

**LETTERS PATENT FOR  
INVENTIONS.**

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THE  
 LAW AND PRACTICE  
 RELATING TO  
 LETTERS PATENT FOR  
 INVENTIONS.

BY  
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THIRD EDITION

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## PREFACE.



IN this Edition I have endeavoured to bring the subject of Letters Patent up to date. Recent decisions before the Courts and the Law Officers have cleared up so many important but hitherto obscure points in the Law and Practice that the 1889 Edition of this work has become incomplete and unreliable. I have had the advantage of the assistance of the Author on many points of difficulty, and I trust that it will be found that the result of my labours is as reasonably free from error and imperfection as a legal text book is expected to be.

W. PETER RYLANDS.

NEW COURT, TEMPLE.



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# THE LAW AND PRACTICE

## RELATING TO

# LETTERS PATENT FOR INVENTIONS.

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## CHAPTER I.

### LETTERS PATENT.

LETTERS patent for inventions are granted by the Crown by virtue of its common law prerogative. Letters patent are franchises, being a branch of the royal prerogative vested in the hands of a subject. In *Reg. v. County Court Judge of Halifax (a)*, Baron Pollock, in giving the judgment of the Court, said: "It was contended on behalf of the defendant that 'franchise' includes the right or privilege which is granted by a patent for a new invention. The primary meaning of the word 'franchise,' as its origin denotes, is a freedom; but it has been used in the language of the law in a wider sense as including a liberty or privilege. In *Termes de la Ley*, tit. 'Franchise,' the only meaning given to it is 'an immunity or exemption from ordinary jurisdiction.' The various rights, however, which it aptly describes are dwelt upon at great length in the *Digests of Viner and Comyn*, and in *Bacon's Abridgement*; and in *Blackstone's Commentaries*, Vol. II. p. 7, it is said: 'Franchise and liberty are used as synonymous terms, and their definition is, a royal privilege, or branch of the king's prerogative, subsisting in the hands of a subject. Being, therefore, derived from the Crown, they must arise from the king's grant; or in some cases may be held by prescription, which, as has been frequently said, presupposes a grant. The kinds of them are various and almost

(a) L. R., 1891, 1 Q. B. 793, 797;    mod by C. A., L. R., 1891, 2 Q. B. 263.



infinito.' In Chitty's Prerogative of the Crown, p. 119, a franchise is defined to be a royal privilege, or branch of the royal prerogative, subsisting in the hands of a subject by a grant from the king; and for this he refers to Finch's Law, p. 164. In Comyn's Digest, tit. 'Prerogative,' D. 30, it is said: 'The king may grant to another to have any franchise or liberty as privileges of trade;' and under the head of 'Trade' (B), instances are given of grants by the king's patent for the sole printing of certain books. In *Darcy v. Allen* (b), the Court said, in dealing with the first question—viz., whether the said grant to the plaintiff of the sole making of cards within the realm was good or not—'Also such charter of a monopoly, against the freedom of trade and traffic, is against divers Acts of Parliament, as 9 Edw. III. cc. 1 & 2, which for the advancement of trade and traffic extends to all things vendible, notwithstanding any charter of franchise granted to the contrary, or usage or custom, or judgment given upon such charters, which charters are adjudged by the same Parliament to be of no force or effect.' These words are inapplicable to the 'first question,' unless the Court intended to assume that the grant of the sole making of cards within the realm was a 'charter of franchise'; and, although the charter of franchise mentioned in the statute cited apparently referred to charters which had been granted to corporations or towns, it seems to be a fair inference that the Court considered such charter of a monopoly as a charter of franchise; and that this would be none the less true when the monopoly answered to the description which the Court declared to be lawful, *i.e.*, 'where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm.' The result of these authorities is, in our opinion, that 'franchise' does include such a right as was put in issue by the proceedings in the county court."

By the creation of monopolies to first and true inventors in the right of using their inventions, a species of property is created in favour of inventors, as a reward for the benefits which they have conferred on humanity, by the exercise of their thought, know-

(b) 11 Rep. 84.

ledge, and industry. It is to the interests of the community that persons should be induced to devote their time, energies and resources in furtherance of the development of arts and manufactures, and this was recognised in England from the earliest periods which can pretend to be described as civilized.

It was to the advantage of the whole community that inventors should be rewarded, and no measure of reward can be conceived more just or equitable, and bearing a closer relation to the benefit conferred by the particular inventor than to grant him the sole right of making, using and vending his invention for a limited period of time.

In the corrupt ages of the Stuarts, it is not to be wondered at, that the prerogative of the crown to grant monopoly rights to first and true inventors, should have been made a lever for assuming a prerogative to grant monopoly rights in trade generally. In the reign of James the First, to such an extent had this abuse been carried, that it was deemed advisable by the legislature that the rights of the crown in respect of letters patent should be declared by legislative enactment—this was the origin of the Statute of Monopolies.

It has been supposed that the prerogative of the crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments and of the authorities which preceded it, shows clearly that, so far from the statute giving to the crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the crown, and the declaring that, which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited “that all grants of 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 Majesty’s laws, which your Majesty’s declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted or hereafter to be made or granted . . . 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.”



Section 6 saved the granting of letters patent to inventors in the following words:

“Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent 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 and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State by raising of 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 patent 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.”

It will thus be seen that the Statute of Monopolies creates no statutory rights, but merely saves the common law rights of the crown; and by section 116 of the Patents Designs and Trade Marks Act, 1883, it is enacted, “*Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the crown in relation to the granting of any letters patent, or to the withholding of the grant thereof.*” By section 46 of the same Act the word “*invention*” is defined as meaning “*any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies . . . and includes an alleged invention.*”

So it is that in the present day, notwithstanding the various statutes which have been passed in relation to letters patent for inventions, these monopolies are still granted upon the mere motion of the sovereign, in the exercise of her royal prerogative, and that all that has been done, has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining letters patent for inventions.

For the purpose of supporting the validity of the letters patent it is necessary that the patentee should conform to certain requisites, and these requisites are indicated in the 6th section of

the Statute of Monopolies. In the first place, he must be the true and first inventor of a new manufacture; the new manufacture must not be contrary to law, nor must it be mischievous to the State, by raising the prices of commodities at home; it must not be hurtful to trade, nor generally inconvenient. The Act of 1883 has adopted this definition of an invention, and anything that does not conform with all these requisites is not entitled to be called an invention. The host of important decided cases as to the construction of the 6th section of the Statute of Monopolies, and the enormous expense, and labour and learning, which have been devoted to obtaining these decisions, no doubt induced the legislature to adopt a definition which had in some respects obtained a correct judicial meaning; but it is doubtful whether it was wise to re-enact it in a form which had, we may say, centuries ago, already become to some extent obsolete.

The protection of trade by means of guilds, and by all those various schemes which were elaborated in the middle ages, has been found to be fallacious. Industries in this country are no longer protected by the artificial process of law, and therefore it is difficult to understand the correct meaning which would be given to the words in the 6th section of the Statute of Monopolies, which refer to an invention having a tendency to raising the prices of commodities at home, or to hamper trade, or to be generally inconvenient, terms exceedingly vague in themselves, and which the Courts have not had occasion to consider for a very great number of years.

These matters, and the construction which is to be placed upon the word "*invention*," will have to be dealt with hereafter, when we consider the cases which have been decided upon the subject.

Thus we see that the same essentials must be proved by an applicant for the grant of letters patent to-day as were necessary at the date of the Statute of Monopolies; he must be the first to introduce into this realm the manufacture for which he seeks a patent, whether by enterprise in importing it from abroad, or by the exercise of his own inventive faculty. The Patents, &c., Acts, 1883-1888, deal merely with points of procedure and



practice, adopting, as has been already pointed out, the definition of an invention contained in the sixth section of the Statute of Monopolies; the Act of 1883 consolidated all the provisions of previous acts on the subject, at the same time introducing some few innovations, the effect of which will be dealt with in detail in the course of the consideration of the various branches of the subject as they arise.

## CHAPTER II.

## THE PATENTEE.

By sect. 46 of the Act of 1883, the word "patentee" is construed as meaning "the person for the time being entitled to the benefit of the patent," consequently it may mean the original grantee, his executors and administrators, or any assignee.

A mortgagee is the legal owner of the patent, but if not registered in "The Register of Patents" as *proprietor*, he is not the person for the time being entitled to the benefit of it so as to constitute him "patentee," and it is not necessary that he should be joined as a party in an action for infringement (*a*), and *semble* this would be the case, even if he was so registered (*b*).

An exclusive licensee has not such an interest in the patent as to enable him to maintain an action for infringement, he may, however, sue in the name of the grantor of the license (*c*).

Lord Justice Cotton in the Court of Appeal said: "All that is contended is that an exclusive license is equivalent to a grant, and that the licensee may, without the concurrence of the patentee, or without there having been any violation of the agreement between the patentee and himself, sue the person who is infringing the rights conferred by the license. In my opinion that is wrong. That is turning that which is merely a license into something very different, namely a grant of the whole letters patent" (*d*).

(*a*) *Van Gelder Apsimon & Co. v. Sowerby Bridge Flour Co.*, L. R., 44 Ch. D. 374.

(*b*) *Ib.* p. 389.

(*c*) *Heap v. Hartley*, L. R., 42 Ch. D. 461; *Derosne v. Fairie*, 1 Web. P

C. 154; *Renard v. Levinstein*, 2 Hem. & M. 628.

(*d*) *Heap v. Hartley*, L. R., 42 Ch. D. 469; *Guyot v. Thomson*, 11 P. O. R. 541, 554.

By sect. 4 of the same Act it is enacted: (1) *Any person, whether British subject or not, may make an application for a patent.*

It will be observed that there is no limitation whatever preventing a person under incapacity, either by reason of infancy or otherwise, from obtaining a patent.

There does not appear to have ever been a question as to whether an infant or a married woman might under the old law have become a grantee of letters patent. The new law, however, is perfectly clear, and sweeps away any doubt that might have been entertained on the subject.

Before this Act it was competent for an alien to obtain a patent; Lord Cairns in the matter of *Wirth's Patent (e)*, went even further than this: "I am quite clear that letters patent may be granted to a foreigner who is resident abroad for an invention communicated to him by another resident abroad" (*f*).

But quære if letters patent could be obtained by an alien enemy (*g*).

In *Patterson v. Gas Light and Coke Co.*, James, L.J., in the Court of Appeal, said: "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation (*h*).

It has been thought doubtful whether a beneficed clergyman could become the grantee of letters patent, since the exercise of an invention would probably amount to trading within the meaning of 57 Geo. III. c. 99 (*i*).

Rule 73 of the P. O. Rules, 1890: "A body corporate may be registered as proprietor by its corporate name." It could, however, only become proprietor as assignee of the letters patent, or as co-grantee with the original inventor, since

(e) *Wirth's Patent*, L. R., 12 Ch. D. 303; 28 W. R. 329.

(f) See also *Chappell v. Purday*, 14 M. & W. 318.

(g) *Bloxam v. Elsec*, 1 C. & P. 558.

(h) L. R., 2 Ch. D. 832.

(i) Hindmarch on Patents, p. 35  
*Hall v. Franklin*, 3. M. & W. 259.

a corporation, being without a mind, lacks that which is obviously an essential to invention (*k*).

By sect. 4 (2) it is enacted "Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly."

Only one of the applicants need make the declaration, a capitalist or other person or persons may join an inventor and obtain a valid joint patent (*l*).

A grant of letters patent confers on the patentee "a right to exclude others from manufacturing in a particular way and using a particular invention" (*m*), it does not affect his right of manufacturing according to his invention, which he would have had if there were no letters patent at all; consequently, where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the others, and without affording an account of his profits to his co-patentees (*n*), and this is the case whether they are co-grantees or co-assignees.

As to rights of such co-patentees to the profits made by granting licenses, quære (*o*).

A co-owner of letters patent is entitled to work the invention without accounting for profits, even though he may be mortgagee of the share of the other co-owner (*p*).

By sect. 5 (1) "An application for a patent must be made in the form set forth in the schedule to this Act or in such other form as may be from time to time prescribed; and must be left at or sent by post to the Patent Office in the prescribed manner" (*q*). (2) "An application must contain a declaration to the effect that the applicant is in possession of an invention thereof 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

(*k*) Hindmarch on Patents, p. 34.

(*l*) 48 & 49 Vict. c. 63, s. 5.

(*m*) Per Lord Chancellor in *Steers v. Rogers*, L. R., 1893, App. Cas. 235; 10 P. O. R. 251.

(*n*) *Steers v. Rogers*, 9 P. O. R. 177; L. R., 1892, 2 Ch. 13; 10 P. O. R. 245; L. R., 1893, App. Cas. 232;

*Mathers v. Green*, L. R., 1 Ch. 29; 35 L. J., Ch. 3; *Hancock v. Bewley*, 1 Johns. 604; Good P. C. 219.

(*o*) *Mathers v. Green*, L. R., 1 Ch. 33; 35 L. J., Ch. 3.

(*p*) *Steers v. Rogers*, supra; see Chap. XII., post.

(*q*) See Appendix, Forms A, A1, A2.



*for which he or they desire or desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*

By sect. 99 of the Act, due provision is made for enabling infants, and people under incapacity to take the requisite steps for obtaining letters patent.

Sect. 34 makes provision for the granting of letters patent to the legal representatives of a deceased inventor, provided application be made within six months from the decease of the inventor; the application must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

We have now to deal with the construction of the words "first and true inventor."

The reason that the common law has created a prerogative of the Crown to grant letters patent to first and true inventors is, that the public benefit by the consideration which the inventor gives in return for the monopoly privilege which is granted to him. That consideration may be divided into three parts.

In the first place the patentee must be the actual inventor, that is, the consideration must move from him.

Secondly, he must have invented a new and useful invention.

Thirdly, he must publish his invention.

## CHAPTER III.

## THE CONSIDERATION—BEING THE ACTUAL INVENTOR.

An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The process of invention may be divided into two parts. The operation of the mind, and the carrying out the results of that operation by the hands. It is true that when an invention is the result of pure accident the physical production may precede the operation of the mind in perceiving its applicability, still, as a general rule, it will be observed that the operation of the mind will precede the physical production. The operation of the mind must, in all cases, be that of the mind of the inventor. The carrying out of the results of the operation of the mind may be done by the hands of the inventor or by those of anyone else whom he may employ for the purpose.

In *Tennant's Case* (a) a material portion of the invention claimed was found to have been suggested by a chemist at Glasgow. Lord Ellenborough held, that the patent was bad because the plaintiff was not the inventor. It will be observed in this case, that although it is possible that the plaintiff was the first person to use the particular method for making bleaching liquor, still, inasmuch as that method of producing this bleaching liquor was thought out by someone else and communicated to the plaintiff, he was held not to be an inventor. In considering this question, we must not confuse the idea of first manufacturer with that of first inventor.

It is evident that cases may arise where the operation of one man's mind may have assisted the operation of another's mind.

(a) *Tennant's Case*, 1 Web. P. C. 125.

In this case it will be a question for the jury as to which was, so to speak, the dominant mind and which the servient mind, the dominant mind will be entitled to the patent. In *Allen v. Rawson* (b), Tindal, C.J., said: "It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But when we see that the principal objects of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void."

In *Cornish v. Keene* (c) Tindal, C.J., said: "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not, because these patents are granted as a reward, not only for the benefit conferred upon the public by the discovery, but also the ingenuity of the first inventor; and although it is proved that it is a new discovery, so far as the world is concerned, yet if anybody is able to show that although that was new with the party who got the patent, he was not the man whose ingenuity first discovered it, that he borrowed it from A. or B., or had taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would be an important question whether he was the first and original inventor of it." There is no doubt that under the circumstances stated by the Chief Justice, the patentee would not be the original inventor.

We do not propose to deal at length with the cases that succeed *Cornish v. Keene*. The principle laid down in those cases we have cited has been invariably followed. In *Gibson v. Brand* (d), Tindal, C.J., said: "A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor, he may have borrowed it from some other person or book. The legislature

(b) *Allen v. Rawson*, 1 C. B. 574.

(d) *Gibson v. Brand*, 1 Web. P. C.

(c) *Cornish v. Keene*, 1 Web. P. C. 628.



never intended that a person, who had taken his knowledge from the art of another, from the labours and assiduity of another, should be the man who was to receive the benefit of another's skill." The same judge in *Walton v. Potter* (e): "If the subject-matter of the patent has been published in a dictionary, for example, and if a man merely adopts it, the merit is so small that his patent for it would be worth nothing."

In *R. v. Wheeler* (f), Abbott, C.J., delivering the judgment of the Court said: "If the patentee has not invented the matter or thing of which he represents himself to be inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen that the patentee has invented some other matter or thing, of which, on due representation thereof, he might have been entitled to a grant of the exclusive use."

In *Bloxam v. Elsee* (g), the patentee had worked out the principle of his invention in his own mind, the mechanical details and arrangements requisite for carrying the principle into practice so as to realize the idea were extremely numerous and complicated, and Mr. D. was employed professionally to assist in these arrangements. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that the patentee was not the inventor, the objection was overruled. It will be seen in this case that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the intellectual hands employed by the patentee to carry out that which he had previously conceived in his mind. The summing-up of Baron Alderson, in the case of *Minter v. Wells* (h), is instructive on this point: "The patentee," said the learned judge, "claims under the patent, stating, in his petition to the Crown, that he is the true inventor of the machine in question, and if it could be shown that he was not the true inventor, but that someone else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent, and then the

(e) *Walton v. Potter*, 1 Web. P. C. 132, n. 592.

(f) *R. v. Wheeler*, 2 B. & Ald. 345. 127.

(g) 1 C. & P. 558; 1 Web. P. C.

(h) *Minter v. Wells*, 1 Web. P. C.

law is, that the patent obtained under such circumstances would be void, and no action could be maintained against the party for the infringement of the patent. If Sutton suggested the principle to Minter, then he, Sutton, would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect."

Exactly to what extent the man who conceives an idea is entitled to improvements suggested by the person he employs to work out that idea, is difficult to define, and must depend upon the facts of each case in which the question may arise; but the guiding principle is, Is it the mere idea, or is it the method of carrying it into effect that constitutes the pith of the invention?

In *Elias v. Grovesend Tinsplate Co.* (i), the facts were as follows: In the year 1867, and subsequently, one Morewood took out patents for machines for removing the superfluous tin from tinplates, this he effected by the immersion of the tinplate in a grease-pot by means of a cradle, with an adjustable guide at each end, so that the plate, upon immersion, was sent down into the grease-pot in a perpendicular position, and so brought under the rollers therein, these rollers raised the plate to the surface in a like perpendicular position having in the meantime squeezed or compressed from the plate any superfluous tin adhering to it; by means of what was practically a duplicated machine of this description Morewood was able to treat two plates at a time, but when the "double Morewood" was at work it brought up the plates alternately and not simultaneously. In 1885 it occurred to the plaintiff that saving in time and labour would be effected if a similar machine were constructed to bring up the two plates simultaneously. In 1886 he communicated his idea to Mr. Glyn Thomas, of whose works he was the manager, describing it "to work two sheets at a time, side by side, on the Morewood principle, with rollers lengthened." The patent was held invalid for want of subject-matter, but the Master of the Rolls in the Court

(i) *Elias v. Grovesend Tinsplate Co.*, 7 P. O. R. 455.



of Appeal said (*k*): "Supposing there is an invention in that which is claimed—the carrying out of an idea in a machine—was the whole of that invention Mr. Elias', the plaintiff's, or was not part of it the invention of Karrop the machinist? Upon the assumption that there must be more than the idea, and that the machine is part of the invention—I mean the mechanism is part of the invention—was the whole of that done by Elias? The evidence seems to me to be clear as to this, that he had the idea in his mind of doubling Morewood's pot lengthways, that is of making a pot of Morewood's twice the size of Morewood's, so that the two plates might be put in side by side. That was his idea. If that was all, it was not patentable; but it is to be done in a machine. Did he have anything in the world to do with the construction of the machine which upon the assumption is part of the invention? . . . . If it is an invention Karrop has invented part of it."

The above quoted cases (*l*) all seem to show that the man who conceives the idea has no right to the inventions of the man whom he employs to carry it out other than mere improvements in mechanical details, whether that man be his immediate servant or an independent mechanic, and the relationship of master and servant gives to the master no rights to the invention of his servant (*m*).

A. may have invented something, it may have pleased him to try a few experiments with his invention, and then to abandon it without publication. B. may subsequently have invented the same thing altogether independently of A. If B. applies for letters patent he is at law the first inventor; but should it be shown that the process of invention was not carried on in B.'s mind at all, but that A. communicated his ideas to B., although

(*k*) *Ib.* pp. 465, 466.

(*l*) *Allen v. Rawson*, 1 C. B. 551, 574; *Minter v. Wells*, 1 Web. P. C. 127; *R. v. Wheeler*, 2 B. & Ald. 349; *Elias v. Grovesend Tinplate Co.*, 7 P. O. R. 455; see also *David & Woodley's Patent*, Griff. L. O. C. 26.

(*m*) *Barker v. Shaw*, 1 Web. P. C. 126, n.; *In re Lowe's Patent*, 25 L. J.,

Ch. 456; *R. v. Arkwright*, Dav. P. C. 61; *Homan's Patent*, 6 P. O. R. 104; *Barber v. Walduck*, 1 Carp. P. C. 438; *Re Russell's Patent*, 2 Do G. & J. 130; *Scott v. Young*, L. R., 6 Ch. 274; *Saxby v. Gloucester Waggon Co.*, Griff. L. O. C. 56; *In re Heald's Patent*, 8 P. O. R. 429; but see *Kurtz v. Spence*, 5 P. O. R. 180.



with the full intention of abandoning them, B. will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (n): this was an improvement in the manufacture of object-glasses for telescopes. Dr. K. had made and used identically similar object-glasses for his own purposes, but he had in no way published his invention. Dollond, without any communication from Dr. K., had re-invented these object-glasses; held that Dollond's patent was good.

In *Lewis v. Marling* (o), Mr. Justice Bailey said: "If I discover a thing for myself, it is no objection to my claim to a patent that another also has made the discovery, provided I first introduce it into public use." The suggestion in that case having been that the patentee had acquired his invention by seeing a model of a similar machine which had been brought from America; it was disproved that he had seen the model, and consequently he was held to be the first and true inventor.

In dealing with this branch of the subject, and showing that one of the essential portions of the consideration for the grant of letters patent is the labour of the mind of the inventor, we may cite the case of *Patterson v. Gas Light and Coke Company* (p). In that case certain referees had been appointed under the City of London Gas Act to inquire into the subject of the purification of gas. The plaintiff was one of those referees. The referees drew up a report on the 31st January, 1872. The report contained a description of the subject-matter of the plaintiff's patent. Subsequently to the making of the report, but before its delivery to the Board of Trade, the plaintiff, who had really discovered the invention, obtained provisional protection. The action was brought against the Gas Light and Coke Company for infringing his patent. The company alleged that the invention was not new, and also denied the title of the plaintiff to take out a patent in respect of it, on the ground presumably, that he had no consideration to offer to the public in return for the grant of letters patent, he having already disposed to the public of his knowledge upon the subject for other considerations. In the judgment of the House of Lords, Lord Blackburn said: "It seems to me

(n) 1 Web. P. C. 43.

433.

(o) 10 B. & C. 27; 1 Web. P. C. (p) L. R., 3 App. Cas. 239, 243.

clear that the duty of the referees under the Act was to ascertain how far the gas could be practically purified by each company. If they found that gas containing not more than a certain limited amount of impurity could be practically produced by any means, they were to prescribe the maximum amount accordingly, and they were by obvious implication, though it is not expressly enacted, to make public how this degree of purity could practically be obtained. It was not material to them to inquire whether these were means previously known, which the companies had failed to make use of from parsimony, negligence or ignorance, or whether there was some new idea which had been developed during the course of their enquiries, which made these old means practically valuable when before they were not. They were not at all required to distinguish new from old. In all these respects the report was quite different from a specification. But, as soon as they became aware that the gas could be practicably brought to this degree of purity, their duty was to fix the maximum accordingly, and to make known to the public the means by which this could practicably be done. The report of the 31st January, 1872, is drawn up as it ought to have been. It shows that, by some means there explained, purity to a great extent could practicably be obtained, it makes no attempt to show how much of this was previously known though neglected, and it nowhere states that any part of what was now disclosed was invented by one of their own body." In the Court of Appeal James, L.J., had said (*q*): "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the very least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation . . . It is to be borne in mind that the report then made belonged absolutely to the State. Every fact and figure in it had been ascertained, and obtained at the public expense, every hour of every referee and of the secretary employed in the production of it was public time . . . the consideration for every patent is the communication of useful information to the public. What con-

(*q*) L. R., 2 Ch. D. 832.

sideration is there when the information was already the property of the State ? ”

These judgments, although going to a point which was not absolutely necessary for the decision of the case (for the case was decided upon the ground of want of novelty in the invention), tend to show that it was in the minds of the judges that the mental labour of making the discovery being an essential element for the consideration of the grant, if that mental labour had already been paid for by the State, it failed as a consideration to support the patent.

By sect. 35 of the Act of 1883, “ *A patent granted to the true and first inventor shall not 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.* ” This clause is only a re-enactment of that which had been decided to be the law previous to the Act. In *Ex parte Scott and Young (r)*, the servant had filed a provisional specification of an invention, after which the master filed a specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent. It was held that, under the circumstances, the Great Seal might be affixed to the letters patent of the servant’s invention, and that the patent might bear the date of his provisional specification.

In the case of *Ex parte Bates and Redgate (s)*, it was held, that leaving a provisional specification, and obtaining a provisional protection, does not prevent a second applicant from leaving a specification of a similar invention, and obtaining valid letters patent for the invention before six months have elapsed from the time when the first provisional specification was left, and in such a case letters patent will not be granted to the first applicant for any part of his invention, which is covered by the letters patent already obtained by the second applicant, but in this case there was no suggestion of fraud on the part of the second applicant. This decision has, however, been doubted in *Re Dering’s Patent (t)*, by Lord Cairns, who said: “ I may

(r) L. R., 6 Ch. 274.

(s) L. R., 4 Ch. 577.

(t) L. R., 13 Ch. D. 395.



however, state my objections to that decision" (*Bates and Redgate*), "which I never could thoroughly understand; it has always seemed to me that if Parliament hold out to inventors the advantage they could get from provisional protection, the inventor should have the enjoyment of that advantage for the six months granted to him. Parliament intended the six months to be for the completion of the invention, and for perfecting the specification, and never said that the applicant should be deprived of or lose that privilege for want of any due diligence on his part."

The difficult questions, however, which arise in these cases, seem to be set at rest by the 14th section of the Act of 1883: "*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.*"

The general question of concurrent applicants, where there is no fraud, that is, where each applicant is in a position to offer the consideration of mental labour, will be considered in a subsequent Chapter. It is only material here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. We find that so far back as 1567 a patent had been granted to one Hastings (u) for the making of frisadoes in consideration of his having imported the skill of manufacturing them from abroad. So in Mathey's case, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In the *clothworkers of Ipswich* case we have this (x) said, "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void.

(u) 1 Web. P. C. 6.

(x) 1 Web. P. C. 6; 1 Godb. 252  
254.

But if a man hath brought in a new invention and a new trade in the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything, in such cases the king, of his grace and favour in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the king cannot make a new grant thereof." This was in 1615.

Then came the Statute of Monopolies, and we have seen that the 6th section of that Act carefully excepted "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."

Afterwards came the decisions of *Darcy v. Allin* (y), and *Edgebury v. Stevens* (z), where it is said, "for the statute speaks of new manufactures within this realm, so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." See the remarks of Eyre, C.J., in *Boulton v. Bull* (a).

In the early days of manufacturing enterprise, when true inventors were so exceedingly rare as scarcely ever to be heard of, the word inventor had not acquired the meaning which it has at present, and seems to have been used to designate a first introducer rather than a first inventor. In the early reports shortly succeeding the Statute of Monopolies we do not find the judges in any difficulty in dealing with the words "true and first inventor," showing that the word inventor had not the precise meaning which it has since acquired.

In *Marsden v. Saville Street Co.* (b) in the Court of Appeal, Jessel, M. R., said, speaking of imported inventions, "It has been argued that before the Statute of James such patents were valid and were allowed by the judges, and that the statute

(y) 1 Web. P. C. 6.

(a) 2 H. Bl. 491.

(z) 1 Web. P. C. 35 : 2 Salk. 447.

(b) L. R., 3 Ex. D. 203.

merely restricts the duration of the patent and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed over since. It is difficult to say *à priori* on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. I have never been able to discover the principle; and although I have often made enquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, 'It has been so decided and you are bound by the decisions.' But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is that I must look on it as a sort of anomalous decision which has acquired by time and recognition the force of law."

The practice of granting letters patent to the first importers of manufactures and inventions new within this realm has been uniformly sustained by our Courts of law (c).

In *Milligan v. Marsh* (d) it was held by Vice-Chancellor Page-Wood that a person taking out a patent and making a declaration that he is a first inventor, when, in truth, he is only an importer of a communicated invention, makes a false suggestion, and the patent is void.

When the Act of 1883 was passed, doubts were expressed as to whether the effect of seci. 5, sub-sect. 2, was not to do away with the granting of patents for what are known as communications from abroad, these doubts were shared by the author, particularly with reference to the case of *Milligan v. Marsh* (*supra*). The question has since been in a manner touched upon in the

(c) *Plimpton v. Malcolmson*, L. R., 530, 535; *Edmunds' Patent*, Griff. P. C. 3 Ch. D. 555; *Chappell v. Purday*, 14 283; *Moser v. Marsden*, 10 P. O. R. M. & W. 318; *Nichels v. Ross*, 8 C. B. 359.  
723; *Carpenter v. Smith*, 1 Web. P. C. (d) 2 Jur. N. S. 1083.



case of *In re Avery's* patent (*e*), where, although in no way deciding the point, it appears to have been considered that such a patent might be granted. Stirling, J. (subsequently affirmed by the Court of Appeal) in giving judgment, said, "The rules which have been framed by the Board of Trade under the power conferred upon them by sect. 101 of the statute contain provisions which the statute itself does not contain, in reference to an application for a grant for an invention which has been communicated from abroad. Rule 27 provides that the application for such a grant shall be in the form 'A' in the 2nd schedule, and that form is different from that which is prescribed by the statute and from the terms in which Lindsay made the application" (his Lordship read the form, and continued:) "That form has been framed so as to fit in with sect. 5, sub-sect. 2, of the statute, which enacts that an application must contain a declaration . . . that the applicant is in possession of an invention, whereof, he . . . claims to be the true and first inventor. That form has not been followed in this case. There is no decision that a patent taken out as for an original invention, when in fact the invention patented was communicated from abroad, is void, though there is in the case of *Milligan v. Marsh* (*supra*) what appears to be a dictum of Vice-Chancellor Sir W. Page-Wood, to that effect, nor is there any decision that where an invention is partly original and partly communicated from abroad, the part communicated from abroad ought to be distinguished in the specification; but in the case of *Renard v. Lerenstein* (*f*), the Lord Justice Knight Bruce expressed great doubt upon the point." . . . And at p. 318: "That being so notwithstanding that the invention was founded on a communication received from abroad it appears to me that it well might be held that the statutory declaration made by the applicant was true in point of law."

Lindley, L.J., in the case of *Moser v. Marsden* (*g*), in his judgment in the Court of Appeal, said: "Then it was suggested that, as the English patentee had himself improved *Grosselin's* inven-

(*e*) *In re Avery's Patent*, L. R., 36  
Ch. D. 316.

(*f*) 10 L. T., N. S. 177.  
(*g*) 10 P. O. R. 359.

tion, the specification ought to have shown this on its face; and that, as the whole invention was not communicated to the plaintiff by Grosselin, as stated by the plaintiff, the patent is bad. This point has been raised before, but as yet it has not found favour in any Court. Nor ought it; there is no substance in it. The patentee is the true and first inventor within the meaning of the patent laws, whether he invents himself or whether he simply imports a foreign invention. I cannot see how he is anything but a true and first inventor if he does both; that is, if he both imports a foreign invention and improves it himself."

A patent granted to a British subject, in his own name for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out and held by the grantee in trust for such foreigner (*h*).

The person who takes out the patent need not be a meritorious importer, he may be merely the clerk or agent to whom the communication was made for any special purpose by the foreign inventor, as for the purpose of enabling him to take out the patent for the benefit of such foreigner (*i*).

The importer of a new manufacture or invention will be considered the true and first inventor, even though he is not the assignee of the foreign inventor, and he may be the foreigner himself, if the Crown chooses to grant him a patent (*k*).

Sect. 23 of the Act of 1883 provides for the registration of owners of patents. Sect. 85 prohibits the registration of any trust. This does not abolish trusts, but merely prohibits the registration of trusts.

The importer of an invention need not have acquired the information from a foreigner resident abroad, but may have done so from a British subject abroad (*l*).

But a communication made in England by one British subject to another, of an invention, does not make the person to whom the communication is made the first and true inventor within the

(*h*) *Beard v. Egerton*, 3 C. B. 129; 15 L. J., C. P. 274; 10 Jur. 613.

