

*matic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 367.)

*Construction of Claims.*—‘You must always construe a claim with reference to the whole context of a specification.’ (Per Sir W. M. James, L. J., in *Plimpton v. Spiller*, L. R. 6 Ch. D. 412.) ‘Every claim in every patent must be read and construed with reference to the specification, and not as if the claim was an isolated sentence having no connection with or reference to what precedes it.’ (*Edison & Swan United Electric Light Company v. Woodhouse*, Court of Appeal, 4 R. P. C. 107, and see *Kaye v. Chubb*, 5 R. P. C. 641.)

As to the construction of a claim which can be read in two senses, one of which would make the patentee appear to claim something which was well known and in common use, see *Cropper v. Smith*, Court of Appeal, W. P. C. p. 81, and *Westinghouse v. Lancashire and Yorkshire Railway Company*, *ibid.* p. 98. And see what fell from Tindal, C. J., in *Haworth v. Hardcastle*, 1 W. P. C. 484. If one construction would imply that the claim is practically a repetition of what has gone before and entirely superfluous, yet so long as it does not seek to enlarge the monopoly beyond what the patentee is entitled to, it will not make the patent invalid. (*Plimpton v. Spiller*, L. R. 6 Ch. D. 412.)

It was decided by the House of Lords in *The British Dynamite Company v. Krebs* (Goodeve’s cases, p. 88) that an appendant claim to something old did not vitiate a patent. In this case the patentee had claimed the manufacture of the dynamite which was found to be new, and also claimed the means of firing by special ignition as described. Some of these means of firing being old and well known as applied to other explosives, the House of Lords construed this claim as being only appendant to dynamite, and upheld the patent. It is not, however, advisable for inventors to make claims of this kind, which if held to extend the patent would invalidate it, and if held not to extend it are simply useless.

The following decisions have reference to the interpre-

tation of 'claims:—*Kay v. Marshall* (2 W. P. C. 39); *Lister v. Leather* (3 Jur. n. s. 811, S. C. in error 8 E. and B. 1004); *Palmer v. Wagstaff* (9 Exch. 494); *Macalpine v. Mangnall* (3 C. B. 496); *Templeton v. Macfurlane* (1 H. L. C. 595); *Sellers v. Dickinson* (5 Exch. 312); *Seed v. Higgins* (8 H. L. C. 550); *Thomas v. Foxwell* (6 Jur. n. s. 271); *Dangerfield v. Jones* (13 L. T. n. s. 142); *Thomas v. Welch* (L. R. 1 C. P. 192); *Jordan v. Moore* (L. R. 1 C. P. 624); *Daw v. Eley* (L. R. 3 Eq. 497); *Hinks v. Safety Lighting Co.* (L. R. 4 Ch. D. 607); *Wright v. Hitchcock* (L. R. 5 Ex. 73).

## CHAPTER XI.

## OPPOSITIONS TO THE GRANT OF PATENTS.

AN inventor's application for a patent may be opposed under the eleventh section of the Act of 1883, amended by the Act of 1888, which enacts that any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant. The opponent is restricted by the Acts of 1883 and 1888 to three grounds: viz. (i) that the applicant had obtained the invention from him, or from a person of whom he is the legal representative; or (ii) that the invention had been patented in this country on an application of prior date; or (iii) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification. The last ground was substituted by the 4th sect. of the Patents Act, 1888. Where such notice is given the Comptroller will give notice of the opposition to the applicant, and will, on the expiration of the two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

As to the procedure in cases of opposition before the Comptroller, see rules 34-44 of the Patents Rules, 1890. The notice of opposition must state the grounds of opposition. When a ground of opposition is that the invention has been previously patented, the title, number, and date of

the alleged prior specification must be duly specified. The opponent's evidence in support of his case and the applicant's evidence in reply must be in the form of statutory declarations. At the hearing before the Comptroller no matter can be gone into which has not been stated in the notice of opposition. He may allow amendments in notices of opposition at the hearing. (See Patents Rules, 1890, R. 16; *Lake's Application*, 2 Griff. P. C. 35; *Airey's Application*, 5 R. P. C. 348.)

Where a notice of the hearing before the Comptroller did not reach the opponent's agent and the case was decided against the opponent in his absence, the Comptroller suggested that the opponent should appeal, and this being done the law officer referred the case back to the Comptroller for rehearing. (*Warman's Application*, 2 Griff. P. C. 43.)

*Appeal to the Law Officer.*—When a person intends to appeal to the law officer against the Comptroller's decision, he must file in the Patent Office a notice of his intention, within fourteen days from the date of the decision. (See the Rules of the Law Officers in the Appendix).

When the Comptroller requires an amendment to be made, but does not at once settle the words of the amendment, it is the practice to regard the time for appealing to the law officer as dating from the day of forwarding to the opponent a copy of the amendment approved by the Comptroller. (*Chandler's Patent*, 1 Griff. P. C. 273).

When a notice of appeal is given by one party, the other party will not be allowed to question at the hearing another part of the Comptroller's decision unless he has also given notice of appeal, or has obtained the consent of the other side. (*Bairstow's Patent*, 5 R. P. C. 287.) When the appellant is one of the opponents, it is the practice, going beyond the rule, to send him notice of the hearing before the law officer.

At the hearing the parties may appear in person, or be represented by counsel, solicitors, or patent agents. The onus of proof lies on the opponent. (*Ex parte Sheffield*, L. R. 8 Ch. 237.) The more important decisions of the law

officers are now officially reported, so that more uniformity may be looked for than formerly, when it was not unusual to find different law officers holding different views on the same points. They are always reluctant to stop patents, because applicants cannot appeal from their decisions; but if the law officer entertains no doubt that the invention has been anticipated by a prior patent he will refuse the application. (*Aire and Calder, &c., Application*, 5 R. P. C. 345; *Waller and Ratcliff's Application*, 5 R. P. C. 347; *Daniel's Application*, 5 R. P. C. 413.)

The infringement of an existing patent was formerly not considered a ground for refusing an application, for the reason that it was possible that the later invention covered a valuable improvement, and according to the present practice if the later invention is an improvement on an invention under an existing patent, the application must be distinctly made for the improvement separate from the already patented invention. (*Hoskin's Patent*, 1 Griffin, P. C. 291.)

Under the old system, if the law officer was at all doubtful as to the effect of the evidence before him, he would allow the patent to proceed, that the question might be tried in a court of law. In the case of *Dance's Patent* (P. M. J. vol. vi. 2nd series, 298), *Atherton, A. G.* (1861), finally gave his judgment as follows:—‘I allow this patent to proceed, thinking that the question of fact, whether Dance or Stevens invented, and the mixed question of fact and law, whether the invention had been made public before Dance applied for protection, admit of too much doubt to justify a law officer in stopping the patent.’

And so in other cases where much doubt hung about the matter; for example, where the evidence was conflicting, and the law officer was unable to decide which side was speaking the truth, he would allow the application to proceed, as was done by *Giffard, S. G.*, May 6, 1876, in the matter of *Liddell's Patent*, No. 3872, 1875.

And in *Re Russell's Patent* (2 De G. and J. 130), where

the novelty of the invention was contested, *Lord Cranworth, C.*, thought that in such a case it was better to run the risk of putting the party opposing to the costs of ulterior proceedings than to withhold the Seal, for the obvious reason that the former course, if wrong, would only create a remediable injury, whilst the latter course, if wrong, would cause an irremediable injury. (See also *Re Tolson's Patent*, 6 De G. M. and G. 422; *Re Lowe's Patent*, 25 L. J. Ch. 454; *Re Simpson and Isaac's Patent*, 21 L. T. o. s. 81; *Re Spence's Patent*, 3 De G. and J. 523.)

And under the new law it is the well-recognised practice that if there is doubt as to the applicant's right to a patent the question should be determined in his favour, and the patent sealed. (*Chandler's Patent*, 1 Griff. P. C. 270; *Welch's Patent*, 1 Griff. P. C. 300; *Jones' Patent*, 2 Griff. P. C. 33.) It is no part of the law officer's duty to decide the validity or invalidity of patents. (*Newman's Patent*, 5 R. P. C. 277.) If a strongly controverted question of scientific anticipation should arise, the patent will not be stopped. (*Lake's Patent*, 6 R. P. C. 548.)

The first ground of opposition mentioned in the Act is that the applicant had obtained the invention from the opponent, or from a person of whom he is the legal representative. The fact that a workman has assisted his master in improving the details of the machine invented by the master and sought to be patented by him affords no ground of opposition to the grant of a patent to the master. (*David & Woodley*, 2 Griff. P. C. 26.) As to the words 'legal representative,' it was held that an agent regularly appointed by power of attorney does not fulfil the requirement. (*Edmund's Patent*, 1 Griff. P. C. 281.)

The second ground of opposition is that the invention had been patented in this country on an application of prior date.

The opponent must be a person who has a real interest in the prior patent, or a person who was the originator of the invention sought to be patented. A patent agent does not fall within the description. (*Heath & Frost's Patent*, 1

Griff. P. C. 289. And see *Hookham's Application*, 2 Griff. P. C. 32.)

A person was allowed to be heard on the ground that he had had an interest under a lapsed prior patent, alleged to anticipate the applicant's invention, and had manufactured under it. (*Glossop's Patent*, 1 Griff. P. C. 285.) But the simple fact that a person had manufactured under a prior patent is not sufficient. (*MacEvoy's Patent*, 5 R. P. C. 285.) Nor is it enough to allege that the opponent is going to work the invention under the prior patent. (*Bairstow's Patent*, 5 R. P. C. 287.)

'Patented in this country on an application of prior date.'—An opponent was allowed to be heard although the prior patent had expired. (*Lancaster's Patent*, 1 Griff. P. C. 293.) But if the invention has been only described but not claimed, it has not been patented in this country. (*Von Buck*, 2 Griff. P. C. 40.) And an invention which has only received provisional protection cannot be cited against the applicant. (*Bailey's Patent*, 1 Griff. P. C. 269; *Paterson's Patent*, 1 Griff. P. C. 296.) But a person whose complete specification has been accepted at the Office, although his patent has not been issued, is entitled, under section 15 of the Act of 1883, to be heard in opposition. (*L'Oiseau & Pierrard*, 2 Griff. P. C. 36.)

Where the opponent proves that the invention is described and claimed in the complete specification under a prior patent, it is no answer to say that the invention is not comprised in the provisional specification of the former patent (*Green's Patent*, 1 Griff. P. C. 286); or that the claim in the complete specification goes beyond the title and provisional. (*Newman*, 2 Griff. P. C. 40; see also *Haythornthwaite's Application*, 7 R. P. C. 70.)

Where it is clear that a claim is covered by an earlier patent the applicant will be ordered to strike it out. (*Hall & Hall's Patent*, 5 R. P. C. 283; *Webster's Patent*, 6 R. P. C. 163.) And an applicant is frequently required to state in his specification that he is aware of a given patent and that he does not claim anything which is described and claimed in the

specification under it. (*Newman's Patent*, 5 R. P. C. 271; *Gozney's Application*, 5 R. P. C. 597; *Lynde's Patent*, 5 R. P. C. 668.) Even a reference to an expired patent is sometimes required to be inserted. (*Hall's Patent*, 5 R. P. C. 283.) In the cases of *Guest and Barrow's Patent* (5 R. P. C. 312); and *Sielaff's Application* (5 R. P. C. 484), a disclaimer of a principle was ordered to be inserted. The reference to an earlier specification must not put a construction on the latter. (*Atherton's Patent*, 6 R. P. C. 547.)

*Rival Applications.*—When two contending applicants for a patent claimed to be independent contemporaneous discoverers, the law officer usually refused to allow the grant to issue to either separately, but offered it to the two jointly. And so in a case of opposition before *Lord Cranworth, C.*, where a master and his foreman had both invented certain improvements, for which the master alone applied for a patent, but was opposed by the foreman on the ground of prior invention by the latter, the patent was ordered to be vested in trustees for the benefit of both. (*Re Russell's Patent*, 2 De G. & J. 130.) Where there was ground for supposing that the applicant owed part of the invention to the opponent, the Comptroller decided to seal a patent for the invention to the two as joint inventors. (*Eadie's Patent*, 1 Griff. P. C. 279.)

Evans's application was opposed by Cutting on the ground that the former had obtained the invention from the latter. Cutting afterwards made an application in respect of substantially the same invention, but that application was not opposed by Evans. As it appeared that the two had been jointly experimenting on the invention, *Sir R. Webster, A. G.*, directed that a patent be issued to Evans on condition that he assigned one half share to Cutting, and that Cutting should assign a half share of his patent to Evans, and if Cutting refused to assign, then Evans's patent was to be sealed forthwith. There being a difficulty in carrying out this arrangement, the law officers afterwards directed that Evans's patent should not be sealed, but that Cutting should assign one half share of his patent to Evans,



the assignment to contain provisions as to payment of the patent fees. (*Evans & Otway's Patent*, 1 Griff. P. C. 279. And see *Garthwaite's Patent*, 1 Griff. P. C. 284; *Luke's Patent*, 1 Griff. P. C. 294.)

Where an employer opposed the application of a person who was or had been in his service, on the ground that the invention sought to be patented probably resulted from investigations or experiments directed and paid for by the employer, the law officer, being satisfied of the *bona fides* of the opposition, granted his warrant on condition that the applicant should submit his provisional specification to the inspection of the opponent, and should strike out such portions of it as contained matters of the kind referred to by the opponent. This was done by *Coleridge, S. G.*, in the case of *Healey's Application*, No. 85, 1872, and also in the case of *Conniff's Application*, No. 3895, 1872.

In a case where there were rival applications for a patent for the same invention, and there was a conflict of evidence as to priority of discovery, the patent was awarded by the Lord Chancellor to him who was first in a position to seal it. (*In re Lowe's Patent*, 25 L. J. N. S. 454.) But now priority of sealing will confer no advantage on a later applicant, inasmuch as by section 13 of the Act of 1883 a patent must be dated and sealed as on the day of the application.

In cases of rival applications where the law officer was satisfied that one of the applicants was entitled to one part of the invention, whilst the other could more fairly claim another part, he issued his warrants to both, limiting the provisional specifications accordingly. This was done by *Coleridge, S. G.*, in the matter of *Craig and Macfarlane's Applications*. (P. M. J. vol. iv. 3rd series, 366.) Macfarlane had applied for Letters Patent for 'Improvements in rollers for paper-making machines,' and obtained the usual provisional protection. He claimed to have invented both a 'couch-roll' and an 'underpress roller' for a paper-making machine. The application was opposed by Craig, on the ground that he was the first inventor of an underpress

roller, covered with vulcanite and vulcanised india-rubber, which formed part of Macfarlane's provisional specification, and for which Craig had also applied and obtained the usual protection. Craig contended that Macfarlane, who had obtained the material for the covering of the rollers from a rubber company, was at that time in Craig's employment, and that he had only applied for his patent after the rollers had been experimented with by Craig at one of his mills, and had been found successful. Craig submitted that the experiments adduced by Macfarlane had only reference to the coutch-roll of the machine, and that Macfarlane had not proved that he had ever experimented on the underpress roller. *Coleridge, S. G.*, decided to grant his warrant for the sealing of Macfarlane's patent for the coutch-roll alone, and to grant his warrant for the sealing of Craig's patent for the underpress roller.

In the case of *Ex parte Bates & Redgate* (L. R. 3 Ch. 577), where the second applicant had procured the Great Seal without having been opposed, before the first applicant petitioned for the Seal, *Lord Hatherley, C.*, only permitted the first applicant to include in his patent so much of the invention as was not covered by the patent already sealed, and, moreover, he ordered the first applicant's patent to bear date after the second applicant's.<sup>1</sup>

And so, where the law officer had reported that part of an invention for which a patent was sought was the subject of an existing patent, the Lord Chancellor ordered that part to be excluded from the new patent. (*Ex parte Mancaux*, L. R. 6 Ch. 273.)

The principle of these cases was that the Crown would

<sup>1</sup> In *Ex parte Dering* (13 Ch. D. 393), where two applicants had applied on the same day for the same invention, *Lord Cairns, C.*, refused to follow the decision in *Ex parte Bates & Redgate* as to the post-dating of the patent, on the ground that the Legislature intended patentees to have the full term of protection given by provisional specification, and ordered the applicant's patent to be sealed, and dated as of the day of application, although the sealing was opposed by the second applicant, who had already had the Great Seal affixed. (See the remarks on these cases by *Mr. Justice Kekewich* in *Kurtz v. Spence*, 5 R. P. C. 178.)

not grant a second patent in derogation of a former grant, and would not assume, without *scire facias*, that the first patent was void. See *Ex parte Bailey* (L. R. 8 Ch. 61) and *Ex parte Henry* (L. R. 8 Ch. 167, 169).

And this principle has been kept in view by the Comptroller and the law officers with regard to applications under the Act of 1883, disclaimers, as already stated, being frequently directed to be inserted in specifications, referring to an earlier patent.

*Mala Fides.*—Under the old law, if a case of *mala fides* could be made out, the Chancellor would interfere to prevent injustice. Thus, where a servant having filed a provisional specification, his master afterwards filed a provisional specification for the same invention, and then after obtaining a patent, a complete specification, there was grave suspicion that the master had surreptitiously obtained a knowledge of the servant's invention, and therefore the servant's patent was ordered to be sealed and dated as of the day of his application, notwithstanding the existence of the master's patent. (*Ex parte Scott & Young*, L. R. 6 Ch. 274.) The consequence of this would be that by virtue of section 24 of the Patent Act of 1852 acts done under the patent first sealed would be an infringement of the patent with an earlier date. (See *Saxby v. Hennett*, L. R. 8 Ex. 210.)

When the opposition was founded on a prior patent granted to the opponent, and the applicant alleged that the invention for which that patent was granted had been communicated by him in confidence to the patentee who had fraudulently obtained a patent for it, the Lord Chancellor directed the applicant's patent to be sealed, so as to give him an opportunity of trying the question in a court of law. *Re Vincent's Patent* (L. R. 2 Ch. D. 341). And see section 35 of the Patents Act 1883.

And where it was shown that the applicant had derived the principle of the invention from a rival applicant, the Seal would be refused to the former.

In April 1853 Hadden made application for a patent

for a method of making gun-cartridges. His plan obviated the necessity of biting off the end of the cartridge when the gun was being loaded, and its main feature consisted in making it weaker at one end, so that when rammed down it burst open and the powder ran into the breech of the gun. After lodging the provisional specification, Hadden had some conversation with Lott, to whom he described the general features of the invention. Shortly afterwards Lott applied for a patent for an invention having a similar object, and his specification described a collapsing chamber in the cartridge to hold the charge of powder, which chamber would be burst open by the action of the ramrod. This method of carrying out the general idea was different from the one adopted by Hadden. The Solicitor-General, having issued his warrant for the sealing of Lott's patent, the case was carried before the Lord Chancellor, who held that the two inventions were substantially the same, the material part in each being that one end of the cartridge was made weaker than the other with a view to its bursting under the action of the ramrod. Holding that Lott had obtained this idea from Hadden, the Chancellor refused to seal Lott's patent. (See also *Marshall's Application*, 5 R. P. C. 661.)

*Herschell, S. G.*, in the case of Macfarlane's Patent (March 1883), opposed by the Animal Charcoal Company, Limited, declined to issue the warrant under the following circumstances. Macfarlane was manager of the company and Jones was a consulting engineer, and Ingham a chemist also employed by the company. It was asserted that Macfarlane was not the inventor of his alleged invention, but that it was based partly on suggestions made by Jones and partly on suggestions made by Ingham, all of which had been experimented upon in the company's works under Macfarlane's management. Although Macfarlane showed at the hearing that he had obtained an American patent for the invention in his own name during the pending of the opposition, the law officer, believing that the suggestions had been originally made by Jones and Ingham, declined to grant the patent.

In the case of *Griffin's Applications* (6 R. P. C. 296), the law officer refused to seal the applicant's patents, as there was strong reason for believing that the applicant had acquired his knowledge of the inventions from the opponent.

In the case of *Abel's Application*, No. 1908, 1876, opposed by De Muller, August 2, 1876, *Giffard, S. G.*, held that he could not take any official notice of alleged fraudulent proceedings abroad on the part of the foreign communicator of Abel's invention as against the opponent. He could not look behind the applicant Abel, who, as the first importer or introducer of the invention into Her Majesty's realm, was in law the inventor. And this course was followed in *Edmund's Patent*, 1 Griff. P. C. 281; and *Lake's Patent*, 5 R. P. C. 415.

#### COSTS.

The Comptroller has no authority to award costs; but the law officers have power, under the thirty-eighth section of the Act of 1883, to order costs to be paid by either party, and any such order may be made a rule of Court. See the Law Officers Rules, 11 and 12. As a general rule costs follow the event, but there may be special circumstances to influence the law officer. It is to be hoped that in any future legislation power will be given to the Comptroller to deal with costs of oppositions. It seems to be but just that in cases of frivolous and unsuccessful oppositions the opponents should pay the costs of the applicant.

## CHAPTER XII.

## THE PATENT: ITS DATE, DURATION, AND EXTENT.

By the twelfth section of the Patents Act of 1883 it is enacted that if there is no opposition to the grant of a patent, or in case of opposition if the determination is in favour of the grant, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office, and a patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom. It is further directed that a patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except (1) where the sealing has been delayed by an appeal to the law officer, or by opposition to the grant, in which case the patent may be sealed at such time as the law officer may direct; and (2) if the applicant should die before the expiration of the fifteen months, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months of the applicant's death.

But by the third section of the amending Act of 1885 it was enacted that a complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively, after the said nine and twelve months respectively, as the Comptroller may, on payment of the prescribed fee, allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said period specified in the principal Act. Applications for

enlargement of time must state on what circumstances, and upon what grounds the enlargement is applied for. (See the Forms U and V.)

By the thirteenth section of the Act of 1883 it is directed that every patent shall be dated and sealed as of the day of the application. The same section provides that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application. This proviso was intended to apply to such cases as *Ex parte Bates & Redgate* (L. R. 3 Ch. 577) and *Ex parte Manceaux* (L. R. 6 Ch. D. 274); see these cases cited in the chapter on Oppositions.

In the event of the death of an applicant for a patent before the sealing of the patent, it may be granted, under section 12 subsection (3 *b*) of the Act of 1883, to his legal representative, and sealed at any time within twelve months after the death of the applicant. In such a case application must be made to the Comptroller, who will require to be furnished with an official copy of or extract from the will or letters of administration, in proof of the applicant's title as legal representative.

By the eighty-sixth section of the Patents Act of 1883 the Comptroller may refuse to grant a patent for an invention, the use of which would, in his opinion, be contrary to law or morality.

The sixteenth section of the Act of 1883 directs that every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man, leaving out the Channel Islands, which have been previously included.

The duration of every patent is by the seventeenth section of the Act of 1883 directed to be limited therein to fourteen years from its date. According to the case of *Russell v. Ledsam* (14 M. & W. 574), the time runs from the day of the date of the patent, including that day: for instance, a patent for fourteen years, dated February 26, 1825, was held to expire at twelve o'clock on the night of February 25, 1839. As to the mode of obtaining an exten-

sion of the term, and the principles which guide the Privy Council in deciding upon the application, the reader is referred to Chapter XIV.

By the thirty-third section of the Act of 1888 every patent may be in the form set forth in the first schedule, but this form the Board of Trade has power, under the 101st section subsection 2, to alter or amend. Further, by the thirty-third section a patent is to be granted for one invention only, but no objection to a patent can be taken in an action or other proceeding on the ground that it comprises more than one invention.

On reference to the form of patent printed in the Appendix to this volume it will be seen that the Crown grants unto A. B. especial licence, full power, sole privilege and authority, that he, the said patentee, by himself, his agents or licensees, at all times thereafter during the term of fourteen years from the date, may make, use, exercise, and vend his invention within the United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them shall in his or their discretion seem meet; and to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, all the Queen's subjects whatsoever are strictly commanded not to infringe the patent. It is, however, provided that, if it shall be made to appear to the Crown or the Privy Council that the grant is contrary to law, or prejudicial or inconvenient to the subjects of the realm in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom, &c., or that the said patentee is not the first and true inventor thereof within the realm, the patent shall be void.

There are also other provisoes, the two most important of which make the grant void—first, if the said patentee shall not pay all fees by law required to be paid in respect of the patent or in respect of any matter relating thereto at the time or times and in manner for the time being by law provided; and, second, if the said patentee shall not supply or cause to be supplied for the service of the Crown all



such articles of the said invention as may be required by the officers or commissioners administering any department of the service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided.

By the operation of the seventeenth section of the Act of 1883 every patent will cease if the patentee fails to make the prescribed payments within the prescribed times. A payment of 50*l.* must be made before the end of the fourth year and 100*l.* before the end of the eighth year (or before the end of the seventh year, in case of patents dated prior to January 1, 1884). Or instead of these payments annual fees may be paid. These annual fees and the prescribed times for payment are set forth in the Appendix to this volume. As to the procedure in regard to certificates of payment or renewal see rules 45-48 of the Patents Rules 1890.

It is, however, provided by the seventeenth section of the Act of 1883 that if in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment; and thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, but not for more than three months. (As to the procedure, see rule 49 of the Patents Rules 1890, and form K.) It is further provided that if any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

In the case of *Williams v. Nash* (28 Bea. 93) it was held that a payment on the third anniversary of the date was a sufficient compliance with the statute which prescribed the

payment of a stamp duty of 50*l.* before the expiration of the third year. The patent was dated on February 26, 1855, and the third year's stamp duty was paid on February 26, 1858.

Under the ninety-eighth section of the Act of 1883, whenever the last day for paying a fee at the Patent Office shall happen to fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the fee may be paid on the day next following any of these days.

Where any prescribed payment has not been made in due time, and no application has been made to the Comptroller for an enlargement of the time, and the patent has consequently become void, nothing short of a special Act of Parliament can restore its validity. But such Acts are more difficult to obtain since the Act of 1883 came into operation than formerly.

In case clerical errors should have been made in Letters Patent, the Master of the Rolls had and still has power to correct them (*Re Nickels' Patent*, 4 Bea. 563; *Re Gare's Patent*, L. R. 26 Ch. D. 105); but the application must be made within a reasonable time (*Re Blamond's Patent*, 3 L. T. N. s. 800). In the case of *Adam's Patent* (1 W. R. 259), a doubt having been expressed as to the jurisdiction of the Master of the Rolls, the order was made by the Lord Chancellor. But now the powers of amendment given to the Comptroller by section 18 of the Patents Act 1883 seem extensive enough to cover clerical errors in patents.

In the event of a patent being lost or destroyed, or if its non-production should be accounted for to the satisfaction of the Comptroller, he is empowered by the thirty-seventh section of the new Act to cause a duplicate thereof to be sealed.

In the case of *Feather v. The Queen* (6 B. & S. 257), it was decided that the Crown has a right to the free use of any patented invention (see the case more fully stated at

the end of the chapter on Infringements) ; and this decision applies to all patents granted before the commencement of the Act of 1883, or on applications then pending ; but as to patents granted afterwards, they will have the same effect against the Crown as against a subject (section 27). The officers or authorities administering any department of the service of the Crown, their agents, contractors, or others are to be entitled to use any invention for the service of the Crown on terms to be agreed upon with the approval of the Treasury ; or if an agreement cannot be effected, then on such terms as the Treasury, after hearing all parties interested, shall settle.

By the forty-fourth section of the Patents Act of 1883 the Secretary of State for War is empowered to acquire by purchase or gift the benefit of any inventions of improvements in munitions of war, and of any patent obtained for the same, and to prevent the disclosure of such inventions.

The effect of the forty-fifth section is that patents issued or applied for before the commencement of the Act will not have the benefit of the provision binding the Crown, nor will they come under the liability imposed by the clauses relating to compulsory licences. But in all other respects, including the proceedings for amendments, prolongations, and revocations, the Act of 1883 will extend to patents granted before the commencement of the Act, or on applications then pending, except slight differences on the payment of the annual fees. (See Appendix.)

By the thirty-fifth section of the Act of 1883 a patent granted to the true and first inventor is not to be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention, subsequent to that fraudulent application during the period of provisional protection.

The 113th section of the Patents Act of 1883 repeals all the statutes described in the third schedule of the Act, but goes on to enact that the repeal shall not affect the *past operation* of any of those statutes. Now, the twenty-fifth

section of the Patents Act of 1852 declares that any British patent which bears date after a foreign patent for the same invention (being a foreign invention) shall be void at the expiration of such foreign patent. Consequently, any British patent granted before the commencement of the Act of 1883, and standing in this relation to a foreign patent, will be void by the operation of these two clauses, in case the foreign patent shall have expired before the commencement of the Act of 1883. That is to say, since the earlier Act has already rendered the British patent void, that 'past operation' of the Act will not be affected by its repeal by the Act of 1883. But if the twenty-fifth section of the earlier Act at the time of its repeal has not had an invalidating operation on a patent, then the British patent will not be touched, and the clause in question will have no effect. As regards patents which have been obtained on applications pending at the commencement of the new Act, it is presumed that the third subsection of the forty-fifth section of that Act will effectually protect them from the operation of the twenty-fifth section of the Act of 1852.

The operation of sect. 113 on patents granted under the Act of 1852 was considered with reference to other points in the cases of *Singer v. Stassen* (1 R. P. C. 121) and *Brandon's Patent* (1 R. P. C. 154).

It was held by *Baron Huddleston* in the case of *Nordenfeldt v. Gardner* (1 R. P. C. 10 and 73), that in order to invalidate a British patent on the ground of the invention being a foreign invention for which a Belgian patent had been obtained prior to the date of the British patent and had lapsed, the foreign patent must have been not merely applied for, but actually obtained before the British patent, and this, although the foreign patent when granted bore a date earlier than that of the British patent.

When a patent is granted to two or more persons, each may use the invention without being liable to account to the other. (*Mathers v. Green*, 1 Law Rep. Ch. Ap. 29, before *Lord Cranworth*, C.) See, however, the earlier case of *Hancock v. Bewley* (Johns. 601), as to the rights of parties

where Letters Patent are vested in trustees for two or more persons as tenants in common.

In case of the death of the patentee intestate before the expiration of the patent, his interest under it passes to his personal representatives, and not to his heir. In case of bankruptcy the property in the patent will pass to the trustee or assignee, like the rest of the bankrupt patentee's personal assets. (*Bloxam v. Elsee*, 9 D. & R. 215.)

## CHAPTER XIII.

## AMENDMENTS OF SPECIFICATIONS.

It has been shown that where a material part of an alleged invention is not new or not useful, the patent is altogether invalid; and that if a patentee claims by his specification more than he is entitled to, the patent is likewise void. The fatal effect of an inconsistency between the title and the specification, or between the provisional and the complete specification, has also been pointed out. To remedy a law which in many cases bore unjustly upon patentees, the Act of 5 and 6 Wm. IV. c. 83 empowered a patentee to take steps for altering his specification by disclaimer. That Act, however, as well as other Acts relating to disclaimers, were repealed by the Act of 1883, which substituted the following provisions for those of previous statutes. By the eighteenth section it is enacted that—

(1) An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment, and his reasons for the same.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

(7) The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10) (As amended by the fifth section of the Act of 1888.) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.

The procedure on applications for amendments is regulated by rules 52-59 of the Patents Rules, 1890.

After specifications have become public property they must be amended under section 18. Any other amendments are to be dealt with under sections 7 and 9 of the Act of 1883. (*Jones' Patent*, 1 Griff. 313.) Where an applicant desires, prior to the acceptance of his complete specification, to omit

part of the invention covered by the original title, the Comptroller should give him the option of either filing the specification with the original title and inserting a disclaiming clause, or should amend the original title in the application and the provisional specification, as he is virtually empowered to do under ss. 7 and 9, the amendment being confined to simple excision. (*Dart's Patent*, 1 Griff. P. C. 307.)

According to the report of *Hearson's Application* (1 R. P. C. 214), both the then law officers were of opinion that the Comptroller has power to impose conditions on giving leave to amend a specification by way of disclaimer. But he cannot give costs. (*Pietschmann's Patent*, 1 Griff. P. C. 310.)

The twenty-first section directs that every amendment of a specification shall be advertised. This will be done by the Comptroller under rule 59.

*Appeal to the Law Officer.*—The law officers rules will be found in the Appendix. By sect. 38 of the Act of 1883 they have power to examine witnesses on oath.

There is no appeal from the order of the law officer when he grants or refuses leave to amend on the appeal to him from the decision of the Comptroller. Nor, according to the decision of a Divisional Court and the Court of Appeal in the case of *Van Gelder's Patent* (6 R. P. C. 22), can a writ of prohibition be obtained, prohibiting the law officer from allowing the amendment of a specification.

An amendment which has been allowed by the Comptroller or law officer can be questioned in a Court of Law if it is contrary to subs. 8 of s. 18 of the Act of 1883, that is, if it makes the specification claim an invention larger than, or different from, the invention originally claimed. (*Van Gelder's Patent*, 6 R. P. C. 22; *Gaulard and Gibbs' Patent*, 6 R. P. C. 225.)

*Who is entitled to oppose.*—When the ground of opposition is that the invention as described in the amended specification is the same as that comprised in a prior patent, it is not competent for any member of the public to oppose; the opponent must show that he has an interest in the prior patent. (*Bell's Patent*, 2 Griff. P. C. 11.)



*Grounds of Opposition.*—These are usually some of the following: that the proposed amendment will introduce disconformity between the provisional and the complete specification; that the scope of the invention will be enlarged; that the amended specification will claim an invention substantially different from that claimed by the original specification; that the invention will be made the same as that described in a prior specification.

