 5. Whether the patent had been infringed.

The patent of 1865 related to a form of globular glazed lamp constituting an improvement on the patent of 1862. The specification, No. 2,615, stated:—‘The object of the improvements is to produce a glazed lamp the frame of which shall throw little or no shadow, and yet at the same time possess the requisite strength and facilities for cleaning.’ The lamp was then described by reference to drawings, which showed it as being spherical in form, with three metal rings for supporting the panes, one ring occupying the middle or equatorial line, and the other two being placed near the top and bottom. The panes were segments of a sphere, separated by longitudinal strips of metal. The door was formed of a light framework of metal containing one pane of glass, and was opened by being slid on the surface of the globe so as to overlap the adjoining pane.

Claim: ‘The arrangement and combination of parts hereinbefore described and represented in the drawings annexed in the manufacture of railway-station and other lamps.’

It appeared that the alleged infringement consisted in the use of a globular lamp with a sliding door. Also that cylindrical lamps with sliding doors were in public use before the date of the patent. Verdict for defendant on issue as to infringement, and for plaintiff on remaining issues.

Per JAMES, V.C.—My verdict on the first three issues is in favour of the plaintiff; but the defendant contends that the specification is not sufficient, and relies for this objection on the judgment of Lord Westbury in *Foxwell v. Bostock* (4 De G. J. & S. 298), to the effect that a patent for the improvement of a machine must with sufficient distinctness describe the particular part of the machine which is alleged to be improved, and the particular improvement for which the protection is claimed. I need not say that I should feel myself bound by that decision, if I did not, which I do, most entirely concur in the judgment. It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant if the improvement is only to be found like a piece of gold mixed up with a great quantity of alloy, and if a person desiring to find out what was new, and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and commonplace, all that was the subject of other patents and other improvements, bringing to the subject, not only the knowledge of an ordinary skilled artisan, but of a patent lawyer or agent.

After all, the question of sufficiency of specification is not a question of law; it is a question really of fact in each particular case. In this case, I am of opinion that the patentee has a right to have his specification of 1865 read with his specification of 1862; and, reading them together, I do not think any maker of lamps would have any substantial difficulty in ascertaining what was claimed under the general description of the 'arrangement and combination of parts hereinbefore described, &c.' But the patent being for the arrangement and combination of parts so as to form an entire lamp, and not being for, or claiming to be for, any particular part, the last question arises, is the introduction into a lamp (which is not alleged in any other respects to have adopted any part of the plaintiff's arrangement and combination) of a sliding door an infringement? The plaintiff's counsel have contended that it is, on the authority of the case of *Lister v. Leather* (8 E. & B. 1,004). The authority of this case has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination. The marginal note, if read hastily, is calculated to give some colour to that contention. But if the judgment be read, it will be found to give no warrant whatever for such, I must call it, baseless notion.

But the principle of that case has no application whatever to the present case. Even if there had been any sufficient novelty or merit in the substitution of a sliding door, I should have held that that was no part of an invention for producing 'a glazed lamp, the flame of which shall throw little or no shadow, and yet at the same time possess the requisite strength, and also facilities for lighting and cleaning.' The sliding door has nothing to do with the shadow, has nothing to do with the strength, and gives no facilities for lighting or cleaning. That ought to have been the subject of a distinct claim if it was intended to have been, and could have been, protected. But I am clearly of opinion that there can be no patent right in the substitution of a slide for a hinge. It was hardly contended before me that the introduction of that alone would have been sufficient to sustain a patent; but it was gravely contended that because it was, as alleged, a novel part of a novel combination and arrangement, it was protected. To say that a patent for an entire combination is a valid patent for a part, when that part would not of itself have been patentable, is in my judgment a *reductio ad absurdum* of the supposed principle in *Lister v. Leather*. My verdict on the issue as to infringement will be for the defendant.

(L.R. 5 Ch. 36.) Motion for a new trial by way of appeal. Defendant also moved for a new trial as to the validity of the patent. Both motions dismissed with costs.

Per LORD HATHERLEY, L.C.—As to the validity of the second patent, which has been disputed, there is a clear line marking off the old from the new. Then as to the other issue, whether the subject-matter of the patent is new, I think, from the exhibits, as well as from the evidence, that this was a new and ingenious method of making a lighter description of lamp, both lighter in appearance, and lighter in the sense of transmitting light, than any which had been previously contrived. Then as regards the door, the question arises whether there is an infringement. In order to arrive at a sound conclusion on that branch of the subject, we must consider whether this door is really new; and the best way of testing that, no doubt, is that which the Vice-Chancellor has adopted—by asking whether, upon the evidence, it could by itself have been the subject of a valid patent. It was argued before me that the sliding door was in itself a novelty as applied to a spherical lamp; but many instances were given of glass in the shape of a cylinder having been made to slide over glass, and it is impossible to say that a sliding door can be the subject of a patent because it is spherical and not cylindrical.

THE PATENT BOTTLE ENVELOPE COMPANY *against* SEYMER, A.D. 1858. }
28 L.J. C.P. 22. }

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent of 29th Aug. 1854, No. 1,892, to *J. Seithen*, for ‘improvements in the manufacture of cases or envelopes for covering bottles.’ Pleas: 1. Not guilty. 6. That the said invention was not an invention for improvements in the manufacture of envelopes for bottles. Issue.

The patent related to a method of forming cases of rush or straw for the protection of bottles. For this purpose equal lengths of straw or rush were tied together at one end, and passed over the mould of a bottle. The material was then tied tightly round the mould at the part intended to form the base of the envelope. A ring, actuated by a treadle, and large enough to slide over the material thus tied down, was raised from below so as to bend the straw back and allow of its being tied again at the extreme end above the neck. The specification described the operation, and contained a drawing of the apparatus. *Claim*: ‘The combination of mechanism, and the making of envelopes for bottles as herein described.’

At the trial, it appeared that the alleged infringement consisted

in the making of straw envelopes for bottles by tying together lengths of straw, placing the same on a mould resembling a bottle, and interweaving them by passing a string over and under alternate portions. WILLES, J. was of opinion that there was no evidence of infringement, and directed a nonsuit. Leave reserved.

Rule nisi to set aside the nonsuit discharged by the Court of Common Pleas.

Per WILLES, J.—We are of opinion that this rule ought to be discharged. The plaintiffs' specification clearly shows that the patent is not for bottle envelopes, but for a mode of making them. The defendant's method resembles the plaintiffs' in the product, which is not the subject of the patent, and in one material particular only, viz., the use of the model or mandril; and the question is, whether such use constitutes an infringement of the plaintiffs' patent. The infringement of any part of a patent process is actionable, if the part of itself is new and useful so that it might be the subject-matter of a patent, and is used by the infringer to effect the object, or part of the object, proposed by the patentee. The question therefore is, whether the plaintiffs could have taken out a patent simply for applying a model or mandril in the form of a bottle, or indeed a bottle itself, in making envelopes for bottles. We are of opinion that they could not. The use of a model or mandril for producing given forms of pliable materials was admitted at the trial. Such use was part of common knowledge, and a model or mandril similar to that of this patent was an ordinary and well-known tool. The application of a well-known tool to work previously untried materials, or to produce new forms, is not in our opinion the subject-matter of a patent.

PATENT MARINE INVENTIONS COMPANY *against* CHADBURN, A.D. 1873. }
L.R. 16 Eq. 447. }

Practice in Patent Suits as to Trial of Issues.

Suit to restrain from infringing a patent. The parties had agreed upon certain issues; but plaintiffs desired that the issues should be tried either before the Court itself with a jury, or before a Court of Law, and defendants opposed a motion to that effect.

LORD SELBORNE, L.C. ordered a trial before the Court without a jury, and said:—'My opinion is, like that of Lord Cairns (see *Bovill v. Hitchcock*, L.R. 3 Ch. 417), that in these patent cases, where all the ordinary issues are raised, and nothing special appears to show that the assistance of a jury is wanted on some mere question of fact properly so called, trial by jury is not ordinarily the most convenient mode of trial. It is to be observed that such cases

almost always involve questions of law and fact, not only mixed, but mixed in such a way as makes the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from a judge; thirdly, that much of the evidence, or that which is permitted to be given as evidence in such cases, is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the judge. It very rarely happens, if it ever does, where the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge.

PATENT TYPEFOUNDING COMPANY *against* RICHARD, A.D. 1859. Johns. 381.

Pleading. Demurrer. Sufficiency of Specification.

Suit to restrain from infringing a patent of 7th April, 1854, No. 817, to *J. R. Johnson*, for 'improvements in the manufacture of type.'

The specification stated:—'The object of my invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or wholly omit the use of lead. The best proportions I am acquainted with are 75 of tin and 25 of antimony; but this may be to some extent varied; and, when lead is also used, I find that it must not exceed 50 parts in 100 of the combined metals employed.' There was no separate claim. Demurrer, on the ground that the specification was bad for uncertainty, over-ruled. Costs to be costs in the cause.

Per WOOD, V.C.—What I have to determine is, whether this specification is so clearly and manifestly bad, that no explanations by workmen or other experts, to whom the specification must be considered as addressed, could induce the Court to hold that this is a new invention, set forth with sufficient clearness and precision. What the patentee considers the best proportions (and he is bound, according to the authorities, to state this) is 75 of tin to 25 of antimony; but this, he says, may be to some extent varied. A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say, 'I limit my claim to these precise proportions.' Even if the patentee had, in terms, absolutely tied himself down to 25 per cent. as a minimum in the

place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent. It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice; whether anything of the kind was ever done before; and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is, that the specification is not void on the face of it.

PATENT TYPEFOUNDING COMPANY *against* WALTER, A.D. 1860. Johns. 727.

Inspection and Delivery of Samples. Laches. Practice in Patent Suits.

Suit to restrain from infringing a patent for improvements in the manufacture of type. Application to inspect certain type, and take samples. It appeared that the Court of Exchequer had refused to grant such permission; also that plaintiffs had lain by for nearly a year in the prosecution of the suit. Order made for inspection and delivery of samples. Costs to be costs in the cause.

Per WOOD, V.C.—The jurisdiction of this Court to order inspection, and, if necessary, the taking samples for the purpose of a suit here, has scarcely been contested. If a precedent is wanted, the case of *Russell v. Cowley* (1 Webs. Pat. Ca. 457) is in point. There specimens were allowed to be taken away, though the necessity for doing so was scarcely so great as in the present case.

It was said that, if plaintiffs had come for an interlocutory injunction *simpliciter*, without asking for any discovery, it would have been refused on the ground of delay, whatever case they might have made out as to the infringement; and therefore, it is said, there can be no inspection for the purpose of supporting such an application; and there is much weight in this argument. But these cases of patents are peculiar. Relief is given in two shapes. It may be by interlocutory injunction in the first instance. But much more frequently, unless the case is of the strongest possible kind, it is by merely putting the matter in train for determination of the right at law; and then, at the hearing, a perpetual injunction is granted, upon the plaintiff succeeding in the action at law. Power has been conferred upon the Common Law Courts to grant an injunction pending an action at law. The words of stat. 15 & 16 Vict. cap. 83, sect. 42, are, 'in any action;' and this seems to have been construed by the judges as limited to the pendency of an action; but whether they have been right or not in their view of the limits of their jurisdiction, the jurisdiction of this Court is unaffected.

With respect to obtaining a perpetual injunction, the rule is

established in *Bacon v. Jones* (4 Myl. & Cr. 433), that in patent cases, unless the plaintiff takes steps to bring the matter before the Court by motion before the hearing, he will not in general be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the Court requires him to place the matter in course of investigation at the earliest possible period.

PENN *against* BIBBY, A.D. 1866. L.R. 1 Eq. 548 ; L.R. 2 Ch. 127.

Particulars of Objections. Novelty of Invention. Variance between Complete and Provisional Specifications. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 2nd Oct. 1854, No. 2,114, to *J. Penn*, for ‘an improvement in the hearings and bushes for the shafts of screw and submerged propellers.’

Defendant filed amended particulars of objections, alleging prior user of the invention ‘in the following, among other instances, viz., &c.’ The words ‘among other instances’ were objected to, but were allowed to remain.

Per WOOD, V.C.—I think these words ‘among other instances’ may be permitted to remain, in order to give the defendant the benefit of a general saving, and liberty to apply for leave to give particulars of other instances of prior user, if and when he may find them.

Defendant subsequently applied for leave to specify seven instances of prior user, which was granted on terms that he paid the costs of the application ; any additional costs consequent thereon being reserved.

The patent related to the construction of hard wood bearings for the shafts of screw propellers. The provisional specification merely stated :—‘This invention consists in employing wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers.’ The complete specification described the manner of performing the invention by reference to drawings, and stated (in substance) :—The inner surfaces of the bearings for a propeller shaft are grooved to receive strips or fillets of wood, which project beyond the inner surface of the metal bearings, and allow the water to circulate freely in the channels so formed. The wood is, by preference, *lignum vitæ*, the grain being either longitudinal with the fillets, or at right angles to the bearing surfaces thereof. In other words, the bearings are not continuous metal surfaces, as previously constructed, but a series of wooden fillets or ridges, having water spaces between them, which support the rubbing action of the shaft. It was further stated that the several pieces of wood

employed in a bearing might be inclined to the axis instead of parallel to it, as shown. *Also*, that it was not essential that the fillets of wood should be fitted in the interior of fixed metal bearings, as a like effect would be obtained if they were attached to the shaft and revolved therewith in metal bearings in the manner shown in figures 4 and 5 of the drawings. *Claim*: 'The employing of wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers, as herein described.'

Hearing of the suit. The following questions of fact were tried before the Court, without a jury (that is to say):—1. Was the invention new at the date of the patent? 2. Was the specification sufficient? 3. Was the invention the subject-matter of a patent? 4. Had the defendant infringed? Defendant gave evidence in accordance with an allegation in the particulars of objections, that wooden bearings had been applied in *May*, 1851, to the propeller shaft of the screw-steamer *Livorno* and used in a voyage. Plaintiff then proposed to call witnesses in reply. Wood, V.C. held that the evidence was admissible. After evidence of plaintiff in reply had been given, and counsel had summed up defendant's evidence, the Court was asked to allow defendant to adduce further evidence to contradict that of plaintiff in reply. Wood, V.C. refused to admit such evidence, and found in the affirmative on each of the above issues.

Appeal to the Lord Chancellor for a new trial on the grounds, (1) that the verdict was against the weight of evidence; (2) that there was a variance between the provisional and complete specifications; (3) that the invention was not the subject-matter of a patent. Motion refused with costs.

LORD CHELMSFORD, L.C. said that, in dealing with the finding of the Vice-Chancellor upon the first question, he regarded himself as placed precisely in the situation of the judges of the Courts of Common Law when a rule is obtained to set aside the verdict of a jury. They do not consider what would be the proper view of the case if originally presented to them, but merely whether there is sufficient evidence to warrant the verdict. Nor had he ever known an instance in which there was evidence on both sides, and the judge who tried the cause was satisfied with the verdict, where a new trial was granted.

His Lordship came to the conclusion that, on the evidence, the Vice-Chancellor was justified in finding in favour of the novelty of the invention, and continued:—'The defendant contends that the patent is void because there is a variance between the title and the specification, or between the provisional and the complete specifica-

tions. It is said, on the part of the plaintiff, that there is no issue to raise this question ; and that the correct mode of tendering such an issue at law would have been either by plea of *non concessit*, or by expressly pleading the variance between the title and the specification. I think, however, that with perhaps a little license of construction, the second issue may meet the case. The objection may be thus stated:—The provisional specification describes the nature of the invention, in the most general terms, to consist in employing wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers. The complete specification describes a particular mode of employing wood to prevent the parts of a propeller shaft, which are within the bearings, from coming in contact with the metal of the bearings, and to cause them to revolve against pieces of wood fixed in such a manner as to admit of water flowing freely between the pieces of wood, and between the inner surfaces of the metal bearings and the outer surfaces of the propelling shaft. The claim at the end of the specification is, “the employing of wood in the construction of the bearings and bushes for propeller shafts, as herein described.” If the words “herein described” are to be disregarded, the patent is void, as the claim will then be for the employment of wood in every possible way in the bearings and bushes of propellers ; and, if these words limit the claim to the precise description in the specification, this is not what is described in the provisional specification, and the plaintiff has therefore obtained a patent for one thing and specified another. This is the defendant’s argument.

‘There can be no doubt that the claim in the specification must be read with the limitation produced by the words “herein described,” and that the question thereupon arises, whether this occasions a departure from the provisional specification so as to render the patent void. It seems clear that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out. That is left to the complete specification. Nor is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. It is clear, therefore, that unless the complete specification in this case claims something different from the provisional specification, the objection to the patent under consideration cannot prevail. But there is not the slightest foundation for the objection in point of

fact, and each specification appears to me faithfully to fulfil its own office.

‘But it was said that one part of the complete specification went beyond the provisional, and extended to something which could not be included in it, viz., the application of wood to the shaft so as to revolve therewith, the provisional specification confining the employment of wood to the bearings and bushes. If wood applied in this manner to the shaft may be properly called a bearing, then there is no excess in this part of the specification. But if, strictly speaking, this application of wood would not come within the description of a bearing, then the answer to the objection is, that it is not claimed, the claim being limited to the employment of wood in the construction of bearings and bushes. There is, therefore, no departure from the provisional specification in the complete specification, and the finding of the Vice-Chancellor upon this issue was right.

‘The last question raised was upon the finding that the invention was the proper subject-matter of a patent. To this it was objected that the finding is erroneous, because the alleged invention was merely a new application of an old and well-known thing. In every case of this description one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test to the present case, it appears to me impossible to say that the patented invention is merely an application of an old thing to a new purpose. The only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings; but they are of a totally different character, and for a totally different object, from the bearings patented. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw propellers in the way described in the patent. It is, to my mind, not merely a different application, but something in itself essentially different. It had been found that, in the mode of constructing screw propellers by making metal work upon metal, they soon wore out, and occasioned a violent irregular motion on the vessel. Mr. *Penn* devised the plan of placing fillets of wood upon the inner surface of the bearings, so as to prevent the shaft coming in contact with the metal of the bearings, and so as to admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings, thereby keeping the wood constantly lubricated. The success of this invention has been proved in a remarkable

manner. It would be an extraordinary fact if an invention of this kind, so long wanted, and of such great utility, should have been lying in everybody's way who knew anything of the construction of a water-wheel or grindstone, and yet should never have been discovered.'

PENN *against* BIBBY; PENN *against* JACK; PENN *against* FERNIE, }
A.D. 1866. L.R. 3 Eq. 308. }

Practice as to Damages and Costs in Patent Suits.

The hearing of these causes now came on together. Plaintiff asked for an injunction, for an account against Mr. *Jack*, and for an inquiry as to damages against the other two defendants. Injunction granted in each case with costs. The account being waived, an order for an inquiry as to damages was made against all the defendants.

Per WOOD, V.C.—With regard to the damages, it has never, I think, been held in this Court that an account, directed against a manufacturer of a patented article, licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used there is continuing damage.

Application for full costs, as between solicitor and client, under stat. 15 & 16 Vict. cap. 83, sect. 43, refused. Application, on behalf of defendant, *Bibby*, to postpone the decree until after the decision of the House of Lords on the appeal, also refused. The Court declined to enforce an offer made by *Bibby* to pay plaintiff the same royalties as were paid by others, not infringers.

Per WOOD, V.C.—My reason for not giving the costs, as between solicitor and client, is this: I consider that stat. 15 & 16 Vict. cap. 83, sect. 43, means that when a second trial for infringement takes place, the certificate by the judge of the first action is produced in evidence on the second trial, and the extra costs are given to afford a complete indemnity. In *Davenport v. Rylands* (L.R. 1 Eq. 302) I gave the certificate for costs *after* the first trial, but I have not done so *upon* the first trial.

With respect to the postponement of the decree, I consider it a matter of right that the plaintiff should have a decree at once and not be delayed.

As to the royalties, I cannot compel the plaintiff to accept the same royalty from these defendants as he receives from others. I cannot in the decree do less than give the plaintiff his full right, and I cannot bargain for him what he may choose, or may not choose, to do. There will be liberty to apply generally.

PENN *against* JACK, A.D. 1867. L.R. 5 Eq. 81.

Assessment of Damages in a Patent Suit.

After decree for injunction as above mentioned, and order that an inquiry be made as to what damages plaintiff had sustained 'by reason of the user and vending of the said invention,' plaintiff claimed to be compensated for the loss of profit of which he had been deprived as a manufacturer in consequence of defendant having wrongfully fitted the invention to certain vessels. Claim disallowed, with costs of the hearing.

Per WOOD, V.C.—There are three portions into which the relief which has been obtained by the plaintiff in this suit may be divided. The first is in respect of the vexation and annoyance of a lawsuit, for which he is entitled to his costs. Secondly, he is enabled, for ever, to restrain the defendant from again infringing his patent; and hence he is in a condition, for the future, to make any bargain he pleases, to any amount. Then the third branch of relief is that which is granted in the shape of damages for the loss which the plaintiff has actually sustained by the conduct of the defendant, irrespective of the vexation and expense of a lawsuit. With reference to this I have to ask myself, what would have been the condition of the plaintiff if the defendant had acted properly, instead of acting improperly? That condition, if it can be ascertained, will, I apprehend, be the proper measure of the plaintiff's loss.

Now if the plaintiff's case had been one of a patentee who had never granted a licence, and had always remained his own manufacturer, the question would have been one of great difficulty; and I do not hesitate to say I should not have attempted to grapple with it, but I should have sent it to a jury to settle the amount of damages. But here is a case where the patentee is not in the habit of manufacturing the articles to which the patent applies, or, at all events, very seldom does so; but he has been in the habit of granting, not general shipbuilders' licences, but a particular licence of 2s. 6d. per horse-power for each ship which is about to be built with his invention. The defendant accordingly, if he had applied, as he ought to have applied, to the plaintiff, would have had to pay 2s. 6d. per horse-power for every ship which he built with the plaintiff's invention. That is the amount which the plaintiff got from everybody else; and it does not appear to me that he is entitled to anything more from the defendant. It has been contended that the plaintiff has lost more than this; he is said to have lost a profit besides. But he has himself estimated the profit at 2s. 6d. per horse-power. His damage must be confined to 2s. 6d. per horse-power for those ships for which he has not been paid.

PIDDING *against* FRANKS, A.D. 1849. 1 Mac. & G. 56.

Equitable Assignment. Estoppel.

Suit to restrain from infringing a patent for manufacturing coffee. It appeared that plaintiff had granted, by deed, to one S., a defendant in the suit, an exclusive licence to use the patent. S. thereupon made an equitable assignment of all his interest under the licence to the other defendants. KNIGHT BRUCE, V.C. having directed an action at law, plaintiff now sought to put the defendants, other than S., on terms not to dispute the validity of the patent. Application refused.

Per LORD COTTENHAM, L.C.—Are the defendants not to be at liberty to say, we have bought the patent, and paid for it, but we do not intend to use it? They are mere equitable assignees, and why should they be deprived of the right which every stranger has of disputing the validity of the patent?

