

THE c†
LAW AND PRACTICE
RELATING TO
LETTERS PATENT FOR
INVENTIONS.

BY
THOMAS TERRELL, K.C.

FOURTH EDITION

BY
COURTNEY TERRELL,
BARRISTER-AT-LAW.

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To

DUGALD CLERK,

IN GRATEFUL RECOLLECTION OF MY PUPILAGE,

I DEDICATE THIS EDITION OF

MY FATHER'S WORK.

C. T.

PREFACE

TO THE FOURTH EDITION.



TEN years have elapsed since the Third Edition of this work was published, and great changes have been effected in the law, by the Legislature and by the Courts. The debates on the policy of the Act of 1902 are still fresh in the public mind, and men of commerce and men of law have rejoiced over a great step towards reform. A few remarks on the policy of this enactment may not be out of place before passing to strictly legal considerations.

Hitherto the State has granted Patents (for what they might be worth) to any applicant on any allegation of invention. The effective force of the patents so granted rested on the strength of the opinions which could be obtained from expert counsel, sometimes supported by Courts of Law. In spite of the most favourable legal opinion, the risk to capital that was involved in the purchase of patent rights gradually impressed itself on the commercial world, and a somewhat hazy notion that things were managed better abroad developed into a fixed desire that inventions should be subjected to a test for novelty before patents should be granted.

If the new Act is to be regarded as an effective measure it must be considered as tentative only. The novelty of the invention is to be inquired into so far as prior British specifications are concerned, and only with regard to such of these as have been published within fifty years preceding the application. The limitation of the period of time is undoubtedly judicious. The subject-matter of the applications for patents obtained more than fifty years ago, which could have any bearing on a modern industry should be a matter of general information in that trade, and well within the knowledge of a person competent to search the records. On the other

hand, the fact that the invention for which application has been made was merely described in a specification more than fifty years old, without any record of its having since been put in practice, should not detract from the merit of a person who presents it to the world anew as a useful art.

But in limiting the extent of the search to British specifications, a great part of the technical information of the country is ignored; and it may well happen that a specification will pass through the Patent Office and a patent be granted although the officials themselves may be aware that the alleged invention is common knowledge.

It was impossible, however, to remedy the entire evil by a single enactment. An organization competent to conduct a more extended inquiry could not be called into being without experience, and this experience could not be obtained save by practice under a tentative measure. Few are aware of the difficulty of organizing and training a staff of officials to deal efficiently with from twenty to thirty thousand applications a year. The manner in which Mr. C. M. Dalton, C.B., H.M. Comptroller-General, has dealt with the problem excites the admiration of anyone who frequents the Patent Office, and has any experience of organization. Those critics who complain of "red tape" have not considered the difficulties of the situation—a new machine necessarily works with some friction. The Patent Office has now an opportunity of becoming a most efficient branch of the Civil Service. So long as the labours of its officials were confined to clerical routine there was no field for the occupation of a vigorous man with intelligence. The post of Examiner at the Patent Office may now be safely offered to gentlemen of high scientific training as an interesting and intellectual profession.

The new procedure by which specifications are critically examined will certainly produce one effect of the greatest professional importance—it will develop the art of drafting, which up to the present has been neglected. Dr. Martin,

of the Patent Office, has recently delivered a course of lectures on this subject; I regret that I was not able to hear and obtain advantage from them. Skill in drafting a specification does not consist, as many people seem to suppose, in composing it from insufficient materials in minimum time, but to a large extent in the ability of the draftsman to obtain from the inventor the necessary facts so as subsequently to determine and indicate in what the invention consists and how to carry it out.

In Chapter VIII., dealing with "Application and Acceptance," I have attempted to describe the practice of the Patent Office under the new Act from the point of view of practical experience, and in general outlines it is probable that it will remain a fairly correct description for some time to come, but it is very possible that the practice will change as it becomes more highly systematized. I desire to express my deep gratitude to the Comptroller-General and to Mr. Hatfield, the Chief Examiner, and also to Mr. Martin, private secretary to the Comptroller, for their great kindness and courtesy in helping me with much information, and many suggestions.

In Chapter XIV. I have dealt with the new procedure on petitions for Compulsory Licenses or Revocation. No one has yet taken advantage of this part of the Act of 1902, and its effect remains to be seen.

I have carefully adhered to the original plan of the Author in presenting statements of law in the exact words used by the judges who enunciated them. So far as I can see there is no advantage in paraphrasing the remarks of a great judge on a matter of principle, and referring the reader to a footnote so that he may at leisure test the inaccuracy of the author. The statements of principle have been selected, where possible, from recent cases, so that their application to the more complex phenomena of the present day may be illustrated. The legal changes effected by judicial decisions have been considerable.

There is probably no branch of the law that illustrates more clearly the beautifully elastic nature of our legal system which permits a growth of ideas to suit the change of relations and circumstances. On this subject, at all events, the Courts are well abreast of the times in which we live. This is particularly to be seen in the series of judgments on subject-matter.

The lecture by Mr. Fletcher Moulton to the Junior Institution of Engineers, quoted at p. 68, will probably become a classic as one of the earliest and most successful attempts to deal with the subject of Invention on a philosophical basis. Those who have sat as humble listeners in the "back row" know well how greatly the country has gained by the elevation of Mr. Moulton to the dignity of a Lord Justice of Appeal, and that a gap which cannot be filled has been made in the ranks of those who practise in the branch of the profession that was particularly his own.

The Index of Cases has been arranged on a new plan which I hope may be found useful—unfortunately it is very difficult to test this arrangement from the point of view of one who is totally unacquainted with this particular branch of law—the best of all tests to which any sort of index can be subjected.

The text has been provided with side-notes, a method not adopted in the previous editions, and the arrangement of some of the Chapters has been materially altered, but I hope that the logical order of their treatment has not been injured.

In the Appendix will be found the "Instructions to Applicants" issued by the Patent Office—a mine of valuable information in a very condensed form.

COURTNEY FERRELL.

NEW COURT, TEMPLE,
1st February, 1906.

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The Law and Practice

RELATING TO

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

LETTERS PATENT.

“LETTERS PATENT” is the name given to the document in which the sovereign signifies his will to confer special rights or privileges upon a subject. The privileges granted to a subject when created a peer of the realm or the monopoly of a trade or manufacture are alike conferred by the issue to the subject of letters patent. Letters patent definition.

Letters patent confer a franchise, that is to say, a branch of the royal prerogative vested in the hands of a subject. In *Reg. v. County Court Judge of Halifax* (L. R. 1891, 1 Q. B. 797 (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 Letters patent confer a franchise.

(a) And see *British Mutoscope Co. v. Horner*, 1901, 18 P. O. R. 179.

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 infinite.' 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. The right of the Crown to grant monopolies of new trades or manufactures to inventors, *i.e.*, persons introducing them into the realm, as a reward for the benefit thereby given to the community, was always recognised as part of the Common Law Prerogative (*b*). In *Darcy v. Allen* (*c*), 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

(*b*) *Darcy v. Allen*, 1602, Noy, 182; *Case of Monopolies*, Noy, 182; *The Clothworkers of Ipswich Case*, 1615, Godb. 252, 253; *Edgbury v. Stevens*, 1691, 2 Salk. 447; 1 Web. P. C. 35; Shephard's Abridg-

ment, Part III., tit. "Prerogative," p. 61; Sergeant Hawkins in Hawkins's Pleas of the Crown, Part I., c. 79, s. 20.

(*c*) 1602, 11 Rep. 84.

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, knowledge 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 civilised.

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 Tudors, 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 (*d*).

It has been supposed that the prerogative of the Crown to

(*d*) 1623, 21 Jac. 1, c. 3.

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."

Sect. 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 sect. 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 sect. 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 sect. 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 his 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.

Firstly, he must be the true and first inventor of—

Secondly, a new manufacture;

Three
requisites.

Thirdly, 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

Protection of
trade
probably
obsolete.

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.

A recent case. Recently (*e*) the validity of a patent was attacked on the ground that the patentee refrained from manufacturing in this country, and maintained the price of the article, which he imported from his works in Belgium, at a very high price. It was argued that this was contrary to the statute. But Mr. Justice Warrington decided that no condition as to manufacturing at home attached to the grant (see Chapter on Revocation).

Indeed, according to the present system of Royalties, a highly inflated price for the new article usually accompanies the grant of letters patent, and constitutes the principal temptation to infringement.

The definition of "new manufacture," 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, 1883-1902, deal merely with points of procedure and practice, adopting, as has been already pointed out, the definition of an invention contained in the 6th 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.

(*e*) *Badische Anilin und Soda Fabrik v. W. G. Thompson & Sons*, 1904, 21 P. O. R. 478.

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” (*f*). Sect. 84 of the Act provides: “*There shall be*

(*f*) *East India Co. v. Sandys*, Skin. 225.

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 gave the form in which letters patent were to be issued, which has since been modified (*g*).

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.

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 suggestion than to quote the language of Parke, B., in *Morgan v. Seaward* (*h*). 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,

(*g*) See Appendix.

(*h*) 1837, 2 M. & W. 544; 1 Web. P. C. 187; 6 L. J. Ex. 153.

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 (*i*). 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* (1818, 8 Taunt. 375; 1 Web. P. C. 244); *Brunton v. Hawkes* (1821, 4 B. & Ald. 558); 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* (1829, 10 B. & C. 22), this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed 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 vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and

(*i*) *Travell v. Carteret*, 3 Levinz, 135; *Alcock v. Cooke*, 5 Bing. 340.

a false suggestion. In the cases cited below letters patent were held void for false suggestion (*k*). And the following cases are illustrations of the distinction drawn by Parke, B.:—*Lewis v. Marling* (*supra*) and *Haworth v. Hardeastle* (1834, 1 Bing. N. C. 182). Also *Bainbridge v. Wigley* (1810, 1 Carp. P. C. 270); *Hill v. Thompson* (1818, 1 Web. P. C. 244).

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. An 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 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

(*k*) *Jessop's Case*, 2 H. Bl. 490; *R. v. Wheeler*, 1819, 2 B. & Ald. 345; *Felton v. Greaves*, 1829, 3 C. & P. 611.

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 (1). In *Newbury v. James* (2 Mer. 446), 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. Williams* (2 Mer. 157): “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

(1) *Canham v. Jones*, 2 Ves. & B. 218.

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 (*m*). 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."

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

(*m*) *Smith v. Dickenson*, 1804, 3 B. & P. 630.

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 (*n*). 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."

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

(*n*) See the Act of 1902, sect. 3.

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 (*o*). 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 (*p*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorise 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 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 (q), or others, at any time after the application, use the*"

(*o*) *Feather v. R.*, 1865, 6 B. & S. 130; L. R. 1 App. Cas. 641. 257.

(*p*) *Dixon v. The London Small Arms Co.*, 1875, L. R. 10 Q. B. 257. (*q*) *Dixon v. The London Small Arms Co.*, supra.

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 practice when a dispute arises between the patentee and the government department is for the matter to be referred to a tribunal consisting of the Chancellor of the Exchequer and two lords of the Treasury, advised by a permanent official, who hear counsel on both sides and in some cases take evidence, although they have no power to administer an oath, and there is no appeal from their decision. The tribunal sits privately.

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.

CHAPTER II.

“THE PATENTEE.”

Who may
apply.

By sect. 4 of the Act of 1883 it is enacted: (1) *Any person, whether British subject or not, may make an application for a patent: and (2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.*

By sect. 5 of the Act of 1885 it is declared that some or one of the applicants, in the case of a joint application, must be the true and first inventor.

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.

Infants and
married
women.

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.

Aliens.

Before this Act it was competent for an alien to obtain a patent; Lord Cairns in the matter of *Wirth's Patent* (a), 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” (b).

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

Officials.

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

(a) *Wirth's Patent*, 1879, L. R. 1845, 14 M. & W. 318.
12 Ch. D. 303; 28 W. R. 329. (c) *Bloxam v. Elsee*, 1827, 1 C. & P. 558.
(b) See also *Chappell v. Purday*, P. 558.

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" (*d*).

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 (*e*). Clergy.

Under sub-sect. 2 of the Act of 1883, quoted above, it is clear that a patent may be granted to a corporation, together with the true and first inventor. But a grant to a corporation alone could only be made in the case of a new manufacture introduced from abroad (*f*), since a corporation could not be said to invent in the modern sense of the word (*g*). Corporate bodies.

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" (*h*), 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 (*i*), and this is the case whether they are co-grantees or co-assignees. Nature of grant.

As to rights of such co-patentees to the profits made by granting licenses, quære (*k*). The answer to this question probably depends upon the wording of the grant.

A co-owner of letters patent is entitled to work the invention without accounting for profits, even though he may be mort-

(*d*) 1875, L. R. 2 C. D. 832.

235; 10 P. O. R. 251.

(*e*) Hindmarch on Patents, p. 35; *Hall v. Franklin*, 1838, 3 M. & W. 259.

(*i*) *Steers v. Rogers*, 1892, 9 P. O. R. 177; 1892, L. R. 2 Ch. 13; 10 P. O. R. 245; 1893, L. R. App. Cas. 232; *Mathers v. Green*, 1865, L. R. 1 Ch. 29; 35 L. J. Ch. 3; *Hancock v. Bewley*, 1860, 1 Johns. 604; Good, P. C. 219.

(*f*) See *In re The Société Anonyme du Générateur du Temple*, 1896, 13 P. O. R. 54.

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

(*k*) *Mathers v. Green*, 1865, L. R. 1 Ch. 33; 35 L. J. Ch. 3.

(*h*) Per Lord Chancellor in *Steers v. Rogers*, 1893, L. R. App. Cas.

gagee of the share of the other co-owner (*l*), but he must account for profits as mortgagee in possession.

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” (*m*).

(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.”

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. And by sect. 12, sub-sect. 3, if the inventor applies, but dies before the grant is made, a grant may be made to his legal representative.

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.

(*l*) *Steers v. Rogers*, supra ; see Chap. XI., post.

(*m*) See Chap. VIII. and Appendix, Forms A, A1, A2.

CHAPTER III.

TRUE AND FIRST INVENTOR.

By the common law the Crown had power to grant letters patent, giving monopolies for manufactures newly introduced into the realm, whether newly invented or newly imported (a). There is no doubt, therefore, that the words "true and first inventor" in the Statute of Monopolies included both—

Preliminary
distinction.
Inventors and
importers.

- (1) True and first inventor (in the strict modern sense), and
- (2) True and first importer.

The words of the statute have, however, given rise to much doubt and misunderstanding.

In *Marsden v. Saville Street Co.* (1878, L. R. 3 Ex. D. 203), 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 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 ever 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 inquiry 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

(a) See p. 31 *seq.*

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."

Long before the Act of 1883, however, there had been a custom or practice for the applicant to distinctly state in his declaration, by virtue of which qualification he prayed for a patent; and the form in which the declaration was made became material, because the Crown must not be deceived. Consequently, in *Milligan v. Marsh* (1856, 2 Jur. N. S. 1083), 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.

Here it is to be noticed that the patent was declared invalid, not because an importer might not have a patent, but because the Crown had been deceived in the grant.

In *In re Avery's Patent* (L. R. 36 Ch. D. 316), 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* (10 L. T. N. S. 177), 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."

The Act of 1883, as amended by the Act of 1888, requires a declaration that the applicant, or one of them, is the "true and first inventor"; and the Patent Office, adhering to the old practice, provides separate declaration forms, A¹ and A², to be used by inventors and importers respectively, whereby an importer declares that he is true and first inventor.

In the old declaration form to be used by an importer, it was not customary to state from whom the invention had been communicated. Form A¹ under the new state of affairs, however, requires this to be done (*b*).

We will therefore consider the "true and first inventor" from the two separate and distinct points of view, and under one of these categories the patentee must fall.

A. An 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

True and first inventor.

(*b*) See on this point *Pilkington v. Yeakley Power Hammer Co.*, 1901, 18 P. O. R. 461.

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* (1795, 1 Web. P. C. 125) 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 *Cornish v. Keene* (1835—1837, 1 Web. P. C. 507), 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 to 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 (c) was new—that the party who got the patent 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 *R. v. Wheeler* (1819, 2 B. & Ald. 345; 10 C. B. 395),

(c) *I.e.*, the publication to the world.

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."

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 with the full intention of abandoning them, B. will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (1776, 1 Web. P. C. 43): 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* (1829, 10 B. & C. 27; 1 Web. P. C. 496; 4 Car. & P. 52), 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 Co.* (1875, L. R. 3 A. C. 239, 243). 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 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 inquiries, 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 practically 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 (*d*): "Although it is not necessary

(*d*) L. R. 2 Ch. D. 832.

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 consideration 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.

What amount of labour of the mind is required is another question, and will be dealt with more fully under the head of “Subject matter.” But it may be broadly stated here that provided the invention has originated in the mind of the patentee, the Court will not inquire further, but will judge in the main from the results produced as shown in the invention itself.

It must be remembered that the question “Is the patentee true and first inventor?” is entirely separate and distinct from one which we shall have to consider later, in the Chapter on Novelty, viz., “Is the invention itself new?” In the former case we are dealing with the history of an idea in the mind of a particular man; in the latter with the history of a manufacture.

This difference was pointed out by Tindal, C.J., in *Gibson and Campbell v. Brand* (1841, 1 Web. P. C. at p. 628): “The defendant next says that these letters patent have not been granted to the true and first inventors, which you are aware is a condition required by the statute. Now 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, he may have taken it from a book, he may have learnt it from a specification; and then the legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. There is some distinction, although perhaps not a very broad one, between the plea which alleges the plaintiffs were not the first and true inventors and that on which I conceive the principal question between the parties will turn . . . whether the subject-matter of this patent was known in England at the time the letters patent were granted?" (e).

Master and
servant.

The extent to which science has developed in modern times, and the immense labour and time required to work out the details of construction of a complicated machine, frequently make it impossible for one man to perfect his invention by himself. . And it is the practice for many inventors to suggest the main idea to their subordinates, together with rough plans and sketches, and to leave the practical working out of the details to the latter, a task often requiring great skill, and occasionally even inventive ability. But this skill, while exercised in the employment of the master, and under his general directions, does not entitle the servant or workman to claim an interest in the invention, although the claim by the master to the ingenuity of the servant does not extend beyond mere improvements in mechanical details. 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 involved in the question, "Is it the mere idea, or is it the method of carrying it into effect that constitutes the pith of the invention?"