It is not a good ground of opposition that the invention will be restricted within narrower limits by the amendment, provided that the invention so restricted is covered by the original specification. *Cochrane's Patent* (1 Griff. P. C. 304); *Ashworth's Patent* (2 Griff. P. C. 6); *Nordenfelt's Patent* (2 Griff. P. C. 19).

*Conditions imposed on allowing Amendments under the old law.*—It had become a common but not invariable practice under the old law for the law officers, on applications for leave to amend specifications under the Act of 5 & 6 Wm. IV., to impose as a condition that no action for an infringement before the date of the disclaimer should be brought either against certain persons or against any of the public. See *Holmes v. London and North-Western Railway Co.* (Macr. P. C. 31) and *Smith's Patent* (Macr. P. C. 232).

In *Re Tranter's Patent* of 1865, which was a patent for fire-arms and cartridges, an application was made in August 1873, by the assignees of the patent, for leave to disclaim certain portions of the matters claimed in the specification, and the application was opposed by manufacturers of fire-arms and cartridges chiefly on the ground that they had embarked large capital in the manufacture of cartridges, and that they ought to be protected in their manufacture against any proceedings on the part of proprietors of a patent which had been allowed to remain in its imperfect state for a long time, inasmuch as the effect of the disclaimer would be to enable the applicants to take such proceedings. *Coleridge, A. G.*, granted the leave sought for on the condition that the applicants 'should undertake that no legal proceedings be taken against the

opponents in respect of the manufacture, use, or sale of cartridges, or for any alleged infringement of the patent in question when amended by disclaimer.' And this decision was followed by *Giffard, S. G.*, in the case of *Re Jones's Patent*, on the application of Mr. Batley, the assignee, for similar leave.

On an application for leave to disclaim parts of the specification under *Crabtree's Patent*, No. 2775 of 1878, *James, A. G.*, Feb. 12, 1881, allowed the application upon terms that no action should be brought against any person in respect of any machine which had prior to the hearing been made or sold by any of the opponents. He directed that lists of such machines should be supplied and verified if required by statutory declaration.

The principle of these cases received considerable extension in *Re Medlock's Patent* (Newton's L. J. N. S. vol. xxii. p. 69). That was an application for leave to enter a disclaimer of part of a specification under a patent for preparing a red or purple dye. The patent had been declared invalid on the ground that, of the two alternative processes described in the specification, confessedly only one would answer. (See *Simpson v. Holliday*, 13 W. R. 577, cited *ante*.) The application was opposed by several chemical manufacturers, some of whom had been made defendants in suits instituted by the owners of the patent. *Collier, S. G.*, would only consent to grant the leave sought for on the terms that the applicants should bring no action against the opposers 'for any infringement of the patent by the use or continued use, during the continuance of the patent, of any processes for manufacturing red and purple dyes in use by them at the present time.' The applicants refused to accept this condition, and the Solicitor-General consequently disallowed the disclaimer.

The law officer, however, did not always insist upon the patentee giving an undertaking of this nature. It was sometimes thought right that he should be at liberty to seek compensation for the past infringement of the patent. (*Re Lucas's Patent*, Macr. P. C. 234.)

*Conditions under the Act of 1883.*—An order having been obtained during the progress of an action for an infringement to amend a specification under a patent issued under the Act of 1852, subject only to the payment of the costs by the plaintiff, application was made to the Comptroller, who gave leave to amend as proposed without imposing any conditions. On appeal to the law officer, *Herschell, S. G.*, he held that the leave should be made subject to the condition that no action should be brought or proceeding taken in respect of any infringement prior to January 1, 1884, but without prejudice to any question in the pending action. (*Re Hcarson's Patent*, 1 R. P. C. 214.) See also *Westinghouse's Patent* (1 Griff. P. C. 315); *Ashworth's Patent* (2 Griff. P. C. 6); *Haddan's Patent* (2 Griff. P. C. 12). The ground for fixing that date is that infringements subsequent to January 1, 1884, would be brought within the scope of the 20th sect. of the Act of 1883. Hence, such a condition is not usually imposed on allowing amendments in specifications under patents issued since the latter Act came into operation. (*Allen's Patent*, 2 Griff. P. C. 3.) There may be special circumstances to induce the law officer to impose the condition that no action should be brought for anything done at any time before the amendment. (*Ashworth's Patent*, 2 Griff. P. C. 9.) This was a patent under the Act of 1852.

The law officer sometimes thinks it right to require the insertion of an additional disclaimer. (*Hampton & Facer's Patent*, 2 Griff. P. C. 13.)

*'Explanations.'*—*Sir R. Webster, A. G.*, said in *Beck and Justice's Patent* (2 Griff. P. C. 10), 'My idea of the function of an explanation (sect. 18, subs. 1, of the Act of 1883) is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently acquired knowledge. I do not mean to lay down a hard-and-fast rule, but, speaking broadly, it was intended to permit a man to amend, correct, and explain the enunciation of his invention as he intended

originally to give it.' And see *Nordenfelt's Patent* (2 Griff. P. C. 18).

The amendment of a specification by inserting the correct description of a drawing which had been misdescribed was allowed in the case of *Morgan's Patent* (2 Griff. P. C. 17).

*Application to a Judge for liberty to apply to amend pendente lite.*—When a patentee has brought an action for the infringement of his patent, or when proceedings for its revocation are pending, he is prevented by the 10th subs. of sect. 18 of the Act of 1883 from applying directly in the usual way to the Comptroller for leave to amend the specification. But by the 19th sect. of that Act it is enacted that in an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed. Under rule 58 of the Patents Rules, 1890, an office copy of the judge's order must be left at the Patent Office along with the request for leave to amend. (*Codd's Patent*, 1 Griff. P. C. 305.)

After judgment it is both too late and unnecessary to make application to the judge for liberty to apply to amend, since the judge has then no power to make an order, and the patentee is at liberty to apply directly to the Patent Office in the ordinary way, even if an appeal to the House of Lords be pending. (*Cropper v. Smith*, 1 R. P. C. 254; and see *Lawrence v. Perry*, 2 R. P. C. 187.)

It seems that where more than one legal proceeding relating to a patent is pending it is not necessary to apply for leave to disclaim in all of them. (*Hall and others*, 5 R. P. C. 306.) And in the same case it was held by a Divisional Court that after a judge's order had been obtained giving liberty to apply to the Comptroller for leave to amend the specification, a writ of prohibition to prevent him pro-

ceeding with the hearing of the application ought to be refused.

The discretion given to the Court or a judge by the 19th sect. is absolute in each particular case upon the particular circumstances of that case, and will not be interfered with by the Court of Appeal unless it can be shown to have been absolutely wrong. (*Allen v. Doulton*, 4 R. P. C. 383; *Lang v. The Whitecross Company*, 6 R. P. C. 570.)

The terms to be imposed on the person seeking to amend should be such as to give full protection to the other party. *Bray v. Gardner* (4 R. P. C. 40).

The Court of Appeal in *Singer v. Stassen* (1 R. P. C. 122) held that liberty to apply for disclaimer during action should be given upon the terms that the costs of the amendment should be the defendants' costs in any event, and that the specification, as amended, should not be receivable in evidence in the action. In *Codd v. Bratby* (1 R. P. C. 209), leave to amend was given upon the terms that the specification when amended should not be given in evidence at the trial; that no evidence of infringement should be given prior to the date of filing the amended specification; and that the costs of the motion be paid by the plaintiffs. In the *Fusee Vesta Co. v. Bryant & May* (4 R. P. C. 71), it was ordered that the costs of the defendants in the action up to and including the plaintiffs' application to amend, and consequent upon the amendment, should be borne by the plaintiffs in any event. See also *Gaulard v. Lindsay* (5 R. P. C. 192); *Haslam Co. v. Goodfellow* (5 R. P. C. 28); *Lang v. The Whitecross Co.* (6 R. P. C. 570); *Gaulard and Gibbs' Patent* (5 R. P. C. 189); as to the terms upon which liberty to apply to the Comptroller for leave to amend the specification will be given. The last of these cases was a petition for revocation, and the two former were actions for infringements, in which, on giving the liberty applied for, the condition was imposed that the action should be confined to the specification as amended, and therefore damages for infringements prior to the amendment could not be claimed.

Seeing what are the terms usually imposed on a plaintiff when making application to the Court for liberty to apply for leave to amend his specification, it may in some cases be worth consideration whether both time and money would not be saved by discontinuing the action as soon as defects are discovered in the specification, applying for leave to amend at the Patent Office in the ordinary way, and then bringing a fresh action if that course is thought desirable.

*Amendments must not enlarge or materially vary the original invention.*—We have seen that under the eighth sub-section of the eighteenth section of the Act of 1883 ‘no amendment shall be allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before the amendment.’

It is part of the duty of the Comptroller and the law officers, when hearing applications for leave to amend, to see that the proposed amendment does not extend the scope of the patent, or alter the claims in such a way that the invention would become something substantially larger than or substantially different from what it was originally. (*Heath and Frost's Patent*, 1 Griff. 310.) When it is clear to the Comptroller or to the law officer that a proposed amendment would contravene subs. 8 of s. 18, it is his duty to disallow it (*Heath and Frost's Patent*, *ubi supra*); but when the question is doubtful, he ought to allow the patentee to make the amendment at his peril. (*Lake's Patent*, 2 Griff. P. C. 16.)

Where a specification claims both a general combination and some of the subordinate parts, a disclaimer may sever and reject the claim to any of the parts. But a specification cannot be altered so as to be made to claim a combination or parts if they were not previously claimed. In the matter of *Serrell's Patent* (6 R. P. C. 103), *Sir R. Webster, A. G.*, said that in his opinion where a specification contains a distinct and specific claim to the operation of what is believed to be new, the patentee cannot be allowed to

strike out the whole of the claim and insert another claim to a subordinate part.

On the other hand, care should be taken in preparing a disclaimer that sufficient of the invention is left to support the patent. (*Gaulard and Gibbs's Patent*, 5 R. P. C. 525; *United Horseshoe Co. v. Swedish Horsenail Co.*, 6 R. P. C. 1.)

If there is a claim to all methods of effecting a certain result, it may be cut down by disclaimer to the particular method described in the specification. (*Ashworth's Patent*, 2 Griff. P. C. 6.)

*Disclaimers under the old law.*—The first section of the earlier Act (5 and 6 Wm. IV. c. 83), now repealed, under which disclaimers were first authorised, disallowed such 'as shall extend the exclusive right granted by the letters patent.'

In the matter of *Bateman and Moore's Patent* (Macr. P. C. 116), an application was made (1854) to *Bethell, S. G.*, for leave to alter the specification, so as to make it disclaim the separate parts of the invention, and claim only the combination. The Solicitor-General said that he should require to see from the specification itself that it had not been intended to claim the separate parts, but their combination only. Finding some indication of an intention to claim the apparatus as a whole, he gave the patentees permission to reject certain words in the claiming part of the specification which were inconsistent with such a construction.

Several cases came before the Courts in which the construction of the prohibitive words of the earlier Act was debated. 'The object of the Act authorising disclaimers' (said *Lord Westbury* in the case of *Ralston v. Smith*, 11 H. L. C. 223) '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 may, 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 operation of a disclaimer under the old law was considered in the case of *Seed v. Higgins* (8 E. & B. 755). The patentee described in his specification, and illustrated by drawings, some machinery for preparing cotton, and after saying that the apparatus so described represented one practicable mode of carrying out the invention, he proceeded to state that he did not intend to confine himself to this particular method, but claimed as his invention the application of the law or principle of centrifugal force for a certain purpose. He afterwards disclaimed his claim to the application of the law or principle, and limited his claim to the application of centrifugal force acting in a certain manner as described in the specification. This was held to be a limitation of his claim to the particular apparatus described, whereby the principle was applied in a certain way, and afforded no ground for contending that the disclaimer described a different invention from that described in the specification. This view was also taken on appeal by the Court of Exchequer Chamber (8 E. & B. 771) and by the House of Lords (8 H. L. C. 550).

In the case of *Ralston v. Smith* (11 C. B. n. s. 471), it was decided by the Court of Exchequer Chamber, and afterwards by the House of Lords (11 H. L. C. 223), that a disclaimer is bad which is in effect an attempt to turn a specification for an impracticable generality into a grant for a specific process, comprised within the generality in one sense, but not to be discovered there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer. The specification in this case was expressed in general terms, embracing a great number of modes of engraving upon rollers any desired design for the purpose of embossing woven fabrics. It was afterwards found that only rollers with circular grooves would answer, and the patentee there-



upon, by disclaimer, limited his invention to such rollers. 'Now' (said *Lord Chelmsford*), 'as these were not specifically described in the original specification, but were merely involved in the general terms which were used, the patentee had not complied with the conditions of the letters patent in particularly describing and ascertaining the nature of his invention. When, therefore, by his disclaimer he confines his claim to circular grooved rollers as his sole invention, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the original specification alone.'

Other decisions as to disclaimers under the old law were *Cannington v. Nuttall* (L. R. 5 H. L. 205) and *Dudgeon v. Thomson* (L. R. 3 A. C. 34).

Under that part of the Act of 5 and 6 William IV. c. 83 which enacts that 'no objection shall be made, in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of alteration had not such authority in that behalf,' it was held that the disclaimer of a patentee who had assigned all his interest in the patent could not be objected to. (*Wallington v. Dale*, 7 Exch. 888.) The language of the Act of 1883 is that 'leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud.'

*Powers of the Master of the Rolls.*—The Master of the Rolls has power to allow amendments in a specification filed under the Act of 1852, or which is otherwise to be considered as a record under the authority of the M. R., notwithstanding s. 18 of the Act of 1883. (*Gare's Patent*, L. R. 26 Ch. D. 105.)

The Master of the Rolls may without action order a disclaimer to be removed from the file, when filed without the consent of the patentee. (*Re Berdan's Patent*, L. R. 20 Eq. 346.)

The M. R. refused to cancel a memorandum of altera-

tion made under 5 and 6 William IV. c. 88, when application was made to him for that purpose, on the ground that it extended the patentee's privilege and infringed the petitioner's patent rights, for he held he had no jurisdiction. (*Re Sharp's Patent*, 3 Beav. 245.)

To amend clerical errors in a specification application must be made to the Master of the Rolls or the Comptroller as before stated.

The following cases decided by the Lord Chancellor or Master of the Rolls relate to the amendment of clerical errors under the old law: *Re Sharp's Patent* (3 Beav. 245); *Re Redmund* (5 Russ. 44); *Re Ruberry's Patent* (1 W. P. C. 649); *Re Dismore* (18 Beav. 538); *Re Johnson's Patent* (L. R. 5 Ch. D. 503).

#### COSTS.

The Acts do not authorise the Comptroller to award costs. (*Pietschmann's Patent*, 1 Griff. P. C. 314.) But the law officer is empowered by the thirty-eighth section of the Patents Act of 1883 to order costs to be paid by either party, where leave to amend is opposed, and any such order may be made a rule of Court. It is usual to let costs follow the event, but the law officer exercises his discretion according to the circumstances of each case. See the Law Officers Rules, 11 and 12.

## CHAPTER XIV.

## EXTENSION OR PROLONGATION OF LETTERS PATENT.

NOTWITHSTANDING the merit and utility of his invention, a patentee frequently finds himself nearly at the expiration of the term for which his patent was granted without having reaped the reward which he was fairly entitled to expect. This may have happened from various causes. To perfect the invention, to make arrangements for the manufacture, and to bring the product to the notice of the public may have been attended with great expenses, which were never repaid. It sometimes occurs that the public are slow to acknowledge the merit of an invention of real value, and the patentee's privilege is on the point of expiring before they can be brought to extend their patronage to it. It may be that the patentee's monopoly has been infringed, and that much time has been lost and large costs have been incurred in enforcing or defending his just rights. Or it may be that the patentee did not himself possess sufficient means, and was never fortunate enough to meet with a capitalist to advance what was necessary to work the invention. From some one of these causes, or from several of them combined, it happens not seldom that a patentee fails to derive any benefit, even if he escapes loss, from an invention of real merit and value.

In order to afford the unsuccessful but meritorious patentee an opportunity of remedying this hardship at a less cost than a special Act of Parliament, the statute of 5 and 6 William IV. c. 83 empowered him to petition the Queen in Council for a prolongation of the term of his patent; and now by the twenty-fifth section of the Patents

Act of 1883 it has been enacted that a patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term ; but such petition must be presented at least six months before the time limited for the expiration of the patent. But in the case of *Brandon's Patent* (1 R. P. C. 154), it was held that owners of patents existing before January 1, 1884, could apply for prolongations at any time before the expiration of such patents. Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension. If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the Committee shall consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard on the petition. The Judicial Committee are to have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case. If they report that the patentee has been inadequately remunerated, her Majesty in Council may extend the term of the patent for seven, or in exceptional cases fourteen, years ; or may order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

An assignee may apply for an extension, but he does not stand altogether in the same favourable position as the patentee. (*Claridge's Patent*, 7 Moo. P. C. 394.) It is chiefly with the view of rewarding a meritorious inventor that the extension of a patent is granted. If, however, the assignee be a person who has assisted the inventor with funds to enable him to perfect the invention and bring it into use, this circumstance is a favourable feature in a petitioning assignee's case. (*Norton's Patent*, 1 Moore, P. C. C. N. S. 339, in which case the petitioners, who were a public company, were refused a prolongation which they applied for after the death of the inventor.) See also the

cases of *Cardwell's Patent* (10 Moo. P. C. C. 488); *Pitman's Patent* (8 Moo. P. C. C. n. s. 297); *Hutchison's Patent* (14 Moo. P. C. C. 364); *Normand's Patent* (L. R. 3 P. C. C. 193); *Reece's Patent* (51, Engineer, 207); *Sillar's Patent* (Goodeve's cases, 581). But public companies have in some cases been successful petitioners, *Houghton's Patent* (7 Moo. P. C. n. s. 309); *Napier's Patent* (13 Moo. P. C. 543); *Church's Patents* (3 R. P. C. 95).

#### THE PETITION AND THE PROCEDURE.<sup>1</sup>

The proceedings commence by the insertion of advertisements in the public prints, giving notice of the patentee's intention to apply for a prolongation of his patent (see the Privy Council Rules), and a petition setting forth the facts must then be presented to her Majesty in Council, at any time before the expiration of the patent, though it will be prudent not to delay presenting the petition much after six months before the expiration.

All facts material to the petitioner's title, and to the history of the patent, must be stated in the petition (*Johnson's Patent*, L. R. 4 P. C. C. 83), which ought to be a clear and candid statement of the circumstances under which the petitioner presents himself before the tribunal. In one case, when material facts were omitted, the hearing was postponed, and the petition directed to be amended. (*Hutchison's Patent*, 14 Moore, P. C. C. 364.) In other cases where important facts were not set forth, the applications were refused. (*Pitman's Patent*, 8 Moore, P. C. C. n. s. 293; *Horsey's Patent*, 1 R. P. C. 225.) Where the patentee had assigned his patent before applying for an extension, and had omitted to state this fact in his petition, it was dismissed, leaving the inventor or his assignee, if he thought proper, to apply again. (*Mitchell's Patent*, February 1882.) A mortgagee ought to be made a party to the petition. (*Church's Patents*, 3 R. P. C. 95.) And the legal personal re-

<sup>1</sup> Forms of Petition for Extension of a Patent, Objections to Extension and a Petitioner's Accounts will be found in Mr. W. N. Lawson's *Law and Practice under the Patents Acts*, 2nd ed. pp. 507-524.

presentative of the deceased patentee must, under certain circumstances, join in the petition. (*Willacy's Patent*, R. 5 P. C. 690.)

If foreign patents have been obtained, the fact should be mentioned. (*Pitman's Patent*, L. R. 4 P. C. 86; *Adair's Patent*, 6 App. Cas. 176; *Newton's Patent*, 1 R. P. C. 177).

Important facts having been inadvertently omitted from the petition, leave was applied for and granted to file supplementary particulars before the hearing. (*In Re Reece's Patent*, 51 Eng. 207.)

Any person may enter a caveat addressed to the Registrar at the Council Office against the extension. Having done so, he is entitled to have notice from the petitioner of any special application and of the hearing, and may be heard in opposition, when the case is entered upon, before the Judicial Committee. The caveat must be entered in the name of the actual opponent, not in that of the patent agent. (*Lowe's Patent*, 8 Moore, P. C. C. 1.) As to the right of an alien living abroad to be heard in opposition to an extension, see *Schlumberger's Patent* (9 Moore, P. C. C. 1).

By the sixth of the Privy Council Rules persons who have entered caveats must, within a fortnight after service on them of copies of the petition, lodge at the Council Office notice of the grounds of their objection. In *Ball's Patent* (4 App. Ca. 171), it was held to be unnecessary to state the particulars if the grounds are given. The Crown may adduce evidence against a patent irrespective of the objections, *Duncan Stewart's Patent* (3 R. P. C. 9); *Church's Patents* (3 R. P. C. 95).

By the ninth rule the petitioner must lodge at the Privy Council Office, at least one week before the day fixed for the hearing, six printed copies of his specification, and also four copies of his accounts. If the accounts are not filed in due time the Committee may refuse to go into the question. (*Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87; *Chatwood's Patent*, L. R. 5 P. C. 88, note.)

Under the eighth section of the 7 and 8 Vict. c. 69, the Judicial Committee may appoint one of the clerks of the

Privy Council to take any formal proofs required to be taken in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself; and this section was not repealed by the Patents Act of 1883. By the sixth sub-section of the twenty-fifth section of that Act it was enacted that her Majesty in Council might make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings should be regulated according to the existing procedure and practice in patent matters of the Judicial Committee. The rules now in force will be found reprinted in the Appendix to this volume.

#### THE HEARING.

The Judicial Committee of the Privy Council is empowered by the twenty-eighth section (sub-section 2) of the new Act to call in the aid of an assessor specially qualified in any proceeding before them relating to patents.

Not more than two barristers will be heard on each side: that is to say, two in support of the applicant's case and two in opposition. Where, however, more parties than one oppose, and they have separate and independent grounds of opposition, each will be allowed two counsel. The Attorney-General usually appears to watch the case on behalf of the Crown. The petitioner may appear in person.

The petitioner must be prepared at the hearing with evidence to show that there is an invention, and that the invention possesses utility, the word here meaning substantial merit and usefulness to the public, not merely the *scintilla utilitatis* which is sufficient to justify the grant of a patent in the first instance. He must further show that all reasonable means had been taken to make the invention productive; and if his case is that he has never been reimbursed his expenses, he must give reasonable evidence of the amount of his loss. If, however, there is a balance of profit, but to an extent incommensurate with his fair expectations, he will be required to show what the real profit

has been. Where the statement of the accounts is unsatisfactory the Committee will either direct that question to be taken before considering the merits of the invention, or adjudicate without reference to them. (*Clark's Patent*, L. R. 3 P. C. 421; *S. C. 7 Moore*, P. C. C. n. s. 255; *Wield's Patent*, L. R. 4 P. C. 89; *S. C. 8 Moore*, P. C. C. n. s. 300.) But where the accounts are satisfactory on their face the usual course is to go into the question of merits first. (*Houghton's Patent*, L. R. 3 P. C. 462.) (See the section on the Accounts, *post*.)

The merit and substantial utility of the invention ought to be shown by the testimony of persons of experience and weight. (*McDougal's Patent*, L. R. 2 P. C. 1; *Betts' Patent*, 1 Moo. P. C. 49; *Stoney's Patent*, 5 R. P. C. 519.) Where the utility of the invention as a whole was not apparent the petition was dismissed. (*Willacy's Patent*, 5 R. P. C. 690.)

The petitioner must show that the parties interested had made efforts to bring the invention into public use.

Delay for a prolonged period on the part of an inventor in attempting to bring his invention into use is a good reason for refusing to grant an extension unless some reasonable excuse can be shown. (*Norton's Patent*, 1 Moore, P. C. C. n. s. 339.)

If the invention has not been brought into use, in spite of the earnest endeavours of the persons interested in the patent, that circumstance will be taken as a strong presumption that it is wanting in practical utility, and, if not satisfactorily explained, the application will be refused. (*Southworth's Patent*, 1 W. P. C. 487; *Kollman's Patent*, 1 W. P. C. 565; *Jones' Patent*, 1 W. P. C. 579; *Bakewell's Patent*, 15 Moore, P. C. 385; *Allan's Patent*, L. R. 1 P. C. 507; *Herbert's Patent*, L. R. 1 P. C. 389; *Patterson's Patent*, 6 Moore, P. C. 469; *Wield's Patent*, 8 Moore, P. C. n. s. 300.) For instance, the patentee may show that he was incapacitated for business for a long period by an accident. (*Roper's Patent*, 4 R. P. C. 201.)

The presumption of non-utility in the invention may



also be rebutted by evidence showing its merit and utility. (*Hughes' Patent*, L. R. 4 App. Cas. 174.) The petitioner should be prepared with evidence to show that there is a reasonable probability of an increased use or sale in the immediate future.

It is open to those who oppose the extension to adduce evidence to show that the invention is wanting in novelty or utility, or that it is imperfect; and they may likewise point out defects in the specification. It is sufficient to state the grounds of objection to an extension without stating the particulars. (*Ball's Patent*, 4 App. Cas. 171.) But in *Saxby's Patent* (L. R. 3 P. C. 294) the Council refused to go into the questions of novelty or utility where the merit of the invention had been proved and the patentee had been inadequately rewarded. Lord Cairns said, 'In point of fact it is not the practice of this tribunal to decide upon the novelty or utility of the invention, although it would abstain from prolonging a patent which was manifestly bad.' See also *Cockings' Patent* (2 R. P. C. 151); *Church's Patents* (3 R. P. C. 95). However, in *Stewart's Patent* (3 R. P. C. 7), evidence that the invention had been anticipated by previous patents and by user of machines was admitted, and the petition was dismissed.

The fact of improvements having been made by other persons in the patentee's invention after the date of his patent does not afford ground of opposition to an application for an extension if the invention has a merit of its own, and if the patentee has not reaped a benefit in proportion to that merit. (*Galloway's Patent*, 1 W. P. C. 727; *Napier's Patent*, 6 App. Cas. 174.)

Nor is it a valid ground of objection that the manner of working the invention had been varied since the filing of the specification. (*Heath's Patent*, 2 W. P. C. 257.)

'If a patentee has allowed his foreign patents, obtained after the date of the British patent, to lapse, that is not a ground for refusing the prayer of the petition. (*Adair's Patent*, 6 App. Cas. 176; and see *Johnson's Patent*, L. R. 4 P. C. 79; *Hills' Patent*, 1 Moore, P. C. n. s. 258.)

But if the invention as originally specified proved a failure (*Bell's Patent*, 2 W. P. C. 160), or when it was only made completely successful by adopting improvements introduced by other persons from abroad (*Woodcroft's Patent*, 1 W. P. C. 740), the patentee was thought disentitled to an extension.

On the other hand, if the introduction of the invention has been strongly opposed by persons engaged in the trade (*Stafford's Patent*, 1 W. P. C. 563 ; *Roberts' Patent*, 1 W. P. C. 573), or if the patentee has never been able to raise the necessary funds (*Wright's Patent*, 1 W. P. C. 575), or if he has been engaged in heavy litigation arising out of the patent (*Heath's Patent*, 2 W. P. C. 257 ; *Russell's Patent*, 2 Moore, 496 P. C. ; *Pettit Smith's Patent*, 7 Moore, P. C. 133), these have been considered good grounds for granting an extension.

If litigation, involving the question of the validity of the patent, should be going on at the time of the application for a prolongation, the Committee will not go into the question, but will assume the patent to be valid (*Betts' Patent*, 1 Moore, P. C. C. n. s. 49), unless a court of law has already decided against the validity of the patent (*Jones' Patent*, 9 Moore, P. C. 41), or, unless the invalidity is beyond all reasonable doubt, in which case they will not grant an extension. (*Woodcroft's Patent*, 2 W. P. C. 30 ; *Hills' Patent*, 1 Moore, P. C. C. n. s. 258 ; *McInnes' Patent*, L. R. 2 P. C. 54 ; *S. C. 5 Moore*, P. C. C. n. s. 72 ; *Stewart's Patent*, 3 R. P. C. 9.) If a competent tribunal should, after the grant of a new patent, decide that the original patent was invalid, the new patent will share its fate, and will be invalid likewise. (*Kay's Patent*, 1 W. P. C. 571.) On the hearing of the application to extend the term of *Honiball's Patent* (3 Eq. Rep. 230 ; *S. C. 2 W. P. C. 208*), it was said that the grant of an extended term is to be considered as a new grant by new letters patent, subject to the same conditions, open to the same objections, and in ordinary cases entitled to the same advantages as the original grant. So that, in point of fact, the extension decides nothing, one

way or other, as to the validity of the patent. And, therefore, where it is only a matter of doubt as to the validity of the patent—as, for example, where the evidence is conflicting—the extension will be granted, if there appear good grounds *aliunde* for that course.

When it appeared that a patentee had agreed by deed with a public company to grant an exclusive licence, and also covenanted with them to obtain at the expiration of the term a prolongation of the patent for the same purpose, the application for a prolongation was refused by the Privy Council, on the ground that the agreement was contrary to public policy and repugnant to the spirit of the statute 5 and 6 William IV. c. 83. (*Cardwell's Patent*, 10 Moore, P. C. C. 488.)

#### THE ACCOUNTS.

‘ It is the duty of a patentee to take upon himself the onus of satisfying the Committee in a manner which admits of no controversy of what has been the amount of remuneration which in every point of view the invention has brought to him, in order that their lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for the Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what may be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received.’ (Per *Lord Cairns* in *Re Saxby's Patent*, L. R. 3 P. C. 292; *S. C.* 7 Moore, P. C. C. n. s. 85. See also *Re Clark's Patent*, L. R. 3 P. C. C. 421; *S. C.* 7 Moore, P. C. C. n. s. 255; *Wield's Patent*, L. R. 4 P. C. C. 89.) In the case of *Yates and Kellett's Patent* (4 R. P. C. 150), the petitioners applied at the hearing for an adjournment to give them time to amend the accounts, but the application was refused and the petition was dismissed. The accounts must, therefore, be full, clear, unreserved, and

properly proved. (*Hills' Patent*, 1 Moore, P. C. C. n. s. 258.) Where the patentee has dealt with his patent only through the medium of assignments and licences, the work of making out correct and complete accounts ought to be easy. His difficulties will be much increased if he has himself entered upon the manufacture of the patented article along with another business, unless he has had the foresight to perceive the propriety of keeping separate books. It is desirable that a patentee should from the first keep his accounts under the patent distinct from those of any other business in which he may be engaged, so that in the event of his applying for an extension, he may be able to give satisfactory evidence of everything paid and received on account of the patent. (*Betts' Patent*, 1 Moore, P. C. n. s. 49; *Duncan and Wilson's Patent*, 1 R. P. C. 257). In the latter case the petition was dismissed because the expenditure of the patent business was not sufficiently distinguished from that of the petitioner's general business.

The profits of every branch of the manufacture connected with the patented invention must be set forth, even those of a subsidiary and independent business, if that business is carried on for the purpose of employing the product as a feeder of the patented manufacture. On the hearing of the petition for a prolongation of *Newton's Patent* (51 Engineer 208), it appeared that the petitioners (Nobel's Explosives Company), who were assignees, had not only manufactured dynamite, the object of the patent, but had also made nitro-glycerine (one of the ingredients of dynamite) and the nitric acid with which that nitro-glycerine was prepared. In making out their accounts in support of their case they treated the matter as if they had bought nitro-glycerine in the market, keeping out of view the profits they had made by the manufacture of nitric acid and nitro-glycerine; their contention being that the latter profits ought not to be taken into consideration in estimating the dynamite profits. It was, however, held that the profits from every branch of their manufacture must be brought into the account; and, as the profits derived from the sub-

sidary manufacture had been very large, the petition was dismissed with costs. See also *Bailey's Patent* (1 R. P. C. 1).

Where the patent has been assigned to a company, not only must the patentee's profits be shown, but the account of the company should be deposited. (*Deacon's Patent*, 4 R. P. C. 119.)

The profit, year by year, ought to be shown (*Perkins' Patent*, 2 W. P. C. 6), including the profits made by sales abroad. (*Hardy's Patent*, 6 Moore, P. C. 441.) The profits made under foreign patents, if any, must be shown. (*Adair's Patent*, 6 App. Cas. 176; *Newton's Patent*, 1 R. P. C. 177; L. R. 9 App. C. 592.) If books of account are not forthcoming, the petitioner will be required to explain their absence. (*Markwick's Patent*, 13 Moore, P. C. C. 310.) If a patentee so deals with his rights that he is unable to show what amount of profit has been made by working the patent, or what has been received by licensees under licences, he will be considered to have disentitled himself to an extension. (*Trotman's Patent*, L. R. 1 P. C. 118; *Saxby's Patent*, L. R. 3 P. C. 294.) In taking an account of the profits and loss the patentee is entitled to charge for personal expenses and loss of time devoted to the patent and in endeavouring to bring the invention into use. (*Trotman's Patent*, L. R. 1 P. C. 135; *Newton's Patent*, 14 Moore, P. C. C. 156; *Perkins' Patent*, 1 W. P. C. 6; *Carr's Patent*, L. R. 4 P. C. 541; S. C. 9 Moore, P. C. C. n. s. 379; *Poole's Patent*, L. R. 1 P. C. 514; *Furness' Patent*, 2 R. P. C. 175.) Travelling expenses, salaries of clerks, and commissions on sales where the patentee has acted as salesman have been allowed (*Bailey's Patent*, 1 R. P. C. 1), and the cost of making experiments has been allowed. (*Kay's Patent*, 1 W. P. C. 572.) In some cases the profits made by the patentee as manufacturer have been permitted to be deducted (*Betts' Patent*, 1 Moore, P. C. n. s. 49; *Galloway's Patent*, 1 W. P. C. 729; *Duncan and Wilson's Patent*, 4 R. P. C. 119); in other cases such profits were not allowed to be deducted. (*Muntz's Patent*, 2 W. P. C. 121; *Saxby's Patent*, L. R. 3 P. C. 292.) Where

manufacturer's profits are allowed to be deducted there is no specific rule as to the proportion, since they vary in different businesses, but in *Hills' Patent* (1 Moore, P. C. 251) and in *Duncan and Wilson's Patent* (2 R. P. C. 260) two-thirds of the net profits were deemed too large a proportion. Law expenses incurred by the patentee in maintaining his rights are in general allowed in deduction of profits, but this will not be done when the patentee has compromised suits and given up costs to which he had an apparent title. (*Hills' Patent*, 1 Moore, P. C. C. n. s. 258.) In the matter of *Bailey's Patent* (1 R. P. C. 1), where the administrator of a patentee claimed at the bar to be allowed some deductions from the profits not mentioned in the petition or accounts, it was held that no such deduction could be made, and evidence on the point was inadmissible.