(*i*) *Ib.* 15 L. J., C. P. 274.

(*k*) See remarks of Pollock, C.B. in

*Chappell v. Purday*, 14 M. & W. 318; see also *Beard v. Egerton*, 3 C. B. 130.

(*l*) *Nickels v. Ross*, 8 C. B. at p. 710,

per Wilde, C.J.

meaning of 21 Jac. I. c. 3, so as to enable him to take out letters patent for the invention (*m*).

It was decided in *In re Wirth's Patent* (*n*) that a patent could be granted to a foreigner resident abroad for an invention communicated to him by another foreigner also resident abroad. This, however, will no longer be the case, a direction having been made that only persons resident in the United Kingdom may apply for a grant of letters patent in Form A 1, this regulation being expressly intended to prohibit agents living abroad from making the declaration in Form A. 1 (*o*).

“The merit of an importer is less than of an inventor . . . . and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller.” Per Lord Brougham in *In re Soames' Patent* (*p*).

It is provided by 46 & 47 Vict. c. 57, s. 103, as amended by 48 & 49 Vict. c. 63, s. 6, that any person who has applied for protection for any patent in any foreign state with whom we have entered into international arrangements for mutual protection of inventions, shall be entitled to a patent for his invention in this country in priority to other applicants, and such patent, on registration, shall have the same date as the date of the protection obtained in such foreign state, provided that his application is made within seven months from his applying for protection in the foreign state with which the arrangement is in force.

In an application for a patent in respect of an invention communicated from abroad, the circumstances under which the invention was obtained by the importer will not be inquired into (*q*), and the object of sect. 103 is to preserve to the foreign inventor a priority for a certain period over persons who might otherwise have anticipated him by filing an application for a patent for his invention without authority to do so.

The rights under this section are purely personal to the

(*m*) *Marsden v. Saville Street Co.*,  
C. A., L. R., 3 Ex. D. 203.

(*n*) L. R., 12 Ch. D. 303; 25 W. R.  
329.

*o*) P. O. J., 9th May, 1884.

(*p*) 1 Web. P. C. 733.

(*q*) *Edmund's Patent*, Griff. P. C.  
283; *Re Lake*, 5 P. O. R. 415; *Re*  
*Bairstow's Patent*, 5 P. O. R. 288.



applicant in the foreign country himself, and cannot be enjoyed by the agent of such applicant or by any person to whom he has communicated his invention (r).

Where the foreign inventor had made two applications in his own country, the first of which applications was abortive, and further, the foreign patentee made a declaration that the proceedings under the second application were in all respects the same as if no prior application had been made, it was held by the L.O. that the seven months mentioned in sect. 103 should run from the date of protection obtained upon the second application, and he directed that the English patent should be sealed as of that date (s).

Where a foreign inventor was resident in a country with which international arrangements for the mutual protection of inventions was made after an application had already been lodged in this country by another for letters patent in respect of a similar invention, it was held by the L.O. that such foreign inventor was entitled to apply in priority over other applicants for so much of the seven months as remained after the Order in Council declaring such foreign country to be "one of the contracting states" (t).

We have now shown what is meant when it is said that the consideration must move from the patentee personally.

(r) *Re Shallenberger*, 6 P. O. R. 550; *Re Carez*, 6 P. O. R. 552

(s) *Re Van de Poelc*, 7 P. O. R. 69.

(t) *In re Main's Patent*, 7 P. O. R. 13.

## CHAPTER IV.

## A NEW AND USEFUL INVENTION.—SUBJECT MATTER.

SECT. 6 of the Statute of Monopolies defines a new **invention** as “any manner of new manufacture which others at the time of making such letters patent shall not use.”

We have seen that the Act of 1883 has adopted this definition of an invention. We have now to consider the legal meaning which has been placed upon the words “New Manufactures.”

A new manufacture does not mean, as it is erroneously sometimes supposed, only a new article of manufacture, but it also means a new process or method of manufacturing something new or old; it does not mean a new principle of manufacturing, but it means a new application of principles. No man can claim an invention in a principle (*a*), for that would be to invent the laws of nature, which have always existed.

Man merely discovers the principle, and if, when he discovers a principle he can discover a method of utilizing the principle so as to make it applicable to the production of a new manufacture, he can obtain a patent for the method, and to a large extent will be protected in the application of the principle itself.

Mr. Justice Wills in *Easterbrook v. The Great Western Railway Co.* said (*b*): “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

(*a*) *Boulton v. Bull*, 2 H. Bl. 479; *The Houshill Co. v. Neilson*, 1 Web. Dav. P. C. 196, 212; *Hornblower v. Neilson*, 1 Web. P. C. 146; *Neilson v. Harford*, 1 Web. P. C. 342; 8 M. & W. 806; *Crossley v. Potter*, Macr. P. C. 240; *Patterson v. The Gas Light Co.*, L. R., 3 App. Cas. 246.  
 (*b*) 2 P. C. R. 207.

though the method and even the purpose to which the principle or idea is applied be different from those embodied in the specification."

Lord Justice Clark Hope in directing the jury in the case of *The Househill Co. v. Neilson (c)*, said:—"I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or 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 describing and 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 Court of Appeal, Lord Justice Cotton, speaking on this subject, said:—"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—a mechanical equivalent for a substantial part of the patentee's invention being looked upon as a mere colourable difference" (*d*).

In *Otto v. Linford (e)*, claim 1 of the plaintiff's specification ran as follows:—"Admitting to the cylinder a mixture of combustible gas or vapour with air, separate from a charge of air or incombustible gas, so that the development of heat and the expansion or increase of pressure produced by the combustion are

(c) 1 Web. P. C. 685.

(d) *The Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 304; see also *Badische Anilin und Soda Fabrik v. Leviastein*, 2 P. O. R. 91, 92, 93; L. R., 24 Ch. D. 156, 171, et seq.; *Proctor*

*v. Bennis*, L. R., 36 Ch. D. 740; 4 P. O. R. 333; *Thomson v. Moore*, 6 P. O. R. 426; *Gadd & Mason v. The Mayor, &c., of Manchester*, 9 P. O. R. 525.

(e) 46 L. T., N. S. 35.



*rendered gradual* substantially as and for the purposes set forth."

Jessel, M.R., in the Court of Appeal, said (*f*):—"It is said that what is claimed is a principle . . . . or, as it is sometimes termed, the 'idea' of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual, what would otherwise be a sudden explosion. Of course, that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out; and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent . . . . One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture (*g*), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel, would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this, he said: 'I will patent that idea in combination with the mode of carrying it out, that is, I tell you that you may heat your air in a closed vessel next your furnace, and then that will effect the object.' It was held that that would do."

So in *The Edison Bell Phonograph Co. v. Smith* (*h*), where the plaintiffs claimed in their specification:—"In a phonograph, attaching both the recording point and the reproducing point to the same diaphragm, means being provided whereby either of the points may be brought into operative position on the surface of the phonogram." It was pleaded by the defendants that this was a claim for the principle of attaching both the points to the same diaphragm; Wright, J., held that it was not so, deciding it to be "a claim for a particular arrangement of essential parts of a machine, which arrangement has obvious advantages, but has never before been made practicable, and which has now been found practicable in a way disclosed by the specifica-

(*f*) At page 39.

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

(*g*) 1 Web. P. C. 295; 8 M. & W.

(*h*) 11 P. O. R. 148.

tion. Such a claim ought probably to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification" (i).

A claim of every method of application of a principle is a claim of the principle itself, and is not subject-matter of a grant of letters patent (k).

The novel application of an old principle is subject-matter of a grant, if invention is disclosed, and provided that such novel application constitutes a new and useful improvement in manufacture (l), but the patentee is strictly tied down to the method of application disclosed in his specification, and valid patents may be taken out by others for different methods of carrying the same principle into effect (m).

In *Barber v. Grace* (n), the patentee's invention related to improvements in the finishing of hosiery and similar goods, and consisted in submitting them to the pressure of hot boxes or surfaces heated by steam, water, or other fluid. At the trial it appeared that the alleged infringement consisted in pressing goods between cylindrical revolving rollers heated by steam, it was held by Pollock, C.B., that the use of such rollers was not a mere colourable evasion of the patent, and that the defendants had not infringed.

In *Boulton v. Bull* (o), the Lord Chief Justice Eyre said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been

(i) At page 163; see also *Boulton v. Bull*, Dav. P. C. 162; *Hornblower v. Boulton*, 8 T. R. 95; *Electric Telegraph Co. v. Brett & Little*, 10 C. B. 838; 20 L. J., C. P. 123; *Minter v. Wells*, 1 Web. P. C. 127; *Cannington v. Nuttall*, L. R., 5 H. L. 205.

(k) *Neilson v. Harford*, 1 Web. P. C. 355; *Booth v. Kennard*, 2 H. & N. 95; 26 L. J., Exch. 355; *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 297, 308.

(l) *Dangerfield v. Jones*, 13 L. T.,

N. S. 142; *Cannington v. Nuttall*, L. R., 5 H. L. 205; 40 L. J., Ch. 739.

(m) *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 113; *Seed v. Higgins*, 8 H. L. Ca. 550; *Curtis v. Platt*, L. R., 3 Ch. D. 135 (n.); *Needham v. Johnson*, 1 P. O. R. 49; *Bovill v. Pim*, 11 Ex. R. 718, 739; *Fletcher v. The Glasgow Gas Commissioners*, 4 P. O. 388.

(n) 1 Ex. R. 339; 17 L. J., Ex. 122.

(o) 2 Bl. 463; Dav. P. C. 162.

produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced." Mr. Justice Heath said, "What then falls within the scope of the proviso? such manufactures as are reducible to two classes: the first class includes machinery, the second, substances, such as medicines formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form; in the first class the machine, and in the second the substance produced, is the subject for the patent. I approve of the term 'manufacture' in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso—that it was introduced for the benefit of trade." With reference to this judgment, we may point out that a new chemical substance is not a new manufacture, as the words "new manufacture" are understood in modern times, but that in the case of manufacturing a new chemical substance, the process of making that substance is the subject of the patent, and not the substance when made.

Upon perusing the cases which we propose to quote, it will be seen that the more modern view of the construction of the words "new manufacture" has been the result of a great deal of development. At first the judges seemed to be inclined to limit the subject-matter of letters patent to new articles produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions in the process of making old and well-known articles of commerce, and so it became evident that should the construction of the words "new manufactures" be entirely limited to the production of new articles, to the exclusion of the process of manufacturing old articles by cheaper, better and improved methods, the inducement which the common law intended to give to inventors would be curtailed to the narrowest possible limits.



*Hall v. Jarvis* (*p*) was an action for the infringement of a patent for the improvement of the manufacture of lace by the use of the flame of gas for the purpose of singeing the fluffy ends of the surface of lace manufactured from cotton. For the defendants it was contended that the process was not new. Fire and flame had been applied for similar purposes before the plaintiff's invention. The mere doing that with the flame of gas could not be the subject-matter of a patent. The patent, which was clearly only for a process, was supported. In *Jones v. Pearce* (*q*) the patentee had used the principle of suspension to the manufacture of wheels; the patent was supported because, although the principle could not be patented, the method of applying that principle to the manufacture of wheels was properly the subject of a patent. In *Russell v. Cowley* (*r*) the patent, which was for an improved process of manufacturing iron tubes, was supported. Lord Lyndhurst, in giving judgment, said: "It is an invention to manufacture tubes for gas and other purposes by welding them without the use of any mandril or internal support, by which certain advantages are produced."

In *Walton v. Potter* (*s*) Chief Justice Tindal said: "Now there can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes open for a man 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." In this case the learned judge by the word "object" must have meant the method of producing an article.

The same judge, in *Gibson v. Brand* (*t*), said: "The patent is taken out 'for a new or improved process for the manufacture of

(*p*) 1 Web. P. C. 100; see also *Booth v. Kennard*, 1 Hurl. & N. 527; *Higgs v. Godwin*, 27 L. J., Q. B. 421; *Hills v. London Gas Light Co.*, 29 L. J., Ex. 409; *Young v. Fernie*, 12 W.

R. 903; *Newall v. Elliot*, 13 W. R. 11.

(*q*) 1 Web. P. C. 122.

(*r*) 1 Web. P. C. 459.

(*s*) 1 Web. P. C. at p. 590.

(*t*) 1 Web. P. C. 633.

silk, and silk in combination with certain other fibrous substances,' taken out therefore strictly for a process . . . . undoubtedly there is a very strong reason to suppose if the specification is carefully and properly prepared, so as to point out with great distinctness and minuteness what the process is, that such a patent may be good in law. Such certainly was the opinion of Chief Justice Eyre, in *Boulton v. Watt* (u), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *The King v. Wheeler* (x), who said that 'the subject-matter of letters patent, *i.e.*, the word "manufacture," as used in the Statute of James, is generally understood to denote either a thing made, which is useful for its own sake, and vendible, or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously-known article, or in some other useful purpose . . . . or it may perhaps extend also to a new process to be carried out by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner or to a better or more useful account.' "

Since the date of these earlier decisions the law seems to have been considered as settled upon the subject. In *Bewley v. Hancock* (y) Lord Cranworth said: "A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would be a good ground for a patent. A discovery of some machinery, by which such a mixture might be more quickly and effectually accomplished, might be the foundation of another patent." In *Simpson v. Holiday* (z) the specification said, "I mix aniline with dry arsenic acid and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or nearly to, its boiling point until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red or purple dyes by heating aniline dyes with arsenic acid as hereinbefore described." Lord Chelmsford, in

(u) 2 H. Bl. 468 ; Dav. P. C. 207.

(x) 2 B. & Ald. 349.

(y) 6 De G., M. & G. 402.

(z) L. R., 1 H. L. 315.

giving judgment, said: "There is nothing on the face of the specification to show that the invention described is not, in every part of it, the subject of a patent." It is obvious that there may be many different processes of accomplishing the same object: if some of the processes are old, and that which is claimed is merely a new method, the subject of the invention will be confined to that method (*a*).

Where the object of a patent is old, and the means to effect it only are new, the court will construe the invention strictly, as it looks jealously at the claims of inventors seeking to limit the rights of the public to a well-known object (*b*).

But where a patent is for a new process to effect a new object which had been sought after but not previously attained, the doctrine of mechanical equivalents will apply, and a man will be held to have infringed who has arrived at the same result by means of a process bearing a substantial resemblance to the invention of the patentee (*c*).

There appears to be some doubt as to whether a patent could be granted for a mere product, irrespective of the means by which it was made. Cotton, L.J., has expressed an opinion that a product would be proper subject-matter. In his judgment in the case of *Vorwerk & Son v. Evans & Co.* (*d*) he said: "I decide that, not on the ground that there could not be a patent for a waistband, if that was claimed as a new thing, provided it was new, because it would be going against principle, I think, to say that there could be no claim for such a thing if it were entitled to

(*a*) *Bovill v. Pimm*, 11 Exch. 739.

(*b*) *Curtis v. Platt*, L. R., 3 Ch. D. 135 (n.); *The Patent Bottle Envelope Co. v. Scymer*, 5 C. B. N. S. 164; *Horton v. Mabon*, 12 C. B. N. S. 437; *Ormson v. Clarke*, 14 C. B. N. S. 475; *Jupe v. Pratt*, 1 W. P. C. 146; *Barber v. Grace*, 1 Exch. 339; 17 L. J., Ex. 122; *Bovill v. Pimm*, 11 Exch. R. 718, 739; *Seed v. Higgins*, 8 H. L. C. 550; *Rushton v. Crawley*, L. R., 10 Eq. 522; *The Badische Anilin und Soda Fabrik v. Levinstein*, 2 P. O. R. 91; *Proctor v. Bennis*, 4 P. O. R. 333; L. R., 36

Ch. D. 740; 57 L. J., Ch. 11; *Gosnell v. Bishop*, 5 P. O. R. 158; *Nettlefolds v. Reynolds*, 9 P. O. R. 270.

(*c*) *Jupe v. Pratt*, 1 W. P. C. 145; *Househill Co. v. Neilson*, 1 W. P. C. 673, 685; *Curtis v. Platt*, L. R., 3 Ch. D. 136, n.; L. R., 1 H. L. 337; *The Badische Anilin und Soda Fabrik v. Levinstein*, 2 P. O. R. 91; *Proctor v. Bennis*, 4 P. O. R. 333; L. R., 36 Ch. D. 740; 57 L. J., Ch. 11; *Thomson v. Moore*, 6 P. O. R. 426. This subject is treated at length in Chap. XVII. on Infringement.

(*d*) 7 P. O. R. 271.



be protected by a patent, and I think it would be contrary to principle, because if there is a new thing produced, then, in my opinion, there could be a thoroughly good patent taken out for that" (e).

Hereafter, in considering the specification, we shall have to discuss the limitations within which a patent for a new process will be held valid, and the cases which have been decided upon the point.

Any addition to or subtraction from any known machine or process causing the old machine or process to accomplish an object in a more speedy, perfect or economical manner, is evidently the subject of a patent. In *Hornblower v. Boulton* (f) Mr. Justice Grose said: "A doubt is entertained whether there can be a patent for the addition of an old manufacture, this doubt rests altogether upon *Bircot's case* (g), if that were to be considered as law at this date (1799) it would set aside many patents for many ingenious inventions . . . . if, indeed, a patent could not be granted for the addition it would be depriving the public of one of the best benefits of the Statute of James." In *Lister v. Leather* (h) Lord Campbell said: "The assertion that all patents for improvements of existing patents must be void, is obviously untenable" (i). In *Fox v. Dellestable* (k) Malins, V.-C., said: "No doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it without the licence of the patentee. He may wait for the expiration of the patent and take out one himself. If his invention be novel, that patent will be valid" (l).

During the argument in *Vickers v. Siddell*, Lord Herschell suggested that if a man used a mechanical equivalent, and

(e) See also *Bowen, L. J.*, *ib.* p. 274; also *American Braided Wire Co. v. Thomson*, 5 P. O. R. 113; 6 P. O. R. 518; *Nobel's Explosive Co. v. Anderson*, 11 P. O. R. 530.

(f) 8 T. Rep. 104.

(g) 3 Inst. 184.

(h) 8 E. & B. at p. 1017.

(i) See also *Russell v. Cowley*, 1 Cr. M. & R. 864; *Booth v. Kennard*, 1 H.

& N. 531; *Morris v. Bransom*, 1 Web. P. C. 51; 1 Carp. P. C. 30; Bull. N. R. 76; *Bovill v. Moore*, 2 Coop. Ch. Ca. 56; Dav. P. C. 361; 2 Marsh. R. 211; *Moser v. Marsden*, 10 P. O. R. 361.

(k) 15 W. R. at p. 195.

(l) See also *Lister v. Leather*, 8 E. & B. 1017; *In re Fox's Patent*, 1 Web. P. C. 431, n.

produced a superior result, such improvement would be patentable (*m*).

An application of an old machine or an old material for a new purpose, may be the subject of a patent; for instance, *Muntz v. Foster* (*n*) was an action for an infringement of a patent for the manufacture of metal plates to be used for sheathing the bottoms of ships. The improvement consisted of using an alloy of zinc and copper in certain proportions for the manufacture of the plates, and for this purpose copper alone had hitherto been used. The alloy of zinc and copper was to produce an old and well-known material, still the application of that old material to sheathing of ships had not before been discovered, and upon its being shown that such an application was a great improvement on the old method of sheathing with copper, it was held that the patent could be sustained.

The application of a known instrument or machine to a new purpose will not support a patent unless the means or method of application is also new and discloses the exercise of a certain amount of ingenuity. Exactly what degree of invention is requisite is difficult to define, and it is impossible to formulate a rule capable of applying to every case that might arise, the question being one that must be decided upon the facts of each particular case.

Lord Esher, M.R., in *Lyon v. Goddard* said (*o*):— “I know that a case before the House of Lords has been cited, *Morgan v. Windover* (*p*), which, it is said, lays down a rule that would oblige us in this case to say that there is no invention. I have a very strong feeling myself that that case in the House of Lords was decided from this view of it: that the patentee there did not claim the combination of the springs at the back of the carriage and the springs at the front, but what he did claim was the mode of attaching each of those springs to the bed of the carriage, and although I am not obliged to say that I should have agreed with them as to the fact they found, they found that that was not

(*m*) 7 P. O. R. 303.

(*n*) 2 Web. P. C. 103; see also *Hayward v. Hamilton*, Griff. P. C. 115; *Lister v. Norton*, 3 P. O. R. 199; *Penn v. Bibby*, L. R., 2 Ch. App. 127; 36

L. J., Ch. 455.

(*o*) 10 P. O. R. 344; see also *Lister v. Norton*, 3 P. O. R. 205; *Morgan v. Windover*, 4 P. O. R. 426.

(*p*) 7 P. O. R. 131.

sufficient invention. They thought so, and therefore I suppose in that case, as there is no contradicting them, we may take it that they were right; but because there was no invention in that case, how can that be an authority for saying that there is no invention in this?"

In *Morgan v. Windover* Lord Halsbury, in the House of Lords, said (g): "Whether that invention is to be ascertained by considering something originally discovered or by considering a combination producing a new result, still it cannot but be certain that the Statute of Monopolies, and the whole branch of the law founded on that statute, make it an absolute condition to the validity of a patent that there should be what may properly be called invention, and the application of well-known things to a new analogous use is not properly the subject-matter of a patent."

In that case the patent consisted in the application of C springs, which previously had only been employed on the back of a carriage, to the fore part, and arranged so as not to interfere with the fore wheels and their motion in turning the carriage. This contrivance was new, and was admitted to give greater ease and comfort in the motion of the carriage to which it was attached. The patent was upheld in the lower courts, but these decisions were reversed by the House of Lords, where it was held *nem. con.* that there was not sufficient ingenuity disclosed to support a grant of letters patent. Lord Herschell in his judgment said (r): "Now, my Lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had heretofore been used in the hind part of a carriage to the fore part of a carriage, so that it was not the mere substitution in front in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back, I should have thought that there was sufficient subject-matter, and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, and that when once that idea is entertained, any workman told to do it would, without

(g) *Ib.* at p. 154.

(r) *Ib.* at p. 157.



any instructions or any special mechanical skill, be able at once to do it, it seems to me that that really concludes the case against the respondents."

In *Penn v. Bibby* (s) Lord Chelmsford, L.C., recognised the difficulty of stating any definition which should be applicable to every case. He said: "It is very difficult to extract any principle from the various decisions on this subject which can be applied with certainty to every case, nor indeed is it easy to reconcile them to each other." He then proceeds to dissent from the definition given by Lord Campbell in *Brook v. Aston*, doubting the accuracy of the report, and proceeds to say: "Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or at least of a rule for judging in these cases, in *Harwood v. G. N. R.* (t), where he says, 'although authorities established the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is so sufficiently meritorious as to be deserving of a patent.'" The case of *Harwood v. G. N. R.*, quoted above by the Lord Chancellor, was carried to the House of Lords, where Lord Chelmsford, then Lord Chancellor, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for the bridge, and having applied it as a fish for the railway. Upon that I think the law is well and rightly settled . . . . viz., that you cannot have a patent for a well-known mechanical appliance, merely because it is applied in a manner or to a purpose which is analogous to the manner or purpose in or by which it has hitherto been notoriously used" (u).

(s) L. R., 2 Ch. App. 127.

(t) 29 L. J., Q. B. 193.

(u) 11 H. L. Cas. 654; see also *Horton v. Mabon*, 12 C. B., N. S. 437; 16 C. B., N. S. 141; 31 L. J., C. P. 255; *White v. Toms*, 37 L. J., Ch. 204; *Ralston v. Smith*,

11 H. L. Cas. 223; *Jordan v. Moore*, L. R., 1 C. P. 624; *Parkes v. Stevens*, L. R. 8 Eq. 367; L. R., 5 Ch. 36; *Losh v. Hague*, 1 Web. P. C. 200; *Ormson v. Clark*, 32 L. J., C. P. 8; *Brunton v. Hawkes*, 4 B. & Ald. 541;

In *Reg. v. Cutler* (x) Lord Denman said: "With regard to the third and fourth claims, in which the defendant claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that would have been a new discovery, and a proper subject for a patent. . . . I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent." Lord Denman's distinction between the mere application of an old instrument to a new purpose and a new combination, appears to have been followed, and to be a correct exposition of the law.

In *Jackson v. Needle* (y) North, J., said: "The plaintiff's first witness seemed to have an idea that because the parcels post was new, therefore a thing to be sent through the parcels post was new: there is no foundation for that."

In *Bush v. Fox* (z) Chief Baron Pollock graphically illustrated the point we are now discussing. He said: "I think if one man invents a new mode of looking at the moon, somebody else cannot take out a new patent for looking at the sun. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think anyone could say, 'I will take out another patent for another telescope to be used for taking observations on the sea.'" That case was ultimately confirmed in the House of Lords (a). In *Brook v. Aston* Baron Martin said (b): "The application of a well-known tool to work pre-

*Sarby v. Gloucester Waggon Co.*, L. R., 7 Q. B. D. 305; *Britain v. Hirsch*, 5 P. O. R. 226; *Blakey v. Latham*, 6 P. O. R. 184; *Deutsche Nähmaschinen Fabrik vorm., Wertheim v. Pfaff*, 7 P. O. R. 251, 258; *Williams v. Nye*, 7 P. O. R. 62; *Elias v. Grovesend Tinplate Co.*, 7 P. O. R. 455; *Leadbeater v. Kitchin*, 7 P. O. R. 235; *The Embossed Metal Plate Co. v. Saupe*, 8 P. O. R. 355; *Lanc Fox v. Kensington*

& Knightsbridge Lighting Co., L. R., 1892, 3 Ch. 424; 9 P. O. R. 413; *Sudbury v. Lee*, 11 P. O. R. 58; *Rose's Patents Co. v. F. Bruby & Co.*, 11 P. O. R. 198.

(x) 3 C. & K. 215; see also *Tatham v. Dania*, Griff. P. C. 213.

(y) Griff. P. C. at p. 134.

(z) Macr. P. C. 164.

(a) 5 H. L. C. 707.

(b) 28 L. J., Q. B. 176.

viously untried materials, or to produce new forms, is not a subject of a patent.”

The border line between a sufficient and an insufficient amount of ingenuity to support a patent for a new use of an old machine is exceedingly fine. The above cited cases give instances where the Courts have held that no invention was disclosed; we now propose to quote a few examples of patents which have been supported as exhibiting an adequate amount of invention.

In *Gadd v. The Mayor, &c., of Manchester* (c), the object of the plaintiff's patent was to keep gasometers vertical without having recourse to the external guiding frames generally used; this object was not in itself new, but had never been attained by any method resembling that employed by the patentees. The principle employed by them was one which had previously been described in specifications of inventions for keeping floating docks and pontoons in a horizontal position. It was held by the Court of Appeal, reversing the decision of the Court below, that in the application of that principle to gasometers there were practical difficulties to be overcome which required a considerable degree of ingenuity, and was good subject-matter for a patent.

In *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.* (d), Lindley, L.J., said: “On the one hand, the discovery that a known thing—such, for example, as a Planté battery—can be employed for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it, as distinguished from novelty of purpose, or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification, or appliance involves any appreciable merit. It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries, but I have endeavoured to state the distinction as I understand it, and so far as is necessary for the purposes of the present case.”

In *Lyon v. Goddard* (e), Bowen, L.J., said: “When you see

(c) 9 P. O. R. 516.

9 P. O. R. 413, 416

(d) L. R., 1892, 3 Ch. 424, 429;

(e) 10 P. O. R. 334, 346.



that the point of this invention is that it enables a process which has been discovered since, to be carried out in a machine which alone is adapted for that purpose and process, and when you observe the marked and beneficial effect, and the commercial and the scientific success of the new machine, you can only answer the question whether there has been ingenuity in one way. I think, not only that there has been ingenuity, but I think myself that there has been very great ingenuity in it, and none the less because it is easy afterwards, as has been pointed out, to say other people might have seen the result."

In the case of *Steiner v. Heald* (*f*), in the Exchequer Chamber, the head-note is inexplicable and erroneous. If the case itself is read, it will be found to be in accordance with the other decided cases on this subject: In the ordinary process of dyeing, by means of madder, the colouring matter was obtained from fresh madder by the application of hot water; the refuse, after boiling, was called spent madder. It had long been known to dyers, that a portion of the colouring remained in the spent madder, but it was not known how to extract it, as it remained in combination with the plant; recently it was discovered that by means of acid and hot-water the pure colouring matter of madder, called garancine, could be obtained from fresh madder, and that this process extracted the colouring matter of the plant. The plaintiff obtained a patent for the new manufacture of garancine, by applying the same process of acid and hot water to the spent madder; since his invention the spent madder, which was previously worthless, became valuable.

At the trial Chief Baron Pollock directed the jury to find a verdict for the defendant, upon the ground apparently that there was no subject for a patent; in reversing this decision Mr. Justice Pearson said: "Now spent madder might be a very different thing from fresh madder in its properties, or it might be in effect the same thing as fresh madder in its properties, chemical and otherwise, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical and otherwise, might or might not have been known to chemists and other scientific persons, so that they could

(*f*) 20 L. J. Exch. 410.

find out whether fresh madder and spent madder were different or substantially the same things. The points appear to us to be questions of fact, and materially to affect the validity or invalidity of a patent." It will appear, therefore, that the Court were of opinion that it was a question of fact whether spent madder and fresh madder were the same thing in their chemical properties; if they were, no patent; if they were not, the validity of the patent would be sustained, but the fact must be decided by the jury.

In *Bamlett v. Picksley (g)*, Blackburn, J., said: "There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Take this example. It was discovered that by taking flour and making it into tough dough by means of machinery you could spin it into a pipe known as macaroni pipe. An ingenious man knowing how to spin flour into a pipe, it occurred to him to take red-hot iron, and spin that into pipes by machinery in the same way as flour was spun into a pipe for macaroni. That was not an invention as it turned out, but had that been so, and had he been able to spin the iron in the same way as flour was spun into pipes for macaroni, few men I think would deny that there was an invention there, it being a product so completely new, and that it would be an invention for making a new manufacture which others did not make, because the result was so totally different, even although in fact the machinery which was used for the purpose, except that it was made stronger, would be identically the same as the machinery originally used for the purpose of making the macaroni."

Lindley, L.J., in *Gadd v. The Mayor, &c., of Manchester*, after an elaborate review of the authorities, expressed the law

(g) Griff. P. C. at p. 42; see also *Hayward v. Hamilton*, Griff. P. C. 115; *Dangerfield v. Jones*, 13 L. T., N. S. 142; *Hals v. London Gas Co.*, 5 H. & N. 312; 29 L. J., Ex. 409; *Penn v. Bibby*, L. R., 2 Ch. 127, 136; *Ehrlich v. Ihlee*, 5 P. O. R. 437; *Thomson v. The American*

*Braided Wire Co.*, 5 P. O. R. 113; 6 P. O. R. 518; L. R. 44 Ch. D. 274; *Moser v. Marsden*, 10 P. O. R. 350; *Leyge v. Wakelam*, 10 P. O. R. 379; *Pirrie v. York Street Spinning Co.*, 10 P. O. R. 34; 11 P. O. R. 429.

upon this subject by the two following propositions: "1. A patent for the mere use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention: no manner of new manufacture within the meaning of the Statute of James. 2. On the other hand, a patent for a new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the Statute (*h*)."

In *Gosnell v. Bishop* (*i*), Bowen, L.J., said: "Where there has been for some time a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplished is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere or in some shape."

And, in *Hinks v. Safety Lighting Co.* (*k*), Jessel, M.R., said: "Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and very important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, as far as a rough test goes, I know of no better."

In the case of *Longbottom v. Shaw* (*l*), Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it, there was

(*h*) 9 P. O. R. 524.

(*k*) L. R., 4 Ch. D. 615.

(*i*) 5 P. O. R. 158; see also *Moss v. Melings*, 3 P. O. R. 378; *The American Braided Wire Co. v. Thomson*, 5 P. O. R. 125.

(*l*) 8 P. O. R. 336; see also *Blakey v. Latham*, 6 P. O. R. 187; *Gosnell v. Bishop*, 5 P. O. R. 158.



a large demand for them . . . . I do not dispute that that is a matter to be taken into consideration ; but, again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much upon certain other circumstances. If nothing be shown beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think that it is of very little importance."

In *Dowling v. Billington* (*m*) the patent in question was one for a method as distinguished from a patent for a machine to carry out the method, or for the manufactured article. It was admitted that the "method" required no novel machinery, but consisted in the use, by the workman, of an existing machine in a way which was novel and the result useful, it was held that this was good subject-matter.

A new combination is an invention consisting of the discovery that two or more, new or old, processes, materials, or implements, when used together, will become applicable to a new purpose, or will effect an old purpose in a better, cheaper, or more expeditious manner than it had before been done.

In *Huddart v. Grimshaw* (*n*), Lord Ellenborough said: "I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject of a patent." There may be a valid patent for a new combination of materials previously in use for the same purpose (*o*).