In *Bloxam v. Elsee* (1 C. & P. 558; 1 Web. P. C. 132, n.), the

(e) And see *Househill Co. v. Nielson*, 1 Web. P. C. at p. 689; *Hill v. Thompson*, 1818, 1 Web. P. C. 244; *Cornish v. Keene*, 1835, 1 Web. P. C. 507.

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* (*f*), 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 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."

In *Allen v. Rawson* (1845, 1 C. B. 557, *conf.* 1 C. B. 594), Erle, J., directed the jury thus: "I take the law to be that, if a person has discovered an improved principle, and employs engineers, agents, or other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of

(*f*) *Minter v. Wells*, 1834, 1 Web. P. C. 127.

the original improved principle, and may be embodied in his patent; and if so embodied the patent is not avoided by evidence that the servant or agent made the suggestion of the subordinate improvement of the primary and improved principle." This was confirmed by Tindal, C.J., who said: "Each case must depend on its merits."

In *Elias v. Grovesend Tinsplate Co.* (1890, 7 P. O. R. 455), the facts were as follows: In the year 1867, and subsequently, one Morewood took out patents for machines for removing the superfluous tin from tinsplates; this he effected by the immersion of the tinsplate 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 of Appeal said (g): "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

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

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."

But where the idea of the invention has not been suggested by the employer, there is nothing to prevent the servant having a patent. The Solicitor-General, in the *Matter of Heald's Patent* (1891, 8 P. O. R. 430), said: "I am not aware of any authority which lays it down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it" (*h*), particularly where the servant has been requested to invent, as in *Marshall and Naylor's Patents* (1900, 17 P. O. R. 553). Here again, however, there must be invention on the part of the servant, who is not on general principles (*i*) otherwise entitled to make use of information obtained by him when serving in a confidential capacity, and the circumstances must be considered in each case.

The cases 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 (*k*), and the relationship of master and servant gives to the master no rights to the invention of his servant.

(*h*) Cases decided in the servant's favour: *Burker v. Shaw*, 1 Web. P. C. 126, n.; *In re Lowe's Patent*, 1856, 25 L. J. Ch. 456; *R. v. Arkwright*, 1785, Dav. P. C. 61; *Homan's Patent*, 1889, 6 P. O. R. 104; *Barber v. Walduck*, 1 Carp. P. C. 438; *Re Russell's Patent*, 1857, 2 De G. & J. 130, 30 L. T. 168; *Scott v. Young*, 1871, L. R. 6 Ch. 274; *Saxby v. Gloucester Waggon Co.*, 1883, Griff. L. O. C. 56; *In re Heald's Patent*, 1891, 8 P. O. R. 429; *In re Marshall and Naylor's Patents*, 1900, 17 P. O. R. 553.

(*i*) See *Lamb v. Evans*, 1893, L. R. 1 Ch. 218; *Robb v. Green*, 1895, L. R. 2 Q. B. 315.

(*k*) Cases in which the master was held inventor or decided in the

Cases where servant held inventor.

Cases where master held inventor.

Fraudulent
application.

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* (1871, L. R. 6 Ch. 274), 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.

The decision of Hatherley, L.C., in *Ex parte Bates and Redgate* (1869, L. R. 4 Ch. 577), cited in the case of *Ex parte Scott and Young*, was in consequence of the discretion given to the Lord Chancellor by the Act of 1852, sect. 23, as to the date of the patent. This discretion no longer exists. The Act of 1883, sect. 13, fixes the date of application as the date of the patent. The decision has, moreover, been doubted in *Re Dering's Patent* (L. R. 13 Ch. D. 395), by Lord Cairns, who said: "I may 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 held 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."

master's favour: *Bloxam v. Elsec*, 1825—1827, 1 C. & P. 558; 1 Web. P. O. 132, n.; *Minter v. Wells*, 1834, 1 Web. P. O. 127; *Kurtz v. Spence*, 1888, 5 P. O. R. at p. 180; *Elias v. Grovesend Tinplate Co.*,

1890, 7 P. O. R. 455; *Worthington Pumping Engine Co. v. Moore*, 1903, 20 P. O. R. 41; *Richmond & Co., Ltd. v. Wrightson*, 1904, 22 P. O. R. 25.

In *Richmond & Co., Ltd. v. Wrightson* (1904, 22 P. O. R. 25), the defendant Wrightson had applied for certain patents (including foreign patents) having obtained the invention either from A. or from B. (this question was not decided). Buckley, J., made a declaration that the defendant was trustee of all the patents for A. and B. jointly. Subsequently (*unreported*), when the time came for sealing the patents, it was found by Sir E. Carson, S.G.; that as Wrightson was expressly declared by the judgment not to be the true and first inventor, no patent could be sealed. But A. and B. were able to apply for a patent under sect. 35.

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 applications, 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.

B. True and First Importer.—The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. 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. We find that so far back as 1567 a patent had been granted to one *Hastings* (1) for the

True and first importer.

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

Early cases of
importers.

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* (1615, 1 Web. P. C. 6; 1 Godb. 252) we have this 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. 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."

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 decision of *Edgebury v. Stevens* (1691, 1 Web. P. C. 35; 2 Salk. 447), 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* (1795, 2 H. Bl. 491; Dav. P. C. 162).

In modern times, however, the most frequent use that is made of the law concerning importations of inventions is to enable a foreigner to instruct his patent agent in this country to take out a patent, without availing himself of sect. 4.

In this case the agent, on account of the fiduciary relationship between himself and his client, holds as trustee for the actual

inventor (*m*). But otherwise the agent is the patentee, and there is no reason why he should not derive the entire advantage of the patent (*n*).

A question has arisen whether an importer may add to the invention by way of improvement on his own part.

Lindley, L.J., in the case of *Moser v. Marsden* (1893, 10 P. O. R. 359), in his judgment in the Court of Appeal, said: "Then it was suggested that, as the English patentee had himself improved *Grosselin's* invention, 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."

Where invention is improved on by the importer.

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 (*o*).

Importer need not be meritorious.

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 (*p*).

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

(*m*) *Beard v. Egerton*, 1846, 3 C. B. 129; 15 L. J. C. P. 274.

(*n*) *Ib.*

(*o*) *Beard v. Egerton*, *supra*.

T.—P.

(*p*) See remarks of Pollock, C.B., in *Chappell v. Purday*, 1845, 14 M. & W. 318; see also *Beard v. Egerton*, 1846, 3 C. B. 130.

information from a foreigner resident abroad, but may have done so from a British subject abroad (*p*).

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

It was decided in *In re Wirth's Patent* (1879, L. R. 12 Ch. D. 303; 23 W. R. 329) 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 (*r*).

“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* (1843, 1 Web. P. C. 733).

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 twelve 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 (*s*), and the object of sect. 103 is to preserve to the foreign

(*p*) *Nickels v. Ross*, 1849, 8 C. B. 1876, C. A., L. R. 3 Ex. D. 203.
at p. 710, per Wilde, C.J. (*r*) P. O. J., 9th May, 1884.
(*q*) *Marsden v. Saville Street Co.*, (*s*) *Edmund's Patent*, 1886, Griff.

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 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 (*t*).

The section (103) as amended by 48 & 49 Vict. c. 63, s. 6, and by 1 Edw. VII. c. 18, is 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.*

“*Provided that his application is made, in the case of a patent within twelve 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*

P. C. 283; *Re Lake*, 1888, 5 P. O. R. 415; *Re Bairstow's Patent*, 1888, 5 P. O. R. 288; and see also *Pilkington v. Yeakley Vacuum Hammer Co.*, 1901, 18 P. O. R. 459. (t) *Re Shallenberger*, 1889, 6 P. O. R. 550; *Re Carez*, 6 P. O. R. 552.

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*” (u).

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 (x).

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 (y).

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 (z).

Where a foreign inventor was resident in a country with which international arrangements for the mutual protection of inven-

(u) See also International Convention, 1883, and Instructions to Applicants, post.

(x) *The British Tanning Co. v. Groth*, 1891, 8 P. O. R. 113. See judgment of Buckley, J., in

Acetylen Illuminating Co. v. United Alkali Co., 1902, 19 P. O. R. 222.

(y) *Rolls v. Isaacs*, 1881, L. R. 19 Ch. D. 268.

(z) *Re Van de Poele*, 1890, 7 P. O. R. 69.

tions 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" (a).

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

(a) *In re Main's Patent*, 1890, 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. The words “new manufacture” under the old Common Law, and as confirmed by the Statute of Monopolies, have acquired some complexity of interpretation as sciences and arts have developed, and some preliminary examination of the different aspects of the subject is necessary.

Preliminary
examination
of subject-
matter.

It may best be approached by considering some of the different grounds upon which the validity of a patent may be attacked in the statement of defence delivered in an action for infringement. The most common among other pleas are:—

1. “The alleged invention is not new.”
2. “The alleged invention is not useful.”
3. “The alleged invention is not proper subject-matter for a patent.”

These three pleas are entirely separate and distinct. The allegation of want of novelty means that the public were at the date of the application in possession of all the information which the inventor purported to give in his specification—that the public had come into possession of its knowledge either through the general common knowledge of the time, or through the medium of some publication, or by the use of the alleged invention prior to the date of the application. As will be seen later, the defendant must specify and prove particularly in what manner the public have acquired their information, and if he succeeds on this ground, the patent fails for lack of consideration.

The allegation of want of utility also is based on failure of consideration for the grant. The plaintiff must give *prima facie* evidence of utility, and it is then for the defendant to attack the grant on this ground if the circumstances permit.

The two features of novelty and utility are, therefore, essentials to the validity of the grant; but it is to be remembered that it is not everything that is new and useful for which letters patent may be granted. The invention must be of "a new manufacture"—and the question whether the invention is a "manufacture," together with the important question of whether ingenuity has been displayed, are approached under the general issue of "subject-matter." It has been seen that ingenuity is essential, as the grant is conferred as a reward and encouragement. But in some cases the amount of ingenuity demanded is greater than in others, and this generally depends upon the nature of the problem which the inventor had to solve, and the results which he attained when measured by the state of public information of his time. In attacking the subject-matter of a patent, the defendant must show that the state of knowledge of the time leaves no room for invention in the alleged patent—and this does not constitute "anticipation," the word "anticipation" referring merely to novelty of the entire invention.

Scope of the question of subject-matter.

In this Chapter we shall consider the attitude which the Courts have adopted towards inventions as "subject-matter," leaving "want of novelty" (strictly so called) and "want of utility" for later treatment.

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, for that would be to invent the laws of nature, which have always existed. Man merely discovers the principle; but 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.

A principle, together with a method of utilizing.

Cases on
patents for
application
of new
principles.

Lord Justice Clark Hope, in directing the jury in the case of *The Household Co. v. Neilson* (1843, 1 Web. P. C. 685) (a), said:—
“I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect (b): 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 above case, as in the case of *Neilson v. Harford* (1841, 1 Web. P. C. 295), the patent was for producing heat in furnaces, by blowing the air for the furnace through a vessel which was heated. It was stated in the specification that the size of the vessel was to depend on the circumstances, and there was no claim. The Court held that the method suggested for carrying the principle into effect was sufficient to support a patent.

In *Otto v. Linford* (1881, 46 L. T. N. S. 35), 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 rendered gradual* substantially as and for the purposes set forth.”

(a) And see *Dangerfield v. Jones*, 1865, 13 L. T. N. S. 142; *Minter v. Wells*, 1834, 1 Web. P. C. 134; *Electric Telegraph Co. v. Brett*, 1851, 10 C. B. 838; *Edison-Bell Phonograph Co. v. Smith*, 1894, 11 P. O. R. 397; *British Vacuum Cleaners v.*

Suction Cleaners, Ltd., 1904, 21 P. O. R. 311; *Jandus Arc Lamp and Electric Co. v. Arc Lamp Co.*, 1905, 22 P. O. R. 296.

(b) See Bramwell, B., in *Hills v. London Gas Light Co.*, 5 H. & N. p. 369.

Jessel, M.R., in the Court of Appeal, said (p. 39):—"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 (c), 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."

An invention which consists in a particular arrangement of old parts on a new principle, although not quite the same thing as a method of carrying out a new principle, is treated in much the same way by the Courts.

So in *The Edison Bell Phonograph Co. v. Smith* (1894, 11 P. O. R. 148), 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

(c) *Neilson v. Harford*, 1841, 1 Web. P. C. 295; 8 M. & W. 876; 11 L. J. Ex. 20, supra.

has obvious advantages, but has never before been made practicable, and which has now been found practicable in a way disclosed by the specification. 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."

In *The British Vacuum Cleaner Co. v. Suction Cleaners, Ltd.* (1904, 21 P. O. R. 312), the invention consisted in a new principle applied to the cleaning of carpets by vacuum. The inventor discovered that it was essential to success to so drive the pump and apply the pipes, that a strong vacuum might be maintained at the carpet and at the filter. Other suction apparatus had been used before the date of the patent, but no one had appreciated the importance of maintaining a high vacuum. It was argued for the defendants that this was merely a patent on a question of the degree of the vacuum. Farwell, J., said: "The whole point of it is as is stated there: that it is essential to practical success to drive the pump by power, and to maintain a vacuum of at least 5 lb. per square inch at the filter. That appears to me to be a perfectly good process and well and sufficiently stated, and I do not feel myself at liberty, with regard to an invention or process of this sort, to tie down the inventor to the particular figures which are set forth in these drawings. If he were tied to these drawings, as to which I had some little hesitation at first, it is probable that the defendants might be able to say then with success that they did not infringe."

In all cases where patents are granted involving "new principles," the principles are new merely so far as the particular application of them is concerned, the laws of nature being eternal.

Every method
of application
cannot be
claimed.

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

(*d*) *Neilson v. Harford*, 1841, 1 Web. P. C. 295; *Booth v. Kennard*, 1856, 2 H. & N. 95; 26 L. J. Ex. 305; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 297, 308; *Patterson v. The Gas Light and Coke Co.*, 1875, L. R. 2 Ch. D. 812; 3 A. C. 239.

In *Patterson v. The Gas Light and Coke Co.* (1875, L. R. 2 Ch. D. 812; 3 A. C. 239), the claim was for "the employment of sulphide of calcium in separate purifiers as a means of purifying coal gas from sulphur existing in other forms than that of sulphuretted hydrogen." James, L.J. (affirmed by the House of Lords), said: "There is nothing in this but the enunciation of a chemical truth that pure sulphide of calcium will absorb the sulphur compounds . . . there is no invention of any particular process or means of employing the pure sulphide of calcium . . . it is obviously impossible to support such a claim as that, which was plainly based on the plaintiff's mistaken idea that he had discovered that peculiar property in sulphide of calcium."

Case of claim to bare principle held void.

But where a new principle has been shown newly applied to some new object, the method of application shown will be given a very wide construction by the Courts, and as Wright, J., said (*supra*): "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."

In the Court of Appeal Cotton, L.J., 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" (*e*).

(*e*) *The Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 304; see also *Badische Anilin und Soda Fabrik v. Levinstein*, 1885, 2 P. O. R. 91—93; L. R. 24 Ch. D. 156, 171 et seq.; *Proctor v. Bennis*, 1887, L. R. 36 Ch. D. 740; 4 P. O. R. 333; *Thomson v. Moore*, 1889, 6 P. O. R. 426; *Gadd & Mason v. The Mayor, &c. of Manchester*, 1892, 9 P. O. R. 525; *The Cassel Gold, Extracting Co. v. Cyanide Gold Recovery Syndicate*, 1895, 12 P. O. R. 103; *The Incandescent Gas Light Co. v. De Mare*, 1896, 13 P. O. R. 318; *The British Dynamite Co. v. Krebs*, 1893, 13 P. O. R. 190; *British Vacuum Cleaners v. Suction Cleaners, Ltd.*, 1904, 21 P. O. R. 311, *supra*; *Jandus Arc Lamp and Electric Co. v. Arc Lamp Co.*, 1905, 22 P. O. R. 296; and see also note (*a*), and Chap. XVI. on Infringement.

Novel application of an old principle.

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 (*f*); 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 (*g*).

In *Brooks v. Lamplugh* (1898, 15 P. O. R. 47) the patent was for improvements in bicycle saddles, and consisted in the application of the old principle of the "trussed beam" for supporting the saddle-frame. The improvement was very great. No one could deny that the principle utilised by Brooks was well known, but it had never before been applied to saddles. The old saddles had given great trouble by continually breaking. The Court of Appeal held that the novel application coupled with the resultant improvement disclosed ingenuity. The judgment of A. L. Smith, L.J., very clearly expresses the principle of law applied, and will be cited at p. 65 on the similar question of the new application of an old machine.

In *The Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate* (1895, 12 P. O. R. 251), the patent related to the recovery of gold from ore and base metal by means of a solution of cyanide of potassium. It was proved that it was well known, prior to the patent, that a solution of cyanide of potassium used together with other materials would dissolve gold out of its ore. The patentee discovered that if the solution was applied in a dilute form a new selective action took place

(*f*) *Dangerfield v. Jones*, 1865, 13 L. T. N. S. 142; *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205; 40 L. J. Ch. 739; *The Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate*, 1895, 12 P. O. R. 251; *Brooks v. Lamplugh*, 1898, 15 P. O. R. 47; and see for no invention, *Reason Manufacturing Co. v. Moy*, 1903, 20 P. O. R. 211; *Corrigal v. Armstrong, Whitworth & Co.*, 1905, 22 P. O. R. 272.

(*g*) *Seed v. Higgins*, 1860, 8 H. L. C. 550; 30 L. J. Q. B. 314; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 113; *Curtis v. Platt*, 1866, L. R. 3 Ch. D. 135, n.; *Needham v. Johnson*, 1884, 1 P. O. R. 49; *Bovill v. Pim*, 1856, 11 Ex. R. 718, 739; *Fletcher v. The Glasgow Gas Commissioners*, 1887, 4 P. O. R. 388; *Ashworth v. English Card Clothing Co.*, 1904, 21 P. O. R. 794.

and the gold was separated from the ore and the baser metals without the necessity for using any other substance. The Court of Appeal (Halsbury, L.C., Lindley, L.J., and A. L. Smith, L.J.) held that there was good subject-matter.

But the inventor is not entitled to claim more than a specific manner of applying the old principle; if he claims more, the patent is invalid.

But the claim must be for the method described only.

