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THE  
LAW AND PRACTICE  
RELATING TO  
LETTERS PATENT FOR  
INVENTIONS.

BY  
THOMAS TERRELL, K.C.

FIFTH EDITION

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COURTNEY TERRELL,  
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## PREFACE

TO THE FIFTH EDITION.

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THE appearance of a Fifth Edition of this work within four years of the Fourth, may be justified on the ground that the Act of 1907 has come into operation.

The Editor has taken the opportunity of correcting many errors for which he was responsible in the Fourth Edition, and every reference to the reported cases has been carefully checked. Mistakes doubtless remain, but no effort has been spared to attain accuracy in this respect.

The new provisions of the Act of 1907 have required special treatment. Speculation as to the effect of section 27 has been rendered easier by the judgment of Mr. Justice Parker in the case of *Hatschek's Patents*, the full report of which (as appearing in the Reports of Patent Cases) is printed at the end of the Appendix. The legal policy involved in sections 24 and 27 is discussed in Chapter XII. Blank pages are inserted at the end of this chapter, and at those parts of the book dealing with Patent Office practice, in order that the reader may conveniently keep up to date or qualify statements of law which may possibly be affected by new decisions. A corresponding blank has been left opposite to the heading "Notes" in the Index.

The numerous defences available in an action for Infringement are set forth at p. 329, and the precedents of pleading have been revised to meet modern views and requirements.

In the Appendix, at p. 651, will be found a few "Hints" for the preparation of the commoner Agreements and Deeds used in Patent Conveyancing.

A considerable portion of the book has been re-written, and the Editor has ventured to substitute a new chapter on "Subject-matter." He has felt for some time past that a fresh survey was required of this vaguely defined legal territory, but he is far from satisfied with the result of his effort. The writing of Chapter III. has involved a corresponding modification of the views expressed in the chapters on "Novelty" and "Infringement" in the last edition; the three topics are inseparably connected.

The text of the Act of 1907 in the Appendix has been furnished with references to the repealed Acts, and to the text in the book.

The Index has been revised and enlarged.

NEW COURT, TEMPLE,

*September 1st, 1909.*

## TABLE OF CONTENTS.

	PAGE
PREFACE ... ..	iii
TABLE OF CASES ... ..	ix
-----	
CHAP.	
I.—LETTERS PATENT ... ..	1
II.—THE PATENTEE ... ..	15
III.—SUBJECT-MATTER ... ..	34
IV.—NOVELTY ... ..	66
V.—UTILITY ... ..	86
VI.—THE SPECIFICATION ... ..	92
VII.—PROCEDURE ON APPLICATION FOR LETTERS PATENT	133
VIII.—OPPOSITION TO THE GRANT ... ..	155
IX.—AMENDMENT OF SPECIFICATIONS ... ..	172
X.—DEVOLUTION, ASSIGNMENT, AND LICENSES ... ..	192
XI.—EXTENSION OF THE TERM OF A PATENT ... ..	219
XII.—THE REMEDY OF THE PUBLIC AGAINST THE PATENTEE	242
Petition for Compulsory License or Revocation	243
Revocation under section 25 ... ..	248
Revocation under section 26 ... ..	258
Revocation under section 27 ... ..	260
XIII.—ACTION TO RESTRAIN THREATS ... ..	268
XIV.—INFRINGEMENT OF LETTERS PATENT ... ..	282
XV.—ACTION FOR INFRINGEMENT ... ..	318
I.—Parties ... ..	318
II.—Pleadings ... ..	321
III.—Interlocutory Injunction ... ..	346
IV.—Discovery ... ..	353
V.—Inspection ... ..	359
VI.—The Remedy ... ..	363
VII.—The Trial ... ..	381
VIII.—Certificate of Validity ... ..	393
IX.—Certificates as to Particulars ... ..	397
X.—Practice on Appeal ... ..	404

## TABLE OF CONTENTS OF THE APPENDIX.

	PAGE
<b>STATUTES—</b>	
The Statute of Monopolies, 21 Jac. I. c. 3 ... ..	407
The Patents and Designs Act, 1907, 7 Edw. VII. c. 29 ...	411
The Patents and Designs Act, 1908 ... ..	453
The Patents, Designs and Trade Marks Acts, 1883—1902, consolidated (to show the state of the law prior to the Act of 1907) ... ..	454
The Patents, Designs and Trade Marks Act, 1885 ...	488
The Patents, Designs and Trade Marks Act, 1886 ...	490
The Patents, Designs and Trade Marks Act, 1888 ...	492
The Patents Act, 1901 ... ..	495
The Patents Act, 1902 ... ..	496
The International Convention for the Protection of Industrial Property, 1883 ... ..	500
Additional Act, 1900 (modifying the Industrial Property Convention of 1883) ... ..	508
The Patents Rules ... ..	513
Forms ... ..	544
Rules regulating the Practice and Procedure on Appeals to the Law Officers ... ..	571
Rules of the Supreme Court (Patents and Designs), 1908, Order LIIIA. ... ..	574
The Register of Patent Agents Rules, 1908 ... ..	583
Memorandum for Inventors (War Office) ... ..	590
Instructions to Applicants for Patents ... ..	592
<b>FORMS AND PRECEDENTS IN PROCEEDINGS IN AN ACTION</b>	
FOR INFRINGEMENT ... ..	623
Indorsement on Writ ... ..	623
Notice of Motion for Interlocutory Injunction ... ..	623
Affidavit in Support of Notice of Motion ... ..	623
Interlocutory Order to Restrain Infringement (two precedents) ... ..	624
Order refusing Interlocutory Injunction on Terms ...	625
Notice of Motion for Inspection ... ..	625
Order for Inspection of Process ... ..	626
Order for Inspection of Plaintiff's Process by Defendant	626
Order for Inspection and for Delivery by Defendant of Samples for Analysis ... ..	627

	PAGE
<b>FORMS AND PRECEDENTS—<i>continued.</i></b>	
Order for Inspection of Defendant's Process by Experts	627
Statement of Claim (five precedents) ... ..	628
Particulars of Breaches (two precedents) ... ..	630
Statement of Defence and Counterclaim ... ..	631
Particulars of Objections in Action for Infringement, or Petition for Revocation ... ..	633
Order for Further and Better Particulars of Objections...	635
Order for Liberty to Amend Particulars of Objections by adding Fresh Objections on Terms ... ..	635
Notice of Motion for Leave to Amend Specification, Action or Petition pending ... ..	636
Order allowing Application to Amend to proceed ...	636
Order allowing Amendment of Specification on Terms ...	637
Minutes of Judgment for Plaintiff in Default of Defence —Order for Inquiry as to Damages, Injunction and Costs (three precedents) ... ..	637
Certificates necessary under Order LIIIA., Rule 22 ...	642
Certificate of Validity under Section 35 ... ..	642
 <b>FORMS AND PRECEDENTS IN AN ACTION TO RESTRAIN</b>	
THREATS ... ..	642
Indorsement on Writ ... ..	642
Interlocutory Injunction (two precedents) ... ..	643
Injunction ... ..	643
 <b>FORMS AND PRECEDENTS IN A PETITION TO THE HIGH</b>	
COURT FOR REVOCATION ... ..	643
Petition for Revocation ... ..	643
Forms used in obtaining the Fiat of the Attorney- General ... ..	645
 <b>FORMS AND PRECEDENTS IN A PETITION FOR EXTENSION OF</b>	
THE TERM OF A PATENT ... ..	647
Advertisement of Intention to present Petition ... ..	647
Petition ... ..	647
Affidavit of Insertion of Advertisements ... ..	648
Notice of Opposition to Petition ... ..	649
Notice of Grounds of Objection ... ..	649

## CONVEYANCING.

	PAGE
SOME HINTS FOR DRAFTING ASSIGNMENTS AND LICENCES	651
Assignment ... ..	651
Assignment for a District ... ..	652
Agreement for a General Licence ... ..	652
Exclusive Licence ... ..	653
PRECEDENTS FOR THE TRANSFER OF INTERESTS IN LETTERS	
PATENT ... ..	655
Sale of Patent Rights to a proposed Company ... ..	655
Agreement to Assign to the Company ... ..	656
Agreement to Obtain and Assign Patent in consideration of a Sum of Money and Delivery of a number of the Patented Articles ... ..	657
Agreement between Joint Owners for a Partition ... ..	659
Agreement for Working and Selling an Invention, in respect of which an Application for a Patent has been made for the joint benefit of the Inventor and another Person ... ..	661
Assignment of a Patent ... ..	666
Additional Recitals... ..	668
Additional Covenants ... ..	670
Non-exclusive Licence to use Patented Invention in con- sideration of an Annual Payment and the Purchase of the Patented Articles from the Inventor ... ..	675
Exclusive Licence for a District ... ..	678
Mortgage of a Patent ... ..	680
Report of the Proceedings in <i>Hatschek's Patents</i> ... ..	684



## TABLE OF CASES.

---

- A. B.'s Application, *collusive opposition*, 157.
- Acetylene Illuminating Co. v. Midland Acetylene Syndicate, *certificate of validity*, 395.
- Acetylene Illuminating Co. v. United Alkali Co., *convention application*, 33; *subject-matter, analogous use*, 48; *subject-matter, product*, 63; *certificate of validity*, 396; *Ord. LIIIA.*, 222, 399.
- Ackroyd and Best v. Thomas, *undertaking to return costs*, 404.
- Actien Gesellschaft für Cartonaggen Industrie v. Remus and Burgon, *one defendant not defending*, 371.
- Adair's Patent, *extension*, 238.
- Adair v. Young, *infringement, possession*, 313; *infringement on British ship*, 315; *injunction*, 367.
- Adam's Patent, *extension*, 241.
- Adams v. North British Rail. Co., *agent cannot sue*, 320.
- Adamson's Patent, *old grounds of opposition*, 158.
- Adie v. Clark. See Clark v. Adie.
- African Gold Recovery Co., Ltd. v. Sheba Gold Mining Co., Ltd. *licence for fixed term*, 207.
- Aire and Walker's Application, *opposition, second ground*, 162.
- Albo-Carbon Light Co. v. Kidd, *subject-matter*, 56.
- Alcock v. Cooke, *false suggestion*, 8.
- Alexander v. Henry, *damages*, 375.
- Alfred Appleby's Twin-Roller Chain Co., Ltd. v. Albert Eadie Chain Co., *trial by jury*, 382.
- Allan's Patent, *extension*, 225.
- Allen's Patent, *amendment of specification*, 181.
- Allen v. Doulton, *amendment of specification*, 187.
- Allen v. Horton, *amendment of particulars of objections*, 345.
- Allen v. Rawson, *master and servant*, 24.
- Alliance Pure White Lead Syndicate v. MacIvor's Patents, *interrogatories*, 355, 356.
- Alsop Flour Process, Ltd. v. Flour Oxidising Co., Ltd., *particulars of objections*, 336.
- Alsop's Patent, *amendment of specification*, 187.
- Aluminium Co. v. Domeiere, *interim injunction*, 350.
- American Braided Wire Co. v. Thompson, *commercial success and novelty*, 85; *damages*, 375; *damages and discovery*, 377.

- Amory *v.* Brown, *plea of novelty*, 322.
- Andrew's Patent, *costs of three counsel*, 402.
- Andrew *v.* Crossley, *amendment of specification*, 181, 183.
- Anglo-American Brush Corporation *v.* Crompton. *See* Crompton *v.* Anglo-American Brush Corporation.
- Anti-Vibration Incandescent Lighting Co. *v.* Crossley, *subject-matter combination*, 61.
- Apostolloff and Frendenberg's Application, *joint applicants*, 145.
- Appleby Twin-Roller Chain Co. *v.* Albert Eadie Chain Co., *threats*, 277.
- Armstrong's Patent, *amendment of specification*, 189.
- Arnold *v.* Bradbury, *construction of claims*, 130, 131.
- Ashworth's Patent, *amendment of specification*, 180, 181, 182, 183.
- Ashworth *v.* English Card Clothing Co., *subject-matter, construction*, 42 ; *infringement, claim to principle*, 288 ; *infringement, two kinds of invention*, 289 ; *inspection*, 363.
- Ashworth *v.* Law, *estoppel, fraud*, 208.
- Ashworth *v.* Roberts, *infringement, two kinds of invention*, 289 ; *interrogatories*, 355.
- Atkins and Applegarth *v.* Castner-Kellner Alkali Co., *commercial success and utility*, 88.
- Automatic Airtight Cover, Ltd. *v.* Stockford, *utility*, 91.
- Automatic Coal-Gas Retort Co. *v.* Salford, *account of profits*, 378.
- Automatic Weighing Machine Co. *v.* Combined Co., *prior judgment on construction*, 330.
- Automatic Weighing Machine Co. *v.* International Hygienic Society, *certificate of validity*, 396.
- Automatic Weighing Machine Co. *v.* Knight, *subject-matter, principle*, 42 ; *construction of claim*, 42 ; *construction of specification*, 106, 110 ; *infringement, claim to principle*, 287 ; *infringement, two kinds of invention*, 289.
- Automatic Weighing Machine Co. *v.* National Exhibitions Association, *infringement, two kinds of invention*, 289 ; *certificate of validity*, 397.
- Avery's Patent, *applicant's declaration*, 18 ; *revocation*, 25 ; *locus standi*, 251.
- Axmann *v.* Lund, *partnership*, 199 ; *estoppel*, 202.
- Bacon *v.* Spottiswoode, *account of profits*, 378.
- Badische Anilin und Soda Fabrik *v.* Basle Chemical Works, *infringement, contract for delivery abroad*, 310.
- Badische Anilin und Soda Fabrik *v.* Hickson, *infringement, contract for delivery abroad*, 311 ; *costs where two defendants*, 403.
- Badische Anilin und Soda Fabrik *v.* Isler, *ambit of licence*, 204 ; *limited licence*, 210, 212.
- Badische Anilin und Soda Fabrik *v.* Johnson, *aiding infringement*, 306.
- Badische Anilin und Soda Fabrik *v.* La Société Chimique, *amendment of particulars of objections*, 345.

- Badische Anilin und Soda Fabrik *v.* Levinstein, *utility*, 86 ; *commercial success and utility*, 88 ; *degree of utility*, 89 ; *construction of specification*, 108, 111 ; *good faith in specification*, 123 ; *trial with experts*, 382 ; *costs apportioned*, 400 ; *trial in camera*, 382.
- Badische Anilin und Soda Fabrik *v.* Thompson, *no obligation to work in action at common law*, 6, 244, 260 ; *interim injunction*, 353.
- Bagot Pneumatic Tyre Co. *v.* Clipper Pneumatic Tyre Co., *assignee with notice of covenants*, 196.
- Bailey's Patent, *exclusion*, 222, 236.
- Bailey *v.* Robertson, *provisional specification*, 99.
- Baird *v.* Moule's Patent Earth Closet Co., *amendment of particulars of objections*, 345.
- Bairstow's Patent, *fraud committed abroad*, 32.
- Ball's Patent, *extension*, 240.
- Bancroft's Application, *claims to be succinct*, 139.
- Barff and Bower's Patent, *extension*, 230, 239.
- Barney *v.* United Telephone Co., *threats*, 280.
- Bartlett's Application, *opposition, second ground*, 160, 161.
- Basset *v.* Graydon, *ambit of licence*, 204
- Bateman and Moore's Patent, *amendment of specification*, 177.
- Bates' Patent, *extension*, 236.
- Bates and Redgate, *Ex parte, provisional protection*, 29.
- Batley *v.* Kynoch, *particulars of breaches*, 324 ; *inspection*, 360.
- Beard *v.* Egerton, *communication from abroad*, 20, 31.
- Beck and Justice's Patent, *amendment of specification*, 178.
- Bell and Coleman's Patent, *Attorney-General's fiat*, 254.
- Benno Jaffé *v.* Richardson, *prior user*, 72 ; *interrogatories*, 354.
- Bentley *v.* Fleming, *prior use*, 73.
- Berdan's Patent, *In re, M.R. power over rolls*, 173 ; *amendment of specifications*, 183, 184.
- Bergmann *v.* MacMillan, *co-owners*, 198, 209.
- Berliner *v.* Edison-Bell Phonograph Co., *threats*, 265.
- Berry's Patent, *extension*, 229.
- Betts' Patent, *extension*, 233, 235, 236, 238.
- Betts *v.* De Vitre, *order for destruction*, 380 ; *liability of directors*, 403.
- Betts *v.* Gallais, *remedy for infringement prior to Judicature Act*, 379.
- Betts *v.* Menzies, *interim injunction*, 348.
- Betts *v.* Neilson, *prior user*, 69 ; *sufficiency of specification*, 117.
- Betts *v.* Wilmott, *sale by patentee*, 204, 316, 317 ; *injunction*, 368 ; *proof of infringement*, 387.
- Bickford *v.* Skewes, *interim injunction*, 349.
- Bidder *v.* Bridges, *interrogatories*, 358.
- Binney *v.* Feldtman, *construction of specification*, 108.
- Binnington *v.* Hill, *costs apportioned*, 400.

- Birch v. Mather, interrogatories, 355, 356.*
- Blake's Patent, extension, 238.*
- Blakey v. Latham, subject-matter, analogous use, 48; further evidence on appeal, 405.*
- Bloxam v. Elsee, alien enemy applicant, 16; master and servant, 23; utility, 87, 90; title of specification, 93; drawings with specification, 125; devolution on bankruptcy, 193.*
- Bodmer's Patent, extension, 227, 228, 238.*
- Borrowman's Patent, sect. 25, practice, 255.*
- Boulton v. Bull, imported inventions, 30; subject-matter, manufacture, 50; subject-matter, product, 53; subject-matter, process, 57; utility, 86; addressee of specification, 114.*
- Boulton v. Watt, subject-matter, process, 57.*
- Bovill v. Crate, interim injunction, 350; course where several infringers, 371.*
- Bovill v. Moore, good faith in specification, 122; inspection, 359, 360.*
- Bovill v. Pimm, construction of specification, 104.*
- Bowden's Patent Syndicate, Ltd. v. H. Smith & Co., equitable assignee suing alone, 319.*
- Bowman v. Taylor, estoppel, 200, 205.*
- Boyd v. Horrocks, Ord. LIIIA., r. 22...399.*
- Boyd v. The Tootal Broadhurst Lee Co., certificate of validity, 397.*
- Bradford Dyers' Association v. Bury, costs on higher scale, 402.*
- Brake v. Radermacher, agreement for licence, 203.*
- Bray v. Gardner, amendment of specification, 187.*
- Bremer's Patent and Högner's Patent, sect. 27, bonâ fide efforts, 265; sect. 27, burden of proof, 267.*
- Bridge's Application, subject-matter before Comptroller, 145; opposition, second ground, 162.*
- Briggs v. Lardent, assignment of defendant's business, action pending, 320.*
- Britain v. Hirsch, particulars of objections, Ord. LIIIA., r. 21...343; further evidence on appeal, 405.*
- British Dynamite Co. v. Krebs, subordinate claim, 84; ambit of claim for Court, 104; good faith in specification, 120, 122.*
- British Motor Syndicate v. John Taylor & Sons, Ltd., infringement, sending abroad, 312; infringement, possession, 313; infringement, exposure for sale, 314; damages, 374.*
- British Mutoscope v. Homer, patent a franchise, 1; patent not seizable by sheriff, 193.*
- British Ore Concentration, Ltd. v. Minerals Separation, Ltd., particulars of objection, distinguishing new from old, 342.*
- British Tanning Co. v. Groth, convention application, 33; interim injunction, 349, 352.*
- British Thomson-Houston Co. v. Manchester Corporation, Public Authorities Protection Act, 403.*

- British United Shoe Machinery Co. v. A. Fussell, Ltd., *meaning of "invention,"* 38; *subject-matter, combination,* 59, 61, 341; *error in specification,* 117; *history and nature of the claim,* 127, 128, 130; *distinguishing new from old,* 342; *amendment of specification,* 190; *infringement of combination,* 297; *particulars of objections,* 336.
- British United Machinery Co. v. Hugh Claughton, Ltd., *construction of claim,* 131.
- British United Shoe Machinery Co. v. Simon Collier, Ltd., *subject-matter, principle,* 42; *infringement, claim to principle,* 287; *infringement, possession,* 313; *injunction,* 367.
- British United Shoe Machinery Co. v. Thompson, *distinguishing new from old,* 130.
- British Vacuum Cleaner Co. v. Suction Cleaners, Ltd., *subject-matter, principle,* 41; *infringement, two kinds of invention,* 289.
- Brook v. Aston, *demand and invention,* 52.
- Brooks v. Hall, *Ord. LIIIA., r. 22...* 400.
- Brooks v. Lamplugh, *new application of old principle,* 46; *"substantially as described,"* 132; *costs apportioned,* 402.
- Brooks v. Lycett's Saddle and Motor Co., *amendment of specification,* 185; *certificate of validity,* 395.
- Brooks v. Steel and Currie, *intelligibility of specification,* 104; *expert evidence,* 105, 390.
- Brooks & Co., Ltd. v. Rendall, Underwood & Co., Ltd., *certificate of validity, costs,* 394.
- Brown's Patent, *sect. 25, practice,* 255; *particulars of objections, prior user,* 339.
- Brown v. Hastie & Co., Ltd., *estoppel by judgment,* 330.
- Brunton v. Hawkes, *false suggestion,* 8; *one claim invalid,* 84; *title of specification,* 94.
- Bunge v. Higginbotham, *infringement of claim only,* 294; *infringement by equivalents,* 298.
- Burlingham's Patent, *extension,* 225.
- Burt v. Morgan, *threats,* 272.
- Bush v. Fox, *subject-matter, analogous use,* 47.
- C.'s Application, *examiner's report,* 140.
- Caldwell v. Vanvlissingen, *infringement on foreign ship,* 314; *interim injunction,* 349.
- Campion v. Benyon, *title of specification,* 93.
- Canham v. Jones, *no property in secret,* 11.
- Cannington v. Nuttall, *amendment of specification,* 180.
- Cardwell's Patent, *extension,* 221, 231.
- Carez's Patent, *International Convention,* 32.
- Carnegie Steel Co. v. Bell Bros., Ltd., *affidavit of documents,* 356.
- Carpenter v. Smith, *prior user,* 68; *prior sale,* 74.
- Carr's Patent, *extension,* 236.
- Case of Monopolies, *early patent law,* 2, 67.

- Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate, *new application of old principle*, 46 ; *provisional specification*, 97 ; *"substantially as described,"* 131 ; *costs apportioned*, 400.
- Castner-Kellner Alkali Co. v. Commercial Development Co., *particulars of objections, subject-matter*, 340 ; *Ord. LIIIA., r. 22...* 399 ; *costs of shorthand notes*, 402.
- Cerckel's Patent, *sect. 25, practice*, 256.
- Chadburn v. Mehan, *"substantially as described,"* 131.
- Chadburn's Telegraph Co. v. Robinson, *certificate of validity*, 395.
- Challender v. Royle, *threats*, 269, 270, 272, 273, 274, 275, 278, 280.
- Chamberlain and Hookham, Ltd. v. Bradford Corporation, *infringement, claim to principle*, 287 ; *Public Authorities Protection Act*, 403.
- Chambers v. Critchley, *estoppel*, 201.
- Chanter v. Dewhurst, *form of licence*, 203.
- Chanter v. Johnson, *form of licence*, 203.
- Chanter v. Leese, *estoppel*, 201.
- Chappell v. Purday, *alien may have patent*, 15 ; *communication from abroad*, 31.
- Chatwood's Patent, *amendment of specification*, 188.
- Cheavin v. Walker, *use of word "patent" after expiry*, 149.
- Cheetham v. Nuttall, *licence, patent declared invalid*, 207.
- Cheetham v. Oldham, *particulars of breaches*, 325 ; *inspection*, 360.
- Chollett v. Hoffman, *registration of assignment before suing*, 218.
- Church's Patent, *extension*, 227, 228, 239.
- Clark's Patent, *extension*, 239.
- Clark v. Adie, *construction of specification*, 107, 108 ; *distinguishing new from old*, 130 ; *construction of claim*, 132 ; *estoppel*, 206, 208, 209 ; *principles of infringement*, 288 ; *infringement of combination*, 296, 297, 298.
- Clarke v. Fergusson, *interim injunction*, 348.
- Clarke v. Nichols, *interim injunction*, 349, 352.
- Claughten v. Foster, *certificate of validity*, 395.
- Clay v. Allcock, *sufficiency of specification*, 124.
- Clifton's Patent, *sect. 25, practice*, 255.
- Clothworkers of Ipswich, *early patent law*, 2 ; *imported inventions*, 30.
- Cochrane v. Smethurst, *title of specification*, 93.
- Codd v. Bratby, *amendment of specification*, 188.
- Cogent v. Gibson, *assignment before patent obtained*, 194.
- Colley v. Hart, *threats*, 269, 275, 276, 281.
- Combined Weighing Machine Co. v. Automatic Weighing Machine Co., *threats*, 270, 273, 274, 275, 279.
- Compagnie Générale d'Eaux Minérales Trade Marks, *sect. 25, practice*, 256.
- Consolidated Car Heating Co. v. Carne, *construction of specification*, 108 ; *infringement, two kinds of invention*, 289.

- Consolidated Pneumatic Tool Co. *v.* Churchill, *certificate of validity*, 395.
- Cooper's Application, *subject-matter before Comptroller*, 145 ; *subject-matter, product*, 55.
- Cooper's Patent Anchor Rail Joint Co. *v.* British Electric Equipment Co., *Ord. LIIIA., r. 22...*398.
- Cooper's Patent Anchor Rail Joint Co. *v.* The London County Council, *construction of specification*, 108 ; *Ord. LIIIA., r. 22...*399.
- Cornish *v.* Keene, *true and first inventor*, 21 ; *prior user*, 72 ; *utility*, 87.
- Corrigal *v.* Armstrong, Whitworth & Co., *amendment of specification*, 188.
- Crampton *v.* The Patents Investments Co., *certificate of validity in threats action*, 394.
- Crane *v.* Price, "*invention*," 50 ; *utility*, 87.
- Crist's Application, *amendment on opposition*, 166, 179.
- Croll *v.* Edge, *title of specification*, 94.
- Crompton *v.* Anglo-American Brush Corporation, *particulars of objections, insufficiency*, 341 ; *particulars of objection, disconformity*, 342.
- Crompton *v.* Ibbotson, *misleading specification*, 119.
- Cropper *v.* Smith, *construction of specification*, 106, 107 ; *construction of claim*, 132 ; *amendment of specification*, 185 ; *assignment, estoppel*, 200 ; *particulars of objections*, 337 ; *amendment of pleadings on appeal*, 405.
- Crossley *v.* Beverley, *sufficiency of specification*, 114 ; *good faith in specification*, 122 ; *injunction*, 372.
- Crossley *v.* Dixon, *form of licence*, 203 ; *estoppel*, 206, 207.
- Crossley *v.* Potter, *claim too wide*, 125.
- Crossley *v.* The Derby Gas Light Co., *injunction*, 372 ; *account of profits*, 378.
- Crossley *v.* Tomey, *interrogatories*, 356.
- Crossthwaite Fire Bar Syndicate *v.* Senior, *particulars of objections, prior user, inspection*, 338.
- Cumming's Application, *opposition, second ground*, 162.
- Curtis *v.* Platt, *no infringement of invalid patent*, 283 ; *infringement two kinds of invention*, 289.
- Cutlan *v.* Dawson, *covenant to pay fees*, 204.
- Daniel's Application, *opposition, second ground*, 162.
- Dansk Rekybeiffel Syndikat Aktieselskab *v.* Snell, *assignee with notice of covenants*, 195.
- Darby's Patent, *extension*, 231, 234, 241.
- Darcy *v.* Allen, *early patent law*, 2 ; *utility*, 86.
- Dart's Patent, *amendment of specification*, 180.
- Davenport *v.* Jepson, *inspection*, 362.
- Davies' Patent, *extension*, 236.
- Davies *v.* Curtis and Harvey, *covenants for improvements*, 200 ; *estoppel*, 208.

- Daw v. Eley, *interrogatories*, 358 ; *injunction*, 372.  
 Day v. Foster, *threats*, 269, 270, 273.  
 Deeley's Patent, *judgment*, *revocation*, *estoppel*, 254 ; *amendment and estoppel*, 331.  
 Deeley v. Perkes, *amendment of specification*, 256.  
 Dege's Patent, *Attorney-General's fiat*, 251 ; *particulars of objections*, *insufficiency*, 341, 342.  
 De la Rue v. Dickenson, *infringement question of fact*, 283, 392 ; *interrogatories*, 354.  
 Dellwick's Patent, *amendment of specification*, 176.  
 Delta Metal Co. v. Maxim Nordenfelt Co., *interrogatories*, 355 ; *certificate of validity*, 395.  
 Dent v. Turpin, *co-owners*, 197, 198.  
 Dering's Patent, *provisional protection*, 148.  
 Derosne's Patent, *extension*, 221, 233.  
 De Vitre v. Betts, *damages or account*, 373.  
 Dick v. Haslam, *injunction*, 372.  
 Dircks v. Mellor, *interim injunction*, 348.  
 Dixon v. The London Small Arms Co., *infringement by Crown contractors*, 13, 14, 317.  
 Dolbear's Patent, *extension*, 225.  
 Dollond's Case, *secret prior user*, 22, 70.  
 Douglas v. Pintsch's Patent Lighting Co., *threats*, 270.  
 Dowling v. Billington, *injunction*, 365.  
 Dowson, Taylor & Co., Ltd. v. The Drosophore Co., Ltd., *threats*, 274, 279, 281.  
 Drake v. Muntz Metal Co., *inspection*, 361, 362.  
 Dredge v. Parnell, *subject-matter*, 49 ; *threats*, 278.  
 Driffield Cake Co. v. Waterloo Mills Cake Co., *threats*, 270.  
 Drummond's Patent, *sect. 25, practice*, 256.  
 Duckett v. Sankey, *Ord. LIIIA., r. 22...* 398.  
 Ducketts v. Whitehead, *stay of judgment*, 404.  
 Dudgeon v. Thompson, *colourable imitation*, 293 ; *interim injunction*, 348 ; *injunction*, 372.  
 Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co., *infringement by possession*, 314.  
 Dunlop Pneumatic Tyre Co. v. Clifton Rubber Co., *threats*, 276.  
 Dunlop Pneumatic Tyre Co. Ltd. v. Excelsior Tyre Co., *infringement by repair*, 307.  
 Dunlop Pneumatic Tyre Co. v. Moseley, *infringement of combination*, 305.  
 Dunlop Pneumatic Tyre Co. v. Neal, *infringement*, *instructions of patentee*, 304 ; *infringement by repair*, 307.  
 Dunlop Pneumatic Tyre Co. v. North British Rubber Co., *ambit of licences*, 204.  
 Dunlop Pneumatic Tyre Co. v. The Holborn Tyre Co., *infringement by repairing*, 306, 307.  
 Dunlop Pneumatic Tyre Co. v. Wapshare Tube Co., *costs apportioned*, 401 ; *costs on higher scale*, 402.