In *Foxwell v. Bostock* (*p*), Lord Westbury said: "If a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the

(*m*) 7 P. O. R. 191.

(*n*) Dav. P. C. 267 ; 1 Web. P. C. 86 ; see also Tindal, C.J., in *Crane v. Price*, 1 Web. P. C. 408 ; 4 M. & G. 530 ; *Vickers v. Siddell*, 7 P. O. R. 292.

(*o*) *Hill v. Thompson*, per Lord Eldon, 1 Web. P. C. 237.

(*p*) 12 W. R. 725 ; see also *Harrison v. The Anderston Foundry Co.*, L. R. 1 App. Cas. 574 ; *Hayward v. Hamilton*, Griff. P. C. 115 ; *Moore v. Bennett*, Griff. P. C. 158 ; *Wenham Gas Co. v. Champion Gas Lamp Co.*, 8 P. O. R. 320 ; *Boyd v. Horrocks*, 9 P. O. R. 77.

existing constituent parts of the machine, an improved arrangement or improved combination may be patented."

Bovill's patent consisted of a combination of a blast with an exhaust of air to millstones, for the purpose of preventing the heat generated in grinding corn and saving the dust generated. It was proved that a blast and an exhaust had been used separately, but that the combination was a substantial improvement. The patent was held good (*q*).

In *Crane v. Price* (*r*), the patentee, in his specification, after specifically disclaiming the use of the hot blast or the use of anthracite coal, proceeded: "What I do claim as my invention is, the application of anthracite or stone coal or culm combined with the using of hot air blast in the smelting and manufacture of iron from ironstone, mine or ore as above described." The patent was held valid for the combination.

In his judgment in this case, Lord Chief Justice Tindal said: "We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, that such a combination is an invention or manufacture intended by the statute to, and may well, become the subject of a patent" (*s*).

This exposition of the law has been approved of by the Court of Appeal in the cases *Murray v. Clayton* (*t*) and *Lyon v. Goddard* (*u*).

A combination may be patented which consists in the omission from an old process or machine of some part which had previously been considered to be essential (*x*), or in the substitution for some part of an old process or machine of a mechanical equivalent which was not known before to be a mechanical equiva-

(*q*) *Bovill v. Keyworth*, 7 E. & B. 725; 29 L. T. 194; *Brunton v. Hawkes*, 4 B. & Ald. 550; *Lewis v. Davis*, 1 Web. P. C. 488; 3 C. & P. 502; 1 Carp. P. C. 471; *Carpenter v. Smith*, 1 Web. P. C. 538; *Allen v. Rawson*, 1 C. B. 551; *Lister v. Leather*, 8 E. & B. 1004; 27 L. J., Q. B. 295; *Dangerfield v. Jones*, 13 L. T., N. S. 142.

(*r*) 1 Web. P. C. 377; 12 L. J., C. P. 81; 4 M. & G. 580.

(*s*) 1 Web. P. C. 408.

(*t*) L. R., 7 Ch. 584.

(*u*) 10 P. O. R. 334, 346.

(*x*) *Booth v. Kennard*, 1 H. & N. 527; 2 H. & N. 84; 26 L. J., Ex. 23, 305; *Russell v. Cowley*, 1 Web. P. C. 457; 1 Cr. M. & R. 864.

lent (*y*), provided that a substantial improvement is effected thereby; but a patent will not be upheld which consists merely in substitution of a well known mechanical equivalent for some part of an old process or machine (*z*).

In *Williams v. Nye* (*a*), Cotton, L.J., said: "In order to maintain a patent, there must be a substantial exercise of the inventive power or inventive faculty. Sometimes very slight alterations will produce very important results, and there may be in those very slight alterations very great ingenuity exercised and shown to be exercised by the patentee."

A combination of two well-known contrivances without ingenuity will not support a grant of letters patent.

A patent was granted in 1870 for railway signalling apparatus; in 1871 another patent was granted for other improvements in railway signalling apparatus; in 1874 the plaintiffs obtained a patent for a combination which, in effect, was constituted of the improvements in the 1870 and 1871 patents; any person with ordinary knowledge of the subject would, by placing the two inventions of 1870 and 1871 side by side, be able to effect the desired combination without making any further experiment or gaining any further information. Field, J., held the 1874 patent void (*b*).

The mere fact that the improvement was the result of

(*y*) *Heath v. Unwin*, 2 Web. P. C. 228, 302; 5 H. L. Cas. 505, 522, 545; *The Badische Anilin und Soda Fabrik v. Levinstein*, 2 P. O. R. 90.

(*z*) *Thompson v. James*, 32 Beav. 570; *Horton v. Mabon*, 12 C. B., N. S. 437; 16 C. B., N. S. 141; 31 L. J., C. P. 255; *Rushton v. Crawley*, L. R., 10 Eq. 522; *Murray v. Clayton*, L. R. 7 Ch. 570; *Jensen v. Smith*, 2 P. O. R. 249; *Fletcher v. Arden*, 5 P. O. R. 46; *Tickelpenny v. Army & Navy Cooperative Society*, 5 P. O. R. 405; *United Horseshoe Co. v. Swedish Horseshoe Co.*, 6 P. O. R. 1; *Winby v. Manchester Steam Tramways Co.*, 8 P. O. R. 61.

(*a*) 7 P. O. R. 67; see also *Hayward*

*v. Hamilton*, Griff. P. C. 115, 117; *Hinks v. Safety Lighting Co.*, L. R., 4 Ch. D. 615; *Moss v. Malings*, 3 P. O. R. 373, 378; *Edison v. Woodhouse*, 4 P. O. R. 79, 92.

(*b*) *Saxby v. Gloucester Waggon Co.*, L. R., 7 Q. B. D. 305; see also *White v. Toms*, 37 L. J., Ch. 204; *Ormson v. Clarke*, 13 C. B., N. S. 337; 14 C. B., N. S. 475; *Jackson v. Needle*, 2 P. O. R. 191; *Sharp v. Bauer*, 3 P. O. R. 193; *Rowcliffe v. Longford Wire Iron Co.*, 4 P. O. R. 281; *Haslam v. Hall*, 5 P. O. R. 22; *Longbottom v. Shaw*, 5 P. O. R. 497; 6 P. O. R. 143; *Herrburger v. Squire*, 6 P. O. R. 194; *Morgan v. Windover*, 7 P. O. R. 131; *Williams v. Nye*, 7



accident (c), or was one that appeared obvious after it had been made (d), is of no importance, provided that the result is the production of a cheaper or better article than had been produced before, by some new combination that had not previously occurred to any one else (e).

In *Cannington v. Nuttall* (f), it was held that the patent could be sustained, although each principle or process in it was previously well known, provided that the mode of combining these processes was new and produced a beneficial result, and provided also that the specification claimed not the old processes or any other, but only the new combination. This case is very instructive, as clearly demonstrating what is meant by a "new combination."

To summarise the law upon "subject-matter," a patent may be granted for:—

(1) A new principle, coupled with a method of application, though the principle by itself would not be subject-matter.

(2) The novel application of an old principle, if invention is disclosed and a substantial improvement effected, but the patentee is strictly tied down to his method of application.

(3) A new machine, material, or process for a new purpose.

(4) A new machine, material, or process for an old purpose, but the Courts will construe the invention strictly.

(5) An old machine for a new purpose will be subject-matter only where the novel application obviously demanded the exercise of inventive power, but no patent will be granted for the application of an old machine to a purely analogous purpose.

(6) A new combination of new and old, or new, or old processes or materials, so as to effect an old purpose in a better, cheaper, or more expeditious way than had been done before, coupled with the exercise of ingenuity.

(7) An improvement by the omission of a part of an old

P. O. R. 62; *Newsom v. Mann*, 7 P. O. R. 307; *In re Gaulard & Gibbs' Patent*, 7 P. O. R. 367, 380; *Tucker v. Kaye*, 8 P. O. R. 58, 234.

(c) *Crane v. Price*, 1 Web. P. C. 410; *Boulton v. Bull*, Dav. P. C. 198; *Liardet v. Johnson*, 1 Web. P. C. 54.

(d) *Lyon v. Goddard*, 10 P. O. R.

343; *Benno Jaffé v. Richardson*, 11 P. O. R. 111; *Edison v. Smith*, 11 P. O. R. 398.

(e) *Crane v. Price*, 1 Web. P. C. 408; *Murray v. Clayton*, L. R., 7 Ch. 584; *Lyon v. Goddard*, 10 P. O. R. 346; 11 P. O. R. 354.

(f) L. R., 5 H. L. 205.

machine which was previously thought essential, or by the addition of a new part, or by the substitution for an old part of a new piece of mechanism, or even of a mechanical equivalent which was not previously known to be such, provided that a substantial improvement is thereby effected, and provided that the improvement required the exercise of ingenuity.

(8) A new product.

(9) A new method of using an old machine, by which a new and useful result is attained.

## CHAPTER V.

## NOVELTY.

HAVING now considered the interpretation which has been placed by the Courts upon the word "manufacture," we next examine what has been held to be a "new manufacture," that is to say, to what extent prior user is an answer to an action for the infringement of a patent. It is evident, that, if the alleged new manufacture can be shown to have been in the possession of the public before the application for the grant of letters patent, that there is no consideration for the grant. The patentee offers to the public, in return for the monopoly privilege, his information and knowledge respecting a new manufacture; if the public is already possessed of the information or knowledge, the supposed inventor has nothing to give (a). We shall see hereafter, when we discuss the practice of the Courts in actions for the infringement of patents, that the burden of proof lies on the alleged infringer when he sets up a defence of prior user, *i.e.*, of want of novelty in the alleged manufacture at the date of the patent; and it is as well to keep this in mind in reading the cases which have been decided as to what amounts to prior user.

We have seen that the Statute of Monopolies is a mere declaration of that which was the law before it was passed; it was always held by the Courts that the principle of a patent grant was not an arbitrary advantage granted by the Crown to one subject in detriment to the rest, but that it was an advantage granted by the Crown to persons who introduced a new manufacture, and that it was granted upon principle, not for the benefit of the patentee but for the benefit of the public: it being con-

(a) *Patterson v. Gas Light & Coke Co.*, L. R., 3 App. C. 239; *Morgan v. Seaward*, 2 M. & W. 544, 561; *Humpherson v. Syer*, 4 P. O. R. 407, 414.



sidered to the benefit of the public that reasonable encouragement should be given to inventors to induce them to devote their time, energies and resources to the improvement of the arts and manufactures of the realm.

In the case of *Hasting's Patent* (b), decided in 1567, the patent was in consideration of the patentee having brought into the country the making of frisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentees' bill in the Exchequer Chamber, on the ground that they had made baies very like to Mr. Hasting's frisadoes, prior to the date of Mr. Hasting's patent; they were therefore not restrained from making baies like his frisadoes. A patent was granted to "one Humphrey, of the Tower, 'for the sole and only use of a sieve or instrument for melting of lead, supposing it was his own invention, and therefore prohibited all others to use the same for a time'; and because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber by English bill, in which Court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendip, in West country, which if it were there before used then the Court were of opinion that he should not have the sole use thereof" (c).

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex v. Arkwright* (d), decided in 1785, Buller, J., gave a definition of "novelty" which now would be considered too wide. "Thus the case stands as to the several component parts of this machine, and if upon them you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict."

In *Cannington v. Nuttall* (e), Lord Hatherley, L.C., said: "It

(b) 1 Web. P. C. 6.

(c) 1 Web. P. C. 7; *Darcy v. Allin*, 1 Web. P. C. 6; *Mitchell v. Reynolds*, 19 Mod. R. 130; *Liardet v. Johnson*, 1 Web. P. C. 52, 53.

(d) 1 Web. P. C. 64.

(e) L. R., 5 H. L. 216; see also *Pirrie v. York Street Flax Spinning Co.*, 10 P. O. R. 37, 39.

is quite apparent, my Lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every invention—the skill and ingenuity of the inventor are shown in the application of well-known principles. Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet obtained. And I take it that the test of novelty is this: Is the product which is the result of an apparatus for which the inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?”

Pollock, C.B., treating with this subject in his judgment in *Newton v. The Grand Junction Railway Co.* (*f*), said: “It was argued that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty you take the entire invention; and if, in all its parts combined together, it answer the purpose by the introduction of new matter, by any new combination, or by a new application, it is a novelty entitled to a patent.”

When we speak of an invention being new, we mean that it must be new so far as the public are concerned, that is, so far as the means of information of the public goes. If a man had invented a machine and made it and used it secretly, so that no one but himself had access to it, and the general public had no means of information upon it, there is no doubt that a subsequent inventor, re-inventing, so to speak, the same machine, and disclosing his knowledge to the public in his specification, would be entitled to a valid patent (*g*). A machine made by the person who kept it secret would not amount to such a public knowledge as would anticipate the invention of the patentee, but if the first-made machine had been used in such a manner that other persons had been enabled to acquire the knowledge of its use and applica-

(*f*) 5 Exch. R. 334; 20 L. J., Ex. 429.

(*g*) Dollond's Patent, 1 Web. P. C. 43.



tion, there would be a prior user to void the subsequent patent. Lord Chief Justice Tindal said, in *Cornish v. Keene* (h): "If it was known at all to the world publicly, or practised openly so that any other person might have the means of acquiring a knowledge of it as well as the inventor, then the patent would be void." In *Carpenter v. Smith* (i), Lord Abinger, C.B., analyzed the meaning of the words "public use." "Public use does not mean a use or exercise by the public, but a use or exercise in a public manner." Taking that as a definition of the meaning of the words "public use," it will be apparent that the question of prior user is one of fact, and one which will have to be considered by a jury or a judge sitting as a jury upon the facts of each particular case (k).

The law on this point was laid down by Lord Blackburn in *Patterson v. The Gas Light and Coke Co.* (l), in the words of Mr. Hindmarsh: "If the public once become possessed of an invention by any means whatever, no subsequent patent can be granted for it, either to the true or first inventor himself, or to any other person, for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give" (m).

The public become possessed of an invention if, before the inventor has applied for a grant of letters patent, it has been used by, exhibited, or published to any person (n) without reserve and without injunction to secrecy (o), and that too whether

(h) 1 Web. P. C. 508.

(i) 9 M. & W. 804; see also *Betts v. Neilson*, 3 De G. J. & S. 82; L. R., 3 Ch. 429; *Heath v. Smith*, 3 E. & B. 256; *Harwood v. G. N. Ry. Co.*, 29 L. J., Q. B. 193; 2 B. & S. 194; *Croydale v. Fisher*, 1 P. O. R. 17, 21; *Lister v. Norton*, 3 P. O. R. 199, 210.

(k) *Pickard v. Prescott*, 9 P. O. R. 200.

(l) L. R., 3 App. Cas. 244; see also *Lister v. Norton*, 3 P. O. R. 211; *Humpherson v. Syer*, 4 P. O. R. 414; *Westley Richards v. Perkes*, 10 P. O.

R. 193.

(m) Hindmarch on Patents, p. 33.

(n) *Losh v. Hague*, 1 Web. P. C. 200; *Stead v. Williams*, 2 Web. P. C. 126; *Humpherson v. Syer*, 4 P. O. R. 407, 415; *Harris v. Rothwell*, 5 P. O. R. 225, 230.

(o) *Stead v. Williams*, 2 Web. P. C. 126; *Morgan v. Seaward*, 2 M. & W. 544, 559; *Winby v. Manchester Steam Tramways Co.*, 8 P. O. R. 61, 66; *Lifeboat Co. v. Chambers*, 8 P. O. R. 418; *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 249, 527.



but one sample of the invention was used (*v*), or the information was obtained from one whom the inventor had placed under the bond or seal of confidence (*q*), or if the anticipating machine was made simply for the purpose of export (*r*).

An offer to sell, although no sale is effected, constitutes a prior publication of the invention, and will vitiate a subsequent patent (*s*).

Whether the mere manufacture of an article will or will not amount to a "public user" depends upon the circumstances under which it was carried on (*t*).

In *Betts v. Neilson* (*u*) Lord Chelmsford said: "If the evidence which I am about to examine establishes the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that *Betts'* patent was invalidated."

In *Morgan v. Windover* (*x*) Cotton, L.J., in his judgment in the Court of Appeal, said: "If, in truth, we were satisfied that a carriage, in accordance with that which is claimed by *Mr. Morgan* as his invention, was then made, and made in a practical working shape, it would not be material that it had never been used from that time to this, because there would have been a prior use of that which is claimed by *Mr. Morgan* as his invention; but, as was pointed out by Lord Brougham in *The Househill Co. v. Neilson* (*y*), although, if there is a complete anticipation by prior user, the abandonment of it is nothing, yet

(*p*) *Honiball v. Bloomer*, 2 Web. P. C. 200; *Hollins v. Capper*, 5 P. O. R. 289.

(*q*) *Humpherson v. Syer*, 4 P. O. R. 407, 410; *Useful Patents Co. v. Rylands*, 2 P. O. R. 255; *Kurtz v. Spence*, 5 P. O. R. 161.

(*r*) *Carpenter v. Smith*, 1 Web. P. C. 530; *Westley Richards v. Perkes*, 10 P. O. R. 181, 192.

(*s*) *Oxley v. Holden*, 8 C. B., N. S. 666; *Wood v. Zimmer*, 1 Holt N. P. C. 58; 1 Web. P. C. 82, n.; *Mullins v. Hart*, 3 Car. & K. 297.

(*t*) *Moss v. Malings*, 3 P. O. R. 373, 378; *Lewis v. Marling*, 4 C. & P. 57; *Betts v. Menzies*, 8 E. & B. 923; *Betts v. Neilson*, L. R., 3 Ch. 436; *Morgan v. Seaward*, 1 Web. P. C. 167; *Bramah v. Hardcastle*, Holroyd, 81.

(*u*) L. R., 3 Ch. 436; see also *Humpherson v. Syer*, 4 P. O. R. 407; *Westley Richards v. Perkes*, 10 P. O. R. 192.

(*x*) 5 P. O. R. 302, 303.

(*y*) 1 Web. P. C. 673; see also *King, Brown & Co. v. The Anglo-American Brush Co.*, 6 P. O. R. 414, 424.

when it is a question of whether, really, there was a carriage perfected in accordance with the plans of *Mr. Morgan*, the fact that it had never been used for 36 years, or something of that sort, before he took out his patent is most material, as leading to the conclusion that that which was made in the year 1848 was not a perfect carriage in accordance with the invention of *Mr. Morgan*."

Where the anticipating machine was incomplete and practically useless for the purpose for which it was intended, or merely experimental, and abandoned as being unsatisfactory (s), or what was nothing more than a scientific curiosity of no practical value (a), it has been held that a subsequent patent for a workable and efficient machine is not vitiated thereby.

In *Smith v. Davidson*, a Scotch case (b), the Lord President said: "In order to invalidate letters patent on the ground of previous use it is necessary not only that the use shall have been prior to the date of letters patent, but that it should be a public and not a secret use." The remarks of Lord Bramwell, in *Hills v. London Gaslight Co.* (c), on this subject were as follows: "If a person has invented anything which is the subject of a patent, and has kept it to himself or communicated it privately to one or two, in fact has not made it public knowledge, if anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published."

As further illustrating the distinction between "public use" and "secret use" we may quote the words of Mr. Justice Williams in *Hancock v. Somervell*, which is quoted in "Newton's London Journal," Vol. XXXIX., p. 158. "The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use, in England before the

(z) *Murray v. Clayton*, L. R., 7 Ch. 570; *Hills v. London Gas Light Co.*, 5 H. & N. 312; *Jones v. Pearce*, 1 Web. P. C. 121; 2 Coop. Ch. Ca. 58; *Galloway v. Bleadon*, 1 Web. P. C. 521, 525; *Walton v. Bateman*, 1 Web. P. C. 613, 619; *Cornish v. Keene*, 1 Web. P. C. 501, 508; *Barlow v. Bayliss*, Griff. P. C. 44; *Lyon v. Goddard*, 10 P. O. R. 121, 134; 11 P. O. R. 354.

(a) *Young v. Fernie*, 4 Giff. 577, 611; see also *Benno Jaffé v. Richardson*, 11 P. O. R. 93.

(b) 19 C. S. 691.

(c) 5 H. & N. 336; see also *Morgan v. Seaward*, 2 M. & W. 544; *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 516; *Westley Richards v. Perkes*, 10 P. O. R. 181.



date of the patent, and if that is so it would entitle the defendants, no doubt, to a verdict upon this novelty issue. Upon that part of the case the view that it seems to me ought to be taken by you is this: you will first consider whether the material was before the public; it is not necessary that it should be used by the public if it is in public use, not in secret use . . . . I should here say that I do not think it necessary the use should be actually for sale; if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers. If you should think that the material being so in use, it was so palpable that you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it, that would be a public use."

In *Stead v. Anderson* (d) Baron Parke placed some considerable limitation on the meaning of the words "public use" in saying, "If the mode of forming and laying blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access."

It is difficult to draw the line precisely between public and secret use; we do not suppose that for the purpose of showing that some use was secret use it would be necessary to show an intention of secrecy, but in all cases it will be a matter of fact whether the use was so private and so secret as to make it practically impossible that the public should become acquainted with the manufacture.

Erle, J., in *Heath v. Smith* (e), cast a doubt even upon whether secret use would not amount to anticipation. He said: "If one party only had used the process and had brought out the article for profit and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." But this seems to be in direct contradiction to the decision in *Dollond's Case* (f). In that case the objection to Dollond's patent was that he was not the inventor of the method of making

(d) 2 Web. P. C. 149; see also *Stead* 166, 171.  
v. *Williams*, 2 Web. P. C. 126, 136.

(e) 3 E. & B. 256; 23 L. J., Q. B.

(f) 1 Web. P. C. 43.



new object-glasses, but that Dr. Hall had made the same discovery before him; but it was held that, inasmuch as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the inventor (g).

In *Betts v. Neilson* (h) it is said, "There may be public use of a patented article, without actual sale of the goods manufactured."

There are some conflicting cases on the subject of secret use. It does not appear to be open to much doubt that purely secret use, without publication, even if accompanied with the sale of the article manufactured, provided the article itself, by its appearance or other qualities, does not disclose the invention (i), ought not to invalidate the letters patent granted to a subsequent inventor, since he is in the position to, and does give to, the public the full consideration required by the Statute of Monopolies and the common law, for the patent grant which he applies for. On the other hand, if the secret use has been by himself, and he only applies for letters patent when he has any fear of his invention being discovered, then, probably, the previous secret use of the inventor would be held to invalidate his patent.

This branch of the subject is surrounded with considerable difficulty, for bearing in mind that the consideration which the inventor gives for the patent is the information which he is in a position to give to the world, it is difficult to understand upon what principle, if he keeps that information to himself and manufactures an article which of itself does not disclose his invention, he should not have a patent; since he is always in a position to give the information to the public, and to give a valid consideration for the grant. Unless indeed we regard the grant of letters patent, as not only the result of a contract between two parties, the state and the inventor, but also as somewhat after the nature of a reward for invention, which is only given for merit. There is, as we have pointed out before, no merit in

(g) See also remarks of Buller, J., in *Boulton v. Bull*, 2 H. Bl. 463 to 470; and Dallas, J., in *Hill v. Thompson*, 1 Web. P. C. 244.

(h) L. R., 3 Ch. 429.

(i) *Hancock v. Somervell*, 39 Newton's London Journal, 158.

publishing an invention which you find it difficult to keep any longer secret. Of course it would be otherwise where the article itself, by its appearance or by its properties, discloses the invention; the Courts, in their decisions, seem to have recognized the difficulty of this question. Baron Parke, in *Morgan v. Seaward* (l) said: "For if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a very much longer period than fourteen years." It does not seem to have been expressly decided that if an article sold did not disclose the invention, the use of the invention, if kept secret, would invalidate a subsequent patent by the inventor. Baron Parke as we have seen seems to have thought that it would; on the other hand the cases which have been cited above clearly lay down as law that a patent will only be anticipated if the subject of it has been made public, either by being disclosed to or practised by any person without reserve or in a place to which the public could have access, and consequently if the original inventor manufactured articles but kept the invention secret so that no one else could practise it, it is evident upon the authority of those cases, and particularly of *Dollond's Case* and *Hills v. The London Gaslight Co.*, that if someone else should re-invent the same matter subsequently, the secret use of the invention by the first inventor would not invalidate the patent of the second inventor; and if not the patent of the second inventor, why, upon principle, should one person from whom the consideration would move personally be in a worse position than another? It may be said, perhaps, that the common law contemplated *bona fides* on the part of the inventor, and a *bonâ fide* discovery of the invention to the public within a reasonable time, and that the working of the invention in secret and subsequent application for the patent was strong evidence of *mala fides*, and consequently would avoid the patent on the ground of a constructive fraud upon the public (m).

(l) 2 M. & W. 544.

(m) As to publication by sale, see *Wood v. Zimmer*, 1 Web. P. C. 44; *Losh v. Hague*, 1 Web. P. C. 205;

*Gibson v. Brand*, 1 Web. P. C. 628; *Carpenter v. Smith*, 1 Web. P. C. 586; *Mullins v. Hart*, 3 Car. & K. 297; *Heath v. Smith*, 3 E. & B. 256; 2 Web.



More experiments with a view to discovery have been frequently held not to invalidate a subsequent patent; few inventions could be made without trial, and there are some things of such magnitude that the trials cannot practically be conducted in private; hence it has been held that the mere making of experiments, with a view to invention, does not invalidate a patent whether made by the inventor himself (*n*), or by others to whom he has lent his machine for that purpose (*o*), nor will the fact that pecuniary profit resulted from such experiments necessarily avoid a subsequent patent (*p*).

Whether the experiments may be fairly so regarded, or whether they amount to such an open use of the machine as to constitute a publication, is a question to be decided upon the facts of each particular case (*q*).

Lord Esher, M.R., speaking on this subject in *Elias v. Grovesend Tinsplate Co.* (*r*), said, "The patent law about that is, that so long as you are experimenting upon the thing in the hands of people who ought not to disclose it, you must have people to assist you, and you cannot do everything yourself in your own private room, but so long as you are only doing it with people who are to assist you, and who ought not to tell, that is experimenting, and it is no publication; it does not make it public property. But if you go on with all that you have been in doubt about, to erect or make your patent—if it is a

P. C. 268; *Honiball v. Bloomer*, 2 Web. P. C. 200; *Oxley v. Holden*, 8 C. B., N. S. 666; *Lister v. Norton*, 3 P. O. R. 199.

(*n*) *Newall v. Elliot*, 4 C. B., N. S. 269; *Hills v. London Gas Light Co.*, 29 L. J., Ex. 409; see also *Jones v. Pearce*, 1 Web. P. C. 122; *Bramah v. Hardcastle*, Holroyd, 81; *Cornish v. Keene*, 1 Web. P. C. 508; *Galloway v. Bleaden*, 1 Web. P. C. 525; *Steed v. Williams*, 2 Web. P. C. 135; *Househill Co. v. Neilson*, 1 Web. P. C. 673; *Edison & Swan Electric Light Co. v. Woodhouse*, Griff. P. C. 90; *Elias v. Grovesend Tinsplate Co.*, 7 P. O. R. 455,

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(*o*) *Bentley v. Fleming*, 1 Car. & K. 587; *Useful Patents Co. v. Rylands*, 2 P. O. R. 262; *Humpherson v. Syer*, 4 P. O. R. 407, 411; *Elias v. Grovesend Tinsplate Co.*, 7 P. O. R. 455, 466.

(*p*) *Newall v. Elliot*, 4 C. B., N. S. 269; *Morgan v. Seaward*, 2 M. & W. 544.

(*q*) *Cornish v. Keene*, 1 Web. P. C. 501, 507; *In re Adamson's Patent*, 6 De G., M. & G. 420; 25 L. J., Ch. 456; *Brereton v. Richardson*, Griff. P. C. 54; 1 P. O. R. 165; *Elias v. Grovesend Tinsplate Co.*, 7 P. O. R. 455, 462.

(*r*) 7 P. O. R. 466.



machine, to make your machine—if all that is over, and you put it up in a public workshop or in a place where other people would come who are not bound by any rule of secrecy or faith—who are not bound to keep the secret—if you put it up in a place which they are to frequent and where they can see it, you have published it, and if you have published it, it becomes public property—it becomes the property of all the world immediately.”

The manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention has been held not to amount to a publication (s).

There is another description of anticipation which is capable of invalidating a patent besides that of public use, and that is prior publication. Prior publication means the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention as will enable a practical man to carry it out from the description given. Vague hints or descriptions of experiments, incomplete, or imperfect, are not sufficient to invalidate a subsequent patent (t). It is not necessary that that which is described in the book or publication should have been carried out in practice, it equally anticipates the patent (u). The question will always be one of fact, depending on the circumstances of each particular case, and the point which should be left to the consideration of the jury is, whether upon the whole evidence there has been such a publication as to make the description part of the public stock of information (v).

It is necessary that the description in the publication which is relied upon as evidence of prior publication, should be such as will when carried out produce the patented article; otherwise, however similar the description may be, if

(s) *The Useful Patents Co. v. Rylands*, Griff. P. C. 234; 2 P. O. R. 255.

(t) *Betts v. Menzies*, 1 E. & E. 1038; 8 Jur., N. S. 358; 10 H. L. Cas. 154, 157; *Stoner v. Todd*, L. R., 4 Ch. D. 58; *Thomson v. Batty*, 6 P. O. R. 84.

(u) *The Househill Co. v. Neilson*, 1

Web. P. C. 713, n.

(v) *Stead v. Williams*, 2 Web. P. C. 142; 8 Scott 472; *Stead v. Anderson*, 2 Web. P. C. 147; 4 C. B. 806; *Plimpton v. Malcolmson*, L. R., 3 Ch. D. 581.

it will not produce the alleged invention it will not amount to anticipation (10).

Vice-Chancellor Wood, in *Betts v. Menzies* (x), said, "I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiments set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." This remark of the learned Vice-Chancellor indicates how difficult a thing it is to lay down a general rule which shall bind every case; indeed no such general rule has ever been framed. It is evident that if a man were to describe an invention in a book or in a specification, and describe it so minutely and accurately that any practical person could from the description produce the invented matter, it would be immaterial whether the writer had tried experiments or had ascertained whether his invention would work in practice or not. If it should afterwards turn out to work in practice, and work as described, without any further inventive power and without any further invention being necessary, the description in the book or specification would be sufficient to invalidate any subsequent patent for the same invention.

In *Betts v. Menzies* (*supra*) the Vice-Chancellor had before him a case where the method described in the earlier publication was practically useless. In that event there is no doubt that the description would not invalidate a subsequent patent, because further invention would be necessary to bring the matter to a successful issue.

When *Betts v. Menzies* (y) came before the House of Lords, Lord Westbury said: "To effect a new patent, it must be clear that the antecedent specification disclosed a practical mode of

(10) *Muntz v. Foster*, 2 Web. P. C. 94; *Hills v. London Gas Light Co.*, 29 L. J., Ex. 409; *Hills v. Evans*, 31 L. J., Ch. 457; *Betts v. Neilson*, L. R., 5 H. L. 15; *Plimpton v. Malcolmson* L. R., 3 Ch. D. 531; *Otto v. Linford*, 46 L. T., N. S. 39; *Philpot v. Hambury*, 2 P. O. R. 33, 43; *Lawrence v. Perry*, 2 P. O. R. 179; *Barlow v. Baylis*,

Griff. P. C. 44; *Erhlich v. Ihlec*, 5 P. O. R. 437; *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 516, 533; *English and American Machinery Co. v. Union Boot Co.*, 11 P. O. R. 137, 367, 378.

(x) 3 Jur. N. S. 358.

(y) 10 H. L. C. 117.



producing the result which was the object and effect of the subsequent discovery; a barren general description therefore, though containing some suggestive information or involving some speculative theory, could not be treated as avoiding for want of novelty a subsequent specification or invention, unless it was ascertained that the antecedent publication involved the same amount of useful information." In the same case the opinion of the judges having been taken by the House of Lords as to whether the Court could pronounce Betts' patent to be void simply on the comparison of two specifications without evidence to prove identity of invention, and also without evidence that Dobbs' specification disclosed a practical mode of producing the result, or some part of the result described in Betts' patent; Blackburn, J., subsequently Lord Blackburn, gave it as his opinion, "that to avoid a patent on the ground of want of novelty, it is necessary to show that part of what the patentee claimed as a new invention was at the date of the patent already a publicly-known invention; this may be shown by proving that the invention was already disclosed in a publication accessible to the public . . . . it is not necessary to show that the invention thus made publicly known had already been put in actual use . . . . as soon as it has been ascertained that the description in the book makes known an invention, that is to say, that it adds to the public stock of knowledge what would without any further discovery enable a person to produce a result in the nature of a new manufacture. . . . If Dobbs had made it part of the public knowledge how to produce a new material as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed that which was not new, and if Dobbs had not made it part of the public knowledge how to produce the result, then Betts would not have claimed anything already known. The Court cannot tell without evidence whether what Dobbs disclosed would produce a result, and, therefore, as it seems to me, cannot pronounce the first patent void without evidence. I therefore answer your lordships' question in the negative (s)."