A petition was dismissed where the accounts were insufficient as not distinguishing the expenditure on that part of the invention which was proved useful. (*Willacy's Patent*, 5 R. P. C. 690.)

#### GROUND OF DECISION UPON THE MERITS.

The jurisdiction conferred upon the Judicial Committee by the Legislature, being an extraordinary one, is to be exercised, as remarked in the Council Chamber, only on the most special grounds alleged and proved in reference to each case, and at the discretion of the Committee; for the extension of a patent is a matter of favour, not of right. In considering their decision the Committee is, according to the twenty-fifth section of the Act of 1883, to 'have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.' In coming to a decision they seek to meet the justice of the case with respect to the meritoriousness and public usefulness of the invention, and the adequacy or inadequacy of the patentee's remuneration, regard being had to the patentee's opportunities, the adverse circumstances with which he had to contend, and his general management

of the matter. If he has met with loss, as the total result of his transactions under the patent, and there has been no neglect or gross mismanagement on his part, there is good *prima-facie* ground for an extension ; but, if a certain amount of profit has been derived from working the patent, a decision is less easily formed. The question to be considered, it has been said, is not simply what the patentee has received, but what the patent has gained or what it ought to have gained with proper management.

Assuming that the patentee's conduct in regard to this part of the case is not open to remark, it is obvious that the merit of the invention is now an element to be considered, since a few hundred pounds may very well reward an invention of small utility, whilst 10,000*l.* may be an inadequate payment for a discovery of great public benefit, the working of which has been attended with heavy losses and great anxieties. The amount of inventive power will be taken into consideration, as well as the amount of time and trouble expended by the inventor in making experiments, either previously to his discovery, or in testing it, or in carrying it out. Inventors have different degrees of meritoriousness. It is not, however, to be assumed, that because the step in improvement taken by an inventor is small, his merit is likewise small, and his invention unimportant. A very small addition or alteration may have altogether escaped notice until seized and turned to account by an acute mind, and its adoption may lead to most important consequences in the manufacture with which it is connected. The reward of such an invention ought not to be made proportionate to its apparent insignificance. Common justice dictates that the benefit an inventor has conferred on the public ought to be regarded ; and the advisers of the Crown, acting under this idea, will give him the opportunity of reaping a recompense in some degree commensurate with the value of the result. In delivering judgment on an application to the Privy Council for an extension of *Soanies' Patent* (1 W. P. C. 729), *Lord Brougham* used these words : ' The whole history of science,

from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that has ever been made—is one continued illustration of the slow progress by which the human mind makes its advance in discovery. It is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same discovered or invented.' His lordship proceeded to say, that in the case of a new principle or a novel invention—for instance, a new process—the smallness of the step did not furnish any argument against its importance. But when a new application only is under consideration, such an application as might easily suggest itself to any person—a new application of a well-known simple process, which had been employed with respect to other substances—then, when a patentee comes to apply for an extension of his patent, the smallness of the step involved in the patented invention will be taken into consideration in determining the length of the extension. In this case the invention consisted in an application of mechanical pressure to separate the solid and fluid constituents of cocoa-nut oil. The invention having been of moderate benefit to the public, the moderate extension of three years was granted to the patentee. See also the remarks of *Lord Kingsdown on Hills' Patent* (1 Moore, P. C. C. n. s. 258), and of *Lord Cairns in Saxby's Patent* (L. R. 3 P. C. 294), as well as the case of *Derosne's Patent* (4 Moo. P. C. 418).

To justify an extension for a longer time than seven years the invention must be clearly shown to possess a very exceptional degree of merit and public usefulness. In the cases of *Moncrieff's Patent* (22, Iron 35), *Ruthven's Patent* (Pract. M. J., 2nd ser., 8, 159), and *Stoney's Patent* (5 R. P. C. 518), a prolongation of ten years was recommended. It is very seldom indeed that the full term of fourteen years is granted. (*Mitchell's Patent*, 30 Newton, L. J. c. s. 356.)

In the case of a patent obtained for an invention



imported from abroad, which invention had been previously patented in a foreign country, the British patent became void under the twenty-fifth section of the 15 and 16 Vict. c. 83 at the expiration of the foreign patent; and when application for a prolongation of such a patent was made, it was refused. (*Aube's Patent*, 9 Moo. P. C. 43; *Poole's Patent*, L. R. 1 P. C. 514; *Adair's Patent*, L. R. 6 A. C. 176; *Hills' Patent*, 1 Moo. P. C. n. s. 258.) And this rule was even extended to cases of patents for imported inventions, when the foreign patent was dated shortly after the British patent. (*Newton's Patent*, 14 Moore, P. C. C. 156; *Normand's Patent*, L. R. 3 P. C. 193; *S. C. 6 Moore*, P. C. C. n. s. 477; *Blake's Patent*, L. R. 4 P. C. 535; *S. C. 9 Moore*, P. C. C. n. s. 373.)

This Act having been repealed, no objection can now be founded on the authority of these decisions with reference to patents issued under the new Act; nor, apparently, with reference to patents previously issued, which had not been avoided by the statute of Victoria. But if any patent granted before the commencement of the new Act had been rendered void by the operation of the statute before that date, then it would seem that the cited decisions would still be applicable in case an extension of the patent were petitioned for.

Before the Act of 1883 was passed, it had been decided that the Crown, at any time before the Great Seal was affixed, could countermand the warrant for sealing, upon a proper case being made out. Thus where patentees had applied for a prolongation of their patent, and had obtained a recommendation from the Judicial Committee of the Privy Council, upon which an order was drawn up for a prolongation, a petition was afterwards presented to the Crown, seeking to revoke this order; and this being referred to the Judicial Committee, it was held that this Committee had authority, under 3 and 4 William IV. c. 4, s. 4, to entertain such a petition, and to recall the warrant for sealing the letters patent. (*Schlumberger's Patent*, 9 Moore, P. C. C. 1.)

## THE NEW PATENT.

If the Judicial Committee reports favourably on the petition the patent may be extended under sect. 25 of the Act of 1883, for seven, or in exceptional circumstances for fourteen, years. Or a new patent may be granted for the time therein mentioned with any restrictions, conditions, and provisions that the Committee think fit to insert therein. If a new patent is issued, as is usually the case, it is dated the day after the expiration of the original term, and it will be subject to all the provisions of the Act of 1883. If anyone should use the invention in the interval between the expiration of the original term and the grant of the new patent, he is not liable for an infringement. Moreover, those who may have invested capital in working it during that interval may attend before the Committee, and oppose the application, or prefer a claim to have their acts protected and their expenditure made good. (*Russell v. Ledsam*, 14. M. and W. 574.)

Where a patent seems deserving of prolongation only in respect of one head of invention out of several, the prolongation will be granted solely with reference to that head. (*Bodmer's Patent*, 8 Moore, P. C. C. 282; *Lee's Patent*, 10 Moore, P. C. C. 226; *Napier's Patent*, 6 App. Cas. 174; *Church's Patents*, 3 R. P. C. 102.)

In the case of two cognate patents which had different terms to run, it was ordered that the extensions granted should be such that they should both expire on the same day. (*Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.)

Where the invention is one of great merit, and the patentee has assigned his interest in it to another person for a sum which, looking at the profits likely to be derived from working the invention, appears an inadequate consideration, the Privy Council will see that the patentee receives further reward. With this view, a condition is sometimes introduced into the new patent, making it void in case a fixed annual sum, or a certain share in the profits,

be not paid to the patentee by the assignee. (*Whitehouse's Patent*, 1 W. P. C. 473; *Hardy's Patent*, 6 Moore, P. C. C. 441; *Morton's Patent*, 51 Eng. 274.)

So also where a patentee had mortgaged his patent, and he and his mortgagees asked for a prolongation, it was granted to the patentee alone. (*Bovill's Patents*, 1 Moore, P. C. C. n. s. 348.) But in *Church's Patents* (3 R. P. C. 95) the patentee undertook to give the mortgagee the same security over the new patents that he had over the old. Again, where the petition had been presented by the patentee and the assignee of a moiety of the patent, and the patentee had died before the hearing, a prolongation was granted on the condition that the assignee should hold one moiety of the new term on trust for the personal representatives of the deceased patentee. (*Herbert's Patent*, L. R. 1 P. C. 399.) Other special conditions are sometimes inserted in the new letters patent: for example, that the patented article should be sold to the public at a certain price (*Hardy's Patent*, 6 Moore, P. C. C. 441); that licences should be granted on certain terms (*Mallet's Patent*, L. R. 1 P. C. 308; *S. C.* 4 Moore, P. C. C. n. s. 175); or that the Admiralty should have the privilege of using the invention (in this case an improved propeller for steam and other vessels) without licences from the patentee. (*Pettit Smith's Patent*, 7 Moore, P. C. C. 133.) But in the cases of *Lancaster's Patent* (2 Moore, P. C. C. n. s. 189) and *Carpenter's Patent* (*ibid.* 191) the Judicial Committee refused to insert this latter condition. For instances of other special conditions introduced into the new patent, see *Bodmer's Patent* (8 Moore, P. C. C. 282); *Normandy's Patent* (9 Moore, P. C. C. 452).

When a prolongation of a patent term has once been granted, the jurisdiction of the Judicial Committee is exhausted, and they have no power to entertain an application for a further extension. (*Goucher's Patent*, 2 Moore, P. C. C. n. s. 532.)

When an order has been made by her Majesty in Council for the extension of a patent, or for the grant of a

new patent, an office copy of such order must be forthwith left at the Patent Office that it may be entered in the register. (See Rule 74 of the Patents Rules 1890.)

#### COSTS.

The seventh sub-section of the twenty-fifth section of the Patents Act of 1883 directs that the costs of all parties of and incident to proceedings for the extension of a patent shall be in the discretion of the Judicial Committee, and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

Where the ground of opposition to a patentee's application is frivolous, costs have been awarded to him; but where the case is difficult and doubtful and there is fair ground for opposition costs will not be given to a successful petitioner. (*Church's Patents*, 3 R. P. C. 95.) On the other hand, if a successful opposer has conducted his case in a proper manner, he may obtain his costs. (*Honiball's Patent*, 9 Moore, P. C. C. 394; *Johnson's Patent*, L. R. 4 P. C. 75; *Hills' Patent*, 1 Moore, P. C. C. n. s. 271; *Wield's Patent*, L. R. 4 P. C. 89; *S. C.* 8 Moore, P. C. C. n. s. 300; *Newton's Patent*, 51 Eng. 208.) Costs of opposition have been given against a petitioner who abandoned his application. (*Mackintosh's Patent*, 1 W. P. C. 739; *Hornby's Patent*, 7 Moore, P. C. 503; *Milner's Patent*, 9 Moore, P. C. C. 39; *Morgan-Brown's Patents*, 3 R. P. C. 212.)

It is not unusual for the Privy Council to award opposers a lump sum for costs, to be (when more than one) divided between them. In the case of *Newton's Patent* (51 Eng. 208), the opposers were so awarded 1,000*l.* In the case of *Johnson's Patent* (L. R. 4 P. C. C. 83), the opposers were ordered to receive 500*l.*, and in *Ball's Patent* (4 App. Cas. 171) an order was made for payment of 400*l.* to the opposers in lieu of costs.

By the Privy Council Rules in patent cases, the taxing

officer is empowered to allow or disallow at his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

SELECTED DECISIONS OF THE PRIVY COUNCIL.

The following cases have been selected to illustrate what has been said with reference to the considerations guiding the Judicial Committee in arriving at a conclusion in regard to the term of extension under different circumstances.

On an application for an extension of a patent granted to James Kay, for improved machinery for preparing and spinning flax, it was shown that the patentee had expended 500*l.* in experiments, 500*l.* in obtaining his patent, 2,200*l.* in law expenses, and that he had made about 6,800*l.* profit. The invention was one of great utility, was used by nearly all the flax-spinners in the kingdom; but looking at the sum already cleared by the patentee, it was thought that a prolongation for three years would satisfy the justice of the case. (*Kay's Patent*, 1 W. P. C. 568.)

Richard Roberts obtained a patent for improvements in spinning-jennies, the value of which was so great that, during the last three or four years of the original term, 5,000*l.* a year had been made by the patentee. In consequence, however, of piracies, of combinations amongst work-people, but chiefly of a fire, supposed to have been the act of an incendiary, which destroyed the patentee's premises, and entailed a loss of 10,000*l.* beyond the insurance, the profits did not reach the amount of loss by several thousand pounds. The Committee of the Privy Council, guided by the ingenuity of the invention, and the peculiar character of the resistance to its introduction, were of opinion that seven years' prolongation was merited. (*Roberts' Patent*, 1 W. P. C. 573.)

L. W. Wright applied for an extension of his patent for improvements in bleaching apparatus, and gave evidence before the Committee of his pecuniary embarrassments, and the disputes which had arisen out of his partnership with various persons; which embarrassments and disputes

had prevented the introduction of the invention to the trade. He showed that the invention had been successfully practised by several bleachers, but that he had hitherto derived no benefit whatever from it. The Committee reported that it would be proper to prolong the term for seven years. (*Wright's Patent*, 1 W. P. C. 575).

A patent for a new method of preparing iron plates for tinning was granted in 1839 to Thomas Morgan, who, being unable to work the invention, had sold his patent right for 200*l.* to persons who applied, in conjunction with the patentee, for an extension of the term. The assignees had made a profit of about 1,000*l.* a year for three years, and the patentee, in addition to the sum received from them, was making about 2*l.* a week out of the patent. The invention appearing to possess only a moderate degree of merit, the Committee thought that the benefit received by the patentee and his assignees was a sufficient reward, and they refused the application. (*Morgan's Patent*, 1 W. P. C. 737.)

Beanlands' petition for an extension of his patent for quadrants for opening, shutting, and fastening windows was dismissed, on the ground that, the accounts having shown that his profits amounted to 700*l.*, and those of his licensees to upwards of 300*l.*, the patentee had been adequately remunerated, considering the small merit of the invention and the absence of great public utility. (*Beanlands' Patent*, 4 R. P. C. 489.)

A patent for printing yarns of any fibrous materials was granted in 1828 to Bennet Woodcroft, who, on the expiration of the original term, applied for an extension. The patented process gave to cloth made of yarn, printed by it, a peculiarly clouded appearance, and the invention gave rise to the manufacture of clouded silks and fabrics. During the first four years of the patent 7,000*l.* were realised under it. Certain duty, however, was taken off other goods, and from this cause and others a large capital invested in working the patent ceased to be profitable, and the patent right became of small value. At a subsequent

time the invention, under an improved form, was stated to have become of considerable value, and it was thought proper to apply for an extension of the patent. But the Committee, having regard to the amount of profit already realised, and to the fact that the invention, in its improved and valuable form, was introduced from abroad by other persons than the patentee, refused the application.

In 1840 Orlando Jones obtained a patent for improvements in the manufacture of starch. His method consisted in applying a weak solution of caustic alkali to rice. It was shown, at the hearing of an application for an extension of the patent, that the principle of the invention had been discovered by another person prior to the date of Jones' patent, although Jones was not aware of the fact. The invention being thus shown to have no novelty, the application was refused, and costs to the amount of 100*l.* were decreed against the petitioner.

On the application for an extension of Derosne's patent, for improvements in refining sugar, it appeared that the patentee's net profit had been about 3,300*l.* But the benefit to the public was so great, being appreciable in every pound of sugar consumed, that an extension of six years was granted. (*Derosne's Patent*, 2 W. P. C. 1.)

G. F. Muntz applied for an extension of his patent for improvements in the manufacture of sheathing for ship bottoms, and showed that he had made 55,000*l.* by the manufacture during the existence of the patent. The applicant contended that this sum did not represent his profit as an inventor and patentee, but his profit as a manufacturer. But the Committee of the Privy Council said it was impossible to sever these two heads of profit. It was by means of the patent that he had made the profit. It had given him a monopoly preference; because as patentee he was enabled to sell and trade in a manner which, but for his invention and his patent, he could not have done. The application for a prolongation of the patent was refused. (*Muntz's Patent*, 2 W. P. C. 113.) See also *Hills' Patent* (1 Moore, P. C. C. N. s. 258);

*Saxby's Patent* (L. R. 3 P. C. 292; S. C. 7 Moore, P. C. C. N. S. 82).

A patent was obtained in 1831 by A. M. Perkins for improvements in an apparatus for heating air in buildings, heating fluids, &c.; and in 1845 he applied for an extension, on the ground that he had been inadequately rewarded. The ingenuity of the invention, and its application to a great number of purposes, having been shown, the accounts were investigated; when it appeared that there had been a profit of 15,176*l.* upon gross receipts to the amount of 64,920*l.* The patentee claimed further to reduce the sum representing his profits, by deducting 500*l.*, the cost of experiment, 2,700*l.* interest at five per cent. on the average amount of capital employed, and 5,400*l.* for an allowance of 400*l.* a year to the patentee for his personal superintendence of the business. These sums reduced the profits to 6,576*l.* net. An extension of five years was granted, the invention being ingenious and useful. (2 W. P. C. 7).

An application for the extension of a patent for improvements in the manufacture of steel was opposed on the ground that, whereas the patented process consisted in the addition of carburet of manganese to the crucible, it had been subsequently discovered that a better process of making steel was to place carbonaceous matter and manganese separately in the crucible, and this process obtained generally in practice. The Privy Council thought that the merit of the original invention was not thereby materially detracted from, and they granted an extension for seven years. In granting so long a time, the litigation going on in the courts of law was taken into account, as it was thought probable that some time would elapse before the litigation would terminate and the patentee's representatives have the benefit of the extension granted. (*Heath's Patent*, 2 W. P. C. 257).

Whitehouse, an ingenious mechanic, procured a patent for improvements in the manufacture of iron tubes, which he assigned to his master, Russell, who laid out 14,000*l.* in works to carry out the manufacture. The tubes were in



great demand, being applicable to a variety of new purposes; but, as the manufacture was simple, many expedients were adopted for evading the patent, and Mr. Russell was involved in much litigation, in consequence of which, combined with the loss incurred by surreptitious manufacture and sale, his profits were very considerably reduced. There was evidence to show the value and importance of the invention, the losses he had suffered from infringements, and the great reduction that would take place in the value of the premises and machinery (much of which was fitted only for the particular manufacture) if the patent were thrown open. He further showed that his life had been endangered by the anxiety of certain law proceedings. One witness stated that, if the manufacture were thrown open, it would hardly be worth following: the process was so beautifully simple, that it would almost be within the reach of any person of capital. The net profits amounted to about 13,000*l.*; but this was shown to be not much greater than the ordinary profits on stock without the protection of a patent. The Committee thought the patent ought to be extended for six years, the original patentee receiving 500*l.* a year out of the profits for that time. (*Whitehouse's Patent*, 1 W. P. C. 473.)

A patent for forging and shaping small articles in metal was obtained by Mr. Ryder in 1841: when he applied for an extension, he pleaded that though the profits had been 7,000*l.*, they had only been made during the last four years. This, however, was held to be no ground for the application in the face of the large sum realised, and the petition was dismissed. (*Ryder's Patent*, 'Pract. Mech. Journ.' vol. vii. p. 238.)

In *Ruthren's Patent* ('Pract. Mech. Journ.' 2nd Series, vol. viii. p. 159), which was a patent for improvements in the propulsion of vessels, the invention was proved to be of very great merit, and to have failed in being brought into general use through circumstances altogether independent of the will and without the fault of the inventor, who had not merely derived no profit, but had suffered

considerable loss from his patent. It was shown, moreover, that the Admiralty had then lately instituted experiments with a view to the adoption of the invention, and that several friends of the inventor were willing to provide large capital for working the invention, should a prolongation be obtained. Evidence was also given that from the nature of the invention it would necessarily be a long time before its merit could be properly brought before the public. Under these circumstances the Judicial Committee (stating that they considered the case exceptional) granted a prolongation for the unusual period of ten years.

In the case of *Sillar's Patent* (Goodeve's cases, p. 581), it appeared that the patent had been sold by the patentees to a Joint Stock Company, who had paid them a sum which seemed to be commensurate with the value of the invention. The company had afterwards floated their shares in the market, and had thereby made considerable profit. They then applied for an extension of the patent, but it was refused, although they had been considerable losers by working the invention.

Major Childs obtained a patent in 1869 for improvements in the manufacture of bread and biscuits. By this invention a nutritious aërated bread could be made by machinery with regularity and certainty. Down to 1873 the inventor had failed in his endeavours to get the invention fairly worked, but in that year he became chairman of the Aërated Bread Company, and let them have the use of his patent. It was not until 1883 that a large central manufactory was started in London for the making of bread by his process. He received a salary of 600*l.* as chairman and managing director of the company, which was paying 8 per cent. on the shares, of which he held 12,000. The counsel appearing for the Crown estimated that the inventor had made a profit under the patent of between 20,000*l.* and 30,000*l.*, including the rise in the value of the shares held by him. The Judicial Committee were satisfied that the invention possessed considerable merit, and, although the inventor had made for the last five years a profit which

was increasing, they came to the conclusion that he had not been sufficiently remunerated, and a prolongation for five years was granted. (*Childs's Patent*. The 'Times,' Dec. 1883.)

A petition for a prolongation of Deacon's two patents obtained for improvements in measuring the flow of water through pipes was presented in 1887. The accounts showed that the patentee had made a profit of 6,000*l.*, and that he had besides an interest in a public company to which the patents had been assigned. The invention being very meritorious, an extension of three years was recommended. (4 R. P. C. 119.)

Nussey and Leachman in 1876 obtained a patent for improvements in machinery for pressing fabrics. An application for its extension was heard in December 1889, when their lordships, remarking that they could not say there had been no utility, but finding there had been a net profit of 4,000*l.*, and looking at the degree of merit and amount of remuneration, declined to report that the patentees had not been adequately remunerated. It was also stated that the Privy Council had taken into consideration the fact, although they had not decided the case wholly upon it, that the petitioners had got new letters patent for improvements upon the patent, which had almost shut out the use of that patent. (7 R. P. C. 22.)

The exceptional period of ten years was granted in the case of *Stoney's Patent* (5 R. P. C. 518), where it appeared that the invention possessed considerable merit, but had a very small scope for its employment, whilst the patentee had derived no profit from it. This was a patent for improvements in sluices and floodgates. Mr. Justice Groves' instructive judgment may be usefully consulted with reference to the case which a petitioner for an extension ought to make out before the Privy Council.

## CHAPTER XV.

## ASSIGNMENTS AND LICENCES.

POWER both to assign and to license is by implication given to the patentee by the patent.

It is desirable to register both assignments and licences as soon as may be after their execution. If his assignment is not registered an assignee cannot maintain an action for an infringement against third parties except licensees from the assignor subsequent to and with notice of the assignment. See *Chollet v. Hoffmann* (7 E. & B. 636); *Hassall v. Wright* (L. R. 10 Eq. 510), cases under the old law. See the Chapter on Registration, and Rules 67-72 and 77 of the Patents Rules 1890.

Rules 67 to 72 prescribe a somewhat complicated system of registry for assignments and licences. In all cases there must be a request in writing to the Comptroller to register, and the original document to be registered, together with an attested copy, must be left with the Comptroller. The practice of registration under the Act of 1852 was quite as effective and much more simple.

## ASSIGNMENTS.

To be a valid instrument, an assignment ought to be a deed under hand and seal. It is usual to introduce into assignments covenants on the part of the patentee that he is the true and first inventor, and that the patent is valid. In those cases where the assignor does not part with his entire interest in and under the patent it may be well to insert a covenant binding him not to seek leave to amend the specification or drawings without the written consent of the assignee.

Under the twenty-fifth section of the Patents Act of 1852, a patent obtained in the United Kingdom for an invention previously patented in a foreign country came to an end at the expiration of the foreign patent. But as this provision has not been inserted in the Patents Act of 1883, it is not now of importance for an assignee to see that the foreign patent is kept on foot, although when the assignment deals with a British patent obtained under the Act of 1852 it is still incumbent upon him to see that the foreign patent had not expired prior to January 1, 1883.

A patentee is empowered, by the thirty-sixth section of the Act of 1883, to assign his patent for any place in or part of the United Kingdom or Isle of Man as effectually as if the patent were originally granted to extend to that place or part only.

This provision seems to be of very doubtful utility, and prudent patentees may well hesitate to make assignments under it. To assign a patent for a place or district might not improbably land both parties in grave difficulties which do not all lie on the surface.

It is no answer to an action to enforce a contract for the purchase of a patent for a stipulated sum (*Hall v. Conder* 2 C. B. n. s. 22) to plead that the patent is wholly worthless and of no utility, and that the subject-matter of the patent was not the novel invention of the plaintiff, there being no proof of fraud, and no express warranty. Such a contract was held merely to have the effect of placing the purchaser in the same situation as the seller was with reference to the patent, and the purchaser is bound to take it with all its faults. This being so, it is desirable to consider whether or not an express warranty of the patent should not be introduced into contracts of this nature. See also *Smith v. Neale* (2 C. B. n. s. 67).

The purchaser ought invariably to have a search made by a competent person at the Patent Office and elsewhere as to the novelty of the invention, prior to his entering into a contract for the purchase.

One of two or more joint patentees cannot assign more

than his share of the patent. (*In Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475).

The assignee of part of a patent separate from other parts may bring his action for an infringement of such part without joining as plaintiffs those persons who have distinct interests in the other parts, but have no interest in the damages sought to be recovered. (*Dunnicliff v. Mallet*, 7 C. B. n. s. 209.) This decision was mentioned with approval by the Court when delivering judgment in the case of *Walton v. Lavater* (8 C. B. n. s. 184), where it was unsuccessfully contended that the assignee of an undivided share of a patent had not a sufficient legal interest to sue for its infringement.

It has been held that one co-owner of a patent may sue alone for the recovery of profits due for the use of the patent without making his co-owners parties. (*Sheehan v. G. E. Ry. Co.*, 16 Ch. D. 59.) (See, however, *Van Gelder & Co. v. Sowerby*, 7 R. P. C. 41.)

The assignee of a share of the profits of the patent is entitled to call on a licensee of the patentee for an account, but the assignee suing must make the assignor and the assignees of other shares of the profits parties to the suit, and must offer to pay any moneys due from the assignor to the accounting licensee. (*Bergmann v. Macmillan*, L. R. 17 Ch. D. 427.)

The assignee of the original assignee takes subject to his covenants if he has notice of them. (*Werderman v. Société Générale d' Electricité*, L. R. 19 Ch. D. 247.)

Where a patent is assigned to two persons and one dies, the survivor may sue for an infringement committed during the lifetime of the other. (*Smith v. London and North-Western Railway Company*, 2 E. & B. 69). In the event of a patentee's bankruptcy, the patent becomes vested in the trustee, who may sue for infringements committed before the bankruptcy. (*Hesse v. Stevenson*, 3 Bos. & P. 577; *Bloxam v. Elsee*, 9 Dowl. & R. 215; *S. C.* 6 B. & C. 169.)

Where a partnership at will was formed for the purpose of working an invention for which a patent had been previously obtained and registered in the name of one of the

partners alone, it was held that the patent became an asset of the partnership, and each partner acquired a right to work the invention. Also that this right was not taken away by the registered owner assigning the patent to a third party who had notice of the existence of the partnership. (*Kenny's Button-holing Company v. Somerville*, 37 L. J. Rep. N. S. 878).

It is not contrary to public policy for a patentee, on the assignment of his patent, to contract to assign to the purchaser all future patents which the vendor may obtain having relation to the invention already patented or being of similar nature. (*Printing and Numerical Registering Company v. Sampson*, L. R. 19 Eq. 462.)

A body corporate may take an assignment of a patent, and be registered as the proprietor thereof in its corporate name. (See Rule 73 of the Patents Rules 1890.)

A patentee, after assigning all his interest in a patent for a valuable consideration will not be allowed in an action against himself for an infringement to raise the question whether the patent is void for want of novelty (*Walton v. Lavater*, 8 C. B. N. S. 162, 187; and see also *Chambers v. Crichley*, 33 Bea. 374), unless the patent has been made invalid by the assignee's disclaimer. (*Hocking v. Hocking*, 4 R. P. C. 434.)

But a patentee whose patent has been assigned by the trustee under his bankruptcy is not estopped in an action brought by the assignee against the patentee for an infringement from showing that the patent is bad for want of novelty in the invention. (*Cropper v. Smith*, 1 R. P. C. 92; and see *Goucher v. Clayton*, 11 Jur. N. S. 107.)

#### LICENCES.

Licences have various intents. In their most general form they are nearly tantamount to an assignment of the patentee's whole rights. But usually they are for a term shorter than that mentioned in the patent, and sometimes they do not extend to the whole of the invention. A licence may be restricted, likewise, to a particular district.

What is called an *exclusive licence* is one by which the patentee binds himself not to empower any other person to exercise the patent privilege, either at all or within a given district.

A licence to A. to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. (*Thomas v. Hunt*, 17 C. B. n. s. 183).

The consideration for the grant of a licence is usually an immediate money payment or a periodical payment, which may be either of a certain amount or dependent upon the extent to which the licensee uses the invention. In the last case care should be taken not to create a partnership when no partnership is contemplated. See *Ridgway v. Philip* (1 Cr. M. & R. 415); *Elgie v. Webster* (5 M. & W. 518).

In preparing licences the following points should be attended to:—The patentee ought to enter into the usual qualified covenants that the patent is valid, and that he has a right to grant the licence. The licensee should covenant to pay any sums the payment of which is postponed to a future time. Where the payments are to vary with the extent to which the licensee shall use the invention, there ought to be covenants, on the part of the licensee, to render properly verified accounts, and to allow periodical inspections of books, machinery, stock, &c. If it be intended that the licensee should not be permitted to question the validity of the patent or the sufficiency of the specification, recitals should be introduced affirming these points, or express covenants debarring the licensee from raising the question. But recitals can only affirm the facts as they stood at the time of the execution of the deed: covenants may be made to apply to all future time. Recitals, however, will have the effect of estopping the parties from disputing the facts recited. (*Bowman v. Taylor*, 2 Ad. & El. 278; *Hills v. Laming*, 9 Exch. 256.) In the absence of such recitals or covenants, a licensee, when sued for money reserved by the licence, may, where the contract is executory, or where there is the taint of



fraud, set up, as a defence, that the patent is void. (*Hayne v. Maltby*, 3 T. R. 438; and see *Pidding v. Franks*, 1 Mac. and Gord. 56.) On the other hand, refer to the case of *Lawes v. Purser*, 6 Ell. and Bl. 930. This was an action brought by a patentee upon an agreement whereby the defendant contracted to pay a certain sum per ton of an article manufactured and sold by him, by permission of the plaintiff to him given at his request, the sole manufacture and sale of such article being the subject of the plaintiff's letters patent. The invention having been used by the defendant, he refused to pay the stipulated sum, pleading that the letters patent were void, and that he had a right to make and sell the article without licence. It was held that the defendant was not entitled to set up such a defence, the contract having been executed, and no fraud being alleged. But one of the judges thought that if the defendant had given notice that he disputed the validity of the patent, and would in future use the invention in his own right, such notice would change the position of the parties: for after it the patentee might sue the defendant for an infringement of his patent for any subsequent user; and perhaps, in an action on the agreement for the price of such subsequent user, the invalidity of the patent might be a defence.

Although the licence deed may contain no express power of revocation the licensor is entitled to treat the licence as forfeited and to determine it, if its terms and conditions have been broken. A simple notice in writing is sufficient for the purpose, an instrument under seal not being necessary. (*Ward v. Livesey*, 5 R. P. C. 102). But it will be prudent to insert a clause giving the patentee power to render the licence void, in case of non-payment of royalties or other sums reserved, or on non-performance of any of the covenants. Power is sometimes reserved to place the royalties in the hands of a stakeholder during litigation affecting the patent.

It seems that a licence is not assignable to a third person in the absence of an express or implied power to

assign, such as where the licence is granted to the licensee, his executors, administrators, or assigns. (*Bower v. Hodges*, 22 L. J. C. P. 198.)

There is no decision as to the power of one grantee to grant a valid licence without the consent of his co-grantees, but it would probably be held that he cannot.

It was held by *Lord Romilly, M. R.*, in *Mathers v. Green* (34 Beav. 170), that when one of three joint patentees had granted licences, he was bound to account to his co-patentees for the royalties received.

As licensees sometimes exercise their right of making or dealing in articles *ejusdem generis*, but outside the patent under which they are licensed, it may be well to consider in some cases whether a covenant should be introduced restraining them from so doing. It is frequently stipulated that articles made by a licensee shall be marked in such a way as to show that they were made under the patent.