- Dunncliffe v. Mallett, assignment of part of patent, 196, 318 ; co-owners, 197.*
- Eadie's Patent, opposition, first ground, 159.*
- East India Co. v. Sandys, Great Seal, 7.*
- Easterbrook v. The Great Western Rail. Co., utility, 89 ; "substantially as described," 131.*
- Edgbury v. Stevens, early patent law, 2 ; imported inventions, 30.*
- Edison v. Holland, utility, 88 ; construction of specification, 110 ; addressee of specification, 114 ; action, indemnity, 321 ; prior judgment on construction, 330 ; sect. 35, costs, 393.*
- Edison v. Woodhouse, construction of specification, 109 ; construction of claim, 130.*
- Edison and Swan Light Co. v. Holland, sufficiency of specification, 116.*
- Edison-Bell Phonograph Co. v. Columbia Phonograph Co., particulars of objections, specifications, 339.*
- Edison-Bell Phonograph Co. v. Smith and Young, subject-matter, invention, 37 ; subject-matter, principle, 41 ; construction of claim, 42, 108, 130 ; order for delivery up, 380.*
- Edison-Bell Phonograph Co. v. Waterfield, certificate of validity, 397.*
- Edison Telephone Co. v. India Rubber Co., amendment of particulars of objections, 345.*
- Edisonia, Ltd. v. Forse, master and servant, 28.*
- Edlin v. Pneumatic Tyre Agency, threats, 276.*
- Edmond's Patent, sect. 25, practice, 256.*
- Edmund's Patent, fraud committed abroad, 32, 160 ; stopping patent on opposition, 159 ; "legal representative," 160, 192.*
- Edward's Application, opposition, fourth ground, 167.*
- Ehrlich v. Ihlee, commercial success and novelty, 85 ; utility, 89, 91 ; infringement, two kinds of invention, 289 ; infringement though improvement, 291 ; amendment of particulars of objections, 345.*
- Electric Construction Co. v. Imperial Tramways Co., prior publication, 80 ; construction of claim, 130.*
- Elias v. Grovesend Tinsplate Co., master and servant, 24 ; demand and invention, 52 ; prior user, 73 ; utility, 86 ; construction of claim, 130.*
- Ellington v. Clark, construction of specification, 108.*
- Elmslie v. Boursier, sale of article made abroad by patented process, 308.*
- English and American Machinery Co. v. Gare Machine Co., threats, 276.*
- English and American Machinery Co. v. Union Boot Co., particulars of objections, common knowledge, 341 ; damages, 374.*
- Evans and Otway's Patent, opposition, first ground, 159.*
- Everitt's Patent, provisional specification, 99 ; opposition on convention patent, 166.*

- Fabrique de Produits Chimiques *v.* Lafitte, *certificate of validity*, 397.
- Fairburn *v.* Household, *drawings with specification*, 125.
- Farbenfabriken vorm F. Bayer & Co. *v.* Bowker, *costs on higher scale*, 402.
- Feather *v.* R., *Crown right*, 12, 317.
- Felton *v.* Greaves, *title of specification*, 94.
- Fennessy *v.* Clark, *interrogatories*, 354.
- Ferranti's Patent, *extension*, 221.
- Finch's Patent, *extension*, 229.
- Fletcher's Patent, *the register*, 217.
- Flour Oxidising Co., Ltd. *v.* Carr & Co., Ltd., *prior judgment on construction*, 330.
- Flower *v.* Lloyd, *inspection*, 360.
- Fox's Patent, *drawings with specification*, 125.
- Foxwell *v.* Bostock, *distinguishing new from old*, 130 ; *amendment of specification*, 175, 184 ; *infringement of combination*, 297.
- Foxwell *v.* Webster, *course where several infringers*, 371.
- Frearson *v.* Loe, *infringement by experiments*, 307 ; *injunction*, 364 ; *delivery up*, 380.
- Fusee Vesta Co. *v.* Bryant and May, *threats*, 277.
- Gadd *v.* Mayor, etc., of Manchester, *subject-matter and novelty*, 38 ; *prior publication*, 75 ; *expert evidence*, 105 ; *costs on higher scale*, 402.
- Galloway's Patent, *extension*, 227, 234, 236.
- Galloway *v.* Bleaden, *prior user*, 72.
- Gammons *v.* Singer Manufacturing Co., *indemnity by manufacturer, no subsequent estoppel*, 331.
- Gardner *v.* Broadbent, *interim injunction*, 346, 348, 353.
- Gare's Patent, *M.R.*, *power to amend specification*, 172.
- Garnett's Application, *amendment on opposition*, 166, 179.
- Garthwaite's Patent, *opposition, first ground*, 159.
- Gaulard and Gibbs' Patent, *addressee of specification*, 114 ; *amendment of specification*, 184 ; *Attorney-General's fiat*, 254 ; *sect. 25, practice*, 256 ; *Ord. LIIIA., r. 22...* 398.
- Gavioli *v.* Shepherd, *damages*, 376.
- Geary *v.* Norton, *injunction*, 367.
- Geipel's Patent, *amendment of specification*, 189.
- General Electric Co. *v.* Safety Light and Elevator Co., *interrogatories*, 355, 356.
- Germ Milling Co. *v.* Robinson, *inspection*, 360, 361.
- Gibson and Campbell *v.* Brand, *true inventor and novelty*, 20 ; *subject-matter, process*, 57 ; *prior sale*, 74 ; *licensing is not infringing*, 303 ; *infringement by agents*, 310.
- Gillette Safety Razor Co. *v.* A. W. Gamage, Ltd., *interim injunction*, 350.
- Goddard *v.* Lyon, "*substantially as described*," 131.
- Goerz and Hoegh's Patent, *sect. 25, practice*, 256.

- Gosnell *v.* Bishop, *demand and invention*, 51.  
 Goucher's Patent, *extension*, 241.  
 Goucher *v.* Clayton, *estoppel*, 330.  
 Graham *v.* Campbell, *interim injunction*, 351.  
 Graham *v.* Fanta, *patent agents*, 134.  
 Green's Patent, *opposition, second ground*, 161.  
 Green *v.* Bristol Tanning Co., *interim injunction*, 350.  
 Grenfell and McEvoy's Patent, *joint application*, 134.  
 Guest and Barrow's Patent, *specific reference*, 164.  
 Guyot *v.* Thompson, *revoking licence*, 205.
- Haddan's Patent, *sect. 25, practice*, 255, 322 ; *affidavit of documents*, 356.  
 Hall and others, *In re, amendment of specification*, 191.  
 Hall *v.* Conder, *estoppel*, 201.  
 Hall *v.* Franklin, *beneficed clergyman applicant*, 16.  
 Halsey *v.* Brotherhood, *threats*, 268, 279.  
 Hamilton's Application, *specific reference*, 164.  
 Hampton and Facer's Patent, *amendment of specification*, 179.  
 Hardy's Patent, *extension*, 231, 237.  
 Harrild and Parkins' Application, *amendment on opposition*, 165.  
 Harris *v.* Rothwell, *prior publication*, 78, 79.  
 Harrison *v.* Anderston Foundry Co., *construction of specification*, 107 ; *distinguishing new from old*, 130.  
 Harwood *v.* Great Northern Rail. Co., *subject-matter, analogous use*, 47.  
 Haskell Golf Ball Co. *v.* Hutchison, *subject-matter, manufacture*, 35 ; *threats*, 275, 276 ; *costs apportioned*, 401.  
 Haslam & Co. *v.* Hall, *particulars of breaches*, 325, 326 ; *certificate of validity*, 396.  
 Haslam Foundry Co. *v.* Goodfellow, *amendment of specification*, 188.  
 Haslett *v.* Hutchinson, *the register*, 217.  
 Hassall *v.* Wright, *assignee with notice of licences*, 195 ; *registration of assignment before suing*, 218.  
 Hastings' Patent, *novelty, old common law*, 67.  
 Hatfield's Patent, *opposition, first ground*, 159.  
 Hatschek's Patents, *applicant to revoke under sect. 27...261* ; *"mainly" worked abroad*, 261 ; *sect. 27, part only of machine patented*, 263 ; *"satisfactory reasons,"* 264 ; *bonâ fide efforts*, 265, 266 ; *onus of proof*, 332 ; *petitions may be presented from time to time*, 333 ; *full report of case*, 684 *et seq.*  
 Hattersley *v.* Hodgson, *construction of specification*, 109 ; *amendment of specification*, 185 ; *trial with assessor*, 381.  
 Hattersley and Hodgson's Patent, *amendment of specification*, 178.  
 Haworth *v.* Hardcastle, *utility*, 90 ; *construction of specification*, 107.  
 Haydock *v.* Bradbury, *certificate of validity*, 394.

- Hayne *v.* Maltby, *estoppel*, 206, 209.
- Haythornthwaite's Application, *opposition, second ground*, 161, 162.
- Hayward *v.* Pavement Light Co., *interim injunction*, 348.
- Hazlehurst *v.* Rylands, *particulars of objections*, 337.
- Heald's Patent, *master and servant*, 26.
- Heap *v.* Hartley, *licences*, 202; *the register*, 216.
- Heath's Patent, *extension*, 224, 228, 234.
- Heath and Frost's Patent, *opponent's locus standi*, 156; *amendment of specification*, 179.
- Heath *v.* Unwin, *secret prior user*, 72; *construction of specification*, 113; *good faith in specification*, 121; *infringement, ignorance*, 283.
- Heathfield *v.* Greenway, *particulars of objections, documents*, 339; *particulars of objections, insufficiency*, 341.
- Heine, Solly & Co. *v.* Corden, *interim injunction*, 350.
- Henderson's Patent, *extension*, 225, 226, 230, 233.
- Henderson *v.* Shiels, *estoppel*, 201.
- Henser *v.* Hardie, *infringement negatived by instructions*, 304; *particulars of breaches*, 328.
- Herbert's Patent, *extension*, 225, 230.
- Herrburger *v.* Squire, *prior publication*, 80; *threats*, 272, 277.
- Hesse *v.* Stevenson, *devolution on bankruptcy*, 193.
- Heugh *v.* Chamberlain, *estoppel*, 202, 330.
- Higgins' Patent, *amendment of specification*, 179.
- Hill's Patent, *extension*, 222, 236.
- Hill *v.* Thompson, *false suggestion*, 8; *utility*, 87; *intelligibility of specification*, 103; *interim injunction*, 352, 353.
- Hills *v.* Evans, *prior publication*, 76, 77; *construction of specification*, 104.
- Hills *v.* London Gas Light Co., *prior user*, 70; *construction of specification*, 105.
- Hinde *v.* Osborn, *further evidence on appeal*, 405.
- Hinks *v.* Safety Lighting Co., *demand and invention*, 51, 52; *construction of specification*, 105, 131.
- Hocking *v.* Fraser, *costs apportioned*, 401; *stay of judgment*, 404.
- Hocking *v.* Hocking, *estoppel*, 200, 202; *conditional defence of invalidity*, 331.
- Hodgkins' Application, *opposition, second ground*, 162.
- Hoe *v.* Foster, *prior user*, 73.
- Hoffman *v.* Posthill, *interrogatories*, 356, 357.
- Hoffnung *v.* Salsbury, *threats*, 281.
- Holliday *v.* Heppenstall, *particulars of objections, subject-matter, common knowledge*, 340, 341.
- Holophone, Ltd. *v.* Berend & Co., *interim injunction*, 349.
- Honiball *v.* Bloomer, *prior sale*, 74; *Ord. LIII.A., r. 22...* 399.
- Hopkinson's Patent, *extension*, 230, 239.

- Hopkinson *v.* St. James and Pall Mall Electric Light Co., *addressee of specification*, 114; *amendment of specification*, 190; *injunction*, 371; *costs on higher scale*, 402.
- Horrocks *v.* Stubbs, *estoppel*, 331.
- Horsey's Patent, *extension*, 221.
- Houghton's Patent, *extension*, 230, 234.
- Househill Co. *v.* Neilson, *true inventor and novelty*, 21; *subject-matter in principle*, 39; *prior user*, 70.
- Hudson *v.* Chatteris Engineering Co., *injunction*, 369.
- Hudson, Scott & Sons, Ltd. *v.* Barringer and Others, *prior user by sample*, 74.
- Hughes' Patent, *extension*, 225, 233.
- Hull *v.* Bollard, *particulars of breaches*, 327.
- Hutchinson's Patent, *extension*, 234.
- Huth's Application, *fraud on appeal to L. O.*, 171.
- Incandescent Gas Light Co. *v.* Brogden, *limited licence*, 209, 210.
- Incandescent Gas Light Co. *v.* Cantelo, *limited licence*, 209, 245.
- Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light Co., *addressee of specification*, 103; *infringement, two kinds of invention*, 289; *infringement, taking part only*, 291.
- Incandescent Gas Light Co. *v.* New Incandescent Mantle Co., *aiding infringement*, 305.
- Incandescent Gas Light Co. *v.* Sluce, *injunction*, 372.
- Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., *threats*, 278; *claim narrower than invention*, 293; *costs apportioned*, 401.
- Innes *v.* Short, *aiding infringement*, 306.
- J. and J.'s Application, *opponent's locus standi*, 157.
- Jackson *v.* Needle, *interim injunction*, 349.
- Jackson *v.* Wolstenhulmes, *infringement of claim only*, 292.
- Jameson's Patent, *Attorney-General's fiat*, 251; *judgment, revocation, estoppel*, 254.
- Jandus Arc Lamp Co. *v.* Arc Lamp Co., *amendment of specification*, 185.
- Johnson's Application, *subject-matter before Comptroller*, 145, 163.
- Johnson's Patent, *amendment of specification*, 178.
- Johnson's Patent, *In re, M.R. or L.C., power to amend specification*, 172.
- Johnson's Patent (1908), *extension*, 223, 226, 237, 239, 240.
- Johnson's Patent (1871), *extension*, 232, 237, 238.
- Johnson and Atkinson's Patent, *extension*, 234, 239.
- Johnson *v.* Edge, *threats*, 270, 271, 272.

- Jones' Patent, *patent granted for one invention*, 135 ; *amendment before publication*, 174.
- Jones *v.* Pearce, *prior user*, 72 ; *infringement by experiments*, 307.
- Joy's Patent, *extension*, 227.
- Jupe *v.* Pratt, *infringement, claim to principle*, 286, 287.
- Kane and Pattison *v.* Boyle & Co., *communication from abroad and good faith*, 20 ; *addressee of specification*, 114 ; *amendment of specification*, 190 ; *amendment of specification pleaded*, 323.
- Kay's Patent, *extension*, 236.
- Kay's Patent, *sect. 25, practice*, 256.
- Kaye *v.* Chubb, *prior publication*, 77 ; *costs apportioned*, 401 ; *stay of judgment*, 404.
- Kelly *v.* Batchelar, *infringement negatived by instructions*, 304.
- Kelly *v.* Heathman, *amendment of specification*, 177.
- Kelly's Directories, Ltd. *v.* Gavin and Lloyds, *costs where two defendants*, 403.
- Kempton and Mollan's Application, *opposition settled, result*, 157.
- Kenny's Patent Button-holeing Co. *v.* Somervell, *partnership*, 199.
- Kensington, &c. Electric Light Co. *v.* Lane-Fox Co., *threats*, 272, 273.
- King & Co.'s Trade Mark, *sect. 25, practice*, 256.
- King, Brown & Co. *v.* The Anglo-American Brush Light Co., *prior publication*, 76.
- Klaber's Patent, *subject-matter, combination*, 59 ; *amendment of specification*, 189.
- Kopp *v.* Rosenwald, *subject-matter, product*, 54.
- Kurtz *v.* Spence, *master and servant*, 26 ; *threats*, 270, 271, 272.
- Lake's Application, *amendment of opposition notice*, 168.
- Lake's Patent, *amendment of specification*, 183.
- Lamb *v.* Evans, *master and servant*, 26, 27.
- Lancaster's Application, *opposition, second ground*, 161 ; *amendment on opposition*, 166.
- Lane-Fox's Patent, *extension*, 224.
- Lane-Fox *v.* Kensington and Knightsbridge Electric Lighting Co., *subject-matter, discovery and application*, 43 ; *utility*, 87 ; *amendment of specification*, 187.
- Lang's Patent, *amendment of specification*, 180.
- Lang *v.* Gisborne, *prior publication*, 78.
- Lang *v.* Whitecross Wire and Iron Co., *amendment of specification*, 187.
- Law *v.* Ashworth, *threats*, 281.
- Lawes *v.* Purser, *estoppel*, 206.
- Lawrence's Patent, *extension*, 221, 234.
- Lawrence *v.* Perry, *anticipation by provisional specification*, 83 ; *drawings with specification*, 125 ; *amendment of specification*, 185, 190.

- Lawson v. Donald Macpherson & Co., *licensee, power to sub-license*, 204.
- Lea v. Saxby, *interrogatories*, 354.
- Leadbeater v. Kitchin, *construction of claim*, 130.
- Ledgard v. Bull, *particulars of breaches*, 325.
- Lee's Patent, *extension*, 227.
- Leeds Forge Co. v. Deighton's Patent Flue Co., *injunction*, 372; *damages*, 375.
- Leonhardt v. Kallé, *sufficiency of specification*, 118.
- Lewis' Patent, *judgment, revocation, estoppel*, 254.
- Lewis v. Marling, *false suggestion*, 9; *secret prior user*, 22; *utility*, 90; *misleading specification*, 120, 122.
- Liardet v. Hammond Electric Light Co., *estoppel*, 201.
- Liardet v. Johnson, *accidental invention*, 50; *good faith in specification*, 123.
- Lindon's Patent, *extension*, 241.
- Lister v. Norton, *novelty*, 68; *prior sale*, 74; *abandoned provisional*, 82; *infringement of combination*, 297; *interim injunction*, 349; *interrogatories*, 354.
- Livet's Patent, *extension*, 240.
- London and Leicester Hosiery Co. v. Griswold, *estoppel*, 202.
- Longbottom v. Shaw, *demand and invention*, 52; *Ord. LIIIA., r. 22...* 399.
- Losh v. Hague, *prior sale*, 74; *injunction*, 367; *Ord. LIIIA., r. 22...* 399.
- Lowe's Patent, *extension*, 234.
- Lucas v. Miller, *utility*, 91; *trial by jury*, 382.
- Ludington Cigarette Machine Co., Ltd. v. The Baron Cigarette Machine Co., Ltd., *amendment of specification*, 187.
- Luke's Patent, *opposition, first ground*, 159.
- Lycett Saddle Co., Ltd. v. Brooks, *threats*, 274, 279.
- Lyon v. Goddard, *demand and invention*, 51; *construction of specification*, 107; *stay of judgment*, 404.
- McAlpine v. Mangnall, *devolution on bankruptcy*, 193.
- McCormick v. Gray, *infringement*, 284.
- McCornish v. Gray, *licensing is not infringing*, 303.
- McDougall v. Partington, *estoppel, fraud*, 208; *inspection*, 359, 362.
- MacEvoy's Patent, *opponent's locus standi*, 156.
- McLay v. Lawes & Co., *subject-matter*, 56.
- McNeil and Pearson Fire Alarm Co., *fraud committed abroad*, 160.
- Main's Patent, *In re, convention application*, 33.
- Mandleberg v. Morley, *particulars of breaches*, 324, 326.
- Manton v. Manton, *proof of novelty*, 387.
- Manton v. Parker, *utility*, 86.
- Marsden v. Saville Street Co., *importers inventors*, 18; *communication from abroad*, 31.
- Marshall and Naylor's Patents, *master and servant*, 26. •

- Martin's Patent, *Attorney-General's fiat*, 254.  
 Mathers *v.* Green, *co-owners*, 197.  
 Mathey's Case, *imported inventions*, 30.  
 Max Müller's Patent, *Attorney-General's fiat*, 251.  
 Mellin *v.* Monico, *trial with experts*, 382.  
 Meyer's Application, *opponent's locus standi*, 156.  
 Mica Insulators Co. *v.* Bruce, Peebles & Co., Ltd., *Scotch practice*, 322.  
 Mica Insulator Co. *v.* The Electrical Co., *prior grant*, 85.  
 Middleton *v.* Bradley, *Ord. LIIIA., r. 22...398*.  
 Miller *v.* Clyde Bridge Steel Co., *addressee of specification*, 114 ; *infringement, two kinds of invention*, 289.  
 Miller's Patent, *secret prior user by patentee*, 71 ; *sect. 25, practice*, 256.  
 Miller *v.* Scarle, *utility*, 91 ; *error in specification*, 119 ; *drawings with specification*, 125.  
 Milligan *v.* Marsh, *applicant's declaration*, 18, 19.  
 Mills' Application, *amendment on opposition*, 166, 179.  
 Mills *v.* Carson, *covenant to pay fees*, 201 ; *estoppel*, 203, 207.  
 Minerals Separation Co., Ltd. *v.* Ore Concentration Co., Ltd., *particulars of objection, prior user, process*, 338.  
 Mitchell *v.* The Darley Colliery Co., *inspection*, 363.  
 Monnet *v.* Beck, *error in specification*, 117 ; *costs apportioned*, 401.  
 Montforts *v.* Marsden, *estoppel*, 201 ; *Sale of Goods Act, warranty*, 317.  
 Montgomerie *v.* Paterson, *infringement by agents*, 303.  
 Moore *v.* Bennett, *costs on appeal*, 406.  
 Morgan's Patent, *extension*, 221, 230.  
 Morgan's Patent, *amendment of specification*, 179, 183 ; *revocation, sect. 25, locus standi*, 251.  
 Morgan *v.* Seaward, *false suggestion*, 8 ; *prior user*, 70, 73 ; *one claim invalid*, 84 ; *utility*, 86, 88, 89 ; *addressee of specification*, 114 ; *sufficiency of specification*, 115 ; *good faith in specification*, 123.  
 Morgan *v.* Windover, *subject-matter, analogous use*, 48 ; *prior user*, 69 ; *utility*, 90.  
 Morris and Bastert *v.* Young, *certificate of validity*, 396.  
 Morsey's Patents, *In re, the register*, 216.  
 Moore *v.* Bennett, *distinguishing new from old*, 130 ; *trial with experts*, 382.  
 Moseley *v.* Victoria Rubber Co., *provisional specification*, 96 ; *privilege*, 357.  
 Moser *v.* Marsden, *importers inventors*, 19 ; *amendment of specification*, 184 ; *action, no need to join manufacturer*, 321.  
 Moss *v.* Malings, *amendment of particulars of objections*, 345.  
 Mouchel *v.* Coignet, *costs apportioned*, 402.  
 Mouchel *v.* Cubitt & Co., *covenants for improvements*, 199.  
 Mountain *v.* Parker and Smith, *threats*, 281.



- Muirhead *v.* Commercial Cable Co., *estoppel*, 208; *costs on higher scale*, 402.
- Mullins *v.* Hart, *prior sale*, 74.
- Muntz's Patent, *extension*, 222, 241.
- Muntz *v.* Foster, *subject-matter*, 55; *infringement*, 283; *infringement by experiments*, 308; *interim injunction*, 348; *petition for revocation and action for infringement*, 384.
- Murray *v.* Clayton, *account of profits, discovery*, 377, 379.
- Nadel *v.* Martin, *estoppel*, 201; *further evidence on appeal*, 405.
- Nahnsen's Application, *opposition, second ground*, 162.
- Nairn's Patent, *amendment of specification*, 179.
- Napier's Patent, *extension*, 229.
- Needham *v.* Johnson, *construction of specification*, 106.
- Needham *v.* Oxley, *particulars of breaches*, 324.
- Neil and Others *v.* Neil, *estoppel*, 208.
- Neilson *v.* Betts, *infringement, burden of proof*, 309; *infringement by transport*, 313; *damages or account*, 373.
- Neilson *v.* Harford, *subject-matter, principle*, 40, 42; *construction of specification*, 104; *infringement, claim to principle*, 287; *infringement though improving*, 291.
- Nettlefolds *v.* Reynolds, *particulars of objections, specifications*, 339.
- New Conveyor Co. *v.* Edinburgh Commissioners, *Public Authorities Protection Act*, 403.
- New Inverted Gas Lamp Co., Ltd. *v.* Cope and Timmins, Ltd., *certificate of validity*, 396.
- New Ixion Tyre and Cycle Co. *v.* Spilsbury, *assignee with notice of licences*, 195; *the register*, 216.
- Newall *v.* Elliott, *prior user*, 73; *provisional specification*, 95, 96; *infringement, intention*, 284; *infringement, British ship abroad*, 315; *estoppel, arbitrator's award*, 331.
- Newall *v.* Wilkins, *sect. 35, costs*, 394.
- Newbury *v.* James, *no property in secret*, 11.
- Newcomen *v.* Coulson, *interim injunction*, 351.
- Newton's Application, *specific reference*, 164.
- Newton's Patent, *extension*, 233, 234, 238.
- Newton *v.* Vaucher, *construction of specification*, 109.
- Nickels *v.* Ross, *imported invention*, 31.
- Nobel's Explosives Co. *v.* Anderson, *construction of specification* 106, 108; *infringement only of claim*, 285; *infringement, two kinds of invention*, 286, 288; *infringement of claim only*, 294; *infringement by equivalent*, 302.
- Nobel's Explosives Co. *v.* Jones, Scott & Co., *infringement by possession*, 314; *infringement, custom house agent*, 315.
- Noble's Patent, *extension*, 228.
- Nordenfelt's Application, *amendment of specification*, 179, 180.
- Nordenfelt *v.* Gardner, *infringement of combination*, 295.
- Nordenfelt *v.* The Maxim Nordenfelt Co., *covenants for improvements*, 199.

- North British Rubber Co. *v.* Macintosh, *trial with experts*, 382 ;  
*stay of judgment*, 404.
- North British Rubber Co. *v.* The Gormully and Jeffery Co., *interim injunction*, 350.
- North Eastern Marine Engineering Co. *v.* Leeds Forge Co., *revocation of expired patent*, 248 ; *no declaration of invalidity*, 249.
- Norton's Patent, *extension*, 228, 229.
- Norwood's Patents, *fraud, sect. 15, sub-sect. 2...*252.
- Nunn *v.* D'Albuquerque, *account of profits*, 378.
- Nussey and Leachman's Patent, *extension*, 227.
- Nuttall *v.* Hargreaves, *disconformity*, 101.
- Otto *v.* Linford, *subject-matter, principle*, 40 ; *utility*, 88, 89 ; *construction of specification*, 106 ; *sufficiency of specification*, 116 ; *error in specification*, 117.
- Otto *v.* Steel, *prior publication*, 79 ; *estoppel by judgment*, 330 ; *certificate of validity*, 397.
- Owen's Patent, *utility*, 91 ; *amendment of specification*, 187.
- Oxley *v.* Holden, *prior sale*, 74 ; *abandoned provisional*, 81.
- P.'s Application, *specific reference*, 143.
- Palmer Tyre Co., Ltd. *v.* Pneumatic Tyre Co., Ltd., *costs of shorthand notes*, 402.
- Parker and Smith *v.* Satchwell & Co., *subordinate claim*, 84.
- Parker *v.* Maignen's Filtre Rapide Co., *amendment of particulars of objections*, 345.
- Parkes *v.* Stevens, *subject-matter, combination*, 63.
- Parkinson's Patent, *amendment of specification*, 177.
- Parkinson *v.* Simon, *construction of specification*, 106, 109 ; *construction of claim*, 130, 132 ; "*substantially as described*," 131.
- Parnell's Patent, *the register*, 218.
- Patent Exploitation, Ltd. *v.* Siemens Bros., *construction of specification*, 106, 108.
- Patent Marine Inventions Co. *v.* Chadburn, *preparation for trial*, 382.
- Patent Type Founding Co. *v.* Walter, *inspection*, 361.
- Patterson *v.* Gas Light and Coke Co., *official commissioner patentee*, 16 ; *novelty*, 68 ; *one claim invalid*, 84.
- Patteson *v.* Holland, *petition for revocation and action for infringement*, 384.
- Peach's Patent, *extension*, 238.
- Penn *v.* Bibby, *provisional specification*, 97.
- Penn *v.* Fernie, *sect. 35, costs*, 393.
- Penn *v.* Jack, *damages*, 374 ; *rebutting evidence*, 387.
- Peroni *v.* Hudson, *certificate of validity*, 394.
- Perry *v.* Mitchell, *particulars of breaches*, 328.
- Peter Pilkington, Ltd. *v.* Massey, *infringement though improvement*, 291 ; *Ord. LIIIA., r. 22...*399.

- Phillips *v.* The Ivel Cycle Co., *particulars of objections, subject-matter*, 340 ; *costs apportioned*, 400.
- Philpott *v.* Hanbury, *prior publication*, 76 ; *utility*, 89 ; *intelligibility and sufficiency*, 110.
- Pickard *v.* Prescott, *novelty, issue of fact*, 68 ; *prior publication*, 78 ; *drawings with specification*, 125.
- Pieper's Patent, *extension*, 225, 236, 239.
- Pietschman's Patent, *amendment of specification*, 181.
- Piggott & Co., Ltd. *v.* Corporation of Hanley, *Ord. LIIIA., r.22...*399.
- Pigott *v.* The Anglo-American Telegraph Co., *inspection*, 360.
- Pilkington *v.* Massey, *costs apportioned*, 401.
- Pilkington *v.* Yeakley Vacuum Hammer Co., *communication from abroad*, 31 ; *fraud committed abroad*, 32.
- Pirrie *v.* York Street Flax Spinning Co., *utility*, 89 ; *amendment of particulars of objections*, 346, 406.
- Pitman's Patent, *extension*, 221, 229.
- Pitt's Patent, *amendment of specification*, 182.
- Plimpton *v.* Malcomson, *importers patentees*, 17 ; *communication from abroad*, 31 ; *prior publication*, 79 ; *construction of specification*, 115 ; *misleading specification*, 119 ; *interim injunction*, 349 ; *delivery up*, 380 ; *expert evidence*, 389.
- Plimpton *v.* Spiller, *prior publication*, 79 ; *subordinate claim*, 84 ; *construction of specification*, 106 ; *construction of claim*, 130 ; *particulars of objections, writings*, 340 ; *interim injunction*, 351.
- Pneumatic Tyre Co. *v.* East London Rubber Co., *provisional specification*, 99 ; *disconformity*, 100.
- Pneumatic Tyre Co. *v.* English Cycle and Tyre Co., *evidence of prior user*, 81.
- Pneumatic Tyre Co. *v.* Chisholm, *certificate of validity pleaded*, 323.
- Pneumatic Tyre Co., Ltd. *v.* Puncture Proof Pneumatic Tyre Co., Ltd., *damages*, 374.
- Pneumatic Tyre Co. *v.* Warrilow, *interim injunction*, 351.
- Poole's Patent, *extension*, 236, 238.
- Postcard Automatic Supply Co. *v.* Samuel, *form of licence*, 203.
- Poulton's Patent, *prior user*, 73 ; *Attorney-General's fiat*, 253.
- Presto Gear Case Co. *v.* Orme, Evans & Co., *construction of specification*, 108, 294.
- Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., *remedy for infringement prior to Judicature Act*, 379.
- Printing and Numerical Registering Co. *v.* Sampson, *covenants for improvements*, 199.
- Proctor *v.* Bayley, *infringement by experiments*, 308 ; *infringement, possession*, 313 ; *injunction*, 368.
- Proctor *v.* Bennis, *no duty to warn infringers*, 282 ; *infringement, claim to principle*, 288 ; *infringement, two kinds of invention*, 289 ; *injunction barred by acquiescence*, 373 ; *stay of judgment*, 404.
- Proctor *v.* Sutton Lodge Chemical Co., *certificate of validity*, 397.
- Punchard *v.* Dade, *joint applicants*, 145.