In *The Reason Manufacturing Co., Ltd. v. Ernest F. Moy* (1903, 20 P. O. R. 203), the invention related to the construction of safety electric fuze boxes, and described an arrangement of contiguous fuze boxes in which only one box at a time could be opened; the opening of any one locking the others. The first claim was "the construction and arrangement of electrical fuze or cut-out boxes or covers which automatically prevent access being obtained to more than one main at a time." The Court of Appeal held this claim to be too wide and the patent to be invalid.

The strict tying down of the patentee to the described method of applying the principle is well shown in the case of *Ashworth v. Eng. & Card Clothing Co.* (1904, 21 P. O. R. 794). The patentee described a particular method of applying the old principle of heating wire kept away from the oxygen of the air to produce tempering. The defendants employed another method. The House of Lords held "no infringement."

Further illustrated in *Infringement*. And see Chap. XVI.

In *Barber v. Grace* (1847, 1 Exch. R. 339; 17 L. J. Ex. 122), 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.

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 pro-

Development of interpretation of "new manufacture."

Processes and mixtures.

duced; 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.

In *Boulton v. Bull* (1795, Dav. P. C. 162), 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 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.

Hall v. Jarvis (1822, 1 Web. P. C. 100) (*h*) 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* (1832, 1 Web. P. C. 122) 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. Corley* (1834, 1 Web. P. C. 459) 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* (1841, 1 Web. P. C. at p. 590), 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.

(*h*) See also *Booth v. Kennard*, 1856, 1 Hurl. & N. 527; *Higgs v. Godwin*, 1858, 27 L. J. Q. B. 421; *Hills v. London Gas Light Co.*, 1858, 29 L. J. Ex. 409; *Young v. Fern.*, 1864, 12 W. R. 993; *Newall v. Elliot*, 1863, 13 W. R. 11.

The same judge, in *Gibson v. Brand* (1841, 1 Web. P. C. at p. 633), said: "The patent is taken out 'for a new or improved process for the manufacture of 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* (1795, 2 H. Bl. 468; Dav. P. C. 207), 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* (1819, 2 B. & Ald. 349), 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* (1856, 6 De G. M. & G. 402), 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 afford a good ground for a patent. A discovery of some machinery, whereby such a mixture might be more quickly and effectually accomplished, might be the foundation of another patent." In *Simpson v. Holiday* (1866, L. R. 1 H. L. 315) 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 *Bovill v. Pimm* (11 Exch. 739), 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.

Where the object of a patent is old, and the means to effect it only are new, the Court will require invention to be shown, and 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. The general rule in these cases seems to be that if a new effect is produced in arriving at that old object the patent will be held valid, and if that new result is to be found in the defendant's article produced by means closely resembling the plaintiff's invention, infringement will be held. A good instance of the validity of the patent together with infringement is to be found in *Hardmuth v. Baker* (1904, 21 P. O. R. 509) (i).

Where the object of the invention is old.

But where a patent is for a new process or a new machine to effect a new object which had been sought after but not previously attained, invention will not be so strictly required, and the construction given will be such that anyone 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 (k).

Where the object of the invention is new.

(i) Patent held valid and infringement: *The National Opalite Co. v. Ceralite*, 1896, 13 P. O. R. 655; *British Motor Syndicate v. Andrews* 1899, 16 P. O. R. 586 in H. L., 1901, 18 P. O. R. 55; *Hardmuth v. Baker*, 1904, 21 P. O. R. 509. Patent not held invalid, but no infringement: *Barber v. Grace*, 1847, 1 Exch. 339; *Curtis v. Platt*, 1863, L. R. 3 Ch. D. 135, n.; *Gosnell v. Bishop*,

1888, 5 P. O. R. 155; *Nettlefold's v. Reynolds*, 1892, 9 P. O. R. 284. Patent held invalid: *The Patent Bottle Envelope Co. v. Scymer*, 1858, 28 L. J. C. P. 22; *Horton v. Mabon*, 1862, 31 L. J. C. P. 255 (many cases cited); *Ormson v. Clarke*, 1862, 32 L. J. C. P. 8, 291 (*Harwood v. G. N. Rail.* cited); *Rushton v. Crawley*, 1870, 10 Eq. 522.

(k) *Jupe v. Pratt*, 1837, 1 Web. P. C. 145; *Houschill Co. v. Neilson*,

The attitude of the Courts towards the two classes of cases, *i.e.*, (a) a new process for an old object and (b) a new process for a new object, has been clearly expressed by Buckley, J., in *Sutcliffe v. Abbott* (1903, 20 P. O. R. 58). "I have now got to answer the question, which has been greatly argued in the case, as to whether this is a patent which falls within the principle of *Curtis v. Platt*, or whether it falls within the principle of *Proctor v. Bennis*. To answer that it appears to me that I have to ask myself these questions—Is the plaintiff's invention one to produce improvements in the mechanical means and arrangements which *Lake* (referred to as showing public knowledge) used to obtain well-known objects in a well-known machine? Is the claim only one for improvements in a known machine for producing a known result? If I have to answer those in the affirmative then I must tie down the plaintiff strictly to the structural details of the thing which he has described. If I answer them in the negative then I do not tie him down at all to those structural details of the thing which he has described; he has then described a new way of arriving at a new result. *Curtis v. Platt*, as we all know, was a case in which the result to be attained was an old result. If you are going to get that by new details of construction then you are tied down to your details. *Proctor v. Bennis* was a case in which the result was new; then you are not tied down to your details. It seems to me here that the plaintiff was arriving at a new result by new means."

The case of *Brown v. Hastie* (1905, 22 P. O. R. 100) is a particularly good instance of a "master" patent of the *Proctor v. Bennis* type (see chapter XVI. on Infringement, where this subject is further dealt with).

The interests
of the public
safeguarded.

The attitude of the Court in safeguarding the public is well exemplified in the case of *Partington v. Hartlepool Pulp &*

1843, 1 Web. P. C. 673, 685; *The Badische Anilin und Soda Fabrik v. Levinstein*, 1885, 2 P. O. R. 91; *Proctor v. Bennis*, 1887, 4 P. O. R. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11; *Thomson v. Moore*, 1889, 6 P. O. R. 426; *Leonhardt v. Kallé & Co.*, 1895, 12 P. O. R. 103; *The Automatic Coal Gas Retort Co. v. Salford*, 1897, 14 P. O. R. 466; *Sutcliffe v. Abbott*, 1903, 20 P. O. R. 58, *supra*; *Gammons v. Battersby*, 1903, 20 P. O. R. 512; 1904, 21 P. O. R. 331; *Brown & Brown, Ltd. v. Hastie*, 1905, 22 P. O. R. 100 (Scotch case).

Paper Co. (1895, 12 P. O. R. 302), where the inventor discovered that if a certain paper-making machine were used in a perfectly clean condition to start with instead of being cleaned during the operations a new effect was produced of a most valuable kind. Oil had been used before during the process of paper-making, with the effect but never with the *object* of maintaining the machine in a clean condition. Romer, J., held that to give effect to the patent would be to prevent the public from keeping their machines clean, and quoted James, L.J., in *Patterson v. The Gas Light & Coke Co.* (1876, L. R. 2 Ch. D. 835): "No one has a right to prevent a workman from using care to keep his tools in the most efficient state. No one has a right to prevent a manufacturer from cleaning his vessels, and throwing away the useless contents whenever he likes, or to ask him his motives or intentions in doing so."

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.* (1890, 7 P. O. R. 271) 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 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" (1).

Query, can there be a patent for a product *per se*.

But this opinion was *obiter dicta*, as the Court expressly decided that in that particular case the claim was not for the waistband alone, but for a waistband made in the way pointed out by the patentee. Recent opinions have been hostile to the view that there can be a claim for a product *per*

(1) See also *American Braided Wire Co. v. Thompson*, 1888, 5 P. O. R. 113; 6 P. O. R. 518; *Nobel's Explosive Co. v. Anderson*, 1894, 11 P. O. R. 530; *Rickman v. Thierry*, 1897, 14 P. O. R. 114; *Kopp v. Rosenwald*, 1902, 19 P. O. R. 211.

In *Riekmann v. Thierry* (1897, 14 P. O. R. 114) the claim was for an eyelet covered with celluloid, and the method of manufacture was expressly disclaimed, though described. In the House of Lords the patent was declared invalid on the ground that there was no invention in the article produced which was not new, though there was invention in the process. So that although the Lord Chancellor seemed to incline to the view that had the article itself been new it would have been patentable if new, the question itself was never argued, and the case was decided on another point altogether.

The question was more nearly dealt with in *Kopp v. Rosenwald* (1902, 19 P. O. R. 211). The "invention" there consisted in an entirely new article (strips of whalebone braided together with a selvedge for sewing) by the use of a machine which was old. The claim was for "The manufacture of the new material, strips of natural whalebone covered or braided with threads of fibrous material applied substantially in the manner and by the means herein before described with reference to and shown in the drawings." It was not denied during the case that the article produced was quite new and useful. Buckley, J., said: "The subject-matter of this invention, Mr. Terrell tells me, is that the patentee says there is a well-known thing known as a braiding machine, and that he tells you, 'Select a particular type of that well-known machine, namely, one with four heads and thirteen spindles. Use it in the way indicated in my specification, and the result is you will produce an article which is new,' and that is patentable. Now I doubt myself whether, in the strict sense of the word, an article can ever be treated as being in itself the subject of a patent. In saying that, I am not for a moment forgetting *Thompson v. American Braided Wire Co.* in the House of Lords. What I mean is that, assuming that an article is produced by a particular process, and that that article is new, you may say that you take out a patent for the article in the sense that it is a new thing, and it is got out in a way which was not known before, but I do not think it has ever been laid down that it would be an infringement of a patent for that article if someone ascertained a totally different path by which you would

arrive at the same completed thing." The patent was held invalid by the learned Judge on the ground that the claim was for a process, and that the process itself was old—its new application requiring no invention. It is submitted that the reasoning of Buckley, J., was correct. The invention must be of "a new manufacture," and protection will be granted against any method of manufacture of the new product which is substantially similar to that of the patentee. In other words the construction will be wide, as is usual where a new process is applied to effect a new result.

It is respectfully submitted that upon the cases the decision of Sir R. Finlay, A.-G., in *re Cooper's Application* (1902, 19 P. O. R. 54) (*m*), was erroneous, although the object of the invention was new. In that case the patentee claimed the method of printing a newspaper in such a manner as to leave narrow blank spaces along the lines on which the newspaper would be folded. The Attorney-General decided that this was a new manufacture. But when examined such a claim seems merely for a newspaper printed in a particular way and not for a process for the arranging of the type.

In earlier times there was considerable doubt whether a patent could be taken out for an improvement on an already existing patented invention. These doubts have now been set at rest, and in modern practice a "master patent" with a long string of subsidiary improvement patents is frequently found. The use of the improvement, together with the main invention, must be with the license of the original patentee. Similarly the improvement may not be used without the license of the patentee of the improvement. In *Lister v. Leather* (1858, 8 E. & B. at p. 1017), Lord Campbell said: "The assertion that all patents for improvements of existing patents must be void is obviously untenable" (*n*).

Patents for
improvements
on existing
patented
inventions.

(*m*) See *Craue v. Price*, 1842, 1 Web. P. C. 393.

(*n*) See also *Russell v. Cowley*, 1835, Good P. C. 406; 1 Cr. M. & R. 864; *Booth v. Kennard*, 1857, 1 H. & N. 531; *Morris v. Bransom*,

1776, 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*, 1893, 10 P. O. R. 361; *White & others v. Bailey & others*, 1903, 20 P. O. R. 270.

In *Fox v. Dellestable* (1866, 15 W. R. at p. 195), 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 license 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." In *Kynoch, Ltd. v. Webb* (1900, P. O. R. 107), Halsbury, L.C., said: "Now it is true that any machine protected by a patent is susceptible of improvements, and such improvements, if in other respects conforming to the patent law, may be protected themselves, but they can only be made use of by the license of the proprietor who is in command of the master patent" (o).

Patents for
mechanical
equivalents.

The employment of a mechanical or a chemical equivalent may be the subject of a patent, provided that such was not known to be an equivalent at the date of the patent, that ingenuity is displayed, and that a superior result is arrived at. An instance of a chemical equivalent (cases of which are necessarily more common owing to the obscurity of the science) is to be found in *Nobel's Explosive Co. v. Anderson* (1895, 12 P. O. R. 167). Here a patentee had taken out a patent for an explosive, one of the ingredients of which was stated to be "soluble nitro-cellulose." Stress was laid on this quality of solubility, and chemists of experience gave evidence to the effect that it was not known at that date that insoluble nitro-cellulose would be equally, if not more effective. A subsequent patent was taken out for a patent for the use of insoluble nitro-cellulose, whereby the explosive "cordite" was produced. It was held in an action by the owners of the first patent, against the manufacturers under the second patent, that there was no infringement, and the decision is in such terms as to warrant the assumption that there would have been enough subject-matter to support the second patent, had its validity been in question.

Old material
applied to
new purpose.

The application of an old material for a new purpose, or the discovery of a use for an old material formerly thought useless, may be the subject of a patent (p); for instance, *Muntz v. Foster*

(o) See also *Lister v. Leather*, *Patent*, 1 Wob. P. C. 431, n. 1858, 8 E. & B. 1017; *In re Fox's* (p) *Hayward v. Hamilton*, Griff.

(1844, 2 Web. P. C. 103) 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.

In the case of *Steiner v. Heald* (1851, 20 L. J. Ex. 410), 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

P. C. 118; *Bushon v. Crawley*, 1870, 10 Eq. 522; *The Albo-Carbon Light Co. v. Kidd*, 1887, 4 P. O. R. 281; *Hills v. London Gas Light Co.*, 1860, 29 L. J. Ex. 409; *Lister v. Norton*, 1886, 3 P. O. R. 199;

Penn v. Bibby, L. R. 2 Ch. App. 127; 36 L. J. Ch. 455; *Cooper & Co., Ltd. v. Bacdaker*, 1900, 17 P. O. R. 209; *McLay v. Law*, 1905, 22 P. O. R. 201.

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 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.

But it is necessary that there should be some ingenuity displayed. In *McLay v. Lucas & Co.* (1905, 22 P. O. R. 201), the invention consisted in utilising the calcium sulphate obtained as a waste product in the manufacture of tartaric acid, in conjunction with agglutinating materials to form a non-conducting "cagging" for boilers. It was proved that the use of calcium sulphate, as obtained from other sources, was well known for this purpose. The patent was declared invalid.

Known
instrument
applied to
new purpose.

Difficulty
of defining
invention.

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.

This difficulty of formulating a principle has been felt by many learned judges. The reason of course being that ingenuity or invention is psychological, and the utmost that can be done to estimate what has taken place in the mind of another person is to put oneself as far as possible in that person's place, and, relying upon the general similarity of minds, to endeavour to reproduce his mental process. Nor is this all—

a correction must be applied in the mind of the observer.—the mind which the inventor must be assumed to possess, is that of an ordinary person at the date of the invention, skilled in the trade to which the invention relates. The result is, as will be seen, that the Court usually decides by looking at the general result obtained in the light of what was known at the time, and at the demand for the article produced. The difficulty has been stated by Lord Esher, M.R., in *Lyon v. Goddard* (1893, 10 P. O. R. 344) (g) :—“ I know that a case before the House of Lords has been cited (*Morgan v. Windorer* (r)), 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 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 *Penn v. Bibby* (1867, L. R. 2 Ch. App. 127) 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.”

We propose to quote (as illustrations merely) cases in which the Court has held that sufficient invention has not been displayed, and cases in which the invention has been considered sufficient. And on general principles regard should be had to what has been said (r) on the novel application of an old prin-

(g) See also *Lister v. Norton*, 1886, 3 P. O. R. 205.

(r) See p. 59, post.

principle. It should be remembered, however, that the requirement of invention appears to be somewhat more strict in the case of the novel application of a known machine or material, than in the case of a known principle.

Cases where
the patent
was held
invalid.
See footnote (a).

In *Bush v. For* (1856, Macr. P. C. 164) 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. In *Brook v. Aston* (1859, 28 L. J. Q. B. 176) the patent was for the use of friction brushes to polish yarns of wool or hair. They had previously been used to polish linen and cotton yarns. Baron Martin said: "The application of a well-known tool to work previously untried materials, or to produce new forms, is not a subject of a patent."

In *Harwood v. G. N. R.* (1865, 35 L. J. Q. B. 38) (a case very frequently cited), the patentee used a "fish plate" for joining together the ends of rails. The evidence showed that this particular form of joint had been applied in various mechanical contrivances, and notably in the joining together of pieces of timber used in bridge building, with pieces of channelled iron. It was more or less agreed, however, that exactly the same kind of strains were not involved, where the earlier applications were made. But Lord Chelmsford, L.C., said:—"Then the question is whether there can be any invention of the plaintiff in having taken that thing, which was a fish for a bridge, and having applied it as a fish for a railway. Upon that I think that the law is well and rightly settled, for there would be no end to the interferences with trades, and with the liberty of any mechanical contrivance being adopted, if every slight difference in the application of a well-known thing were held to constitute a patent. . . . No sounder or more wholesome doctrine, I think, was ever established by the decisions which are referred to in the opinions of the four learned judges,

who concur in the second opinion delivered to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose which is analogous to the manner, or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance, to a purpose exactly analogous, or corresponding to the purpose, to which it had been previously applied."

In *Morgan v. Windover* (1890, 7 P. O. R. 134) 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 Halsbury, in the House of Lords, said: "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." Lord Herschell, in his judgment, said (at p. 137): "Now, my Lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had hitherto 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 was entertained, any workman told to do it would, without 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 *Shaw v. Barton* (1895, 12 P. O. R. 291) the patent was for a new mode of fastening the ends of wire rings which are used to hold on pneumatic tyres. The ends were inserted into a longitudinally-split tube, and then solder was introduced along the split. This produced a joint which was able to stand the immense strain caused by the tyre. It was proved that such a joint was well known as the best for neatness and strength by many in the wire trade prior to the date of the patent, although it was not certain that it had been specially employed to withstand great strain. Stirling, J., said: "Therefore, to a person acquainted with the state of knowledge in the wire trade at the time, the only problem that would suggest itself, as it seems to me, was whether materials, such as steel and solder, could be found of sufficient tenacity to make a joint suitable for use in bicycle tyres. This might require experiment, but does not seem to me to call for the degree of invention necessary to support a patent. The explanation of the failure of bicycle makers to make use of the joint appears to be that they were not aware of what had been done by wire-workers."