In the case of an exclusive licence it is desirable that the licensee should covenant to pay a certain minimum sum at stated periods in the shape of royalty; and in some cases to insert covenants on the part of the patentee to proceed against persons infringing the patent (see *Henderson v. Mostyn*, L. R. 3 C. P. 202), or to permit the licensee to proceed in the patentee's name.

When a sum of money has been paid for a licence, and the consideration fails, the money may be recovered. Thus in *Knowles v. Bovill* (22 L. T. N. S. 70), it appeared that a patentee had granted to the plaintiff a licence to use his patent, and had agreed to apply for a prolongation of the patent of which the plaintiff was to have the benefit; and he further agreed to grant a licence under a new patent, for which he had applied. The patentee, however, died shortly afterwards without having done anything. It was held that the plaintiff could recover the money paid from the patentee's executors.

In *Chanter v. Leese* (4 M. & W. 295, affirmed on appeal, 5 M. & W. 698), there was a licence not under seal to use

six patents, one of which was found to be invalid; it was held that there was a failure of consideration, as there was no proof that the licensee had used the five good patents and there was no apportionment of the annual payments.

On the other hand, it has been decided that annual sums paid in consideration of a licence cannot be recovered by action when the patent turns out to be void (*Taylor v. Hare*, 1 Bos. and Pul. N. R. 260); except where fraud is proved. (*Lovell v. Hicks*, 2 Y. and C. 472). To meet this case it will be prudent to have a covenant in the licence, under which the parties may readjust their accounts in the event of the patent proving void or voidable.

A licensee during the continuance of the licence cannot set up as a defence to an action for the royalty that the invention was not new or not useful, or that the patentee was not the first inventor, or that the specification is insufficient. (*Noton v. Brooks*, 7 H. & N. 499; *Trotman v. Wood*, 16 C. B. n. s. 479; *Smith v. Scott*, 5 Jur. n. s. 1356; *Charasse v. Stevens*, W. N. 1874, p. 193; *Adie v. Clark*, L. R. 2 App. Cas. 423; *Liardet v. Electric Lighting Co.*, W. N. 1883, p. 96.) But when in such a case the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other and more natural one would make it good, it was held that the licensee may insist that the latter is the true construction. (*Trotman v. Wood*, 16 C. B. n. s. 479). But now see *Adie v. Clark* cited above. Even where no formal licence has been executed, a person who has paid money in the nature of a royalty will not be allowed to dispute the validity of the patent. (*Crossley v. Dixon*, 10 H. L. C. 293.) Furthermore, a licensee will not be permitted to use the invention without payment of the royalties he has covenanted to pay, even after the patent has been found invalid in proceedings between other parties. (*The Grover & Baker Sewing Machine Company v. Millard*, 8 Jur. n. s. 713.)

The plaintiff held an exclusive licence from the patentee of a machine to use the invention within a certain district for four years, and the licence was registered at the Patent

Office. After the date of the licence and before the time expired the defendants brought into the district certain machines which they had purchased from persons who had bought them from the patentee outside the district. It was held that as there was no proof that the defendants had notice of the licence they were not liable in an action to restrain the use of the machines within the district. (*Heap v. Hartley*, 5 R. P. C. 603; S. C., on appeal, 6 R. P. C. 496.)

A licensee has, however, a right to have it ascertained what is the field covered by the specification as properly construed, and is entitled to say that he has not gone inside that field. He may seek to have the boundary of the patentee's invention defined with the view of showing that he had not rendered himself liable to make the payments stipulated in the licence. (*Adie v. Clark*, L. R. 4 App. Cas. 423; *Couchman v. Greener*, House of Lords, 1 R. P. C. 197; *Useful Patents Co. v. Rylands*, 2 R. P. C. 255; *Crosthwaite v. Steele*, 6 R. P. C. 190.) And after a licence has been determined, a licensee is at liberty to dispute the validity of a patent in a suit for an injunction to restrain an infringement. (*Dangerfield v. Jones*, 13 L. T. N. S. 142; *Armann v. Lund*, L. R. 18 Ch. D. 330; and see *Neilson v. Fothergill*, 1 W. P. C. 290).

In an action for infringement the defendant, being the mortgagee of certain articles made under a licence which the plaintiff alleged had been revoked, disputed the fact of revocation, and at the same time contended that the patent was invalid. It was held that he must elect which of these lines of defence he would take. (*Post Card Automatic Supply Co. v. Samuel*, 6 R. P. C. 560).

A licence was granted during the period of provisional protection. The scope of the invention was afterwards considerably limited. The licensees contended that the licence was void, but it was held upon the particular words of the licence that the licensees were bound by the deed. (*Otto v. Singer*, 7 R. P. C. 7.)

An exclusive licensee has no right to bring an action

for an infringement in his own name without joining the patentee. (*Heap v. Hartley*, 5 R. P. C. 602; S. C. on appeal, 6 R. P. C. 496.) An ordinary licensee has no right to apply in the name of the owner for an injunction to restrain infringements (*Newby v. Harrison*, 1 J. & H. 393), nor has the agent of the patentee. (*Adams v. North British Railway Company*, W. N. 1873, p. 191.)

A patentee will not be allowed to publish advertisements and circulars calculated to deter the public from dealing with his licensee. (*Clark v. Adie*, 21 W. R. 764.)

The following cases relate to licences connected with partnerships: *Chambers v. Crichley* (33 Bea. 374); *Armann v. Lund* (L. R. 18 Eq. 330); *Hugh v. Chamberlain* (25 W. R. 742).

Formerly when the patent was silent as to the form of licence, a simple licence, without covenants, need not have been under seal (*Chanter v. Dewhurst*, 12 M. & W. 823; *Reuss v. Lever*, Ch. Div. April 9, 1879; V. C. Hall); nor, it seems, if it was not a deed, did it require a stamp. (*Chanter v. Johnson*, 14 M. & W. 408.) But now the form of patent set forth in the first schedule of the Act of 1883 requires licences to be in writing under the hand and seal of the patentee. A stamp of 10s. must be impressed in ordinary cases, and an *ad valorem* stamp on the consideration-money when a fixed sum is paid. When a licence contains a covenant for the payment of a minimum royalty, the Stamp Office insists upon payment of an *ad valorem* duty upon the gross minimum royalty reserved, and this although the licence contains power for licensor or licensee to determine the licence.

*Compulsory Licences.*—The twenty-second section of the Patents Act of 1883 introduced an entirely new regulation as to licences by empowering the Board of Trade to order a patentee to grant licences to persons petitioning the Board.

‘If on the petition of any person interested it is proved to the Board of Trade that, by reason of the default of a patentee to grant licences on reasonable terms, (a) the

patent is not being worked in the United Kingdom; or (b) the reasonable requirements of the public with respect to the invention cannot be supplied; or (c) any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus,' which will require an application to the High Court of Justice.

Patents granted before the commencement of the Act, or on applications then pending, are excepted from the operation of this provision. (Sect. 45.)

As to the procedure on petitions for compulsory licences see Rules 60-66 of the Patents Rules 1890.

As to the persons representing the Board of Trade in all matters authorised to be done by the Board under the Patents Act of 1883, and as to the documents and certificates issued by the Board, see the 25th sect. of the Act of 1888, or sect. 102A of the Act of 1883.

The orders of the Board in relation to this difficult and delicate matter seem to be absolute and final, no appeal from their decision being given by the Act; nor is any power to award costs given to the Board. From the wording of the section it is clear that the three grounds for application are independent of each other, any one if properly proved being sufficient to authorise the Board to make an order on a defaulting patentee. To rebut the charge that a patent is not being worked in the United Kingdom the patentee, whether British or foreign, would probably be required to show that any manufacture established in this country was of a real and substantial nature carried on *bonâ fide* under the same conditions and to the same extent as a licensee, not exclusive, would carry it on under a reasonable royalty.

Up to the time of the publication of this book very few petitions have been presented to the Board of Trade for compulsory licences, and not a single order has been made

under the powers given to it. This section of the Act, though apparently a dead letter, may yet have had a certain indirect effect, by inducing patentees to come to terms privately with persons who desire to take licences, when otherwise they might have refused to do so. And in some cases foreigners who have obtained British patents for their inventions may possibly have been prompted to establish manufactories in this country instead of manufacturing the goods abroad and importing them.

In case a patentee should have made a *bonâ-fide* grant of an exclusive licence, it may be doubted whether he would be ordered by the Board to grant other licences, and still more whether such an order, if made, would be enforced by mandamus in a court of law.

## CHAPTER XVI.

## THE REGISTRATION OF PATENTS, ETC.

THE twenty-third section of the Patents Act of 1883 directs that there shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. The Register of Patents will be *primâ-facie* evidence of any matters by the Act directed or authorised to be inserted therein. Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

By the eighty-seventh section of the Act, where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered, as proprietor of the patent, in the Register of Patents. The person for the time being entered in the Register of Patents as proprietor of a patent shall, subject to the provisions of the Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Any equities in respect of such patent may be



enforced in like manner as in respect of any other personal property.

Notices of trusts, expressed, implied, or constructive, are not to be entered in the register nor to be received by the Comptroller. (Sect. 85.)

The probate of a patentee's will or the letters of administration must be registered, in order that when the executor, administrator, or legatee comes to deal with the patent the chain of title may be complete.

The procedure as to the registration of patent documents is set forth in Rules 67-77 of the Patents Rules 1890. A fee of ten shillings is payable for each entry on the register. The Patent Office refuses to register any document until the patent affected has been sealed. Deeds left for registration must be duly stamped.

The Court may (sect. 90), on the application of any person aggrieved by the omission without sufficient cause of the name of any person (or of any other particulars, sect. 23 of Act of 1888) from the register or by any entry made without sufficient cause in such register, make such order for making, expunging, or varying the entry as the Court thinks fit; or the Court may refuse the application: and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. Further, the Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved. Any order of the Court rectifying a register must direct that due notice of the rectification be given to the Comptroller; and Rule 74 of the Patents Rules 1890 requires an office copy of the order to be left at the Patent Office.

In *Re Parnell's Patent*, 5 R. P. C. 130, Mr. Justice North said he saw that there may be documents which can be properly entered on the register although dated before the date of a patent, but in many instances the objections

against the registration of such pre-dated documents would be insuperable.

It would seem that under the Judicature Acts there lies an appeal from any order made by a judge under section 90 of the Act of 1883. (*Morgan's Patent*, 24 W. R. 245.)

If any rectification of a register is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification must be served on the Comptroller, and he is to rectify the register accordingly. (Sect. 111.)

The Comptroller is empowered (sect. 91) to correct any clerical error in the name, style, or address of the registered proprietor of a patent.

The making of false entries in the register; the making of any writing falsely purporting to be a copy of an entry therein; and the tendering in evidence of any such writing, are declared to be severally misdemeanours. (Sect. 93.)

The former registers of patents and of proprietors are to be deemed parts of the register of patents kept under the new Act (sect. 114), which is directed to be open at all convenient times to the inspection of the public, subject to such regulations as may be prescribed. (See Rule 79.)

Certified copies, sealed with the seal of the Patent Office, of any entry in such register will be given to any person requiring the same on payment of the prescribed fee. (Sect. 88, and see Rule 79.)

The thirty-fifth section of the Patents Act of 1852 provided that until registration of an assignment the grantee of the patent should be deemed the proprietor of the exclusive privileges thereby granted; and it was held in *Chollet v. Hoffmann* (7 E. and B. 636) that an assignee could not bring an action for an infringement against third parties until his assignment had been registered. But in the case of *Hassall v. Wright* (L. R. 10 Eq. 509), Sir R. Malins, V. C., was of opinion that an assignee of a patent might maintain a suit against the assignor and subsequent licensees of the assignor with notice of the assignment to

restrain them from using the patent, although at the time of the institution of the suit the assignment had not been registered. And from the same case it seems that the judge thought that registration related back to the date of the assignment, so as to enable the assignee to maintain a suit to restrain infringement instituted between the dates of the assignment and registration. No case bearing upon this point has been reported since the Act of 1883 came into operation. When the executors of a patentee obtained probate of their testator's will and assigned his patent, but the probate was not registered till after the assignment, it was held that the assignment was valid. (*Ellwood v. Christy*, 10 Jur. n. s. 1079 ; S. C. 11 L. T. n. s. 342.)

Under the thirty-eighth section of the Patents Act of 1852, which gave power to the Courts to expunge entries in the register of patents similar to that conferred by the ninetieth section of the new Act, the Master of the Rolls ordered the registry of a second assignment of a patent to be expunged on the application of the assignees under a prior assignment, which had not been registered until after the second, as it appeared that the second assignment had been executed for a fraudulent and improper purpose. (*Re Green's Patent*, 24 Bea. 145.) In another case, the Master of the Rolls said that if there were two deeds assigning the patent *simpliciter* to two different persons, and the second was registered before the first, and if it were clearly proved that the second deed was executed with full and complete notice of the prior one, though subsequently registered, he conceived he should have power to direct an entry to be made upon the register, stating the facts. In *Re Morey's Patent* (25 Bea. 58), it was said to be the duty of the Court to insert on the register any facts relating to the proprietorship, but not the legal inferences to be drawn from them. One of two joint patentees assigned by deed his interest in the patent to a third person, and released him from all claims on the part of both patentees. At the instance of the other patentee the Master of the Rolls ordered the

entry of the assignment to be expunged. (*Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.)

In the matter of the same patent (L. R. 4 Ch. 784) it was decided that there was no appeal from such an order of the Master of the Rolls. But the jurisdiction having now been transferred to the High Court of Justice (*Re Morgan's Patent*, 24 W. R. 245), it would seem to be subject to appeal.

In *Speckhart v. Campbell* ('Times,' March 13, 1884), it was held by the Court of Appeal that a person (who in this case was a foreigner) may bring an action in his own name for an infringement when the patent is registered in the name of another person, if that other person is a trustee for the plaintiff.

Registration of an exclusive licence for a district is not in itself notice to the world. (*Heap v. Hartley*, 5 R. P. C. 603.)

## CHAPTER XVII.

## INFRINGEMENTS.

THIS chapter will be devoted to a discussion of the substantive law and the reported cases; and the next will treat shortly of the practice connected with the proceedings for infringements in the High Court of Justice.

The rights of a patentee may be violated in several ways. 1. The invention may be overtly exercised exactly as the specification has described it without the permission of the patentee. 2. The invention may be copied not textually and literally, but with certain changes and variations, such as additions, omissions, transpositions, or substitutions of parts, so as to produce something colourably different from the original. 3. By dealing in articles made by the patented method without the licence, express or implied, of the patentee. 4. By the user of articles made by an infringement of the patent.

As to the first mode of infringing a patent, nothing more need be said at present, because, when the fact is capable of proof, the remedy can be readily applied. It is the second method of encroaching on his rights that gives most trouble to the patentee. Certain devices (mechanical equivalents, transpositions of parts, &c.) having been employed to give a different appearance to the copy, with the design of seeming not to trespass within the pale set up by the patentee, and with the view of causing that copy to be mistaken for a distinct thing, it becomes the patentee's task to expose the scheme and to show that the pretended novelty is in truth an infringement in disguise. The lead-

ing idea, or principle, as it is usually termed, remaining the same, the contrivances will be considered identical, and when that is capable of satisfactory proof, the continuance of the infringement may be stopped by application to a court of law, and the infringer may be compelled to make compensation for the injury he has committed. Further, a machine may display ingenuity in its construction and may have been the work of an honest and independent inventor, yet if there is a previous patent for what is substantially the same thing it must be deemed an infringement.

A person will not be allowed to deprive an inventor of the fruits of his discovery by substituting a well-known equivalent, either chemical or mechanical, for some part of the patented invention. Where the question arises as to the infringement of the patent for a machine, the substance and not merely the form of the invention will be looked at in a court of justice. Therefore, when it is shown that two machines are alike in principle, and that the constructor of the second machine has carried the principle of the first into effect by substituting one mechanical equivalent for another, here it will be held that there has been an infringement. (See *Morgan v. Seward*, 1 W. P. C. 171; *Thorn v. Worthing Skating Rink Company*, L. R. 6 Ch. D. 415 n.; *Adair v. Young*, L. R. 12 Ch. 21.)

‘It will not be the less an infringement’ (said *Lord Cairns, C.*, in *Dudgeon v. Thomson*, L. R. 3 App. Cas. 44) ‘because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist and yet the thing protected by the specification be taken notwithstanding.’ And in the same case (p. 53) *Lord Blackburn* said, ‘If part of the property in the invention be really taken, there is an infringement, however much that may be disguised or sought to be hidden. If that is detected by the patentee, and if what is taken is really part of his property given to him by the letters patent, he has a right to proceed against the infringer, however ingeniously the colours may have been contrived to try to

conceal the fact that there has been a taking of part of the property.'

The following cases will show clearly that to make a colourable alteration in a patented invention, or to arrive at the same result by means which are substantially the same, although independently discovered, will be an infringement of the patent. Walton took out a patent for making cards for carding textile materials with the aid of caoutchouc, the object being to obtain an increased degree of elasticity and durability. The wire teeth were described as inserted in a foundation of slices of caoutchouc, on the back of which a piece of cloth was cemented. The claim was not confined to the use of caoutchouc in slices, but he claimed the exclusive right of making cards by fixing the teeth in caoutchouc as the fillet, or sheet, or medium. After the date of this patent, Potter and Horsfall took out a patent for a new material for forming the backs of cards, and their mode of preparing it was by repeatedly passing a woven fabric of a peculiar construction through, and saturating it with, a solution of caoutchouc, and then drying it to evaporate the solvents, and leave the fabric impregnated and coated with caoutchouc, the object being to render the fabric so dealt with extremely elastic in the direction of the thickness of the fabric, so as to impart elasticity to the wire teeth when set. It was held (*Walton v. Potter*, 1 W. P. C. 585) that Potter's process fell within the generality of Walton's claim, and was an infringement of his patent. At the trial, *Tindal, J.*, told the jury that, 'when a party has obtained a patent for a new invention 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 invention, to obtain either 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 evasion of the right.' Then referring to a card purchased from the defendants, which was produced to the jury, he said, 'Now, what you have to say is, whether you are satisfied that the card produced

is a specious variation in form only, an ingenious alteration in the mode of adaptation, or whether it is really and substantially a new discovery on the part of the defendants. In the one case it would be an infringement of the patent; in the other it would not. . . . 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 has been before granted exclusively to another; and therefore the question again comes round to this, whether you are of opinion that the subject-matter of this second patent is perfectly distinct from the former, or whether it is virtually bottomed upon the former, varying only in certain circumstances which are not material to the principle and substance of the invention.'

Under a patent for improvements in apparatus for the manufacture of sulphate of soda, &c., the plaintiff claimed the use of iron retorts worked in connection with each other. The essence of the invention was held to be the use of two chambers with separate furnaces worked in connection with each other, so that the materials might be decomposed in one and then removed to and finished in the other. The defendant for the same purpose employed two chambers, one of iron, the other of brick. This was decided to be an infringement of the patent. (*Gamble v. Kurtz*, 3 C. B. 425.)

Trotman obtained a patent for improvements in anchors. His mode of making the improved anchor was to affix the



'palm' and 'horn' to the back of the 'arm' by a separate operation. It was held that the making of similar anchors by forging the arm, palm, and horn all in one piece was an infringement. (*Trotman v. Wood*, 16 C. B. n. s. 479.)

In 1871 E. L. Hayward obtained a patent for an improved pavement-light. A piece of glass in the form of a prism was fitted into a frame and let into a floor with the object not only of allowing light to pass through, but also of sending it obliquely into the room below. In 1874 Hamilton took out a patent for a contrivance for the same purpose. He employed also a prism of glass shaped like that used by Hayward, except that pieces were cut out of it. The Court of Appeal held that as the notches had no effect on the strength of the apparatus, nor any optical effect, affording, in fact, no advantage whatever, there was no substantial difference between the two contrivances, and the second patent was therefore adjudged to be an infringement of the earlier one. (*Hayward v. Hamilton*, 1 Griff. P. C. 115.) And in *Hayward & Eckstein v. Pavement Light Co.* (1 R. P. C. 207), the judge at the trial of an action for the infringement of the same patent held that the use of glass moulded so as to form a curve was an infringement.

It is not permissible for a person to evade a patent by making immaterial transpositions of parts of a machine (*Cropper v. Smith*, W. N. 1883, p. 49; 1 R. P. C. 84); or by making one part act indirectly instead of directly (*Kaye v. Chubb*, 4 R. P. C. 23; S. C. on appeal, 5 R. P. C. 641); or by altering the shape of part of a machine in an unimportant particular (Per Parke, B., in *Barber v. Grace*, 1 Exch. 339); or by transposing the action of some of the parts, as, for example, in a brick machine, moving the clay against the cutters, instead of making the cutters move against the clay (*Murray v. Clayton*, L. R. 7 Ch. 570); or, in a machine for marking out the court in the game of lawn tennis, removing the marking wheel from behind to the front, and substituting a revolving brush for a feeding wheel (*Osmond v. Hirst*, 2 R. P. C. 265); or in a mechani-

cal musical instrument, employing a rotating wind chest and a fixed music sheet in place of a fixed wind chest and a rotating music sheet. (*Ehrlich v. Ihlee*, 5 R. P. C. 188; affirmed on appeal, 5 R. P. C. 437.) In *Parke v. Stevens* (8 Eq. 367), it was laid down by *V. C. James*, that a man could not evade a patentee's right by substituting a spring for a weight. And in *Winby v. Manchester, &c., Steam Tramways Co.* (6 R. P. C. 359), it was held that a patent was not to be evaded by substituting a weighted lever for a spring.

The specification under a patent for a telephone claimed a combination of a diaphragm or tympanum with a tension-regulator. In this arrangement the diaphragm was placed next the mouth when speaking into the instrument, and its vibrations acted on the tension-regulator behind. Bassano employed for the same purpose an apparatus in which a tension-regulator was nearest the mouth and what was equivalent to a diaphragm was placed behind. It was held that he had infringed the patent. (*United Telephone Co. v. Bassano*, 3 R. P. C. 295. See also *United Telephone Co. v. St. George*, 3 R. P. C. 321.)

And it has been held that a patent for improvements in a known process secures those improvements to the patentee, whether applied to the process as known at the date of the patent, or to the same process altered and improved by discoveries not known at that time, so long as that process remains essentially the same. (*Electric Telegraph Company v. Brett*, 10 C. B. 881.)

*When the Principle is New.*—‘When you have invented some mode of carrying the principle into effect,’ said *Alderson, B.*, in *Jupe v. Pratt* (1 W. P. C. 146), ‘you are entitled to protect yourself from all other modes of carrying the same principle into effect.’

‘There never were two things to the eye more different,’ said *Alderson, B.* (1 W. P. C. 146), commenting upon the case of *Crossley v. Beverley*, ‘than the plaintiff's invention of a gas-meter, and what the defendant had done in contravention of the patent right. The plaintiff's invention was

different in form, different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it. The scientific men, all of them, said, the moment a practical scientific man has got that principle in his head he can multiply, without end, the forms in which that principle can be made to operate.'

A patent having been obtained for the application of a self-adjusting leverage to chairs, an action for an infringement was brought in which the defendant contended that the plaintiff claimed a principle, inasmuch as the defendant's method of applying the leverage to chairs was different from the plaintiff's. 'But,' said *Mr. Baron Parke*, 'for the application of a self-adjusting leverage to a chair, cannot he patent that? He claims the combination of the two, no matter in what shape or way you combine them; but if you combine the self-adjusting leverage, which he thus applies to the subject of a chair, that is an infringement of the patent' (*Minter v. Mower*, 1 W. P. C. 134.)

In the case of the *Househill Company v. Neilson* (1 W. P. C. 685), *Lord Justice Clerk Hope* said, 'You may obtain a patent for a mode of carrying a principle into effect; and if you discover not only the principle, but how it may be applied to a practical result by a mechanical contrivance and apparatus, and show that you are aware that no particular modification or form of the apparatus is essential in order to obtain benefit from the principle, then you may take out your patent for the mode of carrying it into effect, and are not under the necessity of confining yourself to one form of apparatus. . . . You may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will more or less produce the benefit, and you are not tied down to any form.'

In the case of *Otto v. Linford* (Court of App., 46 L. T. N. S. 35), it appeared that the plaintiff had patented a

gas engine working on a certain new principle, and that the defendant had subsequently constructed an engine working in rather a different way with two pistons instead of one, and with six motions in place of four, which required the cams, slides, &c., to be altered. It was held that notwithstanding these differences, as he had borrowed the plaintiff's new principle, his engine was substantially similar to the plaintiff's, and was therefore an infringement. 'It appears to me to be pretty clear upon the authorities, that, although there cannot be a patent for an idea or principle apart from its physical embodiment in adequate apparatus, yet that if the specification discloses the idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea is an infringement of the patent, though the method used and even the purpose to which the idea or principle is applied be different from those embodied in the specification.' (Per *Mr. Justice Wills*, in *Easterbrook v. G. W. R. Co.*, 2 R. P. C. 207.)

And the same doctrine holds good in chemical inventions. 'When a patent is taken out for a new result' (said *Mr. Justice Pearson*, in delivering judgment in the case of the *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. L. R. 156), 'and there is one process described in the specification which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result; and no person can, without infringing upon his patent, adopt simply a different process for arriving at the same result.'

'Where the thing is wholly novel, and one that has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been done before.' (Per *Wood*, *V. C.*, in *Curtis v. Platt*, L. R. 3 Ch. 135 n.)

It seems a fair inference from the cited judicial dicta in the cases of *Jupe v. Pratt*; *Househill Co. v. Neilson*; *Minter v. Wells*; *Easterbrook v. G. W. R. Co.*; and *Badische Anilin und Soda Fabrik v. Levinstein*, to say that they tend to establish the proposition that when a mode of carrying a principle into effect has been invented and the principle itself is new, then a patent can be obtained for securing not only that particular mode but every other mode of carrying the principle into effect. But *L. J. Cotton*, when delivering judgment in the case of the *Automatic Weighing Machine Co. v. Knight* (6 R. P. C. 304), an action brought for an infringement of the plaintiff's machine, commented on Baron Alderson's words in *Jupe v. Pratt* (cited *ante*, p. 238), and made the following remarks: 'Those were the expressions of Mr. Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing with a colourable difference. . . Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether in effect, although the mode is not exactly the same, it is only a colourable difference. . . What I said in *Proctor v. Bennis* (4 R. P. C. 333) was, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variations or by mechanical equivalents, the substance of it, so as to produce the same result by practically the same means?"' . . . In the weighing machine case it had been argued by the plaintiff's counsel that his machine was the first machine which had been invented to act upon a certain principle, which principle had been adopted by the defendant, but with some differences in the mechanism, and that he was therefore liable for an infringement notwithstanding these differences. To this *L. J. Cotton* replied, 'A patent cannot be taken out for a prin-

principle. It can only be taken out if in addition to the principle shown the patentee shows some mode of carrying that effectually into operation.' And the Court of Appeal held that there had been no infringement of the plaintiff's patent, because the defendant had employed different mechanism. See also *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (6 R. P. C. 367).

*Where the Principle is not New.*—We have seen that there are judicial dicta which imply that where the principle of an invention is new, the patentee may secure not only the method of carrying it out described by him, but all other methods that fall under the same principle. On the other hand, where the principle is not new the patentee is confined to the particular method described, and his patent will not be allowed to cover other methods. Thus in *Barber v. Grace* (1 Exch. 339), it was held that the pressing of woollen goods by a set of rollers, heated within by steam, was not an infringement of a patent for a mode of pressing similar goods by two cast-iron boxes filled with steam. The jury found that the former was not a colourable variation of the latter process, and the Court, after argument, approved of the finding. (See also *Easterbrook v. G. W. R. Co.*, 2 R. P. C. 201.)

In *Curtis v. Platt* (L. R. 3 Ch. D. 135 *n.*), *Sir W. P. Wood, V. C.*, said, 'When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because, otherwise, that would be to say that the whole world is to be precluded from exercising its invention for achieving some desirable and well-known object which everybody has had in view for years. One looks more jealously at the claims of inventors seeking to limit the rights of the public at large for effecting that which has been commonly known to all the world long ago. Of course no patent can be taken out for effecting this as a new object,

but only for effecting it by a new means. What those means may be, and what is the extent of the claim which the patentee has a right to insist upon as to those means, is often a matter of much difficulty.'

'Where there is the principle first introduced in the (patented) machine we look upon it with very different eyes to what we do when what the patentee has done is simply by some variation to make an improvement in an existing machine. Then he is confined to the actual thing he has produced as an improvement in an existing machine, and we cannot say, if anyone else were to take some other mechanical means of arriving at the same end, that that is an infringement.' (Per *L. J. Cotton*, in *Proctor v. Bennis*, L. R. 36 Ch. D. 740.)

Hence if another person invents a method of carrying out the same object different from that patented, he may obtain a valid patent for it, or he may use it without being liable for an infringement, since the inventions stand independently one of the other, each inventor being limited to his own particular combination or method. Identity of object must not be mistaken for identity of means. The patented apparatus is, under the supposed circumstances, nothing more than a particular mode of attaining a certain end, and if one man is entitled to a patent for one road to that end, any other person is on the same ground entitled to a patent for another road to the same end.

Where a patent has been obtained for improvements in an old machine and there is no novelty in the result, the patentee will be held strictly to his description of the particular means by which his invention is to be carried into effect, and the doctrine of mechanical equivalents will not be applicable. (*Curtis v. Platt*, L. R. 3 Ch. D. 136 *n.*, 139 *n.*; *Saxby v. Clunes*, 43 L. J. Ex. 228; *Dudgeon v. Thomson*, L. R. 3 App. Cas. 34; *Nordenfeldt v. Gardner*, on appeal, 1 R. P. C. 61; *Hocking v. Hocking*, House of Lords, 6 R. P. C. 76.)

As an example of this class of cases, *Bovill v. Pimm* (11 Ex. R. 718) may be referred to.

It had been long known that if grain were kept cool during the process of grinding, the flour was of superior quality. To effect this desideratum various contrivances had been adopted, and several patents had been obtained for them, before Bovill obtained one for an invention consisting of the application of ventilating vanes or screws at the centre of the grinding-stones, by which means air was supplied between the grinding surfaces. A portable ventilating machine, blowing in a screw vane, which caused a flow of air parallel to the axis of the vane, was attached externally to the eye of the upper millstone. When the screw vane was set in motion air was compelled to pass through the eye of the upper millstone into the centre of the two stones, and found its way out between them. Pimm subsequently took out a patent for improvements in grinding wheat. His plan for keeping the grain cool whilst grinding consisted in the removal from the centre of both stones of a large circular portion, and in the space thus obtained to place a fan, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones. It was held that the latter method was no infringement of Bovill's; the two inventions were deemed independent original improvements, and each inventor was entitled to protection in respect of the method disclosed in their respective specifications, but could not claim beyond the method actually described.

An action was brought for the infringement of a patent dated in 1877 for improvements in machinery for winding, doubling, and twisting yarn and thread. As there were previous machines for the same purpose as the plaintiff's, all of which included a swinging-plate and a catch-plate, and as the plaintiff laid special stress on the particular form of his catch-plate as an important improvement, and when describing the machine said he did not claim the combination of a swinging-plate with any catch-plate, but only the combination of a swinging-plate with a catch-plate as described in the specification, it was held by the Court of Appeal that the plaintiff was bound to this limited



claim, and as the defendant did not use a catch-plate in his machine he had not infringed the patent. (*Boyd v. Horrocks*, 6 R. P. C. 152.)

On the other hand, where there is not only novelty in the patented machine, but also in the result produced by the machine, the doctrine of mechanical equivalents will be applied in the case of an alleged infringement. For instance, a patent was obtained for an improved and self-acting mechanism for supplying and distributing fuel at intervals over the fire surface of furnaces. From the specification it appeared that the object of the patent was the automatic placing of coal on a fire by intermittent radial motion, and this object was proved, at the trial of an action for an infringement, to be new and effected by a new combination. It was also shown that in the defendant's mechanism the motion was intermittent and radial, and produced by means of a radius as in the plaintiff's mechanism; but there was this difference: that in the plaintiff's contrivance the shaft was actuated by tappets and a spring, the radius being attached to the shaft, whilst in the defendant's contrivance the radius itself was actuated by tappets and a spring, the radius working on a pin. Thus the same radial motion, with the same result, was produced by substantially similar means. The Court of Appeal, here applying the doctrine of mechanical equivalents, held that the defendant's mechanism was an infringement. (*Proctor v. Bennis*, 4 R. P. C. 354, 359, 361.) See also *Gosnell v. Bishop*, on appeal (5 R. P. C. 156, 159); *Ehrlich v. Ihlee*, on appeal (5 R. P. C. 437); *Thomson v. Moore*, Court of Appeal, Ireland (6 R. P. C. 426).

In the case of interfering patents, the following rule was laid down by *Pollock, C. B.*, in *Bush v. Fox* (Macr. P. C. 165): 'Whenever it appears that the use of a prior patent invention would be an infringement of a subsequent patent, the second patent cannot be sustained.' See also *Thomas v. Foxwell* (5 Jur. n. s. 39); *Betts v. Menzies* (1 Ell. & Ell. 1020); and *Kaye v. Chubb* (4 R. P. C. 298).

In *Saxby v. Hennett* (L. R. 8 Ex. 210), it was held that

where two patents are in existence for the same invention, acts done under the patent of later date are infringements of the earlier patent.

