# LAW AND PRACTICE

RELATING TO

# LETTERS PATENT FOR INVENTIONS

# TREATISE

ON THE

# LAW AND PRACTICE

RELATING TO

# Letters Patent for Inventions

WITH

## AN APPENDIX

OF

*STATUTES, INTERNATIONAL CONVENTION, RULES, FORMS AND PRECEDENTS, ORDERS, &c.*


BY

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TO

THE RIGHT HONOURABLE LORD ALVERSTONE,

LORD CHIEF JUSTICE OF ENGLAND,

*THIS WORK IS BY PERMISSION*

Dedicated

# PREFACE.

SINCE the last edition of this work was published two Patent Acts, viz., those of 1901 and 1902, have been added to the Statute Book; new Rules regulating matters of procedure at the Patent Office and before the Judicial Committee of the Privy Council have been made; and many important cases have been decided.

In response to suggestions from both Bench and Bar, I have divided the book into two volumes. I have endeavoured to so arrange the text that only one volume will be required during the hearing of a particular matter, whether in Court, the Judicial Committee of the Privy Council, Judge's Chambers, or at the Patent Office; and the Table of Cases and Index will be found in each separate volume. If desired, the Publishers will supply the two volumes bound in one.

Though the result of my labour falls far short of perfection, I venture to hope that those who consult the book will consider it satisfactorily brought up to date.

I have pleasure in thanking Mr. W. C. Fairweather for the great assistance he gave me in correcting the proof sheets as they came from the press.

5 NEW COURT,
LINCOLN'S INN, W.C.,
*October* 1906.

# PREFACE TO THE FIRST EDITION.

THIS book is my attempt to bring within a reasonable compass our law, as it at present exists, in reference to Letters Patent for Inventions. Any complete history of our legislation in the past upon the subject would have inconveniently added to the bulk of the volume; and, consequently, it has not been referred to, except where necessary to explain the present practice. For the same reason I have omitted all reference to the laws of foreign countries where legal protection to Inventors is afforded.

To the extent that the book approximates to the end I had in view, so must be the measure of its success or failure. Whatever its shortcomings, I hope it may be found of use.

ROBERT FROST.

8 KING'S BENCH WALK, TEMPLE,
*January* 1891.

# ABBREVIATIONS USED IN THIS WORK.

| | |
|---|---|
| A. & E. | Adolphus and Ellis' Reports. |
| B. & Ad. | Barnewall and Adolphus' Reports. |
| B. & Ald. | Barnewall and Alderson's Reports. |
| B. & C. | Barnewall and Cresswell's Reports. |
| Beav. | Beavan's Reports. |
| B. & S. | Best and Smith's Reports. |
| Bing. N. C. | Bingham's New Cases. |
| B. & P. N. R. | Bosanquet and Puller's New Reports. |
| Brod. & Bing. | Broderip and Bingham's Reports. |
| Bull. N. P. | Buller's Nisi Prius. |
| Camp. | Campbell's Reports. |
| C. B. | Common Bench Reports. |
| C. B. N. S. | Common Bench Reports, New Series. |
| Car. & K. | Carrington and Kirwan's Reports. |
| Car. & P. | Carrington and Payne's Reports. |
| Carp. P. C. | Carpmael's Patent Cases. |
| C. L. R. | Common Law Reports. |
| Cl. & F. | Clark and Finnelly's Reports. |
| Co. R. | Coke's Reports. |
| Coop. Ch. Ca. | Cooper's Chancery Cases. |
| Cr. M. & R. | Crompton, Meeson, and Roscoe's Reports. |
| D. & L. | Danson and Lloyd's Reports. |
| Dav. P. C. | Davies' Patent Cases. |
| De G. F. & J. | De Gex, Fisher, and Jones' Reports. |
| De G. & J. | De Gex and Jones' Reports. |
| De G. M. & G. | De Gex, Macnaghten, and Gordon's Reports. |
| De G. J. & S. | De Gex, Jones, and Smith's Reports. |
| Dowl. & Ry. | Dowling and Ryland's Reports. |
| Dr. & S. | Drewry and Smale's Reports. |
| E. & B. | Ellis and Blackburn's Reports, |
| E. B. & E. | Ellis, Blackburn, and Ellis' Reports. |
| E. & E. | Ellis and Ellis' Reports. |
| Eng. | The Engineer (a weekly publication). |
| Eq. Rep. | Equity Reports. |
| Exch. | Exchequer Reports. |
| F. & F. | Foster and Finlason's Reports. |
| Giff. | Giffard's Reports. |
| Griff. L. O. C. | Griffin's Patent Cases decided by the Comptroller-General and Law Officers in 1887. |
| Griff. P. C. | Griffin's Patent Cases. |
| G. P. C. | Goodeve's Patent Cases. |
| G. P. P. | Goodeve's Patent Practice. |
| H. Bl. | H. Blackstone's Reports. |
| H. & M. | Hemming and Miller's Reports. |
| H. L. C. | House of Lords Cases. |
| Holt N. P. | Holt's Nisi Prius Cases. |
| H. & N. | Hurlstone and Norman's Exchequer Reports. |
| Ir. Ch. Rep. | Irish Chancery Reports. |
| Iron | Iron (a weekly publication). |

| | |
|---|---|
| Johns. | Johnson's Reports. |
| J. & H. | Johnson and Hemming's Reports. |
| Jur. N. S. | Jurist, New Series. |
| Jur. O. S. | Jurist, Old Series. |
| K. & J. | Kay and Johnson's Reports. |
| L. J. N. S. Ch. | Law Journal Reports, New Series, Chancery. |
| L. J. N. S. C. P. | ,, ,, ,, Common Pleas. |
| L. J. N. S. Ex. | ,, ,, ,, Exchequer. |
| L. J. N. S. Q. B. | ,, ,, ,, Queen's Bench. |
| L. J. O. S. | Law Journal Reports, Old Series. |
| L. O. C. | Griffin's Patent Cases decided by the Comptroller-General and Law Officers in 1887. |
| L. R. App. Cas. | Law Reports, Appeal Cases. |
| L. R. Ch. | ,, Chancery Appeals. |
| L. R. Ch. D. | ,, Chancery Division. |
| L. R. C. P. | ,, Common Pleas Cases. |
| L. R. E. & I. App. | ,, English and Irish Appeal Cases. |
| L. R. Eq. | ,, Equity Cases. |
| L. R. Ex. | ,, Exchequer Cases. |
| L. R. H. L. | ,, House of Lords. |
| L. R. P. C. | ,, Privy Council Cases. |
| L. R. Q. B. D. | ,, Queen's Bench Division. |
| L. T. | Law Times, Old Series. |
| L. T. N. S. | Law Times, New Series. |
| M. & G. | Manning and Granger's Reports. |
| M. & S. | Maule and Selwyn's Reports. |
| M. & W. | Meeson and Welsby's Reports. |
| Mac. & G. | Macnaghten and Gordon's Reports. |
| Macr. P. C. | Macrory's Patent Cases. |
| Marsh. | Marshall's Reports. |
| Mer. | Merivale's Reports. |
| Moo. P. C. N. S. | Moore's Reports of Cases in the Privy Council, New Series. |
| Moo. P. C. O. S. | Moore's Reports of Case in the Privy Council, Old Series. |
| Myl. & Cr. | Mylne and Craig's Reports. |
| N. R. | The New Reports. |
| Newt. L. J. C. S. | Newton's London Journal of Arts and Sciences, Conjointed Series. |
| Newt. L. J. N. S. | Newton's London Journal of Arts and Sciences, New Series. |
| Parl. Rep. | Parliamentary Reports. |
| Phill. | Phillips' Reports. |
| P. O. R. | Patent Office Reports of Patent Cases. |
| Q. B. | Queen's Bench Reports. |
| R. | The Reports. |
| R. P. C. | Patent Office Reports of Patent Cases. |
| R. S. C. | Rules of the Supreme Court. |
| Russ. | Russell's Reports. |
| Russ. & M. | Russell and Mylne's Reports. |
| Ry. & M. | Ryan and Moody's Reports. |
| Scott N. R. | Scott's New Reports. |
| Stark. R. | Starkie's Reports. |
| Taunt. | Taunton's Reports. |
| T. R. | Term Reports. |
| Times R. | Times Law Reports. |
| Tyr. | Tyrwhitt's Reports. |
| Ves. | Vesey's Reports. |
| W. N. | Weekly Notes. |
| W. P. C. | Webster's Patent Cases. |
| W. R. | The Weekly Reporter. |
| Y. & C. | Younge and Collyer's Reports. |

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Wolstenholms, Jackson *v.*
Wood, Lister *v.*
Wood, Siddell and Hilton, Ld. *v.*
Wood, Trotman *v.*
Woodhouse, Edison and Swan Co. *v.*
Woodley, David *v.*
Worthing Skating Rink Co., Thorn *v.*
Wren, Bercham *v.*
Wright, Bossmans *v.*
Wright, Hassall *v.*
Wright and Butler, Ld., Tilghman's Patent Sand Blast Co. *v.*
Wrightson, Richmond & Co., Ld. *v.*
Wrigley, Bainbridge *v.*
Wyatt, Johnson *v.*

YATES, Mathias *v.*
Yeatley Vacuum Hammer Co., Pilkington *v.*
York Street Flax Spinning Co., Pirrie *v.*
Young, Adair *v.*
Young, Edison United Phonograph *v.*
Young, Fernie *v.*
Young, Morris *v.*
Young, Scott *v.*

ZIMMER, Wood *v.*

# ADDENDA.

## VOLUME I.

Page 40, note (*d*), *add* "Northern Press and Engineering Co., Ld. *v.* Hoe (R.) & Co., (1906) 23 R. P. C. 417."

,, 108, ,, (*r*), *add* "Hudson, Scott & Sons, Ld. *v.* Barringer, Wallis & Manners, Ld., (1906) 23 R. P. C. 502."

,, 125, ,, (*x*), *add* "23 R. P. C. 506."

,, 207, ,, (*f*), *add* "23 R. P. C. 461."

,, 291, ,, (*i*), *add* "*Times*, July 24th, 1906."

,, 334, ,, (*l*), *add* "Crawthorp *v.* Mason, (1906) 23 R. P. C. 401."

,, 367, line 16, *add* "*Brown* v. *Hastie (John) & Co., Ld.*, (1906) 23 R. P. C. 361."

,, 376, note (*z*), *add* "23 R. P. C. 433."

,, 492, ,, (*b*), *add* "Davidson *v.* Sun Fan Co., Ld., (1906) 23 R. P. C. 493."

,, 513, line 24, *add* "*Dr. Joung* v. *United Motor Co.*, (1903) 20 R. P. C. 472."

,, 521, note (*b*), *add* "as to principles on which objections should be certified as reasonable and proper, *see* Clay *v.* Allcock & Co., Ld., (1906) 23 R. P. C. 381."

,, 529, ,, (*a*), *add* "Anti-Vibration Incandescent Lighting Co., Ld., *v.* Wholesale Incandescent Fittings Co., (1906) 23 R. P. C. 399."

,, 533, ,, (*x*), *add* "See also Osmond *v.* Mutual Cycle and Manufacturing Supply Co., Ld., [1899] 2 Q. B. 488."

## VOLUME II.

Page 83, note (*l*), *add* "Andrews' Patent, (1906) 23 R. P. C. 441; Waterhouse's Patent, (1906) 23 R. P. C. 470."

,, 179, ,, (*i*), *add* "Scott's Patent, (1906) 23 R. P. C. 478."

,, 182, ,, (*n*), *for* "L. R. 4 P. C., App. Cas. 88 *n.*," *read* "L. R. 5, App. Cas. 88 *n.*"

,, 182, ,, (*q*), *add* "Cross, Bevan and Beadle's Patent, (1906) 23 R. P. C. 485."

# LETTERS PATENT FOR INVENTIONS.

## CHAPTER I.

### THE PATENTEE.

#### Introductory.

Before the reign of James I., the Sovereigns of England laid claim to, and exercised, the right of granting monopolies of carrying on certain trades, or producing various articles within the realm, or importing them from other countries. Early monopolies.

These monopolies were given to the recipients in respect of services rendered by them, or as marks of royal favour.

The system of creating monopolies was made the means on various occasions of raising large sums of money for the expenditure of the government, and the support of the Crown, to the detriment of the public at large.

Under the Tudor Sovereigns monopolies were granted to such an extent, and became so monstrously oppressive, that, finally, in the twenty-first year of James I., Parliament passed the celebrated Statute of Monopolies, (*a*) which, *as a declaration of the Common Law on the subject* must be considered as the foundation of our modern patent laws. Statute of Monopolies.

The Statute of Monopolies is the earliest statute which relates to grants of the sole use and exercise of inventions, though several Acts had been previously passed for suppressing various illegal monopolies. (*b*)

There is no doubt, however, that the Crown, previous to the Statute of Monopolies, (*c*) did exercise the right, which it claimed at Common Law, of granting to inventors the sole use and exercise of their inventions. There are several reported

(*a*) 21 Jac. I. c. 3.

(*b*) See Mag. Ch. c. 30; 9 Edw. III. st. 1, c. 1; Stat. of Cloths (25 Edw. III. c. 2); Stat. 27 Edw. III. st. 2; 28 Edw. III. c. 13, s. 3; 31 Edw. III. c. 10; 2 Ric. II. st. 1, c. 1; 7 Hen. VII. c. 9; and 12 Hen. VII. c. 6.

(*c*) 21 Jac. I. c. 3.