- Railway and Electrical Appliance Co., *In re*, *covenant to pay fees* 196, 205.
- Ralston *v.* Smith, *amendment of specification*, 175.
- Rawes *v.* Chance, *interrogatories*, 354.
- Redges *v.* Mulliner, *estoppel*, 207; *account of profits*, 378.
- R. *v.* Arkwright, *master and servant*, 26; *utility*, 86; *intelligibility of specification*, 103.
- R. *v.* Comptroller-General of Patents, *opposition*, *locus standi*, *Law officer*, 156.
- R. *v.* County Court Judge of Halifax, *patent a franchise*, 1; *jurisdiction of County Court*, 383.
- R. *v.* Crampton, *provisional protection*, 148.
- R. *v.* Elsee, *title of specification*, 93.
- R. *v.* Mill, *amendment of specification*, 175.
- R. *v.* Townsend, *use of word "patent" before sealing*, 149.
- R. *v.* Wallis, *provisional protection*, 148.
- R. *v.* Wheeler, *true and first inventor*, 22; *subject-matter, manufacture*, 36; *subject-matter, process*, 57.
- Renard *v.* Levenstein, *interim injunction*, 349; *interrogatories*, 355.
- Renard *v.* Levenstein, *applicant's declaration*, 19.
- Richmond & Co. *v.* Wrightson, *master and servant*, 28; *true and first inventor declaration*, 29.
- Robb *v.* Green, *master and servant*, 26, 27.
- Roberts' Patent, *extension*, 236.
- Robertson *v.* Purdey, *novelty*, 68; *secret prior user*, 71; *prior grant*, 85; *costs apportioned*, 401.
- Roper's Patent, *extension*, 226.
- Rothwell's Patent, *Attorney-General's fiat*, 254.
- Rothwell *v.* King, *interim injunction*, 348, 349.
- Rowcliffe *v.* Morris, *Ord. LIIIA., r. 22...* 398.
- Russell's Patent, *opposition on first ground*, 159; *co-owners*, 197.
- Russell *v.* Cowley, *construction of specification*, 106; *infringement by equivalent*, 302.
- Russell *v.* Hatfield, *particulars of breaches*, 326.
- Russell *v.* Ledsam, *time for filing specification*, 146; *particulars of objections, t. and f. inventor*, 337.
- Rylands' Patent, *amendment of specification*, 179.
- Rylands *v.* Ashley's Patent Bottle Co., *interrogatories*, 358.
- Saccharin Corporation *v.* Alliance Chemical Co., Ltd., *action on many patents*, 323.
- Saccharin Corporation *v.* Anglo-Continental Co., *certificate of validity*, 396.
- Saccharin Corporation *v.* Chemicals Co., *interim injunction*, 353; *account of profits*, 373; *discovery on inquiry or account*, 377, 380.
- Saccharin Corporation *v.* Dawson, *infringement, burden of proof*, 309; *injunction*, 372; *certificate of validity*, 397.
- Saccharin Corporation *v.* Haines, *interrogatories*, 354.

- Saccharin Corporation *v.* Jackson, *infringement, burden of proof, 309; injunction, 372.*
- Saccharin Corporation *v.* Mack, *infringement, burden of proof, 309.*
- Saccharin Corporation *v.* Reitmeyer & Co., *infringement, intention, 284; infringement, contract for delivery abroad, 311.*
- Saccharin Corporation *v.* Skidmore, *Ord. LIIIA., r. 22...400.*
- Saccharin Corporation *v.* White & Sons, Ltd., *action on many patents, 323.*
- Sachse's Application, *specific reference, 165.*
- Salvo Laundry Co. *v.* Mackie, *particulars of objections, common knowledge, specifications, 341.*
- Samuda, *In re, prior user on opposition, 158.*
- Sadow *v.* Szalay, *provisional specification, 99; construction of specification, 109.*
- Savage *v.* Brindle, *infringement by agents, 304; one defendant not defending, 371.*
- Savage *v.* Harris, *prior publication, 77.*
- Saxby's Patent, *extension, 222, 233, 235.*
- Saxby *v.* The Gloucester Waggon Co., *mode of trial, 381.*
- Scott and Young, *Ex parte, master and servant, 28, 29.*
- Seed *v.* Higgins, *construction of specification, 104; expert witness, 390; infringement, law and fact, 392.*
- Sellers *v.* Dickenson, *infringement of combination, 297.*
- Semet and Solvay's Patent, *extension, 225, 238.*
- Shallenberger's Patent, *International convention, 32.*
- Sharp's Patent, *M.R. or L.C., power to amend specification, 172.*
- Shaw *v.* Beck, *burden of proof, 388.*
- Shaw *v.* Day, *construction of specification, 110.*
- Shaw *v.* The Bank of England, *inspection, 360.*
- Sheehan *v.* Great Eastern Rail. Co., *co-owners, 197, 318.*
- Shoe Machinery Co. *v.* Cutlan, *revocation, judgment, estoppel, 254; particulars of breaches, 327, 328; estoppel by judgment, 330; amendment of particulars of objections, 346, 406; injunction, 366.*
- Shone's Patent, *extension, 231.*
- Shrewsbury and Talbot Co. *v.* Morgan, *amendment of particulars of objections, 345.*
- Siddell's Patent, *Attorney-General's fiat, 254.*
- Siddell *v.* Vickers, *account of profits, 378; order for delivery up, 380.*
- Sidebottom *v.* Fielden, *particulars of objections, specifications, 339; inspection, 362.*
- Siemens *v.* Karo, *particulars of objections, specifications, 339.*
- Simpson *v.* Holliday, *utility, 90; error in specification, 117.*
- Singer Sewing Machine Co. *v.* Wilson, *inspection, 360.*
- Sirdar Rubber Co., Ltd. *v.* Wallington, Weston & Co., *infringement by repair, 307.*
- Skinner *v.* Perry, *threats, 269, 270, 281.*
- Slazenger *v.* Feltham, *prior judgment on construction, 330.*
- Smelting Co. of Australia *v.* Commissioners of Inland Revenue, *licence, stamp, 203.*

- Smith's Patent, *disconformity on application*, 137 ; *opposition, second ground*, 162.
- Smith *v.* Buckingham, *estoppel*, 201.
- Smith *v.* Cropper. *See* Cropper *v.* Smith.
- Smith *v.* Dickenson, *no property in secret*, 11.
- Smith *v.* London and North Western Rail. Co., *co-owners*, 198.
- Smith *v.* Upton, *petition for revocation and action for infringement*, 385.
- Soame's Patent, *extension*, 220, 227, 229.
- Société Anonyme des Manufactures de Glaces *v.* Tilghmann's Patent Sand Blast Co., *licence to sell abroad*, 204, 316.
- Société Anonyme du Générateur du Temple, *In re, Corporation patentee*, 16, 133.
- Société Anonyme Trade Mark, *sect. 25, practice*, 256.
- Southby's Patent, *extension*, 225.
- Southwell and Head's Application, *specific reference*, 165.
- Speckhart *v.* Campbell, *writ, service in Scotland*, 321.
- Spencer *v.* Ancoats Vale Rubber Co., *liability of directors*, 403 ; *further evidence on appeal*, 405.
- Spiel's Patent, "*legal representative*," 160.
- Spilsbury *v.* Clough, *amendment of specification*, 173.
- Standfield's Patent, *extension*, 221.
- Stead *v.* Anderson, *prior user*, 69 ; *infringement, intention*, 283.
- Steiner *v.* Heald, *subject-matter*, 55.
- Stevens *v.* Keating, *infringement by equivalents*, 299.
- Stewart's Application, *opponent's locus standi*, 157 ; *opposition, second ground*, 161.
- Stewart's Patent, *extension*, 223, 240.
- Stewart *v.* Casey, *assignment requires deed*, 194 ; *the register*, 217.
- Stocker *v.* Rodgers, *certificate of validity*, 394.
- Stocking *v.* Llewellyn, *interim injunction*, 353.
- Stoner *v.* Todd, *anticipation by provisional specification*, 83 ; *provisional specification*, 95.
- Stoney's Patent, *extension*, 222, 227, 239.
- Stuart's Application, *stopping patent on opposition*, 159 ; *costs before L. O.*, 170.
- Stubbs' Patent, *opposition, second ground*, 161.
- Sturtz *v.* De la Rue, *misleading specification*, 119 ; *interim injunction*, 352.
- Sugg *v.* Silber, *particulars of objections, Ord. LIIIA., r. 21...344 ; trial by jury*, 381.
- Sunlight Incandescent Gas Lamp Co. *v.* The Incandescent Gas Light Co., *commercial success and utility*, 88 ; *costs apportioned*, 401.
- Sutcliffe *v.* Abbott, *particulars of objections, subject-matter*, 341.
- Swan *v.* Edlin-Sinclair Tyre Co., *inspection*, 360.
- Sykes *v.* Howarth, *infringement by agents*, 303 ; *aiding infringement*, 306 ; *particulars of breaches*, 328.

- Talbot *v.* La Roche, *particulars of breaches*, 325.  
Tattersall's Patent, *opposition, second ground*, 162.  
Taylor's Agreement Trusts, *In re, dissolution of company, merger*, 193.  
Taylor's Patent, *prior user*, 69.  
Taylor *v.* Hare, *estoppel*, 209.  
Temler *v.* Stevenson & Sons, *threats*, 274, 279.  
Tennant's Case, *true and first inventor*, 21; *secret prior user*, 72.  
Terrell, *Re, costs, appeal*, 403.  
Tetley *v.* Easton, *utility*, 88; *good faith in specification*, 121; *interrogatories*, 354.  
Thierry *v.* Rickman, *simplicity and invention*, 52.  
Thomas and Prevost's Application, *amendment on opposition*, 165, 166.  
Thomas' Patents, *extension*, 237.  
Thomas *v.* Foxwell, *construction of specification*, 106.  
Thomas *v.* Hunt, *ambit of licence*, 204.  
Thomas *v.* Welch, *provisional specification*, 99.  
Thompson's Patent, *extension*, 225.  
Thompson's Patent (No. 2), *extension*, 241.  
Thompson *v.* American Braided Wire Co., *subject-matter, product*, 54.  
Thompson *v.* Moore, *infringement, two kinds of invention*, 289; *infringement though improvement*, 291; *estoppel by judgment*, 330.  
Thornborough and Wilks' Application, *opposition, second ground*, 161.  
Thorneycroft's Patent, *extension*, 235.  
Thwaite's Application, *opposition, first ground*, 160.  
Ticket Punch Register Co. *v.* Colley's Patents, Ltd., *undertaking to return costs*, 404.  
Tilghmanns' Patent Sand Blast Co. *v.* Wright and Butler, Ltd., *particulars of breaches*, 326.  
Todd's Application, *opposition, second ground*, 162.  
Tolhausen's Patent, *old grounds of opposition*, 158.  
Tolson *v.* Speight, *construction of specification*, 106.  
Townsend *v.* Haworth, *infringement of combination*, 305; *infringement of claim for use*, 305.  
Travell *v.* Carteret, *false suggestion*, 8.  
Trotman's Patent, *extension*, 237.  
True and the Variable Electric Lamp Syndicate *v.* Bryant Trading Syndicate, *subordinate claim*, 84, 132.  
Tubes, Ltd. *v.* Perfecta Seamless Tube Co., *construction of specification*, 108, 109; *construction of claim*, 131.  
Turner's Patent, *extension*, 236.  
Turner *v.* Hancock, *costs, appeal*, 403.  
Turner *v.* Winter, *utility*, 90; *misleading specification*, 118; *proof of novelty*, 387.  
Tweedale *v.* Ashworth, *infringement, two kinds of invention*, 289; *patenting is not infringing*, 303; *costs apportioned*, 401.  
Tweedale *v.* Howard, *form of licence*, 203.

- Ungar *v.* Sugg, *threats*, 270, 281; *damages*, 375.  
 Union Electrical Power Co. *v.* Electrical Storage Co., *threats*, 281.  
 United Horse Shoe and Nail Co. *v.* Stewart, *utility*, 90; *damages or account*, 373; *damages*, 373, 374, 376.  
 United Horse Shoe and Nail Co., *v.* Swedish Horsenail Co., *utility*, 90; *costs on appeal*, 406.  
 United Phonograph Co. *v.* Young, *certificate of validity*, 395.  
 United Telephone Co. *v.* Bassano, "*substantially as described*," 131.  
 United Telephone Co. *v.* Dale, *infringement of combination*, 305; *injunction*, 373.  
 United Telephone Co. *v.* Donohoe, *admission of infringement*, *damages*, 331.  
 United Telephone Co. *v.* Equitable Telephone Co., *interim injunction*, 350.  
 United Telephone Co. *v.* Harrison, *infringement though improvement*, 291.  
 United Telephone Co. *v.* Henry, *infringement, lending*, 316.  
 United Telephone Co. *v.* London and Globe Telephone Co., *infringement, possession*, 313; *order for delivery up*, 380.  
 United Telephone Co. *v.* Nelson, *infringement by repair*, 307.  
 United Telephone Co. *v.* Patterson, *certificate of validity*, 397.  
 United Telephone Co. *v.* St. George, *certificate of validity*, 397.  
 United Telephone Co. *v.* Sharples, *infringement by experiments*, 308; *infringement, "making use of"*, 312.  
 United Telephone Co. *v.* Walker, *damages*, 376.  
 Universities of Oxford and Cambridge *v.* Richardson, *infringement by possession*, 314; *interim injunction*, 347, 348.  
 Unwin *v.* Heath, *infringement by equivalents*, 300.  
 Upmann *v.* Elkan, *action against carriers*, 315, 369.  
 Useful Patents Co. *v.* Rylands, *prior user*. 73; *prior user by samples*, 74.
- Vaisey's Patent, *sect. 25, practice*, 255.  
 Valveless Gas Engine Co. *v.* Day, *covenants for improvements*, 199.  
 Van de Poele, *In re*, *convention application*, 33.  
 Van Gelder, Apsimon & Co. *v.* Sowerby Bridge Co., *mortgagee's rights*, 196, 320.  
 Van Gelder's Patent, *amendment of specification*, 181, 184.  
 Vavasseur *v.* Krupp, *property in infringing articles*, 380.  
 Vickers *v.* Siddell, *claim*, 127.  
 Vincent's Patent, *old grounds of opposition*, 158.  
 Von Buch's Patent, *opposition, second ground*, 160.  
 Von Heyden *v.* Neustadt, *prior publication*, 75; *sale of article made abroad by patented process*, 309.  
 Vorwerk *v.* Evans, *subject-matter, product*, 53.
- Wallis and Ratcliff's Application, *opposition, second ground*, 162.  
 Walton *v.* Bateman, *prior user*, 72; *infringement*, 282.  
 Walton *v.* Lavater, *assignee plaintiff*, 318.



- Walton *v.* Potter, *infringement question of fact*, 283.
- Wapshare Tube Co. *v.* Hyde Imperial Rubber Co., *equitable assignment*, 194.
- Ward *v.* Hill, *utility*, 86, 89, 91; *provisional specification*, 99; *plea true and first inventor*, 322, 387.
- Ward *v.* Livesey, *covenant to pay fees*, 204.
- Washburn and Moen Manufacturing Co. *v.* Cunard Steamship Co. *action against carriers*, 315, 321, 369, 370.
- Watling's Patent, *Attorney-General's fiat*, 254.
- Watson *v.* Holliday, *Bankruptcy Act, 1869, sect. 31...380*.
- Webb *v.* Kynoch & Co., Ltd., *inspection*, 361.
- Weber's Patent, *sect. 27, bona fide efforts, postponement of revocation*, 266.
- Wegmann *v.* Corcoran, *communication from abroad*, 31; *misleading specification*, 118, 119.
- Welch's Patent, *specific reference*, 164.
- Welsbach Incandescent Gas Light Co., Ltd. *v.* Daylight Incandescent Mantle Co., *certificate of validity*, 397.
- Welsbach Incandescent Gas Light Co., Ltd. *v.* Dowle, *particulars of breaches*, 326, 328; *injunction*, 365.
- Welsbach Incandescent Gas Light Co., Ltd. *v.* New Incandescent Co., *utility*, 89; "*substantially as described*," 131.
- Wenham Gas Co. *v.* The Champion Gas Lamp Co., *construction of claim*, 132; *infringement though improvement*, 291; *particulars of breaches*, 324; *costs on higher scale*, 402.
- Werderman *v.* Société Générale d'Electricité, *assignee with notice of covenants*, 195.
- Westinghouse *v.* Lancashire and Yorkshire Rail. Co., "*substantially as described*," 132; *order for delivery up*, 380.
- Westley *v.* Tolley, *trial by jury*, 382.
- Westley, Richards & Co. *v.* Perkes, *novelty*, 68; *amendment of particulars of objections*, 345; *burden of proof at trial*, 385; *proof of novelty*, 387, 388; *costs apportioned*, 401.
- White and others *v.* Bailey and others, *subject-matter, combination*, 63.
- Whitehouse's Patent, *extension*, 231.
- Whitton *v.* Jennings, *interim injunction*, 352.
- Wield's Patent, *extension*, 233, 241.
- Willans and Robinson's Patent, *extension*, 235.
- Williams *v.* Nash, *time for filing complete specification*, 146.
- Williams *v.* Nye, *subject-matter, combination*, 59.
- Williams *v.* Williams, *no property in secret*, 11.
- Wilson *v.* Union Oil Mills, *licence, stamp*, 203; *estoppel*, 205, 208.
- Wilson *v.* Wilson, *amendment of particulars of objections*, 345, 346.
- Winby *v.* Manchester Steam Tramways Co., *subject-matter, combination*, 63.
- Wirth's Patent, *alien may have patent*, 15, 31.
- Wood *v.* Raphael, *subject-matter, combination*, 60.
- Wood *v.* Zimmer, *prior sale*, 74; *good faith in specification*, 121.

- Woodward *v.* Sansum, *provisional specification*, 96, 98.  
Wool Syndicate *v.* Riches, *joint applicants*, 145.  
Woolfe *v.* Automatic Picture Gallery Co., *discovery of documents*, 358.  
Woolfe *v.* The Automatic Picture Gallery Co., *amendment of specification*, 186.  
Worthington Pumping Engine Co. *v.* Moore, *master and servant*, 26.  
Wren *v.* Wield, *threats*, 269; *particulars of breaches*, 328.  
Wright's Patent, *extension*, 225.  
Wright *v.* Hitchcock, *infringement, intention*, 284; *sale of article made abroad by patented process*, 308.  
Wüterick's Patent, *extension*, 233.  
Wylie and Morton's Application, *opposition, second ground*, 162.
- Yates and Kellett's Patent, *extension*, 234.  
Young and Beilby *v.* Hermand Oil Co., *estoppel*, 208.  
Young *v.* Fernie, *prior user*, 72.  
Young *v.* Rosenthal, "*substantially as described*," 132; *infringement, intention*, 284; *costs apportioned*, 400.

# THE LAW AND PRACTICE

RELATING TO

## LETTERS PATENT FOR INVENTIONS.

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### 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 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

Letters patent  
a franchise.

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

is, a royal privilege, or branch of the king's prerogative, subsisting in the hands of a subject. Being, therefore, derived from the Crown, they must arise from the king's grant; or in some cases may be held by prescription, which, as has been frequently said, pre-supposes 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. 33, 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 and 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

(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 Abridgment, Part III., tit. "Prerogative," p. 61;

Serjeant Hawkins in Hawkins's Pleas of the Crown, Part I., c. 79, s. 20.

(c) 1602, 11 Rep. 84. The most interesting account of this famous trial is to be found in Mr. J. W. Gordon's book, "Monopolies by Patent."

to charters which had been granted to corporations or towns, it seems to be a fair inference that the Court considered such charter of a monopoly as a charter of franchise; and that they 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 very early periods.

Granted as a reward.

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*).

The Statute of Monopolies.

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

Merely declares common law.

It has been supposed that the prerogative of the Crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments, and of the authorities which preceded it, shows clearly that, so far from the statute giving to the Crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the Crown, and the declaring that which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited "that all grants of monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . That all monopolies, and all commissions, grants, licenses, charters and letters patent heretofore made or granted or hereafter to be made or granted . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution."

Sect. 6 saved the granting of letters patent to inventors in the following words:—

Words of the statute.

"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. 97 of the Patents and Designs Act, 1907 (*e*), 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. 98 (*f*) of the same Act the word "*invention*" is defined as meaning "*any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six (sic, really sect. 6) of the Statute of Monopolies . . . and includes an alleged invention.*"

Definition of  
"invention"  
still retained.

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;

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.

Contrary to law  
X L R.P.C. X L  
No

The Acts of 1883 and 1907 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

(*e*) Sect. 116 of the Act of 1883.

(*f*) Sect. 46 of the Act of 1883.

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.

In the case of *The Badische Anilin und Soda Fabrik v. Thompson* (1904, 21 R. P. C. 473) it was argued that the patent should be declared void, because it had never been the intention of the patentee to manufacture in this country, and by means of his patent he maintained a very high price in this country for the article which he manufactured in Belgium. It was urged that this was contrary to sect. 6 of the Statute of Monopolies and to the condition recited in the letters patent. It was held that no condition was imposed by law that the manufacture should be carried on in this country.

The Act of 1907 has, however, imposed obligations of this kind, which will be considered in Chap. XII.

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 "Subject-matter."

Thus we see that the same essentials must be proved to-day by an applicant for the grant of letters patent 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 and Designs Act, 1907, adopts the definition of an invention contained in the 26th section of the Statute of Monopolies, and consolidates all the previous enactments together with certain innovations introduced by an amending Act passed earlier in the same year, 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.

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

The Patents Act of 1907 consolidates the law.



attached to them, "for all the king's subjects are bound to take notice of the king's great seal" (g). Sect. 14 of the Act of 1907 (h) enacts: "*A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the great seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man.*" And sect. 64 (i), "*Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.*"

The seal of the Patent Office.

## THE LETTERS PATENT.

Form D in the first schedule to the Act of 1883 gave the form in which letters patent were to be issued, which has since been modified (k). By sect. 14, sub-sect. 2, it is enacted, "*Every patent may be in the prescribed form . . .*"

The form of a patent.

Letters patent, as issued at the present time, consist of six material parts:—

- 1st. The address.
- 2nd. The recitals.
- 3rd. The grant.
- 4th. The prohibition.
- 5th. The provisoes.
- 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

Recitals contain suggestions

(g) *East India Co. v. Sandys*, of the Act of 1883.  
 Skin. 225. (i) Sect. 84 of the Act of 1883.  
 (h) Sect. 12, sub-sects. 1 and 2, (k) See Appendix.

not in use by any other person to the best of his knowledge and belief.

which must  
be true.

This recital contains "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* (l). In that case the false suggestion complained of was in the title of the specification, which it was alleged did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (m). 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 W. 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

(l) 1837, 2 M. & W. 561; 1 W. P. C. 196; 6 L. J. Ex. 153.

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

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."

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 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. 75 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.

The requirements as to novelty, utility, subject-matter, and disclosure of the invention in the specifications will be considered in detail in subsequent chapters, but they are all based on the "suggestions" contained in these recitals.

#### THE GRANT.

"Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c.,

The monopoly grant.

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 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. 97 of the Act.

Nature of  
patent right

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 of manufacture cannot, apart from contract express or implied (*n*), 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

differs from  
trade mark.

No property  
in mere  
secret.

(*n*) See p. 26 *et seq.*

or otherwise, as he may think proper (o). 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* (3 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 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 subsequently to invalidate the plaintiff's patent, or to take out a patent for the invention himself (p), and if he does so, he will be liable in damages to the plaintiff (q). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 93rd 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

The prohibition.

(o) *Canham v. Jones*, 2 Ves. & B. 1907, and p. 28.  
218.

(q) *Smith v. Dickenson*, 1804, 3

(p) See sect. 15 of the Act of B. & P. 630.

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 was appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the “penalties” referred to in the prohibition are, and how they are to be put in force or recovered. The Act certainly does not mention penalties as a form of punishment for infringers.

#### THE PROVISOS.

##### Proviso for revocation.

“Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by us and the same may be revoked and made void accordingly” (see Chap. XII).

The next proviso is one for the determination of the patent in the event of the prescribed fees not being paid (*r*), and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee.

##### Proviso for use by Crown.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*s*). But should the Crown have employed a contractor, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There are two methods of infringing—first, making and vending; and secondly, using;

(*r*) See the Act of 1907, s. 20.

(*s*) *Feather v. R.*, 1865, 6 B. & S. 257.

consequently the contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (t).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to 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 was abolished by sect. 27 of the Act of 1883, re-enacted by sect. 29 of the Act of 1907 as follows:—

*"A patent shall have to all intents the like effect as against His Majesty the King as it has against the subject: Provided that any government department may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested."*

Sect. 30 (u) deals with the acquisition by the Secretary of State for War or by the Admiralty 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.

Procedure  
when Crown  
uses inven-  
tion.

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

(t) *Dixon v. The London Small Arms Co.*, 1875, L. R. 10 Q. B. 130; L. R. 1 App. Cas. 632.  
(u) Sect. 44 of the Act of 1883.

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.

Construction  
of patent.

“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 ousting the common rule of construction of grants of the Crown (*x*) that they shall be read most strongly against the grantee. This favourable construction applies only to the letters patent and not to the specification. The form of a “Patent of Addition,” created by the Act of 1907, resembles that of an ordinary patent in all particulars material to the questions hitherto discussed (*y*).

Form of  
patent of  
addition.

(*x*) See *Feather v. R.*, 1865, 6 B. & S. at p. 283.      (*y*) See Appendix.



## CHAPTER II.

## "THE PATENTEE."

By sect. 1, sub-sect. 1, of the Act of 1907 (a), "*An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with another person.*" **Who may apply.**

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

There does not appear to have ever been a question as to whether an infant or a married woman might under the old law have become a grantee of letters patent. The words "any person" and the Married Women's Property Act, 1882, however, sweep away any doubt that might have been entertained on the subject. By sect. 83 (b), which deals with persons under disability of lunacy or infancy, it is enacted that the necessary declarations and other acts may be made and performed by the committee or by a guardian appointed by the Court. **Persons under disability.**

Sect. 43, sub-sect. 1 (c), enacts: "*If the person claiming to be an inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.*"

It was always competent for an alien to obtain a patent; Lord Cairns in *Wirth's Patent* (d) 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" (e).

(a) Sects. 4 and 5 of the Act of 1883.

(b) Sect. 99 of the Act of 1883.

(c) Sect. 34 of the Act of 1883.

(d) *Wirth's Patent*, 1879, L. R. 12 Ch. D. 303; 28 W. R. 329.

(e) See also *Chappell v. Purday*, 1845, 14 M. & W. 318.

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

In *Patterson v. Gas Light and Coke Co.* (1875, L. R. 2 Ch. D. 832), James, L.J., in the Court of Appeal, said: "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation."

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 (*g*).

Under sect. 1 of the Act of 1907, 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 (*h*), since a corporation could not be said to invent in the modern sense of the word (*i*).

The enactment that the true and first inventor may receive a grant of letters patent jointly with another person is for the purpose of enabling an impecunious inventor to associate himself with a financier and so to give the latter an interest in the invention from the beginning.

As to the rights of co-grantees and co-owners *inter se*, see Chap. X.

The declaration.

The law requires that each application shall be accompanied by a declaration to the effect that the applicant, or in the case of joint applicants, one at least is the "the true and first inventor;" and in the case of an application by the representative of a deceased inventor a declaration is required that the applicant believes the deceased to have been the "true and first inventor."

(*f*) *Bloxam v. Elsee*, 1827, 1 C. & P. 558.

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

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

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

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

## 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. There is no doubt, therefore, that the words "true and first inventor" in the Statute of Monopolies included both—

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

The effect of numerous earlier decisions was summed up by Jessel, M.R., in the important case of *Plimpton v. Malcolmson* (1876, L. R. 3 Ch. D. at p. 555): "The Act of Parliament (21 Jac. I. c. 3) on which all these patents are founded, tells us this: that to come within the exception of the Statute of Monopolies a man who has the patent must be the first and true inventor, and he must describe something in his specification which is not already known and used. What is the meaning of a first and true inventor? To ascertain its meaning you must have recourse, no doubt, to various decisions given on the statute, which is very nearly three hundred years old. . . . In order that those who may have to consider my judgment hereafter may know the view that I take of the statute, combined with decisions, I will state the result at which I have arrived. As I understand, shortly after the passing of the statute, the question arose whether a man could be called a first and true inventor who, in the popular sense, had never invented anything, but who having learned abroad (that is out of the realm, in a foreign country, because it has been decided that Scotland is within the realm for this purpose) that somebody else had invented something, quietly copied the invention, and brought it over to this country, and then took out a patent. As I said before, in the popular sense he had invented nothing. But it was decided, and now, therefore, is the legal sense and meaning of the statute, that he was a first and true inventor within the statute, if the invention being in other respects novel and useful, was not previously

True and first inventor.

Jessel, M.R.,  
on importers.

known in this country—‘known’ being used in that particular sense as being part of what had been called the common or public knowledge of the country” (*k*).

Declarations distinguish inventors into classes.

Long before the Act of 1852 (*l*), 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 was considered material, because the Crown must not be deceived. Consequently, in *Milligan v. Marsh* (1856, 2 Jur. N. S. 1088), 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. By sect. 5, sub-sect. 2, of the Act of 1883 it was enacted for the first time that “every application must contain a declaration that the applicant . . . claims to be the true and first inventor.” The Rules, however, continued the old practice of using distinct forms for original inventions and those communicated from abroad, but required the applicant on a communicated invention to state that he claimed to be the true and first inventor. Consequently the *ratio decidendi* of *Milligan v. Marsh* no longer exists.

Legal effect of this.

In *Avery's Patent* (1887, L. R. 36 Ch. D. 316), 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 his 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

(*k*) And see Jessel, M.R., in *L. R. 3 Ex. D. 203. Marsden v. Saville Street Co.*, 1878, (*l*) See Hindmarch, pp. 509, 510.

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 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. Levenstein* (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."

And Lindley, L.J., in the case of *Moser v. Marsden* (1893, 10 R. P. C. 359), said: "Then it was suggested that as the English patentee had himself approved *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."

Hence the applicant is not bound to observe the rule requiring him to state that the invention has been so communicated, but the rule affords facilities to foreign inventors, saving them the trouble of making declarations; the invention is communicated to the patent agent who holds the patent as a trustee for his foreign client (*m*).

(*m*) See Chap. VII.

The foreign inventor, it would appear, is the person who is responsible for exercising good faith (*n*). But the agent is the patentee, and, save in so far as his relations with his client are concerned, there is no reason why he should not derive the entire advantage of the patent (*o*).

The actual inventor.

**A. An Actual Inventor.**—An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The operation of the mind in which the invention originates must 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. What amount, if any, 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.

True inventor and novelty distinguished.

This difference was pointed out by Tindal, C.J., in *Gibson and Campbell v. Brand* (1841, 1 W. 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

(*n*) *Kane and Pattison v. J. Boyle & Co.*, 1901, 18 R. P. C. 338; *British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.*, 1908, 25 R. P. C. at p. 386.  
 (*o*) *Beard v. Egerton*, 1846, 3 C. B. 129; 15 L. J. C. P. 274.

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?" (p).

In *Tennant's Case* (1795, 1 W. P. C. 125) a material portion of the invention claimed was found to have been suggested to the patentee 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 W. 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 (q) 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

(p) And see *Househill Co. v. Neilson*, 1843, 1 W. P. C. 689; (q) *I.e.*, the publication to the world.  
*Cornish v. Keene*, 1835, 1 W. P. C.

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 have followed *Cornish v. Keene*. The principle laid down in those cases we have cited has invariably been followed.