In *Dredge v. Parnell* (1899, 16 P. O. R. 629) the patent was for a method of cutting out necktie linings. The material to be used was exceedingly soft and fluffy. The patentee placed many layers of the material between a pair of templets of the required shape, which templets he screwed tightly together to get sufficient resistance in the material thus compressed, which he then cut through with a band knife, using the templets as guides. The use of templets and a band knife was old, and veneers had been cut in this way. Lord Halsbury, L.C., said: "I should say it would be more true to say that the skilled workman found out in the arrangement of his tools that he ought to do what has been done here than to say that he had made an invention, because this is only an arrangement of his

tools, and they are applied practically in the same way, though, I admit, requiring additional strength to the bottom part of the material, as well as to the top, and the application of a templet to the material, which is intended to be cut out, adapted to that particular material. When I come to analyse these elements of the supposed invention, I confess I am unable to see that there is anything in them which amounts to invention. What I should say is, that it is a rather more skilled and experienced application of the same old and well-known tools to the same sort of process that is applicable to fabrics of a firmer texture.”

In *Glover, Ltd. v. The American Steel and Wire Co.* (1902, 19 P. O. R. 109) the patentee applied a well-known process of welding to the particular object of attaching solid ends to the flexible conductors used in bending electric rails. Farwell, J., held that there was no invention displayed merely because the metal when in the shape of electrical conductors had not been before treated by the process.

It will be seen that 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 (s); we now propose to quote a few

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| <p>(s) <i>Kay v. Marshall</i>, 1836, 2 Web. P. C. 36, 39, 47, 48, 69, 71, 77, 79; <i>Lesh v. Hague</i>, 1837, 1 Web. P. C. 200; 5 M. & W. 387; <i>Reg. v. Cutler</i>, 1847, 14 Q. B. 372 n.; 3 C. & K. 215; <i>Bush v. Fox</i>, 1856, Macr. P. C. 164; 24 L. J. Ex. 251; 5 H. L. C. 707; <i>Brook v. Aston</i>, 1857, 28 L. J. Q. B. 175; <i>The Patent Bottle Envelope Co. v. Seymer</i>, 1858, 28 L. J. C. P. 22; <i>Harwood v. G. N. Rail. Co.</i>, 1860, 35 L. J. Q. B. 27; 11 H. L. C. 654; <i>Horton v. Mabon</i>, 1862, 12 C. B. N. S. 437; 16 C. B. N. S. 141; 31 L. J. C. P. 255; <i>Ormson v. Clarke</i>, 1862, 14 C. B. N. S. 475; <i>Jordan v. Moore</i>, 1866, L. R. 1 C. P. 621; 35 L. J. C. P. 268;</p> | <p><i>Parkes v. Stevens</i>, 1869, L. R. 5 Ch. 56; 38 L. J. Ch. 627; <i>Bamlett v. Picksley</i>, 1875, Griff. P. C. 40; <i>Philpot v. Hanbury</i>, 1885, 2 P. O. R. 33; <i>Sharp v. Brauer</i>, 1886, 3 P. O. R. 193; <i>Rowford v. Longford Wire Co.</i>, 1887, 4 P. O. R. 281; <i>Herrburger v. Squire</i>, 1889, 6 P. O. R. 194; <i>Morgan v. Windover</i>, 1890, 7 P. O. R. 131; <i>Longbottom v. Shaw</i>, 1891, 8 P. O. R. 333; <i>The Embossed Metal Plate Co. v. Saupe</i>, 1891, 8 P. O. R. 355; <i>Baker v. Kinnell</i>, 1892, 9 P. O. R. 441; <i>Sudbury v. Lee</i>, 1894, 11 P. O. R. 58; <i>Singer v. Rudge Cycle Co.</i>, 1894, 11 P. O. R. 463; <i>Shaw v. Barton</i>, 1895, 12 P. O. R. 282; <i>Dredge v. Parnell</i>, 1899, 16 P. O. R.</p> |
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examples of patents which have been supported as exhibiting an adequate amount of invention (*t*).

Cases where patent has been held valid.

In *Penn v. Bibby* (1866, L. R. 2 Ch. 127) the invention related to bearings for screw propeller shafts of vessels. The specification described the inner surfaces of the bearings as having grooves to receive fillets of wood which projected to some extent beyond the inner surfaces of the metal bearings, so as to prevent the shaft coming into contact with the metal of the bearings, the spaces permitting water to flow freely between the shaft and the inner surfaces of the metal bearings. Great utility was proved. The nature of the alleged anticipations is shown in the judgment of Lord Chelmsford, L.C., who said: "In every case of this description one main consideration seems to be whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test, which cannot be considered an unfair one, to the present case, it appears to me impossible to say that the patented invention is merely an application of an old thing to a new purpose. The only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings, but they are of a totally different character, and for a totally different object, from the bearings patented. In neither water-wheel nor grindstone is there a wooden bearing in which the wheel revolves, but the wheel is merely supported on wood, not encased or submerged, nor constructed for the purpose of admitting the

629; *Glover, Ltd. v. The American Steel and Wire Co.*, 1902, 19 P. O. R. 109; *British Thomson-Houston Co., Ltd. v. Manchester*, 1903, 20 P. O. R. 461; *Acetylene Illuminating Co., Ltd. v. United Alkali Co.*, 1903, 20 P. O. R. 174; 1905, 20 P. O. R. 152.

(*t*) *Penn v. Bibby*, 1866, L. R. 2 Ch. 127; *Newton v. Vaucher*, 1851, 6 Exch. 365; *The American Braided Wire Co. v. Thompson*, 1889, 6 P. O. R. 518; *Moser v. Marsden*,

1893, 10 P. O. R. 350; *Pirrie v. York Street Flax Spinning Co.*, 1894, 11 P. O. R. 429; *Fawcett v. Homen*, 1896, 13 P. O. R. 404; *The Adamant Stone and Paving Co. v. Liverpool*, 1897, 14 P. O. R. 21; *Brooks v. Lamplugh*, 1898, 15 P. O. R. 47; *The Presto Gear Case Co. v. Orme, Evans & Co.*, 1901, 18 P. O. R. 23; *British Motor Syndicate v. Andreu*, 1901, 18 P. O. R. 93; *Kane v. Pattison*, 1901, 18 P. O. R. 335.

water to flow freely within the bearing, and the revolutions of each of them are at a very slow pace. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw propellers in the way described in the patent."

In *Bumlett v. Pickstey* (1875, Griff. P. C. at p. 42) the patent was declared invalid, but 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."

In *Gadd v. The Mayer, &c. of Manchester* (1892, 9 P. O. R. 516) 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.

Lindley, L.J. (at p. 524), after an elaborate review of the authorities, expressed the law 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."

In *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.* (L. R. 1892, 3 Ch. 424, 429; 9 P. O. R. 413, 416) the invention consisted in the use of Planté batteries (which were known) as secondary reservoirs in conjunction with a dynamo for the novel purpose of regulating and keeping constant the pressure in the mains. 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" (u).

(u) In this case, however, the patent was held invalid on grounds other than want of subject-matter.

In *Brooks v. Lamplugh* (1897, 15 R. P. C. 47) A. L. Smith, L.J., said: "It by no means follows that a patent is bad because an old well-known mechanical contrivance has been brought into use by a patentee. If it were so, very few patents at the present day could be upheld. We think the law on the subject may be stated thus: Although there cannot be a valid patent for a well-known mechanical contrivance merely, when it is applied in a manner, or to a purpose, which is not quite the same, but is analogous to the manner, or the purpose in or to which it has hitherto been notoriously applied (we quote here the words of Lord Westbury in *Harwood v. The Great Northern Railway Co.*, and the same will be found again repeated by the House of Lords in the case of *Morgan v. Windover*), yet there may be a valid patent although well-known mechanical contrivances are used, if they are applied in a manner, or to a purpose, to which they have not been hitherto applied, and which new application results in a new and useful article not theretofore attained. In the first case there is no room for invention; that is, there is what is called no subject-matter. In the second there is room for invention; and if the Court comes to the conclusion that there has been invention in what has been done, then there is good subject-matter, and it is no answer to say that an old well-known mechanical contrivance has been used in bringing about the novel and useful result attained.

"If what the plaintiff has claimed by his patent is merely the user of a well-known mechanical contrivance, in a well-known manner, for a well-known purpose, then, of course, the patent is invalid, and *Longbottom v. Shaw* (1891, P. O. R. 333) is a good example of this. There will be found in that case a statement by Lord Herschell as to what does and does not constitute evidence of invention."

In this case, which has been already quoted at p. 44, the invention consisted in the application of the principle of a trussed beam for bicycle saddles. But the reasoning involved is exactly similar.

In *Lyon v. Goddard* (1893, 10 P. O. R. 334, 336), Bowen, L.J., said: "When you see that the point of this invention is that it enables a process, which has been discovered since, to be carried

Evidence of
ingenuity.

Previous demand and commercial success are evidence of ingenuity.

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 *Gosnell v. Bishop* (1888, 5 P. O. R. 158), 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 unaccomplished 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" (v).

Lord Herschell, in *The American Braided Wire Co. v. Thompson* (1889, 6 P. O. R. 518), said: "If the demand of the public for a particular article of dress be better met by a new combination than it has been by articles previously in use, and if this new combination, though its component parts be not new, required some exercise of the inventive faculty to produce it, I think it can be protected by a patent, though it may be impossible to say that the invention is important or necessary for the public good."

And, in *Hinks v. Safety Lighting Co.* (1876, L. R. 4 Ch. D. 615), 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* (1891, 8 P. O. R. 336), Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in

(v) See also *Moss v. Malings*, 3 P. O. R. 378.

accordance with it, there was a large demand for them But demand and success are not conclusive;
 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" (x).

But commercial utility will not alone be evidence of invention, any more than mere simplicity negatives invention. In *Thierry v. Rickman* (1897, 14 P. O. R. 115), Halsbury, L.C., said: "Whether there is or is not invention such as will support a patent is a question of fact and degree, and the state of facts and degree in one case can never be any guide in another. It is certainly quite true that mere simplicity will not prevent there being invention." He then referred to *Hinks v. Safety Lighting Co.* and *Brook v. Aston* (supra), and continued: "I refer to these two cases only as illustrative of the proposition that no smallness or simplicity will prevent a patent being good, while mere novelty of manufacture or usefulness in the application of known materials to analogous uses will not necessarily establish invention within the meaning of the patent laws (y).

In *Dowling v. Billington* (1890, 7 P. O. R. 191) the patent in question was one for a method of weaving wire mattresses 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. Patent for new method of using old machine.

We now have to deal with that most important branch of the patent law—that which concerns the validity of patents for new combinations. New combinations of new with old contrivances, or of old contrivances with other old contrivances, are principally Combinations.

(x) See also *Blakey v. Latham*, 6 Smith, L. J., in *Elias v. Grovesend Tinsplate Co.*, 1890, 7 P. O. R. at P. O. R. 187.

(y) And see judgment of A. L. p. 461.

Mr. Moulton's
statement of
the principle.

to be met with in the field of labour-saving machinery. New principles are rarely met with. Fundamental departures from old methods of manufacture are not so common nowadays as the new arrangement in old machines of their various parts (which in themselves as mechanical appliances are seldom novel) to produce the old effect in a better, cheaper, or more expeditious manner. Mr. Fletcher Moulton, in his presidential address (1904) to the Junior Institution of Civil Engineers, in dealing with this fact, said: "It is here that the lawyers' difficulties are greatest. The benefits of the patent laws are confined to inventions, and it therefore becomes necessary, in deciding whether a new machine or a modification of an old machine is good subject-matter for letters patent, to put to oneself the question, 'Does it involve invention?' The decision is not difficult when it involves a new cycle, or a wholly new mechanism for accomplishing an old cycle. But when it consists of an improvement on old mechanism by the substitution of different but equivalent devices, the task is one of great nicety. It would seem to be necessary to fix upon some definition of invention, but this has never been done, and in my opinion no definition of invention can be found which is of the slightest assistance to anyone in a case of difficulty. . . . When you approach the dividing line it is so impossible to get a test that it becomes, more or less, a matter of personal opinion. Some of the elements of a combination are altered so as to improve, but not essentially change its working. Is that a new invention? If it is only the substitution of mechanical elements which are notoriously the equivalents of the old elements the law is clear, but in any other case it is treated as being a question of fact for the judgment of whatever tribunal has the duty of deciding. Our Courts in this, as in many other questions, lean to the practical rather than the dogmatic. They impose no rigid test such as that to which the German Patent Office inclines, viz., that the new combination must produce a different technical result. To do the same thing better, or in a way so different that it gives to the public a useful choice of means, may with us be sufficient to support the claim to invention. And I have little doubt that if a case should arise in which a judicious selection out of the list of known

and notorious mechanical equivalents gave an unforeseen and markedly superior result, the Courts would consider themselves free to hold it to be an invention, and in treating the decision as thus dependent on the resulting utility they would only be following the dictum of Lord Watson: 'There are many things which you cannot say are or are not inventions until you have tried them.'"

And in *Rex v. Arkwright* (1785, 1 Web. P. C. 71), Buller, C.J., said: ". . . . In the case of an invention many parts of a machine may have been known before, yet if there be anything material or new which is an improvement of the trade, that will be sufficient to support a patent," and the comment on this case in the footnote to it is: "Thus the latter words 'improvement of the trade' define and explain the preceding, and the utility of the invention as ascertained by this result becomes, in cases of this kind, the real test." Cases supporting the above statement.

In *Huddart v. Grimshaw* (1805, 1 Web. P. C. 86), 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" (z).

In *Foxwell v. Bostock* (1864, Good. P. C. 200), 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 existing constituent parts of the machine, an improved arrangement or improved combination may be patented."

In *Bovill v. Keyworth* (7 E. & B. 725; 29 L. T. 194), 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.

(z) See also Tindal, C.J., in *Crane v. Price*, 1842, 1 Web. P. C. 408; 4 M. & G. 580; *Vickers v. Siddell*, 1890, 7 P. O. R. 292,

In *Crane v. Price* (1840, 1 Web. P. C. 377, 408; 12 L. J. C. P. 81; 4 M. & G. 580), 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."

This exposition of the law (although on the facts the decision has been more than once doubted) has been approved of by the Court of Appeal in the cases *Murray v. Clayton* (1872, L. R. 7 Ch. A. C. 584) and *Lyon v. Goddard* (1893, 10 P. O. R. 334, 346).

In *Williams v. Nye* (1890, 7 P. O. R. 67), 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."

In *Cannington v. Nuttall* (1871, L. R. 5 H. L. 205), 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."

On account of the views above set forth, that one set of facts cannot be a guide in coming to a conclusion on a different set of facts, it is not proposed to quote a series of cases on one side and on the other of the line. But as illustrations from modern case

law the following two instances may be taken as types: *Wood v. Raphael* (1896, 13 P. O. R. 734) is an instance (often cited) of the requirement of the Courts for a new effect. There the patent was for a new combination of parts in a pince-nez. It was shown that pince-nez with a rigid bridge piece and a spring to cause the glasses to grip the nose were well known. It was also shown that in other forms of glasses that the "plaquet" or pieces that come into contact with the side of the nose had been hinged to secure greater adjustability. The plaintiff's improvement consisted in combining the well-known feature of the adjustable plaquet with the well-known glasses with a rigid bridge. Romer, J., said: "It now appears that pivoted placquets as applied to pince-nez with spring bridges were perfectly well known, their qualities were well known, their advantages and disadvantages; and all that the plaintiff's so-called invention comes to is this: that to a well known article he has given an additional well known feature; not to do anything new to the glass as a whole, in my opinion, but merely to give to the original well known article the well known qualities of the addition. In my opinion there was nothing novel in the application of that extra feature, or in the purpose for which it was applied; there was no difficulty in adding that additional feature if so desired. Certainly no invention was required to add it." This judgment was confirmed by the Court of Appeal (a).

Type case, where combination patent held invalid.

It must be remembered, however, that in very many cases patents for combinations have been held invalid, not because there was no subject-matter in the combination, but because the

Point to be noticed.

(a) And see *Sarby v. Gloucester Waggon Co.*, 1881, L. R. 7 Q. B. D. 305; *White v. Toms*, 1867, 37 L. J. Ch. 204; *Ormson v. Clarke*, 1862, 13 C. B. N. S. 337; *Jackson v. Need's*, 1885, 2 P. O. R. 191; *Rowcliffe v. Longford Wire Co.*, 1887, 4 P. O. R. 281; *Longbottom v. Shaw*, 1888, 5 P. O. R. 497; 1889, 6 P. O. R. 493; *Williams v. Nye*, 1890, 7 P. O. R. 62; *Newsom v. Mann*, 1890, 7 P. O. R. 307; *In re Gaulard and Gibbs' Patent*, 1890, 7 P. O. R. 380; *Tucker v. Kaye*, 1891, 8 P. O. R. 58, 234; *Rockcliffe v. Priestmann*, 1898, 15 P. O. R. 157; *Duckett v. Duckett and Sankey*, 1899, 16 P. O. R. 359; *Electric Construction Co. v. Imperial Tramways Co.*, 1900, 17 P. O. R. 545; *Stohwasser v. Humphreys*, 1901, 18 P. O. R. 123; *Wilson v. Wilson*, 1901, 18 P. O. R. 152; *In re Justices' Patent*, 1901, 18 P. O. R. 246.

claims of the specification were unskillfully framed, and did not point out wherein the novelty consisted. These must not be confused with the cases which have been decided on subject-matter, *e.g.*, *Moore v. Bennett* (Griff. P. C. 158); *Allen v. Oates and Green* (1898, 15 P. O. R. 301, 747); *Kynoch v. Webb* (1900, 17 P. O. R. 107).

Type case,
where com-
bination
patent held
valid.