Introductory.

cases dealing with grants of letters patent from the Crown to inventors before 1623, the date of the statute, (*d*) and the practice is referred to by the early text-writers. (*e*)

Statute of Monopolies.

The unrepealed portions of the Statute of Monopolies (*f*) recite and enact, shortly, as follows:—

Preamble.

The preamble recites:

"Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God one thousand six hundred and ten, publish in print to the whole realm and to all posterity, 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: And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet, nevertheless, upon *misinformations* and *untrue pretences of public good*, many such grants have been unduly obtained and unlawfully put in execution to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid: For avoiding whereof and preventing the like in time to come, may it please your excellent Majesty," &c.

First section.

The first section of the statute declares and enacts that:—

"All monopolies and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate, whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others; or to give licence or toleration to do, use or exercise anything against the tenor or purport of any law or statute; or to give or make any warrants for any such dispensation, licence, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or

(*d*) Darcy *v.* Allin, (1602) Noy R. 182; 1 W. P. C. 5; Hastings' Case, (1561) Noy R. 182; 1 W. P. C. 6; Clothworkers of Ipswich Case, (1615) Godb. 252; S. C. 1 Rol. R. 4; Mitchell *v.* Reynolds, (1713) 1 P. Wms. 181; 10 Mod. 130.

(*e*) Sheppard's Abridgment, part iii. tit. Prerog. p. 61; Hawkins, Pleas of the Crown, bk. i. c. 79, s. 20; Coke, 3 Inst. 184.

(*f*) See Vol. II. p. 197.

Introductory.

Statute of Monopolies.

sum of money, that is or shall be due by any statute before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them, *are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.*"

Second section.

The second section provides that all monopolies, and all such grants, letters patent, &c., ought to be, and shall be, tried by the common laws of the realm, and not otherwise.

Third section.

The third section provides that all persons shall be disabled and incapable to have or exercise any monopoly, or any such grant, letters patent, &c., as aforesaid.

Fourth section.

The fourth section provides that any person aggrieved by any monopoly, or any such commission, grant, letters patent, &c., shall have a remedy by action to recover treble damages and double costs, and imposes the penalties of præmunire upon persons delaying such actions except by authority of the Court.

The fifth and sixth sections refer to letters patent for inventions, and exclude them from the effect of the foregoing clauses, which effectually suppressed all illegal monopolies, and deprived the Crown of all claims to grant such monopolies in the future, and also of all power to prevent persons aggrieved from pursuing their legal remedies.

Fifth section.

The repealed fifth section referred to patents already granted, and declared that none of them should be of any force for a longer period than twenty-one years from the date of the grant.

Sixth section.

The terms of the sixth section, which deals with patents to be granted in future, are as follows:—

> "Provided also 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 patents and grants shall not use*, so as also they be not contrary to the law, or mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patents

Who may Apply.

or grants 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."

## Who may Apply for Letters Patent.

Any person may be an applicant,

From the above quoted sixth section it is clear that the grantee of letters patent for an invention must be the true and first inventor, and, if there are two or more grantees, the true and first inventor must be included in their number, otherwise the Crown, as the dispenser of the privilege, has no power to make the grant. (*g*)

It is expressly provided by the Patents Designs and Trade Marks Act 1883, and subsequent enactments, that any person, whether a British subject or not, may make an application for letters patent for an invention, (*h*) and that two or more persons may make a joint application, and a patent may be granted to them jointly. (*i*) Moreover, a patent granted to several persons, jointly, is not invalid because some or one of them only are or is the true and first inventors or inventor, (*k*) and, consequently, a capitalist may advance money to a needy inventor and obtain an interest in the patent from the beginning.

if he can make the necessary declaration.

Every application must contain a declaration to the effect that either the applicant is in possession of an invention, whereof he claims to be the true and first inventor, or, in the case of a joint application, one or more of the applicants claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent. (*l*)

Previous to the direct enactment above referred to it had long been the practice for the Crown to grant letters patent for inventions to foreigners who were, in law, the true and first inventors thereof within this realm: (*m*) and in one case the question was raised whether a patent granted to a person in trust for an alien enemy would be valid, but the Court did not determine the point, as the patent was found defective on other grounds. (*n*)

(*g*) Marshall's Application, (1888) 5 R. P. C. 961.
(*h*) 46 & 47 Vict. c. 57, s. 4 (1).
(*i*) 46 & 47 Vict. c. 57, s. 4 (2).
(*k*) 48 & 49 Vict. c. 63, s. 5.
(*l*) 46 & 47 Vict. c. 57, s. 4 (2). See Vol. II. p. 5.
(*m*) Chappell *v.* Purday, (1845) 14 M. & W. 318; *In re* Wirth's Patent, (1879) L. R. 12 Ch. D. 303; Beard *v.* Egerton, (1846) 3 C. B. 97.
(*n*) Bloxam *v.* Elsee, (1827) 1 C. & P. 558; 6 B. & C. 169; see p. 20 *post*.

Who may Apply.

A married woman may be a patentee, and the property in the invention will be her separate estate. (*o*)

Married woman.

Infant.

It might be doubted whether the grant of letters patent to an infant inventor alone would be valid, as there does not appear to be any case which judicially decides the point; but it would seem that in the case of a grant to two persons, one of whom is an infant, the infancy of such joint grantee does not affect its validity. (*p*)

Lunatic.

A patent may be granted to a person found lunatic; but, in such case, the declaration, which must accompany the application, must be made by the guardian or committee of the lunatic, or a person appointed by the Court or a Judge. (*q*).

The Comptroller of the Patent Office does not inquire as to the age, coverture, or sanity of an applicant.

Legal representative.

The legal representative of a person dying possessed of an invention in respect of which no application for a patent has been made, may apply for, and obtain, a patent in respect of it, if such application be made within six months after the decease of such person, and contains a declaration by the legal representative that he believes such person to be the true and first inventor. (*r*)

The application in such a case must be accompanied by the original probate or letters of administration or an official copy of such probate or letters, and such further evidence as may be necessary. (*s*)

The legal representative of a person dying possessed of an invention in respect of which he has made an application for a patent within fifteen months prior to his decease, may obtain a grant of a patent in respect of the invention within twelve months of the decease of the person so dying.

It is the practice for the legal representative of a person so dying, after having made an application for a patent, to produce the probate of the will, or letters of administration granted of the estate and effects of the deceased, for the inspection of the Comptroller, and subsequently to carry out the later stages of the application in his own name.

## True and First Inventor.

Patent invalid unless true and first inventor is a grantee.

Letters patent for an invention can, except under sec. 34, 103 or 104 of the Act of 1883, be validly granted only to

(*o*) M. W. P. Act (45 & 46 Vict. c. 75).
(*p*) Cheavin *v.* Walker, (1877) L. R. 5 Ch. D. 858; 46 & 47 Vict. c. 57, s. 4 (2); 48 & 49 Vict. c. 63.
(*q*) Vol. II. p. 5.
(*r*) 46 & 47 Vict. c. 57, s. 54.
(*s*) See Patent Rules, (1903) r. 6.

True and First Inventor.

the true and first inventor either alone or together with another person or persons. (*t*)

Except where pursuant to sec. 103 or 104 of the Act of 1883, a patent obtained by one person alone who was not the true and first inventor or his legal representative would be void, for the Crown would have been deceived in its grant. (*u*)

It therefore becomes a very important question to decide what, in the patent law, is the meaning of the words "true and first inventor."

Except in the case of an invention communicated from abroad (*x*) a person will not be considered the true and first inventor if he himself did not make the invention, or if the idea of it did not originate in his own mind, (*y*), or if it was suggested to him by another, (*z*) or taken from a book or other document circulated in Great Britain, (*a*) or if the invention had been previously used by the public. (*b*)

It is not an objection to a patent that the discovery was the result of accident; and it is immaterial whether it be the outcome of some happy thought, or great study, labour, and expense. (*c*)

The true and first inventor must have invented every part of that for which he claims protection. (*d*) If he claims a number of things, as being the inventor of them, whether they consist of improvement or original inventions, and it turns out that some of them are not his own ideas, his patent is void. (*e*)

Inventor who first discloses the invention.

The person who himself actually makes an invention and is the first to disclose that invention will be the true and first inventor in the legal sense of the term, and a valid patent may be granted to him notwithstanding the fact that it may possibly be shown that the invention had been previously made by another who did not disclose it. (*f*) Thus,

(*t*) In the Matter of Marshall's Application, (1888) 5 P. O. R. 661; 46 & 47 Vict. c. 57, s. 5.

(*u*) Com. Dig. Grant, c. 8 and 9; Earl of Devon's Case, 11 Co. 90; R. *v.* Mussary, 1 W. P. C. 41; Minter *v.* Wells, (1834) 1 W. P. C. 129.

(*x*) pp. 16–19 *post*.

(*y*) Jones *v.* Pearce, (1832) 1 W. P. C. 124.

(*z*) Tennant's Case, (1798) 1 W. P. C. 125.

(*a*) Arkwright's Case, (1785) Dav. P. C. 61; Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Mo. 424, S. C.; The Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Lang *v.* Gisborne, (1862) 31 Beav. 133; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412; chap. iii.

(*b*) Chap. iii.

(*c*) Crane *v.* Price, (1842) 1 W. P. C. 411.

(*d*) Tennant's Case, (1798) 1 W. P. C. 125; Arkwright's Case, (1785) Dav. P. C. 61.

(*e*) Losh *v.* Hague, (1838) 1 W. P. C. 203.

(*f*) Chap. iii.

*Tindal*, C.J., in *Cornish* v. *Keene*, (*g*) stated the law as follows:— True and First Inventor.

"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 that is 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 was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or 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 become an important question whether he was the first and original inventor. . . . A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiment, and, therefore, that he was not the first discoverer of it—because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and to enjoy its benefits." (*h*) Law as to first discloser. stated by Tindal, C.J.

And again in *Gibson* v. *Brand* (*i*):

"A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the art 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."

(*g*) (1835) 1 W. P. C. 501, 507.
(*h*) But see Vol. II. chap. i.
(*i*) (1841) 1 W. P. C. 627, 628.

True and First Inventor.

The proof of publication must be very clear indeed in order to invalidate a patent granted to a person for a process producing a useful article at an economical rate when that person was, *de facto*, the first to produce the thing to the public practically in a working state. (*k*)

Dollond's Case.

In *Dollond's Case*, one of the earliest on the subject of true and first inventor, which is not reported, but is often referred to (*l*) in subsequent decisions, and always with approval, it was objected that *Dollond* was not the inventor of a new method of making object-glasses, but that a Dr. *Hall* had made the same discovery before him. It was, however, held that as Dr. *Hall* had confined it to his closet, and the public were not acquainted with it, *Dollond* was to be considered as the inventor.

Tennant's Case.

In *Tennant's Case* (*m*) the patent was declared void on the ground that though the utility of the invention and the general ignorance of it of those engaged in the trade to which it referred were proved, yet the plaintiff was not the true and first inventor, as the process had been used by one engaged in the trade for five or six years previous to the date of the patent.

Result of above cases.

From the principles of these two cases it appears that in order to invalidate a patent on the ground that the patentee is not the true and first inventor, it is not enough to show that the alleged invention is only a disclosure of what was known to others before; but it must be shown that it was communicated to some extent, or that it was more or less made use of, so as to constitute discovery as applied to the subject with which the invention deals—*i.e.*, that the alleged prior user was not merely experimental and partial, but was a user of the completed invention. (*n*)

Several inventors.

If several persons about the same time discover the same thing, but keep it secret, and make no use of it, the party first making application for a patent becomes the true and first inventor, and is entitled to the benefit of a grant of letters patent; (*o*) provided that no application has been made by or on behalf of a person, who has within twelve months applied for protection in respect of the same invention in any State with the Government of which His Majesty

(*k*) Von Heyden v. Neustadt, (1880) 50 L. J. N. S. Ch. 126; L. R. 14 Ch. D. 230.

(*l*) Boulton v. Bull, (1795) 2 H. Bl. 463.

(*m*) (1798) Dav. P. C. 429; 1 W. P. C. 125.

(*n*) Hill v. Thompson, (1818) 1 W. P. C. 239.

(*o*) p. 116 *post*.

has made any arrangement for mutual protection of inventions. (*p*)

True and First Inventor.

If a man makes a discovery and is enabled to produce an effect from his own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his mind unless it has become public (*q*) or been put to practical use. (*r*).

There is no case in which a patentee has been deprived of the benefit of his invention because another also had invented it, unless he had also brought it into practical use or disclosed it. (*s*)

First person who produces a commercial success.

An inventor who succeeds in producing in abundance, suitable for economic and commercial purposes, that which was before only produced as a rarity and unsuited for either of the above purposes, will be considered the true and first inventor of the process, and entitled to a patent in respect of it.

Thus, in *Young* v. *Fernie* (*t*) the plaintiff's claim was for "obtaining paraffin oil, or an oil containing paraffin, and paraffin, from bituminous coals by treating them in the manner hereinbefore described." The defendant proved that paraffin was discovered in 1830, twenty years previous to the date of the plaintiff's patent, by Dr. *Reichenbach*, and was first obtained from beechwood tar. On the other hand the plaintiff had found out and stated in his specification that cannel coal, or other highly bituminous coal, was suitable for producing paraffin, but that the temperature should be much lower than that employed in the dry distillation of coal for gas-making, and should not rise above a low red-heat which was visible in the dark. An American book containing the following extract from a publication of *Reichenbach*, in 1854, was adduced in evidence, "So remained paraffin until this hour a beautiful item in the collection of chemical preparations, but it has never escaped from the rooms of the scientific man." *Stewart*, V.C., who tried the case, pointed out that this illustrated the important distinction between the discoveries of the merely scientific chemist and of the practical manufacturer who invents the means of producing in abundance, suitable for

(*p*) 46 & 47 Vict. c. 57, s. 103; 1 Edw. VII. c. 18, s. 1 (1), chap. vii.