In *R. v. Wheeler* (1819, 9 B. & Ald. 345), 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 the 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 *Dolland's Patent* (1776, 1 W. 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. Dolland, without any communication from Dr. K., had re-invented these object-glasses; held, that Dolland's patent was good.

*Dolland's  
Case.*

In *Lewis v. Marling* (1829, 10 B. & C. 27; 1 W. P. C. 496; 4 C. & 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.

*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 of inventors to suggest the main idea to 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 idea itself, or is it merely the method of carrying the idea into effect, that constitutes the pith of the invention?"

The rights of  
the master.

In *Bloxam v. Elsee* (1 C. & P. 558; 1 W. P. C. 132, n.), the patentee had worked out the principle of his invention in his own mind; the mechanical details and arrangements requisite for carrying the principle into practice, so as to realize the idea, were extremely numerous and complicated, and Mr. D. was employed professionally to assist in these arrangements. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that the patentee was not the inventor. The objection was overruled. It will be seen in this case that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the intellectual hands employed by the patentee to carry out that which he had previously conceived in his mind. The summing-up of Baron Alderson, in the case of *Minter v. Wells* (1834, 1 W. P. C. p. 129), 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

Cases to illus-  
trate.

inventor, but that some one 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. 567), 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 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 (p. 574): "It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." This case was followed by Buckley, J., in *In re Smith's Patent* (1905, 22 R. P. C. 57).

In *Elias v. Grovesend Tinsplate Co.* (1890, 7 R. P. C. 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 tinplates ; this he effected by the immersion of the tinplate in a grease-pot by means of a cradle, with an adjustable guide at each end, so that the plate, upon immersion, was sent down into the grease-pot in a perpendicular position, and so brought under the rollers therein ; these rollers raised the plate to the surface in a like perpendicular position, having in the meantime squeezed or compressed from the plate any superfluous tin adhering to it ; by means of what was practically a duplicated machine of this description Morewood was able to treat two plates at a time, but when the "double Morewood" was at work it brought up the plates alternately and not simultaneously. In 1885 it occurred to the plaintiff that saving in time and labour would be effected if a similar machine were constructed to bring up the two plates simultaneously. In 1886 he communicated his idea to Mr. Glyn Thomas, of whose works he was the manager, describing it "to work two sheets at a time, side by side, on the Morewood principle, with rollers lengthened." The patent was held invalid for want of subject-matter, but the Master of the Rolls in the Court of Appeal said (r) : "Supposing there is an invention in that which is claimed—the carrying out of an idea in a machine—was the whole of that invention Mr. Elias', the plaintiff's, or was not part of it the invention of Karrop the machinist? Upon the assumption that there must be more than the idea, and that the machine is part of the invention—I mean the mechanism is part of the invention—was the whole of that done by Elias? The evidence seems to me to be clear as to this, that he had the idea in his mind of doubling Morewood's pot lengthways, that is, of making a pot of Morewood's twice the size of Morewood's, so that the two plates might be put in side by side. That was his idea. If that was all, it was not patentable ; but it is to be done in a machine. Did he have anything in the world to do with the construction of the machine which upon the assumption is part of the invention? . . . If it is an invention, Karrop has invented part of it."

(r) Pp. 465, 466.

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 *In re Heald's Patent* (1891, 8 R. P. C. 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," particularly where the servant has been requested to invent, as in *Marshall and Naylor's Patents* (1900, 17 R. P. C. 553). Here again, however, there must be invention on the part of the servant, who is not on general principles (s) 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 (t).

Where servant requested to invent.

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

It may be, however, that the relations between master and servant may be of such a close and confidential character that it may be inequitable to allow the servant to retain the benefit of a patent. In *The Worthington Pumping Engine Co. v. Moore* (1902, 20 R. P. C. 41), the plaintiffs employed the defendant as their agent and manager in England, and communications constantly passed between them as to improvements and alterations in the machines sold to suit the English market. The defendant was employed at a high rate of remuneration and a commission. There was no express stipulation as to inventions or original suggestions which might be made by the defendant. The defendant took out three patents for inventions which he

Where relations confidential.

Cases.

(s) See *Lamb v. Evans*, 1893, L. R. 1 Ch. 218; *Robb v. Green*, 1885, L. R. 2 Q. B. 315.

(t) See also *R. v. Arkwright*, 1785, Dav. P. C. 61; *Kurtz v. Spence*, 1885, 5 R. P. C. at p. 180.

employed in the business of the plaintiffs. He was subsequently dismissed, and sought to restrain the plaintiffs from using the patented inventions. This action was to obtain a declaration that the defendant should be declared a trustee for the said patents on behalf of the plaintiffs. Byrne, J., said (p. 46): "I think he (the defendant) would not have been acting in accordance with the good faith implied in his contract had he kept back new ideas or details of construction suggested or carried out in the ordinary course of business between the parties (even though such ideas or details might have been in the hands of a third person properly subject-matter for a patent) with a view to his personal profit at the expense of the plaintiff corporation. It appears to me that the degree of good faith due from the defendant to the plaintiff company was little, if at all, less than that required from a partner towards the firm of which he was a member . . . (p. 48). I propose now to deal with the principles of law applicable to the case; and first I desire to say that I recognise and quite appreciate the principle of those cases which have established that the mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject-matter germane to and useful to his employers in their business, and that, even though the servant may have made use of his employers' time and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment; but, on the other hand, without repeating what has been so fully and admirably expressed by the Court of Appeal in the two cases of *Lamb v. Evans* and *Robb v. Green* (u), it is clear that all the circumstances must be considered in each case. I consider that, bearing in mind the principles laid down in the authorities to which I have referred, it is impossible to say in the present case that the defendant has established the right he claims, having regard to the obligations to be implied arising from his

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

contract of service, and I am of opinion that his case is inconsistent with an observance of that good faith which ought properly to be inferred or implied as an obligation arising from his contract" (v).

**Applications  
in fraud of  
inventor.**

By sect. 15 of the Act of 1907 (x), "*(1) 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.*

*"(2) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked :*

*" Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted."*

This is in substance the same as sect. 85 of the Act of 1883, which was 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.

**Provisional  
protection.**

By sect. 4 of the Act of 1907 (y), "*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 invention. And such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

(v) And see *Richmond & Co. v.* 25 R. P. C. 546.

*Wrightson*, 1905, 22 R. P. C. 25;  
and *Edisonia, Ltd. v. Forse*, 1908,

(x) Sect. 35 of the Act of 1883.

(y) Sect. 14 of the Act of 1883.

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* (supra), was in consequence of the discretion given to the Lord Chancellor by the Act of 1852, s. 23, as to the date of the patent. This discretion no longer exists. The Act of 1883, s. 13, fixed the date of application as the date of the patent. The decision was, moreover, doubted in *Dering's Patent* (L. R. 13 Ch. D. 395) by Lord Cairns.

In *Richmond & Co., Ltd. v. Wrightson* (1904, 22 R. P. C. 25), the defendant Wrightson had applied for certain patents (including foreign patents), having obtained the invention either from A. or from B. (but from which of them 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 of the Act of 1883.

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 invention, 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

Patents  
granted to  
importers.

Inventions  
new to the  
realm.

the precise meaning which it has since acquired. We find that so far back as 1567 a patent had been granted to one *Hastings* (z) for the making of frisadoes in consideration of his having imported the skill of manufacturing them from abroad. So in *Mathey's Case*, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In *The Clothworkers of Ipswich* (1615, 1 W. 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 manufacture 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 W. 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).

Importer need  
have no merit.

The person who takes out the patent need not be a meritorious

(z) See "Monopolies by Patents," by J. W. Gordon, at p. 220.



importer; he may be merely the clerk or agent to whom the communication was made for any special purpose by the foreign inventor, and as trustee for him for the purpose of enabling him to take out the patent for the benefit of such foreigner (a). Communica-  
tions.

As to the duty of the grantee of a patent for an invention communicated from abroad with regard to disclosure in the specification, see Chap. VI., *Plimpton v. Malcolmson* (1876, L. R. 3 Ch. D. at p. 582) and *Weymann v. Corcoran* (1878, L. R. 13 Ch. D. at p. 77).

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 (b).

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

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 (d). Circumstances might render it necessary to send over from abroad some person who understands the invention, in order that the intended grantee may be able to understand it and properly describe it in the specification. It is submitted that this would not prevent the communication from being a genuine "communication from abroad." This point was raised, but not decided, in *Pilkington v. Yeakley Vacuum Hammer Co.* (1901, 18 R. P. C. at p. 461).

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,

(a) *Beard v. Egerton*, 1846, 3 C. B. 129; 15 L. J. C. P. 274.      1846, 3 C. B. 130.  
 (b) See remarks of Pollock, C.B., in *Chappell v. Purday*, 1845, 14 M. & W. 318; see also *Beard v. Egerton*,  
 (c) *Nickels v. Ross*, 1849, 8 C. B. at p. 710, per Wilde, C.J.  
 (d) *Marsden v. Saville Street Co.*, 1878, C. A., L. R. 3 Ex. D. 203.

as a matter of practice, is no longer possible, 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 (e).

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 (f).

Applications  
under Inter-  
national Con-  
vention.

It was provided by sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885, and re-enacted by sect. 91 of the Act of 1907, 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. The section also applies to such British Colonies as have made arrangements for the protection of inventions patented in this country.

The object of the section is to preserve to the foreign inventor a priority for a certain period over persons who might otherwise have anticipated him by filing an application for a patent for his invention without authority to do so.

The rights under this section are purely personal to the 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 (g).

Foreigner has  
double right.

A foreign patentee thus has a double right: he may either take advantage of the Act and apply for a patent, antedated to

(e) P. O. J., 9th May, 1884.

(f) *Edmund's Patent*, 1886, Griff. P. C. 283; *Lake's Patent*, 1888, 5 R. P. C. 415; *Bairstow's Patent*, 1888, 5 R. P. C. 288; and see also *Pilk-*

*ington v. Yeakley Vacuum Hammer Co.*, 1901, 18 R. P. C. 459.

(g) *Shallenberger's Application*, 1889, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552.

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; he may also obtain a patent for the full period by instructing his British agent to apply on a communication from abroad, the patent when obtained to be conveyed to the foreigner; but after having obtained a patent for the full period in the ordinary way, he may not avail himself of the provisions of sect. 91 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 (*h*).

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 (*i*).

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 Law Officer 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 (*k*).

Where a foreign inventor was resident in a country with which international arrangements for the mutual protection of inventions was made after an application had already been lodged in this country by another person for letters patent in respect of a similar invention, it was held by the Law Officer 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" (*l*).

(*h*) *The British Tanning Co. v. Ch. D. 268.*  
*Groth*, 1891, 8 R. P. C. 113; *Acety-* (*k*) *Re Van de Poele*, 1890, 7  
*lene Illuminating Co. v. United* R. P. C. 69.  
*Alkali Co.*, 1902, 19 R. P. C. 222. (*l*) *In re Main's Patent*, 1890, 7  
(*i*) *Rolls v. Isaacs*, 1881, L. R. 19 R. P. C. 13.

See also *See Patent by F. xxxvii R.P.C. 112*  
*Wilson v Charles xxxix R.P.C. 252.*  
*British Oxygen Co v. Munn Lighting XL R.P.C. 604*

### CHAPTER III.

#### SUBJECT-MATTER.

Defined by  
Statute of  
Monopolies.

THE Statute of Monopolies declared all grants of monopoly rights to be void at common law. "Provided (sect. 6) 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 inventors of such manufactures which others at the time of making such letters patent and grants shall not use." This definition of the subject-matter of a valid grant has been followed in all subsequent enactments; by sect. 93 of the Act of 1907, " 'Invention' means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six (sic, but section six is meant) of the Statute of Monopolies."

Confusion  
with novelty.

Letters patent can only be granted, therefore, in respect of manufactures. Unfortunately the term "subject-matter" has been very loosely applied in practice, and under the plea that "the alleged invention is not proper subject-matter," there have been discussed not only the issue of whether the invention is a manufacture, but also whether its production has required ingenuity, and whether there has been substantial novelty in view of prior common knowledge. It is not easy to get rid entirely of the question of novelty; the evolution of arts and sciences has caused inventive genius to proceed by steady development rather than by abrupt changes, and consequently the substantial novelty of a new invention must be judged rather by its ultimate results than by its inherent characteristics.

The line between manufacture and mere commercial enterprise is often hard though usually possible to draw. Commercial enterprise is usually novel in character if successful, but in spite of novelty it is not always embodied in

a manufacture, and consequently fails as subject-matter for a patent; and, on the other hand, an alleged invention may be of an undoubted manufacture, but it may lack substantial novelty. It will be found that in most of the cases where the patent has been held to fail for want of subject-matter, as opposed to want of novelty, that the invention lacks the characteristics of a manufacture and is shown to consist in commercial acumen or in mere discovery alone. A useful illustration is to be found in *The Haskell Golf Ball Co. v. Hutchinson*, which turned upon the validity of the patent for the Haskell golf-ball. This patent was held invalid by Mr. Justice Buckley and by the Court of Appeal and the House of Lords. The patented invention consisted of a ball of which the cover was made of gutta-percha, and the core of rubber thread wound under tension into a ball. It had been well known to use gutta-percha as a cover for golf balls, and it was well known that this material was the only suitable one for such covers. Balls had also been used for other purposes than golf composed of rubber thread wound under tension, and such balls were usually covered with leather. The purpose of the rubber thread core was to impart elasticity; the purpose of the gutta-percha cover was to protect the core and to muffle that elasticity when the ball was given a slight blow, as when on the putting-green, where elasticity is a disadvantage. Balls having elasticity were at first regarded with great disfavour by golfers, but ultimately—some four years or so after the grant of the patent—the majority of players came to the conclusion that their use was advantageous. As soon as this change of opinion took place the Haskell ball became a great commercial success, *i.e.*, the success of a particular point of view rather than that of a manufacture. The judgment of the Master of the Rolls (now Lord Collins) demonstrates this aspect of the matter. He said (23 R. P. C. at p. 313): "Now there being that right in every person to play the game with any ball that he found if he chose to do so, what was there open to this gentleman to patent in this case? . . . All that he has done is really, when you come to sift it, that he has substituted for the leather cover, which was the common cover of the balls composed of rubber wound in

Subject-matter means a manufacture.

The "Golf-ball Case."

tension then in use, for the purpose of golf, a cover of gutta-percha. That is the invention. What room was there for invention in taking that step into the unknown?—a step from a cover of leather to a cover of gutta-percha for the purpose of making a ball, fit for other purposes, fit for golf. What did he find to his hand? He found that every ball in the market was a ball made either in whole or in part of gutta-percha. Certainly the external part of it was gutta-percha. It was well known that if you wanted to strike a ball with an iron club probably gutta-percha was one of the best substances you could choose to admit of that impact. It was well known that gutta-percha was a common, or at least a well-known, cover for balls which required a considerable impact from the conditions in which they were used. Under those circumstances, it seems to me that that step, when you have once made up your mind that there was a certain degree of originality in playing golf with an elastic ball, was not the subject of a patent. 'The idea of putting a cover on strong enough to stand the impact of an iron club, and substituting, therefore, gutta-percha for leather, seems to me not to be one which can be the subject-matter of a patent.'

Abbott. C J.

The nature of a "manufacture" was admirably defined by Abbott, C.J., in *R. v. Wheeler* (1819, 2 B. & Ald. at p. 349). He said: "Now the word 'manufactures' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed, either in the making of some previously known article, or in some other useful purpose, as a stocking-frame or a steam engine for raising water from mines. Or it may perhaps extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufactures.' Something of a corporeal and substantial nature, something that can be made by

man from the matters subjected to his art or skill, or at least some new mode of employing practically his art or skill, is requisite to satisfy this word."

The confusion which has arisen over the interpretation of the term "subject-matter" has been mainly due to the small degree of precision required in pleading objections to the validity of a patent. It has long been considered that the nature of an invention must be such as would have normally required an inventive act of the mind to have produced it, although such inventive act *in fact* may never have taken place. The merits of this legal theory will be discussed later (p. 50), but it is necessary to note here that the requirement has been discussed under the head of "subject-matter," whereas in fact it is only relevant to the issue of novelty. The confusion of ideas was pointed out and ridiculed by Lord Fisher in *The Edison Bell Phonograph Co. v. Smith and Young* (1894, 11 R. P. C. at p. 398): "Now, whenever I hear the objection taken to a patent which has been used, which has been bought and sold, which has been therefore treated by men of business, as a useful thing, that it is wanting in subject-matter, I look upon it, I confess, with an amused contempt. What is the meaning of want of subject-matter? It is not the same thing as want of invention, or rather I should say (a) want of novelty; it is not the same thing as want of utility, but, where you cannot maintain either of these propositions which would be sufficient to destroy the patent, it is something else which someone or other at some time has invented as an idea for destroying patents. And what is it? It really comes to this, that, although the invention is new—that is, that nobody has thought of it before—although it is useful, yet when you consider it you come to the conclusion that it is so easy, so palpable, that everybody who thought for a moment would come to the same conclusion; or, in more homely language, hardly judicial, but rather business-like, it comes to this, it is so easy that any fool could do it. Well, I look, as I say, upon that objection, when all others have failed, generally with amused contempt. It can be made out, but hardly

Case to illustrate confusion.

(a) N.B.—This correction is most important.

ever, when you find that which I have stated, it is hard to think that people would be buying and selling a thing—and that has been sometimes the whole thing—and yet the objection should be taken that it is wanting in subject-matter.” It is clear that the Court considered that in this case subject-matter was argued by the defendant to mean the same thing as ingenuity, whereas novelty and ingenuity can co-exist without subject-matter (see p. 39); and under such an interpretation Lord Esher, with characteristic directness, ridiculed the objection.

The word  
“invention”  
ambiguous.

The many meanings which the word “invention” has been made to bear (b) is largely responsible for the confusion in the interpretation of “subject-matter.” Sometimes it is used to express a step forward in an art, *i.e.*, a new manufacture; sometimes as synonymous with ingenuity; sometimes as meaning the monopoly claimed. In the first sense invention is always necessary. For example, the mere adaptation of an old principle to a new purpose is not a manufacture; but where there is a mode, process, or mechanism as the means by which the adaptation is accomplished, then that mode, process, or mechanism is subject-matter, and if it contain the qualifications of novelty and utility a patent can be obtained. This will be found to explain the meaning of several decisions in which it has been said that “the mere adaptation of an old “contrivance” to a new purpose without invention is not subject-matter (c).

Novelty dis-  
tinguished  
from subject-  
matter.

The difference between novelty and subject-matter was illustrated by Lindley, L.J., in *Gadd v. The Mayor, &c. of Manchester* (1892, 9 R. P. C. at p. 525): “In considering subject-matter, novelty is assumed; the question is whether, assuming the invention to be new, it is one for which a patent can be granted. In considering novelty, the invention is assumed to be one for which a patent can be granted if new, and the question is whether on that assumption it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new;

(b) See on this point the judgment of Fletcher Moulton, L.J., in *The British United Shoe Machinery Co. v. Fussell, Ltd.*, 1908, 25 R. P. C. at p. 651.

(c) See p. 42, below.



but if the two things are different the nature and extent of the difference have to be considered. The question then becomes one of degree. But unless it can be said that the differences are practically immaterial: that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first." In this case the arguments were directed against subject-matter. The Court, however, dealt with the question as one of novelty. In many of the cases argued on subject-matter, this distinction has been lost sight of and the decision is in fact based on novelty; for, strictly speaking, subject-matter is a question of law, while novelty is a question of fact.

The meaning of subject-matter as manufacture is illustrated by the fact that a business scheme which involves ingenuity, novelty, and utility in its production is nevertheless not subject-matter, such, for example, as a new method of filing correspondence, or a method of keeping books (*d*).

No man can claim the monopoly of a principle, for that would be to claim 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 (but see p. 42).

No subject-matter in a principle.

Lord Justice Clark Hope, in directing the jury in the case of *The Household Co. v. Neilson* (1843, 1 W. P. C. at p. 685), said: "I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of the apparatus, is essential in order to obtain benefit from the principle; then you may take out your patent for the mode of carrying it into effect, and are not under the necessity of

Cases on alleged claims to principle.

(*d*) *E.g.*, as in *Johnson's Application*, 1902, 14 R. P. C. at p. 56.

describing and confining yourself to one form of apparatus. If that were necessary you see what would be the result? Why, that a patent could hardly ever be obtained for any mode of carrying a newly discovered principle into practical results though the most valuable of all discoveries. For the best form and shape or modification of apparatus cannot, in matters of such vast range, and requiring observation on such a great scale, be attained at once; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence 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 W. 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. 95), 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."

Jessel, M.R., in the Court of Appeal, said (p. 39): "It is said that what is claimed is a principle . . . or, as 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.' The Master of the Rolls then instanced the case of *Neilson v. Harford* (supra).

In *The British Vacuum Cleaner Co. v. Suction Cleaners, Ltd.* (1904, 21 R. P. C. 303), the invention consisted in an apparatus involving 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."

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.

Arrangement  
of parts on  
new  
principle.

So in *The Edison Bell Phonograph Co. v. Smith* (1894, 11 R. P. C. 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 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."

Claim to universal application void.

A claim to every method of application of a principle is a claim to the principle itself, and not being a manufacture is not subject-matter (*e*).

Claims to applications of new principles have wide scope.

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: "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" (*f*).

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" (*g*).

The construction of the claim in relation to its ambit will be more fully discussed in Chap. XIV. on Infringement.

Novel application of old principle.

Cases to illustrate and explain.

The novel application of an old principle is subject-matter if it constitutes a useful manufacture, but the patentee is strictly tied down to the application which constitutes his invention, and valid patents may be obtained by others for different methods of carrying the same principle into effect. Some difficulty

(*e*) *Neilson v. Harford*, 1841, 1 W. P. C. at p. 355; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 R. P. C. at p. 308; *The British United Shoe Machinery Co., Ltd. v. Simon Collier, Ltd.*, 1908, 26 R. P. C. at p. 49.

(*f*) *Edison Bell Phonograph Co.*

*v. Smith*, 1894, 11 R. P. C. at p. 148 (quoted supra).

(*g*) *The Automatic Weighing Machine Co. v. Knight*, 1889, 6 R. P. C. at p. 304; and see *Ashworth v. English Card Clothing Co.*, 1903, 20 R. P. C. 790.

*supra* *Hickin's Patent*  
1909 R.P.C. p. 346

is usually experienced in ascertaining whether the method of application of the old principle is really novel. It must be remembered that an *anticipation* must be such as to enable any competent person to carry out the invention claimed without any particular difficulty, and in cases where the patent has been held valid the *ratio decidendi* has usually been that the former applications of the old principle would not have led a competent person to the discovery of the new application, and consequently were not anticipations. As has been pointed out above in cases such as *Gadd v. The Mayor, &c. of Manchester*, the argument against the patent usually proceeds upon the assumption that the invention claimed is for "the old machine applied to a new purpose," whereas it is not the old machine applied to a new purpose, but an old *principle* newly applied to a new purpose, and what are cited as "previous applications of the old machine" are shown to be applications of an old principle which do not *anticipate* the present application, as the application to the new purpose involves special difficulties. Of course, if the old machine (same in fact as the new machine) is merely applied to a new purpose, there is no manufacture, and the invention, although novel and useful, fails for want of subject-matter. "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 a 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" (*h*). The following cases will illustrate the principle of law involved.

Contrivance  
and principle  
disting-  
guished.

The "Lane-  
Fox Case."

(*h*) Lindley, L.J., in *Lane-Fox Electric Lighting Co.*, 1892, 3 Ch. at v. *Kensington and Knightsbridge* p. 429; 9 R. P. C. at p. 416.

Cases on  
novel applica-  
tion of old  
principle.

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 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 *Gadd v. The Mayor, &c. of Manchester* (1892, 9 R. P. C. 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. Lord Justice Lindley (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 the second example the learned Lord Justice was employing the term "contrivance" in a wide sense, or as synonymous with "principle." This is shown by the passage on p. 523, in which he prefaced his discussion of the law with a statement of the facts. "The plaintiffs have used, for keeping gasometers upright, principles previously described by *Wild* and *Stansfield* for keeping floating docks and pontoons horizontal. Under these circumstances, can the plaintiffs' patent be supported?" Later on, after enunciating the above quoted proposition of law and discussing the authorities, he said, at p. 525: "A specification which discloses a principle and applies it to one thing will not necessarily invalidate a subsequent patent for the application of the same principle to another thing." He then proceeds to distinguish between novelty and subject-matter in the passage quoted at p. 38, and decides on the validity of the plaintiffs' patent as a question of *novelty, i.e., fact*, in the following passage (p. 526): "Applying this test to the present case, I cannot regard *Wild's* or *Stansfield's* specifications as anticipations

of the plaintiffs' patent. Their invention involved more than *Wild's* or *Stansfield's* has described. They showed the principle, but their attention was not turned to gasometers, and they did not show how to apply the principle to them. I am convinced that this was by no means so easy and obvious as the defendants contend."

In *Brooks v. Lamplugh* (1898, 15 R. P. C. 33) 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, constituted subject-matter. Lord Justice A. L. Smith stated the law in much the same terms as were used by Lord Justice Lindley quoted above. Care must, however, be used to realise clearly the signification with which the word "contrivance" is used. Sometimes Lord Justice Smith uses it in a wide and sometimes in a narrow sense.

In *The Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate* (1895, 12 R. P. C. 232), 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 and the gold was separated from the ore and the baser metals without the necessity of using any other substance. The Court of Appeal (Halsbury, L.C., Lindley and Smith, L.JJ.) held that there was good subject-matter (i).

Method of application of old principle must be novel.

The following cases illustrate the rule that when the method of application of the old principle to the new purpose is not

(i) And see *Thomson v. American Braided Wire Co. (The "Bustle" Case)*, 1889, 6 R. P. C. at p. 523.



novel there is no new manufacture and the patent is invalid, although the ultimate result obtained be novel and useful. Here, again, it is necessary to remember that in considering novelty the Court inquires, as a question of fact, whether the alleged anticipation would have led without special difficulty to the patented invention. Test of novelty.

In *Bush v. Fox* (1856, Macr. P. C. at p. 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 *Harwood v. G. N. R.* (1865, 35 L. J. Q. B. 27) (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 (at p. 38): "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 R. P. C. 131) the patent consisted in the application of C springs, which previously had only been employed on the back of a carriage, to the fore part, and arranged so as not to interfere with the fore wheels and their motion in turning the carriage. This contrivance was new, and was admitted to give greater ease and comfort in the motion of the carriage to which it was attached. The patent was upheld in the lower Courts, but these decisions were reversed by the House of Lords, where it was held *nem. con.* that there was not sufficient ingenuity disclosed to support a grant of letters patent. Lord Herschell, in his judgment, said (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" (k). *Blakey v. Latham* (1889, 6 R. P. C. 184 (*The "Shoe Heel-plate" Case*)) is another useful example of want of subject-matter of this kind.

(k) And see the judgment of Lord Davey in *The Acetylene Illuminating Co., Ltd. v. United Alkali Co.*, 1905, 22 R. P. C. at p. 155.

It must be remembered that although it is true to say that the alleged anticipation must lead without special difficulty to the invention patented, yet the person who uses tools to produce some new result cannot take out a patent for the mere care and skill which it may require to adapt his tools to the particular result which he seeks. Skill is not a new manufacture, and an arrangement which, when examined, proves to be what any skilful person would adopt to effect the new purpose, if using the old tool or instrument, is not subject-matter. For instance, in *Dredge v. Parnell* (1899, 16 R. P. C. 625) 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 one templet and a band knife was old, and veneers had been cut in this way. Lord Halsbury, L.C., said (at p. 629): "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."

Mere skill is not subject-matter.

But where the use of the old tool requires more than mere skill in the method of its employment to produce the new result:—where the ordinary degree of skill in the use of the tool would not have sufficed, but an entirely new method of use has to be employed, then such new use amounts to a new

manufacture and is subject-matter for a patent. Before the industrial revolution which took place in the eighteenth century, the judges seemed to be in doubt as to whether the term "manufacture" could include method, and were inclined to limit it to tangible articles only. These views were finally swept away by the judgment of the Court of King's Bench in *Boulton v. Bull*. The arguments and the judgment are fully and clearly reported in *Dav. P. C.* p. 162.

Explanation  
of require-  
ment of  
ingenuity.  
Concerns  
novelty only.

It will have been observed that in decisions upon the new application of an old principle much use has been made of the word "invention." It must not be imagined that the State attaches the slightest importance to what has actually occurred in the mind of an inventor (*l*). Patents have been held valid for inventions that have been the result of the merest accident (*m*), and for inventions imported from abroad. But in considering whether any given application can be considered novel or not in the light of prior applications of the same principle it is necessary to inquire whether in fact the new application would be indicated by an examination of the old application. In considering this question regard must be had to the class of persons to whom the specification is addressed and who are concerned in the act with which the invention deals. If it can be shown that the new result was long sought for:—if it be shown that persons of this kind had been working without success to attain it, and had long regarded it in the light of a problem, and that the invention of the patentee successfully solved the problem,—then such a state of affairs constitutes evidence of the strongest kind that the prior applications did not in fact give a clear clue to the solution and ought not to be considered as anticipations. Therefore "ingenuity" has nothing to do with subject-matter. What occurred in the mind of the inventor would be utterly immaterial even if it were discoverable. But the fact that the problem was not and could not clearly be solved with the materials available is evidence that the solution offered by the

(*l*) See Tindal, C.J., in *Crane v. Price*, 1842, 1 W. P. C. at p. 411.      (*m*) See *Liardet v. Johnson*, 1 W. P. C. at p. 54.

inventor is novel *in fact*; and it is with this meaning that judges have used the term "evidence of invention."

The attention of the reader is recalled to the words of Lord Esher quoted at p. 37, *supra*, and the following quotations are offered in support of this view.

In *Lyon v. Goddard* (1893, 10 R. P. C. 334) Lord Esher, at p. 343, used much the same expressions as he did in the case cited at p. 37, *supra*, and 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 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."

Evidence of novelty further discussed. Unsatisfied demand.

In *Gosnell v. Bishop* (1888, 5 R. P. C. at p. 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 uncomplished is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere or in some shape."

And in *Hinks v. Safety Lighting Co.* (1876, L. R. 4 Ch. D. at p. 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."

But commercial success alone, without the solution of a previous difficulty, will not establish novelty or that the invention is a manufacture. For commercial success is often due merely

to commercial enterprise, or the awakening of a new demand. The case of *The Haskell Golf Ball v. Hutchinson* (cited at p. 35) is an instance in point.

In the case of *Longbottom v. Shaw* (1891, 8 R. P. C. at p. 336) Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it, there was a larger demand for them. . . . I do not dispute that that is a matter to be taken into consideration; but, again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much upon certain other circumstances. If nothing be shown beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think that it is of very little importance."

In *Thierry v. Rickman* (1897, 14 R. P. C. at p. 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.* (1876, L. R. 4 Ch. D. 607) and *Brook v. Aston* (1859, 8 E. & B. 478), 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" (n).

Patentability  
of new pro-  
duct dis-  
cussed.