*Invention of Improvements no Defence.*—A person is at liberty to patent an improvement upon an invention which forms the subject of an existing patent, without rendering himself liable for an infringement; but he will not be able to use the improved invention before the expiration of the earlier patent unless he obtains the licence of the patentee. (*Lister v. Leather*, 8 E. & B. 1004.) It is no defence to an action for an infringement to say that the infringer has invented improvements. The case of *Saxby v. Clunes* (43 L. J. Ex. 228) arose out of the alleged infringement of a patent for a mode of working the points and signals of railways. When it went on appeal to the House of Lords, *Lord Chelmsford* said that, although the defendant's invention was a great improvement upon the plaintiff's, yet if, in carrying it out, the former made use of any part of the invention to which the plaintiff's patent extended, and which was new and material, it was an infringement. See also the case of *White v. Fenn* (15 W. R. 348).

In the case of *Proctor v. Bennis* (4 R. P. C. 353), an action for an infringement which went to the Court of Appeal, *Lord Justice Cotton* made the following observations: 'What was very much relied on (by the defendant) was this: that there are certain omissions in the defendant's machine of parts which there are in the plaintiff's combination, and that there are certain things in the defendant's machine not found in the plaintiff's, producing a result which is not obtained in the plaintiff's. . . . Now, if in fact the defendant has . . . made an improvement, that will not enable him to take the plaintiff's combination which he has protected without infringing the plaintiff's patent. . . . The mere fact that there are certain parts omitted or certain parts added, if he really has taken the substance and essence of the plaintiff's combination, cannot prevent his machine being an infringement of the plaintiff's. . . . If in substance and in essence the combination is taken,

and practically the same parts, or the parts in which there is a variation, or for which there are mechanical equivalents, are so arranged as to produce the same result, then the essence of the invention has been taken, and an infringement has been committed by the defendant who makes, sells, or uses these machines.' (And see *Wenham Co. v. May*, 4 R. P. C. 308; *Hocking v. Hocking*, 4 R. P. C. 442; *Ehrlich v. Ihlee*, appeal, 5 R. P. C. 437.)

*Common Dilemma.*—In actions for infringements the defendant's defence frequently endeavours to place the patentee on one or the other horn of the dilemma, an example of which is afforded by the case of *Macnamara v. Hulse*, cited in the chapter on Novelty. If the patentee's claim is read in a wider sense so as to cover the alleged infringement, it is met by a charge of anticipation; if read in a narrower sense so as to avoid that difficulty, there is no infringement. (*Stevens v. Keating*, 2 W. P. C. 194; *Downes v. Falcon Works*, 3 R. P. C. 70; *Kaye v. Chubb*, 4 R. P. C. 289; *Gosnell v. Bishop*, 5 R. P. C. 158; *Ellington v. Clark*, 5 R. P. C. 327; *Hutchison v. Patullo*, 4 R. P. C. 359.)

#### COMBINATIONS.

With regard to the infringement of patents obtained for a general arrangement and combination of numerous parts, all of them old, or some old and some new, the whole in either case forming a new apparatus or machine, questions of some complication may arise, and it may not be easy to decide in a given case whether what has been done amounts to an infringement or not. A patentee may assert that, although his invention as described in the specification has not been exactly copied by another person part by part, yet sufficient has been taken to bring it within the reach of the law and render him liable as an infringer. In other words, that the differences are merely colourable, and that the inventions specified by the patentee and practised by the defendant are substantially identical. On the other hand, the alleged infringer may aver that what he has done, though directed to the same object and producing a

similar result, has been effected by methods that were open to all the world, and that if the means employed by him are to a certain extent similar to those employed by the patentee, they yet differ so far as to render his process or apparatus a distinct and independent mode of arriving at a common end, and do not constitute an illegal copy or evasion of the patentee's method. These opposite views may both be supported by witnesses of equal weight and credibility, and thus a very difficult question of fact may be placed before a jury or submitted to the decision of a judge. Those upon whom may devolve the duty of deciding a controversy of this nature will anxiously seek to discover on which side lies the preponderance of probability after hearing the whole case.

When the case *Clark v. Adie*, which arose out of an alleged infringement of a patent for improvements in apparatus for clipping horses, was taken on appeal to the House of Lords (L. R. 2 App. Cas. 315), *Lord Cairns, L. C.*, made the following general remarks on infringements of patents for inventions of this nature: (1) 'One mode of infringement would be a very simple and clear one: the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise.' (2) 'The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument, but he might make an instrument which in many respects might resemble the patented instrument, but would not resemble it in all its parts. And there the question would be, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented.' (3) 'But there is a third way in which it is possible to conceive an infringement of a patent of this kind. Inside the whole invention there may be that which in itself is a minor invention, and which does

not extend to the whole, but forms only a subordinate part or integer of the whole. Now again, that subordinate integer may be a step or a number of steps in the whole, which is or are perfectly new; or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term "combination." . . . In a patent of that kind the monopoly would or might be held to be granted not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind and has intended to claim protection for those subordinate integers.' Proceeding to apply these principles to the case before the House, his lordship said: 'I cannot find from beginning to end of the specification any sentence or any number of sentences, as to which, by any reasonable interpretation, you can say that they may make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture, a thing to be protected by the patent.'

In the same case (L. R. 2 App. Cas. 335), *Lord Blackburn* said: 'I incline to agree with what was said by the Exchequer Chamber in the case of *Lister v. Leather*, that you cannot decide in the abstract whether the using of two parts A and B of a combination A B and C is or is not using part of that invention, nor can you decide in the abstract the other question, whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister v. Leather*, before deciding, to have before me the nature of the machine, in order that I might see what A B and C are, and what is their relation to each other.'

The following propositions are deducible from the numerous cases which bear upon the infringement of patents relating to general combinations and subordinate parts:—1. If a combination alone is claimed there is no infringement unless the entire combination, or the substance of it, is taken. 2. Subordinate parts and minor combinations will not be protected unless they are expressly claimed. 3. Subordinate parts and minor combinations when claimed must be new, useful, and patentable *per se*.

In the earlier cases cited in the footnote<sup>1</sup> it was laid down that to take a new and material part of a combination, though not expressly claimed, was an infringement. Thus, *Lord Campbell*, in *Lister v. Leather* (8 E. & B. in error 1032), said that the cases established ‘that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process without any express claim of particular parts.’ And in *Bovill v. Keyworth* (7 E. & B. 725), the Court said: ‘Supposing the patent to be for a combination consisting of several parts for one process, we are of opinion that the defendants are liable for having used a material part of the process, which was new, for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.’

In later cases the limitation was introduced that the new and material part must be capable of being by itself the subject-matter of a patent.

In *The Bottle Envelope Co. v. Seymer* (5 Jur. N. S. 174, C. P.), it was said by the Court that the infringement of any part of a patent process is actionable if that part is of itself new and useful, so as that it might be the subject-

<sup>1</sup> *Newton v. Grand Junction Railway Company* (5 Exch. 334); *Smith v. London & South-Western Railway Company* (Macr. P. C. 203); *Smith v. London & North-Western Railway Company* (2 E. & B. 69); *Sellers v. Dickenson* (5 Exch. R. 312); *Lister v. Leather* (8 E. & B. 1004); *S. C.* in error *ibid.* 1032; *Saxby v. Clunes* (43 L. J. Ex. 228); *White v. Fenn* (15 W. R. 348); *Harrison v. Anderston Foundry Company* (L. R. 1 App. Cas. 574); *Dudgeon v. Thomson* (L. R. 3 App. Cas. 34).

matter of a patent, and is used by the infringer to effect the object or part of the object proposed by the patentee. Where a part only of an invention has been taken, it must be shown in order to make out a case for infringement that the part is one that could stand by itself in respect to invention and in respect of use as the subject of a distinct patent. (Per *Mr. Justice Willes* in *Tatham v. Dania*, 1 Griff. P. C. 215.) And in *Parkes v. Stevens* (L. R. 8 Eq. 358), *James, V. C.*, held that a patent for a combination will not cover any part which would not be of itself patentable. In deciding this case the learned judge made these remarks on the case of *Lister v. Leather*, cited above: 'The authority of that 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. . . . It was contended (in the case before the judge) that because it (a sliding door) was as alleged a novel part of a novel combination (forming a lamp), 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*.'

In the case of *Harrison v. Anderston Foundry Co.* (L. R. 1 App. Cas. 574), *Lord Cairns, C.*, said: 'If it is clear that the claim is for a combination and nothing but a combination there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new.' And in the same case *Lord Chelmsford* said: 'If a patent is solely for a combination nothing is protected by it, and consequently nothing can be infringed, but the use of the entire combination.' See also *Dudgeon v. Thomson* (L. R. 3 App. Cas. 34), and

the remarks of *Sir G. Jessel, M. R.*, in *Townsend v. Haworth* (L. R. 12 Ch. D. 837 n.).

When, however, it is laid down that to constitute an infringement of a combination the entire combination must be taken, the proposition must be understood in this sense, that if the substance of the combination is borrowed there will be an infringement, although all the details of the invention as described by the patentee may not have been taken. It is a clear principle in patent law that a person cannot borrow some substantial part of that which as a whole is a useful invention, and thereby take the benefit of it, without rendering himself liable for an infringement.

In *Parke v. Stevens* (L. R. 8 Eq. 358), *James, V. C.*, stated the law on this branch of the subject as follows: 'The law is summed up thus: the cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process; which is nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention? Supposing that a clock was now for the first time invented and patented as a machine for measuring and indicating time, a man could not evade the patentee's right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus.' See also *Walton v. Potter* (1 W. P. C. 586) and *Thorn v. Worthing Skating Rink Company* (L. R. 6 Ch. D. 415 n.).

The case of *Lister v. Leather* (said *Lord Penzance*, in *Harrison v. Anderston Foundry Co.*, L. R. 1 App. Cas. 574) decided nothing more than this, that though the patent is for a combination, it does not follow that there can be no infringement of it unless every part of that combination without exception is pirated. What the Court said was that the taking of a subordinate part or parts of the combination *might* be, not that it necessarily would be, an



infringement of the patent; and that whether it would be so or not depended, as the Court of Error said, 'upon what the parts taken were, how they contributed to the object of the invention, and what relation they bore to each other.' This only amounts to saying that on a question of infringement the essential nature of the invention will be regarded; and that there may be cases in which, though the patent is for an entire combination of numerous parts, a collusive imitation of that invention may be effected, though some detail of the combination is omitted or changed, which is a doctrine familiar enough in patent law.

And see *Flower v. Lloyd* (W. N. 1877, p. 132); *United Telephone Company v. Harrison* (L. R. 21 Ch. D. 720).

'I understand the rule to be that if a man uses a part of that to which the patent applies for the purpose for which the patentee intended it, and for which he has taken out his patent, and the difference is unsubstantial or colourable, the use of it is an infringement.' (Per *Mr. Justice Field* in *Burnett v. Tate*, 45 L. T. N. s. 143.)

It was decided in a case where the patentee's combination consisted of three old mechanical parts, that another person might use two of those parts and substitute hand-power for the third. (*Murray v. Clayton*, L. R. 10 Ch. 675 n.)

The taking of one part out of a combination of three, the part taken not being a substantial part nor capable of being made the separate subject of a patent, was held not to be an infringement. (*Garrard v. Edge*, 6 R. P. C. 372; affirmed on appeal, 6 R. P. C. 563.)

When a patent is for a new combination of machinery, every part being old, it may be that the manufacture of the separate parts in this country, and the exportation of them abroad, will be no infringement; but in *Goucher v. Clayton* (11 Jur. N. s. 462, 465) it was held to be otherwise when the part so made and exported is new and is claimed as new.

When there are several distinct heads of invention, an infringement of any one renders the infringer liable to

legal proceedings. (*Gillett v. Wilby*, 1 W. P. C. 271; *Edison & Swan United Electric Company v. Woodhouse*, 4 R. P. C. 79.)

#### CHEMICAL PROCESSES AND PRODUCTS.

Precisely the same rules of law are applicable to the case of chemical as to the case of mechanical inventions. The chief questions will continue to be, has the new principle discovered and applied by the patentee, or his new method of carrying out a known principle, or his new combination of parts or ingredients been borrowed by the alleged infringer?

In *Stevens v. Keating* (2 W. P. C. 188), it was a question whether the use of borax (a compound of boracic acid and soda) was not an infringement of a patent, the specification of which claimed the use of acids and alkalies in the preparation of cements. Both *Lord Cottenham* and *Pollock, C. B.*, held that it was an infringement.

In *Hancock v. Moulton* (June 1852), an application was made in the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanised caoutchouc, alleged to be an infringement of the plaintiff's patent for obtaining a certain product by subjecting a mixture of sulphur and caoutchouc to heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead and artificial sulphuret of lead with caoutchouc; that combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiff's patent. 'Assuming,' said *Turner, V. C.*, 'the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confined their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that sulphate

and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that those parts being decomposed by heat, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent.' The judge's opinion, after examining the evidence, was, that the evidence preponderated very considerably in favour of the plaintiffs.

In the case of *Talbot v. Laroche* (15 C. B. 310), the plaintiff was the inventor of a photographic process, patented in 1841. The specification claimed, amongst other things, the employment of gallic acid or tincture of galls, in conjunction with a salt of silver, to render paper more sensitive to the action of light; and also the making visible photographic images upon paper by washing them with liquids (meaning only, as other parts of the specification showed, gallo-nitrate of silver) which act upon those parts which had been previously acted on by light. Subsequently to the date of this patent the collodion process was discovered, and the defendant having practised it, the plaintiff brought this action, alleging that this process was an illegal copy of his process. It was argued by the defendant—firstly, that the plaintiff had claimed only the rendering of *paper* more sensitive to light; whereas collodion, the substance he employed, was a different thing, being a solution of gun-cotton in ether; secondly, that when the collodion was put into the camera it contained no gallic acid, a material essential to the plaintiff's process; thirdly, that in developing the image he employed pyrogallic acid, and not gallic acid. Several scientific persons gave evidence that collodion was not only a different material from paper, calling into play processes not needed when paper was employed, but that it possessed peculiar photographic properties, as was proved by the fact that gallic acid was

not required to render it sensitive, as in the case of paper; also, that pyrogallic acid was much more rapid in its action than gallic acid, and that it was, in many respects, a different thing from gallic acid. The questions submitted by the judge to the jury upon this part of the case were these: Is the use of collodion with nitrate of silver and iodide of potassium the same as the use of paper prepared with nitrate of silver, iodide of potassium, and gallic acid? Is pyrogallic acid the same as, or a chemical equivalent for, gallo-nitrate of silver? The jury returned a verdict implying that, in practising the collodion process, the defendant had not infringed the plaintiff's process.

The difficulty that sometimes exists in determining whether one chemical process is, in contemplation of law, distinct from, or an illegal copy of, another is exemplified in the history of the case of *Heath v. Unwin*.

Under a patent for improvements in the manufacture of iron and steel, the patentee claimed 'the use of carburet of manganese in any process whereby iron is converted into cast steel;' and his specification stated that the invention consisted in adding from one to three per cent. of the carburet to iron or blistered steel whilst in the crucible. The carburet of manganese was separately prepared, by subjecting oxide of manganese and carbonaceous matter to a strong heat, and the resulting carburet was then added to the crucible containing the metal to be converted into cast steel. Upon the trial of an action for an infringement, it appeared that the defendant did not use any single substance answering to the description of carburet of manganese; but he placed in the crucible containing the iron or blistered steel some oxide of manganese and carbonaceous matter. These two substances would form during the process of conversion, and before actual union with the melted iron, carburet of manganese in a state of fusion; but the quantity of the carburet so formed was less than one per cent. of the weight of iron in the crucible. It was held by the Court of Exchequer, that since the defendant had not contemplated the use of carburet of manganese,

and had not known prior to the investigation that took place in consequence of the action that the result of his adding the oxide and carbon was to produce the carburet—since, moreover, the patentee had expressly stated his invention to be the addition of the substance called carburet of manganese to the crucible, there was no infringement on the part of the defendant, for there was no imitation of the patentee's process behind a colourable variation. The specification was construed as claiming the use of one particular combination of carbon and manganese—namely, the carburet of that metal; and a particular mode of using that combination—namely, by putting a certain quantity by weight, in an unmelted state, into the crucible.

*Heath v. Unwin* subsequently went before the Court of Exchequer Chamber. A majority of the judges of that Court held that, inasmuch as the plaintiff had not limited his claim to the particular mode of using the carburet described in his specification, the defendant's process was an infringement of the patented invention, since it effected the manufacture of cast steel by the employment of either carburet of manganese or a chemical equivalent. A minority of the judges thought that the defendant had not infringed the patent: for, though he had used a chemical equivalent for the carburet of manganese—viz. its component parts—it was not known at the date of the patent that such component parts were equivalent to the carburet, in such special applications of it as were described in the specification, and for the purpose there mentioned. Moreover, they thought that the defendant's process was an improvement upon the plaintiff's, for the same quality of steel was made at less expense, one crucible and one heating effecting the desired result.

When this extraordinary case came before the House of Lords, the judges were called upon to attend the argument, and give their opinions. Eleven judges attended, seven of whom concurred with the Court of Exchequer Chamber, and four disagreed. Notwithstanding this large majority, the two law lords who heard the case (*Lord*

*Cranworth* and *Lord Brougham*) gave judgment for the plaintiff in error, thereby deciding that Heath's patent had not been infringed. 'I think,' said *Lord Cranworth*, 'that the use of substances thus producing carburet of manganese in a state of fusion was no violation of the patent. The substance for the use of which (*inter alia*) the patent was granted was a solid metallic substance capable of being broken into fragments and weighed, so that certain definite quantities might be put into the crucible with the steel. There is no evidence whatever tending to prove that, at the date of the patent, it was known to persons acquainted with the subject of manufacturing steel, that coal-tar and oxide of manganese would be a chemical equivalent for the carburet of manganese claimed by Heath. Indeed, it is obvious that the discovery of such an equivalent was made after the use of the carburet as a distinct metallic substance had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent. The costly nature of the substance claimed in the patent might, and probably would, have prevented its use altogether; and if, at the date of the specification, it was known to Heath that, by the use of two common substances, well known in commerce, more than one hundredfold cheaper than carburet of manganese, the same results precisely would be obtained as by the use of that material, the specification would have been bad, as not truly disclosing the invention. On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, viz. carburet of manganese in certain definite proportions, according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement.' (5 H. L. C. 505, 543.) See also Mr. Justice Pearson's judgment in *The Badische Anilin und Soda Fabrik v. Levinstein* (2 F. P. C. 70).

On the trial of *Muntz v. Foster* (2 W. P. C. 96), an action brought for the infringement of a patent for an

improved manufacture of metal plates for sheathing the bottoms of ships, it appeared that the patentee claimed the invention of an alloy of 60 per cent. of copper and 40 per cent. of zinc—the copper and zinc being of the best quality—which alloy could be rolled at a red heat into sheets that furnished a sheathing for ships which was more durable, under the corrosive action of salt water, than copper sheathing; whilst it oxidated sufficiently to keep the ship's bottom clean from barnacles and other things that impeded the ship's progress. A patent had been obtained in 1800, by one Collins, for a preparation of sundry materials, to be used chiefly for the preservation of shipping or for marine purposes, the specification of which described, amongst other things, a mixture of 100 parts copper and 80 parts zinc—*i.e.* 55½ per cent. of copper and 44½ per cent. of zinc—which was to be extended into proper form by rolling. The two inventions, on their faces, seemed to be substantially the same, but the following arguments were used to prove a difference. Collins stated that other metallic substances might be added to the alloy of copper and zinc; whereas Muntz alleged that foreign ingredients would destroy the value of his composition. Collins stated that a good composition might be made of 55½ per cent. of copper and 44½ per cent. of zinc; whereas Muntz alleged that 60 per cent. of copper and 40 per cent. of zinc were the precise proportions required to produce the best metal for sheathing, and that a variation of one or two parts of copper or zinc, on one side or the other, made a very material difference in the result. Again, it was alleged on the part of Muntz that, at the time of Collins' invention, neither copper nor zinc existed of the purity required for the successful production of an alloy as suitable as Muntz's for ship-sheathing; and that before his invention it was not possible to obtain a metal which would roll hot or cold, and could at the same time serve for sheathing. The defendants alleged that the sheathing made by them was the result of following the directions of Collins' specification. (As to this part of the case, however,

*Lord Lyndhurst*, on the hearing of an appeal from an order of *Knight Bruce, V. C.*, said he was satisfied that the object could not be accomplished by uniting ordinary copper and zinc according to Collins' process. The defendants must, therefore, have originally used, not the ordinary, but the purest quality of the two metals, or they must have purified them in the course of the process by some mode not suggested in Collins' specification. In one case the invasion of Muntz's invention was plain and direct; in the other it was colourable and indirect.) Furthermore, witnesses stated that no person could make the compound material by following Collins' directions. The jury found a verdict for the plaintiff, the judge having taken a favourable view of Muntz's case in his address to the jury.

A man may invent improvements on a patented chemical process, by which improvements he may produce a better result in a simpler manner at less cost and with less waste, but, if these are effected by equivalent operations known to be equivalent at the date of the patent, he will be deemed an infringer if he puts them in practice. Thus, in the case of the *Badische Anilin und Soda Fabrik v. Levinstein* (2 R. P. C. 81; affirmed by H. of L., 4 R. P. C. 459), an action brought for the infringement of a chemical patent, *Mr. Justice Pearson* said: 'The processes employed by the defendant are processes deserving of great praise, but they are simply processes which produce exactly the same results from the same materials which are produced under the patent. The same object is pursued, the same materials are employed, the same result is obtained. I cannot do otherwise than come to the conclusion that these processes are not an invention differing from the patented one.'

In those cases where the invention consists of the employment of a material composed of several ingredients, and the inventor has stated the most suitable proportions known to him, another person will not be allowed to evade the patent by employing somewhat different proportions. (*Patent Type Founding Company v. Richard, Johns. 381.*)



## DEALING IN ARTICLES MADE BY INFRINGING A PATENT.

The sale by a dealer of articles made in infringement of a patent is itself an infringement, and it is not necessary for the patentee to prove that the dealer was aware of the articles having been surreptitiously made by a patented process. (*Wright v. Hitchcock*, 5 Ex. 37; *Davenport v. Rylands*, L. R. 1 Eq. 303.) And this is so whether such articles have been made in this country or have been imported from abroad. (*Walton v. Lavater*, 8 C. B. n. s. 162; *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Von Heyden v. Neustadt*, L. R. 14 Ch. D. 230; *Burnett v. Tate*, Q.B., April 27, 1883; *Société Anonyme v. Tilghman's Company*, L. R. 25 Ch. D. 1; *United Telephone Company v. Sharples*, 2 R. P. C. 31.) This will be so even where the persons importing the patented articles are the licensees under a foreign patent obtained by the same inventor for the same invention as that secured by the British patent. (See the two last cited cases.)

After the plaintiff has given *prima-facie* evidence of infringement by proving that the patented article was sold by the defendant, he is not bound in ordinary cases to go on to prove that it was not obtained from himself, or from persons to whom he had sold it, or from his licensees. (*Badische Anilin und Soda Fabrik v. Dawson*, 6 R. P. C. 395.) The circumstances, however, may be such that the patentee is bound to prove not only the sale, but that the article was not made and sold by himself or his agents. (*Betts v. Willmott*, L. R. 6 Ch. 239.) In this case, a patentee having manufactories both in England and on the Continent filed a bill against a druggist to restrain him from infringing his patent for metallic capsules, the infringement consisting of the sale of a bottle of French toilet vinegar having a capsule attached similar to those manufactured under the patent, but the bill was dismissed (and on appeal *Lord Hatherley, C.*, upheld the Vice-Chancellor's decision) on the ground that the plaintiff had not shown that he had not himself sold through his house in

Paris the very article the use of which he sought to prohibit. A sale of the article by the patentee in one country would imply a right to use it in another. (See observation of *Cotton, L. J.*, on this case in *Société Anonyme, &c. v. Tilghman's &c. Company*, L. R. 25 Ch. D. 1.)

Proof of the sale of an article shown to have been made in the same way as that for which a patent has been obtained, such sale being without the leave, expressed or implied, of the patentee, is *primâ-facie* evidence of an infringement. (*Gibson v. Brand*, 1 W. P. C. 630.) But there must be proof that the article was made according to the patented method. Thus, on the trial of an action for an infringement, a candle with a plaited wick, made by the defendant and sold at his manufactory, was produced to the jury as evidence that he had infringed the patent. It was held that, as the patent was not for the candle itself, but for the mode of manufacturing it, the mere production of a candle similar to the plaintiff's was no evidence that it had been made by his patented method. It should have been shown how the candle had been made, seeing that it was quite possible the same result had been produced by a different method. (*Palmer v. Wagstaff*, 8 Exch. 840 ; 9 Exch. 494.)

But in *Huddart v. Grimshaw* (1 W. P. C. 91), it was held that the production of pieces of rope having the essential qualities of the patented article was *primâ-facie* evidence of infringement. And in *Hall v. Boot* (1 W. P. C. 186), it was held that the sale of an article, which might during manufacture have been improved according to a patented process, coupled with the fact of the necessary machine being in the defendant's possession, was sufficient evidence of infringement. (See also *Davenport v. Richards*, 3 L. T. N. S. 504.)

The point whether a mere exposure or offering for sale of a patented article amounts to an infringement, in the absence of proof of actual sale, seems to have been decided differently in the cases of *Minter v. Williams* (1 W. P. C. 137) and *Oxley v. Holden* (5 C. B. N. S. 667). In *Muntz v.*

*Foster* (2 Web. P. C. 101), *Tindal*, C. J., held that the making of ten tons of metal sheathing was an infringement, although no sale was proved.

In *Speckhart v. Campbell* ('Times,' March 13, 1884), it was held by the Court of Appeal that the defendant, who was domiciled in Scotland, had committed an infringement in England of the plaintiff's patent by buying in London articles made in infringement of the patent, and advertising them for sale in Scotland; and by sending to a Liverpool firm, in exchange for postage stamps, samples of the article, accompanied by a letter stating the price per gross.

#### INFRINGEMENT BY USER.

A patentee may not only obtain compensation from a manufacturer who infringes his patent, but he may pursue the infringing articles into the hands of other persons and recover damages in respect of them without regard to what he recovered from the manufacturer. (*Penn v. Bibby*, L. R. 3 Eq. 308; *United Telephone Company v. Walker*, 4 R. P. C. 67.)

The user in this country of an article made abroad, but which is the subject of a British patent, is illegal, even when such user is merely of a passive nature, and takes place in the course of transit from one foreign country where the articles have been made to another to which they are consigned. (*Betts v. Neilson*, 6 N. R. 221, affirmed on appeal, *ibid.* 361; 3 De G. J. & D. 82; L. R. 3 Ch. 431; L. R. 5 H. L. 1.) In this case bottles of beer sent from Scotland protected by capsules made in contravention of an English patent were transhipped in an English port for convenience of exportation to India. It was held, first by *Wood*, V. C., and afterwards by the Court of Appeal and the House of Lords, that, as the capsules were necessary for the preservation of the beer, there had been a user of the invention in England, and an injunction was granted. But his Honour said he could well conceive a case in which there would be no user in England, as, for instance, foreign tools infringing an English patent, packed up in boxes and

lying inert, or transhipped in course of transit in an English harbour. (6 N. R. 222.) In *Nobel's Explosives Co. v. Jones* (L. R. 17 Ch. D. 271), where the object of a patent in regard to a preparation of nitro-glycerine was to render it non-explosive with a view to its safe conveyance from place to place, it was held by *V. C. Bacon* that the transshipment in an English port of a quantity of nitro-glycerine prepared abroad according to the British patent was a user of the invention and an infringement of the patent. The *V. C.*'s decision was reversed by the H. of L., but on another ground, stated below. See also *Caldwell v. Van Vlissingen* (9 Hare, 415, 428), where the user was an active use.

But the doctrine of *Betts v. Neilson* will not be extended so as to allow an injunction to issue against persons who merely act as Custom House agents for the importers of the patented articles. (*Nobel's Explosives Co. v. Jones*, L. R. 17 Ch. D. 721, affirmed in H. L. 8 App. Cas. 5.)

A user of infringing articles by the pupils of the purchaser of the articles renders him liable for an infringement. (*United Telephone Company v. Sharples*, 2 R. P. C. 28.)

The possession of articles made in infringement of a patent is sometimes enough to afford ground for an injunction without proving user, if the circumstances are such as to show that user is intended. An injunction was granted by *V. C. Bacon* against the master of a ship, restraining him from using certain pumps constructed according to the plaintiff's patented invention and placed on board the vessel. The validity of the patent and the fact of infringement by the manufacturers of the pumps were established, but actual user of the pumps was not proved. The master, however, acted with the makers in asserting his right to use the pumps as against the patentee. It was held on appeal that the injunction was properly granted. (*Adair v. Young*, L. R. 12 Ch. D. 13.) And see *United Telephone Company v. London & Globe Telephone Company* (L. R. 26 Ch. D. 766; 1 R. P. C. 117).

But where the user of the infringing machines, which still remained in the possession of the defendants, who admitted the validity of the patent, took place only for a short time, four years before the action was brought, and there was no evidence of an intention to repeat the infringement, it was held that an injunction ought to be refused. (*Proctor v. Bennis*, C. of Appeal, 6 R. P. C. 538.)

On the general question of infringement by user see *The Universities of Oxford and Cambridge v. Richardson* (6 Ves. 689); *Minter v. Williams* (1 W. P. C. 137).

#### AGENTS.

Where an infringement is committed through an agent both employer and agent are liable; it being no justification for the agent to allege that he did the acts complained of by the order of his principal. (*Gibson v. Brand*, 4 M. & G. 179; *Betts v. De Vitre*, 11 Jur. N. S. 9; *Sykes v. Howarth*, L. R. 12 Ch. D. 833; *Spencer v. Ancoats Vale Rubber Co.*, 6 R. P. C. 46.)

#### CARRIERS.

Steamship carriers may be restrained by interim injunction from importing or exporting goods alleged to have been made in infringement of a patent and from parting with the possession of them, when the validity of the patent has been proved in an action against another person. In these cases the goods had been manufactured abroad and there had been no user, passive or otherwise, of the goods on board the ships. (*Washburn, &c., Co. v. Cunard Co.* and *Washburn, &c., Co. v. Dublin and Liverpool, &c., Co.* 6 R. P. C. 398.)

#### FOREIGN VESSELS.

By the forty-third section subs. (1) of the Patents Act of 1883, the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, shall not be deemed an infringement of any

British patent obtained for such invention, unless it is used for the manufacture or preparation of something intended to be sold in or exported from the United Kingdom or Isle of Man. But by subs. (2) the first subsection is not to extend to vessels of any foreign state which does not show similar indulgence to British vessels under like circumstances.

Any case not coming under the protection afforded by the first subsection will be governed by the decision in *Caldwell v. Van Vlissingen* (9 Hare, 415), where an injunction was obtained to restrain the use on board of a Dutch vessel within British waters of certain propelling apparatus made according to a British patent.

#### THE CROWN.

It was decided in the case of *Feather v. The Queen* (6 B. & S. 257) that, as all grants made by the Crown must be construed favourably to the grantor and adversely to the grantee, there was nothing in the ordinary form of Letters Patent in use up to January 1, 1884, to debar the Crown from using the invention comprised therein, and consequently that the Crown had a right, either by itself or by its officers, agents, or servants, to exercise such invention and manufacture the patented object without paying royalties or compensation.

However, in *Dixon v. The London Small Arms Company* (L. R. 1 App. Ca. 632), where a manufacturing company had entered into a contract with the Government for the supply of a patented article for the public service at a fixed price, and in pursuance thereof had manufactured the article without the patentee's licence, and delivered the same and received payment, it was held by the House of Lords that the manufacturers were not in the position of servants or agents of the Crown, although they had received an indemnity from the Government against the claims of the patentee; and, therefore, that they were not entitled to the privilege of the Crown against a patentee, but were liable

to an action for an infringement of the patent. See also *Varasseur v. Krupp* (L. R. 9 Ch. D. 351).

The case of *Feather v. The Queen* will still apply to patents granted before the commencement of the Patents Act of 1883 or on applications then pending (sect. 45), but by the twenty-seventh section of that Act a patent granted on an application made after the commencement of that Act shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

#### CASES OF NON-INFRINGEMENT.

It has been sufficiently shown on previous pages that when a patentee is limited to the particular combination described in his specification another person may lawfully effect the same object by employing different means. In such cases another method of attaining the same end is not an infringement.

To construct a patented machine simply as an amusement or as a model is not an infringement of the patent (*Jones v. Pearce*, 1 W. P. C. 125); nor is the making of the patented article for the purpose of *bonâ-fide* experiment (*Frearson v. Loe*, L. R. 9 Ch. D. 48); and if a person makes use of a patented process and obtains the product, not for the purpose of commercial profit, he is not guilty of infringing the patent. Thus Higgs obtained a patent for a process of precipitating, by means of hydrate of lime, the animal and vegetable matters suspended in sewage water, with a view to their use as manures. Goodwin employed the same process, but solely for the purpose of

purifying the sewage water, and he derived no profit from the product. It was held that the patent was not infringed. (*Higgs v. Goodwin*, E. B. & E. 529.)

It has been decided that the application of a new and material part of an arrangement to a purpose *different* from that to which it is applied in the patented combination does not infringe the patent. (*Lister v. Eastwood*, 9 L. T. N. S. 766; *McCormick v. Gray*, 7 H. & N. 25; *Newton v. Vaucher*, 6 Exch. Rep. 859; *Fletcher v. Glasgow Gas Commissioners* 4 R. P. C. 386.)