The case of *The Anti-Vibration Incandescent Lighting Co. v. Crossley* (1905, 22 P. O. R. 445) is an interesting instance of the length to which the Courts will go in conceding invention, where a new and useful result is attained. In the course of this case most of the "stock" cases on invention were cited. The facts are sufficiently set forth in the judgment of Collins, M.R., who said: "The object of the invention in question is to protect the mantle used in incandescent gas lamps from damage by vibration. The only question before us is one of subject-matter. The claim is for a combination, all the factors in which are old. I will read the provisional specification and the claim in the complete specification. 'The nature of this invention is as follows: An elastically (or spring) suspended frame (or holder) for use with the incandescent gas burners as a preventer or destroyer of vibration. As the incandescent gas burners cannot be used at present in mills and places where there is vibration (the vibration rattling the mantles to pieces) I have overcome this difficulty by making a wire (or metal) holder (or any other substance would do) and by suspending it with elastic (or strings could be used) the gas being conducted by a rubber pipe thus all vibration is overcome and the mantles do not get shaken to pieces. The frame may be made in any form.' Then follows the complete specification, and it concludes thus: 'Having now particularly described and ascertained the nature of this invention, and in what manner the same is to be performed, I declare that what I claim is:—A gas burner fitting combined with a flexible connecting tube and suspended by one or more elastic cords or springs connected thereto, all arranged substantially in the manner as shown and described and for the purposes as hereinbefore set forth.' At the date of the patent a common means of mitigating vibration in the case of portable lamps was to suspend them by elastic cords or springs. The

rendering gas lamps portable by attaching them by flexible tubes to the gas supply was also well known. It is not perhaps quite clear that incandescent gas lamps had been used in this manner, although I am inclined to think on the evidence that they had been. The object, however, of the flexible tube was merely to admit of the lamp being moved from place to place and not to mitigate or destroy vibration, for which special purpose, so far as it appears, it had never been utilised until the patentee introduced it into his combination. I confess I was much impressed by the point made by Mr. Moulton in his opening, that the effect of the patent was to prevent a person, who at this date possessed an elastic arrangement or frame for suspending lamps, and also possessed an incandescent gas lamp made portable by a flexible tube, from hanging the lamp in the frame. I have, however, come to the conclusion that the combination was not so obvious at the date of the patent as to leave no room for invention. The efficacy of the flexible feeding tube as an anti-vibrator had not at that time been realised. All sorts of contrivances for breaking the rigid connection between the source of vibration and the mantle had been tried without success, and it was not until the patentee had combined a hanging arrangement at the top, with a gas supply through a flexible tube at the bottom, that the problem was solved. Thus the contrivance, which is said to be so obvious as to require no invention, occurred to no one, even under the stimulus of an urgent demand, until the patentee hit upon it, and so unpromising did it appear to users, that they could not be introduced to try it without an undertaking to replace the mantles so often as they were shattered by vibration. Under these circumstances I am unable to hold that the learned judge was wrong in his view that subject-matter was established. The appeal must therefore be dismissed " (b).

(b) And see *Harrison v. The Anderston Foundry Co.*, 1876, L. R. 1 A. C. 574; *Hayward v. Hamilton*, 1881, Griff. P. C. 115; *Vickers v. Siddell*, 1890, 7 P. O. R. 292; *Wenham Gas Co. v. Champion Gas Lamp Co.*, 1891, 8 P. O. R. 320; *Boyd v. Horrocks*, 1892, 9 P. O. R. 77; *Ducketts v. Whitehead*, 1895, 12 P. O. R. 189; *Perry v. Société des Lunetiers*, 1896, 13 P. O. R. 659; *The Pneumatic Tyre Co. v. Casswell*, 1896, 13 P. O. R. 187; *Birch v. Harrap & Co.*, 1896, 13

Hence it seems to follow that the utmost that can be said in a statement of principle in these cases is, that the old parts must not continue to perform their functions in a mere "additive" manner—merely in the way they formerly performed those functions when separate. If this be so, the patent is invalid.

New combinations consisting of omissions or substitutions.

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 (c), 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 equivalent (d), 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 (e).

In *White and others v. Bailey and others* (1903, 20 P. O. R. 270) the invention related to the manufacture of pocket-handkerchiefs. Before the plaintiff's machine was invented, the use of two cylinders, one to effect the pattern of the body and the other the pattern of the border, had been common, but in order to effect the change from one cylinder to the other, so

P. O. R. 625; *Moser v. Marsden*, 1896, 13 P. O. R. 30; *Varey v. Walker & Co.*, 1899, 16 P. O. R. 604; *The Electrolytic Plating Co. v. Evans*, 1900, 17 P. O. R. 740; *Taylor and Scott v. Annand*, 1900, 17 P. O. R. 135; *Parker & Co. v. Satchwell & Co.*, 1901, 18 P. O. R. 306; *Patent Exploitation Co. v. Siemens*, 1903, 20 P. O. R. 239; 1904, 21 P. O. R. 546; *Geipel v. Manchester Corporation*, 1904, 21 P. O. R. 45; *Arnott v. Dunlop Pneumatic Tyre Co.*, 1905, 22 P. O. R. 108.

(c) *Booth v. Kennard*, 1857, 1 H. & N. 527; 2 H. & N. 84; 26 L. J. Ex. 23, 305; *Russell v. Cowley*, 1835, 1 Web. P. C. 457; 1 Cr. M. & R. 864; *White and others v. Bailey and others*, 1903, 20 P. O. R.

270.

(d) *Heath v. Unwin*, 1850, 2 Web. P. C. 228, 302; 5 H. L. Cas. 505, 522, 545; *The Badische Anilin und Soda Fabrik v. Levinstein*, 1885, 2 P. O. R. 90.

(e) *Thompson v. James*, 1863, 32 Beav. 570; *Horton v. Mabon*, 1864, 12 C. B. N. S. 437; 16 C. B. N. S. 141; 31 L. J. C. P. 255; *Rushton v. Crawley*, 1870, L. R. 10 Eq. 522; *Murray v. Clayton*, 1872, L. R. 7 Ch. 570; *Jensen v. Smith*, 1885, 2 P. O. R. 249; *Fletcher v. Arden*, 1888, 5 P. O. R. 46; *Tickelpenny v. Army and Navy Co-operative Society*, 1888, 5 P. O. R. 405; *United Horseshoe Co. v. Swedish Horseshoe Co.*, 1887, 6 P. O. R. 1; *Winby v. Manchester Steam Tramways Co.*, 1891, 8 P. O. R. 61.

as to transfer the weaving from the body to the border, there always had been some intermediate mechanism. The plaintiff's machine entirely did away with any intermediate mechanism, and substituted direct action of one cylinder on the other; moreover, an expensive part of the other machinery called a "nog card" was abolished, and cheap and simple "perforated cards" substituted. All the individual parts by which these simplifications were produced were old. Hall, V.C., held the patent valid.

The mere fact that the improvement was the result of accident (*f*), or was one that appeared obvious after it had been made (*g*), 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.

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.

(*f*) *Crane v. Price*, 1841, 1 Web. P. C. 410; *Boulton v. Bull*, 1795, Dav. P. C. 198; *Liardet v. Johnson*, 1778, 1 Web. P. C. 53.

(*g*) *Lyon v. Goddard*, 1893, 10 P. O. R. 343; *Benna Jaffé v. Richardson*, 1894, 11 P. O. R. 111; *Edison v. Smith*, 1894, 11 P. O. R. 398.

(7) An improvement by the omission of a part of an old 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, together with a method of manufacturing it (construed widely).

(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" or "prior publication" 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. 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 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 or publication.

Novelty at
common law.

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 considered 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.

Early cases at
common law.

In the case of *Hasting's Patent* (1567, 1 Web. P. C. 6), 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" (a).

General
principles.

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex v. Arkwright* (1785, 1 Web. P. C. 64), 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* (1871, 5 H. L. 216) (b), Lord Hatherley, L.C., said: "It 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

(a) And see *Darcy v. Allin*, 1602, 1 Web. P. C. 6; *Mitchell v. Reynolds*, 1713, 19 Mod. R. 130; *Liardet v.*

Johnson, 1778, 1 Web. P. C. 52, 53.

(b) See also *Pirrie v. York Street Flax Spinning Co.*, 1893, 10 P. O. R. 37, 39.

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.* (1846, 5 Ex. R. 334; 20 L. J. Ex. 429), 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, and the means by which the public become possessed is immaterial. The law on this point was laid down by Lord Blackburn, in *Patterson v. Gas Light and Coke Co.* (1875, L. R. 3 A. C. 244), in the words of Mr. Hindmarsh (p. 33): “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 and 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.” And in the case of *Humpherson v. Syer* (1887, 4 P. O. R. 407, 414), Fry, L.J., said: “Is it the fair conclusion from the evidence, that some English people under no obligation of secrecy arising

from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent" (c).

Therefore, the question of whether the invention is new or not is one of fact and depends on the circumstances in every case (d).

Having stated the general principles upon which a patent may be attacked for want of novelty, we may now proceed to deal particularly with the cases of "prior user," in which it is alleged that the invention has been previously put into practice within the Realm. (That the invention has been put into practice in a foreign country or in a colony will not invalidate the patent—for a patent may be obtained for importing an invention from abroad.) The prior user must have been public, and the question of the extent of publicity required gives rise to considerable difficulties.

Prior user.

A machine made by a 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 application, there would be a prior user to void the subsequent patent.

Definition of
"public use."

In *Carpenter v. Smith* (1842, 1 Web. P. C. 540; 9 M. & W. 304) (e), the patent sued on was for a lock. The defendant called a witness who proved that a similar lock had been used on a gate adjoining a public road for sixteen years prior to the patent. It was held that this invalidated the patent. 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." In *Re Taylor's Patent* (1896, 13 P. O. R. 487) the patent was for a fire-grate. It was revoked on the ground that a similar grate had been used in a

(c) See also *Lister v. Norton*, 1886, 3 P. O. R. 211; *Westley, Richards & Co. v. Perkes*, 1893, 10 P. O. R. 193.

(d) *Pickard v. Prescott*, 1892, 9 P. O. R. 200.

(e) See also *Stead v. Anderson*, 1846, 2 Web. P. C. 149; *Betts v.*

Neilson, 1868, 3 De G. J. & S. 82; L. R. 3 Ch. 429; *Heath v. Smith*, 1854, 3 E. & B. 256; *Harwood v. G. N. Rail. Co.*, 1865, 29 L. J. Q. B. 193; 2 B. & S. 194; *Croysdale v. Fisher*, 1883, 1 P. O. R. 21; *Lister v. Norton*, 1886, 3 P. O. R. 211; *Re Taylor's Patent*, 1896, 13 P. O. R. 487.

private house in the ordinary way and under no conditions of secrecy.

In *Stead v. Anderson* (1846, 2 Web. P. C. 149) the alleged prior user consisted in the use on a private carriage drive, the principal approach to a private house, of the kind of paving for which the patent was granted, and 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."

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. By manufac-
ture.

In *Betts v. Neilson* (1868, L. R. 3 Ch. 436) 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* (1889, 5 P. O. R. 302, 303) 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* (1843, 1 Web. P. C. 673) (*f*) although, if there is a complete anticipation by prior user, the abandonment of it is nothing, yet 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

(*f*) See also *King, Brown & Co. v. The Anglo-American Brush Co.*, 1889, 6 P. O. R. 414, 424.

never been used for thirty-six 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.*"

Secret user.

In *Smith v. Davidson* (1857, 19 C. S. 691), a Scotch case, 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.* (1858, 5 H. & N. 336), 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."

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.

Dollond's Case.

In *Dollond's case* (1766, 1 Web. P. C. 43) the objection to Dollond's patent was that he was not the inventor of the method of making 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*).

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

(*g*) See also remarks of Buller, J., 463—470; and Dallas, J., in *Hill v. Boulton v. Bull*, 1795, 2 H. Bl. *Thompson*, 1818, 1 Web. P. C. 244.

appearance or other qualities, does not disclose the invention, 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 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 recognised the difficulty of this question. Baron Parke, in *Morgan v. Seacard* (1837, 2 M. & W. 544; 1 Web. P. C. 192), 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." Romer, J., in *re Miller's Patent* (1898, 15 P. O. R. 213), said: "I think it might be said to be still open in some respects for further consideration by the Court whether a person who discovers a secret process and uses the benefit of that secret process to manufacture an article which he sells publicly and commercially,

Secret use by
patentee.

and obtains considerable benefit from it, and then seeks to obtain a patent for that very same process, is entitled to hold that patent under those circumstances." 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. 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 (*h*).

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

(*h*) Cf. Lord Campbell's remarks (*obiter*) in *Heath v. Smith*, 1854, 2 Web. P. C. 278.

(*i*) *Jones v. Pearce*, 1832, 1 Web. P. C. 124; 2 Coop. Ch. Ca. 58; *Cornish v. Keene*, 1835, 1 Web. P. C. 508; *Galloway v. Bleaden*, 1839, 1 Web. P. C. 525; *Walton v. Bateman*, 1842, 1 Web. P. C. 619; *Winby v. Manchester Steam Tramways*, 1889, 6 P. O. R. 363; *Lyon*

v. Goddard, 1893, 10 P. O. R. 342; *Dick v. Tullis*, 1896, 13 P. O. R. 162.

(*k*) *Young v. Fernie*, 4 Giff. 577, 611; see also *Benno Jaffé v. Richardson*, 11 P. O. R. 110.

(*l*) *Sunlight Incandescent Co. v. Incandescent Gas Light Co.*, 1897, 15 P. O. R. 773; *Electrolytic Plating Apparatus Co. v. Holland*, 1901, 18 P. O. R. 527.

Mere 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, or by others to whom he has lent his machine for that purpose (*m*), nor will the fact that pecuniary profit resulted from such experiments necessarily avoid a subsequent patent (*n*). But if a machine is erected in a place where other people may come who are not bound by any rule of secrecy or faith, in order to use it as a completed thing, the patent will be invalidated (*o*).

Experimental
use.

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 (*p*).

Lord Esher, M.R., speaking on this subject in *Elias v. Grovesend Tinsplate Co.* (1890, 7 P. O. R. 466), 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 machine, to make your machine—if all that is

(*m*) *Bentley v. Fleming*, 1844, 1 Car. & K. 587; 1 C. B. 479; *Useful Patents Co. v. Rylands*, 1885, 2 P. O. R. 262; *Humpherson v. Syer*, 1887, 4 P. O. R. 411; *Elias v. Grovesend Tinsplate Co.*, 1890, 7 P. O. R. 466.

(*n*) *Newall v. Elliot*, 1858, 4 C. B. N. S. 269; *Morgan v. Seaward*, 1837, 2 M. & W. 544; 1 Web. P. C. 195.

(*o*) *Elias v. Grovesend Tinsplate*

Co., 1890, 7 P. O. R. 466; *Hoe v. Foster*, 1899, 16 P. O. R. 33.

(*p*) *Cornish v. Keene*, 1835, 1 Web. P. C. 508; *In re Adamson's Patent*, 1856, 6 Do G. M. & G. 420; 25 L. J. Ch. 456; *Brereton v. Richardson*, 1883, Griff. P. C. 54; 1 P. O. R. 173; *Elias v. Grovesend Tinsplate Co.*, 1890, 7 P. O. R. 462; *Electrolytic Co. v. Holland*, 1901, 18 P. O. R. 527, 528.

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.”

Publication
to an
individual.

The public become possessed of the invention if it is exhibited or published without reserve to any person not under an obligation of secrecy, but if such an individual communicate the invention to a third person, this will amount to publication. The principles which govern the cases of publication to an individual were clearly enunciated in *Humpherson v. Syer* (1887, 4 P. O. R. 413). The patentee had employed one Widmer to make a model of his invention, and it was contended that this constituted a prior publication to Widmer. Cotton, L.J., said: “The question is not a very easy one to settle as regards Widmer in my view. It is perfectly true, as Mr. Widmer said, and Mr. Syer adopts the view, that there was no secrecy about the employment of Mr. Widmer to make a particular article. But it seems to me one must look at the whole case, and ask oneself, not merely by the light of what they say were the oral instructions which passed between them, but also by the light of the understood relations between the two men, whether Widmer really could, in good faith, have disposed of the information which he received from Syer, after he received it—whether he could have used it for his own purposes against the person who gave it to him. I think when a man sends a patent to be made to a shop, you must take what passes orally; you must take all the circumstances of the case, and ask yourself whether there was any confidential relation established between the two parties—whether it was an implied term of the employment that the information should be kept by the shopman to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chose. I think, myself, that this kind of consideration is one which has been applied by this Court in the famous cases of *Tipping v. Clark* and *Prince Albert v. Strange*.” The patent was declared invalid,

however, because whatever the position of Widmer may have been, the invention had been seen by two or three other persons in his shop. Lord Justice Fry said: ". . . . Supposing Widmer was under an obligation to secrecy, that obligation was broken by him because he made the machine in open shop" (g).

The prior sale of an article, even though to one individual only, will nearly always be sufficient to invalidate the patent, since it is strong evidence that the invention was put into use (r). But the question is one of fact for the jury, and still remains open (s). In order for the sale to constitute sufficient evidence, it should be open and in the ordinary way of business (t). The fact that there was no demand for the article will not affect the sale either in law or fact (u). It will be sufficient if only one article be sold (x), and merely for export (y). An offer to sell, even though no sale was effected, will also be evidence of prior publication (z).

Prior sale.

Samples.

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. And the number of the articles which will amount to a sample will depend on the circumstances of each case (a).

Another description of anticipation which is capable of invalidating a patent is prior publication in a document, *i.e.*, the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention

Publication in writing.

(g) And see *Useful Patents Co. v. Rylands*, 1885, 2 P. O. R. 262; *Westley, Richards & Co. v. Perkes*, 1893, 10 P. O. R. 193; *Winby v. Manchester Steam Tramways Co.*, 1891, 8 P. O. R. 66, 67; *Gadd v. Mayor of Manchester*, 1892, 9 P. O. R. 527.

(r) *Wood v. Zimmer*, 1815, Holt, N. P. 58; 1 Web. P. C. 44.

(s) *Gibson v. Campbell*, 1841, 1 Web. P. C. 628.

(t) *Honiball v. Bloomer*, 1854, 2 Web. P. C. 200; *Lister v. Norton*,

1886, 3 P. O. R. 208.

(u) *Losh v. Hague*, 1837, 1 Web. P. C. 205.

(x) *Honiball v. Bloomer*, 1854, 2 Web. P. C. 200; *Hollins v. Capper*, 1888, 5 P. O. R. 291.

(y) *Carpenter v. Smith*, 1841, 1 Web. P. C. 536.

(z) *Orley v. Holden*, 1860, 8 C. B. N. S. 666; *Mullins v. Hart*, 1852, 3 C. & K. 297.

(a) *The Useful Patents Co. v. Rylands*, 1885, Griff. P. C. 234; 2 P. O. R. 255.

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. 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. 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.