PIGGOTT *against* THE ANGLO-AMERICAN TELEGRAPH COMPANY, }
A.D. 1868. 19 L.T. N.S. 46. }

Practice in Patent Suits. Inspection.

Suit to restrain from infringing a patent for 'improvements in the manufacture of submarine telegraph cables, and in the method of giving signals.' Plaintiff applied for an inspection of the mode of working a certain cable in possession of defendants. Application opposed on the ground that the inspection would disclose important secrets and might expose the company to loss and injury. GIFFARD, V.C. refused the application, and said:—'The Court ought to be satisfied of two things: that there was really a case to be tried at the hearing of the cause, and that the inspection asked for was of material importance to the plaintiff's case as made out by his evidence. The plaintiff could have no difficulty in proving the nature of the cable used by the defendants; in fact, a portion of it had been produced in the arguments, and the difference between it and that of the plaintiff was apparent.'

PLATT *against* ELSE, A.D. 1853. 8 Ex. R. 364.

Pleading non concessit.

CASE for the infringement of a patent.

Rule nisi for leave to plead *non concessit* (Martin, B. having refused leave at Chambers) made absolute by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Martin, BB.)

During the argument PARKE, B. said:—'The law is thus stated in *Hynde's* case. (4 Rep. 71 b.) So against the King's letters patent under the great seal showed in Court, none can deny them, but *non concessit per præd. literas patentis* is a good plea; for although there

be such letters patent, yet perhaps nothing pass by them; and so *per consequens non concessit.*'

POTTER *against* PARR, A.D. 1860. 2 B. & S. 216 n.

Novelty of Invention. A part previously published must be distinguished.

CASE for the infringement of two patents—viz., of 21st Dec. 1836, No. 7,263, and of 25th May, 1842, No. 9,366, each to *J. Potter*, for 'improvements in spinning machinery.' Pleas: 1. Not guilty. And (as to patent of 1842): 11. That the invention was not new. 12. That the specification was insufficient. Issue.

The patents related to one part of the operation of mule spinning, viz., the winding the yarn into a 'cop' upon the spindle. This operation is begun by winding a conical layer of thread at a continually increasing vertical angle, so as to form the 'cop bottom' upon the bare spindle, and is completed by winding a succession of similar conical layers upon the foundation thus formed. The speed of revolution of the spindles for taking up the yarn should therefore vary according to the diameter of that portion of the cop at which the winding is taking place. The specification of the patent of 1836 described a method of obtaining the required variable motion of the spindles during the *winding on* by means of a chain attached to a spiral conical drum, and caused to traverse towards the smaller end of the drum during the formation of the cop bottom. The shifting of the chain on the drum was effected by a screw of varying pitch, called a *hyperbolic* screw. The winding of the uniform conical layers which completed the cop was effected by the spiral drum after the screw had ceased to act upon the chain. *Claim*: 'The spiral drum and hyperbolic screw, with which, in connection with the chain-wheel and chain, I effect the winding-on motion as described. I do not confine myself exclusively to the hyperbolic screw, as the curve may be varied by using a different form of spiral drum, &c.'

The specification of the patent of 1842 referred to the patent of 1836, and described the invention as consisting in various improvements on the mule therein specified. The spiral drum and hyperbolic screw were abandoned, and in their place a plate with curved slots on its face was rotated at the back of another plate with radial slots, whereby a set of studs working at the same time in both sets of grooves was caused to assume a spiral form, and gave a flattened fusee for the chain connected with the chain-wheel to run upon. This fusee was caused to enlarge or contract in dimensions by rotating the plate with curved scrolls relatively to the other plate by means of a worm or screw, and could be adapted to the varying requirements of speed during the respective stages of the formation

of the cop. The relative motion of the scroll and radially grooved plates was effected by a combination of two segmental wheels called 'sectors,' with a snail called a 'spiral.' *Claim 5*: 'The improved winding-on motion, as set forth, which, although in part used in an imperfect form before the date of this patent, did not produce a correct winding-on till I constructed the improved curves as represented, and which, together with the sectors and spiral, regulate the position and form of such curves, by which, in conjunction with the parabolic incline, seen at fig. 8 (this incline was concerned in the movement of the faller wire), I produce a perfect result.'

At the trial, it appeared that the form of winding-on motion referred to in the fifth claim (which embodied the radiating apparatus but was defective in the curves) had been brought out in a machine constructed in 1839. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant on the first and eleventh issues made absolute by the Court of Queen's Bench. (Cockburn, C.J., Crompton, Blackburn, JJ.)

Per COCKBURN, C.J.—I think the true construction of the fifth claim is, that the radiating apparatus as shown is a substitution for the conical drum in the patent of 1836; and that in 1842 the plaintiff intended to patent that as a substantial part of his claim, and not only in combination with the improved curves. He said that he had made that radiating apparatus in 1839, and that it did not work satisfactorily; and that he had improved it by substituting for one portion of it an improved system of curves; and he contended that he might then take out a patent for the radiating apparatus, which he had made perfect by the improved curves. In that he was wrong, for he had already made known to the world the principal part of the machine; and he could not take out a fresh patent for a combination including that and the improvements without expressly stating that the patent was for a new combination only. Therefore the patent of 1842 falls to the ground for want of novelty.

As to the patent of 1836, the specification claims a spiral movement by means of the apparatus therein described,—the spiral drum and chain, and hyperbolic screw,—which last, it says, may be varied. For that apparatus the plaintiff, in the patent of 1842, substitutes an entirely new apparatus in express terms. I think the two are perfectly distinct; and indeed it hardly lies in the mouth of the plaintiff to say the contrary, because, if they are not distinct, the patent of 1842 would be bad as patenting an old invention. The defendant's machine is an infringement of the patent of 1842, and not of the patent of 1836, and the patent of 1842 is bad for the reasons already given.

POW *against* TAUNTON, A.D. 1845. 9 Jur. 1,056.

Misdirection by Judge. Subject-matter of a Patent.

CASE for the infringement of a patent of 28th Feb. 1837, No. 7,312, to *J. Robinson*, for 'a nipping lever for causing the rotation of wheels, shafts,' &c. Pleas: 1. Not guilty. 2. That the invention was not new. Issue.

The patent related to a method of rotating a wheel by the reciprocation of a nipping lever which dragged the wheel round in one direction by a friction grip on its rim, but was inoperative when moving in the opposite direction. It was an equivalent for an ordinary ratchet-wheel and driving paul, and has been commonly fitted to the windlasses of ships. The specification stated:—'That the invention consisted in a nipping lever applied to the rim of a wheel in such a manner that, when the outer arm of the lever was acted upon, the inner arm or *tusk* pressed against the rim, and caused a nip which enabled the power applied to the outer arm of the lever to force the wheel round, together with any machinery to which it might be attached.' It then described the invention by reference to drawings, and showed the wheel having a rimmed flange upon which a block or *box* was capable of sliding. The nipping lever was pivoted on a pin passing through the box. *Claim*: 'The nipping lever, with its tusk and sliding box, hereinbefore described, applied to a rimmed wheel for the purpose of causing the same to rotate together with any shaft or machinery which may be attached thereto.'

At the trial, it appeared that a nipping lever was not new, and ROLFE, B. directed the jury:—That the invention was new if the application of a nipping lever to the surface of a wheel, by means of the sliding boxes, as a method of making the wheel revolve, was new.

Verdict for plaintiff.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Queen's Bench.

Per LORD DENMAN, C.J.—The application of a nipping lever to the surface of a wheel for the purpose of making it revolve may be new, but the mere novelty of the application is not enough; it must also appear that the means essential for carrying the application into effect are also new. In the present case the means for applying the old invention to the new purpose are the sliding boxes; and if they are essential to the application, and novel as means for the purpose, the patent may be supported.

The learned judge left no question to the jury as to whether the sliding boxes were or were not an essential or necessary part of the

invention claimed. We think the jury may have been misled by the mode in which the question was left to them, and that they may have considered that it was unimportant whether the use of sliding boxes was necessary or essential to the plaintiff's invention, provided their use was new. Either they are essential and not claimed; or they are not essential, and in that case there is no novelty: we therefore think that the rule should be made absolute for a new trial.

POUPARD *against* FARDELL, A.D. 1869. 18 W.R. 59, 127.

Novelty of Invention. Sufficiency of Specification.

Suit to restrain from infringing a patent of 19th Jan. 1859, No. 166, to *W. Poupard*, for 'an improved wheel-skid or shoe.'

The patent related to the construction of a skid with a tail-piece of some length, which formed a gradual incline for the wheel to run upon when entering the skid. The specification described the contrivance by reference to drawings, and showed a skid with a tail projecting backwards in a curve adapted to the form of the carriage wheel. It went on to state:—'I find the best results to be obtained when the projecting tail-piece is curved upwards, but I do not limit myself to so shaping it.' *Claim*: 'The construction of a wheel-skid with a tail-piece projecting from the back part and top of the skid chamber, as hereinbefore described and illustrated.'

At the hearing by the Court, without a jury, it appeared that the service skid in use by the *Royal Artillery* had a short projection, with an eye for hanging the skid to the carriage, but that it was insufficient for guiding the wheel into the skid. MALINS, V.C. granted a perpetual injunction with costs, and also an inquiry as to damages, and said:—'What the plaintiff claims in this case is perfectly clear from the drawings and specification, and by their aid any good workman could produce the article intended to be patented. It is a skid with a tail projecting from the upper plate, but differing from the *Royal Artillery* skid. I hold that the specification is sufficient. The addition of the words, "but I do not limit myself to so shaping the tail-piece," does not vitiate the specification.'

PRICE'S PATENT CANDLE COMPANY *against* BAUWEN'S PATENT CANDLE }
COMPANY, A.D. 1858. 4 K. & J. 727. }

Practice in Patent Suits. Account. Expiry of Patent.

Suit to restrain from infringing four several patents for the manufacture of candles. Bill for injunction and account filed on 28th Nov. 1856. Notice of motion for an *interim* injunction given for 10th Dec. 1856, two days before the expiry of the first patent on 8th Dec. 1856. Order made for actions at law, which were tried, and

resulted in a verdict for plaintiffs upon the first patent, but in a verdict for defendants upon the remaining three patents.

At the hearing of the cause, defendants admitted the infringement of the first patent down to 8th *Dec.* 1856, but denied the possession of any candles or fatty matters, of which an account was sought. As regarded the first patent, account refused; but inquiry ordered as to the possession, by defendants, of any candles or fatty matters manufactured according to that patent; and as regarded the remaining patents, bill dismissed with costs.

Per Wood, V.C.—I must adhere to the observations I made in *Smith v. London and South-Western Railway Company* (Kay 408) as to the right to an account being dependent mainly upon the right to an injunction, so that, if for any reason an injunction cannot be obtained, there can be no right to an account.

On the 10th of *December*, a stock of these articles (of which the bill seeks an account) must have been still in the defendants' possession; and that being so, it follows that had I been then clear as to the question of right which has since been established at law—or, rather, had that question been then established at law as it has since been—the plaintiffs would have been entitled to an injunction. But it does not by any means follow that they are *now* entitled to the same relief, at a time when it may well be that an injunction would be utterly useless, in consequence of there being nothing left upon which it could operate. If, at the hearing, there is nothing upon which an injunction can operate, the arm of the Court is stayed; and I am bound by the authorities to say that, there being nothing at the hearing to which the jurisdiction of equity can attach, the case is reduced to damages, and the bill must be out of Court.

RALSTON *against* SMITH, A.D., 1860-5. 9 C.B. N.S. 117; }
11 C.B. N.S. 471; 11 H. L. Ca. 223. }

Function and validity of Disclaimer. Evidence of Infringement. Subject-matter of a Patent. Sufficiency of Specification.

CASE for the infringement of a patent (in part disclaimed) of 23rd *Nov.* 1858, No. 2,654, to *W. Ralston*, for 'improvements in embossing and finishing woven fabrics, *and in the machinery or apparatus employed therein.*' By disclaimer, the words in italics were erased from the title of the patent. Pleas: 1. Not guilty. 4. That the specification was insufficient. 5. That the disclaimer extended the patent right. 6. That the patent was not for the working or making of any manner of manufacture. Issue.

The invention related to a method of obtaining a *watered* or *moiré antique* finish on woven fabrics. A series of small circular

grooves, about equal in number to the warp threads in a fabric, were engraved round a metal cylinder, which was made to run against a smooth paper roller or *bowl*, but at a higher surface speed. The fabric was pulled a little on one side during its passage between the roller and bowl, whereby the threads became crushed upon the ridges of the grooves in irregular patches, and a watered or *moiré* pattern, as well as a glaze or polish, was produced. This was the invention, but the specification stated:—‘I employ a roller of metal, wood, or other suitable material, and groove, flute, mill, or otherwise indent *upon* it any required design, and cause it to revolve with a bowl or bowls of paper; and I give the circumference of the pattern roller a quicker motion than that of the bowl, so as to obtain a frictional action upon the surface of the fabric as well as pressure. If the fabric is moved transversely when fed up to the machine, an indefinite number of watering patterns may be given at one operation; and, with two operations, *moiré antique* or other varieties may be obtained, which may be varied according to the number of times that the fabric passes. A finish or lustre is also given to the fabric by means of the friction of the surfaces of the rollers.’ *Claim*: ‘The employment of grooved, fluted, engraved, milled, or otherwise indented rollers of metal, wood, &c., driven at greater speed than the bowls connected with them, so as to exert a rubbing friction upon the fabric submitted to their action, and thereby to produce an indefinite variety of pattern, as well as a bright finish or lustre.’

The disclaimer stated:—‘I disclaim the use of any pattern roller except those which are made of metal, or other suitable material, and have circular grooves, flutes, or indentations, made *around* their surface; and I also disclaim the use of any other description of design upon the surface of such rollers except such circular grooves, flutings, or indentations, as aforesaid. If the grooves are as numerous as the warp threads operated on, or nearly so, and the fabric has a slight transverse motion given to it when fed into the machine, an indefinite number of watering patterns may be produced.’ The amended *claim* was for ‘the employment of grooved, fluted, or indented rollers of *hard* metal or other suitable material driven at a greater speed &c. (as in the original claim).’

At the trial, plaintiff deposed that, up to the time of filing his specification, he had used no other than circular grooves for the purpose of his invention. It appeared that the plaintiff’s roller had from sixty-two to seventy-four rings per inch of length, the surface speeds of the roller and bowl being eighteen and ten respectively. The defendant’s roller had spiral or screwed grooves with sixty-eight turns of the spiral per inch, the surface speeds of the roller and bowl

being eleven and a half and ten respectively. It also appeared that a differential motion of the roller and bowl was not new, and that the use of a patterned roller for embossing was well known at the date of the patent. ERLE, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for the defendant on the 1st, 4th, 5th, and 6th issues, made absolute by the Court of Common Pleas.

Per ERLE, C.J.—The plaintiff has entered a disclaimer; and his amended specification confines his invention to one kind of substance for rollers, viz., a hard metal; and to one kind of pattern for engraving thereon, viz., circular grooves around the roller. It seems to us that this is practically a claim of a new invention, and not a part of any invention comprised in the former specification. The patentee, under colour of disclaiming, introduces a new invention. Such a disclaimer is in effect an attempt to turn a specification for an impracticable generality into a grant for a specific process which is comprised within the generality in one sense, but could not be discovered to be there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer.

The plaintiff has disclaimed all patterns except circular grooves round the roller. Spiral grooves are not within the strict meaning of circular grooves; and we think we should hold the plaintiff to that strict meaning, and, under that construction, we find that the defendant did not infringe.

We also observe that a patent for the exclusive right to one particular use of a known machine might be objected to. Although the patentee may have discovered how to use the machine more beneficially than the owner knew, he has no right to take a grant which virtually prohibits the owner from an existing right over his own property.

(11 C.B. N.S. 471.) Error brought in the Court of Exchequer Chamber. (Wightman, Crompton, Blackburn, JJ., Channell, Wilde, BB.) Judgment affirmed except as to the issue upon not guilty; verdict upon that to be entered for plaintiff; the Court being of opinion that the use of spiral grooves was an infringement of plaintiff's patent.

Per WIGHTMAN, J.—If the 'other' rollers disclaimed will not succeed, and the special rollers are alone effectual, then the true invention resides entirely in the process described in the disclaimer; and the original specification does not describe or even suggest the form of roller in which that invention consists. And this is by the disclaimer to extend the right granted by the patent.

With respect to the entry of the verdict on the plea of not guilty, we are not prepared to concur with the Court of Common Pleas.

(11 H.L. Ca. 223.) On appeal to the House of Lords, judgment affirmed as to the 5th and 6th issues, but reversed as to the 4th issue, verdict upon that to be entered for plaintiff.

Per LORD WESTBURY, L.C.—It is quite clear that the original specification was utterly bad and void in law. It was expressed in such a way that the indentations, grooves, or flutings might be made longitudinally, and not merely in a circular form around the roller. And it is quite clear upon the evidence that any longitudinal grooves or patterns would not have the effect desired, but would be destructive of the fabric. Therefore, upon the face of the original specification, there was, in reality, no invention that could be maintained.

In the amended specification the plaintiff has struck out the material word '*upon*,' and instead of that he has put in the distinctive word '*around*' the roller, and he has altered the language so as to convert the general direction contained in the original specification into a specific direction to make grooves, flutes, or indentations around the roller. And instead of the words being made to comprehend '*any required design*,' these words are struck out, and the only direction now consists of a direction to make circular grooves around the roller. It is quite obvious that the limits of the authority or license given to the patentee by the statute with respect to disclaimers, are here very much transgressed. The object of the Act authorising disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient, without the necessity of addition, then you might, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention as described in the specification untainted and uninjured by that vicious excess.

The next question is, whether the description contained in the specification, as corrected by the disclaimer, amounts to a new manufacture. I should have thought that the patentee might have maintained a patent for a new combination if he had put his invention upon this ground, that he was the first person who discovered that the circular grooved roller would answer by one process the double operation of calendering and imprinting the fabric. Your Lordships are well aware that by the large interpretation given to the word '*manufacture*' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition

to the thing produced, it will comprehend a new machine, or a new combination of machinery; it will comprehend a new process, or an improvement of an old process. But, if we look at this patent, I think there is no such improvement as amounts to a new manufacture.

There were some objections raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took 'a roller of hard metal or other suitable material.' I do not think those words, 'or other suitable material,' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material' no doubt would mean any material equally sufficient for the purpose with hard metal.

Per LORD CRANWORTH.—The most material question is as to the issue which is raised in the sixth plea. I agree with what was said by Mr. *Grove*, that it is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words '*a new manufacture.*' I, as a manufacturer, have my engraved roller, which I am in the habit of rolling upon a bowl, the fabric passing between the two at equal velocities. Then I can impress my pattern upon it. I have my roller without any pattern engraved upon it; I can impress that at an unequal velocity, and it will calender. But I do not do them both at the same time, because I suppose that in doing so I shall tear the fabric; and I rightly so suppose, until the plaintiff makes the discovery that there is one particular sort of pattern which may be produced without tearing the fabric. That is a very useful discovery, but it would be strange to say that it is a new manufacture, and that therefore I am to be deprived of the most useful way of employing my roller. There is nothing new in the invention, except that I now know that by a particular use of it I shall obtain a result which I did not before know that I could obtain.

RENARD *against* LEVINSTEIN, A.D. 1864–5. 10 L.T. N.S. 94, 177; }
11 L.T. N.S. 79, 505; 13 W.R. 229; 2 H. & M. 628. }

Practice in Patent Suits. Interrogatories. Obligation on Patentee when Invention is in part communicated from abroad. Evidence admissible under Particulars of Objections. Rights of Licensee. Injunction. Account.

Suit to restrain from infringing a patent of 12th Jan. 1861, No. 97, to *C. A. Girard*, for 'improvements in preparing colouring matters for dyeing and printing.' (The result partly of a communication from abroad by *G. de Laire*, and partly of invention made by himself.)

Injunction granted. Answer excepted to upon the ground that defendant had not stated fully whether he had used the materials and substances according to *Girard's* process. Wood, V.C. said:—

The defendant is bound to answer whether he uses the ingredients mentioned in the specification, whether he adds anything else, and whether the additions make any difference in the process, though he is not compelled to disclose the nature and quantities of the additions.

On appeal to the Lords Justices, injunction dissolved, defendant to keep an account. Costs to be costs in the cause. One objection taken was that, although the specification stated that the invention was partly original and partly communicated from abroad, it did not distinguish between the respective portions thereof.

Per KNIGHT BRUCE, L.J.—In the present case, various objections have been suggested at the bar, one being that the invention, being stated to be partly original and partly communicated from a foreign country, it is not distinguished either in the letters patent or in the specification, or otherwise, what is the nature or what are the particulars of the communication from abroad, made by the gentleman mentioned. Considering the different consequences that may arise as to the part of an invention communicated from a foreign country, and as to the part of the same invention which may be deemed to be in every respect new, I consider it to be a serious and very arguable question, whether it is or is not incumbent on the patentee to distinguish, to define, and to particularise what is new and what is old, which here is not done. This is not the time at which to decide upon such a point.

I think that the sufficiency and validity of the specification is matter of serious doubt. The consequence is, that with a patent no older than the present patent is, though its age is no objection to an interlocutory injunction of itself, in the present stage of the cause there ought to be no injunction.

(11 L.T. N.S. 79.) The Court was next occupied in considering the sufficiency of plaintiffs' answers to certain interrogatories. One related to the proportions of acid and water used by plaintiffs in forming the dye, as to which Wood, V.C. said:—'Those who practise an invention are bound to say what they do themselves. The plaintiffs must state the proportions they use.'

(11 L.T. N.S. 505; 13 W.R. 229.) The cause now came on for hearing before the Court without a jury. At the close of plaintiffs' case, counsel for defendant referred to prior publication by the specification of a patent taken out by *Girard* in 1860. Leave was then given to defendant to serve a notice of motion to amend his particulars. On the argument, Wood, V.C. said:—

‘Nothing can be more inconvenient and objectionable than the omission to bring forward this objection at an earlier period. The Court is bound to look at the substance of the case. It sees that to refuse this application may be an injury to the plaintiffs, for the only result would be a motion for a new trial before the Court itself, or an appeal to a higher jurisdiction; while to grant a perpetual injunction would be most burdensome on the defendant, if it should turn out afterwards that there is now a document in existence which makes the patent invalid upon the face of it. Therefore, holding that the lesser of two evils is to admit the evidence now tendered, I shall allow the amendment of the particulars of objection. In doing so, however, I shall exercise the power given by stat. 15 & 16 Vict. cap. 83, sect. 41, and impose such terms as seem to me fit. They are, payment of the costs of this motion; and, whatever may be the result of the trial, payment by the defendant of any extra costs which may be occasioned by the introduction of this fresh evidence.

His Honour was then asked to order defendant to give security for such extra costs, but he declined to vary the terms.