(z) See also *Betts v. Neilson*, L. R., 3 Ch. 429; L. R., 5 H. L. 1.



The cases which have been decided have generally been upon the subject of antecedent publication by means of a specification, but it is evident that the publication of a book or newspaper, or in any other form which gives the public a means of information, is equally potent as an anticipation of a subsequent patent (a). *Hills v. London Gas Light Company* (b) illustrates very clearly the principle laid down by Lord Westbury in *Betts v. Mensies*. The plaintiff obtained a patent for the employment of hydrated oxide of iron in purifying coal gas. A specification was put in evidence as published some ten years prior to the plaintiff's patent by one Croll, in which he said that coal gas could be purified by using the oxide of manganese, the oxide of zinc, or the oxide of iron. Now there are two descriptions of oxide of iron, hydrated and anhydrous. Anhydrous oxides of iron will not purify coal gas. It was held, therefore, that inasmuch as further experiments were required to discover that the action of hydrated oxide of iron was different from that of anhydrous oxide of iron in the purification of coal gas, that the antecedent specification did not anticipate the plaintiff's specification.

In *Hills v. Evans* (c) Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

In *Philpott v. Hanbury* (d), however, Grove, J., said: "What I am going to say now is an expression of opinion that is rather obiter. . . . As a matter of fact my opinion is . . . that there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to

(a) *Young v. Fernis*, 12 W. R. 901; *Carpenter v. Smith*, 1 Web. P. C. 530; *Gibson v. Brand*, 1 Web. P. C. 628; *The Househill Co. v. Neilson*, 1 Web. P. C. 718, n.; *Plimpton v. Spiller*, L. R., 6 Ch. D. 412; *Patterson v. Gas*

*Light & Coke Co.*, L. R., 3 App. Cas. 239; *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720.

(b) 29 L. J., Ex. 409.

(c) 31 L. J., Ch. 463.

(d) 2 P. O. R. 43.

merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction; but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent.”

In *King, Brown & Co. v. The Anglo-American Brush Co.*, Lord McLaren in his judgment said that the proposition of prior publication “may be proved by showing that the invention was previously described, not necessarily in language sufficient as a direction to a mechanic, but in language clear and intelligible to educated men, conversant with the subject, and capable of giving the necessary directions to the hypothetical workman” (e).

In *Kaye v. Chubb* Lord Esher, M.P., said (f): “I quite agree with what has been stated as to the law by Lord Westbury. If in the first patent which is thus alleged there is a general statement which gives no clear intimation either by its own construction or by that mode of putting construction upon patents—namely, by considering what would be the effect of it upon a hypothetical workman of ordinary skill—if it is so general that, neither by its own construction nor that adapted mode of construction, it would lead to any clear conclusion at all either as to the result or as to the means, and if some other person coming with great skill and great care should, out of the general words, really produce something not inconsistent with them, but which is not disclosed by them, I quite agree that he can take out a patent,

(e) 7 P. O. R. 443; see also *Betts v. Neilson*, L. R., 5 H. L. 15; *Plimpton v. Malcolmson*, L. R., 3 Ch. D. 531; *Bray v. Gardner*, 4 P. O. R. 405; *American Braided Wire Co. v. Thomson*, 5

P. O. R. 122; *Dowling v. Billington*, 7 P. O. R. 204.

(f) 4 P. O. R. 298; see also *Benno Jaffé v. Richardson*, 11 P. O. R. 111, 261.



and he cannot be defeated, because that which is really his invention can be got within general words which describe nothing."

It is not necessary that the book containing the description of the invention should be sold so as to constitute an anticipation. Mere exhibition in a bookseller's window for sale is sufficient publication, or sending it to a bookseller's in this country to be published (g). "There is no difference between a foreign inventor and an English one if, when the inventor is a foreigner, he publishes the book in a foreign language and sends it over to the booksellers in this country for the purpose of being sold (h)." Prior publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place, and was open to public inspection (i).

In *Otto v. Steel*, where a French treatise was placed in the British Museum library in 1863, it was held by Pearson, J., that having regard to the arrangements of the library there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. The library arrangements were as follows: There was no access to the public to any part of the library of the British Museum beyond the reading room. The public had access to the general catalogue and to books of reference kept in the reading room. In the general catalogue of the British Museum the printed books were referred to under the names of their authors. The treatise in question was entered in the catalogue under the name of Beau de Rochas, and in no other place. It was itself kept in an inner room, and it could only be obtained by one of two means, either by some person knowing of the book and writing the name of the book on a piece of paper and requesting that the book might be furnished to him; or if a reader wanted to find something on a particular subject, and went to the superintendent and asked what books there were that he had better read. The superintendent, if not able

(g) *Lang v. Gisborne*, 31 Beav. 133.

383; *Pickard v. Prescott*, 7 P. O. R.

(h) Per M. R. in *Lang v. Gisborne*, 31 Beav. 135; see also *Harris v. Rothwell*, L. R., 35 Ch. D. 416; 56 L. J., Ch. 459; 56 L. T. 552; 3 P. O. R.

361; 9 P. O. R. 195.

(i) *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720; *Stead v. Williams*, 8 Scott N. R. 449.



to give the information, would direct one of the assistants to take him to that section of the library where such books were likely to be found, and would desire him to let the reader look over the titles of those books, and select what book he pleased out of that section of the library.

In *Harris v. Rothwell* (*k*), Lord Justice Lindley, reading the judgment of Lord Justice Cotton and himself, after an elaborate review of the authorities, said: "The conclusion at which I have arrived, and which in my judgment is most in accordance with the authorities, and the principles which underlie them, may be thus expressed. *Prima facie*, a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, whether in English or in any other language commonly known in this country, was known to exist in this country, either in the patent office or in any other library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates, would naturally go for information. But if, as in the *Plimpton* cases (*l*) and in *Otto v. Steel* (*m*), it be proved that the foreign publication although in a public library, was not in fact known to be there, the unknown existence of the publication in this country is not fatal to the patent."

A patent for a machine may be anticipated by a drawing of it unaccompanied by explanatory letterpress if published in a book or elsewhere so that it could become generally known, provided that any mechanist would understand it, and could make the machine from the drawing without any further information, and without the exercise of ingenuity (*n*).

An inventor may invalidate his own invention by previous publication in a specification. For instance, if an inventor

(*k*) 4 P. O. R. 225, 232; see also *Stead v. Williams*, 7 M. & G. 818; *Lang v. Gisborne*, 31 Beav. 133; *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720; *The United Horsenail Co. v. Stewart*, 2 P. O. R. 133.

(*l*) *Plimpton v. Malcolmson*, L. R., 3 Ch. D. 531; 44 L. J., Ch. 257; 45

L. J., Ch. 505; *Plimpton v. Spiller*, L. R., 6 Ch. D. 412; 47 L. J., Ch. 211.

(*m*) *Otto v. Steel*, L. R., 31 Ch. D. 241; 55 L. J., Ch. 196; 3 P. O. R. 109.

(*n*) *Herrburger v. Squire*, 6 P. O. R. 198.

applies for letters patent and files a complete specification, and after the publication of the specification abandons it and begins again, applying for letters patent for the same invention, the previous publication of the specification will invalidate a subsequent patent.

Under the Act of 1883 it is clear that if he only filed a provisional specification there would be no publication, since provisional specifications which are subsequently abandoned are not published. In *Oxley v. Holden* (o) it appeared that on the 17th March, 1858, the plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages. On the 10th April, 1858, he obtained a second provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The first application was abandoned, and the second carried to completion—*there was no evidence that between the date of the first application and the second the invention had in any way been put in practice or published*: held, that the first application did not invalidate the patent.

Erle, C.J., in the course of his judgment said: "Although the first provisional specification may afford an objection either to receiving a second patent for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void if it is so granted; and, on the contrary, sect. 24 (of the Act of 1852) enacts that the patent, dated as of the day the provisional specification was delivered in, shall be of the same force and validity as if it had been sealed on that day. This patent is dated as of the 10th of April. On that day the protection given under the specification of the 17th of March existed; and the patent is valid by the operation of this section" (p).

In *Lister v. Norton* (q) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the

(o) 8 C. B., N. S. 666.

Vict. c. 63, s. 4.

(p) *Ibid.* at p. 708; cf. 46 & 47 Vict. c. 57, ss. 13 and 14; also 48 & 49

(q) *Griff. P. C.* at pp. 151, 153.



reasoning of *Oxley v. Holden* applied to this case, and said: "But reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley v. Holden*. The Court held that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification which is to describe the nature of the invention, and for the grant of the certificate, proceeds in the 8th sect. to enact that 'Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same.' The phrase 'to be granted for the same' obviously means in this section, and in the 9th sect. (which relates to the filing of a complete specification in the first instance) for the same invention, and cannot be construed as referring to the application or petition. . . . There is no express condition in the Act avoiding the protection conferred in reference to the first provisional specification by the filing of a second provisional specification in relation to the same invention, and having regard to the decision in *Oxley v. Holden* (*supra*), it is not open to me to say that there is any such implied condition."

So far as the author can ascertain this judgment was not appealed from, nor does it appear to have been discussed in any subsequent cases. Should the decision be upheld the results will be curious.

If, however, a provisional specification containing a sufficiently clear description of the nature of an invention be published, it will amount to an anticipation so as to avoid a subsequent patent granted for the same invention (*r*).

In *Von Heyden v. Neustadt* the defendants pleaded anticipation, and put in evidence a mass of paragraphs extracted from a large number of publications. James, L.J., in his judgment, said (*s*): "We are of opinion that if it requires this

(*r*) *Lawrence v. Perry*, 2 P. O. R. 187; *Stoner v. Todd*, L. R., 4 Ch. D. 58

(*s*) 50 L. J., Ch. 128; see also *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 252.



mosaic of extracts from annals and treatises spread over a series of years, to prove the defendants' contention, that contention stands thereby self-condemned. . . . And even if it could be shown that a patentee made his discovery of a consecutive process by studying, collating and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would do."

A patent will be upheld where the result of the invention for which it was granted is the production of an article in abundance and suitable for economic and commercial purposes, which previously had been but a scientific curiosity and of no practical value whatever (*t*).

The consideration for a grant of letters patent is entire and indivisible, consequently where two or more mechanisms or processes are claimed in one specification the want of novelty of one will avoid the whole (*u*), but where one of the claims is but subsidiary to the rest and does not in any way increase or enlarge the monopoly claimed by the remainder of the specification, the Courts have held want of novelty in such a claim to be no objection to the patent (*x*).

In *Hopkinson v. St. James and Pall Mall Electric Light Co.*, Mr. Justice Romer said: "I think it is not a fair objection to the novelty of a process which is intended to be, and which is, of great use, when applied to a system comprising many things, to say that the case of one has not been expressly excluded by the inventor, and that, as the application of the process to the case of the one, so far as it could be applied to the one, was known, therefore the process has been anticipated, though the utility of

(*t*) *Young v. Fernie*, 4 Giff. 577, 611; *Edison and Swan Electric Light Co. v. Woodhouse*, Griff. P. C. 93; 4 P. O. R. 106; *Von Heyden v. Neustadt*, L. R., 14 Ch. D. 280; 50 L. J., Ch. 126.

(*u*) *Hill v. Thompson*, 8 Taunt. 375; 1 Web. P. C. 239; *Brunton v. Hawkes*, 4 B. & Ald. 541; *Morgan v. Seaward*, 2 M. & W. 544; *Kay v. Marshall*, 2 Web. P. C. 71; *Bloxam v. Elses*, 6 B.

& C. 178; *Turner v. Winter*, 1 Web. P. C. 77; 1 T. R. 602; *Bramah v. Hardcastle*, 1 Carp., P. C. 168; *Patterson v. Gas Light & Coke Co.*, L. R., 2 Ch. D. 812, 833; *Cropper v. Smith*, 1 P. O. R. 87; *The United Horsenail Co. v. Stewart*, 2 P. O. R. 132.

(*x*) *Plimpton v. Spiller*, L. R., 6 Ch. D. 412.

the invention practically disappears when the case of the one is considered (y)."

Mr. Justice Kekewich, in *Ehrlich v. Ihlee* (x), said: "If within a short time of the first manufacture and sale, an article of commerce commands a ready and extensive sale, that fact, which is proof of utility, must be accepted as evidence, not conclusive, but cogent of novelty."

By sect. 39 of the Patents, &c., Act of 1883, it is enacted that, "*The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:—*

"(a) *The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and*

"(b) *The application for a patent must be made before or within six months from the date of the opening of the exhibition*" (a).

By sect. 103 of the same Act, as amended by 48 & 49 Vict. c. 63, s. 6, it is enacted as follows:—

"(1) *If Her Majesty is pleased to make any arrangements with the Government or Governments of any foreign state or states for mutual protection of inventions, designs, and trade-marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark in any such state, shall be entitled to a patent for his invention, or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent shall have the same date as the date of the application in such foreign State.*

(y) 10 P. O. R. 60.

(z) 5 P. O. R. 205, 453; see also *The American Braided Wire Co. v. Thomson*, 5 P. O. R. 113, 125.

(a) See Appendix, p. 449, post; note effect of 49 & 50 Vict. c. 37, s. 3; also P. R., 1890, r. 15.



*“ Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade-mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.*

*“ Provided that nothing in this section shall entitle the patentee or proprietor of the design or trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.*

*“ (2) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark.*

*“ (4) The provisions of this section shall apply only in the case of 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 ” (b).*

A foreign patentee has a double right, he may either take advantage of the Act and apply for a patent, antedated to the date of his foreign application, and thereby shorten the period of protection to that extent, or he may obtain a patent for the full period in the ordinary way, the date of the patent being conclusive to show which course he has pursued, but after having obtained a patent for the full period in the ordinary way, he may not avail himself of the provisions of sect. 103 to escape the result of a publication of his invention during the period that elapsed between his foreign application and his application in this country (c).

The fact of an invention having been practised previously in a British Colony, will not affect the power of the Crown to grant letters patent for its exercise in this country (d).

(b) See also International Convention, 1883, p. 411, post.

*Groth*, 8 P. O. R. 113.

(d) *Rolls v. Isuacs*, L. R., 19 Ch. D.

(c) *The British Tanning Co. v.*

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## CHAPTER VI.

## UTILITY.

WE now come to the consideration of the question of utility, for not only must the invention be new, but it must be new and useful. The 6th section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law prerogative of the Crown in respect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy v. Allin* (a), decided in 1602, it was held, the invention must tend to the furtherance of trade, and be for the good of the realm, and that the monopoly was granted in consideration of the good that the inventor doth bring by his invention to the commonwealth, otherwise not. Consequently an essential element of a valid grant is, that it should be for something which is for the good of the realm; that is, it must be useful (b).

In *Boulton v. Bull* (c), Rooke, J., said: "The public have a right to receive a meritorious consideration in return for the protection granted." In the same case Buller, J., said: "The invention professes to lessen the consumption of steam, and to make the patent good the method must be capable of lessening the consumption to such an extent as to make the invention useful." And in the case of *The King v. Arkwright* (d) the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for

(a) Noy, R. 182.

(b) *Edgebury v. Stephens*, 1 Web. P. C. 35; *R. v. Arkwright*, 1 Web. P. C. 72; *Turner v. Winter*, 1 Web. P. C. 80; *Morgan v. Seaward*, 2 M. & W. 544; *Manton v. Parker*, Dav. P. C.

327; 1 Web. P. C. 192, n.; *The Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 462.

(c) 2 H. Bl. 478.

(d) 1 Web. P. C. 72.

if it appears, as some of the witnesses say, to do as well without the stripes, and to answer the same purpose if you suppose the stripes never to have been used before, that is not such an invention as will support the patent."

It will always be a question for the consideration of the jury, whether the invention is useful; that is, whether that which is new is a sufficient advance or improvement upon what was already known by the public as to add to a material extent to the public stock of knowledge (e). It does not mean that there must necessarily be a great deal of invention, or an extensive operation, to support the patent, but that the invention when carried out in some way materially improves the process or manufacture, either by cheapening the article produced, or by improving its quality, or by improving the method of producing, or the uses to which it can be put.

Each of the cases which have been decided upon the question of utility deal, and necessarily must deal, with an independent state of facts; and, consequently, no case can be said to be an authority for another case; but they go to show the general principle that "utility" means a substantial improvement, and not necessarily an extensive improvement; for instance, a man might invent a large and complicated machine for the manufacture of boots, which, when completed, would do nothing which was not done before, and would not make them any quicker or any cheaper than they were made before. Such a machine would not form the subject of a patent. On the other hand, a man might discover a new needle for stitching boots, which would economise half-an-hour in the manufacture of each boot; such a needle would be the subject of a patent, although the whole improvement might consist of a bend.

In *Crane v. Price*, Tindal, C.J., said: "If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden or lucky thought, or mere accident of discovery" (f).

The test of utility of an invention, is that, when put in practice by a competent man, it should really do what it assumes to do,

(e) *Hill v. Thompson*, 1 Web. P. C. 237; *Bloxam v. Elsee*, 1 C. & P. 565; *Cornish v. Keene*, 1 Web. P. C. 506. (f) 1 Web. P. C. 411.



and be practically useful at the time when the patent is granted for the purposes indicated by the patentee (*g*).

Utility to support a grant of letters patent does not depend at all upon the amount of commercial success that may result from the invention (*h*), nor is it affected by the fact that it may be enormously expensive when put in practice (*i*), provided that cheapness of production is not the main point of the inventor's claim, in which case commercial failure will be taken into consideration as evidence of the uselessness of the invention.

In *The Badische Anilin und Soda Fabrik v. Levinstein*, before the House of Lords, Halsbury, L.C., said: "The element of commercial pecuniary success has, as it appears to me, no relation to the question of utility in patent law generally, though of course where the question is of improvement by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled" (*k*).

The fact that a patent was never put into practice is no proof of the uselessness of the invention. In *Edison v. Holland* (*l*), Lindley, L.J., said: "The utility of the patent must be judged by reference to the state of things at the date of the patent; if the invention was then useful, the fact that subsequent improvements have replaced the patented invention and rendered it obsolete and commercially of no value, does not invalidate the patent" (*m*); and Cotton, L.J., in the same case,

(*g*) Per Lindley, L.J., in *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 417; *Cornish v. Keece*, 1 Web. P. C. 507; Per Grove, J., in *Young v. Rosenthal*, 1 P. O. R. 41; *The Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 462, 466; L. R., 12 App. Cas. 712, 719, 720; *Edison v. Holland*, 6 P. O. R. 283; see also *Wilson v. Union Oil Mills Co.*, 9 P. O. R. 70.

(*h*) *The Badische Anilin und Soda Fabrik v. Levinstein*, L. R., 12 App. Cas. 712, 719, 720; 4 P. O. R. 462, 466; *Otto v. Linford*, 46 L. T., N. S. 41; *United Telephone Co. v. Bassano*,

3 P. O. R. 313; *Ehrlich v. Ihlee*, 5 P. O. R. 450; *Kurtz v. Spence*, 5 P. O. R. 182; *Edison v. Holland*, 6 P. O. R. 257, 277, 283; *Lane Fox v. Kensington & Knightsbridge Electric Lighting Co.* 9 P. O. R. 417; *Wilson v. Union Oil Mills Co.*, 9 P. O. R. 69, 70; *Hopkinson v. St. James & Pall Mall Electric Light Co.*, 10 P. O. R. 62.

(*i*) *Wilson v. Union Oil Mills Co.*, 9 P. O. R. 69, 70; *The Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 462, 466.

(*k*) 4 P. O. R. 462.

(*l*) 6 P. O. R. 243.

(*m*) *Ib.* p. 283.



said (n): "A patent is not to be defeated simply because subsequent inventions improved the patented article, or because, in consequence of subsequent improvements, no article was, in fact, made in accordance with the specification."

In *Otto v. Linford*, Lord Jessel, M.R., said: "It is quite true that it has been said that it is *prima facie* evidence of want of utility (o) if you do not make and vend your machine; but that is subject to this observation, that you may make and vend an improvement upon it, and if you have found out immediately after you have patented your invention that it can be improved, it does not by any means show that the first invention was useless" (p).

A very slight amount of utility will be sufficient to support a patent. Alderson, B., in *Morgan v. Seaward*, said (q): "I think if it was of different construction from any other steam engine, and of *any use* to the public, then that is sufficient." Again, Lord Jessel, M.R., in *Otto v. Linford*, said (r): "And, as to this question of utility, very little will do."

"The law does not require any definite amount of utility, and a very slight amount of utility will be sufficient, provided it does not appear that the Crown has been deceived as to the extent of the utility of the invention" (s).

Utility, however great it may be, cannot by itself support a grant of letters patent, and the application of an old contrivance to an analogous purpose, however useful the result may be, will not constitute a patentable invention (t).

(n) 6 P. O. R. p. 277.

(o) *Morgan v. Seaward*, 1 Web. P. C. 186; *Tetley v. Easton*, Macr. P. C. 63.

(p) 46 L. T., N. S. 41; *Galloway's Patent*, 1 Web. P. C. 724; *Renard v. Levinstein*, 11 L. T., N. S. 505; *United Telephone Co. v. Maclean*, Scotch Session Cases, 4th Series, 710; see also *United Telephone Co. v. Bassano*, 3 P. O. R. 313; *Thompson v. Batty*, 6 P. O. R. 100.

(q) 1 Web. P. C. 186; see also per Baron Halsbury, L.C., in *The Badische*

*Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 462.

(r) 46 L. T., N. S. 41; see also *Philpott v. Hanbury*, 2 P. O. R. 37; *Ehrlich v. Ihlee*, 5 P. O. R. 450; *Pirrie v. York Street Flax Spinning Co.*, 10 P. O. R. 39.

(s) Per Chatterton, V.-C., in *Pirrie v. York Street Flax Spinning Co.*, 10 P. O. R. 39; see also *Easterbrook v. Great Western Railway Co.*, 2 P. O. R. 201, 210.

(t) Per Lord Watson in *Morgan v. Windover*, 7 P. O. R. 136.

Utility, like novelty, is part of the consideration for a grant of letters patent, and if a material portion of the invention be useless, there is a failure of consideration, and the patent is altogether void (u), so, too, where a specification claims ability by means of one process to produce two or more things or effect two or more results, and fails in any one of them. The patent is void for falsity of suggestion, the Crown having been deceived in the grant (x); but want of utility in an immaterial part of a machine, which is not claimed as essential, will not vitiate a patent.

Lord Tenterden, C.J., in *Lewis v. Marling*, said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that the patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful" (y).

Tindal, C.J., in *Haworth v. Hardcastle*, said: "If the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold that patent void" (z).

In that case part of the patentee's claim was for the application of the machinery described for drying calicoes, the said machinery being adapted for taking up and removing the said calicoes after being dried. At the trial it appeared that the machine failed in taking up certain cloths stiffened with clay.

Where an invention is as a whole useful, a very small amount of utility will be sufficient to support a second and subsidiary

(u) *Simpson v. Holliday*, L. R., 1 H. L. 315, 322; *Templeton v. Macfarlane*, 1 H. L. Ca. 595; *Turner v. Winter*, 1 Web. P. C. 77; *Morgan v. Seaward*, 2 M. & W. 544; *Bloxam v. Elsee*, 6 B. & C. 169; *Hill v. Thompson*, 1 Web. P. C. 232; 3 Mer. 622; *Lawrence v. Perry*, 2 P. O. R. 179; *The United Horsenail Co. v. Stewart*, 2 P. O. R. 132; *United Horseshoe & Nail Co. v. Swedish Horsenail Co.*, 6 P. O. R. 8.

(x) *Turner v. Winter*, 1 Web. P. C. 77; *Bloxam v. Elsee*, 6 B. & C. 169, 178.

(y) 10 B. & C. p. 25; see also *Morgan v. Seaward*, 2 M. & W. 544; *Haworth v. Hardcastle*, 1 Bing. N. C. 182; *United Horsenail Co. v. Stewart*, 2 P. O. R. 132; *United Horseshoe & Nail Co. v. Swedish Horsenail Co.*, 6 P. O. R. 8.

(z) 1 Bing. N. C. 190.

claim (a), and it does not show that the patent is bad because one of the methods claimed is preferred to the others (b).

Commercial success is strong and almost conclusive evidence of utility (c), though, as has been pointed out above, its absence is no proof of want of utility (d).

Kay, J., in *Lucas v. Miller* (e), said: "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it."

(a) *Ehrlich v. Ihles*, 5 P. O. R. 203, 455.

(b) *Miller v. Scarle*, 10 P. O. R. 110; *Ehrlich v. Ihlec*, 5 P. O. R. 437, 455.

(c) *Cole v. Sequi*, 5 P. O. R. 495; *Ehrlich v. Ihlec*, 5 P. O. R. 205; *Ameri-*

*can Braided Wire Co. v. Thomson*, 5 P. O. R. 113; *Pirris v. York Street Flax Spinning Co.*, 10 P. O. R. 39.

(d) See ante, p. 72.

(e) 2 P. O. R. 160; see also *Morgan v. Windover*, 4 P. O. R. 422; *Miller v. Scarle*, 10 P. O. R. 111.



## CHAPTER VII.

## THE SPECIFICATION.

THE third condition which supports the consideration for a valid patent is that the patentee must publish his invention, that is to say, that in the specification which he files, and which forms the basis of the description of the subject-matter of his patent, he must give such an account of his invention, of the way of working it, and of what he particularly claims, as to enable an ordinary skilled person to carry out the invention without further assistance or discovery. By the 5th section of the Act of 1883 it is provided :—

“(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; and must be left at, or sent by post to, the Patent Office in the prescribed manner.*

“(2) *An application must contain a declaration 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 (a).*

“(3) *A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.*

(a) “Whereas sub-sect. 2 of s. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-sect. mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts; Be it therefore

enacted that: The declaration mentioned in sub-sect. 2 of s. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act or not, as may be from time to time prescribed.” Patents, &c., Act, 1885, s. 2.

“(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 (b).*”

“(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.*”

Such are the provisions of the new Act in respect of the requirements of the specification. It leaves the law respecting the necessary disclosures to be made in the specification very much as it was before; and the changes which are made are more changes of practice than anything else.

The regulations dealing with the manner and the time in which a specification must be lodged, and the practice generally upon an application for a grant of letters patent, will be reserved for consideration in a subsequent chapter (c); for the present it is proposed to treat merely with the internal requirements of the specification, that is to say, the amount of disclosure which is required by the Crown, and which constitutes an important part of the consideration given by the patentee to the public in return for the monopoly granted to him.

The specification is the means which is provided by the state, whereby a patentee publishes his invention, that is, dedicates it to the public. We have observed that two descriptions of specifications are provided for, one called “provisicnal,” and the other “complete”; the applicant for letters patent may, if he so pleases, in the first instance, file a complete specification, or he may file a specification which, for want of a better word, has been described as provisional; subsequently, and within the prescribed time, filing a complete specification, which particularly describes

(b) By the Patents, &c., Act, 1886, s. 2, it is provided: “The requirement of sub-sect. 4 of s. 5 of the Patents, &c., Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the Complete Specification refers to the

drawings which accompanied the provisional specification, and no patent heretofore sealed shall be invalid by reason only that the Complete Specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.”

(c) Chap. VIII.

and ascertains his invention. It is only necessary, however, that the provisional specification should describe the nature of the invention; and although it is not absolutely necessary that full details should be given as to the method of working the invention, care should be taken to ascertain to what extent and in what direction the invention goes.

There are three things in the specification which must agree with each other—the title, the provisional specification, and the complete specification.

#### THE TITLE.

The title of the specification must disclose the object of the invention (*d*).

The title is a part of the specification, and should be read into it so that it may limit the patentee's claim, which otherwise would be too large (*e*).

In the case of *Rex v. Else* (*f*), the title of the patent was held to contain the claim, there being no other claim.

The title must not be inconsistent with the specification, that is to say, it must not embrace an invention substantially different, neither more nor less extensive than that disclosed by the specification. For instance, a man who had invented a new street lamp, and described his invention in the title as being "a method or methods of more completely lighting cities, towns and villages," was held to have vitiated his patent by going too far in his title. His claim should have been for a new or improved street lamp (*g*). So care must be taken that an improvement in buttons, for instance, is not described as an improvement in the manufacture of buttons; if the improvement is in the article, it must be so stated, and if in the process, likewise. In *Campion v. Benyon* (*h*) the title was "a new and improved method of making and manufacturing double canvas

(*d*) *Househill Co. v. Neilson*, 1 Web. P. C. 678.

(*e*) *Newton v. Vaucher*, 21 L. J., Ex. 308; *Neilson v. Harford*, 1 Web. P. C. 312, 373; *Oxley v. Holden*, 8 C. B., N. S. 666; 30 L. J., C. P. 68; *Lister*

*v. Norton*, 3 P. O. R. 203.

(*f*) 1 Web. P. C. 76.

(*g*) *Cochrane v. Smethurst*, Dav. P. C. 354; 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.

(*h*) 6 B. Mo. 71.



and sail cloth with hemp and flax, without any starch whatever;” the title, therefore, described an invention, the novelty and utility of which was to omit the use of starch, but upon reading the specification we find that the real invention was an improved mode of twisting the threads to be applied to the making of unstarched cloth, the patent was held bad. In the case of *Bloxam v. Elsee* (i) the title for the invention was for a machine for “making paper in single sheets without seam or joining from 1 to 12 feet and upwards wide, and from 1 to 45 feet and upwards in length.” It was found that to vary the width of the paper it was necessary to have a different machine, and that consequently the title did not correspond with the invention, and the title was held bad. In *Felton v. Greaves* (k), the title was “a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments.” The machine would not sharpen scissors:—Held bad.

In *Croll v. Edge* (l) the title was for “improvements in the manufacture of gas for the purpose of illumination, and in apparatus used therein, and when transmitting and measuring gas,” an important part of the patentee’s claim consisted in a new mode of manufacturing clay retorts, an apparatus used in the manufacture and not in the transmitting and measuring of gas:—Held, that there was fatal inconsistency, the specification being substantially wider than the title.

These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton v. Hawkes* (m), Best, J., said: “That the patent was taken out for more than the patentee was entitled to, that, in my opinion, avoids the patent *in toto*, for the king is deceived.”

Mere vagueness in the title is not a fatal objection to a patent, provided that it is sufficiently explained by the specification.

(i) *Bloxam v. Elsee*, 6 B. & C. 169.

(k) 3 C. & P. 611; see also *Rex v. Wheeler*, 2 B. & Ald. 345; *Rex v. Metcalf*, 2 Stark. R. 249.

(l) 9 C. B. 479; 19 L. J., C. P. 261.

(m) 4 B. & Ald. 558; see also *Rex*

*v. Wheeler*, 2 B. & Ald. 345; *Morgan v. Seaward*, 2 M. & W. 544; 6 L. J., Ex. 153; *Bloxam v. Elsee*, 1 Car. & P. 558; 6 B. & C. 169; 3 L. J. (O. S.), Q. B. 93.

In *Cook v. Pearce* (n), Tindal, C.J., in the Exchequer Chamber, said: "This was an action on the case against the defendant for the infringement of a patent taken out by the plaintiff for improvements in carriages. The 6th plea, after setting out the specification, averred that 'although the said alleged invention in the declaration of letters patent respectively mentioned is therein styled and described as improvements in carriages, yet the said invention in truth, and in fact, is not an invention of improvements of carriages generally, but certain alleged improvements in the fixing and adapting of German shutters in those carriages only in which German shutters are used, and that German shutters cannot be used in divers and very many carriages, to wit, coaches, &c.,' and so the defendants say that the title of the said invention is too large and general, and by reason thereof the said letters patent are void and of no force. . . . It has been observed that the decision (in the Court below) does not proceed upon the ground that the title of this patent must be held of necessity to claim more than the invention as explained by the specification, as if the title had been 'an invention and improvement of *all* carriages,' and the specification had limited the invention to the improvement of one or more species of carriages only, or if the title had been for the invention of two things, and the specification had shown it to be an invention of one only out of the two; in such cases it may be readily admitted that the patent would be void, in the first, because there was no specification enrolled agreeing with the title, and in the second, upon the principle laid down by Mr. Justice Bayley, in his judgment in *Brunton v. Hawkes*: 'that the entire discovery of all the things for which the patent was taken out may be held to be the consideration upon which the patent was granted by the Crown;' but such an objection would not apply to the case now before us, for the words 'improvements in carriages' do not necessarily imply in all carriages, but in their ordinary use may well be held to be satisfied by an invention for improvements in some carriages only, but the ground of the decision is as before stated confined to the vagueness and

(n) 8 Q. B. 1054, 1062.



generality of the title, and to that only. Now the mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground to avoid the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void. . . . We think it would be unsafe to lay down the rule in terms so large as it appears to have been adopted by the Court below, for that it would endanger the validity of very many patents which had hitherto been free from exception, if every patent must be held to be void simply on the ground that its title was conceived in such terms as to be capable of comprising some other invention besides that contained in the specification in the absence at the same time of any proof of an intention to commit any fraud upon the Crown, or of deceiving or misleading the public" (o). It will be seen, therefore, that although variance between the title and the specification is held to vitiate the patent as in *Felton v. Greaves*, that mere excess and generality in the title will not vitiate the patent in the absence of any evidence of fraud upon the Crown (p).