In *Newall v. Elliott* (10 Jur. N. S. 954; S. C. 13 W. R. 11), a patent for an invention of improvements in apparatus employed in laying down submarine telegraph cables, which consisted of an internal cone placed in the eye of the coil of cable, an external cylinder round the coil, and rings suspended over it, was held not to have been infringed by an apparatus in which the cable was coiled round a cylinder and prevented from slipping by means of a cylinder placed outside, it being found that this had been done before for the purpose of safe carriage, and there being no evidence that the defendants used their apparatus for any other purpose.

The mere publication of a specification is not an infringement of a prior patent. It is the use of the earlier invention that constitutes the infringement. 'Where the invention is the mode of working or the mode of manufacturing an engine, there is no infringement until another engine is worked or made in the same way. Upon the question of infringement, the specification of the defendant (the alleged infringer) is of very little importance.' Per *L. J. Brett*, in *Otto v. Linford* (46 L. T. N. S. 35).

The application of a natural mineral substance to effect a given purpose is not an infringement of a patent obtained for the application to the same purpose of an artificial substance having the same chemical constitution. A patent was obtained for a process of purifying coal gas by means of hydrated oxide of iron, and the method of obtaining that material artificially was described in the specification. The use for the same purpose of a natural substance called



bog ochre, containing oxide of iron, was held not to be an infringement of the patent. The specification also described and claimed a mode of revivifying the artificial oxide for subsequent use in the same way. *Lord Westbury, C.*, granted an injunction to restrain the user of the natural substance after it had been revivified by the process described in the patent. (*Hills v. Liverpool Gas Light Company*, 9 Jur. n. s. 140.)

It is not an infringement of a patent to sell chemical substances, knowing that the buyer intends to use them in infringing the patent. Nor is it an infringement for the seller, in consideration of the purchase, to indemnify the buyer against proceedings by the patentee, if the patent is disputed or likely to be so. If buyer and seller know the patent to be valid, an agreement for indemnity would be void as being against public policy, and the seller would not be guilty of infringement. (*Townsend v. Haworth*, L. R. 12 Ch. D. 826 n., affirmed by the Court of Appeal. Appendix to Higgins's *Digest of P. C.*, 1880, p. 60. And see *Sykes v. Howarth*, L. R. 14 Ch. D. 833.)

A patent for the United Kingdom will not be infringed by acts done on board a British vessel at Malta or on the high seas. (*Newall v. Elliott*, 4 N. R. 429.)

Where a foreign sovereign had bought abroad articles made in infringement of a British patent, and they were brought to England to be placed on board a ship of war belonging to the foreign sovereign, it was held that, as the Court had no jurisdiction to interfere with the property of a foreign sovereign, it could not prevent him from removing the articles in question. (*Varasseur v. Krupp*, L. R. 9 Ch. D. 351.)

#### INTENTION OF INFRINGER NOT MATERIAL.

In determining the question of infringement, the *intention* of the infringer is immaterial; if he violate the patentee's rights he renders himself liable to make compensation, although he acted in ignorance. In the case of *Stead v. Anderson* (2 W. P. C. 156), *Wilde, C. J.*, when

delivering the judgment of the Court of Common Pleas, said that, 'in the action of *Heath v. Unwin*, 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 evidence 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 what he intends.' And *Shadwell, V. C.*, said, in *Heath v. Unwin* (15 Sim. 553): 'I am at a loss to see how the want of intention can be any answer where the act complained of is an injury. The party complaining of the act is not the less prejudiced by it because it was committed unintentionally, and my opinion is that if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury) he is answerable for the consequences.'

In a subsequent stage of the case of *Heath v. Unwin*, it was admitted by *Mr. Baron Parke* that the Court of Exchequer had been in error when it took the intention of the alleged infringer into consideration, adding, 'There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.' (25 L. J. C. P. 19). See also *Wright v. Hitchcock* (L. R. 5 Exch. 37); *Davenport v. Rylands* (L. R. 1 Ch. D. 303); and *Young & Neilson v. Rosenthal* (1 R. P. C. 39).

Nor can a master of workmen protect himself by alleging that the infringement was committed by them against his orders. (*Betts v. De Vitre*, 3 Ch. D. 430.) But where a retail dealer had, in ignorance of the plaintiff's rights, sold to an agent of the plaintiff an article made in infringement of the patent, and the article itself showed from whom its vendor had bought it, and the Court was satisfied that the infringement was innocent, accidental, and trivial,

and not such as to have produced any substantial damage to the plaintiff, *James, V. C.*, dismissed a bill for an injunction. (*Betts v. Willmott*, 18 W. R. 946.) The case went afterwards on appeal before "Lord Hatherley, C.", who affirmed the decision, but upon other grounds. (L. R. 6 Ch. 239.) See also *Upmann v. Elkan* (L. R. 12 Ch. 145).

## CHAPTER XVIII.

## THE PRACTICE IN ACTIONS FOR INFRINGEMENTS.

SINCE the Judicature Acts of 1873 and 1875 have abolished the distinction between the Courts of Law and Equity, every question of law and fact, or mixed law and fact, arising in any action is now determined wholly in that division of the High Court of Justice in which the action is brought, subject to certain powers of transfer of the action from one division to another, and subject also to the further qualification that trials by jury cannot be had before a judge of the Chancery Division. (*Warner v. Murdoch*, L. R. 4 Ch. D. 750.)

The thirteenth section of the Act of 1883 directs that no proceeding shall be taken in respect of an infringement committed before the publication of the complete specification. And the fifteenth section provides that an applicant shall not be entitled to institute any proceedings for infringement until a patent has been granted to him.

‘A plaintiff is not bound before commencing proceedings to apply to the defendant and ascertain whether he will without suit do what is required (*Upmann v. Elkan*, L. R. 12 Eq. 146). . . . Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but he is entitled to the protection of an injunction’<sup>1</sup> (*Geary v. Norton*, 1 De G. & Sm. 9; *Losh v. Hague*, 1 W. P. C. 200.)

*Interlocutory Injunctions.*—It has always been the practice of the Court of Chancery, when the plaintiff can make

<sup>1</sup> W. N. Lawson: *Patents Designs and Trademarks Acts*, 2nd ed., p. 109. In this work will be found carefully collected and arranged all the cases bearing on legal proceedings in patent actions.

out a proper case, to grant an interlocutory injunction, that is, an injunction before the trial of the action, without requiring the patent to be established. 'The principle on which the Court acts,' said *Lord Eldon*, in *Hill v. Thompson* (3 Mer. 622), 'in cases of this description is the following:—Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will grant him the benefit of an injunction.' And, again, in *Dudgeon v. Thomson* (30 L. T. N. s. 244), *Sir George Jessel, M. R.*, said, 'The Court can grant an injunction before the hearing when the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or when its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or when the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent.' (See also *Renard v. Levinstein*, 10 L. T. N. s. 94, affirmed on appeal, *ibid.* p. 177; *Betts v. Menzies*, 3 Jur. N. s. 357; *Clark v. Ferguson*, 5 Jur. N. s. 1155; *Briggs v. Lardeur*, 1 R. P. C. 126; *United Telephone Co. v. St. George*, 3 R. P. C. 33.)

When it can be shown that the patentee has had undisturbed possession for many years the Court will grant an interlocutory injunction without requiring the patent to be established, notwithstanding doubts may exist as to its validity. (*Losh v. Hague*, 1 W. P. C. 201; *Muntz v. Foster*,

2 W. P. C. 93, 95; *Betts v. Menzies*, 3 Jur. n. s. 357; *Briggs v. Lardeur*, 1 R. P. C. 126.) But in order to establish a right to an interlocutory injunction on this ground, the patentee must show actual public user of the invention (*Plimpton v. Malcolmson*, L. R. 20 Eq. 37), unfettered by the necessity of obtaining the licence of any prior patentee. (*Heugh v. Magill*, W. N. 1877, 62.) Where the patent has been the subject of several suits, all of which have terminated in favour of the patentee, an interlocutory injunction will be granted, notwithstanding a fresh fact is brought forward tending to impeach the novelty of the invention (*Newall v. Wilson*, 2 De G. M. & G. 282; *Davenport v. Jepson*, 4 De G. F. & J. 440), or the defendant offers to keep an account. (*Renard v. Levinstein*, 2 H. & M. 628.) And the fact that the validity of the patent has been established in Scotland is sufficient *primâ-facie* evidence to warrant the granting an interlocutory injunction in England. (*Dudgeon v. Thomson*, 30 L. T. n. s. 244.)

If the plaintiff has shown negligence in prosecuting his rights, even though his patent has been established against another defendant, an interim injunction will be refused. (*Bridson v. Renecke*, 12 Bea. 1; *Bovill v. Crate*, L. R. 1 Eq. 388.) But delay in taking proceedings may be explained to the satisfaction of the Court, and an injunction granted. (*United Telephone Co. v. Equitable Telephone Association*, 5 R. P. C. 233.) If the fact of infringement is matter of doubt, an injunction will be refused until after a trial, and even then if there is ground for supposing that a new trial will be obtained. (*Collard v. Allison*, 4 My. & Cr. 487; *Electric Telegraph Co. v. Nott*,<sup>1</sup> 2 Coop. C. C. 41, and the other cases collected by the reporter.) In almost all cases,

<sup>1</sup> In this case *Lord Cottenham, C.*, said that the Court will not grant an injunction where the legal right is disputed, unless it is satisfied that the legal right will eventually be established; nor where the legal right is disputed unless satisfied that the acts complained of are a violation of it. Where, however, the sole question is the validity of the patent, and there has been exclusive enjoyment under it for a reasonable time, the Court will interpose, by injunction, until the invalidity has been established; but the injunction will be refused if there is conflicting evidence as to the infringement.

however, the Court thinks it right, when it postpones the consideration of the injunction, to order the defendant to keep an account until the plaintiff has had an opportunity of testing the validity of his patent. But if the interlocutory injunction be granted, the Court always requires from the plaintiff an undertaking to abide by any order the Court may make as to damages in case it should ultimately be of opinion that the defendant has sustained any by the injunction which the plaintiff ought to pay. (*Wakefield v. Duke of Buccleuch*, 11 Jur. n. s. 523; *United Telephone Co. v. Equitable Telephone Association*, 5 R. P. C. 283.)

For further statements of the general principles on which the Court acts in granting or withholding interlocutory injunctions, see *Bacon v. Jones* (4 My. & Cr. 434); *Bridson v. McAlpine* (8 Bea. 229); *Davenport v. Jepson* (4 De G. F. & J, 440); *Plimpton v. Spiller* (L. R. 4 Ch. D. 286); *Thomson v. Hughes* (7 R. P. C. 71).

The Court, however, being now empowered to try the validity of the patent, and having the control of the proceedings, and being, consequently, able to prevent any undue delay, is less disposed than formerly to grant an interlocutory injunction, especially when the patent is new, but will generally content itself with giving directions to insure an immediate trial of the questions at issue between the parties, and order the motion for the injunction to stand to the hearing of the cause, adding, when necessary, a direction for the defendant to keep an account. The action may then proceed to trial in the ordinary way. (See the remarks of *Sir George Jessel, M. R.*, in *Plimpton v. Malcolmson*, L. R. 20 Eq. 37. See also *Lister v. Norton*, 1 R. P. C. 114; *Jackson v. Needle*, 1 R. P. C. 174.)

But in a case where the patent was only six years old (*Rothwell v. King*, 3 R. P. C. 379), and in another where the patent was only two years old (*Coles v. Baylis*, 3 R. P. C. 178), injunctions were granted. In the latter case, however, the circumstances were very special.

It is a rule of the Court not to interfere until the patentee's rights have been actually violated. But where

a defendant alleges an intention and claims the right to infringe, the Court will grant an injunction, although no actual infringement may have taken place. (*F'rearson v. Loc*, L. R. 9 Ch. D. 48 ; *Adair v. Young*, L. R. 12 Ch. D. 13.)

The case of *Crossley v. Beverley* (1 W. P. C. 119) shows how far the Court will go in aiding a patentee to repress infringements. It appeared that the defendants had been secretly manufacturing gas-meters, which were copies of those protected by the plaintiff's patent, their object being to pour them into the market as soon as the patent expired. A few days before the expiration of the patent, the plaintiff, having discovered what had been done, filed his bill, and obtained an injunction to restrain the using of the articles so made even after the patent expired.

*Concurrent Actions against several Infringers.*—When a plaintiff commences several actions at one time against separate infringers, the Court will, on the application of the several defendants, order the validity of the patent and other questions common to all the cases to be tried in one of the actions, and will in the meantime stay proceedings in the other actions ; but this order will not be made until the defendants have given full discovery of the machines used by them and alleged to be infringements. (*Foxwell v. Webster*, 2 Dr. & Sm. 250 ; *S. C.* on appeal, 10 Jur. n. s, 137.)<sup>1</sup>

But the plaintiff is not bound by the result of the trial if it goes against him, and he may proceed against any of the other infringers, unless prevented by the order of the Court.

*Issues.*—It is open to either party, at any stage of the action, to move that issues may be settled, raising the various questions of fact in the cause. In a patent case the issues usually are, whether the invention is new, whether it is useful, whether it was a new manufacture,

<sup>1</sup> It was said by *Wood, V. C.*, in the case of *Bovill v. Crate* (L. R. 1 Eq. 389), that when the infringers are very numerous, the proper course for a plaintiff to pursue before filing separate bills against the infringers is to select one as a defendant, and write to the others, and ask if they object to be bound by the proceedings against that one, and have the case tried once for all.



whether the patentee was the true and first inventor, whether the specification is sufficient, and whether the defendant has infringed; but, of course, these may be varied as circumstances require. Since the Judicature Acts, however, the practice appears to be not to apply for issues, but to let the action come on for trial generally, upon the pleadings, particulars of breaches, and objections.

It is not a matter of course for the Court to grant issues, and they are sometimes refused. (*Davenport v. Goldberg*, 2 H. & M. 282; *Davenport v. Phillips*, 5 N. R. 485; *Bovill v. Goodier*, Law Rep. 1 Eq. 36.) The Court will at any time during the progress of a suit allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been previously discovered. (*Holste v. Robertson*, L. R. 4 Ch. D. 9.)

Sometimes one of the parties in an action moves for an order that certain issues of fact should be tried before the other issues. In the *United Telephone Co. v. Mottishead* (3 R. P. C. 213), on the defendants admitting that the plaintiff's patent was valid, the Court directed the trial by itself of an issue whether the defendants had infringed.

*Inspection of Machines and Processes.*—In an action for infringement of a patent, the Court or a judge may, under the thirtieth section of the Patents Act of 1883, and on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

The following cases were decided under the old law with reference to an inspection of the processes used or the articles made by the defendant in alleged violation of the rights of the plaintiff:—*Bovill v. Moore* (2 Coop. C. C. 56); *Brown v. Moore* (3 Bligh, 180); *Morgan v. Seward* (1 W. P. C. 169). In the case of *The Patent Type Founding Company v. Walter* (Johns. 727), the defendant, a printer, who used types alleged to be made in colourable imitation of the type patented by the plaintiffs, was on motion ordered by *Wood*,

V. C., to deliver a sample of type to the plaintiffs for analysis, although a similar application had been refused by the Court of Exchequer in *The Patent Type Founding Company v. Lloyd* (5 H. & N. 192). However, by Order L., Rule 3, of the Supreme Court Rules 1883, the Court or a judge is empowered in any cause or matter to authorise any samples to be taken, or any observation to be made, or experiment to be tried, which may seem necessary or expedient for the purpose of obtaining full information or evidence.

Inspection will not be granted unless the Court is satisfied that there is really a case to be tried at the trial, and that inspection is essential to enable the plaintiff to prove his case. (*Piggott v. Anglo-American Telegraph Company*, 91 L. T. N. S. 46; *Batley v. Kynock*, L. R. 19 Eq. 90.)

An order for inspection was refused when the evidence of infringement only amounted to suspicion, and the grounds thereof were not stated. (*Germ Milling Co. v. Robinson*, 1 R. P. C. 217. And see *Cheetham v. Oldham*, 5 R. P. C. 617.)

The plaintiffs sued for an infringement of a patent for the manufacture of meal and flour, and obtained an order for an inspection of the process used by the defendant, who afterwards moved for leave to inspect the plaintiff's process and take samples. This was ordered. (*Germ Milling Co. v. Robinson*, 3 R. P. C. 11. And see *Cheetham v. Oldham*, No. 2, 5 R. P. C. 622.)

Where, in a suit for an injunction to restrain the infringement of a patent for a sewing machine, an application was made for an inspection of *all* the machines of every kind on the defendant's premises, the Court declined to make the order in the terms asked for, but directed the defendant to verify on affidavit the several kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's last disclaimer, and to produce at his solicitor's office one of each class for inspection by the plaintiff's solicitor and two of their scientific witnesses. (*Singer Manufacturing Co. v. Wilson*, 13 W. R. 560; S. C.

5 N. R. 505. And see *Drake v. Muntz's Metal Co.*, 3 R. P. C. 43.)

A licensee who is not a party to the action cannot be compelled to give inspection in an action against his licensor. (*Germ Milling Co. v. Robinson*, 3 R. P. C. 14.)

*Particulars of Breaches.*—By the Patents Act of 1883, sect. 29, the plaintiff in an action for infringement of a patent must deliver with his statement of claim, or by order of the Court or the judge at any subsequent time, particulars of the breaches complained of. The particulars may be from time to time amended by leave of the Court or a judge.

If the particulars delivered are insufficient, further and better particulars may be required. In *Needham v. Oxley* (1 H. & M. 248), it was held by *Wood, V. C.*, that particulars of breaches are sufficient if, *taken together with the pleadings*, they give the defendant full and fair notice of the case made against him. See, however, the subsequent case of *Curtis v. Platt* (8 L. T. 657), before the same learned judge.

A plaintiff may be ordered to point out by reference to the pages and lines the parts of his specification which he alleges to be infringed. (*Lamb v. The Nottingham Manufacturers' Company*, Seton on Decrees, 4th ed. p. 349.) But this will not be required when the things alleged to be an infringement have been made an exhibit in the action. (*Batley v. Kynock*, No. 2, L. R. 19 Eq. 229.) Or when the particulars of breaches and the claims in the specification alleged to have been infringed sufficiently enable the defendant to know what he will have to meet at the trial. (*Cheetham v. Oldham*, No. 3, 5 R. P. C. 624.)

An application by a plaintiff for leave to amend his particulars of breaches may be made to the Court or a judge under sect. 29 (5) of the Act of 1883. An application by either party for an order for further and better particulars of breaches or objections may be made under R. S. C., O. XIX. r. 7.

Other cases bearing upon the amendment of particulars of breaches are *Flower v. Lloyd* (20 S. J. 860); *Church*

*Engineering Company v. Wilson* (3 R. P. C. 123); *United Telephone Company v. Fleming* (3 R. P. C. 268); *Cheetham v. Oldham*, No. 3 (5 R. P. C. 624).

Cases as to further particulars of breaches: *Elsay v. Butler* (1 R. P. C. 189); *Tilghman's &c. Co. v. Wright* (1 R. P. C. 103); *Russell v. Hatfield* (2 R. P. C. 144); *Moseley v. Victoria Rubber Co.* (3 R. P. C. 351); *Haslam Co. v. Hall* (4 R. P. C. 203); *Ehrlich v. Ihlee* (5 R. P. C. 37).

*Particulars of Objections.*—The twenty-ninth section of the Patents Act of 1883, subsections 2 and 3, requires the defendant to deliver with his statement of defence, or by order of the Court or a judge at any subsequent time, particulars of any objections on which he relies in support thereof; and if the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it; and if one of these grounds is want of novelty, he must state the time and place of the previous publication or user alleged by him. And subsection 5 enables the defendant to amend such particulars from time to time by leave of the Court or judge.<sup>1</sup>

If a defendant relies as an objection to a patent on general public knowledge of the invention before the date of the patent, he should not mention in his particulars of objection the several books or publications which he takes to be

<sup>1</sup> Upon the corresponding section (41) of the Patents Act of 1852 the following cases have been reported:—*Penn v. Bibby* (L. R. 1 Eq. 548); *Grover & Baker Company v. Wilson* (W. N. 1870, p. 78); *Flower v. Lloyd* (L. R. 6 Ch. D. 297); *Crossley v. Tomey* (L. R. 2 Ch. D. 533); *Plimpton v. Spiller* (20 S. J. 859); *Morgan v. Fuller*, No. 2 (L. R. 2 Eq. 297).

It has been held that the objections cannot go beyond the pleas; they are merely to state more particularly what the pleas state generally. (*Macnamara v. Hulse*, 2 W. P. C. 128.) As to other points bearing upon this subject see *Palmer v. Wagstaff* (8 Exch. Rep. 840); *Palmer v. Cooper* (9 Exch. Rep. 231); *Hull v. Bollard* (1 H. & N. 134); *Lister v. Leather* (3 Jur. n. s. 816); *Greaves v. Eastern Counties Railway Company* (1 Ell. & Ell. 961; S. C. 5 Jur. n. s. 733); *Talbot v. Laroche* (15 C. B. 310); *Electric Telegraph Company v. Nott* (4 C. B. 462); *Fisher v. Dewick* (1 W. P. C. 551 n.); *Heath v. Unwin* (1 W. P. C. 551); *Jones v. Berger* (1 W. P. C. 544 n.); *Houshill Company v. Neilson* (1 W. P. C. 552); *Holland v. Fox* (1 C. L. R. 440).

proofs of that knowledge, or which gave to the public the means of acquiring it. General public knowledge must be proved by witnesses in the ordinary way at the trial, and they may refer if necessary to well-known books. In the meantime he may be required to strike out of his particulars those publications which go to prove public knowledge only. On the other hand, if a defendant relies on any publications as *anticipations* of the invention, he must state in his particulars the nature of the anticipation on which he relies, and what those publications are and where they are to be found; and must indicate that he relies on them as anticipations, and not as showing the state of public knowledge. In the case of a specification that part of the claim on which he relies should be shown. Generally speaking, he need not state particular pages of the books or specifications, unless the matter would be doubtful without that information. (*Holliday v. Heppenstall*, in the Court of Appeal, L. R. 41 Ch. D. 109; 6 R. P. C. 320.)

Previous to this enunciation of the practice a defendant had been ordered to give the pages and lines of the specifications and books to which he referred as anticipating the plaintiff's invention, and to state which of the claims in the plaintiff's specification had been anticipated by the prior specifications. (*London and Leicester Hosiery Company v. Higham*, Lawson's Patents Acts, 2nd ed. p. 498; see also *Harris v. Rothwell*, 1 Griff. P. C. 110.)

And another defendant, in referring to a book on which he relied as anticipating the plaintiff's invention, was ordered to refer to specified parts thereof, and where there were words in the particulars denoting reliance upon the whole of the various earlier specifications, they were directed to be struck out, leaving him at liberty to refer to pages and lines. (*Harris v. Rothwell*, 3 R. P. C. 243. And see *Fowler v. Gaul*, 3 R. P. C. 247.) However, it has not been unusual in practice to refer to the whole specification, and if there was no special complication this was not often objected to.

When objection is made in general words to a discon-

formity between the provisional and the complete specifications, an order for better particulars may be obtained. (*Anglo-American Brush Electric Light Corporation v. Crompton*, 4 R. P. C. 27.)

Under an objection that the invention is not new the defendant may show the want of novelty of one of two inventions described in the specification. (*Sugg v. Silber*, L. R. 2 Q. B. D. 493.)

As to the terms on which leave to amend particulars of objection are granted under special circumstances, see *Otto v. Steel* (2 R. P. C. 139); *Ehrlich v. Ihlee* (4 R. P. C. 115). Here the form of the order as to costs, where the defendant applied to amend his particulars of objection after the case had been set down for hearing, was considered. *Parker v. Maignen's Filtre Rapide Co.* (5 R. P. C. 207). In this case the application to amend the particulars was made on the eve of trial. *Blakey v. Latham* (6 R. P. C. 29); *S. C.* on appeal (6 R. P. C. 184). In this case leave to amend was granted during the trial, which was adjourned.

Other cases bearing upon the amendment of particulars of objection are *Boyd v. Horrocks* (3 R. P. C. 285); *Boyd v. Horrocks* (5 R. P. C. 557); *Parcall v. Toope* (7 R. P. C. 125).

The following cases were decided under the old law with reference to the amendment by the defendant of his particulars of objection:—*Penn v. Bibby* (L. R. 1 Eq. 548); *Wilson v. Gann* (23 W. R. 546); *Renard v. Levinstein* (13 W. R. 229; 11 L. T. N. S. 505); *Daw v. Eley* (L. R. 1 Eq. 38); *Edison Telephone Co. v. India-rubber Co.* (17 Ch. D. 137).

*Interrogatories.*—In a suit for an injunction a defendant denying infringement may be compelled to answer whether he used the plaintiff's materials, whether he makes any addition to them, and whether such addition makes any difference. (*Renard v. Levinstein*, 10 L. T. N. S. 94.) As to the limits of such discovery see *Crossley v. Tomey* (2 C. L. D. 53); *Crossley v. Stewart* (1 N. R. 426); *Rolls v. Isaacs* (W. N. 1878, 36); *Lister v. Norton* (2 R. P. C. 68); *Moseley v. Victoria Rubber Co.* (3 R. P. C. 351). As to the

discovery which a defendant in such a suit may obtain from the plaintiff as to his patent, see *Renard v. Levinstein* (11 L. T. N. S. 79); *Hoffman v. Postill* (L. R. 4 Ch. 678); *Germ Milling Co. v. Robinson* (3 R. P. C. 11); *Edison & Swan Co. v. Holland* (5 R. P. C. 213); *Ehrlich v. Ihlee* (5 R. P. C. 37).

A plaintiff may be interrogated as to documents in his possession relating to the preparation of his specification. (*Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.)

A defendant who has furnished particulars literally in compliance with the statute may be called upon to answer interrogatories as to the names and addresses of alleged prior users, and whether the machines are in existence. (*Birch v. Mather*, L. R. 22 Ch. D. 629.)

*Order for Production of Models Refused.*—In an action for the infringement of a patent for improvements in presses for pressing tiles, the plaintiff, after the delivery of particulars of objection, applied to a judge at chambers for an order for the production by the defendant to the plaintiff, before the trial, of all dies, models, and drawings of dies intended to be produced by the witnesses on behalf of the defendants at the hearing of the action. The judge held that as the articles called for were not shown to be in the possession or power of the defendants, he had no jurisdiction to make such an order, and the Court of Appeal held that he did rightly. (*Garrard v. Edge*, 6 R. P. C. 372.)

*Inspection of Documents.*—Communications between an inventor and his patent agent are not privileged, and therefore, where the patent agent of a party to an action for infringement is also his solicitor, the other party can claim to see the communications made to the solicitor in his capacity of patent agent, if there is otherwise no valid objection to the disclosure. (*Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.) In this case it was held that the defendants were entitled to inspect any communications between the plaintiff and his patent agent bearing upon the preparation of his specification under a patent for an invention which was closely connected with the invention under an earlier

patent obtained by the plaintiff and alleged to be infringed by the defendants.

The defendants in an action for the infringement of a patent belonging to persons who previously to their becoming the owners of it had in various proceedings disputed or made preparations for disputing its validity applied to the Court for an order for the inspection of certain documents relating to those proceedings. It was held by a Divisional Court that the defendants were entitled to have inspection of all except such as the plaintiffs should state on oath had come into existence merely to be communicated to the solicitor for the purpose of litigation actual or intended, and either as materials for briefs or for his advice and consideration. (*Haslam Co. v. Hall*, 5 R. P. C. 1.)

Litigation had taken place between two companies with regard to the validity of a patent belonging to one of them. They afterwards amalgamated and the new company brought an action for infringement against H. It was held by the Court of Appeal that H. was entitled to administer an interrogatory as to the particulars of objections delivered in the previous action between the two companies. (*Edison & Swan Co. v. Holland*, 5 R. P. C. 213.) In this case (p. 216), the practice with regard to applications for leave to administer interrogatories having reference to documents supposed to be in the possession of the opposite party, who has already given discovery, is stated.

Where it seems probable from a document produced by one of the litigating parties that he has in his possession other relevant documents, he may be called upon to make a further affidavit in regard to those supposed documents. (*Bown v. Sansom*, 5 R. P. C. 515.)

*The Trial.*—Under the twenty-eighth section of the Act of 1883 the action is to be tried without a jury unless the Court shall otherwise direct. Trials of patent cases have very seldom taken place before juries since the Act came into operation.

By the Arbitration Act 1889 (52 & 53 Vict. c. 49 s. 14) repealing and re-enacting with slight variations the fifty-



seventh section of the Judicature Act of 1873, the judge before whom a case requiring 'scientific investigation' comes for trial is empowered to send the issues of fact to be tried before a referee. Where a patent case had been so sent for trial before an official referee, it was contended by the plaintiff in the Court of Appeal that the case was not one that required 'scientific investigation' within the meaning of the Judicature Act, but it was held to be impossible for that Court to say that an action for the infringement of a patent did not require scientific investigation; and that, as the judge had decided that it did, the Court would not interfere with his discretion. (*Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.)

The referee will make a report as to the issues of fact which were sent to him for trial, and his findings so reported are to be considered equivalent to the finding of a jury.

On the trial of an action for the infringement of a patent the Court has power, under the Arbitration Act 1889, repealing and re-enacting with variations sect. 56 of the Judicature Act of 1873, to order without the consent of the parties that a competent person should ascertain facts or make experiments, and report the result of his inquiry for the information and guidance of the Court. (See *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 24 Ch. Div. 156; *Mellin v. Monico*, L. R. 3 C. P. D. 142; *Edison & Swan Co. v. Holland*, 5 R. P. C. 459.) The Court of Appeal sometimes thinks fit to exercise this power. (*Moore v. Bennett*, 1 R. P. C. 129.)

By the twenty-eighth section of the Act of 1883 it is enacted that, in an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. Under the third subsection of the same section the remuneration, if any, to be paid to such assessor shall be determined by the Court and be paid in the same manner as the other expenses of the execution of the Act.

By the nineteenth section of the Act of 1883 the judge is empowered, in an action for infringement or in a proceeding for revocation, to give liberty to the patentee to apply at the Patent Office for leave to amend his specification, and to postpone the trial. (See the chapter on Amendments.)

As to the trial of causes and issues, see Order XXXVI. Rule 5 and Rule 7 (a) of the Supreme Court Rules, 1883.

The defendant in an action for the infringement of a patent for a chemical process set up by his defence that he had a secret process which was not an infringement. The judge, seeing that irreparable mischief would be done to him if he were called upon to state in open Court what that secret process was, in case it should turn out that the patent was bad, allowed him not to answer certain questions which were put to him, but left him to determine for himself whether he would or not communicate his secret process to the Court, so that the Court might be able to determine whether he infringed the patent or not. The defendant, acting on the advice of his counsel, elected before the termination of the case to disclose his secret to the judge, who heard his description of it with closed doors, no persons being present except the parties and their scientific assistants. (*Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 24 Ch. D. 156.) See also *Edison v. Woodhouse* (3 R. P. C. 172).

A model which has not been put in evidence may be handed up to the Court as an example of a class of machine, in order to explain counsel's argument. (*Boyd v. Horrocks*, Appeal, 6 R. P. C. 154.)

Where a judge at the trial of an action is of opinion that the invention under the patent is good subject-matter and is useful, and accordingly upholds the patent in these respects, his decision will be followed by another judge of co-ordinate jurisdiction in case the validity of the same patent is contested on the same grounds by another defendant. (*Slazenger v. Feltham*, 6 R. P. C. 132; *S. C.* on appeal, 6 R. P. C. 234.)

*Evidence.*—In regard to the evidence it may be useful to remember that the Court looks with distrust on experiments conducted for the express purpose of manufacturing evidence for the cause. (*Young v. Fernie*, 5 Giff. 577; *Betts v. Neilson*, L. R. 3 Ch. 429, 433.)

By the 4th subsection of the 29th section of the Act of 1883, no evidence is to be admitted at the hearing, except by leave of the Court or a judge, in proof of any alleged infringement or objection of which particulars have not been delivered.

Hence under this clause the Court at the trial has a discretionary power to allow the evidence to go beyond the particulars of breaches or objections. (*Britain v. Hirsch*, on appeal, 5 R. P. C. 226.)

Where particulars of breaches alleged divers sales and specified sales to two persons, evidence of a sale to a third person was allowed where the defendant admitted having had transactions with him. (*Sykes v. Howarth*, L. R. 12 Ch. D. 827.)

As to the mode of proving the allegation of general public knowledge, see the case of *Holliday v. Heppenstall*, ante, p. 280, under Particulars of Objections.

In actions for infringement the onus of proof with regard to want of novelty is on the defendant, and therefore in an uncontested case the plaintiff is not bound to prove the novelty of his invention. (*Peroni v. Hudson*, 1 R. P. C. 261.)

An offer to execute orders for swivelling pumps in response to applicants, no particular form of swivelling pump being mentioned, was held not to be evidence of an intention to infringe a patent for swivelling pumps where the specification did not claim every kind of that class of pump. It was to be presumed that the offer referred to such pumps as would not be an infringement of the patent. (*Gwynne v. Drysdale*, 2 R. P. C. 160; S. C., appeal, 3 R. P. C. 65.)

It was said by *Lord Herschell* in the House of Lords (*Badische Anilin und Soda Fabrik v. Levinstein*, 4 R. P. C.

465), that neither the patentee nor any other witness could be called to prove what was the invention claimed by the specification. That question was to be answered from a critical examination of the instrument by the Court. It would seem, therefore, that the cases of *Bateman v. Gray* (Macr. P. C. 111) and *Crossley v. Potter* (Macr. P. C. 255) are overruled as far as they relate to this point.

A patentee who has assigned his patent cannot be restrained, on the trial of an action for infringement brought by the assignee against a third party, from giving information in his possession which might tend to show that the patent is invalid. (*London and Leicester Hosiery Co. v. Griswold*, 3 R. P. C. 251.)