(2 H. & M. 628.) The next step was a motion for injunction, when it appeared that MM. *Renard* were the assignees of the patent, and that they had granted an exclusive licence for *England* to Messrs. *Simpson & Co.*, who filed the present bill. MM. *Renard* were made co-plaintiffs, and after the suit had advanced some stages, they assigned their interest in the patent to one *Fayolle*, as trustee for a company. The new owners were joined as defendants. It was objected that a mere licensee, not being assignee of the patent, had no right to sue for an infringement. Wood, V.C. granted an injunction, and said:—‘The Court is constantly in the habit of interfering to protect plaintiffs, in cases where there is some actual or apprehended wrongdoing by a third party, with reference to some contract which has been entered into by the plaintiff or for his benefit. In this case the defendant is knowingly committing a wrong at once against the owners and licensees of this patent. If, then, the case were now exactly in the position in which it was at the time when this bill was filed, there could be no doubt, on this part of the case, that the owners and licensees, acting together as co-plaintiffs, would have such a common interest as would enable them to maintain the suit, and would be entitled to the injunction now asked for. The difficulty in this case arises from the fact that, at the time when the assignment of the patent to *Fayolle* took place, the cause had advanced to such a stage that I did not think I could allow the introduction of a new set of plaintiffs, and therefore *Fayolle* and the company which he represents have been added as

defendants to the bill. But how does that affect the wrong done to *Simpson & Co.*, the licensees?

‘Then it is said, “We offer to keep an account, and therefore there can be no injunction.” But although the Court is in the habit of refusing an injunction when it sees that that course will satisfy the requirements of justice, on the defendant’s undertaking to keep a proper account, I apprehend that it is perfectly discretionary with the Court, and that the strict right of the plaintiff is to have an injunction as soon as he has established the fact that there is an infringement. That there is an infringement in this case I have no doubt.

‘I must grant this injunction. As, however, the defendant has offered, even at this late hour, to keep an account, I must require from the plaintiffs an undertaking as to damages.’

RUSHTON *against* CRAWLEY, A.D. 1870. L.R. 10 Eq. 522.

Subject-matter of a Patent.

Suit to restrain from infringing a patent of 24th *June*, 1867, No. 1,841, to *H. Rushton*, for ‘improvements in the manufacture of artificial hair.’

The specification stated:—‘This invention relates to the manufacture of hair to be used in imitation of human hair for head-dresses. For these purposes I take animal fibre, by preference *Russian* wool, or wool of coarse texture.’ Then followed a description of the treatment of this material. *Claim*: ‘The use and application of wool, particularly that kind known as *Russian tops*, or other similar wools or fibre, in the manufacture of artificial hair, and also in the manufacture of crisped or curled hair for furniture, upholstery, &c.’

It appeared that in 1865 plaintiff had taken out a patent for the manufacture of chignons from mohair, or wool of the *Angola* goat. Also that *Russian tops* was a name given to wool of a coarse description. And further that, before the date of the patent, horsehair, mohair, and wool had all been used in the manufacture of artificial hair. Bill dismissed with costs.

Per MALINS, V.C.—Here the patentee makes an exclusive claim to the use and application of wool. The witnesses have proved beyond doubt that it has been the common course of the trade to make these things from wool of all kinds, for certainly the last fourteen or fifteen years. It is a gross violation of the privilege conferred upon inventors, for a person to take out a patent for a known article which has been used for years, because he finds he can produce a thing cheaper or better by a new material. The use of a new material to produce a known article is not the subject of a

patent. The case of *Brook v. Asten* (8 E. & B. 478) is conclusive against the plaintiff.

RUSSELL *against* COWLEY, A.D. 1832—4. 1 Webs. Pat. Ca. 457 ; }
1 Cr. M. & R. 864. }

Inspection and delivery of Specimens. Novelty of Invention. Sufficiency of Specification.

Suit to restrain from infringing a patent of 26th Feb. 1825, No. 5,109, to *C. Whitehouse*, for 'improvements in manufacturing tubes for gas and other purposes.' Account. Inspection *by consent*. Each party, with their respective scientific witnesses, to be at liberty to inspect the works of the other, and to remove specimens of the pipes or tubes operated upon in their presence.

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

The specification stated:—'I prepare a piece of iron plate, of suitable substance and width, according to the intended calibre of the tube; this is prepared for welding by being bent up or turned over into the form of a long cylindrical tube. The tube is heated by a blast; and when the iron is on the point of fusion it is drawn out by a chain attached to a draw-bench, and passed through a pair of dies, by which means the edges of the iron will become welded together.'

The specification further described the apparatus by reference to drawings, and stated:—'I do not confine myself to this precise construction of apparatus, as several variations may be made without deviating from the principles of my invention, which is to heat the previously prepared tubes of iron to a welding heat and to pass them between dies, by which the edges may be pressed together and the joint firmly welded. The length of the pieces of tube may be from two to eight feet in one piece, whereas by the old modes the length of tubes cannot exceed four feet without considerable difficulty.'

At the trial, it appeared that no mandril was required in order to preserve the circular form of the tube. The alleged infringement consisted in the welding of a tube, prepared like plaintiff's, by passing it between grooved rollers, and then drawing it through an apparatus called a *scorpion*, which was formed by placing together three conical draw-holes. The scorpion restored the cylindrical forms to tubes distorted by the preliminary drawing. The defendant gave in evidence the specification of a patent of 26th July, 1811, No. 3,469, to *H. James* and *J. Jones*, for 'a method of making gun-barrels by rolling.' The specification described a method of welding rollers grooved so as to fit the form of the barrel, and stated that care should

be taken to put in or take out the mandril as quickly as possible. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Exchequer. (Lord Lyndhurst, C.B., Parke, Alderson, Gurney, BB.)

Per LORD LYNDBURST, C.B.—Without any question this invention is ingenious and useful; and the point upon which the validity of the patent depends is, whether it claims to manufacture the pipes without the use of the mandril, in which case it would be a new invention. It is said, on behalf of the defendant, that the specification includes too much, and that the principle of the invention claimed is in fact not new; but it appears to me that the specification claims the invention of welding tubes without the use of the mandril. As I read the specification, the mandril is excluded both in the particular and in the general description. I think that the plaintiff's patent is good as being limited to the welding of tubes without the use of internal support. He has not extended his claim to anything which is not in fact his own invention.

Per PARKE, B.—I am of the same opinion. If the patent claims the invention of welding by circular pressure, then it is clearly void; but if the plaintiff only claims a limited and particular mode of effecting that object, then it is certainly new. In the construction of a patent the Court is bound to read the specification so as to support the patent, if it can be fairly done. Taking the whole specification together, it is clear that it was intended to exclude the mandril.

Per ALDERSON, B.—We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions.

RUSSELL *against* LEDSAM, A.D. 1843–8. 11 M. & W. 647; }
14 M. & W. 574; 16 M. & W. 633; 1 H.L. Ca. 687. }

Novelty of Invention. Evidence of Infringement. Computation of time. 'Prosecution with effect' within the terms of stat. 5 & 6 Will. IV. cap. 83, sect. 4.

CASE for the infringement of the same patent, extended for six years. Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the invention was not new. 7. That the extended letters patent were granted after the expiration of the term of the original patent, and not before the expiration of the said term, as in the declaration stated. Issue.

At the trial, defendant put in evidence the specification of a patent of 19th Jan. 1824, No. 4,892, to *J. Russell*, for a mode of welding iron pipes by hammering, wherein a strip of plate iron was bent into the form of a tube, and placed on an anvil having a block or bolster with a semi-cylindrical recess. The edges were then

welded by a succession of blows from a tilt hammer, either with or without the use of a mandril. After this operation, the pipe was passed between rollers, and the inside was made true by the use of a conical mandril.' It further appeared that the original patent bore date 26th Feb. 1825, and the extended patent bore date 26th Feb. 1839, and it was contended that the original patent expired on 25th Feb. 1839, and before the grant of the extended patent; but ALDERSON, B. over-ruled the objection.

The alleged infringement consisted in welding the edges of the pipe by passing it between rollers arranged so as to form a contracting or bell-shaped cavity, whereby the union of the edges was effected without the use of a mandril. Verdict for plaintiff. Leave reserved.

(14 M. & W. 574.) Rule nisi for a new trial and to enter a verdict for defendant on the issue raised by the 7th plea. Plaintiff also moved for judgment *non obstante veredicto* on the 7th plea, on the ground that under stat. 5 & 6 Will. IV. cap. 83, sect. 4, it is provided that 'no such extension shall be granted (that is, by the Crown) if the application by petition shall not be made and prosecuted with effect before the expiration of the term.' The Court of Exchequer were of opinion that the judgment ought not to be arrested, and that on the whole the plaintiff was entitled to succeed.

Per PARKE, B.—On the trial of this cause, a patent granted in 1824 to Mr. *J. Russell* was given in evidence for the defendant. This patent, it was contended, was for circumferential pressure and without a mandril, and therefore was the same in principle as the plaintiff's, and consequently the latter could not be supported. It appears to us, however, that the principle of the two inventions is not the same, for *J. Russell's* does not operate by continuous equal circumferential pressure as the plaintiff's does, but by the repetition of violent contact of short duration. But then it is said, that, in order to carry the plaintiff's invention into effect, the drawing the pipe through a fixed hole, and that of a conical or bell-mouthed form, is necessary; that it is an essential part of the plaintiff's patent; and that the defendant has not infringed it, for his apparatus does not move the pipe through a fixed hole; there is no relative motion between the pipe and the roller; and it does not draw out or stretch the pipe. It is on this part of the case that some of us have entertained more doubt than on the other; but, after much consideration, we do not see reason to differ in opinion from the jury, and think that the defendant's mode, though it is an improvement in some respects on the plaintiff's patent, is in others the same, and is an infringement of it. There may not be the same injury to the

fibre of the iron as by the drawing process, which weakens and attenuates the tube, and the method of operating is more convenient than that by which the plaintiff carries his principle into effect. But if the process is, as we think it is, in a material part the same, the defendant has been guilty of an infringement.

Another question is, whether the day of the date of the first letters patent was inclusive or exclusive. The usual course in recent times has been to construe the day exclusively, whenever anything was to be done in a certain time after a given event or date; and consequently the time for enrolling a specification within the six months given by the proviso is reckoned exclusively of the day of the date. We are of opinion that the verdict on the issue on the seventh plea must be entered for defendant.

The 'prosecuting with effect,' which is to warrant the Crown to grant, means, according to the ordinary construction of the sentence, a prosecuting with effect prior to and independent of the grant, and not the grant itself; and that must be the obtaining the report of the Judicial Committee, or the approbation of it by the Crown; and, if so, there is no necessity for the new letters patent to be actually issued before the expiration of the old. It seems to us there is no limit except the discretion of the Crown, and it is presumed that the grant will not be made after a long interval. With respect to those persons who use the invention in the interval, there is no doubt they are not responsible. The conclusion to which we have come is, that the Legislature did not intend to restrict the Crown as to the actual date of the grant, if all the preliminaries were completed before the expiration of the term; and therefore it appears to us that the seventh plea is bad.

(16 M. & W. 633.) Error brought in the Court of Exchequer Chamber. (Tindal, C.J., Patteson, Williams, Coltman, Maule, Wightman, Cresswell, JJ.) Judgment affirmed.

(1 H.L. Ca. 687.) Appeal to the House of Lords. Judgment affirmed, with costs.

SAUNDERS *against* ASTON, A.D. 1832. 3 B. & Ad. 881; }
1 Webs. Pat. Ca. 75. }

The Specification must distinguish what is new.

CASE for the infringement of a patent of 13th Oct. 1825, No. 5,264, to *B. Saunders*, for 'improvements in making buttons.' Plea: Not guilty. Issue.

The patent related to a method of forming a covered button with a flexible shank. A toothed steel ring or *collet* secured the back of the button, the surplus material being pinched up at the centre, so

as to form a flexible shank. *Claim*: 'The substitution of a proper soft and flexible material in place of metal shanks to all such buttons as may be formed in the various methods herein described.'

At the trial, there was evidence that, before the date of the patent, flexible shanks had been put upon buttons in several of the ways described by plaintiff; also that the *collet* itself was not new. LORD TENTERDEN, C.J. directed a nonsuit. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of King's Bench. (Lord Tenterden, C.J., Littledale, Parke, Taunton, JJ.)

Per LITTLEDALE, J.—Neither the button nor the flexible shank was new, and they did not, by merely being put together, constitute such an invention as could support this patent. It is contended that the operation of the collet, under the present patent, is new; but that is not stated in the specification as the object of the invention, and it is, in fact, only one mode of carrying it into effect. It appears on the plaintiff's case that there were other modes of producing the same result. I think, therefore, the nonsuit was right.

SAVORY *against* PRICE, A.D. 1823. Ry. & M. 1; 1 Webs. Pat. C. 83.

Specification void for misleading.

CASE for the infringement of a patent of 23rd Aug. 1815, No. 3,954, to *T. F. Savory*, for the 'invention of a neutral salt under the name of *Seidlitz* powder.' Plea: Not guilty. Issue.

The specification set out three distinct recipes for making the ingredients of the powder—viz. (1) *Rochelle* salts (*i.e.* a double tartrate of potash and soda), (2) carbonate of soda, (3) tartaric acid; all of which were well-known substances before the date of the patent. It further stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. Plaintiff nonsuited.

Per ABBOTT, C.J.—It is the duty of any one to whom a patent is granted, to point out the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients; when, in fact, he might go to a chemist's shop and buy the same thing as a separate, simple part of the compound, the public are misled.

SAXBY and ANOTHER *against* EASTERBROOK and OTHERS, A.D. 1872. }
L.R. 7 Ex. 207. }

Practice as to Account and Inspection of Books pending an Appeal.

CASE for the infringement of a patent. At the trial, after verdict for plaintiff, KELLY, C.B. granted an account.

Rule nisi to enter a verdict for defendants discharged by the Court of Exchequer. On 3rd *Feb.* 1872, notice of appeal was given. On 13th *Feb.*, order made at Chambers by Lush, J. for an account of profits to be taken by the master. On 2nd *March*, an injunction, which had been previously granted, was suspended to abide the appeal. On 9th *March*, the parties appeared before the master, but defendants declined to produce any books, and it became impossible to proceed.

Rule nisi for production and inspection of defendants' books, and to administer interrogatories, made absolute by the Court. (Kelly, C.B., Martin, Bramwell, Cleasby, BB.)

Per KELLY, C.B.—In this case the trial was before me; and, upon the verdict being pronounced, I at once, under the power given by the statute, granted an order for an account, meaning an account of profits from the time of the infringement to the time of the verdict. Judgment was afterwards given in this Court confirming the verdict. It appears that afterwards application was made to Mr. Justice Lush, who made a formal order to the same effect, extending its operation to the date of the order, and that order is still in force and has not been appealed against. In pursuance of that order the parties appeared before the master, whose duty it was to take the account, but he found himself stopped almost *in limine* by the refusal of the defendants to produce their books. Application is now made to this Court to enforce the production of these books, and to administer interrogatories. No objection has been made to any particular interrogatory. I am clearly of opinion that the rule should be made absolute.

Per BRAMWELL, B.—The case of *Bridson v. McAlpine* (8 Beav. 229) would go to show that if there was inconvenience in ordering the account the Court would not order it. But no application has been made here by the defendants.

Per CLEASBY, B.—We ought to enforce the order that has been made unless reason is shown for making a different order, and none has been shown.

SAXBY and ANOTHER *against* HENNETT and ANOTHER, A.D. 1873. }
L.R. 8 Ex. 210. }

Pleading. Demurrer. Priority of Patent Right.

CASE for the infringement of a patent of 20th *July*, 1867, No. 2,119, to *J. Saxby*, for 'improvements in machinery for locking railway points and signals.' Plea: That the alleged infringements were in respect of certain apparatus made by defendants under a patent bearing date the 23rd *July*, 1867, and granted to *W. Easterbrook*,

before the grant of plaintiffs' patent. Demurrer and joinder. The contention was, that as *Easterbrook's* patent was sealed before that of the plaintiff, it took priority, although of later date. Judgment for plaintiffs by the Court of Exchequer. (Kelly, C.B., Martin, Pollock, BB.)

Per KELLY, C.B.—Notice is given by a patentee at each step, and any one interested may lodge a *caveat* against the grant of the patent. In this case *Saxby's* application bore date on the 20th of *July*; the defendants' was a few days later. Nothing was done by *Saxby* or *Easterbrook* to prevent the patent of the other from being sealed; and eventually both were sealed, the sealing of *Easterbrook's* being prior in point of time. Now of the competency of the Crown to seal both there can be no doubt; and then the 24th section of stat. 15 & 16 Vict. cap. 83 comes into operation, and enacts that letters patent, where antedated, are to be of the same validity as if sealed on the day they bore date. In this case, therefore, *Saxby's* patent must be taken as dated before the patent of *Easterbrook*, and the plaintiffs are therefore entitled to judgment.

SEED *against* HIGGINS and OTHERS, A.D. 1858. 8 E. & B. 755, 771; }
8 H.L. Ca. 550. }

Evidence of Infringement. Construction of Specification after Disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 14th *July*, 1846, No. 11,293, to *W. Seed*, for 'improvements in machinery for preparing, slubbing, and roving fibrous substances.' Pleas: 1. Not guilty. 5. That the specification was insufficient. 7. That the invention, as altered by disclaimer, was another and a different invention from that for which the patent was granted. Issue.

The patent related to the application of the so-called principle of centrifugal force in causing the small spur or finger which conducted the sliver of cotton to a bobbin, to press upon the same during the operation of winding. The specification stated that the spur in question might be brought to press or bear upon the bobbin by the action of centrifugal force, instead of by springs or other mechanical pressure. It then described one mode of applying the invention to a flyer in an ordinary roving machine. The drawings annexed showed two fixed bearings, at the top and bottom of the leg of a flyer. A vertical wire was swivelled loosely in these bearings, being bent at its lower end into a horizontal spur for conducting the sliver to the bobbin and for pressing thereon, and being also bent at its upper end, first in a horizontal and then in an upward vertical direction, so as to support a small weight at a little distance on one side of the leg of the flyer. As the flyer revolved, the weight tended

to move outwards from the axis of rotation, and the spur was forced inwards so as to press upon the surface of the bobbin. The specification went on to state:—‘The above apparatus represents one particular and practicable mode of applying my invention; but I would remark that I do not intend to confine myself to this particular method; but I *claim*, as my invention, the application of the law or principle of centrifugal force to the particular or special purpose above set forth; that is, for the purpose of producing a hard and evenly compressed bobbin.’ On 3rd Aug. 1854, the patentee filed a disclaimer, in which he stated that he had been advised that the claim of invention might be construed in such a manner as to be more extensive than he intended, and amended it in the terms following:—‘I do hereby *disclaim* all application of the law or principle of centrifugal force as being part of my invention, except only the application of centrifugal force by means of a weight acting on a presser so as to cause it to press against a bobbin as described.’

At the trial, it appeared that the presser in common use before the patent was a lever-finger connected with a spring. There were various forms of springs. The defects of this arrangement were that the spring pressure was weak at starting and became gradually stronger, whereby the outer portion of the bobbin was more compressed than that within; also that the elastic pressure of different springs varied. Defendants put in evidence the specification of a patent of 27th Feb. 1830, No. 5,909, to *J. C. Dyer*, for (*inter alia*) a presser for winding the roving of cotton upon bobbins in a hard and compressed state. The drawing showed a cross-arm pivoted near its centre so as to swing freely in a horizontal plane about a point at the end of the guide-arm of a flyer. The tail end of this arm was carried outwards by the centrifugal force during rotation, and the guiding or front part of the arm was thereby pressed against the bobbin and hardened it in the manner required.

The alleged infringement consisted in distributing the weight necessary for pressing the spur upon the bobbin along a line parallel to the leg of a flyer and close beside it. The weight thus distributed along the leg to the flyer, was attached in such a manner as to move a little outwards during the rotation, and produced a pressure on the bobbin in precisely the same way as the separate weight of plaintiff’s. Mr. *May*, the engineer, deposed that defendants’ flyer was something between *Seed’s* and *Dyer’s*, being rather more than half way between the two, and rather more *Seed’s* than *Dyer’s*, and that every approach of the weight to the lower part of the leg was bad, as setting up vibration. It was objected that the specification, after disclaimer, claimed an invention different from that

for which the patent was granted, and also that there was no evidence of infringement. LORD CAMPBELL, C.J. over-ruled both objections. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on the ground that the disclaimer described a different invention from that for which the patent was granted, and for a new trial on the ground of misdirection by the judge in not telling the jury that the specification claimed too much, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—It is quite clear that, if, the specification and the disclaimer being taken together, anything is claimed which was not comprised in the original specification, the whole is bad. But we are of opinion that nothing new is claimed by the disclaimer, and that, due effect being given to the disclaimer, the plaintiff only claims a particular application of centrifugal force as described by the diagram and explained in the specification. To suppose that the exception mentioned in the disclaimer refers to the general description of the invention, and not to the apparatus portrayed in the diagram, seems to us a violation of the language the plaintiff employs and a perversion of his meaning. If this be so, the alleged misdirection of the judge, in reference to the specification, cannot be supported.

Appeal to the Court of Exchequer Chamber (Williams, Willes, Byles, JJ., Martin, Bramwell, Watson, BB.), leave to appeal having been granted on the additional ground that there was no evidence of infringement to go to the jury. The majority of the Court were of opinion that the decision of the Court of Queen's Bench on the point of law was correct, but the learned judges gave their unanimous judgment for a new trial on the ground that there was no evidence of infringement to go to the jury.

Per WILLIAMS, J.—I am of opinion that the judgment of the Court of Queen's Bench must be reversed; not on any ground considered in that Court, but on the additional ground that there was no evidence, to go to the jury, of any infringement of the patent. The plaintiff sets out one mode of application, yet wishes to state that his patent consists in applying the principle in any way. Then, seeing that his claim is not good, either as comprehending something not new, or as not explaining sufficiently so general a claim, he enters a disclaimer. Now, he is entitled to withdraw so much of his original claim as would leave only an application of the particular method. It comes therefore to this, that he claims simply what is in his drawing. The witnesses show only the user by the appellants of something different from the machine represented by the drawing.

(8 H.L. Ca. 550.) On appeal to the House of Lords, judgment of the Court of Exchequer Chamber affirmed.

Per LORD WENSLEYDALE.—The question of infringement is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as are admissible to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz., what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is no doubt admissible; and, in determining the question of infringement, the judge must apply what the jurymen find to be true. The opinion of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and, if objected to, ought to be rejected. The Court alone is to decide questions of law.