In *Neilson v. Harford* (q), Abinger, C.B., said: "If the specification is consistent with the title, that would be sufficient;" and Baron Parke said, "The title of the patent is for the improved application of air, though that is ambiguous. It is sufficiently explained by the specification, and is not at variance with it."

Purely technical objections to a title have been held not to affect a patent; in *The Electric Telegraph Co. v. Brett* (r) the

(o) This decision was followed in *Crossley v. Potter* by Pollock, C.B. See Macr. P. C. 242.

(p) *Nickels v. Haslam*, 7 M. & G. 378, 385; *Sturtz v. De La Rue*, 5 Russ. 322; *Neilson v. Harford*, 1 Web. P. C. 295; *Morgan v. Seaward*, 1 Web. P. C. 196; *Stead v. Williams*, 2 Web. P. C. 137; *Hills v. London Gas Co.*, 5 H. &

N. 312.

(q) 1 Web. P. C. 333.

(r) 10 C. B. 838; see also *Fisher v. Dewick*, cited 8 Q. B. 1056; *Derosne v. Fairie*, 5 Tyr. 393; *Beard v. Egerton*, 2 Car. & K. 667; 3 C. B. 97; *Pirrie v. York St. Flax Spinning Co.*, 10 P. O. R. 45.



title of the plaintiff's patent was an "Invention of improvements in giving signals and sounding alarms in distant places *by means of electric currents transmitted through metallic circuits.*" Subsequently to the date of this patent it was discovered that the earth would complete the circuit and render a return wire unnecessary; this was the method employed by the defendants in working their apparatus, and it was argued by them that so long as they did not employ a metallic circuit throughout, they could not infringe the patent of the plaintiffs; metallic circuits, although mentioned in the title, were not a condition necessary to the existence of the improvements claimed by the plaintiffs in their specification, and it was held that this objection could not be sustained.

Cresswell, J., in his judgment in the Court of Common Pleas, said (s): "It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed and their application."

The question of variance between the title and the specification is one upon which the decided cases can have but little bearing. All that can be gleaned from previous decisions of the Courts is that variance is a fatal blemish; but in the immense variety of inventions it is evident that the same variance will never occur in any two cases, and it will be a question for the Court in each individual case that comes before it to decide whether, in that case, the specification and the title vary or differ from each other; and although the decided authorities will be of assistance to the Court in showing to what extent variance has been held in prior cases to vitiate the patent, no prior decision will be absolutely binding (t).

(s) 10 C. B. 881.

(t) *Bainbridge v. Wigley*, Higgins' Digest, 155; *Hill v. Thompson*, 1 Web.

P. O. 239; *Nickels v. Haslam*, 13 L. J. C. P. 146; *Croll v. Edge*, 9 C. B. 479; *Wright v. Hitchcock*, L. R., 5 Ex. 37.

## THE PROVISIONAL SPECIFICATION.

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty, therefore, by the Patent Law Amendment Act, 1852, the provisional specification was created. Prior to the passing of that Act, applicants for letters patent, when they made their application, merely deposited the title of their invention. By sect. 6 of that Act a provisional specification was required, which should give some more definite information as to the nature of the invention for which protection was sought than could be possibly given in a mere title.

“The whole object of provisional protection is to enable a patentee to work at and improve his invention without risk of invalidating his patent by premature publication or user (see 46 & 47 Vict. c. 57, s. 14). The only limit set to what he can do in this respect is that the invention, as finally specified, must not be a different invention from that provisionally protected” (11)

It is very difficult to clearly define the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. In *Woodward v. Sansum* (x) the Court of Appeal held that all a patentee need do in his provisional specification is to describe his invention. He need not go on therein to describe any method of carrying out the invention, but, whether he do so or not, if a different or further mode of carrying out the invention is described in his complete specification that will not invalidate the patent so long as such new method of carrying out is fairly within the invention as described in the provisional specification. In *Moseley v. Victoria Rubber Co.* (y), Chitty, J. laid it down that the object of a provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details of the complete specification.

(v) Per Lindley, L.J., in *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 526; see also *Stoner v. Todd*, L. R., 4 Ch. D. 59; *Ex parte Bates and Redgate*, L. R., 4 Ch. 577.

(x) 56 L. T. 347; 4 P. O. R. 166, 174.

(y) 4 P. O. R. 241, 251; 57 L. T. 142.



Sect. 8 of the Act of 1852, to which we have referred, says that "the law officer must be satisfied that the provisional specification describes the nature of the invention," and we have seen that the exact words of that section are retained in subsect. 3 of sect. 5 of the Act of 1883; and probably the Legislature had in view the desirability of retaining the effect of the numerous valuable decisions of the Courts of law upon the construction which should be placed upon what is a sufficient description of the nature of the invention. It will be observed that the complete specification to which we shall refer at greater length hereafter must not only describe the nature of the invention, but must also *ascertain* the nature of the invention and in what manner it is to be performed; but both a provisional specification and a complete specification must commence with a title, and the complete specification must conclude with a distinct statement of the invention claimed (z).

The cases which we have quoted, and which were decided prior to the year 1852, as to the fatal nature of a variation between the title and the specification, will apply equally to the consideration of a variance between a provisional and a complete specification. It is evident, however, that the object of the Legislature in creating a provisional specification, and founding upon it a period of provisional protection, was to enable the inventor in that interval to improve and perfect his invention, and to clearly ascertain what was new and what was old in that which he proposed to patent. That being so, it is obvious that it could not have been the intention of the Legislature that, when framing a complete specification, the inventor should be bound to follow implicitly every detail which he had given in his provisional specification, or that he should be prevented from adding to or subtracting from his invention; for, in that case, the object of the Legislature would be defeated.

In *Newall v. Elliott* (a), Pollock, C.B., said: "The object of the statute which requires a provisional specification is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for a patent, to give some

(z) Post, p. 90, *et seq.*

(a) 10 Jur., N. S. 955.



notion of what his invention is ; that has been followed by Act of Parliament, requiring it to be done ; but the object in both cases is to ascertain the identity of the invention, and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance . . . . I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." Baron Channell in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification." It will be observed that in the cases to which we drew attention upon the subject of variance between title and specification, the point always was as to whether the title and the specification varied in the description of the nature of the invention ; and the same principle holds good when considering the variation between the provisional and complete specification, the question always is, Do they differ in their description of the nature of the invention ? In *Newall v. Elliott (b)*, Byles, J., said : "The office of the provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out" (c).

Lord Chelmsford, in *Penn v. Bibby (d)*, said : "The relation which the provisional specification bears to the complete specification is much the same as that which before the Patent Law Amendment Act a title bore to the specification . . . . the only objection then which is open upon the complete specification, is whether it is sufficient in itself, and whether it agrees with the provisional specification. Now, by 'agreement' is not meant a

(b) 4 C. B., N. S. 269, 293.

(c) See also *Siddell v. Vickers*, 5 P. O. R. 99, 416, 426 ; 7 P. O. R. 292 ; L. R., 39 Ch. D. 92, 97 ; L. R., 15 App. Cas. 496 ; *Stoner v. Todd*, L. R.,

4 Ch. D. 58, 59 ; *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720 746.

(d) L. R., 2 Ch. 127, 133.

perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor then proceeds to quote *Newall's case*, to which we have referred, and proceeds: "Nor is it at all necessary that the specification should extend to everything comprehended in the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand. It is clear, therefore, that unless a complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted in the complete specification without the necessity of any disclaimer (*e*). In *Stoner v. Todd* (*f*), Jessel, M.R., said: "I must consider first the nature of a provisional specification, and the effect of a provisional specification on a final specification of the same invention. A provisional specification was never intended to be more than a mode of protecting an inventor, until the time of filing a final specification; it was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state; until the inventor could perfect its details, the provisional specification as such is not and cannot be known to the public. It is never

(*e*) *Thomas v. Welch*, L. R., 1 C. P. 192; see also the remarks of Lord Chelmsford in *Penn v. Bibby*, quoted

above; *Re Everitt's Patent*, Griff. L. O. C. 27.

(*f*) L. R., 4 Ch. D. 58.



published unless with the final specification, when they become parts of the same document."

Lord Justice Lopes, in *Woodward v. Sansum (g)*, said: "A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention so as to protect the inventor until the time for filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what I may call the ambit of his invention as disclosed in his provisional specification. Provided that this is done, it is no objection that in the complete specification an invention is described more particularly and in more detail, nor to use the words of Lord Blackburn in *Bailey v. Robertson (h)*, 'even if it be shown that there has been more discovery made and so as to make the invention which he has described in the provisional specification really workable.' It is essential that the nature of the invention shall be the same, but upon principle and upon authority, it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts, with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity."

In the same case, Cotton, L.J., said (on p. 175): "A patentee putting in a provisional specification showing the nature of his invention is not bound to describe the way in which that can be carried into effect and operation, but if he does describe a way of doing it, and before he files his complete specification, he either finds out improvements in that way or a different way of carrying

(g) 4 P. O. R. 178 ; see also per Fry, L.J., in *Crompton v. The Patents Investment Co.*, 6 P. O. R. 294, 295 ; also *Lucas v. Miller*, 2 P. O. R. 155 ; Griff. P. C. 156 ; *Walling v. Stevens*, 3 P. O. R. 147, 151 ; *Moseley v. Victoria*

*Rubber Co.*, 4 P. O. R. 248 ; *Siddell v. Vickers*, 5 P. O. R. 99, 426, 427 ; *Gadd v. Mayor, &c. of Manchester*, 9 P. O. R. 526 ; *Miller v. Scarle*, 10 P. O. R. 111.

(h) L. R., 3 App. Cas. 1055, 1075.



into effect that which is described as his invention in the provisional specification, he is bound to give the public the benefit of what he has discovered as regards the mode of carrying the invention, the nature of which must be described in the provisional specification, into effect, *even although there may be improvement, and even invention which was not known to him at the time*" (i).

But if the improvements discovered by the inventor between the dates of filing his provisional and complete specifications are of such a character as to amount to a new invention a fresh patent must be taken out, since, should the patentee incorporate such improvements in his complete specification, his patent would be rendered void on the ground of variance (k).

In the case of *Bailey v. Robertson* (l), decided in the House of Lords, the provisional specification stated the object of the invention to be the preserving of animal substances in the fresh state, and the patentees claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as solution No. 1 a solution composed of bisulphite of lime alone, and gave no direction how this solution was to be used. Bisulphite of lime had been used by a prior patentee. In the action for infringement against the defendants who had used bisulphite of lime pure and simple, it was held that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification. It will be observed that in this case the invention, which was described in the provisional specification, was the coating of animal substances with a film of a mixture of gelatine and bisulphite of lime; the complete specification claimed the dipping of the animal substance into a solution of bisulphite of lime in water; it is apparent,

(i) See also *Crompton v. The Patents Investment Co.*, 5 P. O. R. 397; *Crossley v. Beverley*, 9 B. & C. 64; *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 248; 57 L. T. 142; *Miller v. Scarle*, 10

P. O. R. 111.

(k) *Edison v. Woodhouse*, L. R., 32 Ch. D. 520; *Penn v. Bibby*, L. R., 2 Ch. 127, 138.

(l) L. R., 3 App. Cas. 1055.

therefore, to anyone acquainted with the action of antiseptic substances upon animal decomposition, that the operation of a film of gelatine with bisulphite of lime is entirely different from the operation of a solution of bisulphite of lime; it is a totally different idea, and therefore a different invention; the complete specification, therefore, was not an extension, curtailment or modification of the provisional specification, but was a description of a totally different invention, and so it was held bad for variance (*m*).

Thus we see that the provisional specification is a mere extension of the title; but since variance between the title and the specification vitiated the patent before the inauguration of the provisional specification, variance between the provisional and complete specification also vitiates a patent (*n*), but it is quite open to a patentee to extend, improve or curtail the claim which he has made in his provisional specification when he comes to file his complete specification. A patent is not rendered invalid by the fact that the complete specification describes something different from anything specifically referred to in the provisional specification, provided that what is so described comes within the nature of the invention described in general terms in the provisional specification (*o*).

In *Gadd v. Mayor, &c., of Manchester* (*p*), Lindley, L.J., said: "Even under the present law the Court may be driven to hold a patent invalid on the ground that the invention described and claimed in a complete specification is not the same as that provisionally protected; but having regard to the provisions made for the comparison of the two documents by an official

(*m*) See also *Nuttall v. Hargreaves*, 8 P. O. R. 450; L. R., 1892, 1 Ch. D. 23; *Foxwell v. Bostock*, 4 De G. J. & S. 298; *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720; *Horrocks v. Stubbs*, 3 P. O. R. 221, 233, 236; *Hutchison v. Pattullo*, 5 P. O. R. 351, 362; *King v. The Anglo-American Brush Co.*, 6 P. O. R. 414; 7 P. O. R. 436; *In the Matter of Gaulard and Gibbs Patent*, 6 P. O. R. 215; 7 P. O. R.

367; *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 221, 238, 413, 420; L. R., 1892, 2 Ch. 66, 88; L. R., 1892, 3 Ch. 424; *Cera Light Co. v. Dobbie*, 11 P. O. R. 10, 16.

(*n*) *Nuttall v. Hargreaves*, 8 P. O. R. 456; L. R., 1892, 1 Ch. 23.

(*o*) *Siddell v. Vickers*, L. R., 39 Ch. D. 92.

(*p*) 9 P. O. R. 527.



examiner (see 46 & 47 Vict. c. 57, s. 9, and 51 & 52 Vict. c. 50, s. 4), the Court ought not to decide against the validity of a patent on the ground in question, unless the two inventions are unmistakably different. If a case is on the border line, the patent ought to be held good rather than bad."

#### THE COMPLETE SPECIFICATION.

We now come to the more important subject of the requirements of a complete specification. The complete specification is, as we have seen, one of the essential considerations which the patentee gives for the grant which is made to him. It is the disclosure of his invention, and of the mode of performing it. It contains the information which he is bound to give to the public. That information must be *bonâ fide*, full, complete, and unambiguous; it must disclose the invention, the nature of it, the intention of it, the way of performing it, and an exact statement of what is claimed by the patentee (*q*).

These conditions are imposed by the common law; they were maintained intact by the Statute of Monopolies, by the Patent Law Amendment Act, 1852, and are now specifically re-enacted in the Act of 1883.

The specification must be sufficient—that is, it must give a sufficient description of the invention to enable a person skilled in the art to which it refers to perform the invention from the description which it gives. It must be *bonâ fide*—there must be no reserve on the part of the inventor. He must disclose what he knows; he must conceal nothing, and thus he must give to the public the full benefit of his invention.

As has been pointed out above (*r*), an inventor is bound to disclose in his complete specification any improvement that he may have discovered relating to his invention during the period of provisional protection; but if such fresh discoveries amount to another invention or consist merely in a better way of using his invention as described in his provisional specification, he is not

(*q*) As to required conformity between provisional and complete specification, see "The Provisional Specification,"

supra.

(*r*) See "The Provisional Specification," supra.



required to give the public this further information in his complete specification.

In *Edison and Swan Electric Light Co. v. Woodhouse* (s), a patent dated as to its provisional specification, November, 1879, and as to its final specification, 10th May, 1880, claimed an electric lamp with a carbon filament for its illuminating conductor. The patentee took out a subsequent patent, dated as to its provisional specification, December, 1879, for a method of making carbon filaments for electric lamps. Objection was taken that inasmuch as at the time of filing the complete specification of the first patent the patentee knew the subject-matter of the second, he should have included it in the first, and that therefore the first patent was bad by reason of concealment. This objection was overruled.

In *Coles v. Baylis* (t), the invention was for "Improvements relating to the preparation of lithographic printing surfaces." It was alleged by the defendant that the plaintiff was acquainted with an improved method of using the lithographic printing surfaces after they had been prepared by the patented process, but that he had not disclosed the same in his specification, and that therefore the patent was bad. Bacon, V.-C., overruled the objection, and said:—"It is to be said that the specification . . . is bad because he knew a mode by which a stone prepared according to the specification may be more conveniently or more usefully worked than anybody but himself knew, that he was bound to put that into the specification. I know no authority for saying that."

In *Harmar v. Playne* (u), Lord Ellenborough said:—"The object of requiring the specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell from an inspection of the specification itself what the invention was for which the patent was granted, and how it was to be executed." In *Morgan v. Seaward* (x), Baron Alderson said:—"The patentee ought to state in his specification the precise way of doing it (referring to the invention); if it

(s) L. R., 32 Ch. D. 520.

(t) 3 P. O. R. 178; Griff. P. C. 57.

(u) Dav. P. C. 316.

(x) 1 Web. P. C., at p. 182.

cannot completely be done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement, it would be an infringement to do that perfectly, which, according to the specification, requires something else to be done to make it perfect. If that be correct, you would prevent a man from having a perfect engine. He says, practically speaking, the difference in the length of the rods would not be very material, the difference being small. But the whole question is small, therefore it ought to have been specified, and if it could not be ascertained fully it should have been so stated." We quote this decision at length, because the exposition of the law which it contains is still absolutely correct. The subsequent cases have implicitly followed the judgment of Baron Alderson (y).

In *Cartwright v. Eamer* (s), Lord Eldon said:—"The patent is to be considered as a bargain with the public, and the specification, therefore, is to be construed on the same principle of good faith as that which regulates all other contracts. If, therefore, the disclosure be such that the invention can be communicated to the public, the statute is satisfied."

In the case of *The King v. Arkwright* (a), Mr. Justice Buller said:—"The public have a right to a fair, full, and true description of the invention in the specification."

It is incumbent on a patentee to give a specification of his invention in the fairest and most unequivocal terms of which the subject is capable (b). In the same case, Mr. Justice Buller said:—"Many cases upon patents have arisen within our memory, most of which have been decided against the patentees upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him." In *Newbery v. James* (c), Lord

(y) See *Neilson v. Thompson*, 1 Web. P. C. 278.

(z) Cited 14 Vesey, 131, 136.

(a) 1 Web. P. C. 72; Dav. P. C. 61.

(b) Per Ashurst, J., in *Turner v.*

*Winter*, Dav. P. C. 151; 1 Web. P. C. 80.

(c) 2 Mer. 451; see also *Sturtz v. De La Rue*, 5 Russ. 322; 7 L. J., O. S., Ch. 47.



Eldon said:—"In order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it was granted was at an end."

We have next to consider the bearing of the different decisions upon the question of what amounts to sufficiency in a specification. It is always a question of fact whether the specification is sufficient or not, taking care to distinguish between sufficiency of description and an attempt to cover too much—it is for the jury (that is, it is a question of fact) to say whether from the description given the invention could be carried out. It is for the Court to determine whether the inventor has claimed that which is not new among that which is new (*d*). The question of the sufficiency of the specification is a question for the jury (*e*).

The intelligibility of the specification is a question for the jury (*f*). The construction of the specification is in the same manner as the construction of all documents—a question of law. The duty of the judge at *Nisi Prius* is to tell the jury the specification says so-and-so, placing a meaning upon the different words used and the different sentences used in the specification. It is then for the jury to say it is intelligible or it is not, it is sufficient or it is not sufficient, but the Court will determine in all cases whether or not the patent is defective by reason of the patentee having endeavoured to describe or to claim too much (*g*).

We will deal with these different heads in their natural order, first, as to construction, next as to intelligibility, and then as to sufficiency.

The leaning of the Courts is invariably in favour of the patentee, and specifications will not be construed astutely so as to overthrow a patent. Sir George Jessel, in the case of *Hinks v. The Safety Lighting Co.* (*h*), said "I am anxious, as I believe

(*d*) *Hill v. Thompson*, 3 Mer. 626 ; 613, 619.  
*Seed v. Higgins*, 8 H. L. C. 561.

(*e*) *Bickford v. Skewes*, 1 Q. B. 938 ;  
*Wallington v. Dale*, 7 Exch. 888 ;  
*Parkes v. Stevens*, L. R., 8 Eq. 358.

(*f*) *Neilson v. Harford*, 1 Web. P. C.  
295 ; *Walton v. Bateman*, 1 Web. P. C.

(*g*) *Hill v. Thompson*, 3 Mer. 626 ;  
*Beard v. Egerton*, 19 L. J., C. P. 38 ;  
*Hills v. Evans*, 31 L. J., Ch. 460 ;  
*Seed v. Higgins*, 8 H. L. C. 565 ; *Neil-*  
*son v. Harford*, 1 Web. P. C. 370.

(*h*) L. R., 4 Ch. D. 612.



every judge is who knows anything of patent law, to support honest *bond fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent mode of construction, perhaps that is not the best term to use, but it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton v. Spiller* (i), adopted the remark that "the judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it."

In *Needham v. Johnson* (k), Lindley, L.J., said, "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but of course if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid."

In *Otto v. Linford* (l), Jessel, M.R., said, "I have heard judges say, and I have read that other judges have said, that there should be a benevolent interpretation of specifications. What does this mean? I think, as I have explained elsewhere, it means this, when the judges are convinced that there is a genuine, great, and important invention, which, as in some cases, one might almost say, produces a revolution, in a given art or manufacture, the judges are not to be astute to find defects in the specification, but on the contrary, if it is possible, consistently with the ordinary rules of construction, to put such a construction on the patent as will support it."

Lord Esher, M.R., in *Nobel's Explosive Co. v. Anderson*, said (m): "It is quite true that the Court has in this specifica-

(i) L. R., 6 Ch. D. 422.

(k) 1 P. O. R. 58.

(l) 40 L. T., p. 39.

(m) 11 P. O. R. 524; see also on

this point *Russell v. Cowley*, 1 Web. P. C. 457; 1 Cr. M. & R. 864; *Hallett v. Hague*, 2 B. & Ad. 377; *Palmer v. Wagstaffe*, 9 Exch. 494, 501; *Thomas*

tion, as in every other, to put upon it the most favourable construction which it honestly can in favour of the patentee. What does that involve? If the Court does not take care to confine the patentee's patent within its legitimate limits the Court will hold the patent to be such as would render it void. Therefore they must take care not to stretch his claim, otherwise they may by their construction make the patent void. They must not diminish the claim, limit it too tightly, or they may make his patent worthless. Then they have to come to really what is the honest business conclusion of the meaning of what is written down. That is what they have to do."

In the same case Lord Esher said (p. 523): "I am clearly of opinion that, whether the patent be a pioneer patent, or a master patent, or a patent of the first invention, or whether it be a valuable patent or a patent for the smallest thing, or whether it be a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of a patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court."

Lord Chelmsford, in *Harrison v. Anderston Foundry Co. (n)*, said: "The language should be construed according to its ordinary meaning, the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention, and if the specification is thus sufficiently intelligible it performs all that is required of it." In *Clark v. Adie (o)* it was held that the words used in the specification must be construed like the words in any other instrument, in their natural sense, according to the general purpose of the instrument in which they are found.

When two documents such as specifications are before the Court for comparison, the Court must interpret the meaning of

*v. Foxwell*, 6 Jur., N. S. 272; *Binney v. Feldtman*, Griff. P. C. at p. 50; *Cropper v. Smith*, Griff. P. C. 62; 1 P. O. R. 88; *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 307; *Edison v. Smith*, 11 P. O. R. 400.

(n) L. R., 1 App. Cas. 581.

(o) L. R., 2 App. Cas. 423; *Dudgeon v. Thompson*, L. R., 3 App. Cas. 53; *Wegmann v. Corcoran*, L. R., 13 Ch. D. 77.



the words, but the jury must say if they are identical (*p*). It is evident that, inasmuch as technical expressions are used in different trades and businesses, and that it is impossible for one person to be acquainted with every trade and every business, and every technical expression used in such trade and business, it is not necessary that the specification should be intelligible to any one, it is sufficient that it should be intelligible to a person reasonably skilled in the trade to which it particularly refers, and it must be intelligible to them without the necessity of their making new inventions of their own or additions to the specification or experiments (*q*).

The Court will receive evidence for the purpose of determining the exact sense in which the patentee made use of words and technical terms in his specification (*r*), but it will not consider what the patentee says he meant or intended, if a competent person of ordinary intelligence would on reading the specification understand the language and words in a different sense, since it is to such that the specification is addressed and upon the interpretation of such persons that it is to be construed (*s*); except as to the meaning of scientific terms or as to the working of mechanical appliances or as to what will be the result of working mechanical appliances, or for the purpose of ascertaining the state of public knowledge at the date of the patent, expert evidence is inadmissible in determining the construction of a specification (*t*).

There are numerous authorities which bear out the general rule of construction which has been laid down, viz., that a specification of an invention must be construed by the same rules and

(*p*) *Betts v. Menzies*, 10 H. L. C. 117; *Muntz v. Foster*, 2 Web. P. C. 107; *Tetley v. Easton*, Macr. P. C. 68; but see *Bush v. Fox*, 5 H. L. C. 707; *Booth v. Kennard*, 2 H. & N. 84; also *Hills v. Evans*, 31 L. J., Ch. 457.

(*q*) *R. v. Arkwright*, 1 Web. P. C. 68; but see *The Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 467; L. R., 12 App. Cas. 710; *Edison v. Holland*, 6 P. O. R. 282.

(*r*) *Elliott v. Turner*, 2 C. B. 446;

*Neilson v. Harford*, Web. P. C. 295, 313; *Hills v. Evans*, 31 L. J., Ch. 457; *British Dynamite Co. v. Krebs*, Good. P. C. 92; *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 530.

(*s*) *Kaye v. Chubb*, 4 P. O. R. 289, 302; *Edison v. Woodhouse*, 4 P. O. R. 108.

(*t*) *Gadd v. Mayor, &c., of Manchester*, 9 P. O. R. 530; *Parkinson v. Simon*, 11 P. O. R. 506.



upon the same principles that are applied to other written documents, and if, on the one hand, minute cavilling at the words of a specification is not to be allowed as against a patentee, so, on the other hand, the interpretation must not be strained in favour of a patentee.

The patentee is to be presumed not to claim things which he must have known perfectly well were not new (x), but if upon a fair construction of the specification it is clear that he has claimed such old contrivance the patent will be void upon that ground.

In *Adie v. Clark* (y) Lord Blackburn said: "When it is attempted . . . to say that inasmuch as these specifications show, or are alleged to show, that matters which upon a fair construction of the specification are claimed by the patentee, were old at the time that the patent was taken out, and were generally known to be old, therefore the specification must be so construed as not to include them; that seems to me both contrary, as far as I know, to the course of decision and contrary to principle."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture or, for that of an old principle to a new object or, for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, that, in construing the specification of a patent a decided case upon some other specification will be of very little value. We do not propose, therefore, to discuss at length the constructions which have been placed upon specifications in particular cases. The words "improvements . . . in the manner hereinafter mentioned," followed by a claim concluding with the words, "as above described," have been held to limit the claim to the particular machine described in the specification or to the particular method of carrying out the process and not to include

(x) *Haworth v. Hardcastle*, 1 Web. 85; *Lyon v. Goddard*, 10 P. O. R. P. C. 484; *Oxley v. Holden*, 8 C. B., 133.  
N. S. 666; *Cropper v. Smith*, 1 P. O. R. (y) L. R., 2 App. Cas. 423, 437.

the principle of the process or any other method than that described of carrying it out (z).

In the case of *Hills v. London Gaslight Co.* (a), it was held, that where the meaning of a document depends upon its terms and not on matters of fact, dehors the document, the question will be for the judge, even although the terms are technical or scientific; and where an ambiguity is raised by evidence, dehors the document, which is plain upon the face of it, the ambiguity being as to a term which imports one thing in a scientific sense, and another in a commercial sense—Query, whether it is for the judge or the jury. We should venture to say, that it would undoubtedly be for the jury. The question not being one at all as to the construction of the document, but being as a matter of fact, did the writer of the specification use the scientific term or the commercial term? A specification is to be construed with reference to the state of knowledge at the time it is published (b).

In the construction of a specification, as in the construction of any other document, the Court will read the whole and endeavour to place an interpretation upon it which will be consistent with each part (c), and further, the Court will even look at the provisional specification for the purpose of ascertaining the real object of the invention disclosed in the complete; “for the object of the complete is to carry out in detail that which is more generally expressed in the provisional specification (d).”

The claims in specifications frequently claim the invention in a general manner with the words added “as herein described.” It has been held that the meaning of the words “as herein described” is not limited where the invention is for a mode of

(z) *Barber v. Grace*, 1 Exch. 339; *The Plating Co. v. Farquharson*, Griff. P. C. 187.

(a) 27 L. J., Exch. 60.

(b) *Heath v. Unwin*, 22 L. J., C. P. 7; *The Badische Anilin und Soda Fabrik v. Levinstein*, L. R., 12 App. Cas. 710, 4 P. O. R. 449; *Ellington v. Clark*, 5 P. O. R. 325; *British Dynamite Co. v. Krebs*, Goodeves P. C. 91;

*Nobel's Explosive Co. v. Anderson*, 11 P. O. R. 519, 523.

(c) *Newton v. Vaucher*, 6 Exch. 864; *Oxley v. Holden*, 8 C. B., N. S. 666; *Lister v. Norton*, 3 P. O. R. 203; *Edison v. Woodhouse*, 4 P. O. R. 107; *Parkinson v. Simon*, 11 P. O. R. 493, 507.

(d) Per Lord Esher, M.R., in *Parkinson v. Simon*, 11 P. O. R. 503.



construction or manufacture, and not for a particular method of carrying out the principle which is described in the specification. In *Betts v. Mensies* (c) Mr. Justice Blackburn, giving his opinion to the House of Lords, said, "I agree with what was said by Mr. Justice Crompton in the Court below that, if a general claim for the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words 'as herein described,' it will be a narrow rule of construction, generally working to the detriment of patentees, and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended or those reading them understand."

Another rule of construction is that the Court must give an effective meaning to every part of it, if it can.

Lord Esher, M.R., in *Parkinson v. Simon* said: "Now when you find a patent with several claims in it, you must, if you can, so construe those claims as to give an effective meaning to each of them. If there are several claims in the patent which are identical with each other, then some of them have no effect at all. It follows from the ordinary rule of construction that you must construe the different claims so as to make them effective if possible, to be different from each other in some respects, or else they are not effective (f)."

When a specification has once received a judicial construction the Court, in a subsequent action in respect of the same invention, will hold itself bound on that point by such previous decision (g), but fresh evidence may be adduced at the second action for the purpose of showing that that which before was not regarded as an anticipation, is so in fact (h).

In *Arkwright v. Nightingale* (i), Lord Loughborough, in charging the jury, said: "The clearness of the specification must be according to the subject-matter of it; it is addressed to the

(c) 10 H. L. C. 140.

(f) *Parkinson v. Simon*, 11 P. O. R. 502.

(g) *Edison v. Holland*, 6 P. O. R. 243, 276; *The Automatic Weighing Machine Co. v. Combined Weighing*

*Machine Co.*, 6 P. O. R. 367, 370.

(h) *Shaw v. Day*, 11 P. O. R. 189; see also *Edison v. Holland*, 6 P. O. R. 243, 277.

(i) 1 Web. P. C. 61.



persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." And in *Hornblower v. Boulton* (k), to which we have previously referred, Mr. Justice Grose said: "If the specification be such as to enable artists to adopt the invention and to make the manufacture, it is sufficient."

In *Harmar v. Playne* (l), Lord Ellenborough graphically puts it: "No sort of specification would probably enable a ploughman utterly ignorant of the art to make a watch." But it is necessary that the specification should be in such terms as to enable persons of ordinary ability to understand it, and it will not be sufficient to show that one individual of extraordinary ability or of very exceptional technical knowledge is enabled to understand the specification (m). In *Neilson v. Harford* (n), Baron Parke puts it to the jury: "You are not to ask yourselves the question whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr. Farey, whether they would do it, because generally these persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification is supposed to be addressed: it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary capacity, to the subject (o)."

Lord Justice Lindley, in *Edison v. Holland*, said (p): "In complying with the first condition, i.e., in describing the nature

(k) Dav. P. C. 228.

(l) Dav. P. C. 318.

(m) *Sturtz v. De La Rue*, 5 Russ. 327.

(n) 1 Web. P. C. 314.

(o) See also *Morgan v. Seaward*, 2 M. & W. 544; 1 Web. P. C. 167; 6 L. J., Ex. 153; *Gibson v. Brand*, 1 Web. P. C. 627; *Wallington v. Dale*, 7 Exch. 888; 23 L. J., Exch. 49; *Plimpton v. Mulcolmsen*, L. R., 3 Ch. D.

568; *Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 449; L. R., 12 App. Cas. 710; *Edison v. Woodhouse*, 4 P. O. R. 79; *Bray v. Gardner*, 4 P. O. R. 406; *Miller v. Scarle*, 10 P. O. R. 111.

(p) 6 P. O. R. 280; see also *Arkwright v. Nightingale*, 1 Web. P. C. 60; *Beard v. Egerton*, 8 C. B. 165, 206; *Otto v. Linford*, 46 L. T., N. S. 35, 40.

of his invention, the patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonable competent knowledge of the subject, although from want of skill they could not themselves practically carry out the invention. In complying with the second condition, i.e., in describing in what manner the invention is to be performed, the patentee does all that is necessary if he makes it plain to persons having reasonable skill in doing such things as have to be done in order to work the patent, what they are to do in order to perform his invention."