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

Vice-Chancellor Wood, in *Betts v. Menzies* (1862, 3 Jur. N. S. 358), 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

(*b*) *Muntz v. Foster*, 1843, 2 Web. P. C. 94; *Hills v. London Gas Light Co.*, 1860, 29 L. J. Ex. 409; *Hill's v. Evans*, 1862, 31 L. J. Ch. 457; *Betts v. Neilson*, 1868, L. R. 5 H. L. 15; *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 531; *Otto v. Linford*, 1882, 46 L. T. N. S. 39; *Philpot v. Hanbury*, 1885, 2 P. O. R. 33, 43; *Lawrence v. Perry*, 1885, 2 P. O. R. 179; *Barlow v. Baylis*, 1870, Griff. P. C. 44; *Erhlich v.*

Ihlee, 1898, 5 P. O. R. 437; *Gadd v. Mayor, &c. of Manchester*, 1892, 9 P. O. R. 516, 533; *English and American Machinery Co. v. Union Boot Co.*, 1894, 11 P. O. R. 137, 367, 373; *Thierry v. Rickmann*, 1895, 12 P. O. R. 428; *The Shrewsbury and Talbot Cab Co. v. Sterck*, 1896, 13 P. O. R. 56; *Savage v. Harris*, 1896, 13 P. O. R. 368; *Defries v. Sherwood*, 1897, 14 P. O. R. 322.

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. Prior publication must be workable.

When *Betts v. Menzies* (1862, 10 H. L. C. 117, 152, 153) 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 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" (c).

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 (d). *Hills v. London Gas Light Co.* (1858, 29 L. J. Ex. 409) illustrates very clearly the principle laid down by Lord Westbury in *Betts v. Menzies*. 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,

No further experiments should be necessary.

(c) See also *Betts v. Neilson*, 1868, L. R. 3 Ch. 429; L. R. 5 H. L. 1; and n. (b), ante.

(d) *Young v. Fernie*, 1866, 12 W. R. 901; *Carpenter v. Smith*, 1842, 1 Web. P. C. 530; *Gibson v. Brand*, 1841, 1 Web. P. C. 628;

The Househill Co. v. Neilson, 1843, 1 Web. P. C. 718, n.; *Plimpton v. Spiller*, 1877, L. R. 6 Ch. D. 412; *Patterson v. Gas Light and Coke Co.*, 1875, L. R. 3 App. Cas. 239; *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 720.

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* (1862, 31 L. J. Ch. 463) 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* (1885, 2 P. O. R. 43), 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 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.* (1889, 7 P. O. R. 443), 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* (1887, 4 P. O. R. 298) (f) Lord Esher, M.R., said: "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, and he cannot be defeated, because that which is really his invention can be got within general words which describe nothing."

The authorities are summed up in the *Shrewsbury and Talbot Cab Co. v. Sterck* (1896, 13 P. O. R. 56) by Lord Justice A. L. Smith, and by Lord Justice Lindley in *Savage v. Harris* (1896, 13 P. O. R. 368).

Authorities
on suffi-
ciency of
prior publi-
cation
summed up.

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).

(e) See also *Betts v. Neilson*, 1868, L. R. 5 H. L. 15; *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 531; *Bray v. Gardner*, 1887, 4 P. O. R. 405; *American Braided Wire Co. v. Thomson*, 1888, 5 P. O. R. 122; *Dowling v. Billington*, 1890, 7 P. O. R. 204.

(f) See also *Benno Jaffé v.*

Richardson, 1894, 11 P. O. R. 111, 261.

(g) *Lang v. Gisborne*, 1862, 31 Beav. 133.

(h) Per M.R. in *Lang v. Gisborne*, 1862, 31 Beav. 135; see also *Harris v. Rothwell*, 1887, L. R. 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552; 3 P. O. R.

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* (p. 94 (l)), 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 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.

Public must have access for publication.

In *Harris v. Rothwell* (1887, 4 P. O. R. 232), 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

383; 1887, 4 P. O. R. 225; *Pickard v. Prescott*, 7 P. O. R. 361; 9 P. O. R. 195; *Rucker v. London Electric Corporation*, 1900, 17 P. O. R. 283.

(i) *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 730; *Stead v. Williams*, 8 Scott, N. R. 449; *Rucker v. London Electric Corporation*, 1900, 17 P. O. R. 283; and see *The United Horsenail Co. v. Stewart*, 1885, 2 P. O. R. 133.

is most in accordance with the authorities, and the principles which underlie them, may be thus expressed. *Primâ 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 (*k*) and in *Otto v. Steel* (*l*), 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 machinist would understand it, and could make the machine from the drawing without any further information, and without the exercise of ingenuity (*m*).

The publication in a prior specification is conclusive against a subsequent patent, since the object of a specification is to publish to the world.

The Act of
1902.

By sect. 1 of the Patents Act, 1902, the Patent Office is directed to make a search as to the novelty of all applications filed after the 1st day of January, 1905. The search is only to extend to specifications published within fifty years next before the date of the application.

By sect. 2 it is enacted:—

"An invention covered by any patent granted on an application to which sect. 1 of this Act applies shall not be deemed to have been anticipated by reason only of its publication in a specification de-

(*k*) *Plimpton v. Malcolmson*, 1876, Ch. D. 241; 55 L. J. Ch. 196; 3 L. R. 3 Ch. D. 531; 44 L. J. Ch. P. O. R. 109.

257; 45 L. J. Ch. 505; *Plimpton v. Spiller*, 1877, L. R. 6 Ch. D. 412; 47 L. J. Ch. 211. (*m*) *Herrburger v. Squire*, 1889, 6 P. O. R. 198; *Electric Construction Co. v. Imperial Tramways Co.*, 1900, 17 P. O. R. 550.

(*l*) *Otto v. Steel*, 1886, L. R. 31

posited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification."

Therefore as to inventions filed after the 1st of January, 1905, any anticipation may be alleged that would formerly have been available, save a provisional specification not followed by a complete specification (and such have not been published since 1884), and a person who alleges invalidity may not rely solely upon a specification published fifty years before the application. It is submitted that he could use the fifty-year-old specification as evidence to support an allegation of prior user (n). The effect merely seems to be to take away the conclusive nature of such a specification as evidence of prior publication. The Patent Office search does not preclude anyone from attacking the validity of the patent by means of a specification (see the Preface for some remarks on the policy of this Act) which the Office may have overlooked (sect. 1, sub-sect. 9). With regard to applications filed before the commencement of the Act, the old law applies.

An inventor may invalidate his own invention by previous publication in a specification. For instance, if an inventor apply for letters patent and file a complete specification, and after the publication of the specification he abandon it and begin 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 prior provisional specification there would be no publication, since provisional specifications which are subsequently abandoned are not published. A question has arisen as to whether the abandonment of a provisional specification would invalidate a subsequent application. It must be remembered that the Court has power to order the production of the provisional specification, not as an anticipation, but as evidence to establish a prior user, and in the interests of justice. This was done by

**Effect of
abandoning
prior provi-
sional.**

(n) See, on a somewhat similar principle, *The Pneumatic Tyre Co. v. The English Cycle and Tyre Co.*, 1897, 14 P. O. R. 852 (cited on p. 96).

Mr. Justice Wills in *Pneumatic Tyre Co. v. The English Cycle and Tyre Co.* (1897, 14 P. O. R. 852). In *Orley v. Holden* (1860, 8 C. B. N. S. 666) 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 specification filed in support of it was not published, and the second was 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 (p. 708), 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” (o).

But it will be noticed that in this case the argument against the patent was that the abandonment of the first application implied that the invention became dedicated to the public on the 17th September, by which date it would have been necessary to file a complete specification. The Court held that there was no such dedication.

In *Lister v. Norton* (1886) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J.,

(o) Cf. 46 & 47 Vict. c. 57, ss. 13 and 14; also 48 & 49 Vict. c. 63, s. 4.

held that the 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."

Both of these decisions, however, depend upon sects. 8 and 9 of the Patents Act, 1852, and it may well be that the words "to be granted for the same" in those sections, refer to the invention and not to the petition. This, however, would not be the case in construing sect. 14 of the Patents Act, 1883, which is as follows: "*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.*" Here "such patent" which is not to be invalidated, is the patent for which the particular application is made. Hence

the abandonment of an application for provisional protection will not invalidate a subsequent application for the same invention (*Oxley v. Holden* (supra)); but if the invention is put into practice between the filing of the two provisional specifications, the second patent will be void on the ground of prior user merely.

If, however, a provisional specification, *i.e.*, one published prior to 1884, 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 (*p*).

In *Von Heyden v. Neustadt* (1881, 50 L. J. Ch. 128) (*q*) 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: "We are of opinion that if it requires this 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."

"Mosaic of extracts" may not be used.

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 (*r*).

Anticipation in part invalidates patent;

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

(*p*) *Lawrence v. Perry*, 1885, 2 P. O. R. 187; *Stoner v. Todd*, 1876, L. R. 4 Ch. D. 58.

(*q*) See also *Moseley v. Victoria Rubber Co.*, 1887, 4 P. O. R. 252; *Patent Exploitation, Ltd. v. Siemens*, 1903, 20 P. O. R. 239.

(*r*) *Young v. Fernie*, 1866, 4 Giff. 577, 611; *Edison and Swan Electric Light Co. v. Woodhouse*, 1886, Griff. P. C. 93; 4 P. O. R. 106; *Von Heyden v. Neustadt*, 1881, L. R. 14 Ch. D. 230; 50 L. J. Ch. 126; and see footnotes (*k*) and (*l*), p. 84.

of one will avoid the whole (s); 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 (t). save where
invalid claim
subsidiary.

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (1893, 10 P. O. R. 60), 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 the invention practically disappears when the case of the one is considered."

Mr. Justice Kekewich, in *Ehrlich v. Ihlee* (1888, 5 P. O. R. 453), 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" (u). Evidence of
utility may
also be evi-
dence of
novelty.

It is probable that a patent would be invalidated if it could be shown that the invention had been the subject of a prior grant, without any publication. But only a valid prior grant would be sufficient for this purpose (x). Prior grant.

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 Exhibitions.

(s) *Brunton v. Hawkes*, 1821, 4 B. & Ald. 541; *Morgan v. Seaward*, 1837, 2 M. & W. 544; 1 Web. P. C. 196; *Kay v. Marshall*, 2 Web. P. C. 76; *Bloxam v. Elsee*, 1827, 6 B. & C. 178; *Bramah v. Hardcastle*, 1789, 1 Carp. P. C. 168; *Patterson v. Gas Light & Coke Co.*, 1876, L. R. 2 Ch. D. 812, 833; *Cropper v. Smith*, 1884, 1 P. O. R. 87; *The United Horsenail Co. v. Stewart*, 1885, 2 P. O. R. 132. L. R. 6 Ch. D. 427; *British Dynamite Co. v. Krebs*, 1896, 13 P. O. R. 193; *Parker and Smith v. Satchwell & Co.*, 1901, 18 P. O. R. 307.

(u) See also *The American Braided Wire Co. v. Thomson*, 1888, 5 P. O. R. 113, 125; *The British Vacuum Cleaner Co. v. Suction Cleaners*, 1904, 21 P. O. R. 312.

(x) *The Mica Insulator Co. v. The Electrical Co.*, 1898, 15 P. O. R.

(t) *Plimpton v. Spiller*, 1877, 495.

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 any 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.”

The Patents Act, 1886, extends this protection to inventors in respect of exhibitions held out of the United Kingdom (see sect. 3.

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* (1602, Noy. R. 182), 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 (a).

At common law.

In *Boulton v. Bull* (1795, 2 H. Bl. 478), 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* (1691, 2 Salk. 447, 1 Web. P. C. 72), the same judge, in leaving

(a) *Edgebury v. Stephens*, 1691, 2 Salk. 447; 1 Web. P. C. 35; *R. v. Arkwright*, 1785, 1 Web. P. C. 73; *Turner v. Winter*, 1787, 1 Web. P. C. 80; *Morgan v. Seaward*, 1837, 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*, 1887, 4 P. O. R. 462; *Elias v. Grovesend Tinsplate Co.*, 1890, 7 P. O. R. 467; *Ward v. Hill*, 1903, 23 P. O. R. 199.

the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for 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."

Utility a
question of
fact.

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 (*b*). 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* (1842, 1 Web. P. C. 411), 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 pro-

(*b*) *Hill v. Thompson*, 1817, 1 1827, 1 C. & P. 565; *Cornish v. Web. P. C. 237*; *Bloxam v. Elsee*, *Keene*, 1835, 1 Web. P. C. 506.

found research, or whether by some sudden or lucky thought, or mere accident of discovery."

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, and be practically useful at the time when the patent is granted for the purposes indicated by the patentee (c). Test of utility.

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 (d), nor is it affected by the fact that it may be enormously expensive when put in practice (e), 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 (f). Does not depend on commercial success.

In *The Badische Anilin und Soda Fabrik v. Levinstein* (1887, 4 P. O. R. 462), 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."

(c) Per Lindley, L.J., in *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 1892, 9 P. O. R. 417; *Cornish v. Keene*, 1835, 1 Web. P. C. 507; *Easterbrook v. Great Western Railway*, 1885, 2 P. O. R. 507; *Wilson v. Union Oil Mills Co.*, 1892, 9 P. O. R. 70.

(d) *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, L. R. 12 App. Cas. 712, 719, 720; 4 P. O. R. 462, 466; *Otto v. Linford*, 1881, 46 L. T. N. S. 41; *United Telephone Co. v. Bassano*, 1886, 3 P. O. R. 313; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 450; *Kurtz v. Spence*, 1888, 5 P. O. R. 182; *Edison v. Holland*, 1889, 6 P. O. R. 257, 277, 283; *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.*,

1892, 9 P. O. R. 417; *Wilson v. Union Oil Mills Co.*, 1892, 9 P. O. R. 69, 70; *Hopkinson v. St. James and Pall Mall Electric Light Co.*, 1893, 10 P. O. R. 62; *Fawcett v. Homan*, 1896, 13 P. O. R. 405; *Welsbach Incandescent Co. v. New Incandescent Co.*, 1900, 17 P. O. R. 252; 1900, 1 Ch. 850 (but see p. 107).

(e) *Wilson v. Union Oil Mills Co.*, 1892, 9 P. O. R. 69, 70; *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 P. O. R. 462, 466.

(f) *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 P. O. R. 462; *Atkins v. Castner-Kellner Alkali Co.*, 1901, 18 P. O. R. 296.

In *The Sunlight Incandescent Gas Lamp Co. v. The Incandescent Gas Light Co.* (1897, 14 P. O. R. 775), Wills, J., said: "I do not think commercial success is at all the test of utility in a patent. A great many very meritorious patents would go to the wall if it were so . . . it does not in the least follow, because better things have been done afterwards, that it was not a substantial contribution to the knowledge of the world at the time when the patent was taken out."

Nor on being
put into
practice.

The fact that a patent was never put into practice is no proof of the uselessness of the invention. In *Edison v. Holland* (1889, 6 P. O. R. 277, 283), 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"; and Cotton, L.J., in the same case, said: "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* (1881, 46 L. T. N. S. 41), Jessel, M.R., said: "It is quite true that it has been said that it is *prima facie* evidence of want of utility (*g*) 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" (*h*).

Slight amount
of utility
required.

A very slight amount of utility will be sufficient to support a patent. Alderson, B., in *Morgan v. Seaward* (1837, 1 Web. P. C. 186) (*i*), said: "I think if it was of different construction from

(*g*) *Morgan v. Seaward*, 1837, 1 Web. P. C. 186; *Tetley v. Easton*, 1852, Macr. P. C. 63.

(*h*) And see *Galloway's Patent*, 1843, 1 Web. P. C. 727; *Renard v. Levinstein*, 1864, 11 L. T. N. S. 505; *United Telephone Co. v. Maclean*, Scotch Session Cases, 4th

series, 710; see also *United Telephone Co. v. Bassano*, 1886, 3 P. O. R. 313; *Thompson v. Batty*, 1889, 6 P. O. R. 100.

(*i*) See also per Baron Halsbury, L.C., in *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 P. O. R. 462.

any other steam engine, and of *any use* to the public, then that is sufficient." Again, Jessel, M.R., in *Otto v. Linford* (1881, 46 L. T. N. S. 41) (*k*) said: "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" (*l*).

If the patent is for an invention which purports to offer the public a new choice of means to accomplish what has previously been known, that choice must be a useful choice. In *Ward v. Hill* (1903, 20 P. O. R. 199), Vaughan Williams, L.J., said: "I do not agree with Mr. Terrell's proposition and the wide way in which he puts it, that in every claim, if you secure the end which you profess by the letters patent to have in view, that is sufficient to constitute utility. He says that if you present to the public a new choice, or present to the public an alternative mode of procuring a result in a manufacture which is already well known, that in itself is sufficient to constitute utility. I do not think so. I do not conceive that I am saying anything new, or anything different from the decided cases, when I say that in my judgment the alternative, or the choice which is presented to the public, must be a useful alternative or a useful choice" (*m*).

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 (*n*).

Utility, like novelty, is part of the consideration for a grant of letters patent, and if a material portion of the invention be

Want of utility in part only.

(*k*) 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.

(*l*) Per Chatterton, V.-C., in *Pirrie v. York Street Flax Spinning Co.*, 1893, 10 P. O. R. 39; see also *Easterbrook v. Great Western Rail. Co.*, 1885, 2 P. O. R. 201, 210.

(*m*) And see *Welsbach Incandescent Co. v. New Incandescent*, 1900, 17 P. O. R. 252; 1900, 1 Ch. 850.

(*n*) Per Lord Watson in *Morgan v. Windover*, 1890, 7 P. O. R. 136; and see Chap. IV., on "Subject-Matter," p. 39.

useless, there is a failure of consideration, and the patent is altogether void (*o*); 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 (*p*); but want of utility in an immaterial part of a machine, which is not claimed as essential, will not vitiate a patent.

In subsidiary part.

Lord Tenterden, C.J., in *Lewis v. Marling* (1829, 10 B. & C. 25), 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" (*q*).

Tindal, C.J., in *Haworth v. Hardcastle* (1834, 1 Bing. N. C. 190), 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."

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

(*o*) *Simpson v. Holliday*, 1866, L. R. 1 H. L. 315, 322; *Templeton v. Macfarlane*, 1848, 1 H. L. Ca. 595; *Turner v. Winter*, 1787, 1 Web. P. C. 77; *Morgan v. Seaward*, 1837, 2 M. & W. 544; *Bloxam v. Elsee*, 1827, 6 B. & C. 169; *Hill v. Thompson*, 1818, 1 Web. P. C. 232; 3 Mer. 622; *Lawrence v. Perry*, 1885, 2 P. O. R. 179; *The United Horsenail Co. v. Stewart*, 1885, 2 P. O. R. 132; *United Horseshoe and Nail Co. v. Swedish Horsenail*

Co., 1889, 6 P. O. R. 8.