Doubts have been expressed as to whether a patent can be granted for a new product irrespective of the manner in which it has been brought into existence. It is submitted that such a grant would be wholly invalid since it would not be for a manufacture at all. For example, a new metal might be smelted from some well-known mineral, which metal might possess extraordinary qualities, and become indispensable. A valid

(n) And see A. L. Smith, J., in *Elias v. Grovesend Tinsplate Co.*, 1890, 7 R. P. C. at p. 461

patent could be obtained for the process of smelting, if novel in itself (*o*), which would probably receive a wide construction so as to cover any substantially similar process. But if someone discovered a vein of the metal in a pure state requiring no smelting, the person who had actually first discovered the metal, and patented the process of smelting, could not have a patent to prevent the owner of the vein from selling the produce of his mine. The same remarks apply to a chemical product. Of course the use of the product in manufactures could be patented if the patentee described some particular method of using it. In other words, a discovery of properties is not a manufacture.

The judgment of Lord Davey in *The Acetylene Illuminating Co. v. United Alkali Co.* (1905, 22 R. P. C. at p. 153) contains some observations which would seem to indicate a contrary view, but it is respectfully submitted that the remarks are *obiter dicta* and were clearly not necessary to a decision on the facts of that particular case; moreover, the point was not argued. His lordship said: "The title of the patent, which is still retained, is 'Improved metallic carbides applicable for use in the production of acetylene, and means for producing the same.' I need scarcely say that if the patentee had discovered a new material of the character which he mentions, a material having the very valuable commercial properties which he ascribes to it, that would have been a good subject-matter for a patent, and there would have been no question, supposing that he had done so, that his patent was a good one. He would be bound, of course, to state the means by which he produced that material; but the novelty of the means or the process by which the material was produced would have been immaterial, because the merit and the novelty of the invention would consist in the substance produced itself." This case was decided upon the ground that neither the substance nor the method of manufacture were novel. The remarks of Cotton, L.J., in *Vorwerk v. Evans* (1890, 7 R. P. C. at p. 271) are open to the same comment (*p*).

(*o*) See p. 57, *infra*.

Eyre, C.J., in *Boulton v. Bull*, 1795,

(*p*) See also the remarks of Dav. P. C. at p. 208.

Equally *obiter* were the observations of Buckley, J., in *Kopp v. Rosenwald* (1902, 19 R. P. C. at p. 211), expressing the contrary view. 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 hereinbefore 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 *Cooper's Application* (1902, 19 R. P. C. 54) 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.

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; for instance, *Muntz v. Foster* (1844, 2 W. 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.

Old material  
applied to  
new purpose.

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 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.

**New use for  
old product.**

But it is necessary to establish novelty in the patented use of the old material. In *The Albo-Carbon Light Co. v. Kidd* (1887, 4 R. P. C. 535) the disputed claim was "The use of solid naphthaline prepared in the form of sticks, rods, or pellets for the enrichment of combustible gas, substantially as herein described." It was shown that the use of naphthaline (though not in solid form) was known for enriching gas, and the existence of solid naphthaline was also old. The method of application described involved no novelty and the patent was declared invalid.

In *McLay v. Lawes & Co.* (1905, 22 R. P. C. 199) 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.

The judges at first seemed to be inclined to limit the subject-matter of letters patent to new *articles* produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions of *processes* for 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. The judgment in *Boulton v. Bull* (1795, Dav. P. C. 191) confirmed the change of opinion, and in 1841, in the case of *Gibson v. Brand* (1 W. P. C. at p. 633), Tindal, C.J., 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,

Processes.

P. D. Act 1919  
38A  
G. H. 2712  
XLII R. P. C. 501  
NV 2 2712  
XLII R. P. C. 503

but producing it in a cheaper or more expeditious manner or to a better or more useful account.' ”

Modern instances of valid patents for processes are so numerous that it is not necessary to quote them.

**Combinations.** We have now to deal with that most important part of patent jurisprudence—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 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 are new arrangements in old machines of their various parts (which in themselves as mechanical appliances are seldom novel) to produce old effects in a better, cheaper, or more expeditious manner. Lord Justice (then 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.'"

It is unnecessary to quote the cases which in the early history of patent law went to establish that patents for new combinations were valid. New combinations are such a feature of modern machinery and of modern patent practice that the principle hardly needs argument. But it is important to remember that the combination must in *fact* be a combination and not a mere juxtaposition—the parts must combine for some common result. As Buckley, L.J., said in *The British United Shoe Machinery Co. v. Fussell* (1908, 25 R. P. C. at p. 657), "For this purpose a combination, I think, means not every collocation of parts, but a collocation of inter-communicating parts so as to arrive at a desired result, and to this, I think, must be added that the result must be what, for the moment, I will call a simple and not a complex result. . . . It is not every combination of parts which is for this purpose a combination" (q).

Meaning of  
"combina-  
tion."

The principle enunciated by Buckley, L.J., is illustrated by the well-known "*Sausage-machine Case*": *Williams v. Nye* (1890, 7 R. P. C. 62). The patent in that case was for

The  
"Sausage-  
machine  
Case."

(q) And see Lord Davey in *Klaber's Patent*, 1906, 23 R. P. C. at p. 469.

The "Eye-glass Case."

a machine for mincing meat and filling the minced meat into skins so as to make sausages. In fact it consisted of a well-known form of mincing machine which fed the meat to a well-known filling machine so as to combine in one apparatus two machines which had formerly been used separately. The mincing part performed no more than its already well-known functions, and the same remark is true of the filling part. The ultimate result was novel and useful, but there was no "manufacture" in the mode of combination as opposed to novelty of purpose. The Court of Appeal applied the same principle of law as has been illustrated in the case of the novel application of an old principle in which the mode of application cannot be considered as novel. The case of *Wood v. Raphael* (1896, 13 R. P. C. 730) (*The "Eye-glass Case"*) is another well-known illustration. 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 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 plaquets 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 (r).

(r) 1897, 14 R. P. C. 496.

There is one field of invention in which the Courts are loth to decide that a new arrangement of parts is not subject-matter, *i.e.*, in automatic labour-saving machinery, where a very small alteration may produce a profound result so far as ultimate success is concerned. In *The British United Shoe Machinery Co. v. Fussell* (1908, 25 R. P. C. 631) the patent was for a high speed machine for screwing the soles of boots to the welts. Dealing with this class of machine, Fletcher Moulton, L.J., said (at p. 646): "Its merit is that it does this operation at a high speed, and with unvarying accuracy, so that you can work these machines so as to yield a huge output without making wasters. That is the commercial definition of a high speed machine. . . . When you come to a machine of this type, you have to alter very seriously the canons which influence you in deciding such questions as novelty. In the case of operations which have to be done under normal circumstances, in the absence of any special difficulties arising from speed, small and trivial alterations in the apparatus are viewed with suspicion, as possibly being idle variants; but when you come to machines which with this demand upon them still give uniform success, I think any tribunal will be very careful before it applies its ordinary ideas of what are mere idle and trivial changes to those alterations which have resulted in a success so triumphant. So that I approach the consideration of novelty in this case, *i.e.*, of the importance of apparently slight variations in the combination, in a very humble spirit, willing to be taught by those who know the practical performance of the machine, and are able to judge of the means which render that practical performance so successful."

Labour-saving machinery.

The case of *The Anti-Vibration Incandescent Lighting Co. v. Crossley* (1905, 22 R. P. C. 441) is an interesting instance of the length to which the Courts will go in conceding subject-matter, where a new and useful result is attained. In the course of this case most of the "stock" cases 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

The "Anti-Vibration Case."

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 induced 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."

It is essential to remember that the new combination is what constitutes the subject-matter of the patent, whether the invention in *fact* be the addition of a new element or the subtraction of an old element theretofore considered necessary, and it is the new combination which should be claimed as the subject of monopoly (see Chap. VI.).

The combination must in *fact* be novel; the mere substitution of a well-known mechanical or chemical equivalent does not constitute novelty (s).

In *White and others v. Bailey and others* (1903, 20 R. P. C. 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 as to transfer the weaving from the body to the

(s) See, e.g., *Parke v. Stevens*, v. *Manchester Steam Tramways Co.*, 1869, L. R. 8 Eq. 358; and *Winby* 1891, 8 R. P. C. at p. 67.

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.

#### PATENTS OF ADDITION.

Patent of  
addition.

Sect. 19 of the Act of 1907 is as follows: (1) "*Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*"

And by sub-sect. 4: "*The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject of a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.*"

Subject-  
matter  
limited.

The wording of sub-sect. 4 is important; it does *not* mean that the grant of a patent of addition is conclusive as to the existence of *subject-matter*, but only that the form of the patent cannot be attacked. The *subject-matter* of a patent of addition, therefore, like that of other patents, must be a new manufacture as defined by the Statute of Monopolies, but it is **limited** to improvements and modifications of the original invention—*i.e.*, to inventions which would be infringements of the first patent; and in effect the new legislation is merely a relief to inventors against the burden of taxation in respect of every new improvement they may make in their inventions. Hitherto an inventor has been forced either to take out fresh patents for each improvement or to run the risk that others who, having learnt the groundwork and principle from him, may

blackmail him by patenting some trifling but commercially important improvement.

The cases which we have cited to illustrate the law on "subject-matter" are those leading cases which are most frequently cited in the Courts. The cases which illustrate the application of the principles there laid down to particular facts are very numerous. Throughout the whole of them the law as laid down by the Statute of Monopolies has been held in view, and "subject-matter" is always seen to mean "a new manufacture." The constant use of the word "invention" is extremely likely to mislead, and care must be exercised to ascertain in each case in what sense it is used. The state of mind of the inventor for this purpose is immaterial, although, from other points of view, *e.g.*, fraud, it may be relevant. The introduction of a new art is everything.

*P.L.S. Act 1114 Sec 38A*

*In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the spec. shall not include claims for the substance itself except when prepared or produced by the special methods or processes of manufacture described & claimed.*

*R.P.C. XL1 128*

<i>581</i>	<i>Application of Q.O.</i>	<i>Alimentary paste</i>	<i>Yes</i>
	<i>" " 125</i>	<i>Vegetable milk mixture.</i>	<i>No</i>
	<i>" " J.S.</i>	<i>Confectionery cream</i>	<i>No</i>
	<i>" " J.R.</i>	<i>Bran food</i>	<i>No</i>
	<i>" " L.M.</i>	<i>Effervescent mixtures</i>	<i>No</i>
<i>615</i>	<i>" " A.L.</i>	<i>Navigation with phone cables</i>	<i>No</i>
<i>617</i>	<i>" " "</i>	<i>" " "</i>	<i>No</i>

*Cp. Bonnard v L.G.C.C. xxxviii R.P.C. 149*

*Publication, Sec 11. 1.(b) Undersea Plots Co.  
xli. R.P.C. 623.*

66

*Textile Patents v Humberman  
xlii R.P.C. 520*

## CHAPTER IV.

### 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" will invalidate 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, 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 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.

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. Consequently the defendant to an action for infringement has always been entitled to allege the invalidity of the plaintiff's patent on the ground of want of novelty.

In the case of *Hasting's Patent* (1567, 1 W. 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 patentee's 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).

At common law.

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex v. Arkwright* (1785, 1 W. 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.

When we speak of an invention being new, we mean that it must be new so far as the public is concerned, that is, so far as

Novelty means so far as public is concerned.

(a) And see the account of the Gordon's well-known work "Monopolies by Patent," in Mr. *Case of Monopolies*,

the means of information of the public goes, and the means by which the public become possessed is immaterial (*b*). 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. Hindmarch (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" (*c*).

Is question  
of fact.

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

Prior user.

Having stated the general principles upon which a patent may be attacked for want of novelty, we may now proceed to deal particularly with 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.

The making of a machine by a person who kept it secret would not amount to such a publication 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.

In *Carpenter v. Smith* (1842, 1 W. P. C. 540; 9 M. & W. 304), the patent sued on was for a lock. The defendant called

(*b*) Subject to the qualification introduced by sect. 41 of the Act of 1907; see p. 74.

(*c*) See also *Lister v. Norton*, 1886, 3 R. P. C. at p. 211; *Westley*,

*Richards & Co. v. Perkes*, 1893, 10 R. P. C. at p. 193; *Robertson v. Purdey*, 1907, 24 R. P. C. 299.

(*d*) *Pickard v. Prescott*, 1892, 9 R. P. C. at p. 200.

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., analysed 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 *Taylor's Patent* (1896, 13 R. P. C. at p. 482) the patent was for a fire-grate. It was revoked on the ground that a similar grate had been used in a private house in the ordinary way and under no conditions of secrecy.

In *Stead v. Anderson* (1846, 2 W. P. C. 147) 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" (e).

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.

In *Betts v. Neilson* (1868, L. R. 3 Ch. at p. 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 R. P. C. at p. 302), 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

(e) And see *Humpherson v. Syer*, 1887, 4 R. P. C. 407.

not be material that it had ever 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 W. P. C. 673), 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 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*."

Prior secret  
user no  
anticipation.

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."

Dollond's  
Case.

In *Dollond's Case* (1766, 1 W. 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.

Secret profit-  
able user by  
patentee.

It is probable that an inventor who manufactured an article by a secret process and sold it would be unable subsequently to obtain a patent for the process, since by that means he would be enabled to derive a larger advantage than the law allows him in a monopoly for fourteen years from the date of application. The point is not without difficulty and has never been definitely decided. It has, however, received the attention of judges. Baron Parke, in *Morgan v. Seaward* (1837, 2 M. & W. at p. 559; 1 W. 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 *Miller's Patent* (1898, 15 R. P. C. at p. 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, 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.

A greater difficulty arises in the case of secret use by someone other than the patentee. In *Robertson v. Purdey* (1907, 24 R. P. C. at p. 290) Mr. Justice Parker, dealing with an alleged prior user, found in fact that the article had been manufactured prior to the date of the plaintiff's patent, but had only been used privately, and that such prior private use was not such as to invalidate the plaintiff's patent, but went on to say: "It was, however, argued that on the words of the 6th section of the Statute of Monopolies, 'which others at the time of making such letters patent shall not use,' there may be a contemporaneous user not amounting to publication which will avoid letters patent. In my opinion this argument is well founded. Suppose A. invents a process for the manufacture of dyes, keeps the process secret, and continues to manufacture and publicly sells dyes manufactured according to the process, the sale of the dyes, which might be made by any process, may not amount to a publication of the invention, but I think that A. is using the invention in such a way as to preclude B., who subsequently makes the same invention, from obtaining valid letters patent in respect thereof. This, at any rate, would appear to be the effect of the judgments of Mr. Justice

Secret process  
and sale of  
product by  
others.

\* See  
Miller's Patent  
1898, 15 R. P. C. 213

Erle and Lord Justice Campbell in *Heath v. Unwin* (2 W. P. C. at pp. 227, 228; 3 E. & B. at pp. 272, 273), and *Tennant's Case* (1 W. P. C. 195)." The above quoted observations are of course *obiter dicta*, and against the view expressed by Mr. Justice Parker the argument may be urged that patents are granted as a reward for the instruction of the public in a new and useful art, and that until the public are in possession of the knowledge secretly made use of, it is open to anyone to reap the reward for communicating it to them. It may be fairly replied to this answer that more than one person may be carrying on the process secretly, and consequently, unless the word "others" is to be construed strictly to mean "any other person," a great difficulty in administering the law is involved, since it will be impossible to find any fixed line beyond which the *public* may be said to be in possession of an invention.

The question is really one of policy, but the opinion of Mr. Justice Parker certainly seems correct upon a strict construction of the words "which others at the time of making such letters patent shall not use."

Experimental  
user.

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 (*f*), or what was nothing more than a scientific curiosity of no practical value, or was merely a laboratory experiment (*g*), it has been held that a subsequent patent for a workable and efficient machine is not vitiated thereby.

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

(*f*) *Jones v. Pearce*, 1832, 1 W. P. C. at p. 124; 2 Coop. Ch. Ca. 58; *Cornish v. Keene*, 1835, 1 W. P. C. at p. 508; *Galloway v. Bleaden*, 1839, 1 W. P. C. at p. 525; *Walton v. Bateman*, 1842, 1 W. P. C. at p. 619.  
(*g*) *Young v. Fernie*, 4 Giff. 577, 611; see also *Benno Jaffé v. Richardson*, 11 R. P. C. at p. 111.

patent whether made by the inventor himself, or by others to whom he has lent his machine for that purpose (*h*), nor will the fact that pecuniary profit resulted from such experiments necessarily avoid a subsequent patent (*i*). 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 (*k*).

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.

Lord Esher, M.R., speaking on this subject in *Elias v. Grovesend Tinsplate Co.* (1890, 7 R. P. C. at p. 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 over, and you put it up in a public workshop or in a place where other people would come who are not bound by any rule of secrecy or faith—who are not bound to keep the secret—if you put it up in a place which they are to frequent and where they can see it, you have published it, and if you have published it, it becomes public property—it becomes the property of all the world immediately."

The prior sale of an article, even though to one individual only, will nearly always be sufficient to invalidate the patent, Prior sale.

(*h*) *Bentley v. Fleming*, 1844, 1 Car. & K. 587; 1 C. B. 479; *Seaward*, 1837, 2 M. & W. 544; 1 W. P. C. 195.

*Useful Patents Co. v. Rylands*, 1885, 2 R. P. C. at p. 262; *Elias v. Grovesend Tinsplate Co.*, 1890, 7 R. P. C. 455. (*k*) *Elias v. Grovesend Tinsplate Co.*, 1890, 7 R. P. C. 455; *Hoe v. Foster*, 1899, 16 R. P. C. 33; *Poulton's Patent*, 1906, 23 R. P. C. 183.

(*i*) *Newall v. Elliot*, 1858, 4 C. B. N. S. at p. 295; *Morgan v.*

since it is strong evidence that the invention was put into use (*l*). But the question is one of fact for the jury, and still remains open (*m*). In order for the sale to constitute sufficient evidence, it should be open and in the ordinary way of business (*n*). The fact that there was no demand for the article will not affect the sale either in law or fact (*o*). It will be sufficient if only one article be sold (*p*), and, apparently, if merely for export (*q*). An offer to sell, even though no sale was effected, will also be evidence of prior publication (*r*).

Sending out  
of 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 (*s*).

By sect. 41, sub-sect. 2, of the Act of 1907, the inventor has been protected against fraudulent disclosure of his inventions by persons with whom he might have confidential relations:—

Disclosure  
without con-  
sent of  
patentee.

(2) “*A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.*”

Formerly the law was such that although a confidential communication did not invalidate a subsequent patent, yet if the person to whom the confidential communication was made

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

(*m*) *Gibson v. Campbell*, 1841, 1 W. P. C. at p. 628.

(*n*) *Honiball v. Bloomer*, 1854, 2 W. P. C. 200; *Lister v. Norton*, 1886, 3 R. P. C. at p. 208.

(*o*) *Losh v. Hague*, 1837, 1 W. P. C. 205; and see *Lister v. Norton*, 1886, 3 R. P. C. at p. 208.

(*p*) *Honiball v. Bloomer*, 1854, 2

W. P. C. 200.

(*q*) *Carpenter v. Smith*, 1841, 1 W. P. C. at p. 536.

(*r*) *Oxley v. Holden*, 1860, 8 C. B. N. S. at p. 704; *Mullins v. Hart*, 1852, 3 C. & K. 297.

(*s*) *The Useful Patents Co. v. Rylands*, 1885, Griff. P. C. 234; 2 R. P. C. at p. 262; *Hudson, Scott and Sons, Ltd. v. Barringer and others*, 1906, 23 R. P. C. at p. 87.

published his information the patent was anticipated. It is to be observed that the onus of proving the relieving circumstances is cast entirely on the shoulders of the patentee.

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 as will enable the invention to be carried into effect 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 (see also Chap. III., p. 50 *et seq.*).

Anticipation  
in writing.

In *Gadd v. Mayor, &c. of Manchester* (1892, 9 R. P. C. at p. 525) Lindley, L.J., said: "In considering novelty the invention is assumed to be one for which a patent can be granted if new, and the question is whether, on that assumption, it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new; but if the two things are different, the nature and extent of the difference have to be considered. The question then becomes one of degree. But unless it can be said that the differences are practically immaterial, that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first."

Degree of  
disclosure  
requisite.  
*Gadd v.*  
*Mayor of*  
*Manchester.*

In *Von Heyden v. Neustadt* (1881, 50 L. J. Ch. at p. 128) 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."

Lord  
Westbury's  
dictum.

In *Hills v. Evans* (1862, 4 De G. F. & J. at p. 289; 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."

Effect  
modified  
by later  
judgment.

The effect of this statement has, however, been slightly modified by subsequent judgments.

In *Philpott v. Hanbury* (1885, 2 R. P. C. at p. 43) 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."

And the same thing was better said by Lord Watson, in *King, Brown & Co. v. The Anglo-American Brush Light Co.* (1892, 9 R. P. C. at p. 320): "Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in

such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance ; but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, be sufficient to convey to men of science and employers of labour information which will enable them, without any exercise of inventive ingenuity, to understand his invention, and to give a workman the specific directions which he failed to communicate. In that case, I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill." This statement was accepted by Lindley, L.J., in *Savage v. Harris*, 13 R. P. C. at pp. 368, 369, as modifying and correcting the view of Lord Westbury in *Hills v. Evans*. The view of the Court seems to be that the knowledge of "the ordinary workman" to whom a specification is addressed (see p. 103) is not necessarily the measure of public knowledge.

On the other hand, great caution must be exercised in coming to the conclusion that a given publication or prior user is an anticipation, and it must not be assumed that there is invalidity owing to prior publication merely because a person of great skill might turn the prior publication to practical account. Regard should be had to the observations of Lord Justice Moulton (cited at pp. 58 and 61, ante) concerning labour-saving machinery. Moreover, the distinction drawn by Grove, J., and Lord Watson has not invariably been made ; for instance, in *Kaye v. Chubb* (1887, 4 R. P. C. at p. 298) 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 reader is referred to the chapter on Subject-matter (ante, p. 43 *et seq.*) for consideration of the leading cases in greater detail; it is undesirable to repeat the arguments there set forth. It must be remembered that novelty is a question of *fact*, and a decision as to what may be a sufficient anticipation in any particular case cannot be any guide in deciding upon a different set of circumstances.

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.

Publication  
of the  
document.

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 (*t*). "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" (*u*).

It is the practice for the Patent Office library to receive copies of foreign specifications from abroad and to bind them in volumes which are open to public inspection. An English patent may be invalidated by the fact that such a specification, or in fact any other publication containing the description, was on view prior to the date of the English application (*x*). Prior

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

(*u*) Per Sir John Romilly, M.R., in *Lang v. Gisborne*, 1862, 31 Beav. at p. 136.

(*x*) *Harris v. Rothwell*, 1887, L. R. 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552; 3 R. P. C. 383; 4 R. P. C. 225; *Pickard v. Prescott*, 1893, 9 R. P. C. 195.



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.

In *Otto v. Steel* (1886, L. R. 31 Ch. D. 241), where a French Otto v. Steel. 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 (y).

In *Harris v. Rothwell* (1887, 4 R. P. C. at p. 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 is most in accordance with the authorities, and the principles which underlie them, may be thus expressed. *Primâ*

(y) See also *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 531; 44 L. J. Ch. 257; 45 L. J. Ch. 505; *Plimpton v. Spiller*, 1877, L. R. 6 Ch. D. 412; 47 L. J. Ch. 211

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 (z) and in *Otto v. Steel* (a), 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."

Publication  
by drawing.

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 (b).

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

By sect. 7 of the Act of 1907 the Patent Office is directed to make a search as to the novelty of all applications. The search is only to extend to specifications published within fifty years next before the date of the application.

Rule as to  
fifty-year-old  
specifications.

By sect. 41, sub-sect. 1, it is enacted: "*An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five (c) shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.*"

(z) See note, (y), above.

(a) See p. 79, above.

(b) *Herrburger v. Squire*, 1889, 6 R. P. C. at p. 198; *Electric Construction Co. v. Imperial Tramways*

*Co.*, 1900, 17 R. P. C. at p. 550.

(c) On account of the similar section (2) of the Act of 1902, which came into force on January 1st, 1905.

Therefore, as to inventions patented 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 (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. But it is submitted that he could use the fifty-year-old specification as evidence to support an allegation of prior user (*d*). The effect merely seems to be to take away the conclusive nature of such a specification as prior publication. The Patent Office search does not preclude anyone from attacking the validity of the patent by means of a specification 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.

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 a provisional specification, filed on an abandoned application not as an anticipation, but as evidence to establish a prior user, and in the interests of justice. This was done by Mr. Justice Wills in *Pneumatic Tyre Co. v. The English Cycle and Tyre Co.* (1897, 14 R. P. C. at p. 852). In *Oxley 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.

Abandoned  
prior appli-  
cation.

(*d*) See, on a somewhat similar principle, *The Pneumatic Tyre Co. v. The English Cycle and Tyre Co.*, 1897, 14 R. P. C. at p. 852.

Erle, C.J., in the course of his judgment (p. 708), said: "We are of opinion that a provisional specification abandoned does not become public by abandonment. . . . Furthermore, although the first provisional specification may afford an objection either to receiving a second patent for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void if it is so granted."

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, 3 R. P. C. 199) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the reasoning of *Oxley v. Holden* (supra, p. 81) applied to this case, and said: "But referring 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 section 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 section (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*, 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. 4 of the Act of 1907 (sect. 14 of the Act of 1889), 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 invention; 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.

By sect. 69, sub-sect. 1, it is enacted that specifications filed in pursuance of applications which are subsequently abandoned are not to be published save in the case of applications under the Convention.

Abandoned specifications not published.

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 (*e*).

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

Want of novelty in part makes patent void,

(*e*) *E.g.*, see *Lawrence v. Perry*, 1885, 2 R. P. C. at p. 187; *Stoner v. Todd*, 1876, L. R. 4 Ch. D. 58.

save in case  
of subsidiary  
claim.

of one will avoid the whole (*f*); 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 (*g*). As an illustration of this proposition we may instance the case of *True and the Variable Electric Lamp Syndicate v. Bryant Trading Syndicate* (1908, 25 R. P. C. 461). The patentee described and claimed a new form of incandescent electric lamp. It was essential to the particular nature of his invention that the lamp should be held firmly in the socket, and to ensure this he provided the wire projecting from the lamp to form a bayonet joint with the socket, with a small nut by means of which it was firmly clamped to the socket. There were only three claims, and the second was as follows: "A screwed nut *n* upon the end of the wire *f*, by which the said wire is held firm and prevented from coming out of the bayonet joint, substantially as described and illustrated." Mr. Justice Swinfen Eady said: "It was contended that the plaintiff's patent was invalid as claim 2 was an independent claim to the user of a screwed nut upon the end of a wire to fix the wire to the holder and to prevent it changing its position, and that the use of such a nut for such a purpose was one of the oldest devices in mechanics. In my opinion, the patentee . . . is merely describing a method of affixing his invention to the holder, as an advantageous method of using his invention, where special circumstances render it expedient, as, for instance, in any position where unusual vibration existed, so as to prevent the transverse wire from accidentally coming out of the notches of the bayonet joint, and claim 2 is not an independent claim or a claim in gross, but merely a subsidiary claim within the meaning of the phrase as used by Lord Cairns in *The British Dynamite Co. v. Krebs* (13 R. P. C. 193), applied by Farwell, J., in *Parker v. Satchwell* (18 R. P. C.

(*f*) *Brunton v. Hawkes*, 1821, 4 B. & Ald. 541; *Morgan v. Seaward*, 1837, 2 M. & W. 544; 1 W. P. C. 196; *Patterson v. Gas Light and Coke Co.*, 1876, L. R. 2 Ch. D. 812, 833.

(*g*) *Plimpton v. Spiller*, 1877,

L. R. 6 Ch. D. 427; *British Dynamite Co. v. Krebs*, 1896, 13 R. P. C. at p. 193; *Parker and Smith v. Satchwell & Co.*, 1901, 18 R. P. C. at p. 307.

307). Claim 2 is only claimed in connection with and as appendant to the improved device shown in claim 1."

Mr. Justice Kekewich, in *Ehrlich v. Ihlee* (1888, 5 R. P. C. at p. 205), 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" (h).

A patent will be invalidated if it can be shown that the invention has been the subject of a prior grant, although there may have been no prior publication. But only a valid prior grant would be sufficient for this purpose (i). Prior grant.

By sect. 45 of the Act of 1907 (following sect. 39 of the Act of 1883) it is enacted: "*The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity and consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—*" Industrial exhibitions.

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

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

(2) "*His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.*"

(h) See also *The American Braided Electrical Co.*, 1898, 15 R. P. C. 495; *Wire Co. v. Thomson*, 1888, 5 R. P. C. at p. 125. *Robertson v. Purdey*, 1907, 24 R. P. C. 273.

(i) *The Mica Insulator Co. v. The*

## CHAPTER V.

## UTILITY.

At common  
law.

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 182; see report in Gordon's "Monopolies by Patent") it was held that 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).

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 *R. v. Arkwright* (1691, 2 Salk. 447; 1 W. P. C. 72) the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for if it appears, as some of the witnesses

(a) *R. v. Arkwright*, 1785, 1 W. P. C. at p. 73; *Morgan v. Seaward*, 1837, 2 M. & W. at p. 561; *Manton v. Parker*, Dav. P. C. 327; 1 W. P. C. 192, n.; *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 R. P. C. at p. 462; *Elias v. Grovesend Tinsplate Co.*, 1890, 7 R. P. C. at p. 467; *Ward v. Hill*, 1903, 20 R. P. C. at p. 199.



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

It will always be a question of fact, whether the invention is useful; that is, whether that which is new is a sufficient meritorious advance or improvement upon what was already known by the public (b).

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.

Substantial,  
not extensive,  
improvement  
needed.

In *Crane v. Price* (1842, 1 W. 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 profound 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).

The test of  
utility.

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

(c) Per Lindley, L.J., in *Lane-Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 1892, 9 R. P. C. at p. 417.

Commercial  
success not  
necessary.

In *The Badische Anilin und Soda Fabrik v. Levinstein* (1887, 4 R. P. C. at p. 462), in 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" (d).

In *The Sunlight Incandescent Gas Lamp Co. v. The Incandescent Gas Light Co.* (1897, 14 R. P. C. at p. 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 putting  
in 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 R. P. C. at p. 289) 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. at p. 41) Jessel, M.R., said: "It is quite true that it has been said that it is *primâ facie* evidence of want of utility (e) if you do not make and vend your machine; but that is subject to this observation: that you may make and vend an improvement

(d) And see *Atkins and Apple-garth v. Castner-Kellner Alkali Co.*, 1901, 18 R. P. C. at 297.

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

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."

A very slight amount of utility will be sufficient to support a patent. Alderson, B., in *Morgan v. Seaward* (1837, 1 W. P. C. 186) (*f*), said: "I think if it was of different construction from any other steam engine, and of *any use* to the public, then that is sufficient." Again, Jessel, M.R., in *Otto v. Linford* (1881, 46 L. T. N. S. at p. 41) (*g*), said: "And, as to this question of utility, very little will do."

Slight amount suffices.

"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" (*h*).

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 R. P. C. at p. 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" (*i*).

New choice must be useful.

In *Easterbrook v. The Great Western Ry. Co.* (1885, 2 R. P. C.

(*f*) See also Halsbury, L.C., in *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 R. P. C. at p. 462.

(*h*) Per Chatterton, V.-C., in *Pirrie v. York Street Flax Spinning Co.*, 1893, 10 R. P. C. at p. 39.

(*g*) See also *Philpott v. Hanbury* 2 R. P. C. at p. 37; *Ehrlich v. Ihlee*, 5 R. P. C. at p. 450.