In the case of the *Badische Anilin Fabrik v. Levinstein* (q), the patentee claimed, "First, the production of red and brown colouring matters, which in chemical language may be termed the sulpho acids of oxyazo-naphthaline by the action of the diazo compounds, which may be prepared from naphthylamine or from the sulpho acids of naphthylamine upon any of the isomeric naphthols, or of mixtures of the same, or upon any of the sulpho acids which may be prepared from either alpha naphthol or from beta naphthol, or from mixtures of the same substantially by the process above described." It appeared that the patent was dated 1878; that there were two descriptions of naphthylamine, one called alpha naphthylamine and the other beta naphthylamine; that the substance alpha naphthylamine had been known for a considerable period of time, but that beta naphthylamine had only been discovered in 1876; that at the date of the patent beta naphthylamine was very little known and very rare; that up to the year 1880 it was only used in laboratory experiments and that it was very costly; and that until beta naphthylamine was known, the alpha compound only was known and was called naphthylamine. Objection, that it was not stated what naphthylamine it was intended to be used. Pearson, J., said (r): "I come to the conclusion that the word 'naphthylamine' in the patent means that which was generally known in the year 1878 as naphthylamine, namely, what is now described as alpha naphthylamine . . . although beta naphthylamine was invented in 1876 and would at once be called

(q) L. R., 24 Ch. D. 156.

(r) At p. 161.



beta naphthylamino to distinguish it from the naphthylamino which had been known for at least fifteen years before, it does not follow that that naphthylamino would all of a sudden acquire the name of alpha naphthylamino; it would remain in all the books printed up to that time as naphthylamino only, and I am satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamino simply, would have been supplied with the old naphthylamino, and nobody would have thought of asking him whether he wanted 'beta naphthylamine.' Under these circumstances I think it would be improper to come to the conclusion that any naphthylamino was meant in this patent except that which was known simply as 'naphthylamine,' that is, that which is now properly described as 'alpha naphthylamine.' "

In the Court of Appeal (s), Baggallay, L.J., differing from Fry and Bowen, L.JJ., said: " If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure, and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiff's case in the present action whether the language had been adopted *per incuriam* or of set design. Though the term 'the literature' has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes—those addressed to the scientific world, and those addressed to working or practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. Odling, who being asked by Pearson, J., when the body, as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows: ' My Lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature, and in the technical literature it is called naphthylamine up to the present day, but in the more scientific literature you may

(s) L. R., 29 Ch. D. 366, 370, 384.



find the distinction although it is very rare.' The distinction between the information given by scientific literature and that given by technical literature is one very important to be borne in mind when we are dealing with questions such as that now under consideration. Publications having reference to chemical science and intelligibly expressed will always be enquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds, with a view of putting them to some useful purpose; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained."

In the House of Lords, Lord Herschell, upon the same point, said (*t*), "I am satisfied that after 1875 and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as 'naphthylamine,' and that if anyone had ordered 'naphthylamine' of a manufacturer, he would without hesitation have supplied alpha naphthylamine. Under these circumstances, I entertain no doubt that any reader of the specification would understand by the word 'naphthylamine' occurring in it, the known commercial article, which, until recently at all events, had always borne that name, and not beta naphthylamine, to which the term 'naphthylamine' alone had never been applied. I am, therefore, of opinion that the specification is not in this respect open to the charge of ambiguity."

If in the process of the invention it is necessary to use some old or well-known apparatus, it is not necessary in the specification to describe the apparatus, save in such terms as it is generally known by, in the particular business to which it belongs (*u*).

In *Heath v. Unwin* (*x*), Baron Alderson said: "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention; thus, if a particular mechanical process is specified, and there are for some parts of it, as specified, other

(*t*) L. R., 12 App. Cas., at p. 723.

P. C. 676.

(*u*) *Crossley v. Beverley*, 3 C. & P. 513; *Houshill Co. v. Neilson*, 1 Web.

(*x*) 2 Web. P. C. 245

well-known mechanical equivalents, the specification in those parts is in truth the specification of the well-known equivalent also, to those to whose general knowledge we refer: viz., mechanics and readers of specifications; and so it is with chemical equivalents also, in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification, but must be expressly stated there."

An error in a specification which may be said, in a sense, to be a technical error, will not vitiate a specification, although it be an error in description, provided it be such an error that an ordinary skilled workman would at once observe and be in a position to correct; provided it is not such an error as would require experiments to show that it was an error (*y*).

In *Edison and Swan Electric Light Co. v. Woodhouse* (*z*), Lindley, L.J. said: "The next objection that requires notice is, that it is contended that the evidence shows that it is essential to success to increase the temperature gradually, and that the specification is insufficient because it does not point this out. Now the evidence certainly shows that the maintenance of a high temperature is that which distinguishes Cheesebrough's process from Despretz's experiment, and although Professor Dewar points out the importance of a gradually increasing current, neither he nor any other witness says that the temperature ought to be low to begin with, and be gradually raised. Their evidence only comes to this: that the temperature must be kept up and the electric current must be increased, or the temperature will fall. But the patentee himself tells you this. He says that the temperature must be as high as 7,000° F., and the sentence in the specification, 'as the carbon increases in size more current is required to maintain the temperature,' is shown by the evidence

(*y*) Per Lord Westbury, *Simpson v. Holliday*, 13 W. R. 578; see also *R. v. Metcalf*, 2 Stark. R. 249; *Bainbridge v. Wigley*, Parl. Rep. 197; *Morgan v. Seaward*, 1 Web. P. C. 174; *Otto v. Linford*, 46 L. T., N. S. 40; *Badische Anilin und Soda Fabrik v. Levinstein*,

4 P. O. R. 467; *Miller v. Clyde Bridge Steel Co.*, 8 P. O. R. 201; *Hopkinson v. St. James & Pall Mall Electric Light Co.*, 10 P. O. R. 61; *Miller v. Scarle*, 10 P. O. R. 106, 111.

(*z*) Griff. P. C. at p. 95.



to be useless, and an obvious truism to those who understand the subject, unless the sentence is understood to be a direction to keep up the temperature; and when we find that in fact no difficulty is experienced by reason of defective instructions on this point, the Court cannot hold as a matter of law that the specification is not sufficiently explicit. If the defendants had shown that the directions as to temperature were not practically sufficient to enable a competent person to make the patented articles, the case would be very different; but they have not attempted to do this; they rely on the words used, and on the evidence as to temperature already alluded to. This, in our opinion, is not sufficient for their purpose. If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that, as regards clearness of description, the specification is in point of law sufficient."

In *Plimpton v. Malcolmson* (a), Sir George Jessel said: "It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it; but there are various kinds of people who know something about it, if it is a mechanical invention, as this is; you have, first of all, scientific mechanics of the first class, eminent engineers; then you have scientific mechanics of the second class, managers of great manufactories, great employers of labour, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and still more from

(a) L. R., 3 Ch. D. 568.



imperfect description, and would be able to supplement so as to succeed even from a defective description, and, even more than that, would be able to correct an erroneous description—that is what I would say of the two first classes, which I would call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description. Now, as I understand it, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law.” This judgment very precisely lays down the law upon the subject of intelligibility generally.

The next question, as to what is a sufficient specification, is by far the most important branch of the subject.

We have seen that part of the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently for a specification to be sufficient it must particularly ascertain—(1) What the invention itself is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he has invented, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, “This is old and I do not claim it as a part of my invention.” There are two reasons why the inventor should be called upon to particularly state what he has invented; one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In *Macfarlane v. Price* (b), Lord Ellenborough said: “The patentee in his specification ought to inform the person who consults it what is new and what is old; he should

(b) 1 Web. P. C. 74.

say, 'my improvement consists in this . . . .' A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." And the same judge, in *Harmar v. Playne* (c), maintained the same opinion.

In the case of *Holmes v. London and North-Western Railway* (d), A. obtained a patent for an improved turning-table for railway purposes, and in his specification gave a description of the machinery, of which no part was new except certain suspending rods; the combination, however, was both new and useful. In the specification the patentee claimed as his invention "An improved turning table hereinbefore described, such my invention being, to the best of my knowledge and belief, entirely new." It was held, that no construction of the claim could be put upon it as including a combination of the various parts which were old, but that it must be construed as meaning that the patentee claimed the several parts of the invention as being new, and the combination being the only part which was new, the patent was held void.

Where a patent is for a combination of old or new parts, or for an improved arrangement of old mechanism, the specification need not discriminate between the new and old parts of such combination or improved apparatus (e) unless any of those subordinate parts are specifically claimed (f). Since it is the new combination or improvement alone that constitutes the novelty and merit of the invention, but it is necessary for the patentee to particularly ascertain and define what his improvement consists of, or what are the exact parts of his new combination, so that any person of ordinary knowledge of the subject may be able at once, on reading the specification, to perceive the invention and the manner in which it is to be performed.

In *Foxwell v. Bostock* (g), Lord Westbury, L.C., said: "I must therefore lay down the rule, which is consistent with and in

(c) Dav. P. C. 311; see also *Carpenter v. Smith*, 1 Web. P. C. 532; *Tetley v. Easton*, 2 E. & B. 968.

(d) 22 L. J., C. P. 57.

(e) *Kaye v. Chubb*, 5 P. O. R. 649; *Walling v. Stevens*, 3 P. O. R. 41; *Moore v. Bennett*, 1 P. O. R. 129, 143;

*Kelly v. Heathman*, 7 P. O. R. 348.

(f) *Lister v. Leather*, 8 El. & Bl. 1004; *Harrison v. Anderston Foundry Co.*, L. R., 1 App. Cas. 578; *Rowcliffe v. Morris*, 3 P. O. R. 23.

(g) 4 De G. J. & S. 298, 313; see also *Rowcliffe v. Morris*, 3 P. O. R. 23.



reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty otherwise, and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination."

Sir W. M. James, V.C., while commenting upon this case in his judgment in *Parkes v. Stevens* (*h*), said: "It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy."

The degree of sufficiency which is required by the law is very aptly and accurately put by Eyre, C.J., in *Boulton v. Bull* (*i*): "Suppose a newly-invented chemical process and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary that, in order to carry out this operation, the gold should be put in a crucible, and should be melted in that crucible, but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold in a state of fusion was to be performed. These are mere incidents, with which every man acquainted with the subject is familiar." In taking this distinction as a guide, however, we must be careful to remember that could it be shown that the chemical process would only be successful when the gold was melted in a particular kind of crucible, or at a particular temperature, that then, unless the description was given of the temperature and of the crucible, the specification would be insufficient.

In *Turner v. Winter* (*k*), Ashurst, J., said: "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary

(*h*) L. R., 8 Eq. 365; see also *Harrison v. Anderston Foundry Co.*, L. R., 1 App. Cas. 574, 578; *Moore v. Bennett*, 1 P. O. R. 129, 143; *Philpot v. Hanbury*, 2 P. O. R. 33.

(*i*) 2 H. Bl. 498; see also *Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 469.

(*k*) 1 Web. P. C. 80; see also *Gibson v. Brand*, 1 Web. P. C. 627.



ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void."

If a patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad.

In *Crompton v. Ibbotson* (l), the specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of any suitable material, but I prefer it to be made of linen warp and woollen weft." It appeared that the plaintiff had tried several things but was unable to discover anything that would answer the purpose with the exception of the material which he said "he preferred." Lord Tenterden held that the specification was misleading, and therefore bad.

Jessel, M.R., in *Plimpton v. Malcolmson* (m), said: "You must not give people mechanical problems and call them specifications."

In *R. v. Wheeler* (n), Abbott, C.J., said: "A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad."

But where the ambiguity is of such a character that it would be cleared up by a workman of ordinary ability and information in his trade, such ambiguity will not avoid the patent (o).

Lindley, L.J., in *Edison v. Holland* (p), in his judgment in the Court of Appeal, said: "I feel the great difficulty of

(l) D. & L. 33; see also *Savory v. Price*, 1 Web. P. C. 83; *Lewis v. Marling*, 1 Web. P. C. 493; *Hastings v. Brown*, 22 L. J., Q. B. 161; *Wegmann v. Corcoran*, L. R., 13 Ch. D. 65.

(m) L. R., 3 Ch. D. 576.

(n) 2 B. & Ald. 354; see also *Stevens v. Keating*, 2 Exch. R. 778; *British Dynamite Co. v. Krebs*, Good. P. C. 90; *Wegmann v. Corcoran*, L. R., 13 Ch. D. 65.

(o) *Morgan v. Seaward*, 1 Web. P. C. 176; *British Dynamite Co. v. Krebs*, Good. P. C. 93; *Edison v. Woodhouse*, 4 P. O. R. 107, 108; *Badische Anilin*

*und Soda Fabrik v. Levinstein*, 4 P. O. R. 463; *Thomson v. Batty*, 6 P. O. R. 84, 97; *Lifeboat Co. v. Chambers*, 8 P. O. R. 421; *Miller v. Clyde Bridge Steel Co.*, 8 P. O. R. 201; *Hopkinson v. Pall Mall Electric Light Co.*, 10 P. O. R. 61; *Miller v. Scarle*, 10 P. O. R. 111.

(p) 6 P. O. R. 282; see also *Macnamara v. Hulse*, 2 Web. P. C. 128, n.; *Otto v. Linford*, 46 L. T., N. S. 85; *Simpson v. Holliday*, L. R., 1 H. L. 315; *Plimpton v. Malcolmson*, L. R., 3 Ch. D. 531.

describing in words the distinction between an amount of practice, without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention without which failure is certain, and the necessity for which destroys a patent. The test, however, by which to decide such a question is, I think, to be found by asking whether anything new has to be found out by a person of reasonably competent skill, in order to succeed, if he follows the directions contained in the specification. If yes, the patent is bad; if no, it is good so far as this point is concerned."

There is a head note to the case of *Betts v. Neilson* (q), which is apt to mislead; it runs as follows: "Whether a specification contains a sufficient description can only be ascertained by experiments, and in making an experiment knowledge and means may be employed which have been acquired since the date of the patent." It is evident that this head-note is incorrect, and if the case be read it will be found that the judgment of Lord Chelmsford was, not that the specification of the plaintiff could be held sufficient or insufficient upon experiments tried on the specification itself, with the assistance of subsequently-acquired knowledge, but that the specification, which was alleged to anticipate the plaintiff's patent, might be read for the purpose of determining whether there was anticipation or not, or whether there had been prior publication or not in the light of knowledge acquired by the general public since the date of the specification. This would be undoubtedly correct, because the question always is, in dealing with matters of prior publication, Was the supposed invention of the plaintiff's, at the time when he obtained his patent, already part of the public stock of knowledge or not? The public stock of knowledge consisted of the specification, which is put forth as anticipating the patent, together with all knowledge on the subject which can be proved to have been published or used prior to the date of the plaintiff's patent, and so in reading a specification with a view to ascertaining whether it anticipates a subsequent patent you must read into that specification all subsequently-acquired knowledge of the subject prior

(q) L. R., 3 Ch. 429.



to the date of the patent ; but in discussing the sufficiency of the specification which is actually in dispute, you cannot make use of information which has been acquired since the publication, for otherwise it would be held that the patent, which was void at first for insufficiency of specification, might become valid at some subsequent date by further discovery, which is obviously absurd.

So if a patentee says that there are many modes of doing a thing, when, in fact, only one will do, this will also avoid the patent (*r*), though the distinction must be noted between a claim of something useless and a merely false and inaccurate description of a method, which will not always avoid a patent. In *Lewis v. Marling*, Lord Tenterden said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void ; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful" (*s*).

The object of the patent is to benefit the world, and not to obstruct a subsequent invention ; consequently, if the specification is worded in such a manner as to grasp at more than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*t*).

The question of the sufficiency of a specification is one which must be dealt with on each particular case as it arises ; a single word added to a specification may make that which was insufficient sufficient, and that which would be a sufficient description of one invention would be found to be an insufficient description of another, consequently there can be no absolutely fixed rules of construction in dealing with specifications.

In *Wegmann v. Corcoran* (*u*) it was held that the specification of a patent was bad if one of the materials to be used was

(*r*) Per Bailey, J., in *Lewis v. Marling*, 1 Web. P. C. 496 ; see also *Beard v. Egerton*, 19 L. J., C. P. 40 ; *Kurtz v. Spence*, 5 P. O. R. 184 ; *Pether v. Shaw*, 10 P. O. R. 297.

(*s*) 10 B. & C. 25 ; see also *R. v.*

*Cutler*, 14 Q. B. 372, n. ; Macr. P. C. 124 ; *Neilson v. Harford*, 8 M. & W. 806 ; 1 Web. P. C. 295, 313, 371.

(*t*) *Crossley v. Potter*, Macr. P. C. 245.

(*u*) L. R., 18 Ch. D. 65.



described by a generic comprising a variety of species, the majority of which would be unsuitable. The specification of a patent is bad if a skilled mechanic would not, without performing a series of experiments, be able to construct the machine from the description.

The specification (x) of a machine for crushing meal, described the rollers as "to have a surface consisting of material containing so much silica as not to colour the meal or flour. I prefer to make them of iron, coated with china, and finally turned with diamond tools;" and the claim was, *inter alia*, for the use of material "of the hardness required." It appeared that the rollers must be made of very hard china, such as had scarcely been made in Europe during this century, and specially tough, and must be fixed in a peculiar manner to an iron core or spindle, which carried them; and, according to the evidence, a miller or a skilled mechanic would not, without making a series of experiments, discover of what china the rollers must be made, or how they must be fixed to the spindle. Held by the Court of Appeal, confirming the judgment of Fry, J., that the specification was insufficient and the patent invalid. Fry, J., had said: "Though the grantee of a patent for an invention communicated to him by a foreign resident abroad is only bound to tell the public what he himself knows, yet if the original inventor has not told him enough to enable him so to describe the invention as that it could be constructed by the aid only of the specification, the patent will be invalid.

It will be seen that the last-mentioned case is distinguishable from the case of *Plimpton v. Malcolmson* (y). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

(x) *Wegmann v. Corcoran*, supra.

ment of Jessel, M.R., at p. 582.

(y) L. R., 3 Ch. D. 531. Judg-

We have seen that *bona fides* in the description of the invention is one of the essential elements of the consideration for the grant. The patentee must say not only that which is sufficient to carry out the invention, but he must say all he knows, and he must give every improvement which is within his knowledge at the time and which assists the process or manufacture. *Wood v. Zimmer* (s), decided so far back as 1815, gives a very clear idea of the law upon this branch of the subject. In this action to try the validity of Zinck's patent "for a method of making verdigris," it appeared that the method described in the specification was sufficient to make verdigris, but that Zinck had been accustomed, clandestinely, to put aquafortis into the boiler, whereby the metallic copper was dissolved more rapidly, but the verdigris produced was neither better nor cheaper than that made according to the specification. Gibbs, C.J., said: "It is said that the method described makes verdigris, and that the specification is therefore sufficient—the law is not so. A man who applies for a patent, and possesses a mode of carrying out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is prejudicial concealment and a breach of the terms which the patentee makes with the public."

In this case it must have been proved that the patentee, at the time when he obtained his letters patent and filed his specification, knew of the benefit to be derived by the use of aquafortis. It is evident that if he did not know it at the time, but discovered it subsequently during the currency of the patent, that then it would form an improvement upon his invention, and not one

(s) 1 Web. P. C. 82, n.



which he could possibly have disclosed at the time he filed his specification, and therefore there would be no *mala fides* on his part in not describing it.

The remarks of Gibbs, C.J., in *Borill v. Moore* (a), go to the same extent; and in *Crossley v. Beverley* (b), Bailey, J., said: "It is the duty of the inventor if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable him better to effect the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he had obtained before the specification." In *Morgan v. Seaward* (c), Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification: that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a *bona fides* full and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet v. Johnson* (d).

In *The Badische Anilin und Soda Fabrik v. I. venstein* the patentee in his specification described four processes whereby he could produce sulpho-acids of oxyazo-naphthaline applicable to dyeing and printing, varying in colour from brown to red. All these processes he claimed, although only one of them was proved

(a) Dav. P. C. 400.

(b) 1 Web. P. C. 117.

(c) 1 Web. P. C. 174; see also *Turner v. Winter*, 1 Web. P. C. 81;

*Sturtz v. De la Rue*, 5 Russ. 322;

*Coles v. Baylis*, 3 P. O. R. 180.

(d) 1 Web. P. C. 53; and Bull, N. P. 78.



to have any practical value, and it was argued that the patent was bad on the ground that no specific directions were disclosed how to produce that particular shade of colour; it was held by the House of Lords, reversing the decision of the Court of Appeal, that to require such discrimination was to insist upon what was really impracticable; for, in the words of Lord Halsbury, L. C., "Upon the principle contended for, each shade must not only be shown, but its excellence or popularity must be distinguished separately by the patentee. This, as it appears to me, reduces the obligation supposed to press upon the patentee to an absurdity" (e).

In *Tetley v. Easton* (f) Pollock, C. B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it;" and in *Heath v. Unwin* (g) Coleridge, C. J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and cheap one, it would be directly contrary to the good faith required from a patentee in his communication to the public."

Upon the same ground of *mala fides* it has been held, in a large number of cases, that if the patentee in his specification gives details which are not necessary to the invention, which of themselves do not constitute an invention, and which are merely put in for the purpose of misleading the public as to either what is the nature of the invention or how it is to be carried into effect, then the patent will be void. Bailey, C. J., in *Lewis v. Marling* (h), said: "If the party knew that it was unnecessary the patent would be bad, on the ground that this was deception; but if he thought it was proper, and only by a subsequent discovery finds out it is not necessary, I think that it forms no ground of objection."

(e) 4 P. O. R. 464; L. R. 12 App. Cas. 716; *Otto v. Linford*, 46 L. T., N. S. 35; *Thomson v. Batty*, 6 P. O. R. 97.

(f) Mac. P. C. 76.

(g) 2 Web. P. C. 243.

(h) 1 Web. P. C. 496.

If the extraneous matter is put into the specification, *bonâ fide* thinking that it was necessary, the patent will not be held to be void; if it was put in *malâ fide*, with the intention of deceiving, or knowing it was extraneous and useless, the patent would be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void (*i*). It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bona fides* on the part of the inventor (*k*).

We now come to that portion of the specification which is described as "the claim." By sect. 5, sub-sect. 5, of the Act of 1883, it is provided that "*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.*" This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of this Act, the necessity of the inventor making a distinct and unambiguous claim. He must not claim too much, and yet he must claim sufficient to show a useful manufacture, and he must distinguish in his claim what it is that is new in the process which he has described and what is old. So far as this goes, there is no doubt that the old law provided for similar declarations on the part of the inventor.

In *Borill v. Moore* (*l*), Gibbs, C.J., said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could be legally given to him." In the case of *Gibson v. Brand* (*m*), Tindall, C.J.,

(*i*) *Savory v. Price*, Ry. & M. 1; 1 Web. P. C. 83; *Turner v. Winter*, 1 Web. P. C. 77; 1 T. R. 602.

(*k*) *Simpson v. Holliday*, 20 Newton's Journal, N. S. 108. *Crompton v. Ibbotson*, 1 Web. P. C. 83; *Dau. & L.* 33; *Bickford v. Skewes*, 1 Web. P. C.

218; *Neilson v. Harford*, 8 M. & W. 806.

(*l*) *Dav. P. C.* 404.

(*m*) 1 Web. P. C. 634; see also *Minter v. Mower*, 6 A. & E. 735, 1 Web. P. C. 138.



said: "Looking at the specification in the case, it appears to me that this patent cannot be supported at law, because the plaintiffs have in the course of it claimed more than they are entitled to."

The Court must be taken to distinguish between describing too much and claiming too much. In the course of a well-drawn specification it is frequently necessary to describe something which is old, and if, provided the claim says that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent. But if two methods of doing a thing are described, one of which will answer and the other will not, it will be interpreted, unless one of them is specifically disclaimed, that both parts are claimed as being new and useful, and one of them not being useful the patent will be invalidated, because it is said there is a false suggestion in the specification (*n*). In *Rushton v. Crawley* (*o*), Malins, V.-C., said: "The public must be told in very distinct language in every specification what are the articles they may use and what they may not use. Therefore, if a man makes a discovery, and instead of limiting himself in his specification to that which properly is a discovery (if it be one), makes his specification too extensive, and claims more than he is entitled to claim, that is calculated to embarrass the public; that is, I apprehend, a fatal objection to the patent."

In reading specifications, one frequently comes across a claim in these words: "I claim as my invention the appliances and combinations hereinbefore described." This claim is perfectly good (*p*), provided there is nothing described in the patent which is old. If there be anything old, the claim should proceed: "I do not claim so-and-so, and so-and-so, as part of my invention."

The object of the claim is to crystallize the invention as described in the specification into one or more clauses, so as to render it quite clear what is and what is not the object of the patent. In *Kay v. Marshall* (*q*), Lord Cottenham, L.C., said:

(*n*) *Simpson v. Holliday*, 13 W. R. 578; L. R., 1 H. L. 315, per Lord Westbury, affirmed in House of Lords.

(*o*) L. R., 10 Eq. 527.

(*p*) *Serd v. Higgins*, 8 H. L. C. 550.

(*q*) 2 Web. P. C. 39; see also



“It is introduced (particularly in the case of a patent for an improvement) lest the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new.”

If the invention be for an improvement upon an old process very great care should be taken that the improvement alone is made the subject of the claim; so if it be for a combination of well-known parts, care must be taken that it be clearly shown that the patentee claims the combination, and not the parts. James, V.-C., in *Parkes v. Stephens (r)*, said: “It is obvious that a patentee does not comply as he ought to do with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy. And if a person desiring to find out what was new would have to get rid of a large portion of the specification, by eliminating from it all that was old and commonplace, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinary skilled artizan, but of a patent lawyer or agent.”

In *Gandy v. Reddaway (s)*, the claim was “constructing belts or bands for driving machinery of cotton canvas or duck ‘woven hard’ and stitched and saturated or soaked with oil, such as linseed oil or any combination thereof, as herein described or set forth, or any modification thereof.” It was proved that cotton canvas woven hard was in the trade divided into classes numbered 1—10. Of these, only 2, 3, and 4, would practically answer to carry out the invention; anyone attempting to use the other numbers would fail; certain numbers would crack if used on small pulleys. Mr. Justice Pearson dismissed the action and was affirmed by the Court of Appeal on the ground that the claim was too large. And where a patent is taken out for a combination, it is not material to its validity that the specification should point out what parts are old and what are new, though, if an

*Plimpton v. Spiller*, L. R., 6 Ch. D. 426; *Easterbrook v. Great Western Railway Co.*, 2 P. O. R. 208; *Lucas v.*

*Miller*, 2 P. O. R. 155, 159.

(r) L. R., 8 Eq. 365.

(s) 2 P. O. R. 49; *Griff. P. C.* 101.

alleged infringement consists only in taking part of the combination, it is necessary that the patentee should in his specification have claimed the part so taken as new (*t*). If the whole combination constitutes the novelty of the invention the whole combination alone should be claimed, and subject to the substitution of equivalents and evasion, there will be no infringement unless the whole combination is taken; but if there is *merit and novelty* in *subordinate integers* or *subordinate combinations* they should be specially claimed, otherwise there will be no infringement in taking them. But in the case where there is *novelty in the result* of using the whole combination, and only the whole combination is claimed, then the Court will protect the patentee from infringement by taking the essence of the combination. *Proctor v. Bennis* (*supra*).

In *Harrison v. The Anderston Foundry Co.* (*u*), it was finally held by the House of Lords that if the combination and application of old machinery be new and beneficial the invention of this combination may be protected by a patent. The specification commenced: "The invention consists of a new or improved simple and most efficient mode of and arrangement of mechanism for connecting the set or sets of compound or multiple shuttle-boxes of looms for weaving stripe, check or other ornamental or figured fabrics requiring two, three or more shuttle-boxes in each set." The specification then described in detail and by reference to drawings the arrangement of mechanism in question, and then continued: "What we believe to be novel and original, and therefore claim as the invention secured to us by letters patent, is—(1) The construction and arrangement of the parts and portion of the mechanism, and (2) a shuttle-box moving and holding mechanism as herein distinguished generally for actuating the shuttle-boxes of power-looms, all substantially in the new or improved manner herein described and shown in the drawings or any mere modification thereof." A great number of the parts of the machine were admittedly old, and one of the questions in this case was, whether the first claim above set forth was a sufficient claim to a combination. Lord Cairns, in giving judg-

(*t*) *Proctor v. Bennis*, 36 Ch. D. 740.      (*u*) L. R.; 1 App. Cas. 574.



ment, said : " It is as I read it a claim for a combination, that is to say, a combination of all the movements going to make up the whole mechanism described ; it must, for the present at least, be assumed that this combination, as a combination, is novel, that it is, to use the words of the Lord President, a new combination of old parts to produce a new result or to produce a known result in a more useful and beneficial way ; it is not doubted that a combination such as this is may be the subject of a patent. What, then, are the objections to the first claim viewed as a claim for the combination ? The first is an objection said to be founded upon the case of *Foxwell v. Bostock* (x), decided by the late Lord Westbury. It is said to be determined in that case that where there is a patent for a combination there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what the merit of the invention. I cannot think that, as applied to a patent for a combination, this is or was meant to be the effect of the decision in *Foxwell v. Bostock*. If there is a patent for a combination the combination itself is *ex necessitate* the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In the same case Lord Hatherley said : " The judges extended as it appears to me with great respect, the doctrine of *Foxwell v. Bostock* in their application of it in this case ; it was there held, and that I think was all that was held, that it is not competent to a man to take a well-known existing machine, and, having made some small improvement, to place that before the public and say, ' I have made a better machine : there is this sewing-machine invented by so-and-so, I have improved upon that. That is mine ! it is a much better machine than his ; ' that will not do ; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, ' I think it will not do if you invented the gridiron pendulum to say, I have invented a better clock than anybody else, not telling the public what you have done to make it better than any other clock which is known.' "

(x) 4 De G. J. & S. 298.



In *Moore v. Bennett* (y), Solborne, L.C., in giving judgment in the House of Lords, said: "Your lordships have not at all to consider whether in the case of *Foxwell v. Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my lords, I feel that your lordships cannot refuse to regard the decision in *Foxwell v. Bostock* in the light in which you have already explained, and interpreted, and commented upon it by your own decision in the case of *Harrison v. The Anderston Foundry Co.*, and so explained, it appears to me, to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved. . . . The case of *Foxwell v. Bostock* was qualified or explained in *Harrison v. The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and combinations, which are described, are clearly, plainly and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison v. The Anderston Foundry Co.* to hold the specification bad."

In *Clark v. Adie* (z), Lord Hatherley said, speaking of *Foxwell v. Bostock*: "You must in some way or other inform those whom you are dealing with, by which I mean the general public, who you wish to exclude for a certain limited number of years from using your invention; you must inform them in some mode or other whether you have sub-divided, if I may so term it, your machine into these separate parts and claim for each the merit of

(y) Griff. P. C. 158.

(z) L. R., 2 App. Cas. 328.

novelty, or whether you are simply making a combination of things *per se* old but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection, as a novel and useful machine."

A claim for every method of applying a principle is a claim for the principle itself and will not be supported (a).

The claim will be construed with reference to the entire patent and although at first sight there may be some appearance of obscurity in it, if it can be made clear by the consideration of the whole specification, the patent will not be thereby avoided (b).

As has been pointed out above each subordinate part of an invention must be claimed specifically in order to be protected (c), for everything that is not claimed is considered to be disclaimed, and should a man describe ten inventions in his specification and claim only one of them, he thereby presents to the public the remaining nine (d).

Comprehensive words employed in a specification cannot have the effect of extending the scope of the patent beyond that which is substantially described (e).

A claim to "The apparatus as fully set forth and described in the above specification and drawings," has been held to be a claim for the combination of the constituent parts of that apparatus (f).

The fact that one of the claims is practically a repetition of another will not vitiate a patent; in the *Wenham Gas Co. v. The Champion Gas Lamp Co.*, Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the import-

(a) *Neilson v. Harford*, 1 Web. P. C. 355.

(b) *Beard v. Egerton*, 8 C. B. 165, 215, 216; *Arnold v. Bradbury*, L. R., 6 Ch. 706, 712; *Plimpton v. Spiller*, L. R., 6 Ch. D. 427; *Nordenfelt v. Gardner*, 1 P. O. R. 61, 69; *Edison v. Woodhouse*, 4 P. O. R. 107; *Leadbeater v. Kitchen*, 7 P. O. R. 244; *Elias v. Grovesend Tin Plate Co.*, 7 P. O. R. 463; *Edison v. Smith*, 11 P. O. R. 395; *Parkinson v. Simon*, 11 P. O. R. 493, 507.

(c) *Clark v. Adie*, L. R., 2 App. Cas. 315, 321; *Cropper v. Smith*, 1 P. O. R. 87.