(*q*) Per Bayley, J., Lewis *v.* Marling, (1829) 1 W. P. C. 496; also p. 116 *post*.

(*r*) See pp. 119–140 *post*.

(*s*) Lewis *v.* Marling, (1829) 1 W. P. C. 497; as to practical use see chap. iv.

(*t*) (1863) 33 L. J. Ch. 192; 35 L. J. Ch. 523.

True and First Inventor.

economic and commercial purposes, that which had previously existed as a beautiful item in the cabinets of men of science. It was established to the satisfaction of the Vice-Chancellor that the plaintiff *Young* was an inventor of the latter class, and that his patent was entitled to the protection of the law. *Young* had ascertained, by a course of laborious experiments, a particular class of material among many, and a particular process among many, which enabled him to create and introduce to the public a useful manufacture which amply supplied the market with that which, until the use of the materials, process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffin and paraffin oil. This brought it within the principle laid down by Lord *Westbury*, L.C., in *Hill* v. *Evans*, (*u*) and the Court held that the manufacture, with the materials and process indicated by the inventor, according to the sense in which the word "manufacture" is used in the Statute of Monopolies, was a new manufacture not in use at the date of the patent. (*v*)

Inventors with similar objects in view.

It is no objection to a person being the true and first inventor to show that a patent having a similar object had been previously obtained by another, or that an apparatus or process giving similar results had been previously used, if the means employed by the person seeking to obtain the protection of the law are substantially different to those comprised in the alleged anticipating patent or previous user. (*x*)

For example, in the year 1828 *W. E. Kneller* obtained a patent for "improvements in evaporating sugar." The patent related to a method of evaporating water from a solution of sugar by blowing air into the liquid. This was done according to the specification by an apparatus consisting of a large horizontal pipe, placed near the surface of the liquid, from which a number of small blowing tubes radiated downwards in different directions. Two things were described as essential to the invention. (1) That a stream of air should issue from each blowing tube at the same time. (2) That the ends should all be in the same horizontal plane, whereby the fluid would exert the same pressure at each orifice. At the trial of

(*u*) (1862) 31 L. J. Ch. 457.
(*v*) See judgment of Stuart, V.C., 33 L. J. Ch. 192; 35 L. J. Ch. 523.
(*x*) Walton *v.* Potter, (1841) 1 W. P. C. 590; see chap. ii.

an action (*y*) brought for the infringement of this patent, the defendant put in evidence the specification of a patent obtained in 1822 for a similar apparatus, consisting of a set of perforated pipes, coiled or otherwise, shaped and accommodated to the nature and form of the vessel. The pipes might be replaced by a shallow metallic vessel, in the nature of a colander. *Kneller's* patent was, however, declared valid, and Lord *Tenterden*, C.J., said, "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them. It is evident that the object of the two patents is the same. But the mode of effecting that object is different."

True and First Inventor.

A person may be the true and first inventor of an invention, which merely consists of the omission of one of several component parts of something previously known, if it requires the exercise of invention to make such omission. (*z*)

Omission of component parts.

Thus, *Minter* took out a patent for "an improvement in the construction, making, or manufacture of chairs," and claimed as his invention "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair." When the validity of the patent was contested, it appeared that one *Brown* had previously made chairs embodying the principle patented by this *Minter*, though *Brown's* chair was encumbered with additional machinery. The patent was declared void on the ground of the specification claiming too much. (*a*) But Lord *Denman* having asked the jury to suppose that *Brown's* chair would have been a chair with a self-adjusting leverage if the additional encumbering part had been taken away, said, "then the question is, whether the principle of self-adjustment was at all discovered or thought of at that time. Because, it seems to me, if that principle might have been deduced from the machinery of the chair that was made, but that it was so encumbered and connected with other machinery that nobody did make that discovery, or ever found out that they could have a chair with a self-adjusting leverage, by reason of that or any other defect in the chair actually made; I confess, it seems to me, that does not prevent this from being a new invention when the plaintiff says, I have discovered, throwing aside everything but this

(*y*) Hullett *v.* Hague, (1831) 9 L. J. O. S. K. B. 242; 2 B. & Ad. 370.
(*z*) See chap. ii. (*a*) See chap. v.

True and First Inventor.

self-adjusting leverage itself, that will produce an effect, which I think a very beneficial one." (*b*)

Previous failures.

A person who produces an invention which successfully does that which a previous or similar invention failed to do will be the true and first inventor, and entitled to a patent. (*c*)

If the result produced by a new method is either a new article, or a better article, or a cheaper article to the public than that produced before by an old method, such new method is an invention, or manufacture intended by the statute to be protected, and may become the subject of a patent, (*d*) and there does not appear to be any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines. (*e*)

Joint inventors.

A true and first inventor must have invented every part of that which he claims to have invented; (*f*) hence, if different parts of an invention are the outcome of the inventive faculty of different minds, it will be necessary that all the inventors join in applying for a patent to be granted to them jointly.

Inventors may employ assistants.

**Master and Servant.**—There is nothing in law to prevent an inventor from availing himself of the assistance of workmen or servants in the prosecution of his search after a new manufacture. Indeed, many processes cannot be conducted by the unaided exertions of a single individual, and in almost all cases actual experiments are a necessity in order to find out how a desired end may be best obtained. It would, therefore, be absurd to confine the rewards given to inventors to that small class of them only, who have entirely, and without any assistance whatever, brought their discoveries to perfection, and it is grave matter of doubt whether, strictly speaking, any such could be found. The law, therefore, considers workmen and servants merely as tools of the inventor, and instruments in his hands, carrying out the ideas which originate in the master mind; and a person who has invented

(*b*) Minter *v.* Mower, (1835) 1 W. P. C. 140; 4 L. J. Ex. 72; see also Saxby *v.* The Gloucester Waggon Co., (1881) L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577.

(*c*) Chap. ii.

(*d*) Judgment of Tindal, C.J., (1842) Crane *v.* Price, 4 M. & G. 580; 1 W. P. C. 393. See also W. P. C. 71 (note); p. 163 *post*.

(*e*) Murray *v.* Clayton, (1872) L. R. 7 Ch. 570; L. R. 15 Eq. 115.

(*f*) See p. 6 *ante*.

a main and leading idea remains the true and first inventor, and, as such is entitled to apply for a patent notwithstanding that he avails himself of the assistance and suggestions of workmen and servants in bringing his invention to a state of perfection. (*g*)

True and First Inventor.

This principle has been frequently acted upon by the Courts in cases of which the following are examples:— Cases.

In *Minter* v. *Wells*, (1834) 1 W. P. C. 132, *Alderson*, B., addressing the jury, said: "*Minter* and *Sutton* were together about the time the invention took place: which of the two suggested the invention, and which carried it into effect, is the question for you to decide. If *Sutton* suggested the principle to Mr. *Minter*, then he would be the inventor. If, on the other hand, Mr. *Minter* suggested the principle to *Sutton*, and *Sutton* was assisting him, then Mr. *Minter* would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. *Minter* uses for the purpose of enabling him to carry his original conception into effect. You will judge which is the more probable of the two. Mr. *Minter* makes out his *primâ facie* case; he is the person who takes out the patent, if *Sutton* has received a compensation, nothing would have been more simple and easy than that he should have taken out the patent, and still Mr. *Minter* might have the same benefit to-day; and there is no apparent reason why *Sutton* should not have taken out the patent which Mr. *Minter* has taken out, unless they were both desirous to ruin the invention: for suppose two persons are engaged on an invention of this description, they know perfectly well between themselves who is the real inventor of it, and who is the workman to carry into effect the conception, but they would destroy the value of it to both if they did not take it out in the name of the right person." (*h*)

In *Bloxam* v. *Elsee*, (1825) 1 C. & P. 558, an action in respect of two patents granted to *John Gamble*, it was objected that the improvements on the first invention, which formed the subject of the second patent, were the invention of one *Donkin*, an engineer. It was established that the improvements were the invention of *Donkin*, but it appeared that at the time he invented them he was employed by the patentee and one *Foudrinier*, his partner, as an engineer, for the purpose of bringing the machine to perfection, and was paid by them for so doing; and therefore he was acting as their servant for

(*g*) Minter *v.* Wells, (1834) 1 W. P. C. 132; Bloxam *v.* Elsee, (1832) 1 C. & P. 567; 1 W. P. C. 132; Allen *v.* Rawson, (1845) 1 C. B. 551; David *v.* Woodley, (1884) Griff. L. O. C. 26; Kurtz *v.* Spence, (1888) 5 P. O. R. 181; Healey's Application, Johnson's Pat. Man., 6 ed. 165; Macfarlane's Patent, *ibid.*

(*h*) See also Makepeace *v.* Jackson, 4 Taunt. 770.

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the purpose of suggesting improvements in the machine. The plaintiff, on the other hand, contended that the improvements were the patentee's inventions, and that *Donkin* was employed by him to carry his ideas into effect, and this view of the case seems to have prevailed with the Court.

*Allen* v. *Rawson*, (1845) 1 C. B. 551, is another case supporting the same principle. In this case it was sought to upset a patent for improvements in the manufacture of felted fabrics on the ground that parts of the invention were discovered by two workmen. *Erle*, *J.*, in directing the jury, put his idea of the law 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 agent or servant made the suggestion of the subordinate improvement of the primary and improved principle." A motion for a new trial on the ground that the Judge had misdirected the jury was refused, *Tindal*, C.J., (1 C. B. 574) saying: "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 those taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

In *the matter of Smith's Patent*, (1904) 22 R. P. C. 57, the above statement of the law by *Tindal*, C.J., in *Allen* v. *Rawson* was applied to the particular facts before the Court, and the patent was revoked on the ground that the patentee was not the true and first inventor.

The reward of workmen employed to make inventions or improvements upon existing inventions, whether patented or not, is often made the subject of special contract, which is, of course, enforceable in an action for specific performance. (*i*)

Master is not entitled to the

The mere relationship of master and servant gives no right

(*i*) See Pashley *v.* Linotype Co. (1903), 20 R. P. C. 633.

to the master in the invention of his servant. (*j*) If an employer takes out a patent for an invention discovered and worked out by a workman in his employ, and the patentee has no more connection with the invention than that he is the employer of the workman, the patent will be void, on the ground that the workman and not the patentee is the true and first inventor. Thus, in *Arkwright's Case* (*k*) it appeared that the patentee *Arkwright* had been told of a particular roller, part of the machinery, by one *Kay*, and, perceiving the value of the invention, he took *Kay* into his service for two years, and employed him in making models, and subsequently applied for and obtained a patent for the invention as his own. In the same way *Arkwright* adopted a crank invented by one *Hargreave*. At the trial *Arkwright* was declared not to be the true and first inventor. (*l*)

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invention of his servant,

When, however, a workman, who is employed by his master to make models, or to carry out experiments, in the course of his employment, makes improvements in details, the improvements so made are the property of the master, (*m*) and the workman cannot patent them. (*n*) There is in fact a confidential relationship between a master who experiments with a view to taking out a patent for an invention, the leading idea of which originated with him, and the workman he employs in aiding him to perform those experiments, and anything suggested by the workman during such confidential employment will not necessarily vitiate the subsequent patent of the master. (*o*) It is always, however, a question of evidence whether such confidential relationship actually existed between the employer and employed. (*p*) In general, whether the benefit of suggestions made by a person employed to carry out an invention belong to him or to his employer is a question depending on the merits of each case, but where the main principle and object are complete without the suggestions, which are merely matters calculated more easily to carry

but only to improvements in details made by him.

(*j*) Saxby *v.* Gloucester Waggon Co., (1883) Griff. L. O. C. 56.

(*k*) (1785) Rex *v.* Arkwright, Dav. P. C. 61; 1 W. P. C. 64; Barker *v.* Shaw, 1 W. P. C. 126 *n.*

(*l*) Rex *v.* Arkwright, (1785) Dav. P. C. 61; 1 W. P. C. 64.

(*m*) p. 12 *ante.*

(*n*) David *v.* Woodley, (1884) Griff. L. O. C. 26; Kurtz *v.* Spence, (1888) 5 R. P. C. 181; Healey's Application. Johns. Pat. Man. 6 ed.; Conniff's Application, *ibid.*; Macfarlane's Patent, *ibid.* 165.

(*o*) Saxby *v.* Gloucester Waggon Co, (1883) Griff. L. O. C. 57; Homan's Patent, (1889) 6 P. O. R. 104.

(*p*) Humpherson *v.* Syer, (1887) 4 R. P. C. 407, 413.

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into effect the conceptions of the inventor, they are considered as merely accessory. (*q*)

In the absence of special contract, the invention of a servant, even though made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, does not become the property of the employer so as to justify him in opposing the grant of a patent for the invention to the servant, who is the proper patentee, (*r*) and the patent when obtained is the exclusive property of the servant. (*s*) It may very well be that, under the circumstances of a particular case, it is inconsistent with the good faith which ought properly to be inferred or implied as an obligation arising from the contract of service that the servant should hold the patent otherwise than as trustee for his employer, and a declaration of the Court may be obtained to that effect. (*t*)

A patent may be invalidated on the ground of publication of the invention by one workman to another, for there is no necessary presumption of any confidential relationship between fellow-workmen such as will prevent this result ensuing. (*u*)

Inventions communicated from abroad.