(*p*) *Turner v. Winter*, 1787, 1 Web. P. C. 77; *Bloxam v. Elsee*, 1827, 6 B. & C. 169, 178; *Morgan v. Seaward*, 1837, 2 M. & W. 561.

(*q*) See also *Morgan v. Seaward*, 1837, 2 M. & W. 544; *Haworth v. Hardcastle*, 1834, 1 Bing. N. C. 182; 3 L. J. C. P. 311; *United Horsenail Co. v. Stewart*, 1885, 2 P. O. R. 132; *United Horseshoe and Nail Co. v. Swedish Horsenail Co.*, 1889, 6 P. O. R. 8.

claim (*r*), and it does not show that the patent is bad because one of the methods claimed is preferred to the others (*s*). But the same rule as to falsity of suggestion applies in these cases (*t*).

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

Kay, J., in *Lucas v. Miller* (1885, 2 P. O. R. 160), said: "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it" (*y*).

(*r*) *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 203, 455.

(*s*) *Miller v. Scarle*, 1893, 10 P. O. R. 110; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 437, 455.

(*t*) *Owen's Patent*, 1900, 17 P. O. R. 78, 79.

(*u*) *Cole v. Sequi*, 1888, 5 P. O. R. 495; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 205; *American Braided Wire Co. v. Thomson*, 1888, 5 P. O. R. 113;

Pirrie v. York Street Flax Spinning Co., 1893, 10 P. O. R. 39; *Automatic Airtight Cover, Ltd. v. Stockford*, 1902, 19 P. O. R. 460.

(*x*) See ante, p. 103.

(*y*) See also *Morgan v. Windover*, 1887, 4 P. O. R. 422; *Miller v. Scarle*, 1893, 10 P. O. R. 111; *Ward v. Hill*, 1903, 20 P. O. R. 200.

CHAPTER VII.

THE SPECIFICATION.

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.* ”

Two kinds.

(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 sect. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section 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 sect. 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).*" Disclosure.

(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 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. Internal requirements.

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 "provisional," 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 sect. 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.

History of the title.

After the reign of Anne and prior to the Act of 1852, it was customary for the patent to be granted on deposit of a title sufficient to indicate the nature of the invention. A condition recited in the patent required a complete description to be filed within six months of the date of the grant which otherwise became void. It was necessary, therefore, that the title should sufficiently indicate the nature of the invention, so that frauds might not be committed.

The Act of 1852 did away with this practice, and required a provisional specification to be filed, in addition to the title, if the inventor were not ready to file his complete specification at once. The provisional specification therefore performs the function which was formerly that of the title. By sect. 6 of the Act of 1883 an examination is directed to be made by the Patent Office into the sufficiency of the title; and the Act of 1902 has increased the vigilance of the Office on all matters. The result is that although the legal requirements as to the sufficiency of the title are still in force, since 1883 there has been no case of a patent having been held declared invalid on that account.

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

Use in construction.

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

(*d*) *Househill Co. v. Neilson*, 1843, 1 Web. P. C. 678.

(*e*) *Newton v. Vaucher*, 1852, 21 L. J. Ex. 308; *Oxley v. Holden*,

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 (*f*). 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* (1821, 6 B. Mo. 71) the title was "a new and improved method of making and manufacturing double canvas 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* (1827, 6 B. & C. 169) 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* (1829, 3 C. & P. 611) 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.

Must not be inconsistent with specification.

In *Croll v. Edge* (1850, 9 C. B. 479; 19 L. J. C. P. 261) 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

1860, 8 C. B. N. S. 666; 30 L. J. C. P. 74. Dav. P. C. 354; 2 Coop. Ch. Cas. 57; 1 Stark. R. 205; and see *Rex*

(*f*) *Cochrane v. Smethurst*, 1816, v. *Elsee*, 1785, 1 Web. P. C. 76.

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.

Reason for decisions.

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* (1821, 4 B. & Ald. 558) (g), 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."

No longer exists.

But now that a provisional specification defines the nature of the invention, and the patent is not granted until after the complete specification is filed, it is difficult to see how the patent can be invalid for this reason. Insufficiency of the title is very properly a matter for the Patent Office to consider, and it would appear that the old ground of objection to the title is still preserved when disconformity between the two specifications is considered—see Chap. VIII., *infra*.

It does not appear that the matter has been argued in any recent cases, the ground of decision being invariably, that the invention described was within the title in the particular case considered (h).

In *Sandow v. Szalay* (P. O. R., Dec. 1905), a case in which it was sought to construe the complete specification by the aid of the provisional, the House of Lords held that under the Act of 1883 the patent was granted on the *complete* specification, and that the only function of the provisional was to ascertain the *identity* of the invention, *i.e.*, exactly the function formerly performed by the title.

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

(g) See also *Rex v. Wheeler*, 1819, 2 B. & Ald. 345; *Morgan v. Seaward*, 1837, 2 M. & W. 544; 6 L. J. Ex. 153; *Bloxam v. Elsee*, 1827, 1 Car. & P. 558; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

(h) *Shaw v. Jones*, 1889, 6 P. O. R. 335; *Dowling v. Billington*, 1890, 7 P. O. R. 200; *Pirrie v. York Street Co.*, 1893, 10 P. O. R. 45; but cf. *Leadbeater v. Kitchin*, 1890, 7 P. O. R. 240.

In *Cook v. Pearce* (1843, 8 Q. B. 1062), 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 generality of the title and to that only. Now, the mere vagueness of the title appears

Mere vagueness in title will not vitiate.

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" (i). 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 (k).

In *Neilson v. Harford* (1841, 1 Web. P. C. 333), 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."

Mere
technical
objections
will fail.

Purely technical objections to a title have been held not to affect a patent; in *The Electric Telegraph Co. v. Brett* (1851, 10 C. B. 838; 20 L. J. C. P. 123 (l)), the title of the plaintiff's patent was an "Invention of improvements in giving signals and sounding alarums in distant places by means of electric

(i) This decision was followed by Pollock, C.B., in *Crossley v. Potter*, 1853. See Macr. P. C. 242.

(k) *Nickels v. Haslam*, 1844, 7 M. & G. 385; *Neilson v. Harford*, 1841, 1 Web. P. C. 312; *Morgan v. Seaward*, 1835, 1 Web. P. C. 196; *Hills v. London Gas Co.*, 1858,

5 H. & N. 312; 29 L. J. Ex. 424.

(l) See also *Fisher v. Dewick*, 1838, cited 8 Q. B. 1056; *Beard v. Egerton*, 1846, 2 Car. & K. 667; 3 C. B. 132; *Pirrie v. York St. Flax Spinning Co.*, 1893, 10 P. O. R. 45.

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 (10 C. B. 881), said: "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 was certainly at one time 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.

THE PROVISIONAL SPECIFICATION.—("DISCONFORMITY.")

As we have pointed out, 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

Act of 1852,
sect. 6.

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.

Object of
provisional.

“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” (*m*).

To state the
nature of the
invention
only.

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* (1887, 4 P. O. R. 174; 56 L. T. 347), 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.* (1887, 4 P. O. R. 248; 57 L. T. 142), 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.

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 sub-

(*m*) Per Lindley, L.J., in *Gadd v. Mayor, &c. of Manchester*, 1892, 9 P. O. R. 526; see also *Stoner v. Todd*, 1876, L. R. 4 Ch. D. 59; *Ex parte Bates and Redgate*, 1869, L. R. 4 Ch. 577.

sect. 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. The new machinery of the Act of 1883 does not take away the right of objecting to a patent on the ground that the complete specification describes a wider invention than does the provisional (*n*). 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 (*o*).

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. Discon-
formity.

In *Newall v. Elliott* (1863, 10 Jur. N. S. 955), 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 notion of what his invention is; that

(*n*) *Vickers v. Siddell*, 1890, 7 P. O. R. 303.

(*o*) Post, p. 149 et seq.

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" (*p*). 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* (1863, 4 C. B. N. S. 293), 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."

Provisional performs former function of title.

Lord Chelmsford, in *Penn v. Bibby* (1867, L. R. 2 Ch. 133), 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 perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor

(*p*) Almost the same words were used in *The Cassel Gold Extracting Co. v. The Cyanide Syndicate*, 1895, 12 P. O. R. 257.

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 (*q*). Unless that part which is omitted is an essential part of the invention as originally described (*r*). In *Stoner v. Todd* (1876, L. R. 4 C. D. 58), 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

No discon-
formity by
omission.

(*q*) *Thomas v. Welch*, 1866, L. R. 1 C. P. 201; see also the remarks of Lord Chelmsford in *Penn v. Bibby*, quoted above; *Re Everitt's Patent*, 1886, Griff. L. O. C. 27; *The Pneumatic Tyre Co. v. East London Rubber Co.*, 1897, 14

P. O. R. 98, 582; *Ward v. Hill* 1903, 20 P. O. R. 200.

(*r*) *Bailey v. Robertson*, 1878, 3 A. C. 1062; and see *Vaughan-Williams, L.J.*, in *Ward v. Hill*, 1903, 20 P. O. R. 198.

inventor could perfect its details, the provisional specification as such is not and cannot be known to the public. It is never published unless with the final specification, when they become parts of the same document.”

Need not contain exhaustive description.

Lord Justice Lopes, in *Woodward v. Sansum* (1887, 4 P. O. R. 178), 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* (1878, L. R. 3 A. C. 1075), ‘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.”

After improvements must go into complete.

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 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*" (s).

The Welch patent forms an instructive instance, in point of fact, of the cases in which it has been held that the invention described in the complete specification was within the ambit of the provisional. The validity of this patent was attacked many times on the alleged ground of disconformity, and ultimately in the House of Lords; but the judgment of Romer, J., in *The Pneumatic Tyre Co. v. The East London Rubber Co.* (1897, 14 P. O. R. 98), covers all the arguments. In his provisional specification the inventor describes an improved method of holding solid rubber tyres on to concave wheel rims by means of circular hoops of wire passed through circumferential holes in the edges of the tyre. Towards the end of the specification he said: "The above described improvements are also applicable to cycle and other wheels in present use, or made in the ordinary way, in which case they may be fitted over the existing rubbers without necessarily making any alteration. Or I may substitute in place of the ordinary rubber a lighter or cheaper material such as cork;" he also indicated that his invention might be applied to "cushion tyres." No mention of pneumatic tyres was made, although they were known at that date. In the complete specification he showed the invention as applied to pneumatic tyres, and this turned out to be by far the most valuable part of the invention, the effects produced being quite new, and making the pneumatic tyre, for the first time, a merchantable article. In the provisional specification the chief objects of the invention were stated to be "easy running, reduction of vibration, and the security of the rubbers to the metal rims or felloes." The learned Judge said (p. 99): "The patentee was not bound, in his provisional specification, to detail the advantages of his invention."

(s) See also *Crampton v. The Patents Investment Co.*, 1888, 5 P. O. R. 397; *Crossley v. Beverley*, 1829, 9 B. & C. 64; *Moseley v.*

Victoria Rubber Co., 1887, 4 P. O. R. 248; 57 L. T. 142; *Miller v. Scarle*, 1893, 10 P. O. R. 111.

No doubt, in the first part of his invention, when he is dealing with his tyres when used as the only tyres on a cycle, and not as covers to existing rubbers, he does effect all the three chief objects mentioned above. He certainly obtains one of those objects when his tyre, with its fastening, is applied as a cover to pneumatic rubbers, namely, the securing of their tyre over the existing pneumatic rubber; and if he obtains that and other advantages by the extension, I fail to see why the extension, being useful, is not within the specification. He was not bound, when he came, in his provisional specification, to the extension, to point out its particular advantages; and, indeed, it would have been imprudent, if not impossible, satisfactorily for him to do so, seeing that different advantages might probably be obtained from covering different kinds of existing rubbers" (t).

Unless they
are new
invention.

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 (u).

In the case of *Bailey v. Robertson* (1878, L. R. 3 A. C. 1055), 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

(t) And see the same case on appeal, p. 573; and *Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co.*, 1899, 16 P. O. R. 540; *In re Geipel's Patent*, 1904, 21

P. O. R. 389.

(u) *Edison v. Woodhouse*, 1886, L. R. 32 Ch. D. 523; 3 P. O. R. 175; *Penn v. Bibby*, 1866, L. R. 2 Ch. 135.

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, 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 (*x*).

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 (*y*), 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

A mere extension of the title.

(*x*) See also *Nuttall v. Hargreaves*, 1891, 8 P. O. R. 453; L. R. 1892, 1 Ch. D. 23; *Foxwell v. Bostock*, 1863, 4 Do G. J. & S. 298; *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 742; *Horrocks v. Stubbs*, 1886, 3 P. O. R. 221, 233, 236; *Hutchison v. Pattullo*, 1888, 5 P. O. R. 362; *King v. The Anglo-American Brush Co.*, 1889, 6 P. O. R. 414; 7 P. O. R. 455; *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 1892, 9 P. O. R. 221, 238, 413, 420; L. R. 1892, 2 Ch. 66, 83; L. R. 1892, 3 Ch. 424; *Cera Light Co. v. Dobbie*, 1894, 11 P. O. R. 10, 16; *The Tubeless Pneumatic Tyre Co. v. The Trench Tubeless Tyre Co.*, 1899, 16 P. O. R. 310.

(*y*) *Nuttall v. Hargreaves*, 1891, 8 P. O. R. 456; L. R. 1892, 1 Ch. 23.

within the nature of the invention described in general terms in the provisional specification (z).

In *Gadd v. Mayor, &c. of Manchester* (1892, 9 P. O. R. 527), 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 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" (a).

Border line
cases
protected.

THE COMPLETE SPECIFICATION.

One of the essential considerations for the grant is that the patentee shall completely disclose the nature of his invention and the manner of carrying it into effect. This he does by filing a "complete specification" either at the time of the application or within six months thereof.

The information which must be conveyed by the complete specification is therefore considerably more than that required in a provisional, which need only describe the nature of the invention.

A complete and full disclosure is necessary, as the patent is in the nature of a bargain with the public, and the same principle of good faith must be applied as that which regulates other contracts.

The following are the requirements which a complete specification must fulfil, and which we shall proceed to treat in detail:—

1. It must set forth in clear language, free from ambiguity, the nature of the invention and the way it is to be carried

(z) *Siddell v. Vickers*, 1888, L. R. 39 Ch. D. 96.

(a) And see *Chadburn v. Mechan*, 1895, 12 P. O. R. 134.

into effect, so that persons to whom it is addressed would have no difficulty in carrying out the invention from the description.

2. It must be framed in good faith and show clearly the best way of carrying out the invention known to the patentee at the time—including any information he may have acquired since filing a provisional specification subject to the qualification that we have mentioned on p. 122.

PRELIMINARY.

It is important in framing a specification to consider to whom it is intended to convey information. If one wished to instruct a cobbler in a chemical process, the description would have to be of a more detailed and explanatory character than a manufacturing chemist would require. On the other hand, a manufacturing chemist, though an intelligent man, might be unable to follow a description of a boot-repairing process which a cobbler would understand without difficulty. Therefore the language to be used and the completeness of the description will depend entirely on the person to whom it is addressed. It is not sufficient to say that it must appeal to the ordinary workman practising that particular trade; since, for instance, a workman, or even a foreman, in a chemical works might not possess the technical skill and knowledge to understand a new chemical process which the manager would have no difficulty in directing them to put in practice. This must be understood when those judgments, in which the words 'competent workmen' are used, come to be considered.

As an instance, the case of *The Incandescent Light Co. v. The De Mare Incandescent Gas Light Co.* (1896, 13 P. O. R. 327) may be mentioned, where Mr. Justice Wills said: "The subject-matter of the specification is such that no one but a person possessing a very considerable amount of chemical knowledge could, at the date of the specification, be considered a competent workman."

Subject to this qualification the specification must be intelligible to the persons actually conversant with the trade to

which the invention relates, and must be sufficiently full to enable such a person to carry the invention into effect (b).

Questions for
Court and
jury.

Construction.

Whether it be so intelligible and whether it be sufficient are questions of fact in each particular case to be decided by the jury on evidence (c). Where the meaning of a phrase is dubious, or there is a doubtful use of a commonly used word, the construction, as is the case with all documents, is for the Court alone (d). But in the construction of technical words there are involved the questions of intelligibility and sufficiency, and such construction is one of fact to be decided by the jury after hearing the evidence of experts in the trade (e).

“Benevo-
lent” inter-
pretation.

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.* (1876, L. R. 4 C. D. 612), said: “I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bona 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

(b) *Otto v. Linford*, 1882, 46 L. T. (N. S.) 41; *Badische Anilin v. Levinstein*, 1887, 4 P. O. R. 463; *British Dynamite Co. v. Krebs*, 1896, 13 P. O. R. 192; *Tubes, Ltd. v. Perfecta Seamless Tube Co.*, 1903, 20 P. O. R. 96; and see p. 137.

(c) Intelligibility: *Rex v. Arkwright*, 1787, 1 Web. P. C. 70; *Hill v. Thompson*, 1817, 1 Web. P. C. 237. Sufficiency: *Walton v. Bateman*, 1842, 1 Web. P. C. 621; *Beard v. Egerton*, 1849, 8 C. B. 165; 19 L. J. C. P. 38; *Bickford v. Skewes*, 1841, 1 Q. B. 938; *Wal-*

lington v. Dale 1852, 23 L. J. Ex. 49; *British Dynamite Co. v. Krebs*, 1896, 13 P. O. R. 192.

(d) *Neilson v. Harford*, 1841, 1 Web. P. C. 370; *R. v. Wheeler*, 1850, 2 B. & Ald. 348; *Bovill v. Pimm*, 1856, 11 Ex. 740; *Seed v. Higgins*, 1861, 30 L. J. Q. B. 317; 8 H. L. C. 565; *Hills v. Evans*, 1861, 31 L. J. Ch. 460; and see *Brookes v. Steele and Currie*, 1897, 14 P. O. R. 73; and see Index, cap. “Evidence,” and p. 128, post.

(e) *Neilson v. Harford*, 1841, 1 Web. P. C. 370; *Hills v. Evans*, 1861, 31 L. J. Ch. 460.

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* (1877, I. R. & Ch. D. 422), 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."