(d) *Harrison v. Anderston Foundry Co.*, L. R., 1 App. Cas. 580; *Hinks v. Safety Lighting Co.*, L. R., 4 Ch. D. 612.

(e) *Binney v. Feldtman*, Griff. P. C. 52; *Miller v. Clyde Bridge Steel Co.*, 9 P. O. R. 480.

(f) *Peckover v. Rowland*, 10 P. O. R. 234, 237.



ance of the perforated tube in claim 3—a repetition in fact of claim 3—I do not think it is anything more. If so, it does not vitiate the patent. It may be open to the criticism that it is redundant; but if it is nothing more than pointing out what is a valuable operation, and what has been claimed in clause 3, it does not thereby vitiate the patent” (g).

So too where one of the claims in a specification, although strictly it may be for something old, is purely subordinate to the main invention and merely amounts to a declaration of one of the merits and advantages of the contrivance disclosed in the specification, it has been held that a patent is not void on that account.

In *British Dynamite Co. v. Krebs*, the specification concluded thus: “I claim as the invention secured to me the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the modes of firing the same by special ignition as herein set forth.” Earl Cairns, L.C., after assuming that the modes of firing by special ignition, or some of them, were known before the date of the patent, said: “He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed under this patent to claim them for any other purpose. In other words, he claims in the first claim the dynamite, the substance itself, and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim and contented himself with the first. But the second being, as it seems to me, merely a claim to the user of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless” (h).

But the above must be carefully distinguished from the case of a claim for something old which, although subordinate to the main invention, tends to enlarge the scope of the patent.

In *Plimpton v. Spiller*, *supra*, Brett, L.J., said: “If this

(g) 9 P. O. R. 55.

(h) Good, P. C. 88, 93; see also per James, L. J., in *Plimpton v. Spiller*, L. R., 6 Ch. D. 427, 428; per y, J.,

in *United Telephone Co. v. Harrison*, L. R. 21 Ch. D. 741; also *Neilson v. Belts*, L. R., 5 H. L. 21.



second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and that the plaintiff could never recover" (i).

It has been decided in the House of Lords that the enactment in sect. 5 of the Act of 1883, that a complete specification must end with a distinct statement of the invention claimed is directory only, and when letters patent have been granted, they will not be invalid because it has not been complied with (k), consequently the same rules will apply in cases where no distinct claim is appended to the specification as applied before the passing of that Act. Under the old law if no claim was inserted the patentee was taken to claim everything that was described in the specification, although disclaimer was not necessary in matters which manifestly formed no part of the invention (l).

As has been noticed above, sect. 5, sub-sect. 4 of the Act of 1883, enacts that the complete specification must be accompanied by drawings if required.

Before the Act, drawings were quite optional on the part of patentee (m), and the above section opens up a question as to how far absence of drawings will now affect a patent, it is submitted that the same interpretation should be placed upon it as that which the House of Lords have placed upon sub-sect. 5 of the same section (n), although the words of sect. 2 of the Act of 1886, by which the above sub-section of the principal Act is amended—"no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification"—would seem to imply that if drawings accompanied neither the provisional nor the complete, the patent might be held to be invalid on that account.

(i) See also *British Dynamite Co. v. Krebs*, per Cairns, L. C. Good, P. C. 93; *Cropper v. Smith*, 1 P. O. R. 81, 88, 90, 91.

(k) *Vickers v. Siddell*, 7 P. O. R. 292, 303, 306; L. R. 15 App. Cas. 496, 500, 505.

(l) *Lister v. Leather*, 8 E. & B. 1004; *Tetley v. Easton*, 2 C. B., N. S. 706.

(m) *Boulton v. Bull*, Dav. P. C. 188; *In re Fox's Patent*, 1 Web. P. C. 431, n.

(n) *Vickers v. Siddell*, supra.

The drawings are for the purpose of elucidating the text, and are to be read in with the specification in order to obtain a correct interpretation (*o*), but it is doubtful if drawings can be made use of for the purpose of extending the scope of the patent beyond the obvious meaning of the words used in the letter-press (*p*).

(*o*) *Bloxam v. Elsee*, 1 Car. & P. 558; *Lawrence v. Perry*, 2 P. O. R. 180, 186; *Pickard v. Prescott*, 7 P. O. R. 865; *Miller v. Scarle*, 10 P. O. R. 111.

(*p*) *Clark v. Adie*, L. R., 2 App. Cas. 839; *Fairburn v. Household*, 8 P. O. R. 267; but see *Pickard v. Prescott*, 7 P. O. R. 865.

## CHAPTER VIII.

## APPLICATION AND ACCEPTANCE.

IN a previous chapter the question as to who is entitled to apply for a grant of letters patent has already been considered, and in the present chapter it is proposed to deal with the law and practice relating to the application for a grant, and the acceptance of the complete specification by the Comptroller.

Sect. 5 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts:—

(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; and must be left at, or sent by post to the Patent Office in the prescribed manner.*”

Applications for patents for inventions made in Great Britain and Ireland and Isle of Man must be made in Form A, for inventions communicated abroad in Form A 1, and applications for patent under International and Colonial arrangements must be in Form A 2 (a). Quaere, if the wrong form were used, would the patent be thereby invalidated. The applicant must himself sign the application, but for the purpose of all other communications with, and all other attendances upon the Comptroller he may employ an agent (b), such agent need not be a “patent agent,” but he must be an agent duly authorised to the satisfaction of the Comptroller (c). In the case of an application by two or more persons, the application must be signed by all those persons, but it is not absolutely essential that complete specification should be signed by more than one of them (d).

(a) See appendix p. 440.

(b) P. R. 1890, r. 8, p. 424, post.

(c) Ibid; see also *Graham v. Fanta*,

9 P. O. R. 164; for forms of authorisation see appendix, p. 441.

(d) *McEvoy's patent*, 7 P. O. R. 151.



A document sent to the Patent Office by post is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post, and it is sufficient to prove that the letter was properly addressed and posted (*e*).

Rules 9 and 10 of Patent Rules, 1890, contain formal regulations with regard to applications and other communications sent to or left at the Patent Office (*f*).

If a person possessed of an invention dies without having made an application for a patent, application may be made by, and a patent for the invention granted to his legal representative, but such application must be made within six months of the decease of the inventor (*g*).

*Sect. 5, sub-sect. 2 enacts: "An application must contain a declaration to the effect that the applicant is in possession of an invention, whercof 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.*

*"The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed."*

The form of such declaration and the manner in which it is to be made is regulated by Rules 17 and 17*a* of the Patent Rules, 1890. Where the inventor is incapable, by reason of infancy, lunacy, or other inability, of making any declaration or doing anything required or permitted by the Act, such declarations may be made and such things may be done on his behalf by the guardian or committee of such incapable person, or by any person appointed by the Court (*h*).

Statutory declarations made in conformity with this Act are exempt from the stamp duty of two shillings and sixpence charged on a statutory declaration made under the Statutory Declarations Act, 1835, by the Stamp Act, 1870 (*i*).

(*e*) Sect. 97 of the Act of 1883; see 20, p. 427, post.  
also P. R. 1890, r. 16, a.

(*h*) Sect. 99.

(*f*) See p. 424, post.

(*i*) 47 & 48 Vict. c. 62, sect. 9.

(*g*) Sect. 34; see also P. R. 1890, r.

Only one invention may be the subject of an application, but it is not 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 (*k*). In *Jones' Patent*, Herschell, S.-G., said (*l*):—"I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then there are six inventions. . . . You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent of the purpose of the combination, then you have got an extra invention, and it is not all one (*m*)."

In *Hearson's Application* the provisional specification intimated that the invention was applicable to "*other purposes*"; those words were struck out by the Comptroller on the ground that it amounted to more than one invention, and this decision was affirmed by the Solicitor-General (*n*).

Where a person, by inadvertence or otherwise, includes in his application more than one invention, he may, after the refusal of the Comptroller to accept such application, apply for separate patents for each of his inventions, which applications shall, if the applicant notify his desire to that effect to the Comptroller, bear the date of the first application (*o*).

The meaning of the words true and first inventor, and the requisites of provisional and complete specifications, have already been dealt with in previous chapters.

Sect. 6 of the Act of 1883 enacts that:—"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."

(*k*) 46 & 47 Vict. c. 57, sect. 33.

(*l*) Griff. P. C. 265.

(*m*) See also *Hearson's Patent*, Griff. P. C. 266; *Robinson's Patent*,

Griff. P. C. 267.

(*n*) Griff. P. C. 26

(*o*) P. R., 1890, r. 19.



Seot. 2 of the Act of 1888 repeals seot. 7 of the principal Act, and enacts that :—

(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.*”

(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.*”

The report of the examiner is not to bind the judgment of the comptroller, but merely to assist him in making his decision as to whether the application and specifications fulfil the requirements of the Act (p). It is difficult to define exactly what is the meaning of the words “ whether the nature of the invention has been fairly described,” and there is no direct decision on the point, but it is to be presumed that the duty of the comptroller and examiner does not extend to a minute criticism of specifications, but amounts in fact to deciding whether on the face of it

(p) *In re C.'s Application*, 7 P. O. R. 250.



the specification appears to be for the invention for which the application is made (q). In *Re Smith's Patent* (r), Herschell, S.-G., said:—"There is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I should only guard myself by saying this, that if the statement of the invention claimed were such as 'I claim the invention described in the specification,' that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description."

Sect. 9 expressly throws upon the comptroller the duty of deciding whether the provisional and complete specifications describe substantially the same invention, but this section can hardly mean that the comptroller must go into fine questions of construction, but must merely amount to a direction to the comptroller that an application shall not be accepted if the two specifications on the face of them describe inventions which are substantially different (s), since it is always the rule in the Patent Office and of the law officer in questions of doubt to accept an application and leave the sufficiency of the specifications and the other points that arise in that connection for the consideration of the courts, should the question ever come before them (t).

Under the provisions of sect. 86, the comptroller may refuse to grant a patent for an invention, of which the use would, in his opinion, be contrary to law or morality.

Before exercising any discretionary power adversely to the applicant, the comptroller must give him ten days' notice, so that he may be heard personally or by his agent on the point in question (i).

The subject of appeal to the law officer from decisions of the

(q) *In re C.'s Application*, 7 P. O. R. 250.

(r) Griff. P. C. 268.

(s) *In re Anderson's Patent*, 7 P. O. R. 323, 325; but see per Lindley, L.J. *Gadd v. Mayor of Manchester*, 9 P. O. R. 527; also per Lord Herschell in

*Vickers v. Siddell*, 7 P. O. R. 306.

(t) *Re Chandler's Patent*, Griff. P. C. 274; *Re Cumming's Patent*, Griff. P. C. 277; *Edmunds' Patent*, Griff. P. C. 283.

(u) Sect. 94 of the Act of 1883; see also P. R. 1890, r. 11.

comptroller will be dealt with in the chapter relating to opposition to a grant of letters patent.

Sect. 8 of the Act of 1883, as amended by the sect. 3 of the Act of 1885, enacts:—

“ (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. A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may, on payment of the prescribed fee, allow.*”

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

The nine months allowed by this section for the filing of the complete specification are calendar months (*x*), and are reckoned exclusive of the day of application (*y*), and in the event of the last day of such nine months falling on Christmas Day, Good Friday, or on a Saturday or Sunday, or on any Bank Holiday or day of public fast or thanksgiving, the specification may be filed on the day succeeding such excluded day or days (*z*).

An application for enlargement of time for leaving a complete specification must state in detail the grounds upon which such extension is applied for, and the applicant must produce such evidence in support of his application as the comptroller may require (*a*); the prescribed fee is £2 (*b*).

In the event of an application being abandoned, the specifications and drawings which were left in connection with the application are not published, nor are they at any time open to public inspection (*c*).

Sect. 9 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts:—

“ (4). *Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the applica-*

(*x*) 13 & 14 Vict. c. 21, sect. 4.

(*y*) *Russell v. Ledsam*, 14 M. & W. 574, 582; *Williams v. Nash*, 28 Beav. 98; 1859, 5 Jur. N. S. 696.

(*z*) Sect. 98 of the Act of 1883; see

also P. R. 1890, r. 7.

(*a*) P. R. 1890, rr. 50, 51.

(*b*) P. R. 1892; schedule of fees.

(*c*) 48 & 49 Vict. c. 62, s. 4; see ante, Chap. V., p. 65.



tion shall, at the expiration of those twelve months, become void. A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may, on payment of the prescribed fee, allow" (d).

"(5) Reports of examiners shall not in any case be published or be 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."

Sect. 10 of the principal Act enacts:—

"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."

The advertisements are published in the *Illustrated Official Journal*, which is issued every Wednesday (e).

Sect. 14 enacts:—"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 exists for the purpose of enabling an inventor to work at and improve his invention without thereby avoiding the patent subsequently granted to him on the ground of want of novelty (f); it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot bring an action in respect of any infringement committed before the publication of his complete specification (g), and further he may not style the invention which is provisionally protected as "patent," but he may make use of such words as "patent applied for" (h).

(d) See schedule of fees, Appendix p. 453, post.

(e) P. R. 1890, rr. 21 & 22.

(f) Per Earl Cairns, L.C., in *In re Dering's Patent*, L. R. 13 Ch. D. 395.

(g) Sect. 13 of the Act of 1883.

(h) Sect. 105; see *R. v. Wallis*, 3 P. O. R. 1; *R. v. Crampton*, 3 P. O. R. 367.



“The phrase ‘to be granted for the same’ obviously means in this section . . . for the same invention, and cannot be construed as referring to the application or petition” (i).

Sect. 15 enacts:—“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 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.”

The effect of sects. 13, 14, and 15 is that no proceedings for infringement may be taken before the patent is sealed, after which time proceedings can only be taken with reference to infringements committed after the acceptance and publication of the complete specification.

It has been mentioned above that an inventor may not use the word “patent” with reference to the subject of his invention until his patent is sealed, but it is no offence under the Act to continue to use the word “patent” after the period of protection has expired (k), unless such representation amounts to a suggestion that it is an existing patent.

In *Cheavin v. Walker* (l) the plaintiff’s filters bore a tablet which consisted of the words “G. Cheavin’s Improved Patent Gold Medal Self-cleaning Rapid Water Filter, Boston, England,” above which was a medallion containing the Royal Arms, surrounded by the words “By Her Majesty’s Royal Letters Patent.” This was held to amount to a representation that the filter was the subject of an existing patent, and disentitled the plaintiff to relief.

The effect of the provisions of the Patents, &c., Acts to prevent fraudulent applications, and also of those for the protection of foreign inventors, has already been discussed in an earlier chapter (m).

(i) Per Chitty, J. in *Lister v. Norman*, 3 P. O. R. 207.

(k) *Cheavin v. Walker*, L. R. 5 Ch. D. 850, 862.

(l) L. R. 5 Ch. D. 850, 863, 864; see also *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. Cas. 523.

(m) See Cap. III., ante.

## CHAPTER IX.

## OPPOSITION.

SECTION 10 of the Act of 1883 provides that upon acceptance of the complete specification, but before sealing the patent, the comptroller shall advertise the acceptance, and that then the application and specifications, with the drawings, if any, shall be open to public inspection.

Section 11, as amended by the Patents, &c., Act, 1888, is as follows:—(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 to 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.*”

Prior to the passing of this Act any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda (a)*), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent (b)*), but it was always considered necessary

(a) Hindmarch, at page 534.

Ch. 456; 4 W. R. 473.

(b) 6 Do G., M. & G. 420; 25 L. J.,

that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent* (c), and also *In re Vincent's Patent* (d)). If there was any doubt the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial. These two latter cases indicate the course the law officer should take, where the ground of opposition is an allegation that the applicant has obtained the invention from the opposing party. Such a question might very frequently raise questions of fact of great delicacy, and the question of the credibility of witnesses. Such questions should be left for trial in open court, more particularly as it will be observed that any such opposing party has an ample and unfettered remedy by petition to revoke the patent under sect. 26. In *Edmunds' Patent* (e), Sir R. Webster, A.-G., said:—"I am clearly of opinion that under the circumstances the comptroller-general was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas if the patent is sealed the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings."

In *In re Stuart's Application* (f), Sir E. Clarke, S.-G., said: "I think that the law officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence."

Under sect. 11, sub-sect. 1, there are three grounds upon which a grant of letters patent may be opposed and three only, and provided that the opponent relies upon one or other of these three grounds it does not appear upon the face of that sub-section that the C. G. has any jurisdiction to inquire into the question as to the right or title of the opponent to be heard in opposition,

(c) 14 W. R. 551.

(d) L. R., 2 Ch. 341.

(e) Griff. F. C. at page 233; see

also *Fletcher's Patent*, Griff. F. C. 284;

*In re Todd*, 9 P. O. E. 488.

(f) 9 P. O. R. 452.



although in *In re Bell (g)*, the C. G. refused to hear the opponent on that ground.

The notice of opposition must state the grounds upon which the opponent intends to oppose the grant and must be signed by him (*h*); a copy of such notice is delivered by the comptroller to the applicant (*i*). Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification, the opponent may file statutory declarations in support of his opposition, and must deliver to the applicant a list thereof (*k*); within 14 days from the delivery of such list the applicant may leave statutory declarations in reply, a list of which must be sent to the opponent; the opponent may leave further declarations at the Patent Office, a list of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply (*l*). No further evidence may be left on either side except by leave of the comptroller (*m*).

In the case of an opposition upon the first ground, it frequently happens that the law officer is of opinion that both the applicant and the opponent contributed materially to the invention. In such case terms will be imposed giving both parties an interest in the patent (*n*).

In *David and Wodley (o)*, upon the question of workman and master, Sir H. Davey said:—"I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them."

The words "obtained the invention" do not necessarily imply that the person from whom the invention had been obtained had

(*g*) Griff. L. O. C. 10.

(*h*) P. R. 1890, r. 34.

(*i*) Rule 35.

(*k*) Rule 37.

(*l*) Rule 38.

(*m*) Rule 39.

(*n*) *Russell's Patent*, Good, P. C.

589; *Luke's Patent*, Griff. P. C. 294; *Re Hatfield*, Griff. P. C. 288; *Re Eadie*, Griff. P. C. 279; *Evans v. Otway*, Griff. P. C. 279; *Re Garthwaite*, Griff. P. C. 284.

(*o*) Griff. L. O. C. 26; see also *Re Heald*, 8 P. O. R. 429.

taken out or even intended to take out a patent for it; it refers to the identity of the invention, not the right of the person from whom it was obtained to be regarded as the first and true inventor (*p*).

Where it appeared that a part of the subject of the application had been obtained from the opponent, the law officer struck out that portion and allowed the remainder to go on (*q*).

In *In re Edmunds* (*r*), the comptroller was of opinion that the words "legal representative" in sect. 11 meant the executor or administrator of a deceased person and would not include a person holding a power of attorney.

In the case of inventions communicated from abroad neither the comptroller nor the law officer will enquire into what happened outside the United Kingdom, the importer is the true and first inventor, and the means by which he may have obtained the invention are of no importance and will not be considered since the merit of the invention consists in its importation into this country (*s*).

The other two grounds of opposition are such as can readily be proved or disproved, hence the power of the law officer can be exercised with less prejudice to the interests of justice. In *Cummings' Patent* (*t*), Sir Henry James, although of opinion that the applicant's invention and that which formed the ground of opposition were very nearly the same, thought there was just sufficient difference (although a very slight difference) to justify him in affirming the comptroller-general's decision. He felt, too, that if he refused a patent his decision would be final. It will make no difference in the exercise of the discretion of the law officer, upon the report of the comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, that the validity of the first patent is in dispute (*u*).

(*p*) *Re Thwaites' Application*, 9 P. O. R. 515.

(*q*) *Re Thwaites' Application*, 9 P. O. R. 515.

(*r*) Griff. P. C. 281; see also *Re Adolph Spiel*, 5 P. O. R. 282.

(*s*) *Re Edmunds*, Griff. P. C. 281;

*Re Lake*, 5 P. O. R. 415; *Re Higgins*, 9 P. O. R. 74.

(*t*) Griff. P. C. 277; see also *Jones' Patent*, Griff. L. O. C. 33.

(*u*) *In re Mancaux's Patent*, L. R. 6 Ch. 272.

“On the ground that the invention has been patented in this country” will not give a *locus standi* for opposition where only provisional protection has been granted for the previous invention (x); but it is otherwise where the opponent has brought himself within the terms of sect. 15 (y). If the invention, the subject-matter of applicant’s specification, is fully described in the specification relied on in opposition, the patent will not be allowed to go, notwithstanding that it is not made the subject of claim in the opposing specification (z).

In *Stubbs’ Patent* (a), Sir R. Webster said:—“As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course I need not remind you that stopping a patent is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical. . . . I shall, as a rule, allow costs to follow the event.”

In *Re Lorrain* (b), Sir R. Webster, A.-G., said: “By allowing a specification in any particular form no harm is done to persons who have a prior patent; but, on the other hand, the law officer is bound to protect the public so that they may not be misled by any specification which, upon the face of it, might be held to have a wider scope or include a wider kind of invention than that to which the patentee is, on the evidence, entitled. The patentee of the later patent frames his specification at his peril.”

Where it appears to the C. G. or law officer that the applicant’s specification is too general and calculated to deceive the public, or appears to overlap the invention of the opponent, the patent will only be granted on condition of the

(x) *Bailey’s Patent*, Griff. P. C. 269; *Dundon’s Patent*, Griff. P. C. 278.

(y) *L’Oiseau and Pierrard*, Griff. L. O. C. 36.

(z) *Von Buch’s Application*, Griff. L. O. C. 40.

(a) *Re Stubbs*, Griff. P. C. 298; see

also *Re Todd*, 9 P. O. R. 487; *Re Tattersall*, 9 P. O. R. 150; *Re Griffin*, 6 P. O. R. 296; *Re Cumming*, Griff. P. C. 277.

(b) 5 P. O. R. 142; see also *Re Guest & Barrow*, 5 P. O. R. 313.



insertion of a disclaiming clause ; such clause may be general or special, that is, either a general reference to common knowledge or a special reference to the opponent's specification.

Sir R. Webster, in *Re Stell's Patent* (c), said : "The principles upon which the law officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent ; and secondly, if it is clear that the public would be misled by the later specification without disclaimer."

The law officer is always reluctant to allow the insertion of special disclaimers, as disclaimers are considered to be made in the interest of the public, and are inserted on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (d).

Sir R. Webster, A.-G., in *Re Guest & Barrow* (e), said : "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned." In *re Welch's Patent* (f), Sir R. Webster said : "I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was, for the first time, discovered or disclosed in the opponent's specification."

In an opposition on the second ground the law officer will take into consideration the question of mechanical equivalents in comparing the applicant's specification with the specification relied upon by the opponent (g), but he will not consider the question of disconformity between the opponent's provisional and complete specifications (h).

(c) 8 P. O. R. 236 ; see also *Re Guest & Barrow*, 5 P. O. R. 313.

(d) Per Sir R. Webster, in *Re Guest & Barrow*, 5 P. O. R. 315 ; see also *Re Siclaff*, 5 P. O. R. 484 ; *Re Hill*, 5 P. O. R. 599.

(e) 5 P. O. R. 315 ; see also *Re*

*Tattersall's Patent*, 9 P. O. R. 150, 152 ; *Re Hoffman*, 7 P. O. R. 92.

(f) 8 P. O. R. 443.

(g) *Re Haythornthwaite*, 7 P. O. R. 70.

(h) *Ibid.*

The law officer will not allow the question of fraud to be raised for the first time upon appeal (i).

Where the opponent's complete specification was filed between the dates of the filing by the applicant of his provisional and complete specifications, the opponent will not succeed in his opposition unless his complete specification was clearly foreshadowed by his provisional and the invention described thereby, identical with that described in the complete specification of the applicant (k).

Under this section it will make no difference whether the patent upon which the opposition is founded has expired or not (l).

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 103, and when an application is made for letters patent for the same invention by another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17th, 1888, held in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (m), that although the opponent's patent would override the applicant's by reason of the antedating, still that for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7th, 1887, allowed *L'Oiseau and Pierrard's* patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent* (n).

The third ground of opposition was introduced by sect. 4 of the Act of 1888, for the purpose of preventing an applicant from claiming in his complete specification an improvement on his invention, which was contained in the provisional of the opponent filed after the date of the applicant's provisional specification and thereby depriving the opponent of the benefit of his

(i) *Re Huth*, Griff. P. C. 292.

(k) *Re Bartlett's Application*, 9 P. O. R. 511; but see also *Re Green*, Griff. P. C. 286.

(l) Per Gorst, S.-G., in *Lancaster's Patent*, Griff. P. C. 293.

(m) Griff. L. O. C. 28.

(n) Griff. L. C. C. 36



invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification (o).

The second sub-section provides:—“*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.*”

Notice of appeal must be filed within fourteen days from the date of the decision appealed against (p), and must state the nature of such decision (q). The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller, save as to matters that have occurred or come to the knowledge of either party in the meanwhile, except with the leave of the law officer (r). The law officer shall, at the request of either party, order the attendance at the hearing of the appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter in question, unless, in the opinion of the law officer, there is good ground for not making such an order (s).

In *Heath and Frost's Patent* (t), Sir E. Clarke said: “It appears to me that by sect. 11 it is quite clear that the only class of persons who are entitled to be heard in opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it.”

In that case the opponent was an agent for the patentee, and although it had been common in opposition cases, for the sake

(o) *Re Edwards' Patent*, 11 P. O. R.

461.

(p) L. O. Rules, rr. 1 and 5.

(q) L. O. Rules, rr. 2—4.

(r) L. O. Rules, r. 8.

(s) L. O. Rules, r. 9.

(t) *Griff. P. C.* at p. 290.



of simplicity, for patent agents acting on behalf of clients, to oppose grants of patents in their own names, the law officer decided that the opponent had not such an interest as to be entitled to be heard, and furthermore refused to grant leave to amend the notice of opposition.

It is not sufficient that the opponent has manufactured under the patent which he relies upon in opposition, he must have a direct interest in that very patent (u).

Where the opponent dies before the day fixed for hearing the opposition, the notice of opposition may be amended by inserting the name of another opponent (x).

(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."

Sect. 38 of the Act gives power to the law officers to examine witnesses on oath, to make rules from time to time regulating references and appeals, together with the practice and procedure before them, and in such proceedings they may make such orders as to costs as they may deem just, such orders to be enforceable as rules of Court.

In the absence of opposition, or in the event of any opposition being decided in favour of the patentee, the patent will be sealed. (Sect. 12.)

(u) *Re Macevoy's Patent*, 5 P. O. R. 286; see also *Glossop's Patent*, Griff. P. C. 285; *Re Hookham*, Griff. L. O. C.

82; *Re Bairstow*, 5 P. O. R. 289.

(x) *Re Lake*, Griff. L. O. C. 35.

## CHAPTER X.

## THE GRANT.

SECT. 12 of the principal Act provides that :—

“ (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.*

“ (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 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.*”

Sect. 13 enacts that :—

“ *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.*”

Prior to the Act of 1883 letters patent were issued under the great seal of England, and, consequently, by the Lord Chancellor,

as keeper of the great seal. The process of sealing a patent was surrounded with all the formalities and expense which surrounds an important Act of State. Letters patent derived their authority from the fact that the great seal was attached to them, for "all the king's subjects are bound to take notice of the king's great seal" (a). Sect. 84 of the Act provides: "*There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.*"

Form D in the first schedule to the Act gives the form in which letters patent are to be issued (b).

Letters patent consist of six material parts:—

- 1st. The address.
- 2nd. The recitals.
- 3rd. The grant.
- 4th. The prohibition.
- 5th. The conditions.
- 6th. The construction of the grant.

#### THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Mr. Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee (c).

#### THE RECITALS.

The recitals are four in number. The first recites the patentee's name and address, that he has made a declaration that he is in possession of an invention and is followed by the title of the invention. That he has declared that he is the true and first inventor of the invention, and that the same is not in use by any other person to the best of his knowledge and belief.

This recital contains the "suggestions" which have been made to the sovereign prior to the patent being granted and the representations upon which it has been granted. If either of these suggestions or representations be untrue the patent is void. We cannot do better to illustrate the exact meaning of a false

(a) *East India Co. v. Sandys, Skin.*  
225.

(b) See Appendix, p. 394, post.

(c) Page 40.



suggestion than to quote the language of Parke, B. in *Morgan v. Seacard* (d). In that case the false suggestion complained of was in the title of the specification, which it was alleged did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (e). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as in *Hill v. Thompson* (f); *Brunton v. Hawkes* (g); for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in other words the Crown being deceived in its grant, the patent is void, and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an *improvement* in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis v. Marling* (h), this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed on the attention of the Court or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not

(d) 2 M. & W. 544; 1 Web. P. C. 187; 6 L. J. Ex. 153.

(e) *Travell v. Carteret*, 3 Levinz, 185; *Alcock v. Cooke*, 5 Bing. 340.

(f) 8 Taun. 375.

(g) 4 B. & Ald. 541.

(h) 10 B. & C. 22.

vitiates the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and a false suggestion. In the cases cited below letters patent were held void for false suggestion (i). And the following cases are illustrations of the distinction drawn by Parke, B.:—*Lewis v. Marling* (supra) and *Haworth v. Hardcastle* (k). Also *Bainbridge v. Wigley* (l); *Hill v. Thompson* (m).

The second recital deals with the prayer of the application for the grant.

The third recital recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a false suggestion will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other the false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The fourth recital gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject-matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 86 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality. A serious oversight in the Act appears to be that there is no appeal from the comptroller when he exercises the power given by this section.

#### THE GRANT.

“ Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c., give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by

(i) *Jessop's Case*, 2 H. Bl. 490; *R. v. Wheeler*, 2 B. & Ald. 345; *Felton v. Greaves*, 3 C. & P. 611.

(k) 1 Bing. N. C. 182.  
(l) 1 Carp. P. C. 270.  
(m) 1 Web. P. C. 239.



himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention . . . . in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents."

This language is intended to preserve intact the royal prerogative to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 116 of the Act.

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the state can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity. A trade mark is also an exclusive right, but it differs from a patent, insomuch that it has not merit and the benefit of mankind as its consideration. Its object is to indicate the source from which an article comes; not to restrain others from manufacturing such articles. It merely prevents them from using the mark in connection with particular goods. A patent prevents the public from making the article or using the invention. There is no property which partakes of the nature of an exclusive right save that of a patent, copyright, or trade mark. There is no exclusive right in a secret. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret cannot, by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it, by publication or otherwise, as he may think proper (n). In *Newbury v. James* (o), although an agreement had been made to preserve a secret, the Court refused to grant an injunction on the ground that there was no means of enforcing it. Lord Eldon, L.C., said in *Williams v.*

(n) *Canham v. Jones*, 2 Ves. & B. 218. (o) 2 Mer. 446.



*Williams (p)*, "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secret in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the plaintiff's secret, however, be one which he intends to patent, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as to subsequently invalidate the plaintiff's patent, or to take out a patent for the invention himself, and if he do, he will be liable in damages to the plaintiff (*q*). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 46th section, construed as being "*the person for the time being entitled to the benefit of a patent*;" we shall see presently that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

#### THE PROHIBITION.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

(*p*) 3 Mer. 157.

(*q*) *Smith v. Dickenson*, 3 B & P. 680.

It is very difficult to understand the form of letters patent which is appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how they are to be put in force or recovered. The Act certainly does not mention penalties as a form of punishment for infringers.

#### THE CONDITIONS.

We find in the "conditions" that the grant is to be avoided "if it should appear to us, &c., or six or more of our Privy Council, that this our grant is contrary to law or prejudicial or inconvenient to our subjects generally, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the patentee is not the first and true inventor thereof within this realm as aforesaid." This proviso raises some questions of importance. The only proceedings mentioned in the Act for the repeal of letters patent are proceedings in the High Court of Justice. What is the proceeding before "six of our Privy Council"? It can scarcely be believed that reference is here made in a new codifying Act to the old prerogative claim of power to revoke, which has not been put in practice for two hundred and fifty years. If it be intended to have such a system of avoiding patents, surely it would be well to provide for it in a more certain manner than merely to mention it as one of the conditions in the patent itself. In the next place we find here, for the first time, an intimation that "novelty" means novelty within the kingdom; in the recitals of the patent it is recited as being novelty universally, and throughout the Act itself we find that "novelty" is not limited to novelty within the kingdom. Again, we find here for the first time the inventor described as "the first and true inventor within this realm." In the Act and in the recitals of the patent he is described as the "first and true inventor." We have shown that the omission of the words "within this realm" makes an immense difference not only in the class of persons who may be grantees of letters patent,



but also in the nature of the evidence of "prior user" which may be given in an action either for infringement or revocation. The ambiguity of the form of letters patent which is given, and the by no means clear provisions of the Act upon these matters, will in all probability result in a plentiful crop of litigation (*r*).

The next proviso is one for the determination of the patent in the event of the prescribed fees not being paid, and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee upon reasonable terms and conditions.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*s*). But should the Crown have employed a contractor, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There are two methods of infringing; first, making and vending; and secondly, using, consequently the contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*t*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorize others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather v. R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the same thing, whether the Crown manufactures itself or gives orders to other manufacturers."