A plaintiff is entitled to adduce evidence in reply for the purpose of rebutting the case set up by the defendant. (*Penn v. Jack*, L. R. 2 Eq. 317.)

As to the circumstances under which the Court of Appeal will admit or refuse further evidence in patent cases under Order LVIII., Rule 4, of the Supreme Court Rules, 1883, see *Hinde v. Osborne* (2 R. P. C. 45); *Watling v. Stevens* (3 R. P. C. 147); *Walker v. Hydro-Carbon Syndicate* (3 R. P. C. 253); *American Braided Wire Co. v. Thomson* (5 R. P. C. 118); *Britain v. Hirsch* (5 R. P. C. 226); *Spencer v. Ancoats Vale Rubber Co.* (6 R. P. C. 46); *Blakey v. Latham* (6 R. P. C. 184).

The opinion of scientific witnesses is only admissible as proof of facts. Their opinion whether there has been an infringement or not, though sometimes received in order to save time, is strictly speaking inadmissible, and if objected to ought to be rejected. The Court alone is to decide questions of law. Per *Lord Wensleydale*, in *Seed v. Higgins* (8 H. L. C. 550). See also *Westinghouse v. Lancashire and Yorkshire Railway Co.* (1 R. P. C. 229). But although it is not for a witness to construe a specification, it is allowable to ask him in an ordinary way what he understands by it. Per *Lord Halsbury, C.*, in *Kaye v. Chubb* (5 R. P. C. 650).

In regard to the proof of documents in the Patent Office,

or of copies or extracts from such documents, see Chapter XXIII.

*Functions of the Judge and Jury at the Trial.*—When a patent case is tried before a jury it is the duty of the judge, where a specification comes into question, to explain to the jury what that instrument directs to be done, and it is for the jury to say whether, upon the evidence, the promised result will be accomplished by pursuing those directions. (Per *Cresswell, J.*, in *Beard v. Egerton*, 8 C. B. 165; 19 L. J. C. P. 36.)

The construction of a specification belongs to the Court alone, but if the case is tried before a jury, then the attendant circumstances and the true meaning of the technical phrases, if there be any, are questions which must be ascertained by the jury. (*Neilson v. Harford*, 1 W. P. C. 370; *Bovill v. Pimm*, 11 Ex. 718; *Otto v. Linford*, Court of App. 46 L. T. N. S. 35; *United Telephone Co. v. Bassano*, 3 R. P. C. 295.) ‘Where novelty or infringement’ (said *Lord Campbell*, in *Seed v. Higgins*, 8 H. L. C. 561) ‘depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury.’ It is also for the Court to decide the question as to the identity of inventions described in two nearly contemporaneous specifications, when such questions can be determined by a simple comparison of the specifications. (Per *Coltman, J.*, in *Allen v. Rawson*, 1 C. B. 571; per *Pollock, C. B.*, in *Tetley v. Easton*, at *Nisi Prius*, Macr. P. C. 68; and per *Erle, J.*, in *Bush v. Fox*, Macr. P. C. 168; *Booth v. Kennard*, 2 Hurlst. & Norm. 84; *Thomas v. Foxwell*, 6 Jur. N. S. 271; *Hills v. London Gas Light Company*, 5 Hurlst. & Norm. 312. See, however, the observations of *C. J. Tindal*, in *Muntz v. Foster*, 2 W. P. C. 105.) But if anything more than simple comparison is required to determine the identity or dissimilarity of two

inventions, the question must be submitted to the decision of the jury.

‘We by no means lay down as a general rule’ (said *Lord Campbell, C. J.*, in *Thomas v. Foxwell*, 5 Jur. N. S. 37) ‘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.’ ‘If there be two specifications to be compared’ (said *Lord Westbury, C.*, in *Hills v. Evans*, 4 De G. F. & J. 288–298), ‘in order to arrive at a conclusion of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact, and not a question of law.’

Steiner obtained letters patent for a new manufacture of a certain colouring matter called garancine, extracted from madder-root, and extensively used in dyeing. This colouring matter was formerly extracted by simply boiling the root in water, and the refuse matter, termed ‘spent madder,’ was thrown aside as useless. Steiner’s process, under his first patent, obtained in 1832, was the employment of diluted sulphuric acid of a given strength, and he proposed to apply it to the extraction of the colouring matter from both fresh and spent madder. In 1843 Steiner took out another patent, specially applicable to the extraction of garancine from spent madder. A much stronger solution of sulphuric acid was now used, and heat was employed. He thus obtained a large portion of the garancine which had previously remained attached to the woody fibre. *C. B. Pollock*, at the trial of an action brought for

an infringement of the latter patent (*Steiner v. Heald*, 2 Car. & Kir. 1033), said, 'It appears to me that this is precisely the same as if you applied a process to grapes already imperfectly squeezed, by which you squeeze a little more juice out of them than was formerly done.' Believing the invention to be destitute of novelty, he directed the jury that, in point of law, the invention under the second patent was not patentable. The jury gave their verdict in favour of the defendant, but the verdict was set aside, and a new trial granted on the ground of misdirection. The judge, it will have been observed, treated the conclusion to be drawn from the evidence as a matter of law; whereas he ought to have left it to the jury to say whether fresh and spent madder had different properties, chemical or otherwise, or whether they were the same thing, with the difference only that part of the colouring matter had been already extracted. If the properties of the two substances were different, the invention was a new manufacture; but if the two things were the same, except that one was more charged with colouring matter than the other, in that case the invention claimed would simply have been the application of a process already known, producing a known result. It was for the jury to say, upon the evidence, whether the invention was a new manufacture or not. (*Steiner v. Heald*, 6 Exch. Rep. 607.)

The question of infringement is one of mixed law and fact. 'There may well be a case' (said *Lord Campbell*, in *De la Rue v. Dickinson*, 7 E. & B. 738) 'where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there be a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact or of fact mixed

with law, which the judge is bound to submit to the jury.' In deciding the question of infringement there is (said *Lord Wensleydale*, in *Seed v. Higgins*, 8 H. L. Cas. 550) '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 jury find to be true.'

It is a question for the judge whether, on proof of certain acts having been done by a defendant, the plaintiff has any case to go to the jury. Per *Lord Chelmsford*, in *Seed v. Higgins* (8 H. L. C. 550).

*Damages: Account of Profits.*—It is now settled that the plaintiff in a patent action cannot have both damages and an account of profits, but must elect between the two which he will adopt. (*Neilson v. Betts*, L. R. 5 H. L. 1.)

In estimating the amount of damages sustained by a plaintiff in respect of an infringement of his patent, the Court adopts a form of inquiry different from that which it employs in the analogous case of an imitation of a plaintiff's trade-mark. In the latter instance the Court will not assume in the absence of evidence that the plaintiff would have sold all the articles which the defendant has wrongfully sold. (*The Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299.) But every sale without licence of a patent article must be a damage to the patentee, and therefore the inquiry in a patent case will extend to the sale by the defendant of *any* articles made by him since the infringement was commenced. (*Davenport v. Rylands*, 1 L. R. Eq. 308.) The inquiry will extend to the sales by the defendant within six years before the commencement of the proceedings (*Davenport v. Rylands*, L. R. 1 Eq. 302; *Crossley v. Derby Gas Light Co.*, 1 W. P. C. 119); but if the plaintiff be an assignee of the patent the amount will only be taken from the date of the registration of the assignment to him. (*Elwood v. Christy*, 5 N. R. 312.) And in stating such an account the defendant must file an affidavit, stating the number of the patented articles made by him since the date of the patent,



and the names and addresses of the purchasers to whom the same have been sold (*Murray v. Clayton*, L. R. 15 Eq. 115; *American Braided Wire Co. v. Thomson*, No. 2, 5 R. P. C. 375), and the account may be taken notwithstanding the pendency of an appeal. (*Sarby v. Easterbrook*, L. R. 7 Ex. 207.)

Where separate proceedings have been taken against the manufacturer and user of the patented article the plaintiff may have an account of profits against the manufacturer, and also damages against the user (*Penn v. Bibby*, L. R. 3 Eq. 308; *United Telephone Co. v. Walker*, 4 R. P. C. 67), and he cannot be compelled to accept the same royalty from a litigant as he receives from others (*ibid.*); but a patentee being himself a manufacturer of the patented article, and having been in the habit of licensing the use of his invention on payment of a fixed royalty, is not entitled to claim as against an infringer a manufacturing profit in addition to his ordinary royalty (*Penn v. Jack*, L. R. 5 Eq. 81); and where such a patentee had in some instances received from users (not being the manufacturers of the patented article) his ordinary royalty, it was held that in every such case no further royalty was payable by the manufacturer (*ibid.*).

Where there has been unnecessary delay in filing the bill an account of profits before the filing of the bill will not be ordered. (*Harrison v. Taylor*, 11 Jur. n. s. 408; *Beard v. Turner*, 13 L. T. n. s. 746; *Ford v. Foster*, L. R. 7 Ch. 616; *Crossley v. Derby Gas Light Company*, 1 Web. P. C. 120.)

In taking the account of profits made by the use of his invention, a successful plaintiff is entitled to know for comparison the profits made by the defendants in their business prior to the date at which they first used the plaintiff's invention. (*Siddell v. Vickers*, 6 R. P. C. 464.)

The material question for consideration in estimating damages is the actual loss entailed on the patentee, not the profit made by the infringer. (*United Horsenail Company v. Stewart*, L. R. 13 App. Ca. 413.) And in that case

it was laid down that the measure of damages was the extent to which the infringing articles interfered with the sale of the patented goods. And see *American Braided Wire Co. v. Thomson* (6 Times R. 251).

As to the measure of damages and the principle of assessment where the infringing articles are only partly covered by the patent, and are let out at a rental, see *United Telephone Company v. Walker & Oliver* (4 R. P. C. 62).

When an amendment by way of disclaimer, correction, or explanation has been allowed under the Patents Act of 1883 (see sect. 20), no damages are obtainable in any action in respect of the use of the invention before the amendment unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

The seventeenth section of the Patents Act of 1883 directs (subsect. 4 *b*) that if any proceeding shall be taken in respect of an infringement of a patent committed after a failure to make any prescribed payment within the prescribed time and before the enlargement of the time, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

*Perpetual Injunctions.*—The plaintiff is entitled to a perpetual injunction to restrain future infringements when the validity of the patent has been conclusively established, and the fact of infringement has been proved. And if the defendant chooses to submit the injunction may be obtained without proceeding to trial.

Rule 16 of order LVIII. of S. C. R. directs that there shall be no stay of proceedings pending appeal, except so far as the Court appealed from or a judge thereof or the Court of Appeal may order. See *Flower v. Lloyd* (36 L. T. n. s. 444); *Washburn &c. Co. v. Patterson* (1 R. P. C. 158, 171); *Easterbrook v. G. W. R. Co.* (2 R. P. C. 201); *Hocking v. Fraser* (3 R. P. C. 7); *Otto v. Steel* (3 R. P. C. 109); *Kaye v. Chubb* (4 R. P. C. 23); *Humpherson v. Syer* (4 R. P. C. 184).

A patentee after disclaiming will not be allowed to enforce an injunction obtained before disclaiming, but must proceed *de novo*. (*Dudgeon v. Thomson*, L. R. 3 App. Cas. 34.)

*Delivery up or Destruction of Machines.*—The Court has power to order the infringing machines to be delivered up to the plaintiff, as well as any articles in the defendant's possession made by them. It may also order the destruction of machines made in violation of a patent. (*Betts v. De Vitre*, 34 L. J. N. S. 289, 291; *Tangye v. Stott*, 14 W. R. 386.) However, where the patent was for a combination, and the defendant might still use for other purposes the several parts of the machine, *Wood, V. C.*, refused to order the machines to be destroyed, but directed them to be marked so as to prevent their being used at any future time in such a way as to continue the infringement. (*Needham v. Oxley*, 8 L. T. N. S. 604.) In *Plimpton v. Malcolmson* (*Seton on Decrees*, 4th ed. p. 354), the order was that the defendant should upon oath deliver up to the plaintiff, or break up or otherwise render unfit for use, the articles complained of. See also *Frearson v. Loe* (L. R. 9 Ch. D. 48, 67).

## SCOTLAND.

The 107th section of the Patents Act of 1883 directs that in any action for infringement of a patent in Scotland the provisions of the Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct; but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action, or in any action or proceeding respecting a patent hitherto competent to those Courts. For the purposes of this section 'Court of Appeal' is to mean any court to which such action is appealed.

And by the 111th section the provisions of the Act conferring a special jurisdiction on the Court as defined by the Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any pro-

ceedings relating to patents; and with reference to any such proceedings in Scotland the term 'the Court' shall mean any Lord Ordinary of the Court of Session, and the term 'Court of Appeal' shall mean either division of the said Court.

R. S. C. O. XI. r. 2 provides that where leave is asked of the Court or a judge to serve a writ under r. 1, in Scotland or Ireland, if it shall appear that there may be a concurrent remedy in either country, the Court or judge shall have regard to the comparative cost and convenience of proceeding in England, or in the place of residence of the person sought to be served. As to Scotland, see *Re Burland's Trade Mark* (L. R. 41 Ch. D. 542); *Marshall v. Marshall* (L. R. 38 Ch. D. 330); and as to Ireland see *Washburn &c. Company v. Cunard Steamship Company and Parkes* (6 R. P. C. 398).

#### IRELAND.

By section 110 of the Act of 1883 all parties shall, notwithstanding anything in the Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only. And by the 111th section the jurisdiction of any court in Ireland in proceedings relating to patents is not to be affected by the provisions of the Act conferring a special jurisdiction on the Court as defined by the Act, except so far as the latter jurisdiction extends; and with reference to any such proceedings in Ireland, the terms 'the Court' and 'the Court of Appeal' respectively are to mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

#### ISLE OF MAN.

By the 112th section of the Act of 1883 it is enacted that it shall extend to the Isle of Man, but that nothing therein shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent competent to those Courts.

COSTS AND CERTIFICATES.<sup>1</sup>

The successful plaintiff is entitled to his costs, unless his conduct has been such as to induce the judge to deprive him of them. (*Nunn v. Albuquerque*, 31 Bea. 595.)

In patent actions costs are usually allowed on the higher scale (see R. S. C. O. LXV. rr. 8, 9) on account of the importance or special nature and difficulty of the cases; and costs as between solicitor and client are obtainable under the 31st section of the Act of 1883. (See *post*.)

The plaintiff will not be deprived of costs because he did not apply to the defendant before taking proceedings (*Burgess v. Hateley*, 26 Bea. 249; *Upmann v. Forrester*, 24 Ch. D. 231), nor because the defendant was unacquainted with the plaintiff's rights, nor because he had no intention to do wrong. (*Burgess v. Hills*, 26 Bea. 244; *Cooper v. Whittingham*, 24 Ch. D. 231.)

After judgment has been delivered the counsel on both sides will at once apply to the judge for the certificates to which they may be respectively entitled. A reasonable time after trial is sometimes allowed to a party for applying on paying the costs of the motion. (*Rowcliffe v. Morris*, 3 R. P. C. 145.)

No appeal lies from the grant of a judge's certificate, as it is not a judgment or order within s. 19 of the Judicature Act, 1873. (*Haslam Company v. Hall* (2), 5 R. P. C. 144.)

It is directed by the sixth subsection of the twenty-ninth section of the Act of 1883, that on the taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any costs in respect of any particulars delivered by them unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

The taxing master has no power without the judge's certificate to allow the successful defendant's costs of his

<sup>1</sup> See the cases as to costs collected in Mr. W. N. Lawson's cited work pp. 176-189.

particulars of objection which he had not been called upon to prove at the trial, as the action had been dismissed (with costs) on the ground that the plaintiff's invention was not subject-matter. (*Longbottom v. Shaw*, 6 R. P. C. 510.)

Although a patent is adjudged to be invalid, and the plaintiff has to pay the general costs of the action, yet on the principle that parties ought not, even when right in the action, to add to the expenses by fighting issues in which they are wrong, the plaintiff has been held to be entitled to the costs occasioned by the issues raised by those particulars of breaches which the defendant failed to prove. (*Badische Anilin und Soda Fabrik v. Levinstein*, 2 R. P. C. 117; *Automatic Weighing Machine Company v. Knight*, 6 R. P. C. 297; *Griffin v. Feaver*, 6 R. P. C. 396.)

Where a defendant not only denied infringement but also contested the validity of a patent, and the result was that infringement was proved, but the patent was found to be invalid, the plaintiff was held to be entitled to the costs of the issue in respect of the infringement. (*Pooley v. Pointon*, 2 R. P. C. 167.) And so when the plaintiffs succeeded on a distinct issue, though defeated in the action generally, they were held to be entitled to the costs of that issue. (*Blank v. Footman*, 5 R. P. C. 661.) But on the other hand, see *Guilbert-Martin v. Kerr* (4 R. P. C. 23); *Edison & Swan Company v. Holland* (5 R. P. C. 483); *Blakey v. Latham* (6 R. P. C. 38).

The plaintiffs sued for the infringement of two patents, but abandoned one at the trial, whilst they succeeded on the other. They were ordered to pay such costs as were occasioned by their suing on the abandoned patent. (*Hocking v. Fraser*, 3 R. P. C. 7.) And so where a plaintiff sued on three patents, but only succeeded on one, he was directed to pay such costs as had been incurred by including the other two in the claim. (*Edison v. Woodhouse*, 3 R. P. C. 178.)

The proprietors of two patents having brought an action on each against the same defendant, the judge allowed the plaintiffs only such costs as they would have been entitled

to had they joined both patents in one action. (*United Telephone Co. v. Sharples*, 2 R. P. C. 28.)

If a defendant raises issues which are abandoned at the trial, the unsuccessful plaintiff is entitled to the costs of those issues. (*American Braided Wire Co. v. Thomson*, 4 R. P. C. 322.)

Third parties who appeared in the Court below and in the Court of Appeal, although not made defendants, were ordered to pay costs. (*Edison & Swan Co. v. Holland*, 6 R. P. C. 243.)

As to the proper certificates in cases where judgment is given at the trial for the defendants who are not called upon to go into their defence, see *Germ Milling Co. v. Robinson* (3 R. P. C. 254); *Longbottom v. Shaw* (6 R. P. C. 143).

At the trial of an action for infringement, the judge found for the plaintiff, but on appeal his decision was reversed, and the Court of Appeal gave the defendant such certificates as to costs as ought to have been given by the judge who tried the case, if his decision had been in conformity with that of the Court of Appeal. (*Humpherson v. Syer*, 4 R. P. C. 416; *Cole v. Saqui*, 6 R. P. C. 45. And see *Cropper v. Smith*, 2 R. P. C. 61.)

When a patent case is carried to the Court of Appeal, and can there be decided at once on one short point, the Court will refuse to go on with it, simply for the purpose of ascertaining how the costs should be apportioned between the parties. (*Longbottom v. Shaw*, 6 R. P. C. 147; *Boyd v. Horrocks*, 6 R. P. C. 162; *Blakey v. Latham*, 6 R. P. C. 190.) But sometimes the Court of Appeal, on reversing the judgment in the Court below, will refer the case back to the judge who tried the case to deal with the question of costs. (*Combined Weighing &c. Co. v. Automatic Weighing Machine Co.*, 6 R. P. C. 502.)

The following cases relating to certificates of proof of particulars of breaches may be referred to: *Young v. Rosenthal* (1 R. P. C. 41); *Germ Milling Co. v. Robinson* (3 R. P. C. 260); *Bray v. Gardner* (4 R. P. C. 406).

And as to certificates of proof of particulars of objections, see *Cropper v. Smith* (2 R. P. C. 61); *Lawrence v. Perry* (2 R. P. C. 179); *Germ Milling Co. v. Robinson* (3 R. P. C. 254); *Rothwell v. King* (2) (4 R. P. C. 397); *Albo-Carbon Light Co. v. Kidd* (4 R. P. C. 539); *Badham v. Bird* (5 R. P. C. 238); *Oddy v. Smith* (5 R. P. C. 509); *Longbottom v. Shaw* (5 R. P. C. 502).

By the thirty-first section of the Act of 1883, it is enacted that, in an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

In a case where the defendant did not appear at the trial, and the plaintiff had judgment, the judge refused to give a certificate that the validity of the patent had come into question, holding that the section only applied when the patent was established in a case contested in Court. (*Peroni v. Hudson*, 1 R. P. C. 261.) On the other hand, in *Haydock v. Bradbury* (4 R. P. C. 74), the judge, under similar circumstances, gave the certificate.

In an action for alleged infringement, where the plaintiff proved the validity of the patent, but failed to prove the infringement, the judge gave the certificate. (*Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 120.)

Judgment was given for the defendant in an action for infringement, the patent being declared invalid by reason of one of the claims having been anticipated. The judge, however, gave the plaintiff a certificate that the validity of the patent had come in question in the action. (*Haslam Co. v. Hall*, 5 R. P. C. 26.)

Where the validity of a patent was impeached on grounds different from those brought forward in a former action, in which its validity was established, and the judge's



certificate to that effect was obtained, costs as between solicitor and client were refused, and costs on the higher scale were given to the successful plaintiff in the second action. (*Otto v. Steel*, 3 R. P. C. 120.)

A certificate of validity is not available in an action by the same plaintiff against another defendant, if it was given after the later action was commenced. (*Automatic Weighing Machine Co. v. International Hygienic Society*, 6 R. P. C. 475.)

As to other questions in regard to costs as between solicitor and client, after the validity of the patent has been established in a previous action, see *United Telephone Co. v. Townshend* (3 R. P. C. 10); *United Telephone Co. v. St. George* (3 R. P. C. 339); *United Telephone Co. v. Patterson* (6 R. P. C. 140).

The Vice-Chancellor of the County Palatine of Lancaster is not a Court or judge within the meaning of the 31st section, and cannot grant a certificate thereunder. (*Proctor v. Sutton Lodge Chemical Co.*, 5 R. P. C. 184.)

In the case of *Davenport v. Rylands* (L. R. 1 Eq. 308), under the corresponding section in the Act of 1852, Sir W. P. Wood, V. C., decided that a patentee who has obtained this certificate may have his full costs in any subsequent action for infringement, although the validity of the patent may not have been in question in such action. See, however, *Automatic Weighing Machine Co. v. International Hygienic Society* (6 R. P. C. 475).

As to what is a sufficient certificate to enable the Court to direct the costs to be taxed as above mentioned, see *Betts v. De Vitre* (11 Jur. n. s. 11), *Borill v. Hadley* (17 C. B. n. s. 435).

Other cases relating to the certificate are *Stocker v. Rodgers* (1 C. & R. 99); *Ball v. Ielm* ('Times,' April 14, 1881).

When directors of a limited company are active parties in an infringement of a patent by the company, they may be made parties to a suit against the company, and may be ordered personally to pay the costs of suit. (*Betts v. De*

*Vitre*, 11 Jur. n. s. 9, affirmed on appeal, L. R. 3 Ch. 429. See also *Spencer v. Ancoats Vale Rubber Co.* 6 R. P. C. 46.)

See further as to the taxation of costs in patent suits, *Smith v. Buller* (L. R. 19 Eq. 473); *Batley v. Kynock* (L. R. 20 Eq. 632); *Wegmann v. Corcoran* (27 W. N. 357).

## CHAPTER XIX.

## ACTIONS TO RESTRAIN A PATENTEE'S THREATS.

By the thirty-second section of the Act of 1883 it was enacted that if any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. But this section is not to apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Previously to the passing of this Act it had been held that it was necessary to show a want of good faith, that is, an absence of reasonable and probable cause, as well as the untruth of his assertions, to render a patentee liable for threatening to take legal proceedings. (*Halsey v. Brotherhood*, L. R. 15 Ch. D. 514, and 19 C. D. 386; *Burnett v. Tate*, 45 L. T. N. S. 742; *Société Anonyme v. Tilghman's Co.*, 25 Ch. D. 1; *Sugg v. Bray*, 2 R. P. C. 223.) But now the threatening patentee cannot rely on the absence of proof of *mala fides* as a good defence, unless by bringing and diligently prosecuting an action for infringement he bars the application of the earlier part of the thirty-second section. Where a patentee did so, and failed to support the validity of the patent at the trial, and then the action

to restrain the issue of the circulars came on for hearing, at which evidence of *mala fides* was not forthcoming, the judge said, unless there is plain evidence of malice there is no cause of action. The action was therefore dismissed, but without costs. (*Sharp v. Brauer*, 3 R. P. C. 193. See also *Challender v. Royle*, 4 R. P. C. 371.)

It was at one time supposed that in an action for an injunction to restrain threats under the thirty-second section of the Act the validity of the threatening defendant's patent could not be impeached; but it is now settled that the plaintiff in such an action may prove, in either of two ways, that he has not infringed any legal right of the defendant, the person making the threats. Either he may show that he has not infringed a valid patent; or he may prove that the patent is invalid, and therefore that he has not infringed any legal right of the defendant. In the latter case the defendant is entitled to have the same notice of objections, and the same right of beginning and replying at the trial, as if he had been plaintiff in an action for infringement. See *Challender v. Royle* (4 R. P. C. 363); *Kurtz v. Spence* (4 R. P. C. 427; S. C. 5 R. P. C. 161); *Herrburger v. Squire* (5 R. P. C. 581); S. C. on appeal (6 R. P. C. 194).<sup>1</sup>

It may be useful, perhaps, to give in a short analytical shape the result of the cases relating to actions to restrain threats by a patentee brought by persons aggrieved under the 32nd section of the Act of 1883.

(1.) When the patentee refuses to bring an action for infringement: (a) if the plaintiff shows that the patent is invalid, or that he has not infringed it, he will succeed, without regard to the question of the patentee's *bona fides* in making the threats. (*Kurtz v. Spence*, 5 R. P. C. 161; *Herrburger v. Squire*, 5 R. P. C. 581.) But (b) if it is

<sup>1</sup> Besides the cases cited, the following have a bearing upon minor points in actions under the thirty-second section: *Union Electrical Power and Light Co. v. Electrical Power Storage Co.* (5 R. P. C. 329); *Colley v. Hart* (6 R. P. C. 17; 7 R. P. C. 101).

shown at the trial that the patent is valid, and that it has been infringed, the plaintiff in the threat action will fail. (*Crampton v. Patents Investment Co.*, 5 R. P. C. 382.)

(2.) When the patentee brings an action for infringement, and (a) succeeds at the trial in showing the validity of his patent and its infringement, the action for threats will be decided in his favour (*Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 121); and (b) even if the patentee fails to establish the validity of his patent, or the fact of its infringement, he will still not be liable in the threat action unless absence of *bona fides* is shown (as before the Act of 1883). *Sharp v. Brauer* (3 R. P. C. 193); *Combined Weighing &c. Co. v. Automatic &c. Co.* (6 R. P. C. 502); *Colley v. Hart* (7 R. P. C. 101).

*Threats.*—The first question to be considered is, has a patentee threatened legal proceedings within the meaning of the words ‘circulars, advertisements, or otherwise?’ A letter from the patentee’s solicitor may be a threat for which the aggrieved person may proceed against the client. (*Driffield &c. Co. v. Waterlow & Co.*, 3 R. P. C. 46; *Crampton v. Patents Investment Co.*, 5 R. P. C. 393; *Combined Weighing &c. Co. v. Automatic &c. Co.*, 6 R. P. C. 506.) See, however, remarks of North, J., *Barrett v. Day* (7 R. P. C. 54).

Notices by letters addressed by a patentee to persons who were using an invention of the plaintiff, and so framed as to lead people to believe that the patentee was complaining of the plaintiff’s invention as being an infringement of the patent, were held to be threats within the meaning of the section. (*Burt v. Morgan*, 4 R. P. C. 278.) Then letters written ‘without prejudice’ may contain threats within the section. (*Kurtz v. Spence*, 5 R. P. C. 173.) Also a private letter written by the patentee to a customer of the plaintiff. (*Walker v. Clarke*, 4 R. P. C. 111.)

Pending an action for infringement, the plaintiff has no right to advertise a positive statement that the defendant has infringed, and he may be restrained if he does so advertise. (*Gaulard v. Lindsay*, 4 R. P. C. 189.)

But *quære* whether mere warnings to the public in

respect of the future are threats within the meaning of the section. (*Challender v. Royle*, 4 R. P. C. 374.)

The judges sitting *in banc* refused an injunction to restrain a patentee from sending out circulars containing a verbatim report copied from a newspaper of the trial of an action for the infringement of his patent, the trial having terminated in his favour, and the applicants for the injunction being the defendants in the action. (*Hayward v. Hamilton*, 'Engineer,' vol. xlviii. p. 428; *S. C.*, 1 Griffin P. C. 115.)

*Interlocutory Injunctions.*—An interlocutory injunction to restrain threats must not be moved for *ex parte*. Notice of motion must be given in the regular way. (*Wilson v. Church Engineering Co.*, 2 R. P. C. 175.) An interlocutory injunction was refused when the defendant, the patentee, undertook to proceed with due diligence with an action against the plaintiff for an infringement of the patent, but was afterwards granted on his neglecting to perform the undertaking. (*Household v. Fairburn*, 1 R. P. C. 109; *S. C.*, 2 R. P. C. 140.) A motion for an interlocutory injunction to restrain the circulation of circulars issued by limited licensees was ordered to stand over until after the trial of an action for infringement brought by a patentee against the plaintiffs in the action for an injunction. (*Barnett v. Barretts Co.*, 1 R. P. C. 9, and see *Combined Weighing & Co. v. Automatic Weighing Machine Co.*, 6 R. P. C. 504.)

Where a plaintiff, pending an action brought by him for an infringement, has obtained leave from the Court to amend, but has not yet amended, his specification by disclaimer, he will not be allowed to issue circulars threatening the customers of the defendant with legal proceedings, and the defendant in the action for infringement may move for an injunction to restrain the issue of the circulars. (*Fusee Vesta Co. v. Bryant & May*, 4 R. P. C. 191.)

In granting or refusing an interlocutory injunction the Court will consider not only the balance of convenience and inconvenience between the parties litigant, but also whether the plaintiff has made out a *prima-facie* case, so as to make it seem probable that at the hearing of the action for threats

he will get a decree in his favour on the questions of infringement and, if raised, the validity of the patent. (*Challender v. Royle*, 4 R. P. C. 372; see also *Barney v. United Telephone Co.*, 2 R. P. C. 173.)

*The Proviso* at the end of the thirty-second section of the Patents Act of 1883 declares that the section is not to apply if the person making the threats with due diligence commences and prosecutes an action for infringement of his patent. It is not required that the action for infringement should be brought against the aggrieved person, that is, the person applying for an injunction to restrain threats. 'An action will satisfy the words of the proviso if it is a *bonâ-fide* action brought with due diligence and without collusion against a person to whom threats have been addressed in respect of the act to which the threat referred.' Per *L.L. J.J. Cotton and Bowen*, in *Challender v. Royle* (4 R. P. C. 373-5). But it was held by *Mr. Justice Kekewich*, in *The Combined Weighing &c. Co. v. The Automatic Weighing Machine Co.* (6 R. P. C. 507) that in order to meet the exigency of the proviso, the patentee, if he does not sue the person who has brought an action to restrain threats, must sue a person who has committed an infringement of the same character as the infringement alleged to have been committed by the plaintiff in the threat action. It will not do to bring the action for infringement against a man who is infringing the patent in an entirely different way from that alleged to have been adopted by the man who is suing for threats. With respect to the words 'due diligence,' they will be interpreted with reference to the time when the threats were made, not with reference to the time when the patentee had notice of what the alleged infringer was doing. Threats being made in March, and an action for infringement having been commenced in May, that was held to be due diligence. (*Challender v. Royle*, 4 R. P. C. 376, 372.) And see *Combined Weighing &c. Co. v. Automatic Weighing Machine Co.* (6 R. P. C. 508); *Colley v. Hart* (6 Times R. 212). For a case in which due diligence was not displayed, see *Herrburger v. Squire* (5 R. P. C. 594).

When a threatened action for infringement is commenced and prosecuted with due diligence after the threat, there is no ground upon which an action in respect of such threat can subsequently be commenced under the section. (*Barrett v. Day*, 7 R. P. C. 54.) An action by a patentee against licensees, claiming royalties in respect of articles which the licensees allege are made under another patent and not under the licence, is an action for infringement within the proviso. (See *Barrett v. Day*, cited above.)

*Damages.*—Where no special damage was proved or suggested, forty shillings damages were awarded. (*Kurtz v. Spence*, 5 R. P. C. 177.)

*Certificate of Validity.*—In an action to restrain a patentee's threats, where the validity of the patent came into question and was upheld, the judge gave a certificate to that effect under the thirty-first section of the Act of 1883, but expressed great doubt whether he had jurisdiction to grant it. (*Crampton v. Patents Investment Co.*, 5 R. P. C. 404.) In another action to restrain threats, another judge held that he had no power to give such a certificate. (*Kurtz v. Spence*, 5 R. P. C. 184.)

*Costs.*—When an action for infringement is brought by a patentee after proceedings to restrain threats have been taken against him, the parties ought to come to some arrangement, so as not to incur unnecessary costs by trying two actions about the same facts. (Court of Appeal: *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 367. See also *Combined Weighing &c. Co. v. Automatic Weighing Machine Co.*, 6 R. P. C. 509.)



## CHAPTER XX.

## THE REVOCATION OF PATENTS.

THE old action of *scire facias*, which was one brought in the name of the Crown for the purpose of repealing a grant of letters patent, has been abolished, so far as patents for inventions are concerned, by the twenty-sixth section of the Patents Act of 1883. By that section it is enacted that the revocation of a patent may be obtained on petition to the Court, and that every ground on which a patent might, at the commencement of the Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement, and shall also be a ground of revocation.