In this case the models of both machines are brought before us, and would be before the jury; and, judging from them, we see for ourselves that, though they both answer the object of applying centrifugal force to the flyers, they do it in a different way. The plaintiff uses what is in common parlance *a weight*, and that weight is at the end of the perpendicular wire, at the top of it, and could not be put lower without interfering with the bobbin; the defendants do not use such a weight; they distribute weight by a sort of case round the bottom part of the flyer, the centre of gravity being lower than the middle of the flyer. The evidence of the scientific witnesses cannot alter these facts, and their opinion that one machine is a piracy of the other is of no consequence whatever, for that is a question not in their province to decide. If the claim in the patent had continued to be for *any* mode of applying centrifugal force to the finger or presser, undoubtedly the defendants' machine would have been an infringement. But the disclaimer puts an end to that argument; and the patent being for a particular machine only, which clearly operates differently from that of the defendants, it seems, I own, to be very clear that one is not a piracy of the other. It is only by confounding the patent as it was, with the patent as it is, that infringement of the patent can be made out.

Per LORD CHELMSFORD.—It appears to me that the plaintiff first claims the particular method described, and afterwards every other application of centrifugal force to the purpose set forth. Then, when he disclaims all application of the law or principle of centrifugal force, except only the application of centrifugal force as described in the specification, he does not abandon the whole of his invention,

and leave himself nothing but an illustration of it; but he gives up all that is general, and limits himself to the particular method, which was a substantial and independent claim, to which the general claim had previously been added. In this view the disclaimer certainly does not extend the right, nor can it be said to describe a different invention.

SELLERS *against* DICKINSON, A.D. 1850. 5 Ex. R. 312.

Evidence of Infringement. User of Part of a Combination.

CASE for the infringement of a patent of 17th *March*, 1845, No. 10,563, to *J. Sellers*, for 'improvements in looms for weaving.' Pleas: 1. Not guilty. 4. That the specification was insufficient. Issue.

The patent related to a method of stopping a power-loom automatically when the shuttle remained in the shed. The specification stated that in ordinary power-looms this object was effected by means of a spring *swell* or ridge on the outside of the shuttle-box. When the shuttle entered the box it forced out the swell, and a lever-finger was thereby kept raised; but, when the shuttle failed to travel, the finger fell out of place and came in contact with a piece called a frog, the result of which was that the driving strap was thrown from the fast to the loose pulley, and the lathe or slay was stopped. The concussion, however, caused by this mode of stopping the loom was found to be injurious. The specification then described an improved arrangement of mechanism for the same purpose, which adopted the swell and stop-rod finger, but stopped the loom by separating the two halves of a clutch-box, one attached to the main driving pulley, and the other to the driving shaft, and further arrested the motion without any concussive action by bringing a friction break to bear on the periphery of the fly-wheel. *Claim*: 'The above-described novel arrangement of mechanism for stopping the loom when the shuttle does not complete its course, by disconnecting the main driving pulley from the driving shaft, and also the method of bringing a break into connection with the fly-wheel for the purpose of preventing the lathe from beating up any further.'

At the trial, it appeared that the alleged infringement consisted in working under a patent of 11th *Sept.* 1848, No. 12,267, to defendant for a like invention. In defendant's looms, a finger or detector connected with the swell caused the shifting of the driving strap from the fast to the loose pulley in the ordinary manner, but, at the same time, brought a friction break to press against the periphery of the fly-wheel. WIGHTMAN, J. left it to the jury to say whether plaintiff's arrangement for bringing the break into action

with the fly-wheel was new and useful, and whether defendant's arrangement for effecting a like object was substantially the same as that of plaintiff. The jury answered both questions in the affirmative. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant or for a new trial, on the grounds that the specification was insufficient and that there was no evidence of infringement, discharged by the Court of Exchequer. (Pollock, C.B., Rolfe, Platt, BB.)

Per POLLOCK, C.B.—With the facts as found, I am of opinion that the specification is perfectly good.

The next point is, whether there has been any infringement of the patent. The argument addressed to us was that this is a patent for a combination of old and new mechanism, and, the defendant not having used the combination, there can be no infringement. But that is not so. There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing. The machine is so constructed that one and the same operation throws it out of gear, and at the same time applies a break to the fly-wheel, so as to stop the momentum. The defendant has substituted for the clutch-box the old plan of the 'frog,' and, instead of separating the power and the machine by a clutch-box and so throwing the machine out of gear, he has followed the old mode of throwing off the strap; but he has adopted the more important and substantial improvement of the break, which the jury have found in itself an arrangement of machinery new and useful. I think it may be laid down as a general proposition (if a general proposition can be laid down on a subject applicable to such a variety of matters as patent law), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent. Such is the case in the present instance.

SIMPSON *against* HOLLIDAY, A.D. 1865–6. 5 N.R. 340; }
L.R. 1 H.L. Ca. 315. }

Sufficiency and construction of Specification.

Suit, by assignees, to restrain from infringing a patent of 18th Jan. 1860, No. 126, to *H. Medlock*, for 'improvements in the preparation of red and purple dyes.'

The patent related to the preparation of red and purple dyes by treating aniline with arsenic acid. The specification stated:—'I

mix aniline with *dry* arsenic acid, and allow the mixture to stand for some time; or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour, and then I mix it with boiling water, and allow the mixture to cool; when cold it is filtered or decanted.' The filtered solution gave a red dye, and the residuum when dissolved in alcohol furnished a purple dye. The specification went on to say:—'The mixture of aniline and arsenic acid, *after being heated*, may be allowed to cool, and then forms a paste which may be preserved; when required for use, it is mixed with boiling water, and treated as above described.' The proportion of two parts by weight of aniline to one of arsenic acid gave a good result, but these proportions might be varied. *Claim*: 'The preparation of red and purple dyes, by treating aniline with arsenic acid as hereinbefore described.'

The suit came on before Wood, V.C. for trial without a jury on issues of novelty, utility, sufficiency of specification, and infringement, all of which were found in favour of plaintiff. From this decision plaintiff appealed, when two objections were raised. (1) That the specification described two processes for obtaining the red dye, one a hot process and the other a cold process, and that the latter would not succeed (this was proved in evidence, and admitted by plaintiff). (2) That *dry arsenic acid* meant *anhydrous* acid, as to which there was evidence that the arsenic of commerce was hydrated, and that no good result was obtained unless the arsenic contained a considerable percentage of water. After argument, the Lord Chancellor reversed the order of the Vice-Chancellor, declared the patent to be void at law, and dismissed the bill without costs.

Per LORD WESTBURY, L.C.—The first objection raised by the defendant is that two processes for effecting the end proposed, one of which may be called the cold, and the other the hot process, are described in the specification, but that one of them, viz., the cold process, is ineffective. If the true construction of the specification be, that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is therefore invalid and bad at law. If a specification alleges that a particular process, which may be slow, troublesome, and expensive, is efficient, and the statement is untrue, the vice is not removed by the fact that the same specification also describes another process which is efficient, and which is stated to be speedy, certain, and economical. When it is said that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it

must be understood of errors which appear upon the face of the specification, or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is because such errors cannot possibly mislead. But that proposition is not a correct exposition of the law, if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of any erroneous statement amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject.

Coming now to the construction of the specification, the inquiry is, whether, according to the ordinary rules of interpretation, there is a distinct statement of two separate processes, which are both claimed as inventions. The question depends on the construction of the first sentence in the specification. His Lordship analysed the sentence and continued:—It seems to me impossible, without rejecting several words, and altering the form of the whole sentence, to make it descriptive of *one* process only. Two modes of treating aniline with arsenic acid are plainly indicated. It was argued before me that the word ‘*or*,’ in the words ‘*or I accelerate the operation,*’ should be read ‘*and*,’ a construction which is forbidden by the whole structure of the sentence. And it was further contended, that the subsequent sentence which begins with the words, ‘*the mixture of aniline and arsenic acid, after being heated,*’ proved that one process only, viz., the hot process, was intended to be described and used, and that it corrected the alternative form of expression in the first sentence. But this is not the case, for the sentence in question applies only to the paste which is formed by the hot process, if the mixture, after being heated as directed, is allowed to cool before it is treated with hot water, in the manner described. It was argued that every person well informed on the subject would see that the cold process was ineffective. But this is to correct the specification by the superior intelligence of the reader, and is a mode of proving the invalidity of the patent by showing the false suggestion on which it was granted.

Although my decision rests on the ground I have stated, it would be wrong to omit all notice of the other objection of the defendant. This objection is founded on the direction contained in the specification to take ‘*dry* arsenic acid.’ ‘*Dry*,’ says the defendant, is synonymous with ‘*anhydrous*.’ From the evidence it would seem that arsenic acid, as an article of commerce, at the time when this patent was granted, was usually so prepared as that when sold it was found to contain twelve to fifteen or sixteen per cent. of water of

hydration. It further appears from the evidence that no good result could be obtained from using, in the manner directed by the patent, arsenic acid that contained less than twelve to fourteen per cent. of water of hydration; but there is some evidence to show that, with that extent of water of hydration, a beneficial result would be obtained. Upon a review of the arguments and the evidence, I cannot on this point accept the contention of either side. 'Dry' is not synonymous with 'anhydrous.' When used in its ordinary sense as opposed to 'wet,' it means physically dry, or dry to the touch, and many things are dry superficially to the touch which contain a great deal of water of combination. The plaintiff *Nicholson* states in his evidence that the word '*dry*' was used in order that the proper proportion of acid might be more readily ascertained, and he therefore construes the words as meaning physically dry. Inasmuch as I have found it proved that the ordinary arsenic acid of commerce when used in a state of dry powder, in which it was and is commonly sold, would produce a beneficial result, this addition of the word '*dry*' would not affect the working of the patent. I should not therefore have been of opinion that this objection was fatal to the patent; but the other objection I hold to be fatal.

On appeal to the House of Lords it was contended that the decree of the Lord Chancellor was erroneous in form as well as substance, and that his Lordship, under stat. 21 & 22 Vict. cap. 27, sects. 3 & 5, had no power to declare the patent to be void, but could only direct a new trial. No counsel appeared for the respondent. Decree appealed from affirmed so far as it declared the patent to be bad and void in law, but reversed so far as it ordered the findings of the Vice-Chancellor to be reversed. No order as to costs.

Per LORD CHELMSFORD, L.C.—In this case the issue upon the specification was in part a question of law, and the fact which showed its invalidity was not only proved but admitted by the appellants. It would be the height of absurdity to send the case to a new trial merely to try an undisputed fact, upon which the construction of the specification does not depend, but which shows that the patent is void.

Per LORD CRANWORTH.—There is no doubt in this case as to the construction of the specification. It specifies two modes of obtaining the mixture which produces the dyes, one with, and the other without, the agency of heat. It was admitted that no practical result can be obtained without the heat. This clearly makes the specification bad. It specifies two processes, whereas only one is practicable.

It is no answer to say, as was said at the bar, that any practical

workman would know that the cool process was bad, and so would adopt the other. It may be that, in construing a specification, the Court may sometimes feel justified in understanding the language, not according to its ordinary meaning, but in the mode in which it would be understood by skilled workmen called upon to act according to its direction. But this does not warrant us in giving effect to a specification claiming two things, one practicable, and the other impracticable, because a skilful workman would know that one of them could not be acted upon, and so would confine himself to the other.

THE SINGER MANUFACTURING COMPANY *against* WILSON, A.D. 1865. }
5 N.R. 505. }

Inspection.

Suit to restrain from infringing a patent for sewing machines. Motion for an order to inspect all sewing machines on defendant's premises, and to take drawings or photographs thereof. Wood, V.C. refused to make an order in so general a form, but granted an inspection of one machine of each class sold or exposed for sale by defendant, such machines to be verified by affidavit.

SMITH *against* THE LONDON and NORTH-WESTERN RAILWAY COMPANY, }
A.D. 1853. 2 E. & B. 69; Macrory's Pat. Ca. 188. }

Damages recoverable by surviving Assignee of a Patent. Evidence of Infringement. User of Part of a Combination.

CASE for the infringement of a patent of 14th Aug. 1835, No. 6,880, to *J. Day*, for 'an improved wheel for carriages.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 5. That the invention was not new. Issue.

The patent related to a method of constructing the nave, spokes, and rim of railway-carriage wheels, wholly of wrought iron, by welding. Two pieces of bar iron were placed side by side to form a spoke. A wedge-shaped piece of wrought iron was inserted between the ends of the bars, and the whole was heated and welded into one piece, forming thereby a spoke and part of the nave. The portions of the bar at the other end of the spoke were not welded, but were bent back in opposite directions, so as to form a part of the circular rim. The separate pieces were afterwards welded into a complete wheel having the arms, rim, and box all constructed of wrought iron. *Claim*: 'I declare the new invention to consist *in the circumstances* of the centre box or nave, arms, and rim of the said wheel being wholly composed of wrought iron welded into one solid mass in manner hereinbefore described.'

At the trial, it appeared that the alleged infringement consisted in forming the box of a wrought-iron wheel by welding together separate sectors. The rim was made in one piece, and was fitted to the spokes and sectors of the nave while cold. The whole was then heated, and welded into a solid mass. It further appeared that, in *Aug.* 1845, *Day* assigned the patent to plaintiff and another person, since deceased, as tenants in common, and that the infringements complained of were committed after assignment, but before the death of the co-assignee. It was thereupon contended that plaintiff was not entitled to recover more than half the damages sustained by the infringement; but MARTIN, B. directed the jury to find for the whole damages, if the issues were found for plaintiff. Verdict for plaintiff; damages 1,250*l.* Leave reserved.

Rule nisi to enter a verdict for defendants on the 2nd, 4th, and 5th issues, or to reduce the damages by one half, and for a new trial on the ground that the damages were excessive, refused by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—We are all clearly of opinion that there is no ground for the application with respect to the alleged division of the right to damages between the representatives of the deceased assignee and the plaintiff, because the right of action was a joint right; and, if one of the assignees had not died, the action must really have been brought by both of the two assignees, and, upon the death of one of them, the right survived to the survivor.

The evidence showed a clear imitation and infringement of the manner of forming the box or nave into one piece of malleable iron with the rest of the wheel. Mr. *Atherton* contended that the words of the claim restricted the patent to the invention of a wheel made in every respect 'in manner hereinbefore described;' and that, as the defendants had not used the same mode with regard to the spokes and rim, as the patentee had specified, there could be no infringement of the patent. My brother Martin, who tried the cause, intimated his opinion that the claim was for the invention of a wheel as described in the claim; but that if the defendants had imitated or pirated the mode of welding the nave, and that were a material part of the invention, there was an infringement of a part of the patent for which this action was maintainable. We are of opinion that this ruling was quite correct, and that there was ample evidence to support the action. Where a patent is for a combination of two or three or more old inventions, a user of any of them would not be an infringement of the patent; but, where there is an invention consisting of several parts, the imitation or pirating of any part of

the invention is an infringement of the patent. Suppose that a man invents a machine consisting of three parts, of which one is a very useful invention and the two others are found to be of less practical use, surely it could not be said that it was free to any person to use the useful part so long as he took care to substitute some other mode of carrying out the less useful parts of the invention.

SMITH *against* THE LONDON and SOUTH-WESTERN RAILWAY COMPANY, }
 A.D. 1854. Kay, 408; Macrory's Pat. Ca. 209. }
Practice as to an Account in Patent Suits. Delay.

Suit to restrain from infringing the same patent. The bill was filed on 30th *June*, 1853, more than three years after the patent had expired, and complained of infringements committed nine years previously. It appeared that plaintiffs had delayed to institute these proceedings until after the termination of the action *Smith v. London and North-Western Railway Company* (2 E. & B. 69), where they obtained a verdict with large damages. Bill dismissed with costs. Account refused.

Per WOOD, V.C.—The true ground of relief in these cases is laid down in *Bailey v. Taylor* (1 Russ. & M. 75), where Sir J. Leach, M.R. says:—‘The Court has no jurisdiction to give to a plaintiff a remedy for an alleged piracy, unless he can make out that he is entitled to the equitable interposition of this Court by injunction; and, in such case, the Court will also give him an account that his remedy here may be complete. If this Court do not interfere by injunction, then his remedy, as in the case of any other injury to his property, must be at law.’ Unless that primary right to an injunction exists, this Court has no jurisdiction with reference to a mere question of damages. Unless a case were made out, of a numerous series of past infringements, from which the parties are still deriving advantage, I am at a loss to see how the jurisdiction of the Court could attach, or the relief by injunction be arrived at, after the expiration of the patent. Such a case of a fraudulent attempt to evade the patent might occur, as would enable the Court to restrain the use of articles made in infringement of the patent, and kept back until it expired, even after its expiration; and, the plaintiff having thus obtained the right to an injunction, the right to an account would follow.

I have therefore to consider in this case whether it is right to grant an injunction. The plaintiffs did not file their bill until three years after the patent had expired. During the whole time numerous violations of the patent were going on of which they were aware. They proceeded to bring an action against the *London and North-*

Western Railway Company, in respect of alleged violations committed by them; but they did not give the least intimation to the defendants that they should hold them responsible for any violation of the patent; and not until nine years after some of the infringements now complained of were committed, and when the patent had expired, was any attempt made to restrain the defendants by injunction or otherwise. Now, I think a delay of nine months would be sufficient to induce the Court to say that it was not a case in which the Court would interfere by injunction, especially after the expiration of the patent. Therefore, as to any right to ask now for an account, the right to which appears to be entirely ancillary to the injunction, it must in this case completely fail. I think that the circumstance that some wheels are in use, which were manufactured before the patent expired, does not alter the case: the objection of delay applies to them also.

SMITH *against* THE GREAT WESTERN RAILWAY COMPANY, A.D. 1854. }
 Macrory's Pat. Ca. 221. }

Inspection.

CASE for the infringement of the same patent.

Rule nisi for liberty to inspect certain books of the company, refused by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—There is nothing on the face of these affidavits to show that the books it is sought to inspect will show an infringement of the plaintiff's patent. Great injury by the discovery of trade secrets and other such inconveniences might result if we were to sanction the principle that, on the mere possibility of discovering matter advantageous to one party, an inspection should be allowed by him of the other party's books, ranging, it might be, over a lengthened period of time.

SMITH *against* NEALE, A.D. 1857. 2 C.B. N.S. 67.

Pleading. Non concessit.

Action for breach by defendant of stipulations in a contract for the assignment of a patent to him by plaintiff. Plea: *Non concessit*. Issue.

At the trial, it was contended that defendant was entitled to a verdict on the plea of *non concessit*, upon the ground that the invention was not the subject of a patent. WILLES, J. left the case to the jury. Verdict for plaintiff, with 75*l.* damages.

Rule nisi for a new trial discharged by the Court of Common Pleas. (Cresswell, Williams, Crowder, Willes, JJ.)

Per WILLES, J.—The declaration alleges a contract for the assignment by the plaintiff of the letters patent to be used as therein mentioned, and we apprehend that this is a correct expression of the contract, and that such a contract involves no warranty that the invention was new, or was a manufacture within the statute of James. The defendant in this case, as in *Hall v. Conder* (2 C.B. N.S. 22), contracted for the use of the plaintiff's right, such as it was, without regard to whether it could be sustained on litigation or not; and there is nothing unreasonable or uncommon in such a bargain. Upon this construction of the declaration, the plea of *non concessit* would be bad if it put in issue more than the granting of the letters patent. The learned judge was right in ruling that proof of the letters patent entitled the plaintiff to a verdict upon this issue.

SMITH *against* SCOTT, A.D. 1859. 28 L.J. C.P. 325; 6 C.B. U.S. 771.

Pleading. Demurrer. Estoppel of Licensee.

Declaration for breach of covenant by defendant to pay royalties to plaintiff due under an exclusive licence by deed to work, within certain limits, an invention of improvements in manufacturing wire rope; the declaration setting out the recital in the deed of a grant to plaintiff of a patent for the invention. Plea 11. That the invention was of no use, and was not new, and that plaintiff was not the true and first inventor thereof, and at the time of making the deed plaintiff knew the matters aforesaid, and defendant did not and had no notice thereof. Demurrer and joinder. Judgment for plaintiff by the Court of Common Pleas. (Williams, Willes, Byles, JJ.)

Per WILLIAMS, J.—The first part of the 11th plea, down to the words 'true and first inventor thereof,' is clearly bad on the authority of *Hall v. Conder* (2 C.B. N.S. 22) and the other cases cited. As to the latter part, the agreement being by deed, the parties are estopped from going into the question of consideration, and the allegation in the plea of such knowledge of the plaintiff and ignorance of the defendant does not amount to fraud. There being, then, no fraud, the plea is no answer to the action.

Per BYLES, J.—The 11th plea does show a total failure of consideration; but, the contract being by deed, that is immaterial. No doubt it would be good if it alleged fraud; but the plea does not allege fraud, but only evidence of fraud.

SMITH *against* BUCKINGHAM, A.D. 1870. 21 L.T. N.S. 819.

Pleading. Demurrer. Agreement to purchase a Patent-right.

Declaration for breach of an agreement by defendant to purchase the patent-right of plaintiff in an invention for which provisional

protection had been taken out. The declaration set out a recital in the agreement that plaintiff 'had lately invented an improved composition or material to be used in waterproofing, or rendering woven fabrics impervious to moisture.' Plea: That plaintiff had not invented an improved or any composition or material which could be employed in rendering woven fabrics impervious to moisture. Demurrer and joinder. Judgment for plaintiff by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Lush, Hannen, JJ.)

Per MELLOR, J.—I think that the plea does not show a total failure of consideration. There is no express or implied warranty. The defendant has got what he bargained for, and therefore I think the plea is no answer to the declaration.

SPENCER *against* JACK, A.D. 1862-4. 3 De G. J. & S. 346; }
11 L.T. N.S. 242. }

Subject-matter of a Patent. Construction of Specification.

Suit to restrain from infringing a patent of 17th *Jan.* 1860, No. 120, to *J. F. Spencer*, for 'improvements in steam-engines for propelling vessels.'

The patent related to improvements in surface condensers for marine engines, and the specification stated:—'This invention refers to further improvements on inventions previously patented by me, viz., on 16th *Nov.* 1857 (No. 2,874), and on 29th *March*, 1858 (No. 661), and consists of several parts, each and all of which have reference to improvements in steam-engines working in connection with surface condensers of the kind and description patented by me in the year 1857.' It then described the invention by reference to drawings, showing (1) a direct acting screw-engine, having a pair of inverted cylinders raised overhead, with a surface condenser below the level of the cylinders, and occupying the space between the guides of the two connecting rods; (2) a paddle-wheel engine with a pair of oscillating cylinders, and a surface condenser lying between the cylinders. *Claims*: 1. 'In the arrangement of direct acting screw-engines the disposition of surface condensers of the kind patented by me in my previous patents (of 1857 and 1858), by which the external casing thereof forms part of the main framing, and is placed between and under the cylinders of such engines; and the tubes whereof, being horizontal or slightly inclined, are placed across the line of the propeller shaft.' 2. A like claim for paddle-wheel engines. 3. 'The arrangement, construction, and disposition of parts, and mode of working condensing steam-engines as herein described.'

The patent of 1857 related to improvements in the construction of surface condensers, and that of 1858 related (*inter alia*) to the

combination of a jet with a surface condenser of the kind patented by plaintiff in 1857, and also to an improved construction of marine engines with surface condensers.