**Communicators of Foreign Inventions.**—We next come to the subject of patents for inventions communicated from abroad which are new within this realm. Before the passing of the Patent Act, 1883, the law had long allowed grants of patents, in their own name, to persons who were in possession of inventions which they had received from others resident in foreign countries, but which inventions had never before been published within this realm.

It was stated in the celebrated *Clothworkers of Ipswich Case*, (*x*) which was prior to the Statute of Monopolies, "if a man hath brought in a new invention and a new trade within the kingdom in peril of his life and consumption of his estate, or stock, &c., or if a man hath made new discovery of anything, in such cases the King of his grace and favour in

(*q*) See Allen *v.* Rawson, p. 13 *ante*; Smith's Patent, (1904) 22 R. P. C. 58.

(*r*) Heald's Patent. (1891) 8 R. P. C. 430; Homan's Case, (1889) 6 R. P. C. 184; Siddell *v.* Vickers, (1888) 5 R. P. C. 93; Saxby *v.* Gloucester Waggon Co., (1880) Griff. L. O. C. 56. The above statement was approved by Farwell, J., in Marshall and Naylor's Patent (1900) 17 R. P. C. 555.

(*s*) Saxby *v.* Gloucester Waggon Co., Griff. L. O. C. 56.

(*t*) Worthington Pumping Engine Co. *v.* Moore, (1902) 20 R. P. C. 41; Richmond & Co., Ltd. *v.* Wrightson, (1904) 22 R. P. C. 25; Lamb *v.* Evans, L. R. [1893] 1 Ch. 218; Robb *v.* Green, L. R. [1895] 2 Q. B. 315.

(*u*) Saxby *v.* Gloucester Waggon Co., (1883) Griff. L. O. C. 56.

(*x*) (1615) Godb. 252; S. C. 1 Rol. R. 4.

recompense of his costs and travail may grant by charter unto him that he only shall use such trade or trafique for a certain time, because at the first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the King cannot make a new grant thereof." This practice was continued after the framing of the Statute of Monopolies of 21 James I., and has frequently been sanctioned by the judges in many cases, from *Edgebury* v. *Stephens*, (*y*) which decided that if the invention be new in England, a patent may be granted though the thing was practised beyond sea before; "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," down to cases such as *Carpenter* v. *Smith*, (*z*) *Nickels* v. *Ross*, (*a*) and *Plimpton* v. *Malcolmson*, (*b*) from which the proposition is established that the first actual importer of an invention into this country is *in law the true and first inventor*.

True and First Inventor.

First importer is the true and first inventor.

The Act of 1883 and subsequent legislation does not contain anything to prevent a person who has become acquainted with an invention abroad, though it was not actually made by him, coming over to this country and applying for a patent for it in his own name, and making the declaration (*c*) as to true and first inventor comprised in Form A, (*d*) in the schedule to the Patent Rules 1903, which is sufficiently wide to meet such a case. Before the Act of 1883 it was long the practice for a person applying for a patent in respect of a communication from abroad in his declaration (*e*) to state that he was the true and first inventor *within this realm*—though the words "within this realm" might have been omitted, without detraction, from the validity of the declaration; and in the form of declaration, given in the schedule to the repealed Act of 1852 they were in fact so omitted. It was objected by some that under the Act of 1883 a person cannot obtain a valid patent for an invention communicated from abroad, seeing that the Act requires him to declare himself the true and first inventor, which it was said he cannot be unless he himself actually made the discovery,

(*y*) (1691) Salkeld's Rep. 477; 1 W. P. C. 35; Dav. P. C. 36.
(*z*) (1841) 1 W. P. C. 530, 535.
(*a*) (1849) 8 C. B. 679.
(*b*) L. R. (1876) 3 Ch. D. 531.
(*c*) Vol. II. chap. i.
(*d*) See Appendix; see also Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 54.
(*e*) Vol. II. chap. i.

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and the case of *Milligan* v. *Marsh*, (*f*) decided in 1856, and *Renard* v. *Levenstein*, (*g*) decided in 1865, were relied on as supporting this view. On a reference to these cases it will be found that neither of them amounts to a decision on the point; they are at most dicta of *Wood*, V.C., and *Knight Bruce*, L.J.

The Act of 1883 defines "invention" to be "any manner of new manufacture as defined in 21 Jac. I. c. 3," and it is only reasonable to infer that "inventor" has the same meaning as it has been declared to have in the latter statute—*i.e.*, it includes the actual importer of a communicated invention. (*h*)

Communicators of foreign inventions.

Many patents have in fact been granted under the Act of 1883 to importers in respect of inventions communicated to them from abroad, and it has never been established that the grantees of such patents are not entitled to hold them for their own benefit in the absence of a fiduciary relationship between them and the actual foreign inventor. (*i*)

It must also be noticed that the clauses in the Act of 1883 relating to revocation of the grant of a patent do not exclude the case of a person without the knowledge or against the will of a foreigner endeavouring to forestall him in this country, even though the Comptroller and law officer on appeal have decided to allow the patent. (*k*)

Preference to foreign inventor who has made an application abroad.

In virtue of sec. 103 of the Act of 1883, and the International Convention of 1884, (*l*) a foreign inventor who has applied for a patent in any State or States to which the powers of sec. 103 of the Act of 1883 have been applied, has a right of priority to a British patent, if he applies for it during a period of twelve months from the date of his first foreign application, notwithstanding any intermediate publication of the invention in this country. (*m*)

Communications made in England.

The 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 true and first inventor within the meaning of 21 Jac. I. c. 3, so as to enable him to obtain letters patent for the invention in his own name alone. (*n*)

(*f*) (1856) 2 Jur. N. S. 1083.
(*g*) (1865) 10 L. T. N. S. 177.
(*h*) Marsden *v.* Saville Street Foundry and Engineering Company, (1878) L. R. 3 Ex. D. 203.
(*i*) See Nickels *v.* Ross, (1849) 8 C. B. 679; Steadman *v.* Marsh, (1856) 2 Jur. N. S. 391; Avery's Patent, (1887) L. R. 36 Ch. D. 307, 318, 324; See Vol. II. chap. i. *post.*
(*k*) See Edmunds' Patent, (1886) Griff. P. C. 281; Higgins' Patent, (1891) 9 R. P. C. 74.
(*l*) See Appendix.
(*m*) See Vol. II. p. 19 *post.*
(*n*) Marsden *v.* Saville Street Foundry and Engineering Company, (1878) L. R. 3 Ex. D. 203.

True and First Inventor.

There may well be circumstances under which an oral communication by an agent of a foreigner made in this country to a British subject might entitle such British subject to apply for a patent, and to sustain it on the ground that it was a *bonâ fide* communication from abroad; *e.g.* where a foreigner resident abroad sends over his clerk to communicate the invention orally to a British subject. (*o*) It would appear that a valid patent could not be granted in respect of a communication by an alien permanently domiciled in this country as being a communication from abroad.

Communications made abroad.

*Wirth's patent* (*p*) decided that letters patent may be granted to a foreigner resident abroad for an invention communicated to him by another foreigner resident abroad; but patents will not in future be granted to agents resident abroad in respect of communications to them by foreigners also resident abroad. (*q*)

Patentee need not be meritorious importer.

In *Beard* v. *Egerton*, (*r*) it was held that a person taking out a patent for a communication from abroad need not necessarily be the *meritorious* importer; he may be the mere clerk or agent of the foreign inventor.

The law recognises, however, only the person to whom the patent is granted. Thus it is no objection to the sufficiency of a specification that a foreign inventor was possessed of knowledge, which ought to have been indicated in the specification, when it appeared that the actual patentee, who was merely the agent of the foreign inventor, was not possessed of that information. (*s*) And again, it is not a sufficient answer to an objection that a specification is insufficient to say that it contains all the information which the foreign inventor communicated to his agent, the actual patentee. (*t*)

## Persons Incapable of being Patentees.

We have seen that any person, whether a British subject or not, may make an application for a patent, (*u*) but there are certain persons who, by virtue of their position, could not obtain a valid grant.

(*o*) See Pilkington *v.* Yeakley Vacuum Hammer Co., (1901) 18 R. P. C. 459. On the facts of this case the communication was held in fact to have been made from abroad: Jameson's Patent, (1902) 19 R. P. C. 246.

(*p*) (1879) L. R. 12 Ch. D. 303.

(*q*) Notice 21st April, 1884; P. O. J. 9th May, 1884.

(*r*) (1846) 3 C. B. 97; see also Chappell *v.* Purday, (1845) 14 M. & W. 310.

(*s*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531, 582.

(*t*) Wegmann *v.* Corcoran, (1878) L. R. 13 Ch. D. 65; 44 L. T. N. S. 357.

(*u*) p. 4 *ante*.

**Persons incapable of being Patentees.**

It seems that the King himself could not become a patentee, for he could not grant to himself.

The King.

Body corporate.

Rule 59 of the Patent Rules 1903, provides that a body corporate may be registered as a proprietor by its corporate name; but it is clear that such a body could not alone obtain a grant of a patent for an original invention, for it could not make the requisite declaration, (*x*) invention being the act of the mind, which could not proceed from such a body in its corporate capacity.

Letters patent may be granted to a body corporate, together with the true and first inventor, since "person," as defined by the Act of 1883, (*y*) includes a body corporate. (*z*) It is the practice of the Patent Office in the case of an invention communicated from abroad to grant the patent to a corporation alone, since such corporation, as the first introducer of the invention into this country, is in law the true and first inventor. (*a*) A foreign corporation is entitled to apply for a patent under the provisions of sec. 103 of the Act of 1883. (*b*)

Corporation sole.

A corporation sole, *as such*, cannot become a patentee of an original invention, for he must make the invention by his own mind in his individual capacity, and in that capacity only could he, therefore, become a patentee.

Official persons.

Official persons are in certain cases incapable of obtaining a patent for an invention connected with the subject-matter of their official position.

Thus, in *Patterson* v. *Gas Light and Coke Co.*, (*c*) the House of Lords held that *Patterson*, who had obtained a knowledge of the patented process in the discharge of the duties of his official position of gas referee, appointed by the Board of Trade, under the City of London Gas Act of 1868, was incapable of obtaining a valid patent, as such process was described in an official report of himself and his two colleagues, and thus was public property, notwithstanding that the report was kept back from the authorities to whom it was addressed till after the date of the patent.

Alien enemy.

It is doubtful whether a patent granted to an alien enemy would be valid. It has been doubted whether letters patent taken out on a secret trust, to be held for the benefit of the

(*x*) Vol. II. p. 5.
(*y*) Sec. 117.
(*z*) *Ibid.*
(*a*) In the matter of Carez's Application, (1889) 6 R. P. C. 552, p. 18.
(*b*) Carez's Patent, (1889) 6 R. P. C. 18; Société Anonyme du Générateur du Temple, (1896) 13 R. P. C. 56; see Vol. II. p. 19.
(*c*) (1875) L. R. 2 Ch. D. 812; L. R. 3 App. Cas. 239.

real inventor, who was an alien enemy, were void or not. To hold that such a trust could not exist would appear contrary to the spirit and policy of the patent law, in recognising communications from foreigners as good subject-matters for letters patent; but no action could be maintained by such alien, or by the trustee on his behalf, on any contract, because the resulting moneys might be employed against the country. (*d*)

Persons incapable of being Patentees.

(*d*) Webster on Patents, p. 23; also 1 W. P. C. 418 *n*.

# CHAPTER II.

## SUBJECT-MATTER.

### General.

Subject-matter defined by 21 Jac. I. c. 3, s. 6.

**Any Manner of Manufacture.**—The Statute of Monopolies, in a sense the statutory foundation of our modern patent laws, (*a*) defines, by its *sixth* section, the Common Law right of the Crown to grant letters patent for inventions as limited to the granting of patents for "the sole working or making of any manner of new manufactures within this realm to the true and first inventor or inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient."

Subsequent enactments have not in any way altered the provisions of the Statute of Monopolies as regards subject-matter of letters patent for inventions; and the Act of 1883 (*b*) expressly states that the word "invention" shall mean any manner of new manufacture the subject of letters patent and grants of privilege within section "six" of the Statute of James I.—*i.e.*, the above quoted words.

The effect of this sixth section of the celebrated statute is twofold: (i) it exempts all patents and grants of privilege which its terms embrace from the abolition of monopolies in general which the preceding sections of the Act effected, and (ii) it expressly declares that such patents and grants of privilege shall have the same effect as they would have had if the Act had never been passed and none other—*i.e.*, they are not rendered valid by virtue of the Act, but obtain their force from the Common Law.

The words "working and making of any manner of new manufacture," coupled with the fact that "manufacture" is capable of more than one meaning, suggest the question,

(*a*) Vol. II. p. 197. (*b*) Sec. 46.

What is it the working and making of which the enactment contemplates as forming the subject-matter of a patent?

Subject-matter must be an Art.

"Manufacture" used as a noun may mean either (i) the art or practice of making or constructing any piece of workmanship, or (ii) anything made by art. The words "working or making" used in conjunction with the word "manufactures," seem to imply both these meanings, and the decisions of various Courts warrant the statement that in the contemplation of the patent law the word bears both significations. (*c*)

"Manufacture."