(*i*) And see *Welsbach Incandescent Co. v. New Incandescent*, 1900, 17 R. P. C. at p. 252; 1900, 1 Ch. 850.

201), the patent was granted for machinery for actuating railway points. It was proved at the trial that the patented apparatus could be worked so as to give conflicting signals which might give rise to great danger. The patent was held invalid on this ground.

Utility alone is not sufficient.

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 (*k*).

Want of utility in part.

Utility, like novelty, is part of the consideration for a grant of letters patent, and if a material portion of the invention be useless, there is a failure of consideration, and the patent is altogether void (*l*).

In subsidiary part.

But want of utility in an immaterial part of a machine which is not claimed as essential will not vitiate a patent. Lord Tenterden, C.J., in *Lewis v. Marling* (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."

Tindal, C.J., in *Haworth v. Hardcastle* (1834, 1 Bing. N. C. at p. 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

(*k*) Per Lord Watson in *Morgan v. Windover*, 1890, 7 R. P. C. at p. 136; and see Chap. III., on "Subject-matter," p. 39.

(*l*) *Simpson v. Holliday*, 1866, L. R. 1 H. L. 315, 322; *Turner v. Winter*, 1787, 1 W. P. C. 77;

*Morgan v. Seaward*, 1837, 2 M. & W. at p. 561; *Bloxam v. Elsee*, 1827, 6 B. & C. 169; *The United Horsenail Co. v. Stewart*, 1865, 2 R. P. C. at p. 132; *United Horseshoe and Nail Co. v. Swedish Horsenail Co.*, 1889, 6 R. P. C. at p. 8.

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

Commercial success is strong evidence of utility (*p*), though, as has been pointed out above, its absence is no proof of want of utility (*q*).

Kay, J., in *Lucas v. Miller* (1885, 2 R. P. C. at p. 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" (*r*). Fact of infringement is evidence.

(*m*) *Ehrlich v. Ihlee*, 1888, 5 R. P. C. at p. 455.

(*n*) *Miller v. Scarle*, 1893, 10 R. P. C. 106; *Ehrlich v. Ihlee*, 1888, 5 R. P. C. 437.

(*o*) *Owen's Patent*, 1900, 17 R. P. C. at pp. 78, 79.

(*p*) *Automatic Airtight Cover*,

*Ltd. v. Stockford*, 1902, 19 R. P. C. at p. 460.

(*q*) See ante, p. 88.

(*r*) See also Bowen, L.J., in *Miller v. Scarle*, 1893, 10 R. P. C. at p. 111; *Ward v. Hill*, 1903, 20 R. P. C. at p. 200.

## CHAPTER VI.

## THE SPECIFICATION.

To publish  
the invention.

ONE of the conditions which support the consideration for a valid patent is that the patentee must publish his invention, that is to say, he must file a "specification" containing a description of the subject-matter of his patent. He must give such an account 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 sect. 1, sub-sect. 3, of the Act of 1907, "*the 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 at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*"

The functions of a provisional and those of a complete specification are defined by sect. 2, which has made no alteration in the law upon this point.

(1) "*A provisional specification must describe the nature of the invention.*"

(2) "*A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.*"

If the applicant elects to file a provisional specification he must within six months file a complete specification, and a patent is not granted until the condition of filing a complete specification has been fulfilled.

History of  
specification.

In the early days of patent law the king granted a patent for an invention, naming it in the patent, and defining it merely by that name, and it was open to the patentee to allege that anything which fell within the name was covered by the

patent. As manufactures sprang up this method was found to lack preciseness of limitation, and accordingly in the reign of Anne a condition was inserted in all grants of letters patent, and that condition is the foundation of modern patent law. It was a proviso obliging the inventor "by an instrument under his hand and seal particularly to describe and ascertain the nature of the said invention, and in what manner the same is to be performed and to cause the same to be enrolled within six calendar months." The Crown continued, however, to grant patents on a mere title, the obligation to file a description being a mere subsequent condition. The reason for granting the patent on the title and giving the inventor a further six months was to ensure that he should not be forestalled before he could complete the invention and bring it to a practical form. It was, however, necessary that the specification should not be inconsistent with or wider than the title which still continued to form the basis of the grant, and numerous cases are recorded in which the patent was held to be invalid on the ground of variance between the title and 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 (a).

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

(a) *Cochrane v. Smethurst*, 1816, 57; 1 Stark. R. 205; and see *R. Dav. P. C.* 354; 2 *Coop. Ch. Cas. v. Elsee*, 1785, 1 *W. P. C.* 76.

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.

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 patentee's claim consisted in a new mode of manufacturing clay retorts, an apparatus used in the manufacture, and not in the transmitting and measuring, of gas:—Held, that there was fatal inconsistency, the specification being substantially wider than the title.

These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton v. Hawkes* (1821, 4 B. & Ald. 558) 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."

The provisional specification;

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty; therefore, by the Patent Law Amendment Act, 1852, the provisional specification was created. Whereas prior to the passing of that Act, applicants for letters patent, when they made their application, had merely deposited the title of their invention, by sect. 6 a provisional specification was required, which was intended to give more definite information as to the nature of the invention for which protection was sought than could possibly be given in a mere title. The provisional specification was thereafter to perform the function that was formerly that of the title, and since the Act of 1852 there is no reported case of a patent held to be invalid on the ground of variance between the title and the specification. It is true that the specification must commence



with a title (*b*), but the function of the modern title is altogether different from that which it formerly fulfilled. It is more for the purpose of identifying the invention for reference and indexing, and its accuracy is in these times a matter for the examiners at the Patent Office.

function of  
modern title  
quite  
different.

Sect. 8 of the Act of 1852 enacted that "the law officer must be satisfied that the provisional specification describes the nature of the invention," and the exact words of that section were retained in sub-sect. 3 of sect. 5 of the Act of 1883. 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 filing of a provisional specification confers upon the applicant "Provisional Protection" for his invention against the consequences of publication (*c*). The patent when granted dates back to the time when the application was lodged (*d*), but no rights against the public are conferred until the complete specification is accepted and published (*e*), after which a right of action accrues against infringers. No proceedings may be taken, however, until the patent is sealed (*f*). In these respects the law is the same as under the Act of 1883.

Provisional  
protection.

It is somewhat difficult to define clearly the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. 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." In *Stoner v. Todd* (1876, L. R. 4 Ch. 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

(*b*) Sect. 2, sub-sect. 4.

(*c*) Sect. 4.

(*d*) Sect. 13.

(*e*) Sect. 13.

(*f*) Sect. 10.

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." In *Woodward v. Sansum* (1887, 4 R. P. C. at p. 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 R. P. C. at p. 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.

Purpose of  
provisional  
specification.  
Discon-  
formity.

It is evident, therefore, 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 would be defeated.

The cases cited at p. 93 and decided prior to the Act of 1852 as to the fatal nature of a variation between the title and the specification apply (subject to the effect of sect. 42 of the Act of 1907, to be considered later) to a variation between the provisional specification and the complete specification.

In *Newall v. Elliott* (1863, 10 Jur. N. S. at p. 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 has been followed by Act of Parliament, requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance. . . . I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." Baron Channell, in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification."

A. L. Smith, L.J., in *The Cassel Gold Extracting Co., Ltd. v. The Cyanide Gold Recovery Syndicate* (1895, 12 R. P. C. at p. 257), said: "In a provisional specification no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out his invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter, with that of the complete specification which is to come thereafter, may be ascertained. In the complete specification the patentee has to do much more. Not only has he to state therein what his invention is, but he must particularly describe how his invention is to be carried out and performed, and what he claims."

Lord Chelmsford, in *Penn v. Bibby* (1867, L. R. 2 Ch. at p. 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 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."

Lord Justice Lopes, in *Woodward v. Sansum* (1887, 4 R. P. C. at p. 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. Roberton* (1878, L. R. 3 A. C. at p. 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."

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted from the complete specification without the necessity of any disclaimer (*g*); unless that part which is omitted is an essential part of the invention as originally described (*h*).

Omission  
from complete  
specification.

Moreover, it does not follow if the provisional specification describes some method of carrying the invention into effect, and the complete specification does not describe this method, but sets forth a better method, the nature of the invention remaining the same, that the method described in the provisional specification is thereby disclaimed (*i*).

The plea of disconformity when successful often worked great hardship, for the excess of invention in the complete specification over that in the provisional was sometimes the most meritorious part and quite novel in itself. Of course, if the excess matter had not been novel at the date when the application was made and the provisional specification filed, the patent failed for want of novelty, and the patentee was not entitled to any special sympathy. In order, however, to relieve the patentee under the circumstances of the first-mentioned kind,

- (*g*) *Thomas v. Welch*, 1866, L. R. R. P. C. 200.  
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 R. P. C. 98, 582; *Ward v. Hill*, 1903, 20
- (*h*) *Bailey v. Robertson*, 1878, L. R. 3 A. C. 1062; and see Vaughan Williams, L.J., in *Ward v. Hill*, 1903, 20 R. P. C. 198.
- (*i*) *Sandow v. Szalay*, 1903, 23 R. P. C. 6.

the law has been considerably modified by sect. 42 of the Act of 1907. The section is as follows :—

Statutory  
relief by  
sect. 42.

*“A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.”*

It is to be noticed that disconformity is not abolished as a ground of invalidity. The excess matter must not only have been invented by the inventor, but it must have been novel at the date when the complete specification was put in, a considerably later date than that of the application. If the excess matter was not novel at the date of the provisional specification (*i.e.*, the application), then of course the patent will be invalid for want of novelty. If it be established that the excess matter was novel at the date of the application and provisional specification, but had been published before the complete specification had been filed, even by the patentee himself, the patent will be invalid, not on the ground of want of novelty, for in discussing novelty it is the date of the application that has to be considered, but on the old ground of disconformity.

The Welch  
Case.

The Welch Patent is an instructive example by which to illustrate the law on disconformity and also the effect of sect. 42. The patent was attacked on the ground of disconformity, and was held valid. If the arguments of the defendants had been successful the patent would have been held invalid under the old law, but had the section been law at that time the validity would have been saved, on the ground that the excess matter was novel at the date when the complete specification was put in. The judgment of Romer, J., in *The Pneumatic Tyre Co. v. The East London Rubber Co.* (1897, 14 R. P. C. at p. 98) covers all the arguments. In his provisional specification the inventor described 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. . . . 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 the 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" (k).

Sub-sects. 3 and 4 of sect. 2 are as follows:—

(3) "*In the case of any provisional or complete specification*

**Drawings  
may be  
required with**

(k) Another example of the kind is *Nuttall v. Hargreaves*, 1891, 8 R. P. C. 450.

provisional  
specification.

where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification (l).

(4) "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" (m).

#### THE COMPLETE SPECIFICATION.

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

(l) The relation between the drawings and the letterpress will be discussed at p. 126.

(m) As to title, see p. 93 *et seq.*, supra. As to claims, see p. 126, infra.



acquired since filing a provisional specification subject to the qualification that we have mentioned on p. 96 *et seq.*

## 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 R. P. C. at p. 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 (*n*).

Whether it be so intelligible and whether it be sufficient are questions of fact in each particular case to be decided on evidence (*o*). Where the meaning of a phrase is dubious, or

Person to whom addressed.

Intelligibility and sufficiency questions of fact.

(*n*) See p. 110, *infra*, for a more detailed discussion of this point.

(*o*) *R. v. Arkwright*, 1787, 1 W. P. C. 64; *Hill v. Thompson*,

Expert  
evidence.

Ambit of  
claim is for  
Court alone.

there is a doubtful use of a commonly used word, the construction, as is the case with all documents, is for the Court alone (*p*). In the construction of technical words, however, 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 (*q*), but 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, and for this reason the ambit of the monopoly claim, *i.e.*, the "nature of the invention," is a matter not of evidence but of construction. The distinction was clearly pointed out by Lord Cairns in *The British Dynamite Co. v. Krebs* (1879, 13 R. P. C. at p. 192): "In determining whether the complete specification is sufficient, the first thing is to ascertain what the invention is. This is a question of construction, and the construction of the specification is for the Court, to be determined like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time, and making itself acquainted with the technical meaning in art or manufactures which any particular word or words may have. When the nature of the invention is thus ascertained by the Court, as a matter of construction, the Court has then to inquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the

1817, 1 W. P. C. at p. 237; *The British Dynamite Co. v. Krebs*, 1879, 13 R. P. C. at p. 192; *Brooks v. Steele and Currie*, 1897, 14 R. P. C. at p. 73.

(*p*) *Neilson v. Harford*, 1841, 1 W. P. C. at p. 370; *Bovill v. Pimm*, 1856, 11 Ex. 740; *Seed v. Higgins*, 1861, 30 L. J. Q. B. at p. 317; 8 H. L. C. 565; *Hills v.*

*Evans*, 1861, 31 L. J. Ch. at p. 460; *Brooks v. Steele and Currie*, 1897, 14 R. P. C. 73; and see Index, cap. "Evidence."

(*q*) *Neilson v. Harford*, 1841, 1 W. P. C. 370; *Hills v. Evans*, 1861, 31 L. J. Ch. 460; *Brooks v. Steele and Currie*, 1897, 14 R. P. C. 73.

particular art or manufacture; and this the Court can best do by the evidence of workmen of that description, and by the evidence of what workmen of that description have actually done under the patent." And Lindley, L.J., in *Brooks v. Steele and Currie* (1897, 14 R. P. C. at p. 73), said: "The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. . . . But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined" (r).

In the case of *Hills v. London Gaslight Co.* (1857, 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 was raised by evidence *dehors* the document, which was plain upon the face of it, the ambiguity being as to a term which imported one thing in a scientific sense, and another in a commercial sense, Baron Bramwell was of opinion that the meaning became a matter of fact for the jury.

The leaning of the Courts is generally 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 Ch. D. at p. 612), said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest bonâ 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

Benevolent  
construction.

(r) And see *Gadd and another v. The Mayor of Manchester*, 1892, 9 R. P. C. at p. 530.

it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton v. Spiller* (1877, L. R. 6 Ch. D. at p. 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 commented on in several cases (s):—

In *Otto v. Linford* (1881, 46 L. T. N. S. at p. 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 R. P. C. at p. 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 Explosives Co. v. Anderson*

(s) See also on this point *Russell v. Cowley*, 1835, 1 W. P. C. at p. 469; 1 Cr. M. & R. 864; *Thomas v. Foxwell*, 1858, 6 Jur. N. S. 272; *Binney v. Feldtman*, 1871, Griff. P. C. at p. 50; *Cropper v. Smith*, 1884, Griff. P. C. at p. 62; 1 R. P. C. 88; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 R. P. C. at p. 307; *Edison v. Smith*, 1894, 11 R. P. C. at p. 400; *Parkinson v. Simon*, 1895, 12 R. P. C. at p. 411; *Tolson v. Speight*, 1896, 13 R. P. C. 721; *Patent Exploitation, Ltd. v. Siemens Bros.*, 1903, 20 R. P. C. at p. 234.

(1894, 11 R. P. C. at p. 530), said: "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 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 the patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court."

Lord Chelmsford, in *Harrison v. Anderston Foundry Co.* (1876, L. R. 1 A. C. at p. 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. at p. 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.

The patentee is to be presumed not to claim things which he must have known perfectly well were not new (*t*), but if

(*t*) *Haworth v. Hardcastle*, 1834, *Smith*, 1884, 1 R. P. C. at p. 85; 1 W. P. C. at p. 484; *Cropper v. Lyon v. Goddard*, 1893, 10 R. P. C.

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 (*u*).

In *Adie v. Clark* (1877, L. R. 2 A. C. at p. 487) Lord Blackburn said: "When it is attempted . . . to say that inasmuch as these specifications show, or are alleged to show, that matters which upon a fair construction of the specification are claimed by the patentee, were old at the time that the patent was taken out, and were generally known to be old, therefore the specification must be so construed as not to include them; that seems to me both contrary, as far as I know, to the course of decision and contrary to principle."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture, or for that of an old principle to a new object, or for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that, inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, 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.

Construction  
as of date of  
publication.

A specification is to be construed with reference to the state of knowledge at the time it is published (*x*). Lord Esher, in *Nobel's Explosives Co. v. Anderson* (1894, 11 R. P. C. at

at p. 133; *Tubes, Ltd. v. Perfecta Seamless Tube Co.*, 1903, 20 R. P. C. at p. 97.

(*u*) This statement of the law was approved by Swinfen Eady, J., in *The Cooper Patent Anchor Rail Joint Co. v. The London County Council*, 1906, 23 R. P. C. at p. 295.

(*x*) And see *The Badische Anilin und Soda Fabrik v. Levinstein*, 1887,

L. R. 12 App. Cas. 710; 4 R. P. C. at p. 463; *Ellington v. Clark*, 1888, 5 R. P. C. at p. 325; *The Presto Gear Case Co. v. Orme, Evans & Co.*, 1901, 18 R. P. C. at p. 23; *Patent Exploitation, Ltd. v. Siemens Bros.*, 1903, 20 R. P. C. at p. 234; *The Consolidated Car Heating Co. v. Carne*, 1903, 20 R. P. C. at p. 766.

p. 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."

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 (*y*), including the drawings (*z*), and will give an effective meaning to every part of it, if it can. Lord Esher, M.R., in *Parkinson v. Simon* (1894, 11 R. P. C. at p. 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" (*a*). But if the provisional specification contains a description of the manner in which the invention may be carried into effect, it does not follow that if the complete specification describes a better method, the earlier method is thereby disclaimed (*b*).

In *Hattersley v. Hodgson* (1906, 23 R. P. C. 192) the Court of Appeal had decided that they could not look at the deleted portions of an amended specification for the purpose of construing the remainder. The House of Lords, without

Construction  
of amended  
specification.

(*y*) *Newton v. Vaucher*, 1851, 6 Exch. at p. 864; 21 L. J. Ex. 305; *Edison v. Woodhouse*, 1887, 4 R. P. C. at p. 107; *Parkinson v. Simon*, 1894, 11 R. P. C. at p. 502; *Tubes, Ltd. v. Perfecta Seamless Tube Co., Ltd.*, 1903, 20 R. P. C. at p. 96.

(*z*) *Hattersley v. Hodgson*, 1906, 23 R. P. C. at p. 203.

(*a*) Per Lord Esher, M.R., in *Parkinson v. Simon*, 1894, 11 R. P. C. at p. 503.

(*b*) *Sandow v. Szalay*, 1906, 23 R. P. C. at p. 14.

making any formal pronouncement on this point, actually did examine and consider the deleted portions. The report of the case is defective, as this action of the House of Lords is not mentioned (see p. 125).

Previous constructions binding.

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 (*c*), 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 (*d*).

For the rules governing construction of the claims see p. 130.

#### FIRST REQUIREMENT—INTELLIGIBILITY AND SUFFICIENCY.

Intelligibility and sufficiency distinguished.

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 R. P. C. at p. 38) Grove, J., said: "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

(*c*) *Edison v. Holland*, 1889, 6 R. P. C. at p. 276; *The Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 R. P. C. at p. 370, and the various

actions on the Welch patent.

(*d*) *Shaw v. Day*, 1894, 11 R. P. C. at p. 189; see also *Edison v. Holland*, 1889, 6 R. P. C. at p. 277.



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.'”

We will deal further with the need of stating the nature of the invention, *i.e.*, the statement of the monopoly claimed when discussing the requirements which must be fulfilled by the claims (*e*).

Intelligibility and sufficiency are required. Both depend on the class of persons to whom the specification is addressed (*f*), and on the common knowledge in the industry at the date when the specification is published. An instance is provided by the case of *The Badische Anilin und Soda Fabrik v. Levinstein* (1885, L. R. 24 Ch. D. 156; 2 R. P. C. at p. 73). 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

(*e*) See p. 128

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

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 Ch. D. at p. 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 inquired 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. at p. 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 any one 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."

In *Heath v. Unwin* (1852, 2 W. P. C. at p. 245) Baron  
L.P. 8

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

Degree of  
sufficiency  
required.

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 (*g*). If, for example, 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 (*h*). 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.

In *The Badische Anilin v. La Société Chimique* (1898, 15 R. P. C. 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.

(*g*) *Boulton v. Bull*, 1795, 2 H. Bl. at p. 478; *Morgan v. Seaward*, 1836, 1 W. P. C. at p. 174; *In re Gaulard and Gibbs' Patent*, 1886, 6 R. P. C. 224; *Edison v. Holland*, 1889, 6 R. P. C. at p. 282; *Miller v. Clyde Bridge Steel Co.*, 1891, 8 R. P. C. at p. 201; *Hopkinson v. St. James's and Pall Mall Lighting Co.*, 1893, 10 R. P. C. at p. 61; *Kane v. Boyle*, 1901, 18 R. P. C. at p. 336.

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

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.

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

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

In *R. v. Wheeler* (1819, 2 B. & Ald. at p. 354) Abbott, C.J., said: "A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad."

But this broad statement requires some modification. The inventor cannot be expected to relieve the "competent workman" from all obligation to take trouble in carrying into effect the description in the specification. Moreover, it may safely be said that in modern engineering practice no one would think of treating the drawings of a machine in a specification as working drawings. Even with the best of such drawings a certain amount of designing and calculation has to be carried out before a machine can be built, and the degree of knowledge requisite to perform such operations must be presumed in the person to whom the specification is addressed. From this point of view the classification by Jessel, M.R., in *Plimpton v. Malcolmson* (1876, 3 Ch. D. at p. 569), of different kinds of workmen, and his selection as a matter of law of the kind to which all specifications are addressed, is quite out of date as a generalisation, although of course perfectly correct as governing the issues in that particular case.

Degree of  
experiment  
necessitated.

The law was stated in a manner which is applicable to modern conditions by Alderson, B., in the far older case of *Morgan v. Seaward* (1836, 1 W. P. C. at p. 175): "You see a specification is addressed to all the world, and, therefore, all the world, at least those possessed of a competent skill, ought to be able to construct the machine by following that specification. . . . There was put in, on the part of the defendants, a model, made as it was said, according to the specification, which model would not work. The model was a copy of the drawing, and would not work because one part happened to

be a little too small, whereas if it had been a little larger, it would have worked. Now a workman of ordinary skill . . . would, of course, by the knowledge and skill he possesses, make them of sufficient size to move. There he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine" (i).

In *The Edison and Swan Light Co. v. Holland* (1889, 6 R. P. C. at p. 282) Lindley, L.J., said: "The defendants contend that the competent workman could have made 'carbon filaments' according to the specification without further instructions than are there given. If it be meant that few competent workmen could make them without some practice, I think the contention is well founded; but that is not sufficient to invalidate the patent. If a person is told to carbonise a thread, and, for want of thought or practice, he takes a porous crucible for that purpose, and does not protect his thread, and fails, whereas if he had packed this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instruction, if a little thought or consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that the workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad, if it does not tell him which tool to use."

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: "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

(i) And see *Otto v. Linford*, 1882, 46 L. T. N. S. at p. 40, per Jessel, M.R.

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, 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.

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 or drawing, 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 (k).

Effect of errors.

And it frequently occurs that the inventor states an erroneous theory as to the operation of the machine or process, the subject of the invention. This will not invalidate the patent unless it amounts to a misleading statement (l).

(k) Per Lord Westbury, *Simpson v. Holliday*, 1866, 13 W. R. 578; L. R. 1 H. L. 321; and see *Otto v. Linford*, 1882, 46 L. T. N. S. at p. 40; *Miller v. Scarle*, 1891, 10 R. P. C. at p. 111; *British United Shoe Machinery Co. v. A. Fussell and Sons, Ltd.*, 1908, 25 R. P. C. at p. 385.

(l) *Monnet v. Beck*, 1897, 14 R. P. C. at p. 847.

In *Wegmann v. Corcoran* (1879, L. R. 13 Ch. 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 term comprising a variety of species, the majority of which would be unsuitable, thus rendering experiment necessary to ascertain which were suitable.

But if the inventor describes, 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 are not described, would not be suitable, will not invalidate the patent. In *Leonhardt v. Kallé* (1895, 12 R. P. C. at p. 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?"

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 W. P. C. at p. 80) 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 affectedly introduced into the

Good faith  
and best  
method  
required.



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 patent is bad.

In *Crompton v. Ibbotson* (1828, 1 W. P. C. 83) 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 Ch. D. 67) the invention patented, on a communication from abroad, 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, and without it the description in the specification was useless. The specification was held to be insufficient and misleading. Fry, J., said: "Though the grantee of a patent for an invention communi-  
cated 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 W. P. C. 83) was a very similar case.

In case of  
communi-  
cated inven-  
tion.

It will be seen that *Wegmann v. Corcoran* is distinguishable from the case of *Plimpton v. Malcolmson* (1876, L. R. 3 Ch. D. 582). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, some fact more useful still than the description actually

given, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

In *Lewis v. Marling* (1829, 1 W. P. C. at p. 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."

Inutility in  
unessential  
part of  
description.

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 R. P. C. at p. 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 found subsequently that there was a certain, well-known silicious earth called "kieselguhr" which possessed the requisites of porosity and 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 Hatherley, 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 *Tetley v. Easton* (1856, Mac. P. C. at p. 76) Pollock, C.B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it." And in *Heath v. Unwin* (1850, 2 W. P. C. at p. 234) Coleridge, C.J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public."

In *Wood v. Zimmer* (1 W. 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 (*m*).

The remarks of Gibbs, C.J., in *Bovill v. Moore* (1816, Dav. P. C. 400), go to the same extent; and in *Crossley v. Beverley* (1830, 1 W. 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

(*m*) See *Lewis v. Marling*, 1829, *Dynamite Co. v. Krebs*, 1896, 13 1 W. P. C. at p. 496; and *British R. P. C.* at p. 195, *supra*.

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 W. P. C. 174) Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification; that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The Court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a bonâ fide full and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet v. Johnson* (1778, 1 W. P. C. 53).

In *The Badische Anilin und Soda Fabrik v. Levinstein* (1887, 4 R. P. C. at p. 464; L. R. 12 A. C. 716) the patentee in his specification described four processes whereby he could produce sulpho acids of oxyazo-naphthaline applicable to dyeing and printing, varying in colour from brown to red. All these processes he claimed, although only one of them was proved to have any practical value, and it was argued that the patent was bad on the ground that no description was given of the relative advantages of each particular shade of colour; it was held by the House of Lords, reversing the decision of the Court of Appeal, that to require such discrimination was to insist upon what was really impracticable; for, in the words of Lord Halsbury, L.C., "Upon the principle contended for, each shade must not only be shown, but its excellence or popularity must be distinguished separately by the patentee. This, as it appears to me, reduces the obligation supposed to press upon the patentee to an absurdity."

No need to state advantages,

But where the attainment of a particular advantage constitutes the whole essence of the invention it is necessary to state

save where such are whole essence of invention.

this advantage in order to properly delimit the invention. In *Clay v. Allcock* (1906, 23 R. P. C. 745) the invention consisted of a paternoster sea-fishing line, in which booms carrying hooks were pivoted at right angles to the trace, and were capable of swinging downwards so as to give a "straight pull" when a bite occurred; so far the invention was not novel. The specification stated, however, that the inward end of the boom should be constructed "preferably" of a diamond shape, and the drawings illustrated a construction of this form. The claim was for booms constructed "as described." It appeared, although it was not so stated in the specification, that a particular advantage attended the use of the diamond shape which rendered it very useful and constituted the whole novelty of the invention. The Court of Appeal held that the claim was invalid for want of novelty. Fletcher Moulton, L.J., said: "I quite agree that in the preferable form of his invention, which the patentee has shown in his drawings, he would have that effect or advantage, but I can find nothing which indicates that he intended that to mark out the limits of his territory. . . . Counsel for the plaintiff urged the well-known principle in patent law that a man need not state the effect or the advantage of his invention, if he describes his invention so as to produce it. But that is not true where he has to rely on the presence or absence of such effect or advantage as a part of the necessary delimitation. The fact that it is a mere consequence cannot be pleaded by him as an excuse for not putting it in, if the leaving it out leaves his invention inadequately defined."

If the specification describes more than one process for arriving at a result, and fails in respect of one of them by reason of insufficiency, the whole patent will be void.

To sum up the effect of the decisions on deception and insufficiency:—

If extraneous matter is put into the specification, bona fide thinking that it is necessary, the patent will not be held to be void; if it is put in malâ fide, with the intention of deceiving, or with the knowledge that it is extraneous and useless, the patent will be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from

! Drawing, illustrations, only  
Thomas & South Wales collection  
x L 11 R. P. C. 22.

successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void. It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bona fides* on the part of the inventor.

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

By sect. 2, sub-sect. 3, of the Act of 1907, it is enacted: "*In the case of any provisional or complete specification where the comptroller deems it desirable, he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.*"

Before the Act of 1883 (o) drawings were quite optional on the part of the patentee (p); but then, as now, if drawings had not been filed, and the invention had been too complicated to be understood without them, the patent would be invalid on account of insufficiency, and not because drawings were not filed. Drawings have always been held to be merely part of the specification and to be read with the letterpress, and whether the invention will be limited by the drawings will depend on the nature of the invention (q).

Collins, M.R., said, in *Hattersley v. Hodgson* (1904, 21 R. P. C. at p. 525): "Now in my judgment (and I think it has been so held) a patentee may show what he claims either by the printed matter of the specification alone, or by the drawings alone, or by the combination of the two" (r).

(n) *Crossley v. Potter*, 1853, Macr. P. C. at p. 245.

(o) Sect. 5, sub-sect. 4.

(p) *Boulton v. Bull*, 1795, Dav. P. C. at p. 188; *In re Fox's Patent*, 1812, 1 W. P. C. 431, n.

(q) See, as instances, *Bloxam v. Elsee*, 1827, 1 C. & P. 558; *Lawrence v. Perry*, 1885, 2 R. P. C.

at p. 186; *Fairburn v. Household*, 1886, 3 R. P. C. at p. 267; *Pickard v. Prescott*, 1890, 7 R. P. C. at p. 365; *Miller v. Scarle*, 1893, 10 R. P. C. at p. 111.

(r) And see *Hattersley v. Hodgson* (2nd action), in the House of Lords, 1906, 23 R. P. C. at p. 202.



**Discrepancies  
in drawings.**

It is sometimes asked, "What is to be done if there is a discrepancy between the printed matter and the drawings?" And this may be answered by the question, "Does the discrepancy produce ambiguity sufficient to mislead?" If it be clear to persons skilled in the trade what is meant, then the patent is not ambiguous, and it is immaterial from which part of the specification they have drawn their information. If there is ambiguity, the patent is invalid. It is submitted that this proposition covers the whole point.

**The claims.**

*See Act 1819.*

We have seen that part of the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently, for a specification to be sufficient it must particularly ascertain: (1) What the monopoly claimed is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he claims, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, or at least to indicate, "This is old and I do not claim it as a part of my invention." There are two reasons why the inventor should be called upon to fulfil these conditions: one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In a well-drawn specification the nature of the invention should be set out in the body of the specification, as well as in the "claims" hereinafter referred to, and, if possible, prior to the description of the manner of carrying the invention into effect. This arrangement is not absolutely necessary, since the nature of the invention must in any event be set out in the claims, but it is certainly advisable, for in the course of describing the operation of the invention it will very probably be necessary to include a description of something which is well known, and which it is not desired to claim.

By sect. 2, sub-sect. 4, re-enacting sect. 5, sub-sect. 5, of

the Act of 1883, it is provided that “*a specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.*” This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of the Act of 1883, that the inventor must make a distinct and unambiguous claim.