On motion for injunction, ROMILLY, M.R. directed issues to be tried in the Court of Common Pleas, viz.:—1. Is it a new invention or manufacture? 2. Is it sufficiently described? 3. Have defendants infringed? On appeal, the Lords Justices severed the first issue into two questions; (1) Is it a new invention? (2) Is it a new manufacture?

At the trial, ERLE, C.J. directed the jury, that plaintiff's claim rested upon a combination of old things known before, but that if it were a new combination, resting on a substantial improvement, the patent could be supported, and put the questions:—Is the invention new? Is it a substantial improvement? The jury answered both questions in the affirmative, and found for plaintiff on all issues. His Lordship then certified to the Master of the Rolls that he was satisfied with the verdict, and that there was no conflict of evidence. The case then came back to ROMILLY, M.R., who was of opinion that the invention was not the subject of a patent, and granted a new trial. Appeal to the Lords Justices from this order, when, by consent, the hearing was taken as that of the original motion for injunction. Their Lordships were divided in opinion, and the case went before the Lord Chancellor, who dismissed the bill without costs.

Per LORD WESTBURY, L.C.—In the present case it seemed right to the Court to direct issues to be tried, instead of leaving the plaintiff to bring an action in the ordinary way. I advert now particularly to the second issue, whether the invention was a new manufacture. When the matter came back before his Honour the Master of the Rolls, his Honour appears to have taken up the point of law, without considering, in his judgment, that it was at all affected or concluded by the opinion of the jury, in the answer given by the jury to the second question. But, with very great respect to his Honour, I am of opinion, that he was bound to consider the point of law, taking into his hand the fact, and being guided, for the purpose of so considering it, with the aid and assistance of the fact found by the jury, that fact being that the alleged invention was a substantial improvement. If I am to approach the question of law, with the aid and with the guidance of the finding of the jury, there remains but very little question upon the matter of law, because, having regard to the reason and principle of the thing, and having regard to the numerous decisions upon the point, it is impossible to deny that if there be a combination of several things previously well known, which combination is attended with results of such utility and advantage to the

public that the combination itself is rightly denominated a *substantial improvement*, it is, I say, impossible to deny that that is the subject of a patent. Now the learned judge at the trial used that particular phrase, 'substantial improvement,' for the purpose of putting the question to the jury whether the thing patented was or was not attended with new and useful results. I have no hesitation, therefore, in expressing my opinion that the verdict for the plaintiff on the second issue—involving, as it does, the principal point of controversy before me—is a verdict which ought to stand, and that it includes within it of necessity the legal consequence that this invention is a new and useful thing, and therefore properly the subject of a patent. I cannot, therefore, at all concur with the Master of the Rolls in the direction for a new trial.

Another question is this, whether, in the construction of the specification filed under the patent of 1860, I am to take the plaintiff as limiting his description to the particular form of improved surface condenser, which had been made by him the subject of two antecedent patents. His Lordship then proceeded to examine the patentee's specification in detail, and continued:—The whole arrangement for which the patent is alleged to have been taken, is an arrangement founded upon this, that his own improved condenser is of necessity to be an integral part, a portion, an element, and a unit in that arrangement. That being the plain and obvious meaning of the specification, which I am compelled to give effect to, I find it a confessed fact, as established in the trial of the issues, that the defendants have not used at any time, in that combination or arrangement which the plaintiff says was a violation of his patent, they have never used any patent condenser with the improvements, either described in the patent of 1857, or described in the patent of 1858. I am obliged, therefore, to come to the conclusion that there was no ground for this suit at all. It is a very melancholy spectacle to observe how great has been the miscarriage, how great has been the misapprehension of the true subject which was to be tried, and into what an amount of useless matter and useless speculation these legal proceedings have been carried. It is indeed a strong lesson to distinguish in these cases between matters of law and matters of fact.

STEAD *against* WILLIAMS and OTHERS, A.D. 1843–4. }
 2 Webs. Pat. Ca. 126 ; 8 Scott N.R. 449. }

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

CASE for the infringement of a patent of 19th *May*, 1838, No. 7,645, to *D. Stead*, for 'paving public streets and highways, and

public and private roads, courts, and bridges, with timber or wooden blocks.' Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 6. That before the patent the invention was publicly known, practised, used, and published within *England*. 7. That the title was too large and vague, and at variance with the nature of the invention described in the specification. Issue.

The patent related to a method of paving roads with equal hexagonal blocks of wood, having their sides parallel to each other, and perpendicular to the roadway, the grain of the timber being also vertical. The specification stated:—'I do not confine my claim to hexagonal blocks, as triangular or square blocks placed diagonally may be used with advantage.'

At the trial, it appeared that hexagonal wood pavement had, before the date of the patent, been laid down in the carriage way at the porch of a house of Sir *W. Worsley*, in *Yorkshire*, the blocks being somewhat pointed at the base so as to admit of being driven into the ground. Also that in 1832, two letters, written by one *Heard*, had been published in the *Transactions* of the *Society of Arts*, containing an account of hexagonal wood pavement similar to that patented, which had been laid down at *St. Petersburg*.

CRESSWELL, J. directed the jury:—The defendants say, that scientific books published throughout *England*, before the patent, contained statements which substantially communicated to the public all the information which the plaintiff himself has given; and if he from such communications derived that knowledge which enabled him to take out this patent, he cannot convert to his own private use that knowledge which has before been given to the public. But then the defendants do not bring home to the plaintiff the fact of his having seen these publications; and it is for you to judge, upon the whole of the matter, whether you think that he had seen these publications, or whether he had derived his information from some persons residing abroad. . . . The next question is, whether paving with wood can be the subject-matter of a patent. I propose to state, as my opinion, here, that it is so. . . . Then comes the question, that long before the patent was granted, the invention was publicly known in this country. If you think that the blocks at Sir *W. Worsley's* were essentially the same as the hexagonal blocks introduced by the plaintiff, I should say that, in point of law, that makes an end of the patent; because that pavement appears to have been introduced by Sir *W. Worsley*, or to have been used by him in public—not concealed—no secrecy about it—made known to all persons who came to his house, so far as their ocular inspection went. If you think

that is the same thing in substance as that which the plaintiff claims, I think it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference. . . . Whether the title is too vague or not is rather matter of law than anything else, and upon that I am in favour of the plaintiff. Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, made absolute by the Court of Common Pleas. (Tindal, C.J., Coltman, Cresswell, JJ.)

Per TINDAL, C.J.—We think, if the invention has already been made public in *England*, by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the true and first inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time of the patent granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in obscurity, would afford a very different inference from the production of an Encyclopædia, or other work in general circulation. The question will be, whether upon the whole evidence there has been such a publication as to make the description a part of the public stock of information. We think, therefore, that, as this question has not been submitted to the jury, there ought to be a new trial in this case.

STEAD *against* ANDERSON, A.D. 1846–7. 2 Webs. Pat. Ca. 147; }
4 C.B. 806. }

Novelty of Invention. Evidence of Infringement. Prior Publication.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 5. That before the patent, the invention was publicly known, practised, used, and published within *England*. Issue.

At the trial, it appeared that the alleged infringement consisted in the paving of roads with wooden blocks, presenting on the surface squares of equal size, but *rhomboidal* in shape, with two of the sides inclined at angles of 63 to 45 degrees with the horizon, the grain of the wood being parallel to the inclined sides. The evidence of prior user and publication was the same as in the previous case.

PARKE, B. directed the jury:—The first issue should be found for the defendant, unless you are of opinion that this was a fraudulent

imitation and a mere colourable evasion of the plaintiff's patent right. The 5th issue embraces in it three different allegations. The first is, that the invention has previously been actually used; the second, that it has been publicly known; the third, that it has been published, at least in part. As to the alleged user, the only evidence is, that a similar pavement had previously been laid down at Sir *W. Worsley's*. If the mode of forming and laying the blocks had been precisely similar to the plaintiff's that would have been a sufficient user to destroy the patent, though put in practice in a spot to which the public had not free access. The pavement laid down at *St. Petersburg* unquestionably was of such a description, and the user was of an extent that, if it had existed in *England* prior to the grant of the letters patent, would have rendered them void. Then has it been generally known and published? I think those words mean different things. 'Generally known' means known to the public generally, or at least to that portion of the public whose attention is turned to such matters. But 'published' means offered or dedicated to the public. Was the invention published or offered to the public to such an extent as that it was generally known amongst engineers and persons likely to take an interest in such a matter? His Lordship then referred to the judgment of the Court of Common Pleas in *Stead v. Williams* (8 Scott N.R. 472), stating that he should adopt the law as there laid down, and continuing:—It will be for you to say whether Mr. *Heard*, who clearly first brought the knowledge to *England*, by the communication made to him by the scientific body, made a present of it to the public so as to prevent an individual from appropriating it to himself by taking out a patent for it. If you are of that opinion, your verdict must on the fifth issue be for the defendant. Verdict for defendant on 1st and 5th issues, and for plaintiff on remaining issues.

Rule nisi for a new trial, on the ground of misdirection and that the verdict was against the evidence, discharged by the Court of Common Pleas. (Wilde, C.J., Coltman, Maule, Crosswell, JJ.)

Per WILDE, C.J.—We are of opinion that there was no evidence to justify a jury in finding that there had been an infringement. It may be observed that in *Heath v. Unwin* (13 M. & W. 583) the Court of Exchequer seems to have deemed it material to consider the intention of the defendant in determining whether he had infringed a patent. But in that case the evidence negatived any such intention, and the other circumstances of the case were not such as to show an infringement, so that there was no decision as to what the effect of such intention would be. And we think it clear that the action is maintainable in respect of what the defendant does, not of what

he intends. It appears, that the proper direction was that the verdict should be for the plaintiff on the 5th plea, inasmuch as there was no evidence of user; but as the publication given in evidence was clearly before the plaintiff's invention, it sustained the 2nd plea, that the plaintiff was not the true and first inventor. We discharge the rule, on the defendant consenting that the verdict shall (if the plaintiff think fit) be entered for the defendant on the 2nd plea, and for the plaintiff on the 5th.

STEINER *against* HEALD, A.D. 1851. 2 Car. & K. 1022; 6 Ex. R. 607.

Subject-matter of a Patent.

CASE for the infringement of a patent of 8th Aug. 1843, No. 9,860, to *F. Steiner*, for 'a new manufacture of a certain colouring matter, called *garancine*.' Pleas: 5. That the alleged invention was not any manner of manufacture. 6. That it was not a new manufacture of *garancine*. Issue.

The patent related to a method of extracting the colouring matter from a refuse substance, known as 'spent madder,' which remained in dye-baths after the cloths had taken up as much colouring matter as they could absorb. The spent madder was treated with sulphuric acid and steam, whereby a substance termed *garancine*, containing the whole colouring power of the *residuum*, was extracted. *Claim*: 'The manufacture, hereinbefore described, of the colouring matter, called "garancine," from madder, which has been previously used in dyeing, and which is usually called spent madder.'

At the trial, it appeared that, in the ordinary process of dyeing calico, the bath containing madder was raised to a boiling temperature, whereby a large proportion of the colouring matter was extracted. Also, that before the date of the patent, *garancine* had been made from fresh madder by the action of sulphuric acid at a boiling temperature; the process of extracting *garancine* from fresh madder being substantially the same as that patented. The effect of the acid was to dissolve some of the earthy matter in the substance and to set free the whole of the colouring agent.

In reply to counsel, POLLOCK, C.B. said:—'In my opinion it is not a new manufacture. *Garancine* produced from spent madder is the same thing as *garancine* produced from fresh madder. The process is perfectly old; the product is perfectly old; the thing upon which the process is to be applied is old; indeed I do not see any novelty in the invention at all. There is no magic in calling this "spent madder." It is madder which has undergone a process by which the whole of its virtues are not extracted.' His Lordship then ruled that in point of law, upon the 5th plea, he ought to direct the jury 'that

the invention was not a new manufacture within the statute. Verdict for defendant on 5th and 6th issues.

Error on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber.

Per PATTESON, J.—We are all of opinion that there must be a *venire de novo* in this case. Here is no new contrivance, for the process used under the plaintiff's patent with 'spent madder' is the same as that previously used with 'fresh madder;' neither is the product new, for the garancine produced from the one and the other appears to have precisely the same qualities. If, therefore, the patent be good, it must be on account of the old contrivance being applied to a new object under such circumstances as to support the patent. Now, 'spent madder' might be a very different thing from 'fresh madder' in its properties, chemical or otherwise. Or it might be, in effect, the same thing, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical or otherwise, of both, might or might not have been known to chemists and other scientific persons, so that they could tell whether 'fresh madder' and 'spent madder' were different things, or substantially the same thing. We think that the learned judge was wrong in treating the conclusion to be drawn from the evidence as matter of law, and that the exception is well pointed in treating it as a matter of fact which should have been left to the jury, with such observations, of course, as the learned judge might think proper to make for their assistance.

STEVENS *against* KEATING, A.D. 1847-8. 2 Phill. 333; 2 Ex. R. 772; [2 Webs. Pat. Ca. 175; 1 Mac. & G. 659.]

Practice in Patent Suits. Sufficiency of Specification. Costs.

Suit to restrain from infringing a patent of 8th Oct. 1834, No. 6,688, to *R. F. Martin*, for 'a certain process of combining materials so as to form cements, and for the manufacture of artificial stones, marble, and other like substances;' and likewise a patent of 2nd June, 1840, No. 8,528, to *R. F. Martin*, for 'improvements in the manufacture of cement.' Injunction granted, but subsequently dissolved on the ground of delay. Account ordered, with action at law. On action brought, defendant pleaded:—1. Not guilty. (And as to first patent) 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlsh in water, and then adding sulphuric acid in

sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated:—
 ‘Other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth.’ *Claim*:
 ‘The processes of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning, heating, or calcining the same, for the purposes hereinbefore set forth.’

At the trial, it appeared that the alleged infringement consisted in the use of borax, a compound of boracic acid and soda, in substitution for sulphuric acid and potash. Also it was proved that *nitric acid* would not answer for making the cement. It was objected that the patent was for a process, and not for a product, and that the specification was bad; but POLLOCK, C.B. observed:—‘In one sense, an old substance produced by a new process is a new manufacture; of that there can be no doubt. . . . Although I think this is a patent for the process rather than the product, I think it may be a patent for the product. But, whether it be the one or the other, the objection, I think, takes the same shape—namely, is the process sufficiently described? . . . If the patentee had simply said, I perform my operation in such a way, and had then left it to the ordinary protection which the verdict of a jury generally throws round an honest invention, honestly stated, I think in all probability the specification might have been free from objection; for if any other person had used *borax* as a salt, which is composed of boracic acid and soda, and that had been found to answer, it would have been a fair question for the jury, whether there had not been a colourable imitation of the process invented by the patentee, and whether the person complained of had not in reality been travelling the same road, ploughing with his heifer, and, in substance, using his invention.’

His Lordship then directed the jury:—Some observations have been made at the bar on the subject of patents and specifications, and the different rules of construction that have been maintained at different periods. I take the rule to be that you are not to intend anything in favour of a specification or a patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result.

His Lordship directed a verdict for defendant on the 4th issue. Verdict for plaintiff on remaining issues. Leave reserved.

(2 Ex. R. 772.) Rule to enter a verdict for plaintiff on the 4th

issue, refused by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.)

Per POLLOCK, C.B.—The question is, whether the specification be good or not. Only one alkali (potash) and one acid (sulphuric) are mentioned in the specification, but manifestly the inventor does not confine himself to these; if he did, the defendant would be entitled to a verdict on the plea of not guilty, for he has used neither. To what extent, then, does the claim go beyond the alkali and acid named? If it be a claim of all acids and alkalis, it is clearly bad, as there are some that will not answer the purpose. If it be a claim of those only which will answer the purpose, it is as clearly bad, in consequence of not stating those which will answer the purpose and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not; and this was expressly so determined by the Court of Queen's Bench in *Rex v. Wheeler* (2 B. & Ald. 345), where they say that a specification which casts on the public the expense and labour of experiment and trial is bad. In any view, therefore, this specification is defective.

(1 Mac. & G. 659.) Appeal petition, by two of the defendants, that, after dismissal of the bill, the costs of the motion for injunction should be paid by plaintiff.

LORD COTTENHAM, L.C. made the order, and said:—‘The injunction is the only object of the cause, and getting the costs of the cause without the costs of the motion for the injunction would be practically getting nothing.’

STOCKER *against* ROGERS, A.D. 1843. 1 Car. & K. 99.

Practice as to Certificate for Costs.

CASE for the infringement of a patent. Pleas: 1. Not guilty. 2. That the invention was not new. 3. That the specification was insufficient. Issue.

At the trial, no evidence was adduced, and a verdict was taken by consent for plaintiff, with 40s. damages. ERSKINE, J. refused to certify that the validity of the patent came in question, and said:—‘I think that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties, and it would be possible in a case like the present for two parties, by collusion, to consent to a verdict in favour of a patent, and, if they could obtain a certificate under stat. 5 & 6 Will. IV. cap. 83, sect. 3, to use it afterwards to the injury of another person who was really contesting the validity of the patent.’

STURTZ *against* DE LA RUE, A.D. 1828. 5 Russ. 322.

Sufficiency of Specification. Title of Patent.

Suit to restrain from infringing a patent of 14th Feb. 1827, No. 5,463, to *J. G. Christ*, for 'improvements in copper and other plate printing.'

The patent related to a method of preparing a glazed surface on paper by coating it with a mixture of white lead and size, before the application of pressure. The specification stated that the white lead used should be the finest and purest chemical white lead. *Claim*: 'The glazing and enamel hereinbefore described, applied to paper or cardboard in the manner hereinbefore described for the purpose of copper and other plate printing.'

It appeared that ordinary white lead would not answer the purpose; but that a purer material, imported from *Germany*, and sold at one particular shop in *London*, would produce the required effect.

Per LORD LYNDHURST, L.C.—The title for this patent is for 'improvements in copper and other plate printing.' Copper-plate printing consists of processes involving a great variety of circumstances: an improvement in any one of these circumstances—in the preparation of the paper, for instance—may truly be called an improvement in copper-plate printing. In this case the principal part of the improvement relates to the preparation of the paper. It is material to the perfection of copper-plate printing that the lines should be as distinct as possible; and if by adding anything to the surface of the paper more clearness is given to the lines, that is an improvement in copper-plate printing.

It is a principle of patent law, that there must be the utmost good faith in the specification. It must describe the invention in such a way, that a person of ordinary skill in the trade should be able to carry on the process. Here the specification says that there is to be added to the size certain proportions 'of the finest and purest chemical white lead.' A workman would naturally go to a chemist's shop and ask for 'the finest and purest chemical white lead;' the answer which he would receive would be, that there was no substance known in the trade by that name. It appears to me that this specification does not give that degree of full and precise information which the public has a right to require.

SWINBORNE *against* NELSON, A.D. 1852-3. 16 Beav. 416.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing a patent of 24th Nov. 1847, No. 11,975, to *G. P. Swinborne*, for 'improvements in the manufac-

ture of gelatine.' For an action at law in this cause, see *Wallington v. Dale* (7 Ex. R. 888).

The bill interrogated defendant respecting his dealings and transactions, and sought an account of profits made by the infringement. Defendant, who had obtained prior patents for the manufacture of gelatine, answered that he had worked under a patent of his own, and not under that of plaintiff, and submitted that he was not bound to furnish an account of articles so manufactured. He also denied plaintiff's title. ROMILLY, M.R. said that defendant must answer the interrogatories, notwithstanding that he rested his defence on a denial of plaintiff's title. No costs given to either side.

TALBOT *against* LAROCHE, A.D. 1854. 15 C.B. 310.

Particulars of Breaches.

CASE for the infringement of a patent of 8th Feb. 1841, No. 8,842, to *W. H. F. Talbot*, for 'improvements in obtaining pictures or representations of objects.' The particulars of breaches delivered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 43, charged infringement generally by selling pictures; and further stated:—'That one of such pictures was made and sold by defendant to one *A. H. C.*, on 27th April, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements.'

Rule for the delivery of further and better particulars, refused by the Court of Common Pleas.

Per JERVIS, C.J.—I am of opinion that the defendant is not entitled to any further or better particulars in this case. Under a plea of want of novelty, the Court requires the particulars of objections to condescend upon particular instances. But that is very different from this case; the matter there is not in the knowledge of the patentee. But the defendant must know whether, and in what respects, he has been guilty of an infringement.

TAYLOR *against* HARE, A.D. 1805. 1 B. & P. N.R. 260; }
1 Webs. Pat. Ca. 292. }

The Licensee of a void Patent cannot recover back Payments.

Action for money had and received. Verdict for 425*l.* subject to a case stated for the opinion of the Court. It appeared that defendant obtained a patent on 12th Sept. 1791 (No. 1,826) for an invention of an apparatus for preserving the essential oil of hops in brewing. By agreement, reciting the grant of the patent, defendant licensed plaintiff to use the invention. Plaintiff worked under the licence for several years, and paid sums of money amounting to 425*l.* The

invention turned out not to be new, but the patent was not repealed. Judgment of nonsuit by the Court of Common Pleas. (Mansfield, C.J., Heath, Rooke, Chambre, JJ.)

Per MANSFIELD, C.J.—In this case, two persons, equally innocent, make a bargain for the use of a patent, the defendant supposing himself to be in possession of a valuable patent right, and plaintiff supposing the same thing. Under these circumstances, the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat* what advantage he made of it; for anything that appears he may have made considerable profit. These persons may be considered, in some measure, as partners in the benefit of this invention. In consideration of a sum of money, the defendant permits the plaintiff to make use of this invention, which he would never have thought of using had not the privilege been transferred to him. How then can we say that the plaintiff ought to recover back all that he has paid? I think that there must be judgment for the defendant.

Per HEATH, J.—We cannot take an account here of the profits. It might as well be said, that if a man lease land, and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land.

Per CHAMBRE, J.—The plaintiff has had the enjoyment of what he stipulated for.

TEMPLETON *against* MACFARLANE, A.D. 1848. 1 H.L. Ca. 595.

Failure of Novelty in Part of an Invention.

Suit, in *Scotland*, for the infringement of a *Scotch* patent of 17th July, 1839, to *T. Templeton* and *W. Quigley*, for ‘an improved mode of manufacturing silk, cotton, woollen, and linen fabrics.’ *Claim*: ‘The method of preparing stripes of silk, cotton, &c., so that both cut edges of each stripe shall be brought up on one side and in close contact; *and*, the re-weaving such stripes, with the whole fur or pile uppermost, into the surfaces of carpets, rugs, &c.’

At the trial, it appeared that the method of preparing the stripes was not new; whereupon LORD ROBERTSON directed the jury that proof of a separate prior public user of one part of the invention—viz., the method of preparing the stripes—would not suffice to invalidate the patent. Verdict for the pursuer. Error, on bill of exceptions to this ruling. Exceptions allowed by the Court of Session. On appeal to the House of Lords, judgment affirmed, with costs.

Per LORD COTTENHAM, L.C.—If I am right, the judge at the trial mistook the law in supposing it to be immaterial whether all the

invention, or only part of it, was new; and whether, part only being new, the patentee appeared by his specification to claim the whole.