The right of the Crown to use a patented invention for the

(*r*) See *Marsden v. The Saville Street Foundry Co.*, L. R., 3 Ex. D. 203; *Rolls v. Isaacs*, L. R., 19 Ch. D. 268.

(*s*) *Feather v. R.*, 6 B. & S. 257.

(*t*) *Dixon v. The London Small Arms Co.*, L. R., 10 Q. B. 130; L. R., 1 App. Cas. 641.



public service without being under any obligation to remunerate the inventor has been abolished by sect. 27 of the Act of 1883.

(1) "*A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject.*

(2) "*But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors (u), 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.*"

Sect. 44 deals with the acquisition by the Secretary of State for War of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

#### THE CONSTRUCTION.

"And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee." These words are inserted in the patent for the purpose of preventing the common rule of construction of grants of the Crown when founded upon a petition being read most strongly against the grantee. This favourable construction will not, however, in any way save the validity of the patent if it can be shown to have been granted upon a false suggestion.

(u) *Dixon v. The London Small Arms Co.*, supra.

## CHAPTER XI.

## AMENDMENT OF SPECIFICATIONS.

THE Patents, &c., Act, 1883, provides for the amendment of specifications in two ways, compulsorily and voluntarily. We have seen that sect. 6 directs that the comptroller shall refer the specification to an examiner. Sect. 7 as amended by sect. 2 of the Patents, &c., Act, 1888, provides that (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 direct, bear date as from the time when the requirement is complied with.*" Sub-sects. 2, 3, 4, provide for an appeal to the law officer; and sub-sect. 5 gives directions as to what should be done when there are two applications for substantially the same invention.

Sect. 9, sub-sect. 1, requires that the examiner shall report to the comptroller as to "*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.*" If the examiner reports that these conditions have not been complied with, the comptroller *may* refuse to accept the complete specification until it has been amended to his satisfaction, subject to appeal to the law officer.

Sub-sect. 3: The law officer shall, if required, hear the applicant and the comptroller, and may make an order deter-

mining whether, and subject to what conditions, if any, the complete specification shall be accepted. By sub-sect. 4 the application is rendered void, except in the case of an appeal, unless a complete specification is "accepted" within twelve months from the date of application. Sect. 94 provides: "*Where any discretionary power is by this Act given to the comptroller, 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 the opportunity of being heard personally or by his agent (a).*"

These provisions of the law were novel at the date of the Act of 1883. It will be particularly observed that compulsory amendment is strictly limited to matters of form. The comptroller has no power to order an amendment on the ground that too much is claimed, or that there is want of novelty, or that the invention is not subject-matter for a patent. It is difficult to predicate what judicial interpretation will be put upon the words "that the nature of the invention is not fairly described." Is the examiner to be in the position of an expert witness, and to decide whether or not the description is sufficient to enable a skilled artizan to carry the invention into effect within the meaning of Jessel, M.R., in *Plimpton v. Malcolmson* (b)? or is he merely to see that the language is correct, and that, without going technically into the matter, the specification *appears* to fairly describe the invention? If the former is his province, it is difficult to see how it is to be carried into effect, since there is no machinery in the Act for the receiving of skilled evidence, such as would be necessary for the purpose of arriving at a satisfactory conclusion upon such a point. The applicant or his agent are alone to be heard. It is true that by sect. 38, where the applicant *appeals* he may call witnesses before the law officer, but surely the statute does not contemplate that questions should be gone into which, it is evident, can only be decided on appeal, and even then not satisfactorily without the procedure and care of a regular formal trial.

Under such circumstances, it may fairly be presumed that the

(a) See also P. R. 1890, rr. 11—14.

(b) L. R., 3 Ch. D. 568.



meaning of the section is, that the examiner shall report whether the specification, on the face of it, appears to fairly describe the invention (c).

In construing sect. 9, it will probably be held that a minute and scientific inspection of the specification is not within the contemplation of the statute.

It is the duty of the examiner to report whether the specification contains a full and fair description of the invention, but it is not within his province to decide what the amendment is to be, in cases where amendment is necessary (d).

Sect. 18 provides for the amendment of the specification by the applicant or patentee. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (e). *In re Gare's Patent* in 1884 (f), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c., Act, 1852, and said: "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c., Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, or which is otherwise to be considered as a record under the authority of the Master of the Rolls. So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that the jurisdiction of the Master of the Rolls is still intact with reference to amendments after sealing.

(c) *Brown's Patent*, Griff. L. O. C. 1.

(d) *In re C.'s application*, 7 P. O. R. 250.

(e) *In re Sharp's Patent*, 1 Web. P. C. 641; *In re Nickel's Patent*, 1 Web. P. C. 650; *In re Redmund's Patent*, 1 Web. P. C. 649 (n); *In re*

*Whitehouse's Patent*, 1 Web. P. C. 649, note (m); *In re Rubery's Patent*, 1 Web. P. C. 649 (n); *In re Dismore's Patent*, 18 Beav. 538; *In re Adams' Patent*, 21 L. T. 38; *Re Johnson's Patent*, L. R., 5 Ch. D. 508.

(f) L. R., 26 Ch. D. 105.

*In re Berdan's Patent* (g), it was held that where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction without bill filed, to order it to be taken off the file.

Sect. 91 gives to the comptroller power to correct any clerical error in or in connection with an application for a patent on payment of the prescribed fee (h).

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The common law power of amendment being found insufficient for the purposes of justice in such cases, the Act 5 & 6 Will. IV. c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, &c.,*" with the leave of the law officer, might disclaim any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or might, with such leave as aforesaid, "enter a memorandum of any alteration in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury v. Clough* (i) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original patentee, or his assignees, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any disclaimer or amendment made by the patentee was entirely at his own peril, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 18 of the Act of 1883, as amended so

(g) L. R., 20 Eq. 346.

(i) 2 Q. B. 466.

(h) See also P. R. 1890, r. 16.



far as sub-sect. 10 is concerned by sect. 5 of the Patents, &c., Act, 1886, are as follows:—

“(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.*”

When the comptroller-general has not required an amendment, all amendments by the applicant or patentee from the date of lodging the complete specification must be made under section 18.

“The patentee,” as has been pointed out in a previous chapter, means the person for the time being entitled to the benefit of the patent, while “the applicant” means the person whose patent has not yet been sealed, but whose complete specification has been lodged.

In *Jones' Patent (k)*, an application to amend was made subsequent to filing the complete specification, but prior to its acceptance by the Patent Office, and the point whether the application was rightly made under sect. 18 of the Act was taken before the Attorney-General, Sir R. Webster, who, in his decision, said: “The language of sect. 18 of the Act is somewhat obscure; but I am of opinion, having regard to the earlier sections, particularly 7 and 9, that section 18 was intended to apply to the amendment of specifications after they had become public property. Any other amendments must, in my opinion, be dealt with under sects. 7 and 9, and not under sect. 18. Under these circumstances, I am of opinion that the fact that the office had not signified its acceptance of the complete specification as lodged is immaterial, and that any proceedings for amendment must be taken in pursuance of sect. 18.”

The words “public property” in this decision clearly mean the date of lodging the specification in a public office; it cannot mean open to the public, as in this case that time had not arrived; in that case the comptroller-general did not require the application for leave to amend, and the nature of the amendment to be advertised, on the ground that the specification

(k) Griff. P. O. 313.



was not open to public inspection, and it does not appear clear, from the decision of the Attorney-General, whether, in proceedings for amendment before the acceptance of a complete specification taken under sect. 18, the application should be advertised in accordance with the provisions of sub-sect. 2, in spite of the fact that the complete specification is not open to public inspection at that time.

“Correction or explanation” does not include amendment by the insertion of subsequently ascertained knowledge; it is only allowed for the purpose of explaining more clearly the meaning of the patentee at the time when he patented his invention, that is to correct and explain the enunciation of his invention as he intended originally to give it (*l*).

Under this section there is power neither to amend the title nor the provisional specification. When a complete specification is filed with a narrower title than the provisional, the proper course for the C. G. to adopt is to amend the title of the provisional under sect. 7, or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*m*) (this latter course, it appears to the author, would be dangerous).

Under the Act of Will. IV., when a patentee sought to disclaim it was necessary that he should give his reasons for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment whatever the form of the amendment may be. The reasons will, of course, vary with each case—either that the patentee has discovered that parts of the invention claimed are not new, or are useless, or are not sufficiently described, or that they will not work.

The reasons for an amendment form no part of the amendment itself (*n*).

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*o*),

(*l*) Per Sir R. Webster, in *Beck v. Justice*, Griff. L. O. C. 10.

(*m*) Per Sir R. Webster, in *Dart's Patent*, Griff. P. O. 307.

(*n*) *Cannington v. Nuttall*, L. R., 5 H. L. 205, 227, 228.

(*o*) *Re Nordenfell's Patent*, Griff. L. O. C. 18.

but the amendment will not be refused merely on the ground that the reasons given for it are insufficient (*p*).

Sir E. Clarke, S.-G., in *Re Lang's Patent* (*q*), summed up the jurisdiction of the L. O. under the 18th section in the following words: "I do not doubt that I have power to allow any amendments, whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make."

Prohibition will not lie to the law officer in the exercise of his discretion under this section: *Ex parte Simon*, Times, Aug. 6, 1888, C. A. (*r*).

"(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."

In *Ashworth's Patent*, Sir H. Davey, S.-G., said: "The sect. 18 (2) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request" (*s*).

This sub-sect. enacts that any person may oppose; wherefore it would appear that the C. G. has no power to consider the title of the opponent, although the C. G. decided against an opponent on the ground that he was not entitled to be heard in the case of *Bell's Patent* (*t*).

Rule 53 of the Patent Rules of 1890, provides that:

"A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent), intends to oppose the amendment, and must be signed by him (*u*). Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy."

Rule 54. "On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant."

(*p*) Per Sir H. Davey, S.-G., *Re Ashworth's Patent*, Griff. L. O. C. 7.

(*q*) 7 P. O. R. 469, 471.

(*r*) *In re Van Gelder's Patent*, 6 P. O. R. 22, 27.

(*s*) Griff. L. O. C. 7.

(*t*) Griff. L. O. C. 10.

(*u*) For form of notice of opposition, see Appendix, p. 445, post.



Rule 55. "Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof."

Rule 56. "Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41 and 44 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated."

"(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.*"

The comptroller exercises the power to impose conditions given in express terms to the law officer under sub-s. 4 (x). In *Codd's Patent* (y), he ordered as a condition of allowing an amendment (1), that no proceedings be taken against opponent A. in respect of infringements committed prior to the 1st January, 1884; (2), that the applicant pay to opponent A. 10 guineas as and for his costs of and incident to his opposition to the abortive application of 10th July, 1884. It is however clear that the C. G. has no power to give costs as a condition of amendment (z).

In *Cochrane's Patent* (a), the opposition to the amendment and the opposition to the grant were fixed for hearing before the C. G. on the same day; the C. G. elected to hear the amendment case first on the ground that if the application were successful, the sting would be taken out of the opposition to the grant.

"(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.*"

Any person who would be injuriously affected by a void patent becoming valid is a person entitled to be heard (b).

(x) *Peitschmann's Patent*, Griff. P. C. 314; *Hearson's Patent*, Griff. P. C. 309; *Andrew v. Crossley*, 9 P. O. R. 168.

(y) Griff. P. C. at p. 307.

(z) *Pietschmann's Patent*, Griff. P. C. 314.

(a) Griff. P. C. 304.

(b) See the conditions imposed in *Re Medlock's Patent*, Newton's London



In *Allen's Patent* (c), application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any pipes which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision: "I have carefully considered the question whether in allowing this amendment I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act, I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases, as reported in Griffin's P. O., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act (d). No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I

Journal, new series, vol. 22, p. 69; also *Re Smith's Patent*, Macr. P. C. 232, in which cases great care was taken to protect the vested interests of persons who had acquired rights by reason of the imperfect condition of the original specification.

(c) Griff. L. O. C. 8.

(d) *Re Hearson*, 1 P. O. R. 213; *Re Haddan*, Griff. L. O. C. 12; *Re Cheesbrough*, Griff. P. O. 303; *Re Westinghouse*, Griff. P. O. 315; *Andrew v. Crossley*, 9 P. O. R. 168.

do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition."

In *Cheeseborough's Patent* (e), the conditions were that no action should be brought with reference to any lamps *made* sold or used before the date of the amendment, and that any lamps so made might be used or sold after the date of the amendment without infringing. In the case of a second disclaimer the law officer will be disinclined to give costs to the patentee even if successful (f).

In the case of applications for leave to amend patents granted under the Act of 1883, the law officer on allowing the application will not impose any conditions except under special circumstances. In *Ashworth's Patent* (g), Sir H. Davey, S.-G., said: "If I saw or if there was any evidence before me that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which is claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment" (h).

The specification is considered to be amended from the moment that leave to amend is given, and the conditions imposed, if any, agreed to (i), no written undertaking by the applicant is necessary although it is the practice in the patent office to require some such undertaking as conclusive evidence of the agreement (k),

(e) Griff. P. C. 303; see also the terms imposed in *Westinghouse's Patent*, Griff. P. C. 315.

(f) *Haddan's Patent*, Griff. L. O. C. 12.

(g) Griff. L. O. C. 9.

(h) See also *Re Allen's Patent*, Griff. L. O. C. 3; *Re Haddan*, Griff. L. O. C. 13.

(i) *Andrew v. Crossley*, 9 P. O. R. 165.

(k) *Ibid.* at p. 168.



since the written assent precludes the patentee from alleging that he did not accept the condition (l).

The power of the law officer to grant costs is expressly conferred by the 38th sect. of the Act of 1883 (m).

In *re Ashicorth's Patent* (n), the law officer refused to grant costs to the applicant although successful, on the ground that the specification was so loosely framed it was natural that rival traders should oppose an application for leave to amend.

In *re Lake's Patent* (o), which was an unopposed application for leave to amend, the applicants appealed to the law officer against the decision of the C. G., Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs. "In fact," he said, "I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the C. G. should neither give nor receive costs."

In *re Morgan's Patent* (p), which was a successful appeal to the law officer from the decision of the C. G., application was made for the return of the stamp on the notice of appeal, Sir R. Webster, A.-G., refused this application on the ground that he considered the case to be one in which the C. G. was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

"(5) *When 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.*"

The exercise of discretionary power vested in the C. G. by the Patents and Trade Marks Acts is regulated by sect. 94, of the Act of 1883, and Patent Office Rules, 1890, rr. 11—14.

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

A notice of appeal must be filed in the Patent Office within

(l) *Andrew v. Crossley*, 9 P. O. R. at p. 169; see also *Re Berdan*, L. R., 20 Eq. 346.

(m) See also L. O. R. r. xi.

Appendix C.

(n) Griff. L. O. C. 9.

(o) Griff. L. O. C. 17.

(p) Griff. L. O. C. 17.



14 days from the date of the decision appealed against, in every case where appeal to the law officer from a decision of the C. G. is allowed under the Acts (g); the practice on appeal is regulated by the Law Officers' Rules.

“(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.*”

It will be observed that the amendments under the new Act are to be by disclaimer, correction or explanation, provided the amendment does not cause the specification to claim an invention substantially larger or different. The Act of Will. IV., after using the words “disclaimer” and “alteration,” provided that no extension should take place in the “exclusive right” granted by the letters patent.

It was always a question of great difficulty whether or not a disclaimer or alteration extended the “exclusive right” of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. Mr. Justice Maule's view of the Act of Will. IV. was: “Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer” (r).

Romilly, M.R., in the same case (s), at the Rolls, said: “It is

(g) L. O. Rules, r. i.; p. 455, post. page 24; 10 C. B. 379; 15 Jur. 59

(r) *R. v. Mill*, 20 L. J., C. P. at (s) 14 Beavan, at page 315.

proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in *Macrory's Patent Cases* at page 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original claim being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said: "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged" (t).

The case of *Ralston v. Smith* (u), shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle. Under the Act of 1883 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different.

The decision of the law officer is final, and cannot be appealed against (x), consequently in cases of doubt leave to amend will be granted (y) since if the amendment is bad under sub-sect. 8 it can be questioned when the point comes before the Court (z). Although no one case upon this subject can well be authority for the decision of another, a consideration of a few of the decided

(t) *Foxwell v. Bostock*, 4 De G. J. & S. at page 306; 12 W. R. 723; 10 L. T., N. S. 144.

(u) 11 H. L. C. 223; 20 C. B., N. S. 28; 13 L. T., N. S. 1.

(x) *Bateman & Moore's disclaimer*, M. C. P. C. 116; *Re Lake's Patent*,

Griff. L. O. C. 16.

(y) *Re Lake's Patent*, Griff. L. O. C. 16; *In re Bateman & Moore's Patent*, M. C. P. C. 116.

(z) *Re Van Gelder's Patent*, 6 P. O. R. 22.



cases will show the lines upon which the law officers go in granting or refusing leave to amend a specification.

Where no reason was shown by the patentee for requiring the amendment, in the case of a specification which on the face of it was sufficient without it, the law officer refused the application (a).

In *Hampton & Facer* (b) the applicants desired to insert a statement in their specification imputing disadvantage to former patents, the Solicitor-General refused the application on the ground that he was not at all satisfied that the faults imputed to those patents did in reality exist.

In *Beck & Justice* (bb) Sir R. Webster, A.-G., said: "My idea of the function of an explanation within sect. 18 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 ascertained knowledge."

An amendment which in effect amounts practically to the re-writing of the whole specification will not be allowed (c), nor an amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (d).

The law officer will allow an amendment which upon a fair interpretation tends to limit the scope of the original specification (e), and where a specification is clearly capable of two constructions the patentee by amendment can limit himself to one of them (f).

In *Re Bateman & Moore's Patent* (g) there was evidence upon the face of the specification that the patentees intended their invention to comprise an entire apparatus, at the end of the specification they claimed the several parts of the apparatus,

(a) *Re Morgan*, Griff. L. O. C. 17 ;  
*Re Nordenfelt*, Griff. L. O. C. 18.

(b) Griff. L. O. C. 15.

(bb) Griff. L. O. C. 10.

(c) *Re Nairn*, 8 P. O. R. 444.

(d) *Re Heath & Frost's Patent*, Griff.  
P. C. 311 ; *Re Serrell*, 6 P. O. R. 101.

(e) *Re Nordenfelt*, Griff. L. O. C. 20 ;  
*Cochrane's Patent*, Griff. P. C. 304.

(f) *Re Rylands*, 5 P. O. R. 665 ; see  
also other instances, *R. v. Mill*, 10  
C. B. 379 ; *Seed v. Higgins*, 8 H. L. C.  
550.

(g) *Macr.* P. C. 116.



Bothell, S.-G., allowed the disclaimer the effect of which was to convert the claim into one for the combination.

The law officer will not in the absence of satisfactory explanation permit repeated applications to be made for the same proposed amendment (*h*).

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

Leave to amend, although conclusive as to the right of the party to *make* the amendment, will not give validity to an amendment which is invalid by reason of the provisions of subsect. 8.

In *Foxcell v. Bostock* (*k*), which arose under the similar provisions of 5 & 6 Will. IV. c. 83, the amended specification claimed an invention substantially different from that described in the original specification for which the patent was granted. Lord Westbury, L.C., in his judgment, said: "The question then arises, Is the patent void or is the disclaimer void? And to this question it is not easy to find an answer. There is no express enactment in statute 5 & 6 Will. IV. c. 83, that the disclaimer, if it transgresses the statutory limit, by extending the exclusive right, shall be void to all intents and purposes; and unless it be so, it must remain enrolled with and always accompany the letters patent in the specification. It might be proper to hold that the disclaimer is inoperative for the excess only, where that excess is clearly distinguishable; and this is the course which I have been most anxious to take in the present case."

In *Dudgeon v. Thomson*, Lord Blackburn, in his judgment in the House of Lords, said: "But when we take, as I apprehend we are entitled to take, *the old specification* before the disclaimer in order to see what it means, that becomes still clearer. I say we are entitled to take it, for the object of a disclaimer is merely to take out and renounce part of what had been claimed before, and it would vitiate the new specification if by striking out that

(*h*) *Arnold's Patent*, Griff. L. O. C. 5.

(*k*) 4 D. J. G. & S. 298.

(*i*) *Rs Berdan*, L. R. 20 Eq. 346.

part you gave an extended and larger sense to what is left so as to make it embrace something which it did not embrace before" (l).

In the *Matter of Van Golder's Patent* (m), which was a petition for a writ of prohibition to issue against the law officer on the ground that he had allowed a disclaimer which extended the scope of the patent and consequently *ultra vires* under sub-sect. 8, Lord Esher, M.R., in his judgment in the Court of Appeal, said: "In my judgment these two sub-sections have not altered the law in the least. The *Attorney-General* cannot make a valid amendment if it is to substantially enlarge the invention, or make it a substantially different invention. He cannot do it effectively. That is by virtue of sub-sect. 8. Then, if that be so, sub-sect. 9 has not the effect of making that which he has done invalidly, conclusive, and if what he has done is invalid by reason of sub-sect. 8, whenever anybody attempts to put in force that amendment for any purpose, the Court could say that what the *Attorney-General* has done has not really altered the original specification. Then the matter must be determined according to the original specification. The amendment would be held to be invalid (n)." Lord Justice Lindley in the same case said: "The amendment referred to (in sub-sect. 9) is not only an amendment made, but an amendment which could be properly made under the Act—an amendment which complies with sub-sect. 8—'such an amendment.' If such an amendment as that is made, then such an amendment becomes, in the language of sub-sect. 9, for all purposes, part of the specification. It does not mean any amendment whether authorised by the Act or unauthorised by the Act; that is not the scope of the legislation" (o).

The above cited cases all lead to the conclusion that where an amendment substantially enlarges the patent or makes the specification as amended substantially different from the original specification, the defence of disconformity between provisional specification and complete as amended, cannot be relied on in an action

(l) L. R., 3 App. Cas. 55.

(m) 6 P. O. R. 22.

(n) At p. 27.

(o) At p. 28; see also *In re Sharp's Patent*, 1 Web. P. C. 643; *In re Bateman & Moore's Patent*, Macr. P. C. 116.



for infringement, since the amendment is void and the complete specification must be read as it stood prior to amendment.

But in *Gaulard & Gibbs' Patent*, Lord Justice Lindley said: "We are satisfied that no other construction is worth contending for, and it is, in our opinion, the true construction of the specification as amended. . . . But this construction of the amended specification renders the patent hopelessly bad in law, for (1) on this construction the invention is not the same as that described in the provisional specification, but an entirely different invention; and (2) on this construction the amendment of the complete specification has greatly extended the scope of the patent. As already shown, the essence of the invention, as described in the complete specification in its original shape, and as set forth in the provisional specification, lay in the use in combination of a specially-constructed electrical generator which the patentees believed to be superior to all others, and, in fact to have magical powers; and if they throw this over, they so far depart from their invention as described in those documents as to render the patent they have obtained for it worthless and incapable of being supported" (p).

In *Moser v. Marsden* the same Lord Justice said: "An ambiguity of expression is cleared up, but still, if the claim is thereby enlarged so as to make that to be an infringement which would not have been so before, *the amendment will avoid the patent*" (q).

In *The Farbenfabriken v. Bowker* (r), the defendants raised the objections, that the comptroller had allowed certain amendments of the specification which had not been properly advertised, and further that when the application was made for amendment there was an action for infringement pending, and that therefore under sect. 18, sub-sect. 10 of the Act of 1883, no amendment ought to have been allowed, Mr. Justice Romer refused to go behind the order of the comptroller.

From the above cases it would seem that it is not yet clearly

(p) 6 P. O. R. 225; see also the same case in the House of Lords, 7 P. O. R. 367, 387.

(q) 10 P. O. R. 359; see also *Lane*

*Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 9 P. O. R. 221, 239, 413, 419, 421.

(r) 8 P. O. R. 389, 397.



sottled, whether, when an amendment extends the scope of the patent, the amendment alone is bad, or whether the whole patent is thereby rendered invalid.

The fact of an amendment being required by the patentee does not necessarily imply that the original patent was void (s), and Lord Cairns, L.C., in *Dudgeon v. Thomson*, said: "The original specification may have complied with all the exigencies of the law, and been such as is requisite in the case of every patent, but the amended specification may be wanting in all those qualities which are required by the statute" (t).

(10) "*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.*"

In *Cropper v. Smith* (u) the comptroller having declined leave to amend a specification by reason of the 10th sub-sect. of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding." Application was made to the Court under sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the comptroller of the power of amending the specification under sect. 18.

In *Codd v. Bratby* (x), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the comptroller.

Should a petition for revocation be instituted while an application for leave to amend is pending, the proceedings before the Comptroller General are thereupon suspended by virtue of the sub-sect., and can only be revived by leave of the Court under sect. 19 (y).

(s) Per Tindal, C. J., in *Stocker v. Warner*, 1 C. B. 165; 9 Jur. 138.

(t) L. R., 8 App. Cas. 38.

(u) 1 P. O. R. 254; L. R., 28 Ch. D. 148; see also *Lawrence v. Perry*,

2 P. O. R. 179, 188.

(x) Griff. P. C. 56; 1 P. O. R. 209.

(y) *Re Deeley's Patent*, 11 P. O. R.

72, 76.

Sect. 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 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."

Where more than one action is pending, the leave of the Court must be obtained under this section in each action, otherwise the amendment will not be allowed, and each order must be filed under rule 58 (*infra*) (s).

"The Court" as defined by sect. 117 of the Act, means the High Court of Justice, so would not include the House of Lords (a), and "a judge," of a Court, which, though not a High Court, has jurisdiction to try actions for infringement of a patent, can grant leave under this section, consequently the Vice-Chancellor of the Palatine Court can grant leave under this section while an action is pending within his jurisdiction (b).

It is to be noticed that while an action is pending the amendments made with the sanction of the Court are limited to disclaimer.

Sect. 19 acts as a limitation upon the general words of sub-sect. 10 of sect. 18, and when permission to apply has been granted under sect. 19 the provisions of sub-sect. 10 cease to have effect (c), and the procedure in such application is governed by the remaining provisions of sect. 18 (d).

Sect. 19 gives an absolute discretion to the Court or judge in imposing conditions upon which leave to apply to amend will be granted and the Court of Appeal "will not interfere with the exercise of that discretion unless they can clearly come to the opinion that in their view that discretion was exercised absolutely wrongly" (e).

(z) *Codd's Patent*, Griff. P. C. 305.

(a) *Cropper v. Smith*, 1 P. O. R. 256.

(b) *Winter v. Baybut*, 1 P. O. R. 76; see also p. 316, *post*.

(c) *Singer v. Stassen*, 1 P. O. R. 121, 123, 124; *In re Hall*, 5 P. O. R.

312.

(d) *In re Hall*, 5 P. O. R. 310; *Lang v. The Whitecross Co.*, 7 P. O. R. 392.

(e) Per Lord Esher, M.R., in *Allen v. Doulton*, 4 P. O. R. 384; see also *Bray v. Gardner*, 4 P. O. R. 40; *Lang*



In *Bray v. Gardner* Lord Justice Lindley said (*f*). "I do not understand that there is any form of order which is invariably to be followed in all cases when application is made under sect. 19. It appears to me that whenever leave is given to amend under sect. 19 of this Act, care ought to be taken that no injustice is done to the defendant by reason of the amendment, if amendment is made, or if leave to apply for it is granted. Adequate protection may be given to the defendant in various cases in various forms."

It is usually one of the terms upon which the Court grants applications under this section, that the amended specification should not be used as evidence in the action (*g*), but the words at the end of the section—"and may direct that in the meantime the trial or hearing of the action shall be postponed"—clearly suggest the possibility of cases arising in which the Court would consider it right that the amended specification should be received in evidence at the trial (*h*).

In *Codd v. Bratby* (*i*), in giving liberty to amend under this section, Chitty, J., said, "It is conceded for the applicant, first, that the amended specification is not to be put in evidence at the trial; secondly, that no evidence is to be given of any infringement prior to the amendment of the specification. Besides that, it is conceded that the applicant must pay the costs of this application and all the costs that have been thrown away in the action;" then as to the contention that a condition should be imposed on the plaintiff that he should not sue the defendants on the amended specification for future infringements, his Lordship said, "The result of my acceding to this part of the argument would be, that I should be giving to the defendants practically and substantially a licence to infringe the plaintiff's patent when amended . . . in the circumstances of this case,

*v. Whitecross Wire and Iron Co.*, 6 P. O. R. 570, 574; 7 P. O. R. 389, 394.

(*f*) 4 P. O. R. at p. 44; see also *Lang v. Whitecross Co.*, 6 P. O. R. 570, 575; *Meyer v. Sherwood*, 7 P. O. R. 283, 285.

(*g*) *Gaulard & Gibbs v. Lindsay*, 5

P. O. R. 196; see also *Lang v. Whitecross Co.*, 7 P. O. R. 393.

(*h*) *Bray v. Gardner*, 4 P. O. R. 42; *Fusee Vesta Co. v. Bryant & May*, 4 P. O. R. 71; *Re Hearson's Patent*, 1 P. O. R. 213.

(*i*) *Griff. P. C.* 56; 1 P. O. R. 209.



that would be going too far. . . . There may be cases in which it would be right to impose such a term. I am not satisfied in the case before me on the evidence, that the defendants are right in their attempt to impute knowledge to the plaintiff many years ago of the invalidity of his patent; if that point were made out, I think the case might stand on a different footing, because then I should have the case of a patentee with knowledge of a defect in his patent, lying by until a very few months of the expiration of his patent; and I should have on the other side the defendants saying that they were aware of the invalidity of the patent, that they were advised that the patent was invalid, and that they set up a trade and incurred great expenditure on the faith that the patent was invalid" (k).

Liberty to apply under this section will not be given after judgment (l).

Sect. 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 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."

Under the Statute of Will. IV., no disclaimer or amendment could be given in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time the disclaimer or amendment was enrolled. The object of this was obvious. It would have been unjust that a defendant should be held guilty of infringing a patent when at the time the action was brought against him the patent was void. The saving clause relating to *scire facias* was always exercised subject to just provision as to costs, and was inserted with a view to prevent a

(k) See also as to terms imposed under this section: *Singer v. Stassen*, 1 P. O. R. 121; 50 L. T. 326; Griff. P. C. 207; *Fusee Vesta Co. v. Bryant & May*, L. R. 34 Ch. D. 458; 56 L. J., Ch. 187; 56 L. T. 110; 4 P. O. R. 71; *Bray v. Gardner*, L. R., 34 Ch. D. 668; 56 L. J., Ch. 497; 56 L. T. 292;

4 P. O. R. 40; *Haslam Foundry Co. v. Goodfellow*, L. R., 37 Ch. D. at p. 121; *Gaulard v. Lindsay*, 5 P. O. R. 192; *Lang v. Whitecross Co.*, 6 P. O. R. 570.

(l) *Lawrence v. Perry*, Griff. P. C. at p. 148.

patent being repealed on account of some trifling error which might have been cured by disclaimer or alteration. The entry of a disclaimer under the old Act did not make a void patent valid *ab initio*, "so as to make any person a wrongdoer by relation," and in *Perry v. Skinner* (m) it was held, that the words "from thenceforth" must be read into the specification. Proceedings by *scire facias* are abolished by sect. 26 of the Act of 1883, and a petition to the Court is substituted, the grounds for the petition being the same as heretofore in *scire facias*. Although we have seen that sub-s. 10 of sect. 18 prohibits any amendment *under that section* pending legal proceedings (including proceedings by way of revocation), sect. 19 provides machinery for saving a patent in the event of the Court or judge being of opinion that a disclaimer should be allowed upon such terms as may appear just (n). It will be observed that the Court or judge have no power to permit amendment by "correction or explanation" under this section.

Sects. 19 & 20 must be read together (o), and if an application under sect. 18 or 19 is granted without the imposition of terms, the amendment on being made will be retrospective only, if the patentee can show that his original claim was framed in good faith and with reasonable skill and knowledge (p).

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (q), judgment was given for plaintiff with the usual relief, the defendants referred to sect. 20, and asked that the account of profits should be kept only from the date of the amended specification; Romer, J. refused the application and said that "he thought it was clear from the evidence which was before him, that the plaintiff's original claim was framed in good faith and with reasonable skill and knowledge."

(m) *Hindmarch*, p. 207; 2 M. & W. 471; 1 Web. P. C. 250; 6 L. J., Ex. 124.

(n) As to what are just terms, see *supra*, and *In re Smith's Patent*, Macr. P. C. 232; *In re Medlock's Patent*, *Newton London Journal*, new series, vol. 22, p. 69.

(o) *Lang v. Whitecross*, 7 P. O. R. 391.

(p) *Wenham v. Carpenter*, 5 P. O. R. 68; see also *Lucas' Patent*, Macr. P. C. 235.

(q) 10 P. O. R. 46, 62; see also *Meyer v. Sherwood*, 7 P. O. R. 283, 286.