It is to be noticed that the word "manufactures," construed with the word "working," signifies the art or processes of making, and the words "working of manufactures" refer to the exercise of arts of making or constructing; whereas the word "manufactures" construed with the word "making" signifies articles or things made, and the words "making of manufactures" therefore mean the art of making articles or things which, when made, may properly be nominated manufactures, and which must be articles of trade or commerce. (*d*)

The subject of a valid patent must, consequently, be the working or making of a manner of new manufacture (in one or other of its two meanings) which must be new, useful, and not contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient. It must be new and useful because if it were not so the consideration for which the Crown makes the grant would fail; and it must be not contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient, for the Crown has not the power to make such a grant.

Subject-matter must be a manufacture which is new, useful, and not contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient.

The commodities above referred to must clearly be commodities open to trade before the patent, and cannot include the commodity which is the subject of the new invention. The patentee in fixing the price at which he will sell the new article does not raise the price of the commodity, for the article was not to be obtained at all before he put it on the market. The idea prevalent at the date of the Statute of Monopolies was that some inventions might be of such a nature that if they were put in practice the manufacture

(*c*) Crane *v.* Price, (1842) 4 M. & G. 580; Household Co. *v.* Neilson, (1843) 1 W. P. C. 683; Hornblower *v.* Boulton, (1799) 8 T. R. 98; Dav. P. C. 225; R. *v.* Wheeler, (1819) 2 B. & Ald. 349; 1 Cary. P. C. 393; Stevens *v.* Keating, (1847) 2 W. P. C. 182.

(*d*) Boulton *v.* Bull, (1795) 2 H. Bl. 463; Hindmarch on Patents, pp. 80, 81. See also cases note (*k*) p. 25 *post*.

Subject-matter must be an Art.

would consume such a quantity of a known article of common use in trade as would, in consequence of a limited supply, raise its price to the hurt of other trades, and this is the evil which the limitation is intended to guard against. Protection of trade was a very prevalent notion when the Statute was passed. Whether or not the objection of general inconvenience would be maintained against any particular invention would depend upon the notions of public convenience and political economy prevalent at the time of decision. Thus in the case of a new invention referred to by Coke, (*e*) which related to a fulling mill by means of which more bonnets and caps might be thickened and fulled in a single day than by the labour of four-score men who got their living by the trade, this objection as to hurt of trade was held to prevail. The ground of the decision, as recorded by Coke, was that it was ordained that bonnets and caps should be thickened and fulled by the strength of man and not in a fulling mill, for it was holden inconvenient to turn so many labouring men to idleness. It is safe to predict that this objection to the patent for the fulling mill would not prevail to-day. There is no recorded case within modern times in which a patent has been declared void expressly on the ground of mischief to the State by raising the prices of commodities at home, or hurt of trade, or general inconvenience. The objection now takes the form of a plea that the invention is not new or useful. (*f*) The plea of want of utility is, therefore, in effect, a plea that the invention is, on the specific ground of lack of utility, tainted with the defect which renders the patent granted in respect of it void by reason of the proviso of section six of the Statute of Monopolies. It is open to a defendant in an action, or petitioner for revocation, to allege any other specific ground which is covered by the proviso in question. If the plea were raised in the general form, according to modern practice, the person raising it would be required to give particulars as a matter of course.

Subject-matter must be an art,

**Subject-Matter must be an Art.**—The subject-matter of letters patent for an invention must be an *art*. For, if any person other than the patentee makes any article or articles in accordance with the patentee's specification, he thereby commits an infringement of the patent, and yet the patent does not vest in the grantee the right to use the particular materials of which the articles made in infringement consist,

(*e*) 3 Inst. c. 85, p. 184.

(*f*) See p. 161 *post*.

Subject-matter must be an Art.

for they may never have been his property. What the infringer does besides using the materials, which he has a right to do, and the physical power, which he is also entitled to avail himself of, is to use the art of applying the physical power to the materials in the manner set forth in the specification. (*g*) It is this *art*, therefore, which is the exclusive property of the patentee, and which he, his agents or licensees, and no one else, is entitled to use during the continuance of the privilege. In the case of an article made in infringement of a patent the right of property remains in the infringer, (*h*) though he may be ordered to destroy such article, completely or partially, as may be necessary to render further infringement by its use impossible. (*i*)

by which vendible articles can be produced,

It has been said that only an art by the exercise of which vendible articles, or articles of trade or commerce, are capable of being produced can form the subject-matter of valid letters patent, (*k*) for two reasons:—(i) If the articles made by the exercise of the protected art cannot be sold, the invention will not be used, and therefore will not give any new employment to the people, and the public will receive no benefit from the invention. (ii) The intent of the patent is to reward the inventor by means of the profit arising from making and selling the patented articles during the continuance of the privilege. (*l*) Since the subject of the patent must be a manufacture, it must result in the production of a material entity. Consequently a patent could not be validly granted for a literary composition, or a mere scheme or plan—*e.g.*, a plan for becoming rich; a plan for the better government of a State; a plan for the efficient conduct of business. (*m*)

and which is not to be exercised for illegal purposes.

An art which is to be exercised for the sole object of breaking the law, or for the sole purpose of producing anything designed to be used for an illegal purpose—*e.g.*, implements for housebreaking, picking pockets, locks, &c.—cannot form the subject-matter of valid letters patent. A grant of letters patent for such an object would be void, both on the ground of want of utility, (*n*) and as being contrary to public policy. "It would be absurd if by one law patents might be granted

(*g*) Huddart *v.* Grimshaw, (1803) Dav. P. C. 278; 1 W. P. C. 86.

(*h*) Vavasseur *v.* Krupp, (1878) L. R. 9 Ch. D. 351; p. 508 *post*.

(*i*) See p. 508 *post*.

(*k*) Boulton *v.* Bull, (1795) 2 H. Bl. 493; R. *v.* Wheeler, 2 B. & Ald. 349; Cornish *v.* Keene, (1837) 3 Bing. N. C. 570; Cooper's Patent, (1901) 19 R. P. C. 53; Johnson's Patent, (1901) 19 R. P. C. 56.

(*l*) See Hindmarch on Patents, pp. 101, 102.

(*m*) See Cooper's Patent, (1901) 19 R. P. C. 54.

(*n*) Chap. iv. *post*.

Subject-matter defined by Courts and early Text-Writers.

to reward persons for providing the means of violating any other law. (*o*) It is, however, no objection to a patent that it was taken out for the purpose of evading a statute—*e.g.*, the Pharmacy Act. (*p*)

**Subject-Matter defined by the Courts and Early Text-Writers.**—The Court of King's Bench, in *Mitchell* v. *Reynolds* (*q*) stated what may be deemed capable of forming the subject-matter of a patent—viz.:

Definition by Court of King's Bench.

> "A grant of the sole use of *a new invented art* is good, being indulged for the encouragement of ingenuity; but this is tied up by the Statute of 21 James I. c. 3, s. 6, to the term of fourteen years; for after that time it is presumed to be a known *trade*, and to have spread itself among the people." After a statement of the reasons why monopolies are generally void at Common Law, the judgment of the Court continues: "But none of the cases of customs, by-laws to enforce these customs, and *patents for the sole use of a new invented art*, are within any of these reasons; for here no man is abridged of his liberty or disseised of his freehold; a custom is *lex loci*, and foreigners have no pretence of right in a particular society exempt from the laws of that society; *and as to new-invented arts nobody can be said to have a right to that which was not in being before*; and therefore it is but a reasonable reward to ingenuity and uncommon industry." (*r*)

Definition by Sir Edward Coke.

The Chapter of Monopolies in Sir *Edward Coke's* Third Institute of the Laws of England (*s*) contains the following commentary respecting the exception specified in the Statute of Monopolies as being fit subject-matter of letters patent:

> In reference to the proviso in section 5 the learned author writes: "The first is that this Act shall not extend to any letters patents, or grants of privilege heretofore made of the sole working, or making, of any manner of new manufacture, but that new manufacture must have seven properties.
>
> "*First*, it must be for twenty-one years or under.
>
> "*Secondly*, it must be granted to the first and true inventor.
>
> "*Thirdly*, it must be of such manufactures which any other at the making of such letters patent did not use, for albeit it were newly invented, yet if any other did use it at the making,

(*o*) See Hindmarch on Patents, p. 142.

(*p*) Vaisey's Patent, (1894) 11 R. P. C. 593.

(*q*) 1 P. Wms. 181; 10 Mod. 130 S. C.

(*r*) See also The Master, Wardens, and Society of Gunmakers v. Fell, Willes, R. 388.

(*s*) 3 Inst. c. 85, pp. 181, 184.

of the letters patents, or grants of privilege, it is declared and enacted to be void by this Act.

Subject-matter defined by Courts and early Text-Writers.

"*Fourthly*, the privilege must not be contrary to law: such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet is it not a new manufacture in law; and so was it resolved in the Exchequer Chamber, Pasch, 15 Eliz., in *Bricot's Case*, for a privilege concerning the preparing and melting, &c., of lead ore: for then it was said that that was to put but a new button to an old coat, and it is much easier to add than to invent. And then it was also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited.

"*Fifthly*, nor mischievous to the State, by raising of prices of commodities at home. In every such new manufacture that deserves a privilege there must be *urgens necessitas* and *evidens utilitas*.

"*Sixthly*, nor to the hurt of trade. This is very material and evident.

"*Seventhly*, nor generally inconvenient.

"There was a new invention found out heretofore that bonnets and caps might be thickened in a fulling mill, by which means more might be thickened and fulled in one day than by the labours of four-score men who got their living by it. It was ordained that bonnets and caps should be thickened and fulled by the strength of man and not in a fulling mill, for it was holden *inconvenient to turn so many labouring men to* idleness.

"If any of these seven qualities fail, the privilege is declared and enacted to be void by this Act, and yet this Act, if they have all these properties, set them in no better case than they were before this Act."

In reference to Section 6 of the Statute of Monopolies, Sir *Edward Coke* says:

"The *second* proviso concerneth the privilege of new manufacturers *hereafter* to be granted: and this also must have seven properties: first, it must be for the term of fourteen years, or under; the other six properties must be such as are aforesaid, and yet this Act maketh them no better than they should have been if this Act had never been made, but only excepts and exempts them out of the purview and penalty of the laws.

"The cause wherefore the privileges of new manufacturers, either before this Act granted, or which after this Act should be granted, having these seven properties, were not declared to be good was, for that the reason wherefore such a privilege is good

Subject-matter defined by Courts and early Text-Writers.

in law is, because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost and charges; and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like), for a convenient time, but it was thought that the times limited by this Act were too long for the private, before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years, in making or working of the new manufacture (which is the time limited by law of apprenticehood), must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended, and this was the true cause wherefore, both for the time past and for the time to come, they were left of such force as they were before the making of this Act."

Exhaustive definition is not possible.

It is impossible to give any definition which will enable the question to be at once answered whether a given example is capable of forming the subject-matter of a valid patent. Each instance must be considered on its own merits.

Common Law authorities.

The Common Law authorities, respecting what may be the subject of a valid patent, decided before the passing of 21 Jac. I. c. 3, are not very numerous, but they agree perfectly with the construction which the modern law has placed upon the words of the sixth section of that Act.

In the *Case of Monopolies* (Noy, 182) it was argued by counsel that the Crown may grant a patent of "*a new trade*" or "*any engine tending to the furtherance of a trade that never was used before.*"

In *The Clothworkers of Ipswich Case*, (1615) Godb. 252, 253, it was said that, "if a man hath brought in *a new invention and a new trade*, or *a new discovery of anything*," the Crown may grant to him that he only shall use such a trade.

*Edgebury* v. *Stephens*, (1691) 2 Salk. 447; 1 W. P. C. 35, held that the exception contained in the sixth section of the Statute of Monopolies intended to encourage *new devices* useful to the kingdom.

It is stated in Sheppard's Abridgment (Part iii., tit. Prerog., p. 61) that the King may grant a patent for a new *trade* or *device*, or any new *engine* tending to the furtherance of it.

And Serjeant *Hawkins* says (Hawk. P. Cr. part i. c. 79, s. 20) the King may grant the sole use of "*An Art* invented or first brought into the realm by the grantee."

**Discovery and Invention.**—The words of the exception clause of the statute of James I. appear so wide and extensive as to embrace almost the whole domain of the inventive faculty of the human mind, but there are, nevertheless, certain discoveries which may be most highly beneficial to mankind, and yet, for meritorious reasons, are not capable of forming the subject-matter of a valid patent. Moreover, if a part of what the patentee claims as being his invention is not proper subject-matter, it will vitiate the whole and render the grant entirely void so long as the specification remains unamended. (*t*)

Discovery and Invention.

Difference between discovery and invention.

Many instances of discoveries which are incapable of protection by letters patent, and the reasons why, will be found in the following pages.

Discovery and invention are clearly not the same thing. A discovery will not form the basis of a patentable invention unless the discoverer thereby adds something to the stock of public knowledge, and points to an act to be done, which, besides being new and useful is, on the facts of the particular case, the outcome of skilful ingenuity. (*u*)

In the language of *Buckley*, J. (*v*)—

> "Of course the difference between discovery and invention is very familiar. Discovery adds to the amount of human knowledge, but it does so only by lifting the veil and disclosing something which before had been unseen or dimly seen. Invention also adds to human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new result, or a new process, or a new combination for producing an old product or an old result." (*x*)

The following words of Lord *Lindley*, then *Lindley*, L.J., taken from his judgment in *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.* (*y*) are most instructive upon this point.

Per Lindley, L.J.