It was decided in the House of Lords that the enactment in sect. 5 of the Act of 1883, that a complete specification must end with a distinct statement of the invention claimed, was directory only, and when letters patent have been granted, they will not be invalid merely because it has not been complied with (s).

As has been pointed out at p. 98, the Act of Anne required a specification of the invention to be filed as a condition subsequent to the grant.

In the case of *The British United Shoe Machinery Co. v. Fussell* (1908, 25 R. P. C. at p. 650) Fletcher Moulton, L.J., dealt with the history of distinct claims as part of specifications. After mentioning the Act of Anne, which required the patentee to state in a specification: (1) The nature of the invention, and (2) the method of performing the same, the learned Lord Justice proceeded: “The first was necessary to define the monopoly and the second was necessary to secure that the public was not defrauded by the patentee . . . These two things—the delimitation of the invention and full practical directions how to use it—are in their nature almost antagonistic. As it is the duty of the inventor to give the fullest practical information to the public, he is bound to put in, if for instance the invention is a process, quantities and times which are the best he knows. But it would be very cruel to hold him to the invention when carried out only with those best quantities and times, because a person could then take his invention in substance if he did not take it in quite the best way, and the value of the grant would be practically nothing. Hence inventors, in their own protection, took to

History of the claim.

(s) *Vickers v. Siddell*, 1890, 7 R. P. C. at p. 303; L. R. 15 App. Cas. 496, 500, 505.

introducing into their specifications language intended to distinguish between that which was there for the practical information of the public, and that which was there for delimitation of the invention. Correct delimitation was of the greatest possible importance to the inventor, because if his patent covered something which was old the patent was wholly bad. At the same time there was the danger of confining himself to a mere outline which gave delimitation, but did not tell the public the best way within those limits of performing his invention. The one duty required him to state his invention in its most general form, and the other duty required him to state it in its best, and therefore in a very special form. Out of that has arisen the practice, which originally was perfectly optional, of having a separate part of the specification primarily designed for delimitation. That is what we call the claim."

The Court, therefore, must be taken to distinguish between describing too much and claiming too much. In the course of a well-drawn specification it is frequently necessary to describe something which is old, and, provided that it is made clear that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent.

Purpose of  
the claim.  
Obligations.

Some degree of controversy has arisen by reason of the requirement that the patentee must state "the nature of the invention." The word "invention" is capable of more than one meaning, but is used here in the sense of "monopoly." Fletcher Moulton, L.J., pointed this out in *The British United Shoe Machinery Co. v. Fussell* (1908, 25 R. P. C. at p. 651): "In the Act of 1883, for the first time, it was made a statutable duty to insert claims to define the invention, and that has been continued up to the present time; but the language of the statute follows that of the old proviso and leaves no doubt that the duty is only to define the invention for which the monopoly is claimed. The justice and sufficiency of that requirement are obvious. Specifications are not for the purpose of providing material for subsequent historians as to the genesis of ideas; they are for the purpose of informing the public as to

what is the monopoly . . . A patentee often works solitarily. He has very little idea of what others are doing, and I think I may say that in the enormous majority of instances, if not universally, he has no complete knowledge of what has been done by others in connection with the matter on which he is working. The inventive acts by which he arrives at the invention for which he finally obtains protection may be inventive acts which have started far behind the level of public knowledge at the time, and much of his work truly inventive so far as he is concerned has been to re-invent that which others, without his knowledge, have invented. The consequence is that the inventive act of the inventor can have no relevance or effect; it is a thing which depends on his knowledge of what others had done. Then are we to say that he is to state what would have been the inventive act, supposing him to know the whole knowledge of the world. . . . Of course, if his ignorance has led him to claim something which is not novel he has to take the penalty. He has chosen at his own risk to ask for and take a monopoly as against the public, and the consequence is, that if, with the best of faith, he has asked for too much, he must suffer for it. But to say that he must also ascertain, under the penalty of his patent being bad, everything that preceded his invention, every approach from every side that persons have made to it, and must correctly indicate the little step which he has made in addition to these, most of which he never knew, would be to require something of him, which would be perfectly idle so far as regards utility to the public, and grossly unjust so far as the patentee is concerned. . . . For these reasons I am satisfied that there is no duty to distinguish old from new in the invention actually claimed. If the invention actually claimed is novel that is sufficient."

So where a patent is for a combination of old or new parts, or for an improved arrangement of old mechanism, provided it be clear that a monopoly is claimed for the new combination only, the specification need not discriminate between the new and old parts of such combination or improved apparatus unless it be desired to claim any of those subordinate parts *per se*, since it is the new combination alone that constitutes the novelty

Combination  
claims.

and merit of the invention; but it is necessary for the patentee to particularly ascertain and define what his monopoly covers, or what are the exact parts of his new combination, so that any person of ordinary knowledge of the subject may be able at once, on reading the specification, to know that the invention claimed consists in the combination specified.

A great deal of confusion arose over the apparent conflict between the judgments of the House of Lords in *Foxwell v. Bostock* (1864, 4 De G. J. & S. 298) and *Harrison v. Anderston Foundry Co.* (1876, L. R. 1 App. Cas. 574) as to the alleged necessity of distinguishing new from old in a claim for a combination (t). In view of the judgments in the Court of Appeal in *The British United Shoe Machinery Co. v. Fussell*, above referred to, and the fact that specific claims are always found in modern specifications as a result of the official examination, it is extremely unlikely that this objection will ever be urged against a patent in future. The authorities are all reviewed in the judgments and carefully explained. The objection no longer has any substance. As Lord Justice Fletcher Moulton observed (p. 651): "If I were to sum up my criticism of the point I should say that a man must distinguish what is old from what is new *by* his claim; but he has not got to distinguish what is old from what is new *in* his claim. If the combination which he has claimed, and for which he asks a monopoly, is novel, that is sufficient. There is no obligation to go further and to state why it is novel, or what in it is novel."

**Construction  
of the claims.**

The claim will be construed with reference to the entire patent; and although at first sight there may be some appearance of obscurity in it, if it can be made clear by the consideration of the whole specification, the patent will not be thereby avoided (u).

(t) See, e.g., *Clark v. Adie*, 1877, L. R. 2 App. Cas. 321; *Moore v. Bennett*, 1884, 1 R. P. C. 129; *British United Shoe Machinery Co. v. Thompson*, 1905, 22 R. P. C. 177. p. 427; *Edison v. Woodhouse*, 1827, 4 R. P. C. at p. 107; *Leadbeater v. Kitchin*, 1890, 7 R. P. C. at p. 244; *Elias v. Grovesend Tin Plate Co.*, 1890, 7 R. P. C. at p. 463; *Edison v. Smith*, 1894, 11 R. P. C. at p. 395; *Parkinson v. Simon*, 1894, 11 R. P. C. at p. 507; *Electric*

(u) *Arnold v. Bradbury*, 1871, L. R. 6 Ch. 712; *Plimpton v. Spiller*, 1877 L. R. 6 Ch. D. at

In the case of *Arnold v. Bradbury* (1871, L. R. 6 Ch. 712) Lord Hatherley, in the course of his judgment, says: "I do not think that the proper way of dealing with this question is to look first at the claims, and then see what the full description of the invention is; but rather first to read the description of the invention, in order that your mind may be prepared for what it is the inventor is about to claim."

Each subordinate part of an invention must be claimed specifically in order to be independently protected, for everything that is not claimed is considered to be disclaimed, and should a man describe ten inventions in his specification and claim only one of them, he thereby presents to the public the remaining nine (x).

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 an 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 account of his use of these words (y), 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 emphasising 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 (z). But beyond having

*Construction Co. v. Imperial Tramways Co.*, 1899, 16 R. P. C. at p. 638; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co.*, 1903, 20 R. P. C. at p. 98; *British United Shoe Machinery Co. v. Hugh Cloughton, Ltd.*, 1906, 23 R. P. C. at p. 334.

(x) *Hinks v. Safety Lighting Co.*, 1876, L. R. 4 Ch. D. 612.

(y) See, e.g., *United Telephone Co. v. Bassano*, 1886, 3 R. P. C. at

p. 315; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, 1895, 12 R. P. C. at p. 257; *Parkinson v. Simon*, 1895, 12 R. P. C. at p. 408; *Welsbach Incandescent Gas Light Co. v. New Incandescent Co.*, 1900, 17 R. P. C. at p. 250.

(z) *Easterbrook v. Great Western Rail. Co.*, 1885, 2 R. P. C. at p. 208; *Goddard v. Lyon*, 1894, 11 R. P. C. at pp. 361, 362; *Chadburn v. Mehan*, 1895, 12 R. P. C. at

"Substantially as described."

p. *Chick v. Dick*  
*Brown v. L. J. C.*  
 x x x x x R. P. C. 1. 4  
*Tucker v. W. A. S.*  
*W. A. S. v. E. A. S.*  
 x L. R. 11 R. P. C.  
 589

*Macle v. W. A. S.*  
 x L. R. 11 R. P. C. 34.  
*Pugh v. Riley*  
 1914 31 R. P. C.  
 272

*Tucker v. W. A. S.*  
 1925 42 R. P. C. 29

this cautioning effect, they are mere verbiage, as the same result may be obtained by carefully construing the specification (a).

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

The fact that one of the claims is practically a repetition of another will not vitiate a patent. In the *Wenham Gas Co. v. The Champion Gas Lamp Co.* (1892, 9 R. P. C. at p. 55) Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the importance of the perforated tube in claim 3—a repetition in fact of claim 3—I do not think it is anything more. If so, it does not vitiate the patent. It may be open to the criticism that it is redundant; but if it is nothing more than pointing out what is a valuable operation, and what has been claimed in clause 3, it does not thereby vitiate the patent."

But an effective meaning must if possible be given to each claim. In *Parkinson v. Simon* (1894, 11 R. P. C. at p. 502) Lord Esher, M.R., said: "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 which are identical with each other, then some of them have no effect at all. It follows from the ordinary rules 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" (c).

Where one of the claims in a specification, although strictly it may be for something old, is purely subordinate to the main invention and merely amounts to a declaration of one of the merits and advantages of the contrivance disclosed in the specification, it has been held that a patent is not void on that account (d).

p. 134; *Brooks v. Lamplugh*, 1898, 15 R. P. C. at pp. 48, 49.

(a) *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. at p. 240.

(b) *Young v. Rosenthal*, 1884, 1 R. P. C. at p. 33; *Westinghouse v. Lancashire and Yorkshire Rail Co.*,

supra.

(c) *Clark v. Adie*, 1877, L. R. 2 App. Cas. at p. 321; *Cropper v. Smith*, 1884, 1 R. P. C. at p. 67.

(d) E.g., *True and The Variable Electric Lamp Syndicate v. Bryant Trading Syndicate*, 1908, 25 R. P. C. 461.

## CHAPTER VII.

## PROCEDURE ON APPLICATION FOR LETTERS PATENT.

IN the present chapter it is proposed to deal with the law and practice relating to the application for a grant, and the acceptance of specifications by the Comptroller.

By sect. 1, sub-sect. 2, of the Act of 1907 : “ *The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.*” The practice is regulated by the Patents Rules, 1908, which came into operation on December 31, 1907. In an Appendix will be found a copy of the “Instructions to Applicants for Patents,” issued by the Patent Office and based on the Rules, which is a very complete practical guide.

The forms of application.

Applications for patents for inventions made in Great Britain and Ireland and the Isle of Man must be made on Form 1 ; for inventions communicated from abroad on Form 1A ; and applications for patent under international and colonial arrangements must be on Form 1B ; an application for a patent of addition is made on Form 1C ; and for a secret patent on Form 1D (a). In the case of an invention which is partly original and partly communicated from abroad, it would seem that the best course would be to apply on Form 1. But the patent will not be rendered invalid if the wrong course is taken, since in any case the applicant is the true and first inventor in law (b), and the Comptroller can have no means of knowing how the invention originated. But in the case of an application by a corporation, it has been decided that Form 1 is not applicable (c), apparently for the reason that a corporation cannot perform the mental function of inventing. This decision is, of course, binding on the Patent Office, but as “inventing” in the mental sense is not a requisite of a valid

(a) See Appendix.

(b) See p. 17, ante.

(c) *Société Anonyme du Générateur du Temple*, 1896, 13 R. P. C. 54.



Patent  
agents.

patent (see Chap. III., p. 50) it is submitted that the decision is erroneous in law. The applicant must himself sign the application, and certain other specified formal documents, but for many matters he may employ an agent. (See as to this, rule 9 and the Patent Agents Rules of 1908.) Such agent need not be a "patent agent," but he must be an agent duly authorised to the satisfaction of the Comptroller (*d*).

Recently the Comptroller has refused to be satisfied with the authorisation of irresponsible foreigners, who, although resident in this country, are the nominees of foreign patent agents.

In the case of an application by two or more persons, the application must be signed by all those persons, but it is not absolutely essential that the complete specification should be signed by more than one of them (*e*).

Deceased  
inventor.

If a person possessed of an invention dies without having made an application for a patent, application may be made by, and a patent for the invention granted to, his legal representative, and such an application must contain a declaration by the legal representative that he believes the deceased to have been the true and first inventor (*f*).

Posting  
documents.

A document sent to the Patent Office by post is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post, and it is sufficient to prove that the letter was properly addressed and posted (*g*).

The declara-  
tion.

Sect. 1, sub-sect. 3, enacts: "*The 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 at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*

(4) "*The declaration may be either a statutory declaration or not, as may be prescribed.*"

(*d*) See *Graham v. Fanta*, 1892, 9 R. P. C. 164; for forms of authorisation, see Appendix.

(*e*) *Grenfell and McEvoy's Patent*,

1890, 7 R. P. C. 151.

(*f*) Sect. 43.

(*g*) Sect. 81 and sect. 26 of the Interpretation Act, 1889.

The prescribed form of declaration is incorporated in the form of application in each case, and is not a statutory declaration. Where the inventor is incapable, by reason of infancy, lunacy, or other inability, of making any declaration or doing anything required or permitted by the Act, such declarations may be made and such things may be done on his behalf by the guardian or committee of such incapable person, or by any person appointed by the Court (*h*). When inventor incapable.

Statutory declarations made in conformity with this Act are exempt from the stamp duty of two shillings and sixpence charged on a statutory declaration made under the Statutory Declarations Act, 1835, by the Revenue Act, 1884 (*i*).

By sect. 3, sub-sect. 1, "*The Comptroller-General of Patents, Designs and Trade Marks (hereinafter referred to as the Comptroller) shall refer every application to an examiner.*" Reference to examiner.

The duty of the examiner is to ascertain that the application and specification have been prepared in accordance with the rules.

The following points upon the preparation of the specification require special notice:—

**One invention only must be described.**

Rule 13 commences thus: "(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus or process." One invention only to be described.

In *Jones' Patent*, Herschell, S.-G., said (Griff. P. C. 265): "I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then there are six inventions. . . . You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent

(*h*) Sect. 83

(*i*) 47 & 48 Vict. c. 62, s. 9.

of the purpose of the combination, then you have got an extra invention, and it is not all one."

The rule continues thus: "Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

"Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Act, and by these rules.

"Where the Comptroller has required or allowed any application, specifications or drawings to be amended as aforesaid, such application shall if the Comptroller at any time so direct, bear such date subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application" (k).

By sect. 16 of the Act of 1907 the following new provision has been introduced into the practice of the Office:—

**Provision  
for cognate  
inventions.**

*"Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.*

(2) *"Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for*

(k) Paragraph 2 of rule 13 will be dealt with on p. 137.

Spec not confined to one invention  
S.3 app. XLII R.P.C. 1.

*the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the Court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein."*

It must not be forgotten that, if the applicant avails himself of this arrangement, he runs the risk of the whole patent being declared invalid on account of the want of novelty in a part of the complete specification which is founded on one only of the provisional specifications. Paragraph 2 of rule 13, dealing with this practice, is as follows: "Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other, and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions."

The rule that a patent may only be granted for one invention is merely one of practice, and if a patent be actually granted it cannot afterwards be impugned on the ground that it was granted for more than one invention (sect. 14, sub-sect. 2).

In *Re Smith's Patent* (Griff. P. C. 268) Herschell, S.-G., said: "There is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I should only guard myself by saying this: that if the statement of the invention claimed were such as 'I claim the invention described in the specification,' that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description." But the facts of that case are not reported, and it is highly probable that since the Act of 1905 the power of the Comptroller has been much wider than as defined by this judgment. The Comptroller has the power to require the claims to be modified in accordance

Conformity of  
claims and  
specification.

with the results of the inquiry into novelty, and the invention must be sufficiently clearly described to show what the claims actually mean. It would be strange if the claims need not conform to the description.

Points  
of form  
frequently  
neglected.

The following points are worthy of attention, as a considerable waste of time and trouble are caused by the constant neglect of them by applicants:—

- (1) The specification must be dated and signed (by the applicant or his authorised agent).
- (2) In the case of an application on Form 1B under sect. 91 of the Act of 1907, a copy of the foreign specification, a translation and drawings, all duly certified by the official head of the foreign patent office, must be enclosed.
- (3) Drawings must be furnished in duplicate, marked respectively "original" and "true copy," but the lettering of the duplicate drawings must be in black lead pencil, and not in ink.

This is somewhat irritating, but the reason for it is cogent. The drawings have to be reduced in size for abridgment in the *Journal*, and were all the lettering to be proportionately reduced great indistinctness would result. Where the lettering is in pencil it may be erased and only replaced so far as may be required when the drawing is reduced.

The duplicate may be on tracing cloth.

It may further be noticed that the office are prepared to supply the required duplicate drawings at a small cost.

If a provisional specification is filed it must clearly indicate the nature of the invention. The description must be quite clear, although the detail is not required.

Claims must  
be succinct.

The claims must be succinct as well as separate and distinct from the body of the specification. It must be remembered that the object of the claim is to give a perfectly clear statement of the invention claimed. Of late years a superstition has arisen that a patent is more valid and has a greater hold over infringements if every possible permutation and

? See the  
drawing  
x LII R.P.C.  
APP  
1.725(A)

combination of the elements entering into the invention is separately claimed, and it has become a practice to file claims which are copies of those used in American specifications. American claims may be very useful in dealing with American law, but in English law such prolixity does not help a Court which, whether in considering novelty or infringement, invariably seeks to obtain an answer to the broad question, "What has this man invented?"

The matter came before both law officers of the Crown on the interpretation of rule 4 of the Patents Rules, 1905 (rule 14, 1908), in the case of *Bancroft's Application* (1906, 23 R. P. C. 3). The Attorney-General pointed out that certain kinds of inventions might be such as to justify a large number of claims. "So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that there is necessarily any infringement of this rule. . . . But in the present case we think that the decision of the Chief Examiner was right. . . . An attempt is made to deal with every possible contingency. . . . I must say that I deprecate very much the multiplication of claims by the system, which seems to have prevailed in America, of attempting to deal with every possible contingency. I do not think it results in clearness. I think that the system of claims with which we are more familiar in this country is really clearer in the result, and that those who have American patents and who desire protection in this country, in bringing forward their claims, must endeavour to conform to the practice which has prevailed in this country."

The title of the invention must sufficiently indicate the subject-matter of the invention (see Chap. VI., p. 95).

The complete specification and the provisional must describe substantially the same invention, and the titles must correspond.

By sect. 3, sub-sects. 2, 3 and 4: (2) "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may*

**Power of  
Comptroller  
to refuse at  
this stage.**

*refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with."*

**Examiner's report not binding on Comptroller.**

The report of the examiner is not to bind the judgment of the Comptroller, but merely to assist him in making his decision as to whether the application and specifications fulfil the requirements of the Act (l). It is difficult to define exactly what is the meaning of the words "whether the nature of the invention has been fairly described," and there is no direct decision on the point, but it is to be presumed that the duty of the Comptroller and examiner does not extend to a minute criticism of specifications. It is clear, however, that the invention must be sufficiently described to enable the inquiry as to novelty to proceed. As a matter of practice, the examiners always require ambiguous descriptions to be made clear, and this is distinctly advantageous to applicants.

(3) "*Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.*

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

The procedure on appeals to the law officer will be dealt in Chap. VIII. on "Opposition."

#### The Examination of the Complete Specification.

**Examination of complete specification.**

(A) By sect. 6, sub-sects. 1, 2 and 3: (1) "*Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner.*

(2) "*If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.*

(l) *C.'s Application, 1890, 7 R. P. C. 250.*

*Examiner's report amended disclosed } Sec 68 R.P.C. 1890  
XLI R.P.C. 58*



(3) *“If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may—*

**As to discon-  
formity.**

(a) *refuse to accept the complete specification until it has been amended to his satisfaction ; or*

(b) *(with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date :*

*“Provided that when the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.”*

The courses which may be pursued under clause (b) and the proviso are entirely new. If the original application covers the main principle of the invention, and the subsequent additional matter is in the nature of improvement, it is better to take advantage of the proviso, and so secure the earlier date for the main invention, than to use the procedure created by clause (b).

(B) The complete specification is next examined with reference to the novelty of the invention so far as British specifications published within fifty years from the date of application are concerned. This is provided for by sect. 7 (see Appendix). If anticipations are found the Comptroller may require the specification to be amended to his satisfaction, *“and (by sub-sect. 4) unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and if so what, prior specifications ought to be made in the specification by way of notice to the public.*

**Examination  
as to novelty.**

*“Provided that the Comptroller, if satisfied that the*

**Power to  
refuse patent.**

*invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent."*

This power to refuse a grant is wholly new.

An appeal to the law officer from any decision by the Comptroller under this section is given by sub-sect. 5.

The specific reference.

Rule 32 is as follows: "When under sub-sect. 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—*Reference has been directed in pursuance of sect. 7, sub-sect. 4, of the Patents and Designs Act, 1907, to specification No. of .* Where the reference is inserted as the result of a provisional report (*m*) under rule 29, a statement to that effect shall be added to the reference." It will be noticed that the prescribed form of reference is very clear and explicit, and is intended to warn the public that the invention has been actually claimed in a prior specification.

Two kinds of specific reference.

There are two distinct kinds of specific reference in use; the first is in this form, "*My invention relates to fire-bars of the class described in the specification of Letters Patent No. of .*" The purpose of this is to limit the ambit of the claim and to define more clearly the invention. It may very properly be inserted where the object of the invention is to improve upon a known invention. The insertion of a reference of this kind may be quite sufficient to warn the public and also to safeguard prior patentees (see Chap. VIII.) where the claims are clearly and honestly drafted so as to limit the invention strictly to the improvements which are to be applied to an invention which has been claimed in a prior specification.

The *second* kind is the specific reference prescribed by the rule. The effect of this is to warn the public that the patent is invalid and that the invention claimed has been claimed in a prior specification.

(*m*) See p. 149.

The second kind of reference was introduced by the Patents Rules, 1905, in pursuance of the Act of 1902. Under that Act the Comptroller had no power to refuse a patent even if the claims were specifically anticipated by prior specifications. But now that the Comptroller has power to refuse a grant altogether, it seems that the prescribed form of reference is hardly necessary unless it be considered that the patent may only be refused in the case of every claim being anticipated by a claim in a prior specification.

There is an intermediate type of reference which is sometimes inserted. It amounts in effect to a disclaimer, and runs as follows: "*I am aware of the specification of Letters Patent No. of granted to J. S., and I do not lay claim to anything therein claimed or described.*" This is usually inserted as the result of compromise, and it may be useful where the invention appears to have been described though not claimed in a prior specification. The reason for its existence is that the Office naturally hesitates in a doubtful case to decide that there is no novelty in a claim, but prefers to leave the matter for the Courts.

An inter-  
mediate type.

These three kinds of references were analysed and explained in *P.'s Application* (1906, 23 R. P. C. 644). The decision was given before the Act of 1907, and there is little doubt that under that Act the application would have been refused. The applicant offered to insert a reference of the first kind or of the intermediate kind, but the Chief Examiner, whose decision was supported by the law officer, insisted upon a reference in accordance with rule 32.

The law officer (Sir W. Robson, S.-G.) said (p. 646): "The phrase 'notice to the public,' of course, does not necessarily mean 'Warning to the public'; and I am bound to say that it seems to me that it ought to mean 'Warning to the public,' in a somewhat peculiar case like the present, where the public cannot very easily, however expert they may be, altogether grasp the full significance of the reference as it is made by the applicant here. It is certainly not made in a way which adequately puts the reader on his guard. So far as the Comptroller is concerned, his reference, although it is not, in

form, a warning, any more than the applicant's is, is undoubtedly made in a way which excites attention and arouses apprehension. I think that is by no means inconsistent with the intention of the legislature . . ."

The additional search under sect. 8.

Before the Act of 1907 the search on novelty only extended to complete specifications filed pursuant to prior applications and published before the date of the application. By sect. 8 it is extended further to specifications filed in pursuance of prior applications and published after the application under investigation. Now specifications until accepted and thrown open to public inspection are secret documents, and the Patent Office may not disclose their contents, so that such specifications as are filed in pursuance of prior applications may only be shown to the applicant as they are accepted. The officials, however, who are acquainted with the prior applications already, will know where to find the specification when filed, and after its acceptance they may bring it to the attention of the applicant. Sect. 8 is as follows: (1) "*An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.*

(2) "*Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.*

(3) "*For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.*

(4) “*This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.*”

The date fixed is January 1st, 1909.

The practice is regulated by rule 83.

Under the provisions of sect. 75 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. Immoral inventions.

He may also refuse a patent where the invention is not a “new manufacture” within the Statute of Monopolies (n). As a matter of fact, applications are frequently made to patent most ingenious notions and systems which are not “new manufactures.”

Before exercising any discretionary power adversely to the applicant, the Comptroller must give him ten days’ notice, so that he may be heard personally or by his agent on the point in question (o).

When two persons who are joint applicants quarrel, and each lodges a complete specification, the one specification differing from the other, the Comptroller has no jurisdiction to say which specification is to be filed (p). Dispute between co-applicants.

An applicant who threatens to withdraw or otherwise attempts to wreck an application may be restrained by interim injunction (q) on motion by his co-applicant.

The subject of appeal to the law officer from decisions of the Comptroller will be dealt with in the chapter relating to Opposition to a grant of letters patent.

Sect. 5 fixes the time within which a complete specification must be filed after filing a provisional specification. Time for leaving complete specification.

(1) “*If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application.*”

“*Provided that where an application is made for an extension*

(n) *Bridge’s Application*, 1901, 18 R. P. C. 257; *Cooper’s Application*, 1901, 19 R. P. C. 53; *Johnson’s Application*, 1901, 19 R. P. C. 56. (p) *Apostolloff and Frendenberg’s Application*, 1896, 13 R. P. C. 275.

(o) Sect. 73 of the Act of 1907; see also P. R. 1908, r. 31. (q) *The Wool Syndicate v. Riches*, 1902, 19 R. P. C. 127; see also *Punchard v. Dade*, 1894, 11 R. P. C. 257.

*of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.*

(2) *“ Unless a complete specification is so left the application shall be deemed to be abandoned.”*

Formerly the power to allow an extension of time was in the discretion of the Comptroller; now the applicant may obtain an extension as a matter of right.

**Time for acceptance.**

By sect. 6, sub-sect. 5, the time within which a complete specification must be accepted is fixed.

*“ Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void.*

*“ Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.”*

The six months allowed by this section for the filing of the complete specification are calendar months (r), and are reckoned exclusive of the day of application (s), and in the event of the last day of such six months falling on a Saturday or on a day when the Office is not open, the specification may be filed on the day succeeding such excluded day or days (t).

**Acceptance to be advertised.**

Sect. 6 enacts: *“ On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.”*

The advertisements are published in the *Illustrated Official Journal*.

In the event of an application being abandoned, the specifications and drawings which were left in connection with the application are not published, nor are they at any time open to public inspection (u), except in the case of an abandoned application under sect. 91 (x).

(r) 13 & 14 Vict. c. 21, s. 4.

(s) *Russell v. Ledsam*, 1847, 14 M. & W. 574, 582; *Williams v. Nash*, 1859, 28 Beav. 93; 1859, 5 Jur. N. S. 696.

(t) Sect. 82 of the Act of 1907; see also rule 111.

(u) Sect. 69.

(x) Sect. 91, sub-sect. 3 (a).

A new kind of monopoly right was introduced by the Act of 1907. By sect. 19, sub-sect. 1: *“Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.”* Patents of addition.

(2) *“Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.”*

(3) *“A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.”*

(4) *“The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.”*

For remarks on the subject-matter of a valid Patent of Addition, see Chap. III., p. 64.

Sect. 30 provides for the assignment by an inventor of all the benefit of an invention to the Secretary of State for War or to the Admiralty. And in such a case the Secretary of State or the Admiralty may certify that the application for a patent and the specifications be kept secret. A secret patent cannot be revoked. The procedure is regulated by rules 97—99. Secret patents.

By sect. 2, sub-sect. 5, the Comptroller is empowered to call for samples and specimens of a chemical invention. The purpose of this enactment is to prevent patents being obtained for the mere purpose of stopping further investigation. It was said that certain persons merely watched for reports of investigations in chemical industry and hastened to forestall the inventors by filing specifications which purported to describe and claim the practical results of such investigations, but which contained no really useful description. The new enactment Samples and specimens.

is intended to obtain some indication of the bona fides of the applicant. It is not clear how the specimens and samples are to be dealt with. The officials can hardly be expected to analyse the specimens to see if they are genuine. It is possible, however, that the Court could order the specimens to be produced and analysed if in a subsequent action the validity of the patent were put in issue on the plea of non-utility or insufficiency.

The sub-section is as follows: "*Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.*"

Provisional protection.<sup>1</sup>

The practice is governed by rule 36.

By sect. 4: "*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 invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

Provisional protection exists for the purpose of enabling an inventor to work at and improve his invention without thereby avoiding the patent subsequently granted to him on the ground of want of novelty (*y*); it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot bring an action in respect of any infringement committed before the publication of his complete specification (*z*), and further, he may not style the invention which is provisionally protected as "patent," but he may make use of such words as "patent applied for" (*a*).

Use of word "patent."

Rights given by acceptance of complete specification.

Sect. 10 enacts:—

"*After the acceptance of a complete specification, and until the date of sealing a patent in respect thereof, or the expiration of*

(*y*) Per Earl Cairns, L.C., in *In re Dering's Patent*, 1879, L. R. 13 Ch. D. at p. 395; and see Chap. VI., p. 95.

(*z*) Sect. 13 of the Act of 1907.

(*a*) Sect. 89; see *R. v. Wallis*, 1886, 3 R. P. C. 1; *R. v. Crampton*, 1886, 3 R. P. C. 367.



*the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him."*

It is no offence, therefore, to describe an article as "patented" after the complete specification has been accepted but before the patent is sealed (b).

The mere fact that the article has at one time been the subject of a patent now expired will not entitle the patentee to mark it as "patented," as the word implies that there is an existing patent (c).

The effect of sects. 4 and 10 is that no proceedings for infringement may be taken before the patent is sealed, after which time proceedings can only be taken with reference to infringements committed after the acceptance and publication of the complete specification.

The effect of the provisions of the Patents, &c. Acts to prevent fraudulent applications, and also of those for the protection of foreign inventors, has already been discussed in an earlier chapter.

#### OFFICE PRACTICE.

As a result of these enactments the following system of office practice has sprung up:—The actual operation of searching is performed by the assistant examiners, and the result handed over to one of the examiners. The applicant or his agent then receives a letter in which the deficiencies of his specification are indicated. In the case of a complete specification he receives a further intimation of the result of the search on the novelty of the invention and a list of specifications which the examiner may consider to be wholly or in part anticipations. If the examiner considers that a complete anticipation has been found, the fact is communicated to the applicant and the search is temporarily stayed.