Previous to the Act of 1883, if two patents had been issued to different persons for the same invention, the first patentee could have brought an action of *sci. fa.* to repeal the second patent. (*R. v. Neilson*, 1 W. P. C. 671.) And where there had been a false suggestion, such as was involved in a want of novelty or utility in the invention, the patent could have been repealed by the same proceedings. Fraud, non-compliance with the conditions of the letters patent, such as filing an insufficient specification (*Rex v. Arkwright*, 1 W. P. C. 66), and the fact that the invention was not a patentable one (*R. v. Cutler*, Macr. P. C. 124), were also grounds for the action of *sci. fa.*, and are still therefore available as grounds of revocation.

In the case of *Gaulard & Gibbs' Patent* (6 R. P. C. 225), the patent was held bad on the grounds that there was disconformity between the specification as amended and the provisional specification, and that the scope of the invention had been extended.

The fact that a patent includes more than one invention,

contrary to the direction in section 33, would seem not to be a ground of revocation, since the same section declares that 'it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.'

A petition for the revocation of a patent may be presented by (a) the Attorney-General in England or Ireland, or by the Lord Advocate in Scotland; (b) any person authorised by these law officers; (c) any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; (d) any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the patentee's claim; (e) any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold within this realm before the date of the patent anything claimed by the patentee as his invention. That is to say, the persons who, in addition to the law officers and those whom they authorise, may present a petition for the revocation of a patent are persons who allege that they have been defrauded by the grant; or those who claim to be the true inventors of the patented invention; or those who set up anterior public user by themselves, or by persons through whom they claim. Before a petition can be presented on the ground of prior user by other persons it will be necessary to obtain the authority of a law officer.

A petition cannot be presented by an agent, although authorised by a power of attorney. (*Arery's Patent*, 4 R. P. C. 152; *S. C. on Appeal*, 4 R. P. C. 322.) And all persons beneficially interested in the patent must be made respondents. (*S. C.*)

Along with his petition the plaintiff will have to deliver particulars of his objections to the patent, and no evidence will be admitted at the trial in proof of any objection not included in such particulars, except by leave of the Court or of a judge; but the particulars delivered may be from

time to time amended by leave of the Court or of a judge. The proceedings at the trial will be similar to the proceedings in actions when the validity of a patent is in dispute. The defendant is entitled to begin and give evidence in support of the patent; and if the plaintiff gives evidence impeaching the validity of the patent, the defendant is entitled to reply. (Sub-ss. 5, 6, 7, sect. 26, of the Act of 1883.)

By the nineteenth section of the Act of 1883, the Court or a judge may, in a proceeding for the revocation of a patent, order at any time that the patentee shall, subject to such terms as to costs or otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Leave to disclaim after presentation of the petition was given to the patentee upon the terms of his paying all costs and undertaking to apply forthwith for the disclaimer and prosecute the application with diligence. (*Gaulard & Gibbs' Patent*, 5 R. P. C. 189.)

By the twenty-eighth section of the Act the Court in any proceeding for the revocation of a patent may, if it thinks fit, and shall, on the request of either of the parties, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. The case shall be tried without a jury unless the Court shall otherwise direct.

The following cases have been decided by the Courts upon subsection 4 of section 26 in the Act of 1883.

In construing clause (c) the word fraud must be confined to grave moral culpability, and ought not to be extended to honest mistakes, although the real inventor may have suffered injury. (*Arery's Patent*, 4 R. P. C. 322.)

Cases of alleged prior user under clause (c). (*Walker v. Hydrocarbon Syndicate*, 2 R. P. C. 3; *Haddan's Patent*, 2 R. P. C. 218.)

A person who presents a petition for a revocation under

clauses (c), (d), or (e) is entitled at the hearing, after proving his right to present the petition, to impeach the patent on any other lawful ground. (*Morgan's Patent*, 5 R. P. C. 186.)

Where a patent has been revoked on the ground of fraud, the Comptroller is authorised by the twenty-sixth section of the new Act, on the application of the true inventor, made in accordance with the provisions of the Act, to grant him a patent in lieu of the revoked patent. The new patent is to have the same date as the date of the revocation, but is to expire at the end of the term for which the revoked patent was granted.

Where the Court has made an order for the revocation of a patent, an office copy thereof must be left at the Patent Office, that an entry may be made in the Register. (Rule 74 of Patents Rules, 1890.)

In Scotland, proceedings for the revocation of a patent are directed by the 109th section of the Act to be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only. Service of all writs and summonses in that action are to be made according to the forms and practice existing at the commencement of the Act.

In Ireland, by section 110, all parties are to have their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

There is no provision in the Act for service out of the jurisdiction of petitions for revocation. Where, however, the patentee was resident and domiciled in Scotland, and there was evidence that a copy of the petition and objections had been delivered to him in Scotland, and that he had written to the petitioner's solicitors that he did not intend to appear at the hearing because he was not subject to the jurisdiction of the English Courts, an order *nisi* was made (on the petitioners applying for directions as to the mode of trial) that unless the patentee should appear before a day named the petition should be tried by *vivâ-voce* evidence; but if

the respondent appeared it was to be open to him to dispute the jurisdiction. (*Drummond's Patent*, 6 R. P. C. 576.)

COSTS.

The Act of 1883 is silent as to costs, but the Courts under their general jurisdiction award costs to the petitioner when the patent is revoked. (*Haddan's Patent*, 2 R. P. C. 218 ; *Edmonds' Patent*, 6 R. P. C. 358.)

At the hearing of a petition for revocation the judge thought that he had no power to give a certificate as to proof of the particulars of objections under the twenty-ninth section, subsection 6, of the Act of 1883. (*Gaulard & Gibbs' Patent*, 5 R. P. C. 537.)

## CHAPTER XXI.

## OFFENCES AND THEIR PENALTIES.

THE only penalties imposed by the Act of 1883 are those prescribed for the offences set forth in the 105th and 106th sections. By the 105th section it is enacted that any person who represents that any article sold by him is a patented article when no patent has been granted for the same . . . shall be liable for every offence on summary conviction to a fine not exceeding 5*l.* And further, that a person shall be deemed for the purposes of the enactment to represent that an article is patented . . . if he sells the article with the word 'patent,' 'patented,' or any word or words expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on or otherwise applied to the article.

According to the case of *Cheavin v. Walker* (L. R. 5 Ch. D. 862), the use of the word 'Patent,' along with a representation of the royal arms as a label on an article made according to an invention for which the patent has expired, was considered to be a representation that the patent was still subsisting, and was held to disentitle the plaintiff from obtaining an injunction to restrain the wrongful use of the label. The plea of its being a trade-mark was not allowed to be set up. 'It is impossible' (said *Sir G. Jessel, M. R.*) 'to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. No man can claim a trade-mark in a falsehood. It is a falsehood in representing the patent as still subsisting.' See also the *Linoleum Manufacturing Co. v. Nairn* (L. R. 7 Ch. D. 834).

By the second section of the Merchandise Marks Act,

1887 (50 & 51 Vict. c. 28), every person who (1 *d*) applies any false trade description to goods, and (2) every person who sells or exposes for, or has in his possession for, sale or any purpose of trade or manufacture, any goods or things to which any . . . false trade description is applied, shall be guilty of an offence against that Act, unless he proves that . . . he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade description, and that on the prosecutor's demand he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or that otherwise he had acted innocently. By the third section (1) of the same Act the expression 'trade description' means any description, statement, or other indication, direct or indirect, (*e*) as to any goods being the subject of an existing patent; and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of the above matter, shall be deemed a trade description within the meaning of the Act. The expression 'false trade description' means a trade description which is false in a material respect as regards the goods to which it is applied. Persons found guilty of an offence against the said Act are liable to fine and imprisonment and to forfeit any article in relation to which the offence has been committed. (Sect. 2, *e*.)

In the case of *Gridley v. Swinborne* (5 Times R. 91), it was held that the sale of packets of gelatine which were marked with the royal arms and bore the words 'Under Royal Letters Patent. Swinborne's Patent Refined Isinglass,' was not an offence under the second section of the Merchandise Marks Act of 1887 when there had been a patent for the manufacture of the article, but which patent had expired many years previously. Since no proceedings were taken under sections 105 and 106 of the Patents Act of 1883, it seems to have been conceded that no offence had been committed under those sections.

To avoid all difficulty in cases of this kind, and to rebut any possible charge of fraud, manufacturers would do well

to add the number and date of the patent to the mark or label.

The fact that a provisional specification has been lodged at the Patent Office does not justify the use of the word 'Patent' as a label upon articles made according to the invention until a patent has been obtained. (*The Queen v. Wallis*, 3 R. P. C. 1; *The Queen v. Crompton*, 3 R. P. C. 367.)

By the 106th section of the Act of 1883 it is enacted that any person who, without the authority of her Majesty or any of the Royal Family or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession, by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding 20*l.*

Many persons engaged in business have been accustomed to make use of the royal arms in one way or another, and if they continue to do so they should be careful not to bring themselves within the purview of this section.

By the first section of the Act of 1888 it is enacted that any person describing himself to be a Patent Agent when he is not on the register is liable on summary conviction to a penalty of 20*l.* (See Chapter XXIV., 'On the Institute of Patent Agents.')

In Scotland any offence under the Act of 1883 declared to be punishable on summary conviction may be prosecuted in the Sheriff's Court. (Sect. 108.) In the Isle of Man any offence under the Act which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of the person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted. (Sect. 112, subsect. 3.)

The ninety-third section of the Act of 1883 enacts that if any person makes or causes to be made a false entry in



any Register kept under the Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence, any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

In the Isle of Man the punishment for a misdemeanor under the Act is imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100*l.* at the discretion of the Court. (Sect. 112, subsect. 2.)

## CHAPTER XXII.

## INTERNATIONAL AND COLONIAL ARRANGEMENTS.

*International Arrangements.*

It is enacted by the 103rd section of the Patents Act of 1883 that, if the Crown should make any arrangement with the Government or Governments of any foreign state or states for the mutual protection of inventions, then any person who has applied for protection for any invention in any such state shall be entitled to a patent for his invention under the Act in priority to other applicants, and such patent shall have the same date as the date of the application in such foreign state. But the application must be made in this country in the same manner as an ordinary application under the Act, and within seven months from the date of the application for protection in the foreign state. A patentee under this section will not be allowed to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this country. By the second subsection of the same section it is enacted that the publication in the United Kingdom or the Isle of Man, during the said period of seven months, of any description of the invention, or the use therein during the said period of the invention, shall not invalidate the patent which may be granted for the invention.

Then by the fourth subsection it is directed that these provisions are only to apply to those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

On March 20, 1883, a Convention was signed by representatives of various Governments, which was afterwards ratified by these Governments. Other Governments afterwards joined the Convention, and at the present time it exists between the following states: Belgium, Brazil, France, Great Britain, Guatemala, Holland and its Indian Colonies, Italy, Mexico, Norway, Portugal, Servia, Spain, Sweden, Switzerland, Tunis, United States. By the first article of this Convention it was declared that the said states formed themselves into a *Union for the Protection of Industrial Property*, which words were (according to the Protocol accompanying the Convention,<sup>1</sup> and having the same force, validity, and duration as the Convention itself) to be understood in their broadest sense, and to be applicable not only to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.) and to mineral products employed in commerce (mineral waters, &c.). It may here be remarked that neither agricultural products nor mineral products are patentable in this country.

By the second article of the Convention the subjects or citizens of each of the contracting states are to enjoy in all the other states of the Union the same advantages as regards patents of every kind (see the second paragraph of the Protocol) that their respective laws grant to their own subjects or citizens. They are to have the same protection and the same legal 'recourse' [*i.e.* remedies] on any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation [*i.e.* laws] of each state. With regard to this clause the third paragraph of the Protocol explains that it is not to affect the legislation [*i.e.* laws] of the contracting states relating to legal procedure, jurisdiction, &c.

Subjects or citizens of states not forming part of the Union who are domiciled or have industrial or commercial establishments on the territory of any of the states of the Union are by Article 3 of the Convention to be on the

<sup>1</sup> The Convention and Protocol will be found reprinted in the Appendix.

same footing as the subjects or citizens of the contracting states.

Then, by Article 4, any person who has duly registered [*i.e.* made] an application for a patent in one of the contracting states shall enjoy, as regards registration in the other states, and reserving the rights of these parties, a right of priority for six months, an additional month being allowed for countries beyond sea. Subsequent registration (*i.e.* a patent obtained on a subsequent application) in any of the other states of the Union before expiry of that period shall not be invalidated by any acts done in the interval, either by registration, by publication of the invention, or the working of it by a third party.

Article 5 declares that the introduction by the patentee into the country where the patent has been granted of articles manufactured in any of the states of the Union shall not entail forfeiture of the patent as it did in several states before the date of the Convention. But this clause is followed by another which declares that the patentee shall remain bound to work his patent in those states where the law of the country obliges him to do so. It would appear, therefore, that, although a patentee is entitled to introduce into a country articles made abroad, he must still work the invention in that country if there is a regulation to that effect. In this country there is no law of the kind, but under the 22nd section of the Act of 1883 patentees who are foreigners may be called upon, like those who are British subjects, to grant licences to work the invention, when the patents were issued under that Act.

Temporary protection is to be granted under Article 11 to patentable inventions appearing at official or officially recognised international exhibitions.

In order to carry the Convention into full effect, it was directed by Article 13 that an International Office should be organised under the name of *Bureau International de l'Union pour la protection de la Propriété Industrielle*, and that this office should be placed under the authority of the Central Administration of the Swiss Confederation, and worked under its supervision.

It was then agreed by the next Article that the Convention should be submitted to periodical revisions, with a view to improving its provisions, for which end conferences by delegates from the contracting states will be held. It was also agreed that special arrangements for the protection of industrial property might be made separately between any of the contracting states, provided that such arrangements do not contravene the provisions of the Convention.

By Article 16 it was agreed that states which did not originally take part in the Convention should be permitted to join the Union afterwards by diplomatically notifying their intention to do so to the Government of the Swiss Confederation. And by Article 18 it is provided that any state might retire from the Union by giving notice to that effect to the Government of the Swiss Confederation. At the expiration of one year from the date of the notice the state giving it will cease to be a member of the Union.

Great Britain joined this Convention on March 17, 1884, and an Order in Council under section 103 of the Act of 1883 was duly made. The Board of Trade has issued rules as to applications for patents under this Convention, and a copy of them will be found in the Appendix.

According to present regulations, 'Patents (International and Colonial Arrangements) Rules 24-29, 1890,' an application in the United Kingdom for a patent under the International Convention must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. It must be made upon form A<sup>2</sup> (stamped 1*l.*, and obtainable upon prepayment of the value of the stamp, through any money order office), and, in addition to the specification, provisional or complete, must be accompanied by (1) a copy or copies of the specification and drawings as filed in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief of such Patent Office, or otherwise verified to the satisfaction of the Comptroller; (2) a

statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification be in a foreign language, a translation thereof must be annexed to and verified by such statutory declaration.

By the terms of the 103rd section patents under the International Convention can only be granted to the person who has made the foreign application. (*Shallenberger's Application*, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552.)

The section applies although the state in which the foreign application was made has only acceded to the Convention after the date of the foreign application. (*Main's Patent*, 7 R. P. C. 13.)

A 'renewed application' for a patent was made in the United States, and seven months later a British patent was applied for under this section. There being evidence that the original American application was no longer of any force and effect, and conferred no rights, the British patent was directed to be sealed as of the date of the 'renewed application.' (*Van de Poele's Patent*, 7 R. P. C. 69.)

An International Office (*Le Bureau International*) in connection with the Convention has been established at Berne, Switzerland, which publishes a monthly periodical, entitled 'La Propriété Industrielle.' The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 centimes, and this sum should be forwarded by money order to MM. Jent & Reinert, Imprimeurs, Berne.

*Colonial Arrangements.*—When it is made to appear to her Majesty that the Legislature of any British Possession has made satisfactory provision for the protection of inventions patented in this country, her Majesty is empowered, by the 104th section of the Patents Act of 1883, by Order in Council, to apply the provisions of the 103rd section, with such variations or additions as may seem fit, to such British Possession; but such order is made revocable by another Order in Council. This order has at present only been made with reference to New Zealand.

## CHAPTER XXIII.

THE PATENT OFFICE—THE COMPTROLLER—GENERAL RULES—  
SEAL OF THE OFFICE—OFFICIAL DOCUMENTARY EVIDENCE  
—REGISTERS—PUBLICATIONS AND INDEXES—LIBRARY—  
PATENT MUSEUM.

UNTIL a new office has been provided by the Treasury, under the authority of the eighty-second section of the Act of 1883, the business relating to patents is transacted at the offices of the defunct Commissioners of Patents in Southampton Buildings, Chancery Lane. All the officers and clerks of the office are appointed by the Board of Trade, subject to the approval of the Treasury.

The Office is open to the public every week-day between the hours of ten and four, except on Christmas Day, Good Friday, the day observed as her Majesty's birthday, and the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

## THE COMPTROLLER-GENERAL.

The Comptroller-General of Patents, Designs, and Trade-Marks is an officer appointed by the Board of Trade under the eighty-third section of the statute of 1883 to act under the superintendence and direction of the Board as chief of the Patent Office, which is placed under his immediate charge.

Besides acting as general manager of the business of the office, and as superintendent of the examiners and clerks therein, he has many important duties to perform, as already mentioned in the preceding chapters, in regard to the various steps to be taken on applications for patents, on oppositions to grants, on the issue of patents, on appli-

cations for extensions of time, and on applications for leave to amend specifications.

In addition to these, which may be called his routine duties, though some of them will frequently call for the exercise of much care and thought, he is required, by section 40, to issue periodically an Illustrated Journal of Patented Inventions, as well as Reports of Patent Cases decided by Courts of Law, and any other information that he may deem generally useful or important. He has to make provision for keeping on sale copies of the Journal, and also of all complete specifications for the time being in force, with their accompanying drawings. And he is directed to continue in such form as he may deem expedient the indexes and abridgments of specifications hitherto published, and to prepare and publish from time to time such other indexes, abridgments of specifications, catalogues, and other works relating to inventions as he may see fit.

He is empowered to refuse patents when the use of the invention would, in his opinion, be contrary to law or morality. (Sect. 86.)

He is enabled to correct clerical errors in or in connection with applications for patents, or in the name, style, or address of the registered proprietor of a patent. (Sect. 91.)

By Rule 16 of the Patents Rules 1890 the Comptroller is empowered to amend documents and to correct irregularities in procedure; by Rule 51 he is authorised to enlarge the time prescribed by the Rules for doing any act or taking any proceeding thereunder, and by Rule 80 large powers are given to him, with the sanction of the Board of Trade, to dispense with acts, documents, evidence, &c., required under the Rules.

By section 3 of the Act of 1885 he has power to extend the time for leaving complete specifications at the Patent Office, and for accepting complete specifications, and for sealing patents.

Where any discretionary power is by the Act given to the Comptroller, it is expressly directed by the ninety-fourth section that he shall not exercise that power adversely to



the applicant for a patent, or for amendment of a specification, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent. As to the procedure, see Rules 11-14 of the Patents Rules 1890.

In any case of doubt or difficulty arising in the administration of any of the provisions of the Act, the ninety-fifth section directs that he may apply to either of the law officers for directions in the matter.

The Comptroller is required by the 102nd section to cause a report respecting the execution by or under him of the Act to be laid before both Houses of Parliament, before the first day of June in every year, and to include therein for the year to which each report relates all general rules made in that year under or for the purposes of the Act, and an account of all fees, salaries, and allowances, and other money received and paid under the Act.

In case of the absence of the Comptroller, any act or thing directed to be done by or to him may be done by or to any officer authorised in that behalf by the Board of Trade. (Sect. 82, subsect. 4.)

#### GENERAL RULES.

The Board of Trade was empowered by the 101st section of the Act of 1883 to make rules for regulating generally the business of the Patent Office and all things placed under the direction and control of the Comptroller or of the Board; and particularly for regulating the practice of registration; for making or requiring duplicates of specifications, amendments, drawings, and other documents; for securing and regulating the publishing and selling of copies thereof; for securing and regulating the making, printing, publishing, and selling of indexes to abridgments of specifications and other documents in the Patent Office, and providing for the inspection of indexes, abridgments, and other documents. Such general rules are to be of the same effect as if they were contained in the Act, and are to be judicially noticed. They must be laid before the two Houses of Parliament,

either of which has power within a limited time to annul any of them.

Consolidated Rules have been issued by the Board of Trade, with the short title of the Patents Rules 1890, and are reprinted in the Appendix to this volume.

#### THE SEAL OF THE PATENT OFFICE.

By the eighty-fourth section of the Patents Act of 1883, it is directed that there shall be a seal for the Patent Office, and that impressions thereof shall be judicially noticed and admitted in evidence.

#### OFFICIAL DOCUMENTARY EVIDENCE.

By the eighty-ninth section of the same Act it is enacted that printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts and in all proceedings, without further proof or production of the originals.

Then by the ninety-sixth section a certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by the Act, or any general rules made thereunder, to make or do, shall be *primâ-facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

By the twenty-third section of the same Act, it is enacted that the Register of Patents to be kept at the Patent Office shall be *primâ-facie* evidence of any matters directed or authorised to be inserted therein.

Finally, by the hundredth section of the Act it is directed that copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of the Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science

and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office ; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee ; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man, without further proof or production of the originals.

#### REGISTERS.

The Register of Patents kept at the office and mentioned in the chapter on Registration is open to public inspection daily (with certain exceptions mentioned in Rule 78) between the hours of ten and four. Up to the end of 1883 the registers kept at the Patent Office were two. In the one called the Register of Patents were recorded, in chronological order and with the dates, all patents granted under the Patents Act of 1852, as well as the deposit or filing of specifications, disclaimers, memoranda of alterations, amendments, confirmations, and extensions, and the expiry, vacating, and cancelling of patents. The other register, called the Register of Proprietors, contains entries of the assignments of patents, or of any share or interest therein ; and of licences, mentioning the districts to which they relate, with the names of persons having shares or interests in patents and licences, and the dates at which such shares or interests were acquired.

#### PUBLICATIONS AND INDEXES.

Besides the Illustrated Official Journal relating to Patents and Reports of Patent Cases decided in the Courts of Law and directed to be published by the fortieth section of the new Act, several other publications are issued by the Patent Office. A 'Circular of Information,' containing sixteen pages, is forwarded to applicants. Printed copies of all the specifications filed under the Patents Act of 1852, and of all

specifications enrolled previously to the passing of the said Act are purchasable for small sums at the office, with lithographed copies of the drawings accompanying such specifications. The specifications under the new Act are also printed and published, but only when the complete specifications have been filed and accepted.

Alphabetical indexes of all the specifications of patents enrolled in Chancery, from 1617 to the latest available date, have been published under the authority of the office, as well as an index arranging the specifications according to the subject-matter, and supplemental indexes continue to be published annually. Chronological indexes of patents, from the earliest date to the year 1875, have also been published. Another index, called the Reference Index of Patents, points out the office in which each enrolled or filed specification of a patent may be consulted; the books in which specifications, law proceedings, and other subjects connected with inventions have been noticed; also, such specifications as have been published under official authority. These indexes are of great service in tracing the history of inventions.

The volumes containing abridgments of specifications arranged chronologically in classes are of immense utility to inventors who wish to discover what has been already done in any particular branch of invention; but, unfortunately, these abridgments are not kept up to date.

Copies of the Patent Office publications are presented to the principal public offices, seats of learning, societies, institutions, libraries, British Colonies, and foreign states.

#### PUBLIC LIBRARY.

A library has been established in connection with the Patent Office, and this is open free to the public. The whole of the publications of the office, and also the leading British and Foreign scientific journals and text-books in the various departments of science and art are in this library.

## PATENT MUSEUM.

The Patent Museum at South Kensington is transferred by the forty-first section of the Act of 1883 to the Department of Science and Art, which is empowered by the forty-second section to require any patentee to furnish them with a model of his invention on payment of the cost, the amount, in case of dispute, to be settled by the Board of Trade.

## CHAPTER XXIV.

## THE INSTITUTE OF PATENT AGENTS AND ITS REGISTER.

IN the year 1882 a number of Patent Agents practising in London, being of opinion that it was highly desirable on several grounds to form an association of Patent Agents, and to obtain incorporation for it under the statutes in force, the proper steps were taken, after the memorandum and articles of association had been prepared, to effect the object in view. The Institute, as the association was named, was established to form a representative body of the Patent Agents of the United Kingdom for the purpose of promoting improvements in the law relating to patents and in the regulations under which they are administered ; also to frame rules for the observance of Patent Agents in all matters appertaining to their profession and practice. The Institute is composed of Fellows, Associates (who are not Patent Agents by profession), Foreign Members (who are Patent Agents in the colonies or in foreign countries), and Honorary Members. The affairs of the Institute are managed by a Council, consisting of a President, Vice-President, and Past Presidents, together with eight ordinary members selected from amongst the Fellows. The offices of the Institute are at 19 Southampton Buildings, Chancery Lane, London. Here they keep a library, and at stated intervals meetings are held at which papers relating to patent matters are read and discussed. A volume of their Transactions is published annually.

Since its incorporation the Institute has been of material assistance to the Board of Trade in shaping some of the provisions in the Acts of Parliament bearing upon patents

and in framing rules for the regulation of the business of the Patent Office.

By the first section of the Patents Act of 1888, it was enacted that after July 1st, 1889, a person shall not be entitled to describe himself as a Patent Agent by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a Patent Agent in pursuance of that Act; and any person knowingly contravening this provision is liable on summary conviction to a fine not exceeding 20*l.* But every person who proves to the Board of Trade that he had been *bonâ fide* practising in the United Kingdom as a Patent Agent prior to the passing of the Act is entitled to be registered. The Board of Trade is authorised to make general rules for giving effect to this enactment, and it has accordingly issued a set of Rules, a copy of which will be found in the Appendix to this work.

A register is to be kept by the Institute for the registration of Patent Agents. A copy of the register is to be printed annually and placed on sale. The Institute is to appoint a Registrar to keep the register under the direction of the Board of Trade. A person who desires to be registered on the ground that, prior to the passing of the Act, he had been *bonâ fide* practising as a Patent Agent, must satisfy the Board of Trade that this was the fact before his name will be entered on the register. (Rule 5.) With the exception of persons registered on this ground, no person is to be registered unless he has passed and produced to the Registrar a certificate under the seal of the Institute that he had passed such final examination as to his knowledge of Patent Law and Practice and of the duties of a Patent Agent as the Institute shall from time to time prescribe. Before any person can present himself for the final qualifying examination of the Institute he must have passed one of the matriculation examinations of an English, Scottish, or Irish University, or the Oxford or Cambridge Middle Class Senior Local Examinations, or the Examinations of the Civil Service Commissioners, or such other examinations as

the Institute shall, with the approval of the Board of Trade, by regulation prescribe. These preliminary examinations are, however, not required in the case of solicitors in England and Ireland and law agents in Scotland, or in the case of persons who have for seven consecutive years been continuously engaged as pupils or assistants to registered Patent Agents. In these cases the final qualifying examination only is required to be passed by candidates for registration.

The Institute must hold, at least once in the year, a final qualifying examination, and it is to have the entire management and conduct of such examination, including the appointment of the examiners. The subjects of examination are (a) Patent Law; (b) Patent practice and procedure; (c) the preparation and interpretation of patent documents; (d) physical science and its applications to the arts and manufactures. Persons desiring to obtain further information as to the examination should apply to the Secretary of the Institute. The fees payable by a candidate, and those on registration and annually afterwards by Patent Agents are set forth in Appendix C. to the Rules.

The names of persons convicted of crimes, or found guilty of disgraceful conduct, are to be removed from the register. Non-payment of fees is another cause for erasing the name of a Patent Agent from the register.



# APPENDIX

## PART I

### *STATUTES, INTERNATIONAL CONVENTION, RULES, AND FORMS*

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# APPENDIX

## PART I

### Statutes

21 JAC. I. C. 3. [A.D. 1623.]

*An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.*

FORASMUCH as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesties laws, which your Majesties declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm : And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature ; yet nevertheless, upon misinformations, and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesties subjects, contrary to the laws of this your realm, and contrary to your Majesties most royal and blessed intention so published, as aforesaid ; for avoiding thereof, and preventing of the like to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this present Parliament, that all monopolies, and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted to any person or persons, bodies politic or corporate whatsoever, of

Monopolies,  
etc., con-  
trary to the  
laws of the  
realm.

or for the sole buying, selling, making, working, or using of anything within this realm, or the dominion of Wales; or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenour or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made, or to agree or compound with any others for any penalty, or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity, of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are, and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, etc., shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending, as aforesaid, and the force and validity of them, and every of them, ought to be, and shall be for ever hereafter examined, heard, tryed, and determined by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, etc.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are, or hereafter shall be, shall stand and be disabled, and incapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending, as aforesaid, or any liberty, power or faculty, grounded, or pretended to be grounded, upon them or any of them.

[Sect. 4 enacts that the party grieved by pretext of a monopoly, etc., shall recover treble damages and double costs. And sect. 5 refers to letters patent for twenty-one years already granted. The all-important section is the next.]

6. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true

and first inventor or inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

[The remaining sections of the Act have become obsolete or have been repealed.]

46 & 47 VICT. c. 57.

*An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.* [25th August 1883.]

[The sections relating to the Registration of Designs and of Trade Marks are not here reprinted.]

BE it enacted, &c., as follows:—

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.

Part II.—Patents.

Part III.—Designs.

Part IV.—Trade Marks.

Part V.—General.

Division of Act into parts.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December 1883. Commencement of Act.

PART II.—PATENTS.

*Application for and Grant of Patent.*

4. (1) Any person, whether a British subject or not, may make an application for a patent. Persons entitled to apply for patent.

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.<sup>1</sup>

Application  
and specifi-  
cation.

5. (1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; <sup>2</sup> and must be left at, or sent by post, to the Patent Office in the prescribed manner.

(2) An application must contain a declaration <sup>3</sup> to the effect that the applicant is in possession of an invention, whereof he, or, in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.<sup>4</sup>

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings if required.

(5) A specification, whether provisional or complete, must commence with the title, and, in the case of a complete specification, must end with a distinct statement of the invention claimed.

Reference of  
application  
to examiner.

6. The Comptroller shall refer every application to an examiner, who shall ascertain and report to the Comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings, if any, have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Power for  
Comptroller  
to refuse  
application  
or require  
amendment.

7. [As amended by the Patents Act of 1888.] (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

<sup>1</sup> See Patents Act, 1883, s. 5.

<sup>2</sup> See Rules 5 and 6 of Patents Rules 1890.

<sup>3</sup> See Patents Act, 1885, s. 2.

<sup>4</sup> As to drawings, see Rules 30-33 of Patents Rules 1890.

(2) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

(3) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.

8. (1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.<sup>1</sup>

Time for leaving complete specification.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

9. (1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

Comparison of provisional and complete specification

(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the Comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the complete specification shall be accepted.

(4) Unless a complete specification is accepted within twelve

<sup>1</sup> The Comptroller is empowered to grant further time, not exceeding one month. (See s. 3 of Patents Act, 1885.)

months<sup>1</sup> from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5) [As amended by the 3rd sect. of the Act of 1888.] Reports of examiners shall not in any case be published or open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specification or specifications, with the drawings, if any, shall be open to public inspection.

Opposition to grant of patent.

11. [As amended by the 4th sect. of the Act of 1888.] (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent, on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

<sup>1</sup> The Comptroller is empowered to grant further time, not exceeding three months. (See sect. 3 of Act, 1885.)

12. (1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office. Sealing of patent.

(2) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months<sup>1</sup> from the date of application, except in the cases hereinafter mentioned, that is to say—

(a) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application. Date of patent.

#### *Provisional Protection.*

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection. Provisional protection.

#### *Protection by Complete Specification.*

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed Effect of acceptance of complete specification

<sup>1</sup> A further extension of four months after the fifteen months is allowed for the sealing of the patent by sect. 3 of the Act of 1885.



on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

*Patent.*

Extent of  
patent.

16. Every patent when sealed shall have effect throughout the extent of the United Kingdom and the Isle of Man.

Term of  
patent.

17. (1) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment.

(4) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:—

(a) The time for making any payment shall not in any case be enlarged for more than three months.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

*Amendment of Specification.*

Amendment  
of specification.

18. (1) An applicant or a patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(8) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

(7) The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts, and for all purposes, be deemed to form part of the specification.

(10) [As amended by sect. 5 of the Act of 1888.] The foregoing provisions of this section do not apply when, and so long as, any action for infringement or proceeding for revocation of a patent is pending.

19. In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Power to disclaim part of invention during action, etc.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention

Restriction on recovery of damages.

before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Advertise-  
ment of  
amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner.

#### *Compulsory Licences.*

Power for  
Board to  
order grant  
of licences.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

(a) The patent is not being worked in the United Kingdom ;  
or

(b) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

#### *Register of Patents.*

Register of  
patents.

23. (1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2) The register of patents shall be *prima-facie* evidence of any matters by this Act directed or authorised to be inserted therein.

(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

#### *Fees.*

Fees in  
schedule.

24. (1) There shall be paid in respect of the several instruments described in the Second Schedule to this Act the

fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

*Extension of Term of Patent.*

25. (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

Extension of  
term of  
patent on  
petition to  
Queen in  
Council.

(2) Any person may enter a *caveat*, addressed to the Registrar of the Council, at the Council Office, against the extension.

(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a *caveat* shall be entitled to be heard by himself or by counsel on the petition.

(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.