> "An invention is not the same thing as a discovery. When *Volta* [*sic. Galvani*] discovered the effect of an electric current from the battery on a frog's leg he made a great discovery, but

(*t*) Vol. II. p. 63.
(*u*) See p. 108 *post*.
(*v*) Reynolds *v.* Herbert Smith & Co., Ltd., (1902) 20 R. P. C. 261.
(*x*) See also Jandus Arc Lamp and Electric Co., Ltd. *v.* Arc Lamp Co., (1905) 22 R. P. C. 277, 296–7.
(*y*) (1892) 9 R. P. C. 416.

Discovery and Invention.

no patentable invention. Again, a man who discovered that a known machine can produce effects which no one knew could be produced by it before may make a great and useful discovery, but if he does no more his discovery is not a patentable invention. *Britain* v. *Hirsch*, (1888) 5 R. P. C. 226 (on p. 232); *Harwood* v. *Great Northern Railway Co.*, (1865) 11 H. L. C. 654; *Horton* v. *Nabon*, (1862) 12 C. B. N. S. 437; *Saxby* v. *Gloucester Waggon Co.*, (1880) L. R. 7 Q. B. D. 305. He has added nothing but knowledge to what previously existed. A patentee must do something more; he must make some addition, not only to knowledge, but to previously known inventions and must use his knowledge and ingenuity so as to produce either a new and useful thing or result, or a new method of producing an old thing or result. On the one hand, the discovery that a known thing—such for example as a *Planté* battery—can be used for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention, if there is novelty in the mode of using it as distinguished from novelty of purpose; or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of using 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 purpose of the present case. I have, of course, been guided by the previous decisions on the subject, and especially by *Harwood* v. *Great Northern Railway Co.*, (1865) 11 H. L. C. 654, which is the most instructive of them all. I have been induced to make these observations in order to apply them to the question whether the plaintiff's invention is anything more than a discovery that *Planté* cells can be usefully employed for incandescent lighting." (*z*)

**Invention.**—At common law the Crown has authority to grant letters patent for inventions to the true and first inventor only, *i.e.*, to the true and first inventor alone, or in conjunction with some other person or persons. This is the effect of the statements contained in the Statute of

(*z*) See also Welsbach Incandescent Gas Light Co., Ld. *v.* Daylight Incandescent Mantle Co., (1899) 17 R. P. C. 141, 148; Case *v.* Cressy, (1900) 17 R. P. C. 261, 263; Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1903) 20 R. P. C. 173; 22 R. P. C. 156; and compare Jandus Arc Lamp and Electric Co., Ld. *v.* Arc Lamp Co., (1905) 22 R. P. C. 296-7.

Monopolies, (*a*) and the provisions of sec. 4 of the Patents Act 1883. It is evident, therefore, that the grantee of the patent, or one of the grantees as the case may be, must be an inventor. That is to say he must, in arriving at the discovery, which is the subject-matter of the patent, have exercised that faculty of the mind which is called invention. Invention.

The question arises as to whether any particular quantum of invention, in this sense, is necessary to the support of a grant of letters patent. The result of the cases on the point is that, provided the subject-matter of the patent is a manufacture, within the meaning of the Statute of Monopolies, (*b*) which is new and useful, a mere *scintilla* of invention is sufficient. (*c*) In all cases the question to be decided is, does the specification describe and claim *an* invention. If an invention is disclosed, it is quite immaterial, from the point of view of the validity of the patent as regards subject-matter, whether the invention is a great one or a small one. The essential consideration is the pure question of fact in each instance whether, in view of the circumstances peculiar to each case and the state of public knowledge at the date of the application for the patent, there has been an exercise of invention or not. (*d*) There are dicta of some judges which, at first sight, at any rate, appear to the contrary, (*e*) but it is submitted that the above is a correct statement of the law. Mere scintilla of invention is sufficient to support a patent.

It is true that every invention capable of supporting a patent must be a new manufacture, but it does not follow that every novelty, though an important and useful one, is good subject-matter. In order to support a patent the novelty must be *de jure* as well as *de facto*. (*f*) In other words, it must be the result of invention. It is not, however, necessary that any great amount of thought, design, or skilful ingenuity must have actually been expended in making the invention, for the discovery may have been the outcome of a mere guess

(*a*) See p. 3 *ante*.
(*b*) p. 22 *ante*.
(*c*) See p. 34 *post*. American Braided Wire Co. *v.* Thomson, (1899) 6 R. P. C. 518; Vickers *v.* Siddel, (1890) 7 R. P. C. 292; Rickmann *v.* Thierry, (1896) 14 R. P. C. 105; Longbottom *v.* Shaw, (1891) 8 R. P. C. 333; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. C. 654; 35 L. T. Q. B. 27; Losh *v.* Hague, (1837) 1 W. P. C. 202, 207; R. *v.* Cutler, (1847) 4 Q. B. 372 *n.*; 3 C & K. 215; Neilson *v.* Harford, (1841) 8 M. & W. 806; 11 L. J. Ex. 20; 1 W. P. C. 331; Crane *v.* Price, (1842) 4 M. & G. 580; 12 L. J. C. P. 81; 1 W. P. C. 393; Hayward *v.* Hamilton, (1879-81) Griff. P. C. 115; Patent Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 549; Gramaphone and Typewriter, Ld. *v.* Ullmann, (1906) 23 R. P. C. 260.
(*d*) See pp. 29, 39 *post*.
(*e*) *E.g.* Carter *v.* Leyson, (1902) 19 R. P. C. 478.
(*f*) See Murray *v.* Clayton, (1872) L. R. 7 Ch. 578.

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or happy accident, suggesting the novel application which is the real meritorious invention. Thus, the discovery of water tabbies was made by mere accident. A man having spat upon the floor, placed a hot iron on the moisture, and observed that it spread out into a kind of flower. He afterwards tried the experiment upon linen, and found it produced the same effect. He then obtained a patent for a process based on the accidental discovery, which proved of great value. (*g*)

Unsatisfied demand.

When an article suddenly springs into existence and meets a long-unsatisfied demand, the length of time during which the demand was unsatisfied is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle, which otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere, or in some shape; (*h*) and the merits of an invention are not to be deemed any the less because it subsequently appears what a little alteration was required in, or in the adjustment of, some of the parts of previously known machines, in order to produce the patented machine which will successfully do the work first done by it. (*i*)

The fact, however, must not be overlooked that the demand itself may be quite new, and the novelty of the demand may have led immediately to the production, without ingenuity, of an obvious article to satisfy it, which consequently could not be good subject-matter. (*k*)

Practical success.

The practical success of a new article is in itself cogent evidence from which the conclusion may be drawn that the exercise of invention was necessary to the first production of the article, (*l*) but practical success is by no means in all cases proof of the exercise of invention. (*m*)

Essential considerations.

If the alleged invention is obvious, and it cannot be

(*g*) See Liardet *v.* Johnson, (1778) 1 W. P. C. 54; see also 2 H. Bl. 486; Crane *v.* Price, (1812) 1 W. P. C. 411.

(*h*) Gosnell *v.* Bishop, (1888) 5 R. P. C. 158; American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C., 5 P. O. R. 125; Blakey *v.* Latham, (1889) 6 R. P. C. 187; Elias *v.* Grovesend Tinplate Co., (1890) 7 R. P. C. 455; Morgan *v.* Windover, (1890) 7 R. P. C. 131; Gammons *v.* Battersby, (1901) 21 R. P. C. 331.

(*i*) See *ibid.*; Gammons *v.* Battersby, (1904) 21 R. P. C. 332.

(*k*) *Ibid.*

(*l*) American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C. 125; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 205; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 398; Hayward *v.* Hamilton, (1881) Griff. P. C. 117; Parker *v.* Satchwell, (1901) 18 R. P. C. 307-8; British Vacuum Cleaner Co., Ld. *v.* Suction Cleaners, Ld., (1904) 21 R. P. C. 312.

(*m*) Rickmann v. Thierry, (1896) 14 R. P. C. 105; Fawcett *v.* Homan, (1896) 16 R. P. C. 274; Longbottom *v.* Shaw, (1891) 8 R. P. C. 333.

presumed that the exercise of thought, design, or skilful ingenuity was required in making it, the patent is void, on the ground of lack of subject-matter. (*n*) Invention.

It has been authoritatively stated that in point of law the labour of thought or experiment, and the expenditure of money, are not the essential grounds of consideration on which the question whether the invention is, or is not, the subject-matter of a patent ought to depend; for if the invention be new, and useful to the public, it is not material whether it be the result of long experiment and profound search, or of some sudden and lucky thought, or mere accidental discovery. (*o*)

The conception of the idea is, in many cases, the whole merit of the invention; and its application, when once conceived, becomes the simplest thing in the world, and, consequently, does not evidence the expenditure of much thought, design, or skilful ingenuity. (*p*) Conception of the idea may be the whole merit.

Therefore, the question whether any alleged invention is proper subject-matter depends, not on whether it was the result of great thought, design, or skilful ingenuity, but whether it required the exercise of some thought, design, or skilful ingenuity to arrive at the result claimed by the patentee—*e.g.*, a new combination which is obvious and consists merely in putting together two known things, each being applied to do that which it had been used to do before, without making any other experiment, or gaining any further information, is not proper subject-matter, (*q*) neither is the mere duplicating of a known thing, though the result is eminently useful. (*r*) An obvious combination is not subject-matter.

For example, in *Williams* v. *Nye*, (*s*) the patent was for a sausage-making machine, and it appeared that there was known

(*n*) White *v.* Toms, (1867) 32 L. J. Ch. 204; Britain *v.* Hirsch, (1888) 5 R. P. C. 74, 226; Jackson *v.* Needle, (1885) 2 R. P. C. 191; Sharp *v.* Bauer, (1886) 3 R. P. C. 193; Guilbert-Martin *v.* Kerr, (1887) 4 R. P. C. 18; Rowcliffe *v.* Longford Wire Co., (1887) 4 R. P. C. 281; Haslam *v.* Hall, (1888) 5 R. P. C. 21; Longbottom *v.* Shaw, (1888) 5 R. P. C. 497; 6 P. O. R. 143; 8 R. P. C. 333; Gaulard & Gibb's Patent, (1888) 5 R. P. C. 525; Herrburger *v.* Squire, (1889) 6 R. P. C. 194; Morgan *v.* Windover, (1890) 7 R. P. C. 131; Wood *v.* Raphael, (1897) 14 R. P. C. 496; Haws *v.* Harding, (1897) 14 R. P. C. 640, 930.

(*o*) Per Tindal, C.J., Crane *v.* Price, (1842) 1 W. P. C. 411.

(*p*) See pp. 34, 42, 47 *post*.

(*q*) Sanders *v.* Aston, (1832) 3 B. & Ad. 881, 886; Saxby *v.* Gloucester Waggon Co., L. R. (1880) 7 Q. B. D. 305; 50 L. J. Q. B. 577; Gaulard and Gibbs' Patent, (1890) 7 R. P. C. 380–1; Williams *v.* Nye, (1890) 7 R. P. C. 62; Ormson *v.* Clarke, (1862) 13 C. B. 339; 14 C. B. 490; Newsum *v.* Mann, (1890) 7 R. P. C. 307; Heys *v.* Hallmark, (1891) 9 R. P. C. 25; Bridges Patent, (1901) 18 R. P. C. 257; Wardroper *v.* George Gibbs, Ld., (1903) 20 R. P. C. 355.

(*r*) Elias *v.* Grovesend Tinplate Co., (1890) 7 R. P. C. 455; Morgan *v.* Windover, (1890) 7 R. P. C. 131.

(*s*) (1890) 7 R. P. C. 37, 62, 66.

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an old machine, *Nye's*, in which there was a combination of a cutting process and a forcing forward or filling into the skin which was to enclose the meat when cut up. *Nye's* cutting process was defective. There was also known an old cutting process, *Donald's*, which was satisfactory. What the plaintiff did, was to introduce into *Donald's* cutting machine, and on the shaft which worked it, a screw to force the meat when minced into the sausage skin. Such a forcing screw was used in *Nye's* machine. Though the plaintiff did in fact turn *Donald's* machine into a machine which filled as well as cut, and so produced a machine which was new and better than *Nye's* cutting and filling machine, yet the Court of first instance and the Court of Appeal held that there was no sufficient invention, and the patent was bad on the ground of lack of subject-matter.

Leading cases to the effect that a scintilla of invention is sufficient.

The following are the leading authorities on the point that a mere *scintilla* of invention is sufficient to support a patent for subject-matter which is in fact a new and useful "manufacture" within the meaning of the Statute of Monopolies, with the most important passages of the quoted judgments printed in italics:—

Harwood v. Great Northern Railway Co.

*Harwood* v. *Great Northern Railway Co.*, (1865) 11 H. L. C. 654; 35 L. J. Q. B. 27. In this case the patent related to "improvement in fishes and fish-joints for connecting the rails of railways," and was declared invalid. When the case reached the House of Lords the Judges were summoned and requested to give their opinions as to whether upon the findings of the jury on the facts of the case a verdict should be entered for the plaintiffs or the defendants.