TETLEY *against* EASTON and AMOS, A.D. 1852-7. Macrory Pat. Ca. 48; }
 2 E. & B. 956; 18 C.B. 643; 2 C.B. N.S. 706. }

Novelty of Invention. Subject-matter of a Patent. Evidence of Infringement. Sufficiency of Specification.

CASE for the infringement of a patent of 11th Feb. 1846, No. 11,081, to C. Tetley, for 'improvements in machinery for raising and impelling water, and other liquids, and also thereby to obtain mechanical power.' Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 4. That it was not new. 5. That the specification was insufficient. Issue.

The patent related to a form of centrifugal pump for raising water. The specification described the apparatus by reference to drawings, and showed a hollow wheel mounted on a horizontal axis, and having a central chamber or nave with radial arms projecting therefrom, like the spokes in an ordinary carriage-wheel. The arms were straight tubes fitted with collapsible valves at the ends. The nave was divided into two parts by a plate carrying the wheel and keyed to the driving shaft, the spokes being enlarged at their junction with the nave so as to allow the water to enter freely from either side of the plate. Two hollow shafts, one on each side of the wheel, formed channels for supplying water to the interior of the nave. When the wheel was in action the water entered simultaneously at both sides, and the central partition or disc caused the fluid pressure to become equalised. The wheel itself was mounted in an empty case connected with an exit pipe. The apparatus might be wholly immersed below the water to be lifted, but otherwise an air-pump was employed to suck water into the wheel and fill it before the rotation commenced. When the pump was to be used for forcing water to a higher level, the case was made air-tight and was filled with compressed air, so as to act like the air-vessel in an ordinary force-pump. The specification stated:—'And, generally, I propose to construct the wheel of every variety of configuration, so long as it is constructed to have a channel or channels in the interior thereof for the passage of liquids, and shall be adapted to neutralise the effects of suction, by having a corresponding degree of suction at each side; nor do I confine myself to a form or configuration, or manner of connecting together any other parts of the machine, but I propose to vary the same. Nor do I claim, in any way, the sole application of machinery for raising water by centrifugal force, except

only when the same is used as a means of introducing liquids into compressed air, as specified in my fifth claim.' *Claims*: 1. 'The means of neutralising the effects of suction at one side of the wheel by causing the same degree of suction at both sides thereof. 2. The means of increasing the action of the machine by causing the liquid to enter the wheel at both sides. 5. The construction of machinery for raising or impelling water, by introducing such water into compressed air or other suitable elastic fluid, and causing such compressed air, or other elastic fluid, to operate as the lifting power to impel such water upwards. 9. The application of the before-mentioned inventions, both when all used in combination or when used severally.'

At the trial, it appeared that the alleged infringement consisted in the use and manufacture of a pump known as *Appold's* centrifugal pump, which consisted of a hollow cylindrical box or wheel made up of two outside annular plates, placed parallel to an inside circular disc, which divided the wheel into two distinct parts. The outside plates were connected with the disc by curved blades, the result being that the centre of the wheel on both sides was perfectly open, as was also the circumference, and that there were free passages or channels from the centre to the circumference, the whole forming a divided wheel with an open nave and curved hollow arms. To set up the action, the wheel was immersed in water and rotated on a horizontal driving spindle, to which the central disc was keyed, whereby water entered freely at the central open spaces on each side, and was discharged into a separate chamber at the bottom of an exit pipe. By increasing the velocity of rotation a higher lift was obtained.

In directing the jury, POLLOCK, C.B. read the passage, 'Nor do I claim in any way the sole application of machinery,' &c.; and observed:—I think that these words, taken literally, would limit his claim to compressed air. It appears to me that there is some mistake in the passage, and that it is not consistent with the rest of the specification. I think we ought always to give effect to what a specification means; and if there is a mistake which can be corrected by another part of the specification, I think we are bound to make that correction.

We are also bound to oppose in every possible degree, where the case calls for it, the endeavours to make a patent grasp at and embrace a number of matters that never were in the head of the inventor. It is very likely that Mr. *Tetley* had not in his mind, at the time when he took out his patent, any idea of using bent arms. If he had, there is no doubt that his patent was worth nothing,

because he did not, in his specification, give the public the full benefit of it. A man has no right to patent a principle, and then to give the public the humblest instrument that can be made from his principle, and reserve to himself all the better parts of it, and to box up his improvements, and say to the world, 'You are at liberty to use the straight arm if you like, it will be of very little use;' and if you believe the testimony of one of the witnesses to-day, it would not do more than one-third of the work. Then what is the patent worth without the curved arms? He says: 'I claim every possible shape in which it may be used hereafter.' I do not think that can be done. What you have to decide is, where you think the principle is to be found which *Appold* used. I think all the rest is matter of law. Verdict for defendants.

The patentee then disclaimed a part of his invention, excising, *inter alia*, the part of the title printed in italics, and particularly the sentence commented on in the direction of the learned judge—viz., '*and generally I propose to construct the wheel of every variety of configuration;*' rejecting also claims 3, 4, 6, 7, 8, and omitting the words in the former 5th (now the 3rd) claim, which are printed in italics; but retaining claim 9 as being now claim 4.

(2 E. & B. 956.) Second action between the same parties for infringement of same patent after disclaimer. Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. Issue.

At the trial, defendants put in evidence the specification of a patent of 22nd March, 1841, No. 8,896, to *M. W. Ruthven*, and raised an objection that the specification was bad as describing and claiming the wheel, which was admitted to be old. WIGHTMAN, J. directed the jury that this was a fatal objection to the patent. Verdict for defendants on second and third issues.

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

Per LORD CAMPBELL, C.J.—It was proved, and is now admitted, that the wheel is not new. I am of opinion that there is nothing to show that the wheel is not comprehended in the claim. I do not think that the words of the disclaimer, which precede the four claims, amount to anything like a clear disclaimer of the wheel. But when we come to the third and fourth claims, we find that the wheel is directly claimed. As to the third, the wheel clearly is part of the 'machinery for raising and impelling water' into the compressed air; it does so 'in virtue of centrifugal force imparted thereto by such machinery.' His Lordship then referred to claim 4 (formerly claim

9), and said:—Had the wheel been new and the plaintiff been suing for the infringement of this patent by the mere use of such a wheel, this fourth claim would have furnished him with a most powerful argument to show that the patent was infringed.

Per COLERIDGE, J.—If a specification includes what is old, as well as what is new, the patentee must be taken to claim all, unless he clearly makes it appear that he does not claim that which is old. Here, among the things used as part of the machinery, is the wheel. Does he treat that as an old invention, such an invention as was too notoriously old to require disclaimer? On the contrary, we find an elaborate description of the wheel, and it is introduced into the patent as one of the things necessary to make up the machine.

(18 C.B. 643.) The patentee again disclaimed, giving up wheels of every form, and striking out all claims except the second.

Third action between the same parties for infringement of the same patent after second disclaimer. Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. Issue.

Plaintiff having obtained an order under stat. 17 & 18 Vict. cap. 125, sect. 51, interrogated defendants as follows:—7. State the names and addresses of the several persons to whom the centrifugal pumps (made by you between 21st *April*, 1855, and 5th *May*, 1856) have been sold, &c. 8. Where are or were the said pumps respectively in use or sent to be used. Rule to strike out these interrogatories, refused by the Court of Common Pleas, JERVIS, C.J. observing:—‘That the customers (of defendants) may be exposed to actions is no objection. If you admit the infringement, the plaintiff is entitled to the information he asks.’

(2 C.B. N.S. 706.) At the trial, plaintiff relied on the single claim now left in the specification, and defendants put in the specification of *Ruthven’s* patent before mentioned (No. 8,896). WILLES, J. was of opinion that plaintiff’s invention had been anticipated by *Ruthven*, and directed a verdict to be entered for defendants on 2nd and 3rd issues. Verdict accordingly. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the second and third issues, discharged by the Court of Common Pleas. (Cockburn, C.J., Cresswell, Crowder, Willes, JJ.)

Per CRESSWELL, J.—The form of the wheel used by the plaintiff was not new, nor does he claim it as new; nor was the plan of admitting water at both sides, for the purpose of being projected forwards by centrifugal force, new,—it having been made known by the specification enrolled by *Ruthven*, and the drawings annexed to it. It may be true that the plaintiff first explained the full benefit obtained

claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery in the drawings is composed.'

At the trial, defendant relied on the specification of the patent of *Fisher and Gibbons* (No. 10,424), above mentioned.

Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit on the ground, *inter alia*, of failure of novelty in the second claim of invention, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—Unfortunately the plaintiff seems to have thought that *Howe's American* machine (the invention he had purchased) was not only new in its general combination, but that all the subordinate parts of the general combination were likewise new. Accordingly, after the claim to the general combination, the plaintiff goes on to say, 'Secondly, I claim the application of a shuttle in combination with a needle,' &c. His Lordship read the whole claim, and continued:—In his disclaimer in 1855 he adds to this, 'But I do not claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery shown in the drawings is composed.' This, however, as far as claim No. 2 is concerned, is only a disclaimer of the use in a machine of a plurality of needles and shuttles.

We think that upon the plaintiff's second claim a question of law arises for the Court, and that we are bound to decide whether the subordinate combination described in the plaintiff's second claim is disclosed by *Fisher and Gibbons's* specification. We by no means lay down, as a general rule, that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a question of law for the Court. The specifications may contain expressions of art and commerce, upon which experts must be examined, and there may be conflicting evidence, raising a question of evidence to be determined by the jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively, for the two specifications might be, *in ipsissimis verbis*, the same; and if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents.

In the present case the important point for us to consider is, what is the extent of the plaintiff's claim, No. 2? Is it confined exclusively to the single application of a shuttle in combination with a needle as shown in sheet 1, or does it extend generally to the

application of a shuttle with a needle 'for forming and securing loops of thread or other substance for the purpose of producing stitches either to unite or ornament various fabrics?' We put the latter construction upon the words, considering that the application is shown in sheet 1 by way of example.

The specific claims with which *Fisher* and *Gibbons* sum up their specification, appear to us to include the plaintiff's claim No. 2, although the particular application of a shuttle in combination with a needle shown by him in sheet 1 is not by them expressly described or delineated. Therefore, if the plaintiff's claim, No. 2, be general, as we construe it to be, *Fisher* and *Gibbons's* machine, if posterior to it, would be an infringement, and, being anterior, disproves the novelty of the invention.

Error brought in the Court of Exchequer Chamber. (Pollock, C.B., Williams, Crowder, Willes, JJ., Bramwell, B.) Judgment affirmed.

Per POLLOCK, C.B.—I am of opinion that the judgment of the Court of Queen's Bench is right, and that claim No. 2 is to be read as claiming something more than that which is in fig. 1. I agree that we are to construe the specification '*ut res magis valeat quam pereat*,' but still we are bound to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter, which may very much control the judgment to be formed. It is clear that the patentee did not mean to confine himself in the manner Mr. *Bovill* invites us to construe the claim. *A needle and a shuttle* do not mean *the needle and shuttle in the specification*, but extend to other needles and other shuttles. That which is at the end of the second claim makes this still more evident, and puts it beyond a doubt, 'whatever may be the means of working such shuttle and needle when employed together.' Unless we can see that there are no possible means of working a needle and shuttle other than that comprised in sheet 1, and the description of sheet 1, the patent cannot be sustained. The needle and shuttle are avowedly not new; then how can a claim of every possible mode of working a needle and shuttle together be sustained?

Per WILLIAMS, J.—The construction put upon the claim by the Court of Queen's Bench is strengthened by the disclaimer, which is in exact accordance with its being a general claim.

THOMAS *against* HUNT, A.D. 1864. 17 C.B. N.S. 183.

Rights of Vendee of Licensee.

CASE for the infringement of a patent for improvements in the manufacture of soap. Plea (in substance). That the alleged in-

fringement was the resale by defendant of soap purchased by himself from licensees of plaintiff. Demurrer and joinder.

Judgment for defendant by the Court of Common Pleas.

Per WILLIAMS, J.—The vendee of the licensee has all the privileges of a vendee, including that of selling again. The very object of the licence would be frustrated if this were not so.

THOMAS *against* WELCH, A.D. 1866. L.R. 1 C.P. 192.

Variance between the Provisional and Complete Specifications. Sufficiency of Specification after Disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 27th April, 1853, No. 1,026, to *W. F. Thomas*, for 'improvements in apparatus for stitching and sewing.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 7. That no specification was filed. 9. That the disclaimer extended the patent right. Issue.

The patent related to the invention of the so-called *four-motion* feed for sewing machines, consisting of an instrument which made four movements in producing a step by step feed of the fabric operated upon. This instrument held the work during the insertion of the needle, rose vertically, moved horizontally, and again descended so as to hold the work during the withdrawal of the needle. It then returned to its first position, and carried the fabric through the length of a stitch. The provisional specification stated:—'The improvements consist, *first*, in moving the work after each stitch by an instrument acting on that surface of the fabric which the needle enters. This instrument, *or another acting therewith*, acts to hold the work during the insertion of the needle, and again during its withdrawal. *Secondly*, in withdrawing the holding means from the fabric, whilst the needle is therein, to admit of any shifting thereof, and to facilitate the varying the direction of the next stitch.'

The complete specification contained drawings of sewing machines, with details of parts thereof, and concluded with five separate claims. On 3rd August, 1861, plaintiff excised all the claiming clauses by disclaimer, and the amended specification stated:—'*g* is the instrument by which the work is held during the insertion of the needle.' The construction and operation of *g* was then described, and three forms of it were shown—viz., (1) the instrument already mentioned; (2) an instrument made in two parts as shown; (3) an instrument in the form of a roughened roller which did not rise from the fabric. The specification continued:—'It is the arranging an instrument *g*, *as herein described*, which, while it is the means of holding the fabric during the insertion and withdrawal of the needle, is also the means

by which the step by step movement is given to the fabric or material for the succession of stitches, which constitutes *the* peculiarity of the invention.' The words in italics were inserted in the amended specification, the word '*the*' replacing the word '*another*' in the original specification. Verdict for plaintiff. Leave reserved.

Rule nisi to set aside the verdict (granted on sixteen different grounds of objection), discharged by the Court of Common Pleas. (Erle, C.J., Willes, Keating, Montague Smith, JJ.)

Per ERLE, J.—It is said that the complete specification is void because it omits some of the inventions put forward in the provisional specification. The provisional specification describes an instrument, and then says that '*this, or another acting therewith, acts to hold the work during the insertion of the needle.*' It is said that the complete specification contains nothing corresponding to this second alternative. Assuming that this is so, I do not think the objection ought to prevail. The difference is a slight one, and injured nobody; and it may be that the patentee had something in his mind when he filed his provisional specification, which he found afterwards would be useless. As he could not disclaim formally part of the provisional specification, he might, I think, in such a case as the present, have omitted it from his complete specification. It may be, however, that one form of *g* mentioned in the complete specification, which is in two parts, is what was referred to in the expression, '*and another acting therewith.*'

The real questions, however, are whether the patent is void for want of novelty, and whether there was any infringement, both of which depend on the construction of the specification. In dealing with such inventions I consider what was the mechanical contrivance in the patentee's mind, and what was the object he sought to gain thereby; and if the same object has previously been carried out by the same or similar means, the patent is void. It is necessary that the specification should state the object, and the means by which the patentee proposes to effect it; this is often done in the form of a claim, but here all the claiming clauses have been struck out by disclaimer. In the specification, however, he has declared what is the peculiarity of his invention; and it is the arranging an instrument, *g*, as herein described, which, whilst it is the means of holding the fabric, also moves it. The object of the invention is to show how the fabric can be at the same time held and moved, and it is always by means of *g*. The letter *g* stands for three instruments; but it is the mode in which *g* is used, both to hold and to move the fabric, which constitutes the peculiarity of the invention. Does the patentee then claim all instruments which at once move and hold the fabric? I

think not. Comparing the instrument with those in use before, I find it differs in several points, and there is considerable evidence that it was a really valuable improvement. If we take the invention to be the holding and moving the fabric at the same time, as therein described, by an instrument similar to *g*, I think it is clear that the defendant has infringed it, since his machines contain an instrument similar to *g*, producing substantially the same effects.

THOMPSON *against* JAMES, A.D. 1863. 32 Beav. 570.

Subject-matter of a Patent.

Suit, by assignees, to restrain from infringing a patent of 22nd July, 1856, No. 1,729, to *C. Amet*, for ‘improved means of distending articles of dress.’

The patent was for a flexible petticoat, known as a ‘crinoline,’ and the specification stated that the petticoat was composed of a sufficient number of hoops, made of watch-spring steel, and suspended at intervals by tapes or bands. *Claim*: ‘The exclusive use of steel springs in combination with suspending tapes or bands, made as hereinbefore described and forming a skeleton petticoat.’

Upon motion for injunction, ROMILLY, M.R. made no order, and said:—‘The patent seems to be a mere substituting of steel springs in the place where other elastic materials were used before. There is no invention, and nothing that can be called an invention, in that, and nothing which can properly form the subject of a patent.’

Plaintiffs then asked for an issue to try the validity of the patent, but his Honour said that he would find everything in favour of the plaintiffs which could be found for them by a jury if an issue were directed; still, he must determine, as a judge, that the substitution of steel wire for whalebone was not the subject of a patent. The application must be refused.

TROTMAN *against* WOOD and OTHERS, A.D. 1864. 16 C.B. N.S. 479.

Evidence of Infringement. Estoppel of Licensee.

Action for breaches by defendants of stipulations contained in a licence to them by plaintiff to use a patent of 20th April, 1852, No. 14,076, to *J. Trotman*, for ‘improvements in anchors.’ The declaration assigned as breaches (1) non-payment of royalties; (2) not accounting; (3) not marking certain anchors. Defendants traversed the breaches. Issue.

The patent related to improvements in an anchor patented in 1839, No. 7,774 (as to which see *Honiball v. Bloomer*, ante, page 179). The specification stated:—‘The improvements consist

(1) in forming or fixing the palm intermediate to the breadth of the arm; (2) in forming the horn wider than the arm; (3) in forming or affixing the palm of that class of anchor known as "*Porter's anchor*" at the back of the arm.' It then described the invention by reference to drawings, and showed two anchors, with arms movable on an axis, the palm being placed at an angle with the direction of the arm, and prolonged at one end so as to form a 'horn,' which was broader than the arm. In the first anchor the palm was so formed that part of the substance of the arm was on either side of it; whereas the second anchor had the palm altogether at the back of the arm. The specification concluded by stating:—'I am aware that it is not new to place the palm at the back of the arm of ordinary anchors; this part of the invention therefore consists in combining the fixing of the palms to the back of those arms of anchors which move on axes.' There was no separate claim.

At the trial, it appeared that the object of the invention was to obtain greater power of penetration and a better hold on the ground. Also, that it was not new to forge the palms at the back of the arms of anchors, when the same were fixed immovably to the shank.

It further appeared that defendants made anchors with arms movable on an axis, like *Porter's anchor*, with a palm at the back, and a horn of greater width than the arm, nearly identical in form with the patented anchor; but they forged the arm, palm, and horn all in one piece, whereas plaintiff's palm and horn were affixed to the back of the arm by a separate operation. ERLE, C.J. directed the jury:—That if the defendants adopted the plaintiff's plan in the form and position of the palms and horns, then the circumstance of the whole—arm, palm, and horn—being formed or welded in one piece, would not prevent its being a manufacture in accordance with the plaintiff's patent.

The jury found that the defendants' mode of placing the palm was the same as that described in the plaintiff's specification; but as to the horn, they could not agree.

Verdict for plaintiff for 130*l.* Leave reserved.

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

Per WILLES, J.—It is unnecessary to do more than consider whether the anchor constructed by the defendants be or be not within the specification, having regard to the position of the palm. I apprehend that the licensee of a patent invention, upon the ordinary terms of the licence which appear to have been adopted here, stipulates, not that the patent shall be a valid one in respect of the novelty, utility, and sufficiency of the specification; but that he

stipulates simply for leave to use that which is alleged to be the invention, admitting conclusively that such invention is new, useful, and properly specified. His Lordship then referred to *Hull v. Conder* (2 C.B. N.S. 22), and continued:—This specification must be read according to the ordinary rules of construction; and it does appear to me to claim the application to anchors having arms movable upon an axis, of palms at the back or outside of the arms; and that it is not necessary to constitute an infringement of this patent that another portion of the invention specified should also have been used, viz., the horn forming the palm. I think it is plain that there has been an infringement, and that the plaintiff is entitled to recover. This view of the case renders it unnecessary to enter into any other question.

Per ERLE, C.J.—I am of opinion that the patent was not for the mode of making the palm, but that it was for the form. I am of opinion that this patent was for forming the palm at the back of the arm. The whole value of the patent lay in this form. Mr. *Trotman* formed the palm separately, and then joined it on to the arm. The defendants have taken the identical form of anchor which Mr. *Trotman* specified, and have got the benefit of his invention; but they have made it by welding in one piece, instead of making the palm separately and joining it on afterwards. I think that was an infringement.

TURNER *against* WINTER, A.D. 1787. 1 T.R. 602; }
1 Webs. Pat. Ca. 77. }

Obligation in Specifying. A Patent which misleads is void.

CASE for the infringement of a patent of 26th Feb. 1781, No. 1,281, to *J. Turner*, for ‘a new invented method of producing a yellow colour for painting in oil and water, making white lead, and separating the mineral alkali from common salt, all by one process.’ Plea: Not guilty. Issue.

The specification stated (in substance):—‘Take any quantity of lead, and calcine it, *or minium*, or red lead, litharge, &c., add half the weight of sea salt, with water sufficient to dissolve it, *or sal gem*, or rock salt, or fossil salt, or any marine salt, and mix together by trituration. When the materials have been ground together and allowed to stand for twenty-four hours, the lead will be changed to a good white. The decomposition of the salt may also be produced by digestion or calcination. The alkali (caustic soda) is separated by the addition of water. The yellow colour is produced by calcining the lead, after the alkali has been separated from it, till it acquires the colour wanted, which will be of different tints

according to the continuance of the calcination or the degree of heat employed.'

At the trial, it was objected, on behalf of defendant:—(1) That *minium* would not answer if calcined only, but that it required to be fused. (2) That fossil salt was improperly mentioned, as there were several kinds of fossil salt, whereof one only, viz., *sal gem*, would answer. (3) That the substance obtained was not white lead (mainly a carbonate of lead), but a different product, viz., oxychloride of lead. BULLER, J. directed the jury that if any one of these objections were well founded, it would avoid the patent.

Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of King's Bench.

Per ASHURST, J.—It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary ambiguity affectingly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. If the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void.

Per BULLER, J.—In this case no evidence was offered by the plaintiff to show that he had ever made use of the several different ingredients mentioned in the specification, as for instance *minium*, which he had nevertheless inserted in the patent, nor did he give any evidence to show how the yellow colour was produced. If he could only make it with two or three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So if he makes the article, for which the patent is granted, with cheaper materials than those which he has enumerated, though the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit which he himself does.