The word "benevolent" has been interpreted in the following cases:—

In *Otto v. Linford* (1881, 46 L. T. N. S. 39), 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."

In *Needham v. Johnson* (1884, 1 P. O. R. 58), 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."

Lord Esher, M.R., in *Nobel's Explosive Co. v. Anderson* (1894, P. O. R. 530), said (*f*): "It is quite true that the Court has in this specification, as in every other, to put upon it the most favourable construction which it honestly can in favour of

(*f*) See also on this point *Russell v. Cowley*, 1835, 1 Web. P. C. 469; 1 Cr. M. & R. 864; *Thomas v. Forwell*, 1858, 6 Jur. (N. S.) 272; *Binney v. Feldtman*, 1871, Griff. P. C. at p. 50; *Cropper v. Smith*, 1884, Griff. P. C. 62; 1 P. O. R. 88; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 307; *Edison v. Smith*, 1894, 11 P. O. R. 400; *Patent Exploitation, Ltd. v. Siemens Bros.*, 1903, 20 P. O. R. 234.

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."

Usual canons
of construc-
tion.

Lord Chelmsford, in *Harrison v. Anderston Foundry Co.* (1876, L. R. 1 A. C. 581), 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* (1877, L. R. 2 A. C. 423) 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 (*g*).

Technical
terms by
evidence.

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 (*h*), but it will not consider

(*g*) And see *Dudgeon v. Thompson*, 1899, 16 P. O. R. 638.

(*h*) *Elliott v. Turner*, 1845, 2 C. B. 459; *Neilson v. Harford*, 1841, 1 Web. P. C. 370, 313; *Hills v. Evans*, 1862, 31 L. J. Ch. 460;

1877, L. R. 3 App. Cas. 53; *Wegmann v. Corcoran*, 1879, L. R. 13 Ch. D. 76; *The Electric Construction Co. v. Imperial Tramways, Ltd.*,

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 (*i*); 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 (*k*).

Expert evidence.

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 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 (*l*), 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.

Patentee presumed not to claim what is old.

In *Adie v. Clark* (1877, L. R. 2 A. C. 437), 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."

But construction must be fair,

Gadd v. Mayor, &c. of Manchester, 1892, 9 P. O. R. 530.

P. O. R. 506.

(*i*) And see Index, cap. "Evidence."

(*k*) *Gadd v. Mayor, &c. of Manchester*, 1892, 9 P. O. R. 530; *Parkinson v. Simon*, 1894, 11

(*l*) *Haworth v. Hardcastle*, 1834, 1 Web. P. C. 484; *Oxley v. Holden*, 1860, 8 C. B. N. S. 666; *Cropper v. Smith*, 1884, 1 P. O. R. 85; *Lyon v. Goddard*, 1893, 10 P. O. R. 133.

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.

In the case of *Hills v. London Gaslight Co.* (27 L. J. Ex. 60), 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?

and according
to knowledge
at the time.

A specification is to be construed with reference to the state of knowledge at the time it is published (*m*). Lord Esher, in *Nobel's Explosives Co. v. Anderson* (1894, 11 P. O. R. 523), said: "Now what is the very first canon of construction of all written business documents? Why, that the Court ought to construe them as if it had to construe them the day after they were published."

(*m*) And see *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, L. R. 12 App. Cas. 710; 4 P. O. R. 463; *Ellington v. Clark*, 1888, 5 P. O. R. 325; *British Dynamite Co. v. Krebs*, 1896, 18 P. O. R. 193; *The Presto Gear Case Co. v. Orne, Evans & Co.*, 1901, 18 P. O. R. 23; *Patent Exploitation, Ltd. v. Siemens Bros.*, 1903, 20 P. O. R. 28; *The Consolidated Car Heating Co. v. Carne*, 1903, 20 P. O. R. 766.

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 (n), including the drawings (o), and will give an effective meaning to every part of it, if it can. Lord Esher, M.R., in *Parkinson v. Simon* (1894, 11 P. O. R. 502), 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." 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" (p).

The whole to be read.

As to the use of the provisional.

But if the specification has been amended and portions have been deleted, the Court will not look at the deleted portions to interpret what remains (q).

But not amended portions.

The claims at the end of a specification frequently end with the words "as herein described," or "substantially as herein described." The effect of these words on the ambit of the claim both for novelty and infringement depends entirely on the old question, "What is the invention?" In the cases in which the Courts have held that the inventor has discovered a new result, they have refused to limit the ambit of his claim on

Meaning of "as herein described."

(n) *Newton v. Vaucher*, 1851, 6 Exch. 864; 21 L. J. Ex. 305; *Oxley v. Holden*, 1860, 8 C. B. N. S. 666; *Edison v. Woolhouse*, 1887, 4 P. O. R. 107; *Parkinson v. Simon*, 1894, 11 P. O. R. 493, 502; *Tubes, Ltd. v. Perfecta Co., Ltd.*, 1903, 20 P. O. R. 96.

(o) *Hattersley v. Hodgson*, 1904, 21 P. O. R. 525.

(p) Per Lord Esher, M.R., in

Parkinson v. Simon, 1894, 11 P. O. R. 503; but cf. *Sundow v. Szalay*, in the House of Lords, 1905, 22 P. O. R.

(q) *Hattersley v. Hodgson*, 1904, 21 P. O. R. 524; *Jandus Arc Lamp Co. v. Arc Lamp Co.*, 1905, 22 P. O. R. 290. See, however, on this point *Hattersley v. Hodgson*, in the House of Lords, Dec., 1905 (not yet reported).

account of his use of these words (*r*), and the words are consequently superfluous.

On the other hand, if the merit of the invention be in the discovery of a new road to an old result, the words "as herein described" are a useful abbreviation for emphasizing this fact in the claim, and for preventing the Court from possibly interpreting the claim as one for the result itself, a construction which might invalidate the patent (*s*). But beyond having this cautioning effect, they are mere verbiage, as the same result may be obtained by carefully construing the specification (*t*).

It is doubtful whether the word "substantially" is necessary at all (*u*), but if it be used, it probably somewhat neutralises the limiting effect of "as herein described."

Effect of
previous
construction.

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 (*x*), 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 (*y*).

FIRST REQUIREMENT—INTELLIGIBILITY AND SUFFICIENCY.

Nature and
means
separate.

The inventor must point out clearly (1) the nature of his invention and (2) the manner of carrying it into effect.

In *Phillpott v. Hanbury* (1885, 2 P. O. R. 38), Grove, J., said:

(*r*) *United Telephone Co. v. Bassano*, 1886, 3 P. O. R. 315; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, 1895, 12 P. O. R. 257; *Parkinson v. Simon*, 1895, 12 F. O. R. 401; *Welsbach Incandescent Gas Light Co. v. New Incandescent Co.*, 1900, 17 P. O. R. 250.

(*s*) *Easterbrook v. Great Western Rail. Co.*, 1885, 2 P. O. R. 208; *Goddard v. Lyon*, 1894, 11 P. O. R. 361, 362; *Chadburn v. Mehan*, 1895, 12 P. O. R. 134; *Brooks v. Lamplugh*, 1898, 15 P. O. R. 48, 49.

(*t*) *Westinghouse v. Lancashire*

and Yorkshire Rail. Co., 1884, 1 P. O. R. 240.

(*u*) *Young v. Rosenthal*, 1884, 1 P. O. R. 33; *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 240.

(*x*) *Edison v. Holland*, 1889, 6 P. O. R. 276; *The Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 P. O. R. 370, and the various actions on the Welch patent.

(*y*) *Shaw v. Day*, 1894, 11 P. O. R. 189; see also *Edison v. Holland*, 1889, 6 P. O. R. 277.

“By the letters patent, a patentee is required as a condition of his patent, to particularly ascertain and describe the nature of his invention and the means of performing the same. Now those are two quite different things. The object of requiring the patentee to state what his invention is, as has been said (for I am by no means the first who has said it), to let the public know what is the prohibited ground, and what they are not to do—what the patentee has got his grant for, which gives him a monopoly for fourteen years a patentee for the purpose of telling the public what his patent prevents their using without his licence for fourteen years, must give the nature of his invention in reasonably accurate language. . . . Then the second proviso is that he shall also particularly ascertain the means—I repeat the words, though the words are not repeated but implied—of performing the same, that is, of carrying the invention into practical effect. That is a totally different object. The object of that is to prevent what was at one time done and practised, I believe to a large extent, namely, patentees getting patents for an invention and keeping to themselves the ‘trick of the trade,’ if I may use the expression, that is to say, the means of performing it. . . . Letters patent therefore say ‘you shall not have this monopoly unless you do two things—first of all, disclose the nature of the invention and tell the public the prohibited ground ; and secondly, give them the means of carrying it into effect, so that at the expiration of your patent anybody (at all events, anybody with the ordinary knowledge of the particular trade to which it relates) may put your invention into practice.’ ”

Lord Justice Lindley, in *Edison v. Holland* (1889, 6 P. O. R. 280), said: “In complying with the first condition, *i.e.*, in describing the nature 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.”

We will deal with the need of stating the nature of the invention at p. 148.

Intelligi-
bility.

Intelligibility and sufficiency are required. Both depend on the class of person to whom the specification is addressed. An instance is provided by the case of the *Badische Anilin Fabrik v. Levinstein* (1885, L. R. 24 Ch. D. 156). 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 (at p. 161): “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 beta naphthylamine to distinguish it from the naphthylamine which had been known for at least fifteen years before, it does not follow that that naphthylamine would all of a sudden acquire the name of alpha naphthylamine; it would remain in all the books printed up to that time as naphthylamine only, and I am

satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamine simply, would have been supplied with the old naphthylamine, 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 naphthylamine 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 (L. R. 29 C. D. 384), 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 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 (L. R. 12 A. C. 723), Lord Herschell, upon the same point, said: “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.”

Well-known
matters need
not be
described.

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 (z).

In *Heath v. Uncin* (1852, 2 Web. P. C. 245), 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 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

(z) *Crossley v. Beverley*, 1829, 3 C. & P. 513; 1 Web. P. C. 110, n.

unknown to ordinary skilful mechanics and chemists. These are not included in the specification, but must be expressly stated there."

In other words, an inventor is entitled to assume that the persons to whom the specification is addressed possess the ordinary skill of their trade, and he is not required to give directions of a more minute nature than such a person might fairly be expected to need (a). But should the success of the invention depend particularly on the manner in which an old instrument though well known is directed to be used, the directions must lay stress on this point.

Addressees
presumed
competent.

In the *Badische Anilin v. La Société Chimique* (1898, 15 P. O. R. 364), the specification directed that two substances were to be heated together "in an iron autoclave." Now it was proved that in similar operations the trade frequently made use of autoclaves which were not made of iron, and in many such operations enamelled autoclaves had advantages. The success of the plaintiff's process entirely depended upon the use of an iron vessel, without which the reaction would not take place. The specification was declared insufficient.

In *Edison and Swan Electric Light Co. v. Woodhouse* (1886, 3 P. O. R. 183), 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

(a) *Boulton v. Bull*, 1795, 2 H. Bl. 298; *Morgan v. Seaward*, 1836, 1 Web. P. C. 174; *Plimpton v. Malcolmson*, 1876, 3 C. D. 568; *In re Gaulard and Gibbs' Patent*, 1886, 6 P. O. R. 224; *Edison v. Holland*, 1889, 6 P. O. R. 282; *Miller v. Clyde Bridge Steel Co.*, 1891, 8 P. O. R. 201; *Hopkinson v. St. James's and Pall Mall Lighting Co.*, 1893, 10 P. O. R. 61; *Miller v. Scarle*, 1893, 10 P. O. R. 111; *Kane v. Boyle*, 1896, 13 P. O. R. 336.

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 degrees 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 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."

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 (*b*).

Effect of error
and erroneous
theory

And it frequently occurs that the inventor states an erroneous theory as to the operation of the machine or process, the subject

(*b*) Per Lord Westbury, *Simpson v. Holliday*, 1866, 13 W. R. 578; L. R. 1 H. L. 321; see also *Miller v. Scarle*, 1893, 10 P. O. R. 111.

of the invention. This will not invalidate the patent unless it amounts to a misleading statement (c).

The specification must be sufficient to enable the invention to be carried into effect without a series of experiments.

Must not
require
experiment.

Jessel, M.R., in *Plimpton v. Malcolmson* (1876, L. R. 3 C. D. 576), said: "You must not give people mechanical problems and call them specifications."

In *R. v. Wheeler* (1819, 2 B. & Ald. 354), 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 (d).

Lindley, L.J., in *Edison v. Holland* (1889, 6 P. O. R. 282), in his judgment in the Court of Appeal, said: "I feel the great difficulty of 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" (e).

Test of
amount of
experiment.

There is a head note to the case of *Betts v. Neilson* (1868, L. R. 3 Ch. 429), which is apt to mislead; it runs as follows:

(c) *Monnet v. Beck*, 1897, 14 P. O. R. 847.

(d) *Morgan v. Seaward*, 1836, 1 Web. P. C. 176; *British Dynamite Co. v. Krebs*, 1896, 13 P. O. R. 195; *Good. P. C. 93*; *Edison v. Woodhouse*, 1887, 4 P. O. R. 107, 108; *Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 P. O. R. 463; *Thomson v. Batty*, 1889, 6 P. O. R. 97; *Lifeboat Co. v. Chambers*, 1891, 8

P. O. R. 421; *Miller v. Clyde Bridge Steel Co.*, 1891, 8 P. O. R. 201; *Hopkinson v. Pall Mall Electric Light Co.*, 1891, 10 P. O. R. 61; *Miller v. Scarle*, 1891, 10 P. O. R. 111.

(e) See also *Macnamara v. Hulse*, 1842, 2 Web. P. C. 128, n.; *Otto v. Linford*, 1882, 46 L. T. (N. S.) 35; *Simpson v. Holliday*, 1866, L. R. 1 H. L. 315; *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 531.

“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 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.

In *Wegmann v. Corcoran* (1879, L. R. 13 C. D. 67), it was held that the specification of a patent was bad if one of the materials to be used was 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.

But if the inventor describe, under a generic term, an ingredient to be used, and illustrates the term by examples, the mere fact that some things which might be included under the generic term, and which are not described, would not be suitable, will not invalidate the patent. In *Leonhardt v. Kallé* (1895, 12 P. O. R. 116), Romer, J., said: "Now, with reference to that, what has the patentee done, and what really could he do more? He has pointed out numerous oxidisable substances, and admittedly those oxidisable substances he mentioned are as good, if not better, and are more easily dealt with than the other oxidisable substances which are not specifically mentioned. Was it reasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out which of those could not give very useful results, or which might be disregarded?"

Need not give catalogue under generic term.

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.

SECOND REQUIREMENT, GOOD FAITH AND DISCLOSURE OF BEST METHOD.

In *Turner v. Winter* (1787, 1 Web. P. C. 80) (*f*), 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 ambiguity affectingly 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.

(*f*) See also *Gibson v. Brand*, 1841, 1 Web. P. C. 629.

In *Crompton v. Ibbotson* (1828, 1 Web. P. C. 83) (g), 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.

In *Wegmann v. Corcoran* (1879, L. R. 13 C. D. 67), the invention consisted of a special construction of rollers for milling corn. The specification prescribed the use of iron rollers covered with very hard china, turned smooth by the aid of diamond tools. It was proved that china of the requisite hardness had not been made in England for half a century, and that such china could not be made unless the manufacturer tried elaborate experiments. The plaintiff himself obtained his rollers from Italy, where the process of their manufacture was kept secret, but the specification did not mention this fact. The specification was held to be insufficient and misleading. Fry, J., 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." *Sturtz v. De la Rue* (1828, 1 Web. P. C. 83) was a very similar case.

Duty of agent
for foreigner.

It will be seen that *Wegmann v. Corcoran* is distinguishable from the case of *Plimpton v. Malcolmson* (1876, L. R. 3 C. D. 582). 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

(g) See also *Savory v. Price*, 1 Web. P. C. 83.

to tell all that he himself knew, and to give a sufficient description to work the invention.

In *Lewis v. Marling* (1829, 1 Web. P. C. 495), 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." Introduction
of misleading
statements.

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.

And Bayley, J., in *Lewis v. Marling*, said: "His patent is for an instrument where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the patent. If the party knew that it was unnecessary the patent would be bad, on the ground that this was a deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that forms no ground of objection."

Therefore the requirement is not as much for perfection of detail as for good faith on the part of the patentee. This is illustrated by the case of *The British Dynamite Co. v. Krebs* (1896, 13 P. O. R. 195). The inventor, Nobel, described a new explosive (dynamite) which he said, in his specification, was to be made by causing nitro-glycerine, *per se* a very dangerous and erratic liquid, to be absorbed by a non-porous unexplosive substance. He gave a list of such substances which were shown to be more or less useful. The resulting mass was safe and could be stored. He subsequently found that there was a certain, well-known silicious earth called "kieselguhr" which possessed the requisites of porosity and

The best way
known to the
patentee.

power of absorption to a very high degree, and the dynamite actually manufactured was, in consequence, always produced by the aid of this material. Lord Cairns, affirming the judgment of James, L.J., said: "If it had been proved that the inventor, Nobel, knew the best material, which turned out to be a material called 'kieselguhr,' a silicious earth; if he had known of the existence of 'kieselguhr' at the time, and that it would take up 75 per cent. of the nitro-glycerine, whereas some other materials specified by the patentee took up only 25 or 50 per cent., it would have been an objection to his patent to say that he, being in possession of the best mode of producing the most valuable dynamite, had not informed the public of that method."

In *Wood v. Zimmer* (1 Web. P. C. 82, n.), decided so far back as 1815, a very clear idea of the law upon this branch of the subject is given. 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 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 (*h*).

The remarks of Gibbs, C.J., in *Borill v. Moore* (Dav. P. C. 400), go to the same extent; and in *Crossley v. Beverley* (1830, 1 Web. P. C. 117), 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* (1836, 1 Web. P. C. 174) (*i*), 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

Discovery
between pro-
visional and
complete.

(*h*) See *Lewis v. Marling*, 1829, 1 Web. P. C. 495, and *British Dynamite Co. v. Krebs*, 1896, 13 P. O. R. 195, p. 143, *supra*.

(*i*) See also *Turner v. Winter*,

1787, 1 Web. P. C. 81; *Sturt v. De la Rue*, 1878, 5 Russ. 322; *Coles v. Baylis*, 1888, 3 P. O. R. 180.