*Blackburn*, J., in delivering the opinions of himself and *Shee*, J., stated the law in the following terms, with which all the Judges consulted and the House agreed (11 H. L. C. 666): "The Statute of Monopolies (21 Jac. I. c. 3, s. 6) excepts from the abolition of monopolies patents for '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 patents and grants shall not use.' In order to bring the subject-matter of a patent within this exception, there must be *invention* so applied as to produce a practical result. And we agree with the Court of Exchequer Chamber that a *mere* application of an old contrivance in the old way to an analogous subject, *without any novelty or invention* in the mode of applying such old contrivance to the new purpose, is not a

valid subject-matter of a patent. There are many decisions to that effect, which were referred to at your Lordships' Bar; and, if the matter were now, for the first time, to be decided on the construction of the statute, without reference to the cases, we should think on principle that such should be the conclusion of the Court. But then in every case arises a question of fact whether the contrivance before in use was so similar to that which the patentee claims that there is no invention in the differences, if any, between the old contrivance and that for which the patentee claims a monopoly; and, if there is none, there arises a further question—viz., whether the purpose to which the contrivance was before applied and the new purpose are so analogous or cognate that there is no discovery or invention in the new application? Whether, in short, it is a *mere* application or not? *For if there is invention or discovery producing a practical benefit, as in the case of* Crane *v.* Price, (1840) 1 W. P. C. 377; 4 Man. & Gr. 580, *it is the valid subject of a patent.* And we think it always must be a question of degree—a question of more or less—whether the analogy or cognateness of the purposes is so close as to prevent them being an invention in the application. Mr. *Grove, in his very able arguments, contended, we believe correctly enough, that if there was any real invention, though a slight one, producing a practical beneficial result, the patent was good.* But the question still remains, was there such an amount of cognateness in the purposes that there was no real invention or discovery?"

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Lord *Westbury*, L.C., in moving the House to confirm the decision of the Court of Exchequer Chamber, said (11 H. L. C. 682): "*Then, my Lords, 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 to a railway.* Upon that I think the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance, if every slight difference in the application of a well-known thing should be held to constitute ground for a patent. There is the familiar contrivance of the button to the button-hole taken from the waistcoat or the coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied; but it would be an idle thing, if it were possible, to take a well-known mechanical contrivance, and by applying it to a subject to which it had not hitherto been applied to constitute that application the subject of a patent to be granted as for a new invention. No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions which are referred to in the opinions of the four learned Judges who concur in the second opinion delivered

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to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose, which is not quite the same, but is analogous to the manner or the purpose in or to which it has been hitherto notoriously used."

Elias v. Grovesend Tinplate Co.

In *Elias* v. *Grovesend Tinplate Co.*, (1890) 7 R. P. C. 455, *Smith*, L.J., pointed out that when Lord *Westbury*, L.C., stated that you cannot have a patent for a well-known mechanical contrivance *merely* when it is applied in an analogous manner or to an analogous purpose his Lordship meant "*unless there is invention in the adaptation or mode of application.*"

Penn v. Bibby.

In *Penn* v. *Bibby*, (1866) L. R. 2 Ch. 127 ; 36 L. J. Ch. 453, the patent related to "an improvement in the bearings and brushes for the shafts of screw and submerged propellers."

It was objected against the patent that it was a case of mere analogous use of bearings known in connection with grindstones and water-wheels. Lord *Chelmsford*, L.C., to whom there was an appeal for a new trial, in reference to the question of invention, said (L. R. 2 Ch. 135) : "It was objected that the finding was erroneous, because the alleged invention was merely a new application of an old and well-known thing. It is very difficult to extract any principle from the various decisions on this subject which can be applied with certainty to every case ; nor indeed is it easy to reconcile them with each other. The criterion given by Lord *Campbell* in *Brook* v. *Aston*, 8 E. & B. 485, has been frequently cited (as it was in the present argument), that a patent may be valid for the application of an old invention to a new purpose, but to make it valid there must be some novelty in the application. I cannot help thinking that there must be some inaccuracy in his Lordship's words, because according to the proposition, as he stated it, if the invention be applied to a new purpose, there cannot but be some novelty in the application.

"In every case of this description one main consideration seems to be whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but *to require some application of thought and study.* Now, strictly, applying this test to the present case, it appears to me impossible to say that the patented invention is merely an application of an old thing to a new purpose."

Thomson v. American Braided Wire Co.

*Thomson* v. *American Braided Wire Co.*, (1889) 6 R. P. C. 518, was a case near the border line, but the patent was upheld by the House of Lords on the ground that there was quite sufficient invention in the mode of application. Lord *Herschell's* judgment contains the following passage (6 R. P. C. 527) : "It cannot be denied that both the prior patents to which I have

referred afford some colour to the defendants' contention that the patentee has done nothing more than apply a known substance in a manner and to a purpose analogous to that in and to which it had been already applied, and that the patent therefore cannot be supported. If I thought that the patentee had claimed the mere use of tubular sections of braided wire as a bustle, however fastened or secured, I should arrive at the conclusion that the defendants' contention was well founded, but I do not thus construe the specification. I have already stated that in my opinion it is the combination alone for which protection is sought, and that the method of fastening the ends by clamping plates is an essential part of that which is claimed. Taking this view of the patent, *I think that*, even with the state of knowledge which existed at the time the patent was applied for, *some invention was required to produce the bustle claimed to be protected by it.* All the learned Judges in the Court of Appeal, although they arrived at the same conclusion, stated that they had done so with hesitation, and expressed the opinion that but little invention was requisite, and that the case was near the border line. I entirely agree, and have not been without doubt as to the proper decision to be arrived at."

Vickers v. Siddell.

In *Vickers* v. *Siddell*, (1890) 7 R. P. C. 292, the subject-matter of the patent related to an improved mechanical appliance for making or operating on large forgings in iron or steel. In the House of Lords, Lord *Herschell* said, 7 R. P. C. 304: "The objections of want of novelty and subject-matter cover to some extent the same ground, but it will be expedient to deal with them as far as possible separately. The invention, so far as we are concerned with it in this part of the case, consists of an apparatus for turning heavy forgings, composed of a wheel and endless chain, the wheel being internally toothed, and having a ratchet working in it, by means of which the wheel is caused to rotate, and the forging which rests in the endless chain is thus turned from time to time to the extent desired. It is admitted by the respondent that the elements which form this combination are all old. On the other hand, the appellants admit that the combination was never in use prior to the date of the patent. But they allege that to combine these well-known elements into the apparatus needed no invention, and that it is therefore not proper subject-matter for a patent. Forgings, they say, had long rested in an endless chain, the idea of turning such forgings by turning the wheel over which the chain passed was not a new one, and a ratchet, working in teeth was a well-known device for causing a wheel to rotate to the desired extent. All this, I think, cannot be denied. But the result is an apparatus of extremely simple character, which possesses the advantage of being easily moved

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from place to place and applied wherever wanted. And the question remains whether this mode of dealing with forgings which require to be gradually turned was so obvious that it would at once occur to any one acquainted with the subject and desirous of accomplishing the end, or *whether it required some invention to devise it.* There is no doubt about the law applicable to such a question, though it is often difficult to apply it to the circumstances of a particular case, and its application is perhaps most difficult when the alleged invention consists of a new apparatus combining known elements. If the apparatus be valuable by reason of its simplicity, there is a danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionised the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to every one." (*t*)

Decision may be difficult in cases of mechanical combinations.

When the patentee's claim, properly construed, is for a thing substantially as described, and the fact is that no such thing ever existed before and, by means of the thing, a result not previously produced can be attained, it is difficult to say that that thing is not subject-matter for a valid patent, especially where there is no evidence of any prior instrument performing the same function as the thing described and claimed. (*u*) In this connection the following words of Lord *Halsbury*, L.C., are very instructive: "There is nothing, I suppose, more difficult, when you are dealing with a mechanical combination, than to keep one's mind free from the impression created by the fact that all the elements, or most of the elements, in such a case are old . . . it is, of course, extremely difficult to deal with such questions in the abstract, and I am disposed to think myself that the source of error is in dealing with it in the abstract; because you have to start with the proposition that everything is old, and until you apply yourself to what is the peculiar mechanism for the purpose required, you do not adequately appreciate—and I may frankly say that I did not adequately appreciate—what the invention is until you come to put it in a concrete form and to see what the thing is, what the thing was intended to do, and then apply

(*t*) See also Patent Exploitation, Ltd. *v.* Siemens Brothers & Co., Ltd., (1904) 21 R. P. C. 541.

(*u*) See the above-quoted passage from Vickers *v.* Siddell; Anand *v.* Taylor, (1900) 18 R. P. C. 53; British United Shoe Machinery Co. *v.* Thompson, (1904) 22 R. P. C. 177, 196.

your mind to see whether in its combination it has been anticipated or not." (*x*) Invention.

The immediate commercial success of a new article is not necessarily proof of invention, but it has a very important bearing on the question whether or not it required invention to produce it, when it appears that the thing never was done in the memory of man down to a particular point, and at the moment it is done it is a great success as regards utility. (*y*) Commercial success.

It is thus purely a question of fact in each instance whether, upon a consideration of the circumstances peculiar to each case and the state of public knowledge at the date of application for the patent, there has been an exercise of invention or not; and a decision of fact in one case is neither an authority, nor a help, to a decision of fact in another case. (*z*) In the words of the late Lord *Bowen* (*a*): "Has there been an exercise of the inventive faculties? That depends on a true view of all the circumstances, and it cannot be governed in any one case by a finding of fact, on a totally different invention, by a tribunal like the House of Lords. We must apply our minds to the specific facts in the case before us; and nothing is more pernicious, or likely to lead the Court astray, than, when it has to decide a question of fact in one case, to wander into another case; to look at the decision of fact in that case and then to see what differentiations there can be between the facts in the cited case and the one before the Court. The Court that travels on these lines always goes wrong." (*b*) Invention purely a question of fact.

Though the exact thing claimed by the patentee cannot be said to have been anywhere actually published or described in its entirety yet the state of common knowledge may be Effect of common knowledge on question of invention.

(*x*) Taylor *v.* Annard, (1900) 18 R. P. C. 62.

(*y*) See per Bowen, L. J., American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C. 125; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 205; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 398; Parker *v.* Satchwell, (1901) 18 R. P. C. 307–8; British Vacuum Cleaner Co., Ld. *v.* Suction Cleaners, Ld., (1904) 21 R. P. C. 312; Patent Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 518.

(*z*) Crossley *v.* Beverley, (1829) 1 W. P. C. 107; Lewis *v.* Marling, (1829) 1 W. P. C. 496; King, Brown & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; 7 R. P. C. 436; 9 R. P. C. 313; United Telephone Co. *v.* Harrison, Cox, Walker & Co., (1882) L. R. 21, Ch. D. 720; Actien Gesellschaft fur Cartonnagen Industrie *v.* Schroeder, (1896) 13 R. P. C. 466; Kratz-Boussac *v.* Beehmann, (1905) 22 R. P. C. 448; Gramaphone and Typewriter, Ld. *v.* Ullmann, (1906) 23 R. P. C. 230.

(*a*) Lyon *v.* Goddard, (1893) 10 R. P. C. 316.

(*b*) See also Case *v.* Cressy, (1900) 17 R. P. C. 263; Saxby *v.* Gloucester Waggon Co., (1883) L. R. 7; Q. B. D. 305; 50 L. J. Q. B. 577; Griff. L. C. C. 54; Cropper *v.* Smith, (1884) L. R. 26 Ch. D. 700; 53 L. J. Ch. 891; 1 R. P. C. 90; Morgan *v.* Windover, (1890) 7 R. P. C. 131; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 516.

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such that there is, as a fact, no invention in passing from what was known to the thing claimed by the patentee. (*c*)

Simplicity no bar to invention.

No apparent smallness or simplicity in what the patentee does will prevent the patent being good, if some invention was requisite to produce the new result; but, on the other hand, mere novelty of manufacture, or usefulness in the application of known materials to analogous uses or the arrangement of old parts in combination, will not necessarily establish invention within the meaning of the patent law. (*d*)

Sometimes an invention which is an improvement on what has gone before appears extremely simple when discovered and explained, but it does not at all follow that it was obvious before, or did not require invention, or is not of great merit, and the proper subject-matter of a patent. Thus in the case of the discovery of Lanolin the invention consisted in freeing the known commercial wool-fat from fatty acids and other impurities and so leaving only the cholesterine fats, which it was discovered when kneaded and worked take up water and form the highly useful product Lanolin. At the date of the patent the methods used for separating the cholesterine fats were old and known, and a preparation of wool-fat described by *Dioscorides* and called *œsypus*, from which the fatty acids had not been completely removed, was known as an unguent to the ancients. The Courts nevertheless found that the process which yielded the highly useful product Lanolin was the outcome of great invention and the subject-matter of a valid patent. (*e*)

Conception of an idea may be the merit of an invention.

Sometimes the merit of an invention consists in clearly appreciating some particular useful end to be attained, or, as has been aptly said, in "apprehending a desideratum," the merit of the patent consisting not so much in the way in which the idea was carried out as in conceiving the idea

(*c*) See cases note (*d*) *infra*, and pp. 107, 154, 418, 640 *post*.

(*d*) Rickmann *v.* Thierry, (1896) 14 R. P. C. 105; Longbottom *v.* Shaw, (1891) 8 R. P. C. 336; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; Brook *v.* Aston, (1857-9) 8 Ell. & B. 478; Ormson *v.* Clarke, (1862) 13 C. B. 339, 14 C. B. 400; Saxby *v.* Gloucester Waggon Co., (1880) L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577; Williams *v.* Nye, (1890) 7 R. P. C. 62; Newsum *v.* Mann, (1890) 7 R. P. C. 307; Elias *v.* Grovesend Tinplate Co., (1890) 7 R. P. C. 455; Morgan *v.* Windover, (1890) 7 R. P. C. 131; Heys *v.* Hallmark, (1891) 9 R. P. C. 25; Duckett *v.* Whitehead, (1895) 12 R. P. C. 376; Actien Gesellschaft fur Cartonagen Industrie *v.* Schroeder (1896) 13 R. P. C. 466; Fuller *v.* Handy, (1903) 21 R. P. C. 6; McNaught *v.* Dawson, (1905) 22 R. P. C. 389; 23 R. P. C. 219; Arnot *v.* Dunlop Pneumatic Tyre Co., Ld., (1904) 22 R. P. C. 105, 472.