As to the first objection, the specification should have shown by what degree of heat the effect was to be produced. The next objection was as to the salts. It was proved that *fossil salt* was a generic term including several species, and that *sal gem* was the only species of it which would answer the purpose. There was no contradiction on the third objection; for the most that the plaintiff's witnesses said was that following the specification the experiment only produced a white substance like white lead. On either of these grounds the patent is void. Because if the patentee says that by one process he can pro-

duce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant.

VIDI *against* SMITH and ANOTHER, A.D. 1854. 3 E. & B. 969.

Inspection and Account pending an Action.

CASE for the infringement of a patent for metallic barometers—viz., of 27th April, 1844, No. 10,157, to *P. Armand Le Comte de Fontainemoreau*, for ‘a new mode of constructing barometers’ (a communication from abroad).

Before trial of the action, plaintiff obtained a rule nisi for an account of profits made by the sale of metallic barometers since 1st Oct. 1851, and for an inspection of defendants’ books. The Court of Queen’s Bench (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.) discharged the rule for an inspection of books, and also for an account of profits before action, but made it absolute for ‘an account to be kept by defendants of all such barometers as they should sell upon the principle alleged by plaintiff to be an infringement of his patent and of all profits made therefrom’ until further order; on condition that plaintiff waived a claim to any but nominal damages, and undertook, if he failed in the action, to pay the costs of the account.

Per LORD CAMPBELL, C.J.—Before final judgment we ought not to grant any retrospective account. The inspection mentioned in stat. 15 & 16 Vict. cap. 83, sect. 42, is, we conceive, an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and does not refer to an inspection of books, which is provided for by another Act of Parliament. With regard to an account to be kept during the litigation, we are to see whether there is laid before us reasonable evidence of a valid patent, of this patent having been infringed by the defendants, and of the defendants making profits by the infringement. But we are of opinion that it should only be granted on the condition of the plaintiff waiving his claim to damages, for he ought not to be allowed to seek substantial damages and an account of profits, conjointly.

WALLINGTON *against* DALE, A.D. 1851–2. 7 Ex. R. 888.

Novelty of Invention. Sufficiency of Specification. Subject-matter of a Patent.

CASE for the infringement of a patent (in part disclaimed) of 24th Nov. 1847, No. 11,975, to *G. P. Swinborne*, for ‘improvements in the manufacture of gelatinous substances.’ Pleas: 4. That no sufficient specification was enrolled. 10. That the invention was not new. 11. That it was not a new manufacture. Issue.

The patent related to a method of manufacturing gelatine by

reducing the skin into shavings or thin slices by means of an instrument resembling a carpenter's plane. The specification stated:— 'That when gelatine was to be extracted, the shavings after soaking were to be subjected to heat, taking care that the heat applied should not exceed that of boiling water.' It also pointed out that heretofore it had been the practice to operate on large pieces of hides or skins, except in the case where the hides were reduced to pulp in a paper machine.

At the trial, defendant gave in evidence the specification of a patent of 23rd *March*, 1839, No. 8,010, to *G. Nelson*, for a process of extracting gelatine by scoring hides to a depth of one-eighth of an inch, in lines about one inch apart, and then macerating them in caustic alkali. It was objected that the mere cutting of a material into thin slices was not the subject-matter of a patent, and that the specification was defective in not stating whether the hides were to be cut in a wet or dry state, and further, in not stating the minimum amount of heat to which the shavings were to be subjected.

ALDERSON, B. left it to the jury to say whether the specification was reasonably sufficient, telling them that it must be such as to define the invention so that an ordinary and skilful workman might do it, and so as to limit the claim of monopoly, and not to embarrass the invention or operation of others.

Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial—on the grounds of misdirection by the learned judge in not telling the jury that the cutting a material into thin slices or shavings was not the subject of a patent, and also that the learned judge was incorrect in leaving to the jury the question as to sufficiency of the specification, which was a point of law, and that the verdict was against the evidence—discharged by the Court of Exchequer.

Per POLLOCK, C.B.—It appears to us that the plaintiff's process was new and different from any other described in the specifications given in evidence, and that it was indisputably useful. We think also that the ground of misdirection fails, and that the case was properly left to the jury.

WALTON *against* POTTER and HORSEFALL, A.D. 1841. 3 M. & G. 411;]
1 Webs. Pat. Ca. 585.]

Novelty of Invention.

CASE for the infringement of a patent of 27th *March*, 1834, No. 6,584, to *J. Walton*, for 'improvements in cards for carding wool, cotton, silk, and other fibrous substances.' Plea 3. That the invention was not new. Issue.

The patent related to a method of constructing cards for carding wool, cotton, &c. The specification described a mode of slicing sheets of indiarubber from a block by means of a sharp knife. The sheets were then cemented to linen cloth, and wire dents were inserted. In some cases the linen cloth was cemented between two sheets of indiarubber. *Claim*: 'The application and adaptation of indiarubber as the fillet sheet or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described.'

At the trial, defendant gave in evidence the specification of a patent of 15th *March*, 1825, No. 5,120, to *T. Hancock*, for a patent leather which was made as follows:—A piece of cotton cloth was stretched on a board and coated with a compound of indiarubber and glue. It was then covered with a layer of carded cotton, upon which a fresh coating of the compound was spread. A second piece of cloth was placed over all, and the material was compressed between plates of metal passed through rollers, thereby forming the patent leather.

At the trial, TINDAL, C.J. directed the jury:—Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right. There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbour's book, for he must be contented to rest upon his own skill and labour for the discovery, and he must not avail himself of that which had before been granted exclusively to another.

Verdict for plaintiff.

Rule nisi for a new trial, or to arrest the judgment on the ground that the invention was not the subject-matter of a patent, discharged by the Court of Common Pleas. (Tindal, C.J., Coltman, Erskine, Maule, JJ.)

WALTON *against* BATEMAN, A.D. 1842. 1 Webs. Pat. Ca. 613.

Prior experimental User. Sufficiency of Specification.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That the invention was not new. 3. That it was not a new manufacture within the statute. 4. That the specification was insufficient. Issue.

At the trial, it appeared that the alleged infringement consisted in forming the backs of cards by cementing together several pieces of cloth, with a layer of indiarubber cement between each. Also that a small quantity of *Hancock's* patent leather had been supplied to certain manufacturers, for the purpose of making card backs, between *July*, 1826, and *Dec.* 1827, but not subsequently.

CRESSWELL, J. directed the jury:—Even supposing that the article (*Hancock's* patent leather) did embody the principle of the plaintiff's, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature of an experiment than of any public use of the article, so as to deprive the plaintiff of the fruit of this discovery in respect of this manufacture. His Lordship then referred to the question as to the sufficiency of the specification, and continued:—It is a question for the jury whether the plaintiff has given such a description of his invention, and of the manner of carrying it out, as will enable a workman of competent skill in that line of business to act upon it. And he further said:—I will point out to you what has been the general rule on the subject of these specifications, to show what information a person must give to the public, because if a man knows a better mode than that which he states to the public, that would be very unfair and wrong, and his patent would be vitiated by it.

Verdict for plaintiff.

WALTON *against* LAVATER, A.D. 1860. 8 C.B. N.S. 162.

Assignment of Patent in separate moieties. Evidence of Infringement. Estoppel. Account.

CASE for the infringement of a patent (in part disclaimed) of 7th *Jan.* 1858, No. 23, to *M. L. J. Lavater* (defendant), assigned to plaintiff, for 'the application of the principle of exhausting air for fixing pegs to solid surfaces.' Plea: Not guilty. Issue.

The amended specification stated:—'My invention consists in the application of the principle of pneumatics to cause pegs to adhere mechanically on solid surfaces, such as glass, walls, panels, and furniture.' The principle was that of the common sucker. The base of a peg was cup-shaped and was covered with a flat disc of indiarubber.

On pressing the peg against a smooth surface, and then pulling out the centre of the disc by means of a screw, a vacuum was formed underneath the cup, and the atmospheric pressure held the peg *in situ*. The specification described the construction of the pegs, and the *modus operandi*, without referring to any drawings. There was no separate claim.

At the trial, it appeared that articles called 'plate-holders,' wherein the same principle of exhaustion was applied in the same manner, had been in common use before the date of the patent. Such plate-holders were used by photographers in manipulating glass plates. Also that defendant had assigned one moiety of his patent to plaintiff, and the remaining moiety to other parties, D. and G., who had subsequently assigned their share to plaintiff.

The alleged infringement consisted in the importation from *France* of the patented articles, and in the sale of the same in *London* and elsewhere in *England*. BYLES, J. directed the jury:— That the defendant, having sold the patent, and received the purchase-money, could not be allowed to say that the invention was not new, and he directed a verdict for plaintiff with nominal damages, reserving the point whether certain pegs called 'plate-holders' were within the description of the specification. Verdict for plaintiff.

Rule for a new trial, on the ground that the assignee of two separate moieties of a patent was not entitled to sue for an infringement, refused by the Court of Common Pleas.

Per ERLE, C.J.—As to the point—that the plaintiff, being the assignee of the two moieties of the patent, is not entitled to sue for an infringement in the same manner as he would have been if he had taken the whole interest in the patent under one assignment—we are of opinion that the assignment to the plaintiff of that partial interest, under the deed of 1858, made the plaintiff in effect tenant in common with the defendant of the entirety of the patent; and that, the defendant having afterwards assigned the remaining moiety to D. and G., when D. and G. assigned to the plaintiff in 1859, the plaintiff became assignee of the whole patent, as if the original assignment to him from the defendant had comprised the whole.

Rule nisi to enter a verdict for defendant—on the grounds that the patent was not wholly vested in plaintiff; and that the sale of articles imported from abroad was not an infringement; and for a new trial on the ground of misdirection—discharged by the Court of Common Pleas. (Erle, C.J., Keating, Byles, JJ.)

Per ERLE, C.J.—I think the law will be much better laid down as we lately, whether rightly or wrongly, held in *Dunncliff v. Mallet* (7 C.B. N.S. 209), that an assignee, whether of the entirety of a

patent, or of a part or share in it, takes the legal interest, and is not to be considered merely as a licensee.

The next point contended for is, that the mere sale of articles imported from abroad is not an infringement of the patent, though the making of them would be. The words in the statute of James are *working or making*. In the granting part of the letters patent the words are 'make, use, exercise, and vend;' in the prohibitory part, 'make, use, or put in practice.' All these words are susceptible of some of the constructions which have been contended for; but it appears to me to be clearly the intention of the Crown, in granting letters patent for a new invention, to prohibit and prevent third persons from using the patent article for the purpose of profit by selling. The object is to give to the inventor the profit of his invention; and the most effectual way of defeating that object would be the permitting others to derive from the sale of the patented article the profit which it was intended to secure to the patentee. It seems to me, therefore, that proof that a party has sold the patented article, without proof of his having made it or procured it to be made, would be good evidence to warrant a jury in finding that he has been guilty of an infringement. As to the circumstance of the goods having been imported from abroad, I should say, that if this were simply the case of an importation, without any proof of knowledge on the part of the importer that the article imported was a patented article, the mere sale would be sufficient to charge him. But it is unnecessary to lay that down here, for the defendant acted with full knowledge: he has imported articles with his own name stamped on them as the maker, which he well knew to be a violation of the patent.

As between these parties, the defendant, who has received a large sum for the sale of this patent, ought not to be allowed to raise any question as to its validity.

Per BYLES, J.—As to the selling patented articles not being an infringement—I will not say a word as to the principle, but upon authority the matter stands thus—there is no authority to show that it is not, and there are two distinct authorities to show that it is. In the case of *Minter v. Williams* (4 A. & E. 251) every one of the learned judges gave his judgment on the ground that exposing for sale was not selling, which leads to the inference, as clearly as if it had been expressed in words, that in their opinion a vending or selling of the patented article is an infringement of the patent.

Order made (under stat. 15 & 16 Vict. cap. 83, sect. 42.) for an account of all profits of which plaintiff had been deprived by means of the infringement by the defendant of the letters patent, and that defendant do pay to plaintiff the amount of such profits.

WATSON *against* PEARS, A.D. 1809. 2 Campb. R. 294; }
 1 Webs. Pat. Ca. 154 n. }

Enrolment of Specification. Computation of Time.

CASE for the infringement of a patent.

At the trial, it appeared that the patent bore date the 10th of *May*, 1808, and contained the proviso that the specification should be enrolled 'within one calendar month next and immediately after the date thereof.' The specification was enrolled on the 10th of *June* following. LORD ELLENBOROUGH, C.J. held that this was a good enrolment, and said:—'The case cited upon the statute of enrolments (*Thomas v. Popham*, Dyer, 218 b; F. Moo. 40, s.c.) I think is expressly in point. That shows that the day on which the patent bears date is not to be reckoned.'

REX *versus* WHEELER, A.D. 1819. 2 B. & Ald. 345.

Variance between Title and Specification. Sufficiency of Specification.

Sci. fa. to repeal a patent of 28th *March*, 1817, No. 4,112, to *D. Wheeler*, for 'a new or improved method of drying and preparing malt.' The specification stated:—'My invention consists in the heating of malt to 400° Fahr. and upwards, so that the greater part of the saccharine and amylaceous principles of the grain become changed into an extractive matter of deep brown colour readily soluble in hot or cold water. A small quantity of the malt so prepared may be used as a substitute for the colouring agent made of sugar.' It went on to say:—'The proper degree of heat and the time of exposure will be easily learnt by experience, the colour of the internal part of the grain affording the best criterion.' The drawing showed, *inter alia*, an apparatus consisting of a hollow iron cylinder open at both ends, and having a screw-like channel withinside, whereby the grain was progressively carried forwards as the cylinder rotated, and was delivered when sufficiently heated. There was no separate claim.

At the trial, ABBOTT, C.J. was of opinion that the title of the patent showed that it was obtained for a different thing from that stated in the specification. Also that the title was defective in not stating the purposes to which the article, when prepared, was to be applied; and that the specification did not state the process with sufficient precision.

Verdict for the Crown.

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

Per ABBOTT, C.J.—The word 'manufacture' has been generally understood to denote either a thing made which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many

others; or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam-engine for raising water from mines. Or it may perhaps extend also to a new process, to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, is requisite to satisfy this word.

The defendant has represented himself to the Crown to be the inventor of 'a new or improved method of drying and preparing malt.' Then has the patentee by his specification shown himself to be the inventor of any method of drying or preparing this well-known article? For this we look at the specification; and we there find that he claims to be the inventor, not of a method of drying or preparing this well-known article, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree, viz., the qualities of being soluble in water, and colouring the liquor in which it shall be dissolved, which latter is the object in view. And this is to be effected by a second and additional process, the application of a very high degree of heat. We think the invention mentioned in the specification so entirely different from that mentioned in the patent, as that the latter (if any such there be) remains wholly undescribed and unspecified, and consequently that the issue could not be found for the defendant. His Lordship then commented on the specification, pointing out that it omitted to refer to the condition of the malt, the temperature of the heating process or the length of time it was to last, and said:—A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad. There is either no certain and clear process described, or the process described is such as might be practised without the assistance of the patentee.

WHITE *against* FENN, A.D. 1867. 15 W.R. 348; }
 15 L.T. N.S. 505. }

Evidence of Infringement. User of part of a Combination.

CASE for the infringement of a patent of 11th Jan. 1862, No. 83, to *J. White*, for 'improvements in oil-cans.' Plea: Not guilty. And other pleas denying the novelty and utility of the invention. Issue.

The patent related to an oil-can, in which an orifice leading to the spout was closed by a valve placed at one end of a lever of the first order, having a fulcrum near the centre. A spiral spring was attached to the top of the can, and fastened to the lever on the side removed from the valve, the valve being opened against the pull of the spring by means of a plunger pressing down one end of the lever. Each time that the plunger descended some air was let into the can. The specification described the invention minutely by reference to drawings, and showed the lever supported against the under side of a wire fastened to brackets, one on each side of the can. *Claim*: 'The exclusive right and title to the invention, the exclusive right to which is set forth in the outset (here referring to certain parts of the specification) of this my specification thereof.'

At the trial, it appeared that it was not new to have a valve in the spout of an oil-can closed by the action of a spiral spring upon a bell-crank lever connected with the valve and opened by a plunger, the same having been patented on 17th *July*, 1855, No. 1,604, by *A. Burdess*. The alleged infringement consisted in the use of a lever similarly supported by the aid of brackets and a cross wire, but having a lock spring underneath the lever instead of a spiral spring above it. The jury found that the invention was new, and that defendant had infringed by the use of the spring and brackets. KEATING, J. directed a verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the ground that there was no evidence of infringement, made absolute by the Court of Common Pleas. (Bovill, C.J., Willes, Keating, Montague Smith, JJ.)

Per MONTAGUE SMITH, J.—The patent was for a combination, and the alleged infringement was for parts of that combination only; and the plaintiff's verdict cannot be supported unless the particular parts of the invention alleged to be infringed were new. I think they were not. The plaintiff's case cannot be supported by proving an infringement of a limited character.

WHITE *against* TOMS, A.D. 1867. 37 L.J. Ch. 204.

Subject-matter of a Patent.

Suit to restrain from infringing a patent of 27th *April*, 1864, No. 1,055, to *J. White*, for 'improvements in ladies' mourning bonnet and hat falls.'

The patent related to a mode of making falls for mourning bonnets so that both sides were alike. The specification stated that a fold of crape was to be applied on both sides of a fall above the bottom fold, instead of on one side only as heretofore, and that the edges of the folds were to be pressed down so as to hide the stitches.

Claim: 'The forming both sides of ladies' mourning bonnet and hat falls alike by applying thereto the folds above the bottom fold on each side thereof as explained.'

MALINS, V.C. refused to grant an injunction, and said:—'Whereas formerly the fold was sewn on one side only, now it is sewn on both sides; so that whichever way it is turned it has a good side outwards. There is no invention in it. However meritorious as an improvement, which might probably have been registered for one or two years, it is not the subject of a patent.'

WILLIAMS *against* NASH, A.D. 1859. 28 Beav. 93.

Payment of Stamp Duty. Computation of Time.

Suit to restrain from infringing a patent bearing date 26th Feb. 1855. It appeared that a stamp duty of 50*l.* was paid on 26th Feb. 1858, and defendant insisted that the patent had lapsed. (See stat. 16 & 17 Vict. cap. 5, sect. 2.) ROMILLY, M.R. held that the payment of the stamp duty on the 26th of *February* was within time.

WILLIS *against* DAVISON, A.D. 1863. 1 N.R. 234.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 28th Feb. 1851, No. 13,538, to *H. Willis*, for 'improvements in the construction of organs.' Pleas: 2. That the invention was not a new manufacture. 3. That plaintiff was not the true and first inventor. 4. That the invention was not the subject of a patent. Issue.

The material part of the patent related to an invention for bringing certain stops under the command of the performer, so that he could effect the changes of putting them in or drawing them out without raising his hand from the keys of the instrument. For this purpose the stop was actuated by a separate bellows, called a *pneumatic lever*, an apparatus commonly used in organs, and supplied with compressed air from the main bellows. The specification contained a drawing of the apparatus, and described the pneumatic lever as connected with the stop. When the performer pressed a finger-key the lever was set in action by the opening of an ordinary flap valve; and when the finger was withdrawn the valve closed by a spring, and opened a *double-beat compensating* valve for the rapid escape of air. The object was to make a large opening with a small expenditure of force; and this was effected by constructing the escape valve of two discs, threaded on separate spindles, and attached to the opposite ends of a rocking-bar, whose fulcrum was outside the pneumatic lever. One disc moved inwards and the other outwards, and the pressure of the air was thereby balanced. *Claim*: 'The applica-

tion to pneumatic levers of the *improved escape valve*, whereby the reiterating power of the pneumatic lever is greatly increased. Also, the mode of arranging the pneumatic levers as above described.'

At the trial, it appeared that compound disc or balanced valves, threaded on one spindle, were commonly used in steam-engines, and were old. Also that, before the patent, a compound valve similar to plaintiff's had been fitted to pedal organs as a *supply* valve, in order to obtain greater ease in working; but it was admitted that the use of such a valve in combination with a pneumatic lever, as an *escape* valve, was new. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant on 2nd, 3rd, and 4th issues, made absolute by the Court of Queen's Bench.

Per CURIAM.—It appears that there was an old use of this invention for the purpose of easing the working of organ bellows. Our judgment, therefore, proceeds upon the ground that the novelty of the patent has been successfully impugned, and that the patent is bad.

WOOD *against* ZIMMER, A.D. 1815. Holt, N.P. 58.

Patent void for Concealment. Prior Public Sale.

Issue out of Chancery to try the validity of a patent of 20th Jan. 1812, No. 3,519, to *J. Zink*, 'for a new method of manufacturing verdigris.' Plea: Not guilty. Issue.

The specification stated that granulated copper and oil of vitriol, in certain proportions, were to be boiled together in a vessel of particular construction as described, and that the liquid was afterwards to be strained off and mixed with a solution of potash or soda.

At the trial, it appeared that *Zink* was accustomed to put *aqua-fortis* into the boiler, whereby the copper was dissolved more rapidly. Also, that four months prior to the date of the patent he sold, under the name of *Dutch Imperial Green*, a quantity of verdigris manufactured according to the process subsequently patented. GIBBS, C.J. directed the jury:—A man who applies for a patent, and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. If anything which gives an advantageous operation to the thing invented be concealed the patent is void. Now though the specification would enable a person to make verdigris substantially as good without *aqua-fortis* as with it, still, inasmuch as it would be made with more labour by the omission of *aqua-fortis*, it is a prejudicial concealment and a breach of the terms which the patentee makes with the public. To entitle a man to a patent, the invention must be new to the

world; the public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void.

His Lordship left two questions to the jury:—1. Whether *aqua-fortis* was used by the inventor as an ingredient in the verdigris? 2. Whether the invention was in public sale before the patent? In either case he thought the patent void. The jury found both questions in the affirmative. Verdict for defendant.

WREN and ANOTHER *against* WEILD, A.D. 1869. L.R. 4 Q.B. 213, 730.

Slander of Title relating to a Patent.

Action for slander of title. The declaration alleged that defendant falsely and maliciously wrote to and told persons who had bought certain machines of plaintiffs that the said machines were infringements of his (defendant's) patent, and claimed royalties for the use of the said machines, and threatened legal proceedings if they used the same without payment of royalties. Plea: Not guilty. Issue.

Rule nisi for defendant to deliver particulars of the alleged infringements of his patent, made absolute by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Hayes, JJ.)

Per CURIAM.—The defendant has driven the plaintiffs to take the initiative, and they ought to be in the same position as if the defendant had brought an action against them for the infringement of his patent.

At the trial, plaintiffs' counsel offered to prove that the specification of defendant's patent claimed matters that were not new; but LUSH, J. ruled that this evidence was immaterial, and directed a nonsuit.

Rule nisi for a new trial, on the grounds of rejection of evidence and misdirection, discharged by the Court of Queen's Bench. (Blackburn, Lush, Hayes, JJ.)