**The practice on an application.**

(b) *R. v. Townsend*, 1896, 13 R. P. C. 265.

(c) See *Cheavin v. Walker*, 1877, L. R. 5 Ch. D. 862.

The applicant has now a choice of courses:—He may consider that the specifications cited reduce the scope of his invention. In this case he will do wisely to amend the description of the nature of his invention and modify his claims. He has two months in which to do this, and on re-submitting the specification the examiner may make further objections. The question of time is very important. The two months in which the inventor may endeavour to satisfy the Office run from the date of the first official letter in which an objection is raised to the specification, and is not extended by fresh objections. A considerable amount of annoyance has been felt by agents who are accustomed to the practice of the United States, where the time may be extended indefinitely by correspondence; and it is well to be fully prepared on this point. In suitable cases, however, the Comptroller may extend the time. The reason for the limitation is to be found in sect. 9, sub-sect. 4, of the Act of 1883, which enacts that the application is to be deemed to be abandoned if the specification be not accepted within twelve months.

It is possible that the applicant may feel that the matter is of a nature too difficult to be conveniently dealt with by correspondence. He has now a further choice—he may refuse to amend the specification according to the suggestions of the examiner and may formally apply for a hearing before the Comptroller. The better course, however, is to apply for an interview with the examiner who has the case in hand. A time will be appointed, and in view of the amount of work with which the examiners have to deal it is advisable to be punctual. The interview is of an informal and conversational character, and the applicant presents his view of the case. This usually results in an agreement in which the applicant is content to amend his specification and claims and re-submit them. If, however, the matter should arrive at a deadlock, and the applicant is of opinion that the examiner is wrong, he had better apply for a formal hearing before the Comptroller.

At this hearing, which takes place privately before the Comptroller or the Chief Examiner, the examiner and the applicant are present. The applicant should open his case

quite briefly, and describe the nature of what he considers to be his invention, and leave the objections to the examiner. The applicant replies to the objections of the examiner, a discussion usually then takes place to endeavour to arrive at a conclusion, and finally the Comptroller gives his decision.

If the applicant should decide on obtaining this hearing he should make sure that all the objections put forward by the examiner and still remaining undecided receive the attention of the Comptroller. It is very irritating after a decision, apparently, that the specification is to be accepted subject to certain specified conditions, to find that the examiner still has some objections that may necessitate another hearing. This is certainly an infrequent occurrence, but the annoyance and the extra expense for skilled advice may be considerable. It may sometimes, however, happen that a further search and objections may be unavoidable. An applicant may claim as his invention the combination of A, B, C, and D, and it may turn out, as a result of the search, that these elements of his invention have been so combined before. In his specification, however, he may have described an improvement in the element D, and the Comptroller may decide to allow him so to amend the specification and claims as to claim this only. A search to investigate the novelty of this new claim will obviously have to be on different lines to that which took place on the earlier form of the specification.

#### RESTORATION.

By sect. 20 of the Act of 1907 a remedy is provided for the relief of inventors whose patents have lapsed from non-payment of fees where such non-payment has been due to circumstances concerning which no blame is attributable to the patentee. Formerly, if the agent of the patentee fraudulently misappropriated the moneys entrusted to him for payment of renewal fees, or if the renewal fees were left unpaid through accident or inadvertence, the unfortunate patentee had no remedy but to apply for a private Act of Parliament.

**Restoration  
of lapsed  
patents.**

The section is as follows :—

(1) “ *Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent.*”

(2) “ *Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.*”

(3) “ *If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.*”

(4) “ *Where such notice is given the Comptroller shall notify the applicant thereof.*”

(5) “ *After the expiration of the prescribed period the Comptroller shall hear the case and, subject to an appeal to the Court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.*”

A patentee will be obliged to show a clear case of hardship, and mere inadvertence will not be sufficient to justify restoration.

The following statement of fact is taken from the preamble to Vauclain’s Patent Act, 1906 (Loc. & Pers. 6 Edw. VII. c. v.), and sets forth the circumstances which Parliament considered to justify restoration :—

“ The application for the patent having been filed on June 3 1901 received the number 11,342 of 1901 although the patent itself is actually dated as of November 2 1900 under the provisions of the international convention Owing to the patent agent’s tax clerk being misled by the year endorsed on the outside of the letters patent as the year of the patent he entered it in the tax book as of the year 1901 and entered the

fourth year's tax as being due on November 2 1905 instead of November 2 1904. Consequently the first advice the Patentee received as to any fees being due was dated September 25 1905. When about to pay the tax the tax clerk for the first time noticed a divergence between the number and the supposed date of the patent and discovered that the fee should have been paid in 1904. Notwithstanding this accident mistake or inadvertence the amount of the tax was tendered in the prescribed form to the patent authorities before the date on which it was believed to have been due but was refused."

The requirement for advertisement of the application is for the purpose of enabling persons whose interests may be injured by the restoration to enter an opposition, when terms may be imposed for their protection. Advertisements.

The nature of the conditions which will be imposed may be inferred from those contained in sect. 2 of Vaucrain's Act (supra), which is as follows:— Conditions.

"No action or other proceeding shall be commenced or prosecuted nor any damage recovered—

- (1) "In respect of any infringement of the said letters patent which shall have taken place after the fifteenth day of February one thousand nine hundred and five (being the day on which the letters patent were announced as void in the official journal of the Patent Office) and before the passing of this Act:
- (2) "In respect of the use or employment at any time hereafter of any mechanism machine machinery process or any operation actually made or carried on within the United Kingdom and the Isle of Man or of the use or sale of any article manufactured or made in infringement of the said letters patent after the said fifteenth day of February one thousand nine hundred and five and before the passing of this Act. Provided that such use sale or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made or such mechanism machine machinery process or operation was bonâ fide made or carried on his or their executors

administrators successors or vendees or his or their assigns respectively :

(3) “ In respect of the use or employment or sale at any time hereafter by the person or corporation entitled for the time being under the preceding sub-section to use or employ any machine machinery mechanism process or operation or any improved extended or developed machine machinery mechanism process or operation or of the use or sale of any article thereby manufactured or made in infringement of the said letters patent Provided that the use or employment of such improved extended or developed machine machinery mechanism process or operation shall be limited to the buildings works or premises of the person or corporation by or for whom such machine machinery or mechanism was manufactured or such process or operation was made or carried on within the meaning of the preceding sub-section his or their executors administrators successors or assigns.

“ If any person shall within one year after the passing of this Act make an application to the Board of Trade for compensation in respect of money time or labour expended by the applicant upon the subject-matter of the said letters patent on a bonâ fide belief that such letters patent had become and continued to be void it shall be lawful for the said Board after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted and to specify the party by whom and the day on which such compensation shall be paid and if default shall be made in payment of the sum awarded then the said letters patent shall by virtue of this Act become void but the sum awarded shall not in that case be recoverable as a debt or damages.”

**Practice.**

The practice is regulated by rules 55—59 of the Patents Rules, 1908, and on appeal to the judge (whose decision is final under sect. 92, sub-sect. 2) by rules 4, 5, and 6 of Order LIII.A, and needs no particular comment.

## CHAPTER VIII.

## OPPOSITION TO THE GRANT.

It is provided by sect. 9 of the Act of 1907 (sect. 10 of the Act of 1883) that the acceptance of the complete specification shall be advertised, and that the application and specifications shall be open to public inspection. Sect. 11 is as follows:—

(1) “ *Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—*

(a) “ *that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or* **First ground.**

(b) “ *that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or* **Second ground.**

(c) “ *that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or* **Third ground.**

(d) “ *that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,* **Fourth ground.**

*but on no other ground.*

(2) “ *Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.*

(3) “ *The decision of the Comptroller shall be subject to appeal*

to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine."

**The Opponent.** **The Opponent.**—The wording of sub-sect. 3 limits the interpretation which might otherwise be placed upon the words "any person."

R.P.C.  
XL NO. 9.  
XLII R.P.C. 509. *See also*

Locus standi  
on first and  
fourth  
grounds.

Locus standi  
on second  
ground.

In order to oppose on the first or fourth grounds it is clear that the opponent must be a person who is interested in the invention. But at one time there was considerable doubt as to whether anyone could oppose on the ground that the invention had been previously patented, whether he were interested or not in such prior patent. In a very important case under the Act of 1883 (*The Queen v. The Comptroller-General of Patents*, 1899, 16 R. P. C. 233), an opposition had been entered to the grant of a patent on the second ground, but the opponent had no interest in the prior patent. The Comptroller applied to the law officer for directions under sect. 95 of the Act of 1883. Sir R. Webster, A.-G., construed the section to mean that the opponent must have an interest in such prior patent. The would-be opponent applied for a mandamus directed to the Comptroller. The Court of Appeal decided that no Court had any power to review a decision of the law officer under the Act, but agreed with his construction, which applies also to oppositions to applications to amend under sect. 21 (see p. 181). But, as a general rule, if there has been a bona fide attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof that he may be damnified or affected by the application which he desires to oppose, he is entitled to be heard (a). Each case will depend on its merits.

In *Heath and Frost's Patent* (1886, Griff. P. C. at p. 290),

(a) *Meyer's Application*, 1899, 16 R. P. C. 526. See, however, *MacEvoy's Patent*, 1888, 5 R. P. C. 285 (probably considered overruled).



Sir E. Clarke said: "It appears to me that by sect. 11 it is quite clear that the only class of persons who are entitled to be heard in opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it." In that case the opponent was an agent for the patentee, and although it had been common in opposition cases, for the sake of simplicity, for patent agents acting on behalf of clients to oppose grants of patents in their own names, the law officer decided that the opponent had not such an interest as to be entitled to be heard, and furthermore refused to grant leave to amend the notice of opposition.

An opponent who has a *locus standi* on the first or fourth grounds may, therefore, be unable to oppose on the second ground (*b*).

But having established his right to be heard on the second ground, the opponent is entitled to rely on prior specifications other than that of the patent in which he has an interest (*c*).

The third ground of opposition was introduced by the Act of 1907 for the purpose of placing an obstacle in the way of persons who sought to anticipate future investigations, and was expressly designed for the benefit of chemical manufacturers. No decisions have yet been published upon the question of who is entitled to oppose on this ground. But if the purpose of the enactment is considered it is clear that any bona fide rival trader would have a *locus standi*.

**Locus standi on the third ground.**

In a case where an opposition had been entered, and it was shown that the opposition was collusive and had been entered for the purpose of obtaining an extension of time for sealing, the law officer refused to allow a patent to be sealed (*d*). In *Kempton and Mollan's Application* (1905, 22 R. P. C. 573) the opposition was successful before the Comptroller, and a patent was refused. The applicant appealed, and prior to the hearing

**Result of collusive opposition.**

**Public nature of Comptroller's functions.**

(*b*) *Stewart's Application*, 1896, 19 R. P. C. 555.  
13 R. P. C. 627.

(*a*) *A. B.'s Application*, 1902, 19

(*c*) *J. and J.'s Application*, 1902, R. P. C. 403, 556.

before the law officer, came to an arrangement with the opponent to the effect that the opposition should be withdrawn. Sir E. Carson decided that the appeal could not be allowed by consent, since the Comptroller in refusing the seal was acting in a public capacity, and that the case must be decided on its merits alone, and he refused to allow the patent to be sealed.

The grounds of opposition before 1883.

**The Grounds of Opposition.**—Prior to the passing of the Act of 1883 any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda*, Hindmarch, p. 534), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent*, 1856, 6 De G. M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473); but it was always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent*, 14 W. R. 551, and also *In re Vincent's Patent*, 1867, L. R. 2 Ch. 341). If there was any doubt it was considered that the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial.

Under the Act of 1883.

The Act of 1883, however, reduced the grounds of opposition to three in number, corresponding to the first, the second (with a slight difference hereinafter to be mentioned), and the fourth grounds provided by the Act of 1907.

Under the Act of 1907.

By the Act of 1907 the present third ground was introduced, and a modification of the second ground was effected.

The grounds of opposition will now be considered *seriatim*.

The first ground.

The first ground of opposition as defined by the Act is that the applicant has obtained the invention from the opposing party, or from one of whom he is the legal representative. This question involves the credibility of witnesses. Before the Act of 1907 the Comptroller had no power to examine witnesses, although he might request the voluntary attendance for explanation of anyone who had made a declaration; and if a conflict was shown in the declarations, the usual practice was that the Comptroller formally decided that the patent should be sealed, and the opponent appealed to the law officer, who was able to take evidence on oath. By sect. 77 the Comptroller is now

empowered to take evidence upon oath, in addition to receiving statutory declarations in any case in which he thinks it right to do so. The practice will be further dealt with at p. 167.

But the law officer would not and will not decide a case of this kind against the applicant unless there is very little doubt on the facts, since the opponent always has an opportunity of having the question tried in open court on a petition to revoke the patent under sect. 25, sub-sect. 3. Patent stopped in clear cases only.

In *Edmund's Patent* (1886, Griff. P. C. 283), Sir R. Webster, A.-G., said: "I am clearly of opinion that, under the circumstances, the Comptroller-General was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas, if the patent is sealed, the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings."

In *Stuart's Application* (1892, 9 R. P. C. 452), Sir E. Clarke, S.-G., said: "I think that the law officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence."

In the case of an opposition upon the first ground, it frequently happens that the law officer is of opinion that both the applicant and the opponent contributed materially to the invention. In such case terms will be imposed giving both parties an interest in the patent (e).

The words "obtained the invention" do not necessarily imply that the person from whom the invention had been obtained

(e) *Russell's Patent*, 1857, 2 De G. M. & J. 130; *Good*, P. C. 589; *Luke's Patent*, 1886, Griff. P. C. 294; *Hatfield's Patent*, 1884, Griff. P. C. 288; *Eadie's Patent*, 1885, Griff. P. C. 279; *Evans and Olway's Patent*, 1884, Griff. P. C. 279; *Garthwaite's Patent*, 1886, Griff. P. C. 284.

had taken out or even intended to take out a patent for it; it refers to the identity of the invention, not the right of the person from whom it was obtained to be regarded as the first and true inventor (*f*).

Where it appeared that a part of the subject of the application had been obtained from the opponent, the law officer struck out that portion and allowed the remainder to go on (*g*).

Legal representative.

In *Edmunds' Patent* (1886, Griff. P. C. 281), the Comptroller was of opinion that the words "legal representative" meant the executor or administrator of a deceased person and would not include a person holding a power of attorney (*h*).

No inquiry into fraud abroad.

In the case of inventions communicated from abroad neither the Comptroller nor the law officer will inquire into what happened outside the United Kingdom, the importer is the true and first inventor, and the means by which he may have obtained the invention are of no importance and will not be considered, since the merit of the invention consists in its importation into this country (*i*).

The second ground.

The second ground of opposition has been extended in scope by the Act of 1907. The corresponding words of the Act of 1883 were, "on the ground that the invention has been patented in this country on an application of prior date."

Compared with Act of 1883

By the words of the Act of 1907 the opponent is entitled to rely upon specifications in respect of which patents have not been sealed at the date of opposition; but it is clear that such specifications must have been accepted. The requirement that the invention must have been claimed in the prior specification is for the purpose of continuity with the decisions under the Act of 1883, which ruled that the word "patented" meant that the invention must not only have been described, but must have been claimed, in the prior specification (*k*).

It will be remembered that under sect. 7, dealing with the

(*f*) *Thwaite's Application*, 1892, 9 R. P. C. 515. *Pearson Fire Alarm Co.*, 1907, 24 R. P. C. 680; *Edmunds' Patent*,

(*g*) *Thwaite's Application*, 1892, 9 R. P. C. 515. 1886, Griff. P. C. 281.

(*h*) See also *Adolph Spiel's Patent*, 1888, 5 R. P. C. 281. (*k*) *Von Buch's Patent*, Griff. L. O. C. 40; *Bartlett's Application*, 1892, 9 R. P. C. 514.

(*i*) *Application by McNeil and the*

search on novelty, the office may refuse a grant or insist upon a specific reference under certain circumstances. A patent may be refused when the invention has been wholly and specifically claimed in the specification of a prior patent, and a reference may be inserted when the subject-matter has been previously described. But on an opposition the Comptroller is concerned with prior claiming only, and there is no power to insist upon a specific reference in a case where the invention is only described in the prior specification.

Claims only, not description considered.

In the exercise of the discretion of the law officer, upon the report of the Comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, the fact that the validity of the first patent is in dispute (*l*), or that the opponent's patent has expired (*m*), will make no difference.

Invalidity of opponent's patent immaterial.

20 p. 10. 1912  
D

Therefore the invalidity of the opponent's patent on account of disconformity is immaterial (*n*). But where the opponent's complete specification was filed between the dates of the filing by the applicant of his provisional and complete specifications, and it had been expressly decided in a former case that the part relied on by the opponents was not within their provisional and could not therefore be claimed, it was held that the opposition could not succeed (*o*). But where the facts were the same so far as the dates of filing were concerned, but there had been no such decision, the applicants were not allowed to rely on disconformity between the opponent's provisional and complete specifications (*p*).

In *Stubbs' Patent* (Griff. P. C. 298), Sir R. Webster said: "As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course, I need not remind you that stopping a patent is a very serious step, because there are no means whatever of an applicant

Application only refused with reluctance.

(*l*) *Green's Patent*, 1885, Griff. P. C. 286; *Thorborough and Wilks' Application*, 1896, 13 R. P. C. 115.

(*n*) *Haythornthwaite's Application*, 1890, 7 R. P. C. 70.

(*m*) *Lancaster's Patent*, Griff. P. C. 293; *Stewart's Application*, 1896, 13 R. P. C. 627.

(*o*) *Bartlett's Application*, 1892, 9 R. P. C. 511.

(*p*) *Green's Application*, Griff. P. C. 286.

getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical (*q*). . . .”

This means that the comparison between the two specifications will be made with greater strictness against the earlier one than would be the case were the question one of infringement. But if the differences are immaterial the opposition will be successful (*r*).

In *Smith's Application* (1896, 13 R. P. C. 200), Sir R. Webster said: “It is only in cases in which the law officer is satisfied that there is no difference which can be regarded as amounting to invention that the later patent can be stopped. . . . I desire to say that it is quite incorrect to suppose that, in giving judgment in *Stubbs' Case*, I ever intended to suggest that the law officer ought not to consider mechanical equivalents as bearing upon the question of identity of invention. I entirely agree with the judgment of my then colleague, Sir E. Clarke, in *Haythornthwaite's Case*; and on many occasions when I had to deal with the matter previously, I did consider the question of mechanical equivalents as bearing upon the question of identity.”

The consideration of subject-matter.

And where it appeared that all the elements of the combination claimed by the applicant had been previously patented, and there was no invention in combining them, a patent was refused. (*Bridge's Application*, 1901, 18 R. P. C. 257.)

In *Hodgkins' Application* (1906, 23 R. P. C. 527), the alleged invention was a new process for making golf balls. The opponent proved that the greater part of the process had been the subject of a prior grant. The applicant offered to limit his claim to the additional part only, but having been allowed to file evidence relating to the additional part, he failed

(*q*) See also *Cumming's Application*, Griff. P. C. 277; *Todd's Application*, 1892, 9 R. P. C. 487; *Tattersall's Patent*, 1892, 9 R. P. C. 150; *Nahnsen's Application*, 1900, 17 R. P. C. 203.

(*r*) *E.g.*, as in *Aire and Walker's Application*, 1888, 5 R. P. C. 345; *Wallis and Ratcliff's Application*, 1888, 5 R. P. C. 347; *Daniel's Application*, 1888, 5 R. P. C. 414; *Haythornthwaite's Patent*, 1890, 7 R. P. C. 41; *Wylie and Morton's Application*, 1896, 13 R. P. C. 97.



\*. But see Kempfells; Lipton, Jones, Brown & Barber  
36 R.P.C. 21-27.

\*. Stoll's Patent 8 R.P.C. 236; Brockie 25 R.P.C. 813.

See Woolbridge & Fox Publ. xxvii R.P.C. 114



to convince the law officer that such additional part produced any material advantage in fact, and a patent was refused.

It is sometimes said that the law officer is not entitled to consider the question of subject-matter, but this is quite a mistaken view. If regard be had to the real meaning of the requirement, *i.e.*, that the invention must be of a manufacture, it will be seen that it is not only permissible for him to consider this aspect of the matter, but it is his duty. The above cases are instances of patents having been refused for want of subject-matter (see also *Johnson's Application*, 1902, 14 R. P. C. 56, and p. 89, ante). But it is true that the application will be viewed leniently, and the law officer will be loath to refuse a patent on the ground that the difference between it and the patented invention on which the opposition is based is small. And it is of course true that an opposition cannot be based on want of subject-matter.

Where it appears to the Comptroller-General or law officer that the applicant's specification is too general and calculated to deceive the public, or appears to overlap the invention of the opponent, the patent will only be granted on condition of the insertion of a **disclaiming clause**; such clause may be **general or special**, that is, either a general reference to common knowledge or a specific reference to the opponent's specification, with a disclaimer to the invention therein described. References enforced.

The effect of a general disclaimer is somewhat different from that of a special reference. The former is inserted for the purpose of preventing the later patentee from alleging that his invention is wider than that which he is entitled to claim, both in his own interests, in order that his specification may not be considered too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge. General disclaimer and special reference.

The specific reference, however, is intended as a warning to the public and to protect the prior patentee where there is practical identity of the inventions claimed, and will only be directed with reluctance. †

The difference between the two kinds of disclaimer was

pointed out by Sir Richard in *Newton's Application* (1900, 17 R. P. C. 123): "I have often laid down the rule as to the cases in which I think specific references are right, viz., where there is substantial identity between the fundamental parts of the two inventions, but a difference which can only be justified upon the ground of improvement and it being right to protect in that case both the public and the prior patentee by a specific reference to his invention. In order to make up one's mind whether or not a specific reference or a general disclaimer is required, you must to a certain extent endeavour to grasp what is the invention in each case. . . . I do not consider that a statement of public knowledge in the terms of the claim has by any means the same effect as a specific reference. It seems to me that it then becomes a statement of general knowledge. It allows no inference that the ambit of the invention is the same in the one as the other; on the contrary, it leaves the question of invention to be determined from the consideration of that which the earlier patentee and the later patentee have respectively described" (s).

When special  
reference  
given.

Therefore, in order to entitle a prior patentee to insist upon a reference to his patent in the specification of the applicant, he must show beyond reasonable doubt—

- (a) that the invention claimed by the applicant is covered by the claim in the prior specification, so that at the most it can only be considered as an improvement;
- (b) that the prior patentee has a special claim to consideration, exceeding that of other prior patentees, inasmuch as he was the first to disclose the principle upon which both inventions are based, in short that he has a *master patent*.

Sir R. Webster, in *Guest and Barrow's Patent* (1888, 5 R. P. C. at p. 315), said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned." In *Welch's Patent* (1891, 8 R. P. C. at p. 443), Sir R. Webster

(s) See also *Hamilton's Application*, 1902, 19 R. P. C. 33, and p. 142, ante.

where app is under Sec 11.16 app may not be  
defeated by app. showing prior use

Barnacklongh: case

XXXVII R.P.C. 105

See patent where no invention left

XXXVIII

XL I R.P.C. 626 Healdson

XL I R.P.C. 627 Philips

XL II R.P.C. 4 B.I.H.C.

said: "I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was, for the first time, discovered or disclosed in the opponent's specification."

In *Southwell and Head's Application* (1899, 16 R. P. C. 361), Sir R. Webster, A.-G., decided that, in the absence of an agreement by the parties as to the state of the art at the time of the opponent's invention, the opponent must produce evidence thereof to support his claim to have discovered a new governing principle, *i.e.*, to have a "master patent," in order to entitle him to a specific reference.

no.  
Evidence of  
Master  
Patent.

It would seem that the evidence required in such a case by the opponent would be a declaration of a search having been made at the Patent Office library through specifications of earlier date without discovering any anticipation.

Where, however, the applicant shows only a minimum of invention beyond what is described in the opponent's specification, the question of whether the latter is a "master patent" or not will not be considered in any narrow spirit, and a specific reference will probably be inserted, if the opponent's patent is of great importance (*Sachse's Application*, 1901, 18 R. P. C. 221).

It was for some time a moot point whether the applicant could refer to prior publications other than specifications to disprove the opponent's claim to a master patent; but in an unreported case Sir E. Carson, S.-G., decided that the applicant could refer to such prior publications, and this is now settled practice (see rule 47).

It frequently happens that the applicant's invention is shown to be anticipated to a great extent, and the question then arises as to whether he may be allowed to amend his specification and claims so as to cut away the invalid part. The extent to which this is allowable depends on the circumstances of the case (*t*), and is by no means permitted as a matter of course (*u*). The true principle to be applied is to be found in

Amendment  
of applicant's  
specification.

(*t*) *Harrild and Parkins' Application*, 1900, 17 R. P. C. 617.

(*u*) *Thomas and Prevost's Application*, 1899, 16 R. P. C. 69.

the question, "Does the amended specification indicate an invention substantially different from that at first described?" Where this is so, even though the specification before amendment contained the elements of what is now set forward as the invention to be protected, the patent will be refused (x), and the invention ultimately claimed must in any case have been within the provisional specification (y). In *Crist's Application* (1903, 20 R. P. C. 475), Sir E. Carson said: "Amendments must not be considered as a matter of course. They must be amendments in the real sense, and not the practical re-writing of the whole specification, and the formation of some new claim. The truth of the matter in this case is that Mr. Crist desired to obtain something by his specification which clearly was never his, and if by framing his specification in that way he has lost something which was mingled up with a claim very much wider than anything he could possibly hope to have claimed if he had taken the trouble to look into the previous specifications, it is not the fault of the department, but his own, that he did not originally frame his specification in the proper way" (z).

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 91 (corresponding to sect. 103 of the Act of 1883), and when an application is made for letters patent for the same invention by another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17, 1888, held, in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (Griff. L. O. C. 28), that although the opponent's patent would override the applicant's by reason of the antedating, nevertheless for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7, 1887 (Griff. L. O. C. 36), allowed *L'Oiseau and Pierrard's*

(x) *Thomas and Prevost's Application*, 1899, 16 R. P. C. 69; *Mills' Application*, 1901, 18 R. P. C. 322.

20 R. P. C. 366.

(z) *Garnett's Application*, 1903, 20 R. P. C. 475.

(y) *Lancaster's Application*, 1903,

patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent*.

The **third ground** was introduced by the Act of 1907, and the purpose of it is the same as that of sect. 12, sub-sect. 5, which requires samples to be filed in the case of an application for a patent for a chemical invention. At first sight it would seem bad policy to oppose an application on this ground, since the applicant may be afforded an opportunity of amending his specification and curing defects which, had the application been allowed to proceed, would have rendered the patent when granted hopelessly void. But in the case of chemical inventions it is extremely difficult to show that a description *would have been insufficient at the date when the application was made*, since the patentee may, at the time when the allegation is made, be able to point to practical success by that time attained. Hence it is desirable that the specification should be tested as soon as possible, and before the applicant has had time to steal the fruit of subsequent investigation. Perhaps on an opposition on this ground the samples filed at the office may be brought to light. There is no rule laid down as to this, but the practical advantage would be considerable. **Third ground.**

It is submitted that the applicant should *not* be allowed to amend his specification to any appreciable extent in the course of an opposition on this ground, otherwise its deterrent policy will to a considerable extent be thwarted. **Question of amendment on third ground.**

The **fourth ground of opposition** was introduced by sect. 4 of the Act of 1888, for the purpose of preventing an applicant from claiming in his complete specification an improvement on his invention, which was contained in the provisional of the opponent filed after the date of the applicant's provisional specification and thereby depriving the opponent of the benefit of his invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification. **Fourth ground.** (a).

The **Practice** in oppositions is regulated by rules 40—47 of **Practice.**

(a) *Edwards' Application*, 1894, 11 R. P. C. 461; *Millar's Application*, 1898, 15 R. P. C. 718.

the Patents Rules, 1908, and appeals to the law officer by the Law Officers' Rules. (See sect. 40 of the Act of 1907.) In these will be found all the rules relating to evidence and notices.

The notice of opposition must state the grounds upon which the opponent intends to oppose the grant, and must be signed by him. A copy of such notice is delivered by the Comptroller to the applicant. If the opponent does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice should say so (see p. 170). Either party must give notice to the other of any specification or other publications to which he intends to refer at the hearing.

Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification the opponent may file **statutory declarations** in support of his opposition, and must deliver to the applicant copies thereof. If he intends to rely on the first ground, he must file declarations. If he intends to rely on the third ground, he must state in writing the deficiencies of the specification. Within fourteen days from the delivery of such copies the applicant may leave statutory declarations in reply, copies of which must be sent to the opponent. The opponent may leave further declarations at the Patent Office, copies of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply. No further evidence may be left on either side except by leave of the Comptroller.

The parties, if they so wish, are entitled to a hearing, and when the period of two months from the date of advertisement has elapsed the Comptroller gives his decision. If the opponent dies before the day fixed for hearing the opposition, the notice of opposition may be amended by inserting the name of another opponent (*b*).

By sect. 77 of the Act of 1907 the Comptroller is empowered to receive *vivâ voce* evidence. The section is as follows:—

**Oral evidence.** (1) “*Subject to rules under this Act in any proceeding under*  
*(b) Lake's Application, Griff. L. O. C. 35.*”

*this Act before the Comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary ; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.*

(2) *“ In case any part of the evidence is taken vivâ voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.”*

This enactment is quite new, but effects a very necessary reform. The usual practice is for the parties to request the Comptroller to give notice to the witnesses on the other side to attend for cross-examination. They are asked at the hearing by way of examination-in-chief whether their statutory declarations are true, and are then cross-examined by the other side, and finally re-examined. There is nothing, however, to prevent witnesses being called who have not made declarations.

The attendance of witnesses may be enforced by *subpœna* under Order XXXVI., rule 49, of the Rules of the Supreme Court.

By sect. 40—

*“ The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act ; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.”*

By sect. 39 the Comptroller has also been given power to award costs :—

(1) *“ The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have*

*Revised*

*see Patents  
appeal  
1932 Act*

Costs before law officer.

Costs before Comptroller.



*power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.*

(2) *“If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.”*

It is submitted that an opponent who has successfully obtained the insertion of a specific reference, but has failed to stop the applicant's patent, should not be granted costs unless he has previously notified the applicant, under Rule 40, that a specific reference or amendment is all that he requires.

Under this section the usual practice is for the successful party to send to the Comptroller and to the unsuccessful party a bill of costs. The unsuccessful party may then send in objections in writing, and the Comptroller awards a round sum in most cases approximating to the amount which appears to have been reasonably incurred. At present there is no regular system of taxation. Before the law officer the amount awarded will be specifically named, and will not be a sum large enough to indemnify the successful party; “To do so would seriously discourage the appeals, and limit very much the usefulness which the law officers fill in these matters” (Sir E. Clarke, S.-G., in *Stuart's Application*, 1892, 9 R. P. C. 452). It has been the practice since the Act of 1907, however, to award larger sums.

Costs before  
law officer.

The power which the law officer has, under sect. 11, subsect. 3, of obtaining the assistance of an expert, is seldom made use of.

In all cases save those where fraud is alleged the applicant opens his case first.

Notice of appeal must be filed within fourteen days from the