Per BLACKBURN, J.—We think that as soon as it was shown in evidence that the defendant really had a patent right of his own and was asserting it, the occasion privileged the communication, and the plaintiffs were bound to prove such malice as would support the action. But we think that, supposing everything had been proved which the evidence tendered could have proved, there would have been no case on which the jury could properly have found for the plaintiffs. We think the action could not lie unless the plaintiffs affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had; but a *malâ fide* and malicious attempt to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation.

WRIGHT *against* HITCHCOCK and ANOTHER, A.D. 1870. }
 L.R. 5 Ex. 37. }

Evidence of Infringement. Variance between complete and provisional Specifications. Subject-matter of Patent. Infringement by sale of Patented Articles.

CASE for the infringement of a patent of 19th Feb. 1862, No. 448, to *J. Willcox*, for 'improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein' (a communication from abroad). Defendants pleaded not guilty; that the invention was not new; and that it was not the subject-matter of a patent; and it should seem, although not stated in the report, that there was a further plea raising an objection on the ground of a variance between the complete and provisional specifications. Issue.

The provisional specification stated:—'The invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism,' &c. The complete specification stated:—'The invention relates to a peculiar manufacture of frills, ruffles, or trimmings, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same. The peculiarity is, that the frills are crimped in one direction transversely to the cloth in a perfectly even and regular manner, and are secured by stitches in lieu of the fabric being puckered or gathered in the ordinary manner.' It went on to describe the machine, which had a reciprocating knife for raising the folds, and a spring presser for turning them down and holding them until secured by the stitch of a sewing machine, which was incorporated into the apparatus. It further stated:—'Fig. 8 represents the kind of work produced by the machine.'

The drawing, Fig. 8, showed a double frill, the separate portions of which were secured on opposite sides of a narrow flat band, which itself was formed in flat plaited folds, and was made by the machine. *Claims*: 1. 'The general construction, arrangement, and combination of machinery, apparatus, or means for producing crimped or plaited frills or trimmings in a sewing machine, as hereinbefore described. 2. The application and use of a reciprocating knife for crimping fabrics in a sewing machine, as hereinbefore described. 3. The peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described, and illustrated by Fig. 8 of the drawings.'

At the trial, it appeared that the alleged infringement consisted in manufacturing plaits by a machine with a reciprocating knife (as patented on 4th Nov. 1867, No. 3,093, by *J. Orr*), which was described in the specification referred to as capable of 'folding plaits upon the surface of a roller, straight plate, or table,' but that the

plaits so made were not secured by a sewing machine. KELLY, C.B. ruled that the buying and selling by defendants of plaits made as stated was an infringement, if the manufacture by Orr's process was so. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants—on the grounds that the third claim was not the subject-matter of a patent; that there was a variance between the complete and provisional specifications; that there was no evidence of infringement; and for a new trial on the ground of misdirection—discharged by the Court of Exchequer. (Kelly, C.B., Martin, Pigott, BB.)

Per KELLY, C.B.—The first point made in this case is, that the patent in question is for a particular product, the result of manufacture, and not for a manufacturing process. The title of the patent describes it as being for the invention of 'improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein.' The specification relates entirely to the machinery, and contains from beginning to end nothing which could lead us to construe it as a specification of the articles manufactured. The third claim is in these words—'the peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described and illustrated by Fig. 8;' and, looking at the drawing, we find a double frill, or a middle plaited strip with a frill above and a frill below. But is it the kind of frill that is made the subject of the claim? On the contrary, it is the peculiar mode of manufacturing it, or the frill as manufactured by a reciprocating knife. Therefore, whether we look at the title of the patent, the specification, or the claim, the patent is not for the article manufactured, but for the mode by which the article described is brought into existence.

A second point was, that the manufacture includes the use of a sewing machine, or that it is a manufacture by means not only of a reciprocating knife, but of a sewing machine, without which unquestionably the complete article cannot be produced in the manner described. But, looking at the whole specification and claim, this is only pointed out as the best mode of completing the manufacture. The sewing machine is treated as an invention already in use, and it is separate and distinct from the mode of crimping or plaiting to which the plaintiff lays claim. This point, therefore, also fails.

A third point made is, that there is an inconsistency between the provisional and final specification, the word '*trimming*' being added in the latter. But by whatever name it is described, the thing is in substance identical.

The last point is, whether the selling by the defendants of articles manufactured by the plaintiff's process is an infringement. To de-

termine this, we must look at the words of stat. 21 Jac. I. cap. 3, sect. 5, which excepts from its nullifying operation patents for the 'sole making or working of any manner of new manufacture.' The statute does not contain the word '*vend*' which is found in the grants of patents, but we may have some regard to the constant usage according to which for 200 years patents have contained an express license to use and vend; and although the use of this word by the Crown is not conclusive upon the construction of the statute, it would be strange if for so long a time every patent should have purported to convey the exclusive right and interest if the grant were unauthorised. But, besides this, the authorities are clear and uniform, and are confirmed by the very recent case of *Elmslie v. Boursier* (L.R. 9 Eq. 217) before Vice-Chancellor James. I am clearly of opinion that if a man takes out a patent by means of which an article is made at a considerably less cost than the same article was before produced at, one who buys and sells such articles—I do not say on a single occasion, for each case must be determined on its own circumstances, but when he becomes, in the way of trade, a buyer and seller of quantities of such articles—knowing them to be manufactured by a machine which is *de facto*, though unknown to him, itself an infringement, such buying and selling is an infringement by him of the patent. It is impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the plaintiff's right, and it is immaterial whether it was or was not known to them that *Orr's* machine was identical with the plaintiff's.

YOUNG *against* FERNIE, A.D. 1863-6. 1 De G. J. & S. 353; }
4 Giff. 577; L.R. 1 H.L. 63. }

Novelty of Invention. Evidence of Infringement. Procedure in Prosecuting an Appeal to the House of Lords.

Suit to restrain from infringing a patent of 17th Oct. 1850, No. 13,292, to *J. Young*, for 'improvements in the treatment of certain bituminous mineral substances or matters, and in obtaining products therefrom.'

The patent related to a method of distilling paraffin oil. The specification stated:—'My invention consists in treating bituminous coals in such manner as to obtain therefrom an oil containing paraffin (which I call paraffin oil), and from which oil I obtain paraffin. The coals which I deem to be best fitted for this purpose are parrot coal, cannel coal, and gas coal.' It then described the process of distillation of the coal broken into small pieces and placed in a common gas retort, to which was attached a worm-pipe, passing through a refrigerator, kept at a temperature of about 55° Fahr. It

went on to say:—‘The retort, being closed in the usual manner, is then to be gradually heated up to a low red-heat, at which it is to be kept until the volatile products cease to come off; care must be taken to keep the temperature of the retort from rising above a low red-heat, so as to prevent the products being converted into permanent gas.’ The crude paraffin oil thus distilled or driven off as a vapour was condensed into a liquid in passing through the worm-pipe. The solid substance, paraffin, was separated from the oil by cooling to a temperature between 40° Fahr. and 30° Fahr. *Claim*: ‘Obtaining paraffin oil, or an oil containing paraffin, and paraffin, from bituminous coals by treating them in the manner hereinbefore described.’

The first step reported in this suit was an appeal from an order made by STUART, V.C. directing the trial of certain issues before the Court of Common Pleas. LORD WESTBURY, L.C. directed the cause to be restored to the paper of the Vice-Chancellor, to be heard in the ordinary way.

(4 Giff. 577.) The cause then came on for hearing before STUART, V.C. without a jury, on the following issues:—(1) Was plaintiff the true and first inventor? (2) Was the invention new? (3) Was the specification sufficient? (4) Had defendants infringed? A number of scientific and other witnesses were called on both sides, and it appeared that paraffin was discovered by Dr. *Reichenbach* in 1830, and was first obtained from beech-wood tar. Also, that plaintiff had found out that cannel coal, or other highly bituminous coal, was suitable for producing paraffin, but that the temperature should be much lower than that employed in the dry distillation of coal for gas-making, and should not rise above a low red-heat which was visible in the dark.

STUART, V.C. found in favour of plaintiff on all the issues, and granted an injunction and account, saying:—The main objection to the validity of the plaintiff’s patent is that both as to the process and material there is nothing new, and that the specification indicates nothing which was not publicly known and publicly used before the date of the patent.

It appears from the evidence that for very many years before the discovery of the substances now called ‘paraffin’ and ‘paraffin oils’ the distillation of coals and bituminous substances, at every variety of temperature, had been well known and practised for the production of tars and oils which had been used for lubrication of the ruder kinds of machinery and for burning. It is certain that *Reichenbach*, although he ascertained the existence of paraffin in coal, did not indicate coal of any kind as a material capable of producing paraffin or paraffin oils in most abundance. There is no evidence of any

specification, of any patents, or any publication in which cannel coal, or coal which produces olefiant and other illuminating gases in considerable quantity, was indicated as the class of materials among the wide range of animal, vegetable, and mineral substances which, subjected to a proper process, would produce paraffin and paraffin oils in large quantities so as to create a manufacture for commercial purposes, till *Young's* specification was published. Cannel coals had been tried by many, but without success. Among the many practical and manufacturing chemists who had been vainly attempting to find out how to manufacture paraffin oils and paraffin, so as to supply the market, none had been fortunate. The fair result of the immense load of evidence in this case shows the prevailing opinion to have been that not coals of any kind, but shales or schists properly so called, were the best material.

Referring to the scientific evidence on the part of defendants, his Honour observed:—Experiments conducted for the express purpose of manufacturing evidence for this cause are to be looked at with distrust; and in respect of the evidence adduced to prove that ‘boghead coal’ was a shale, and that all cannel coals were shales, his Honour regarded it as unimportant. He then continued:—On the question of infringement, as well as with reference to the validity of the patent, the defendants have laboured to show by evidence that a temperature lower than a low red-heat, and therefore not according to *Young's* specification, is that at which they have worked, and is the best temperature for producing paraffin oils and paraffin in the greatest quantity and of the best quality. Their evidence has entirely failed to establish the fact that they have not used for their manufacture the same class of coals and the same gradation and limit of temperature which *Young* describes, or that a gradation and limit of temperature lower than *Young's* is the best.

Mr. *Fernie* has adduced in evidence a passage from the work of an eminent *American* chemist, Dr. *Antisell*. This book gives the following extract from a publication by *Reichenbach* in 1854:—‘So remained paraffin until this hour a beautiful item in the collection of chemical preparations, but it has never escaped from the rooms of the scientific man.’ This illustrates the important distinction between the discoveries of the merely scientific chemist and of the practical manufacturer, who invents the means of producing in abundance, suitable for economic and commercial purposes, that which had previously existed as a beautiful item in the cabinets of men of science.

What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for

useful and economical purposes with an article which was previously little more than the ornament of a museum. It has been established to my satisfaction that the plaintiff *Young* is an inventor of this class, and that his patent is entitled to the protection of the law. I find that he has ascertained, by a course of laborious experiments, a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffin and paraffin oils. This brings it within the principle stated by the Lord Chancellor in *Hills v. Evans* (31 L.J. Ch. 457). The manufacture, with the materials and process indicated by him, according to the sense in which I understand the word 'manufacture' to be used in the statute, was a new manufacture not in use at the date of the patent.

(L.R. 1 H.L. 63.) Appeal to the House of Lords. A preliminary objection was taken that the appeal was not maintainable by reason that defendants had omitted to move for a new trial on the findings either before the Vice-Chancellor or before the Court of Appeal. (See stats. 21 & 22 Vict. cap. 27, and 25 & 26 Vict. cap. 42.) Their Lordships held that an appeal was only competent to the extent to which error could be shown in the decree consistently with leaving the findings of the Vice-Chancellor entirely unchallenged.

Per LORD WESTBURY.—Inasmuch as we find a distinct enactment that the verdict of the Court shall have the same effect as the verdict of a jury, and as we know perfectly well that the verdict of a jury, if it remained unchallenged, would be conclusive, we must hold the verdict of the Court as equal to the verdict of the jury; and in so doing the cause is not decided on any technical objection, but it is decided by the application of the clear language of the Act of Parliament.

The case was now heard in the restricted form imposed by the above judgment, and the appeal was dismissed with costs.

ADDENDA.

In the case of *Lister v. Leather* (8 E. & B. 1004) three objections were raised on behalf of the defendant, which were omitted in the abstract of the case, *ante*, page 196, as being manifestly untenable, but are now inserted.

LORD CAMPBELL, C.J. (in delivering the judgment of the Court of Queen's Bench) further observed:—‘The defendant now asserts that each of these patents (viz., those of plaintiffs of 1851 and 1852) is void, contending, first, that a patent for a combination is, in effect, a claim that each part of that combination is new; and, if any part claimed by a patent to be new is old, the whole patent is void. The answer is, that a patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such known parts may be valid, as has often been decided. Even if the specification contained no disclaimer, it would be a question of construction whether the patent was void. But where there is either a disclaimer or an acknowledgment that a part is old, all ground for this objection is gone.

‘The second argument was that, if a subsequent patent for a combination includes a part of an invention already protected by patent, it infringes on the property of another, and so is a violation of his right, and ought to be held illegal on account of his interest. The answer is, that the patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without license, would be an infringement; but with license, that also would be lawful, as is in constant experience. Indeed the objection was carried to the extent that a patent for an infringement on a patent invention of the same patentee would be void; but this rests only on the assumption that the improvement cannot be distinguished from the invention on which it is made. The assertion that all patents for improvements on existing patents must be void, is obviously untenable.

‘The third argument on this point, that a patent for an improvement on a patent was void as contrary to policy, because it prolonged the monopoly granted by the first till the last expired, is already virtually answered. The monopoly in the second patent is for the

improvement only; and the use of the former invention without the improvement is free at the expiration of the first patent.'

In a suit, *Tangye v. Stott*, A.D. 1866 (14 W.R. 386), brought to restrain the infringement of a patent for differential pulley-blocks (*Weston's*), an injunction was granted by Wood, V.C., who further said that there must be a decree for the delivery up to plaintiff of the pulleys made in infringement of the patent.

And in *Betts v. De Vitre*, *ante*, page 33, as reported in 34 L.J. Ch. 291, the order contained the following clause:—'That an inquiry should be made whether the defendants, or any of them, had in their possession or power any or what articles made in violation of the plaintiff's patent; and that all articles which should be certified to have been so manufactured and to be in the possession of the defendants, or any of them, should be destroyed in the presence of the persons named, being the managers and solicitors of the plaintiff.'

DIXON *against* THE LONDON SMALL ARMS COMPANY, A.D. 1876. }
L.R. 1 Q.B.D. (C.A.) 384. }

Appeal from the judgment of the Court of Queen's Bench (*ante*, page 119). Judgment reversed, and entered for defendants by the Court of Appeal. (Kelly, C.B., James, Mellish, L.JJ., Grove, J.)

Per JAMES, L.J.—It appears to me that *Feather v. The Queen* was decided upon principles impossible to be questioned, and that that case is now a binding authority. It has been settled in all kinds of cases that what a person may lawfully do himself he may lawfully do by his attorney, his bailiff, his contractor, his agent, his servant, his workman; and it is a sufficient plea in certain cases that the thing was done by the authority, at the request, or on behalf of the person who had a legal right to do it. Almost every great work in this country is done by contractors, who act under the authority of the bodies who have received authority from Parliament to do what is required to be done.

If it be the case, as it appears to me to be the case here, that what was done was done by the authority, and the express authority, for the use and for the benefit, of the Crown, it is, in my mind, merely saying that it was done by the Crown. The Crown has done it by such person or persons, in such a way and under such circumstances, as the officers of the Crown thought fit to do it.

Per MELLISH, L.J.—I think our difference with the Court below arises partly upon the construction of the contract itself. Some of

the learned judges seem only to have looked at the printed part of the contract, without considering that it refers to a schedule, and that the most material parts of the contract are really contained, not in the printed part, but in the written schedule annexed to it. In the written schedule, when we look at the contents of it, it is plain the Crown was to provide the steel tube and the stock for each rifle, and that then the contractor was to manufacture the steel tube and the stock into a perfect *Martini-Henry* rifle, which was to be inspected during the process of manufacture by the Crown's officers at the particular place where it was to be manufactured. Therefore it plainly was a contract to manufacture certain articles for the purposes of the Crown.

Now if the Crown has the right to have the patented articles manufactured by its servants, has it not the right to have them manufactured by entering into a contract with a contractor? If a railway company employs a contractor to do any one of the numerous works which the railway company are authorised to do by Act of Parliament, there is no doubt at all that the contractor may justify doing the act under the authority of the railway company. The act of the contractor, expressly authorised by the contract, is the act of the employer, just as much as the act of a servant is the act of his master. Therefore, when the Queen employs these defendants to manufacture her stocks and barrels into these *Martini-Henry* rifles, that is really, in point of law, the act of the Queen herself, and the contractor may justify, just as the servant may justify.

On appeal, the House of Lords reversed this decision, and restored that of the Court of Queen's Bench. (Not yet reported.)

SELECTED CASES OF APPLICATIONS RELATING TO PATENTS.

ADAMSON'S *Patent, in re*, A.D. 1856. 6 De G. Mac. & G. 420.

Caveat at Great Seal. Prior public User.

Petition for Great Seal to be affixed to a patent for an invention of a travelling stage or crane to be used in the construction of piers or harbour-works; opposed by one *Robinson*, who claimed to be the inventor. It appeared that the petitioner *Adamson* had used the apparatus, in the construction of a pier at *Hartlepool*, for a period of four months before applying for a patent; and he submitted that it was impossible to test the efficacy of the invention except in rough weather, and in a position exposed to the view of the public.

Petition dismissed with costs.

Per LORD CRANWORTH, L.C.—I cannot put the Great Seal to this patent, because I think there has been a clear dedication to the public. In the present instance an invention has been made in the progress of a work, and it has been used publicly by the inventor, not as an invention, but in the carrying on and execution of that work. It was alleged by *Robinson* that he, and not the petitioner, was the true inventor; but in the circumstances of this case it is not necessary for me to give an opinion upon that point. No doubt an experiment might have been made, and, if made *bonâ fide* only for the purpose of testing the merits of an invention, I do not think it would have amounted to a dedication to the public; but when, as in the present case, thousands of persons had an opportunity of seeing the apparatus at work for a period of four months, during the carrying on of the petitioner's contract, and in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed, and under such circumstances, and after such a lapse of time, I must hold that there was a dedication to the public.

SHARP'S *Patent, in re*, A.D. 1840. 3 Beav. 245; }
1 Webs. Pat. Ca. 641. }

Alteration of Enrolment. Jurisdiction of the Master of the Rolls.

Application, to the Master of the Rolls, to expunge a material part of a disclaimer which had been duly enrolled. Petition dismissed with costs.

Per LORD LANGDALE, M.R.—Patents for inventions are granted on condition of a specification of each invention being enrolled in a limited time; and except for the purpose of correcting mere verbal or clerical errors, proved to have arisen from mistake or inadvertence, I am of opinion that I have no authority to make any alteration in the enrolment of the patent or specification. It does not appear that the Master of the Rolls, as keeper of the Records in Chancery, has ever exercised any greater authority than I have stated in matters of this kind; and being of opinion that I have no jurisdiction to make any such order as is asked by this petition, I must dismiss the petition with costs.

GREEN'S *Patent, in re*, A.D. 1857. 24 Beav. 145.

Register of Proprietors of Patents. Expunging of entry.

Motion, under stat. 15 & 16 Vict. cap. 83, sect. 38, to expunge an entry from the register of proprietors in the Great Seal Patent Office.

It appeared that in 1853 one *Green*, the grantee of a patent, assigned the same to the applicants *W.* and *H.* On 18th *Aug.* 1855 *Green* executed a second assignment of his patent to another party, and the assignment was registered on the same day. On 25th *Aug.* 1855 the first assignment was also registered. Application being now made, on behalf of *W.* and *H.*, to expunge from the register the entry of 18th *Aug.* 1855, ROMILLY, M.R. made the order, with costs, and said:—‘I have no doubt that there is a sufficient case to entitle the applicants to the order to expunge the entry.’

MOREY'S *Patent, in re*, A.D. 1858. 25 Beav. 581.

Jurisdiction of the Master of the Rolls over entries in the Register of Proprietors of Patents.

Motion to expunge or vary an entry made in the register of proprietors in the Great Seal Patent Office.

It appeared that on 13th *Jan.* 1851 one *Morey*, the patentee of a sewing machine, assigned by deed one moiety of his patent to one *M.*, and on 14th *Jan.* agreed with *M.* to grant him an exclusive licence to work the patent. The assignment and agreement were registered on 5th *Aug.* 1857.

On 4th *Feb.* 1853 *Morey* assigned by deed the whole patent to another party *J.* The deed recited that *J.* had agreed to purchase the patent and all rights under it, save and except a licence to use a portion of the invention previously granted to *M.* This assignment was registered on 21st *June*, 1853.

Application being now made, on behalf of *M.*, that the entry on the register might be expunged, vacated, or varied, ROMILLY, M.R. directed an entry to be made—stating the recitals and operative parts of the deed of 1853, and declaring that the licence mentioned in the above passages was referable to the deed of assignment of 13th *Jan.* 1851, and the agreement of 14th *Jan.* 1851, which had been entered in full on the register on 5th *Aug.* 1857,—and said he was satisfied that the duty of the Court was to insert on the register any facts relating to the proprietorship, but not the legal inferences to be drawn from them. No costs given.

HORSLEY and KNIGHTON'S *Patent, in re*, A.D. 1869. L.R. 8 Eq. 475; }
L.R. 4 Ch. 784. }

Register of Proprietors of Patents. Jurisdiction of the Master of the Rolls.

Motion, under stat. 15 & 16 Vict. cap. 83, sect. 38, that an entry in the register of proprietors kept in the Great Seal Patent Office might be expunged, vacated, or varied.

It appeared that *Horsley* and *Knighton* were joint patentees of an invention, and that *Knighton* executed a deed of assignment purporting to convey to *O.* all his interest in the patent, and further to release *O.* from all claims by either or both of the co-patentees in respect of the patent. The deed was entered *verbatim* on the register. Application being made on behalf of *Horsley* to excise the entry, LORD ROMILLY made the order, with costs, and said:—‘Here is a patent granted to two persons, and therefore either of them may use it, but neither can dispose of the right of the other. I cannot alter the deed, because the deed has been executed by two persons, who, whatever may be the effect of it, were competent to enter into it, and I cannot make them execute a deed other than what they have actually executed. I have no option but to strike out the whole entry; and the persons who put it on the register must pay the costs of this application.’

On appeal to the Lords Justices, GIFFARD, L.J. refused to hear the application, and said:—‘Probably a right of appeal would have been given if the attention of the Legislature had been called to the subject. An entirely new register of proprietors of patents was created by the Act, and then the 38th section creates a new jurisdiction, and gives the power of expunging entries to the Master of the Rolls or to one of the Common Law Judges; but nothing is said about an appeal from their decisions, and without such enactment I think there can be no appeal.’