(*e*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 11 R. P. C. 93, 261; see also *ibid*.

itself. (*f*) Thus it has been held the fact that a chemist would know *à priori* that by mixing two known substances together an explosive would be the result, did not destroy the patent of a man, who by experimentally mixing them together and treating the result in a certain known way so as to waterproof it found he did get an explosive, Roburite, which satisfied commercial requisites which were not satisfied by explosives known before. (*g*) In this case the invention consisted, as it often does in other cases, of putting together items of common knowledge which no one else has ever thought of combining—common knowledge that you may mix, common knowledge that you may waterproof—but the essence of the invention was that the inventor had taken a great many things which were common knowledge and tried which of them would produce a useful and new result, and he thus ascertained that, following the process described by him in his specification, he arrived at a new and useful result, which was undoubtedly invention, and in the particular case invention of a somewhat high order. (*h*)

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Invention, again, may sometimes consist in the selection of particular members of a class of substances, which possess properties by means of which the inventor is able to produce a result which is new and useful, or, if old, is attained in a better or more economical way than hitherto. (*i*)

Selection of a member of a class.

So, though a class of bodies may have been employed before for a particular purpose, there may be such invention in selecting one member of the class which possesses particular advantages not shared by the other members of the class as will support a patent for the use of that particular member. (*k*)

So also, though different machines of a certain general class or character be well known, if a person selects and applies one specially adapted for his purpose to effect a new object and produce a new article, or an old article in a

New application of known machine.

(*f*) See *Fawcett v. Homan*, (1896) 13 R. P. C. 405, 410; Hayward *v.* Hamilton, (1881) Griff. P. C. 116-117; also p. 47 *post*.

(*g*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 482.

(*h*) See per Rigby, L.J.; 12 R. P. C. 482.

(*i*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 389; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 478; 13 R. P. C. 429; 14 R. P. C. 303; but see Fabriques de Produits Chimiques de Thann et de Mulhouse *v.* Lafitte, (1899) 16 R. P. C. 61.

(*k*) Hills *v.* The London Gas Light Co., (1857) 27 L. J. Ex. 60; 5 H. & N. 312; 29 L. J. Ex. 409; Wylie and Morton's Patents, (1896) 13 R. P. C. 97, in which a patent was refused on the ground that there was in that case no invention in making the selection.

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substantially more expeditious and economical way than it was produced before, then he may properly claim, as subject-matter of a patent, that machine as applied to the new object, notwithstanding that he could not have claimed the machine *per se*—that is to say, without limitation as to its application. (*l*)

Use according to new method of old machine.

Again, invention may consist in the use according to a new method of a known machine whereby no structural alteration is required in the machine, but a new and useful result is produced, (*m*) or it may consist in degree—*e.g.*, strengthening a part of a previously proposed combination whereby what is in fact a new and useful process may be effected; (*n*) or it may consist in selecting a known thing of a particular size or degree whereby a result highly desired, but till then incapable of attainment, is achieved. (*o*)

Degree.

Mere use of known machine in a more beneficial manner.

The foregoing instances of invention must, however, be contrasted with, and not confused with, the case of a claim to a mere use of a known machine in a more beneficial manner, which is not subject-matter for a valid patent. (*p*)

Mere adaptation of old idea.

It is not invention to adapt, without ingenuity, a well-known idea in a well-known manner for a well-known purpose, though the identical adaptation has not been made before and a very useful effect is the result, (*q*) or merely with greater skill to apply well-known tools and processes, and so to satisfy a want felt by persons in a particular trade, (*r*) or the mere judicious carrying out of a well-known method together with mere adaptive skill in manufacture. (*s*)

Mere skilful application of known tool, or judicious carrying out of known method,

or mere alteration of shape or proportions of parts is not invention.

Neither is it invention merely to alter the shape of a known thing, though to do so might possibly be the subject of a new design; (*t*) or to alter the proportions of parts used in combination before, when proportion is not of the essence of success. (*u*)

**Classes of Inventions.**—Any invention which possesses all the

(*l*) Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 21; Dowling *v.* Billington, (1889) 7 R. P. C. 191.

(*m*) Dowling *v.* Billington, (1889) 7 R. P. C. 191.

(*n*) British Vacuum Cleaner Co., Ltd. *v.* Suction Cleaners, Ltd., (1904) 21 R. P. C. 303; Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 331; 11 R. P. C. 113.

(*o*) Jandus Arc Lamp and Electric Co., Ltd. *v.* Arc Lamp Co., (1905) 22 R. P. C. 277, 297.

(*p*) See pp. 78 and 56 *post*.

(*q*) pp. 90–98 *post*.

(*r*) Dredge *v.* Parnell, (1899) 16 R. P. C. 625.

(*s*) See Beavis *v.* Rylands Glass and Engineering Co., Ltd., (1899) 17 R. P. C. 98, 704.

(*t*) Heys *v.* Hallmark, (1892) 9 R. P. C. 25; Beavis v. Rylands Glass and Engineering Co., (1900) 17 R. P. C. 98, 704.

(*u*) Savage *v.* Harris, (1896) 13 R. P. C. 364.

attributes imposed as conditions by the law—viz., that it is included in the term "new manufactures" as used in the sixth section of the Statute of Monopolies (*x*) and is new and useful—may be the subject of a grant of letters patent. Classes of Inventions.

It is not possible to give a classification of inventions, including all which may be held to fall within the definition given in 21 Jac. I. c. 3, s. 6. The difficulty which exists in giving an exhaustive classification of all inventions which could possibly support a grant of letters patent arises from the fact that the arts and manufactures of the country are in a continual state of progression, and consequently desirable results, never before contemplated, are continually presenting themselves, and the most minute changes may constitute new and useful inventions when they are the outcome of thought, design, or skilful ingenuity. Exhaustive classification not possible.

It may, however, be pointed out that all inventions for which letters patent have hitherto been upheld on the ground of subject-matter may be classed under one or more of the following heads:—

I. New or old methods of applying new principles.
II. New methods of applying old principles.
III. New contrivances applied to new objects or purposes.
IV. New contrivances applied to old objects or purposes.
V. New combinations of new or old, or partly new and partly old, parts, which result either in the production of a material object or process.
VI. New methods, involving the exercise of invention, of applying old things or processes.
VII. Improvements on known methods, processes or combinations consisting in the addition to, the omission from, or the rearrangement of, old steps or parts.
VIII. Application, with ingenuity, of materials, processes, or things previously unapplied to useful purposes to some one or more specific useful purpose or purposes.

## Principles.

A new principle—*i.e.*, an abstract law of Nature, a fundamental law of science—cannot be the subject-matter of a valid patent. Principles alone are not subject-matter,

(*x*) 21 Jac. I. c. 3, s.

Principles.

Principles may be of the utmost value to mankind, as, for instance, the principle of gravitation or the doctrine of evolution, which have in the hands of their discoverers and others been productive of the greatest usefulness. The law, however, will not attempt to secure to the discoverer the sole use and enjoyment of such a bare principle, or to prohibit others from making use of it. In the language of Lord *Kenyon*, it would be difficult to frame a specification of a philosophical principle, it would be something like an idea without a substratum. (*y*)

Moreover, the very statement of what a principle is proves it not to be a ground for a patent. It is a first ground and rule for arts and sciences, or, in other words. the elements and rudiments of them. A patent must be for some production from those elements, and not for the elements themselves; for some new manufacture, whether with or without principle, produced by art or accident. (*z*).

A principle cannot of itself, apart from a practical application, produce any vendible article or manufacture, and therefore, unless the discoverer of a principle points out some practical application of it, it is clear that he cannot give the public the consideration necessary to support a patent—viz., a new and useful manufacture.

but may be together with a method of application.

Principles in a concrete form, together with a method of applying them to a new and useful purpose, may form the subject of a grant of letters patent. In other words, a new principle or a new idea as regards any art or manufacture, together with a mode of carrying it into practice, may be patented, though the idea alone, and very likely the machine alone, because the machine might not be new, is not proper subject-matter. (*a*)

The following remarks of *Jessel*, M.R., (*b*) in reference to the patent for the *Otto* gas engine are most instructive in this connection :

> "The first objection is that this is not the subject-matter of a patent, because it is said that what is claimed is a principle . . . or, as it is sometimes termed, the idea of putting a

(*y*) Hornblower *v.* Boulton, (1799) 8 T. R. 95; Dav. P. C. 221; see also Boulton *v.* Bull, (1795) 2 H. Bl. 463.

(*z*) Boulton *v.* Bull, (1795) Dav. P. C. 196, 198.

(*a*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35; L. R. 18 Ch. D. 394; Crossley *v.* Porter, (1853) Moor, P. C. 240; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 256.

(*b*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35.

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. If you have a new principle, or a new idea, as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new. One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture, where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this. He said: 'I will patent that idea in combination with the mode of carrying it out; that is, I tell you you may heat your air in a closed vessel next your furnace, and then that will effect the object.' It was held that that would do. . . . Now that is a much stronger illustration than this of the validity of a patent as regards the subject-matter. For here is a complicated machine. . . . In the case of the hot blast the man did not pretend to invent anything; he said a machine of any shape in which you can heat air is sufficient. Mr. *Otto* does allege he has invented a machine. It appears that he did, although a machine which, *per se*, was not of sufficient novelty probably to support a patent. It comes therefore to this, that we have a principle and a mode of carrying it out, and, I will assume for this purpose, sufficiently described, and that is good subject-matter for a patent."

Principles.

A claim to every mode of carrying a principle or idea into effect amounts to a claim for the principle or idea itself, and therefore renders the patent void, (*c*) unless the patentee has described in the specification a method or methods of utilising the principle or idea, *i.e.*, unless he has embodied the principle or idea, in which case such a claim is good provided always

Claim to all methods of application amounts to claim to principle itself.

(c) See Neilson *v.* Harford, (1841) 1 W. P. C. 295; Booth *v.* Kennard, (1856) 2 H. & N. 84; 26 L. T. Ex. 23, 305; Wyeth *v.* Stone, 1 Story, 273; Arnold *v.* Bradbury, (1871) L. R. 6 Ch. App. 711; Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239.

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that the patentee was the discoverer of the principle or idea. (*d*)

Illustrations of good claims to principles coupled with methods of application. Neilson *v.* Harford, and Houschill Co. *v.* Neilson.

Thus the patent, the validity of which was questioned in *Neilson* v. *Harford*, (*e*) and also in *Houschill Co.* v. *Neilson*, (*f*) was for an improved method of applying air to produce heat in furnaces, and the specification stated that "a blast or current of air must be produced by blowing apparatus in the ordinary way. The blast so produced is to be passed from the blowing apparatus into an air-vessel, and from that vessel by means of a pipe into the furnace. The air-vessel must be kept artificially heated at a considerable temperature. It is better to be kept to red heat, or nearly so, but so high a temperature is not absolutely necessary to produce a beneficial effect. The size of the air-vessel must depend upon the blast and on the heat necessary to be produced. *The form or shape of the vessel*, or receptacle, *is immaterial to the effect*, and may be adapted to the local circumstances or situation." There was no separate claim. The defendants contended that the patent was bad, as being for a principle only, but the Court of Exchequer, after much debate, came to the conclusion that it claimed not only a principle, but also a practical means of carrying the principle into effect—viz., heating the air in a separate vessel, and was therefore good.

In the *Houschill Co.* v. *Neilson*, (*g*) Lord Justice Clerk *Hope*, addressing the jury and referring generally to the validity of patents for methods of carrying principles into effect, used the following words, which were not objected to by the House of Lords in that case, and have often been quoted with approval by Judges in subsequent cases:

> "It is quite true that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of Nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention in the patent law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry, or to the

(*d*) See p. 51 *post*.
(*e*) (1841) 1 W. P. C. 295, 328, 331.
(*f*) (1843) 1 W. P. C. 673.
(*g*) (1843) 1 W. P. C. 673, 683.

purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a just, general, and most comprehensive principle in science or law of Nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. The main merit, the most important part of the invention, may consist in the conception of the original idea—in the discovery of the principle in science, or of the law of Nature, stated in the patent—and little or no pains may have been taken in working out the best manner and mode of the application of the principle to the purposes set forth in the patent. But still if the principle is stated to be applicable to any special purpose, so as to produce any result previously unknown, in the way and for the objects described, the patent is good. It is no longer an abstract principle. It comes to be a principle turned to account to a practical object, and applied to a special result. It becomes, then, not an abstract principle, which means a principle considered apart from any special purpose or practical operation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. That such is the law, if a well-known principle is applied for the first time to produce a practical result for a special purpose, has never been disputed. It would be very strange and unjust to refuse the same legal effect, when the inventor has the additional merit of discovering the principle as well as its application to a practical object. The instant that the principle, although discovered for the first time, is stated, in actual application to, and as the agent of, producing a certain specified effect, it is no longer an abstract principle, it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of human life."

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In *Patterson* v. *Gas Light and Coke Co.*, (*h*) a patent, which claimed the employment of sulphide of calcium in separate purifiers as a means of purifying coal-gas from sulphur existing in other forms than that of sulphuretted hydrogen, was declared void, on the ground that the claim amounted to a claim to the known principle however effected as distinct from a particular invented means of carrying it out. The judgment of *James*, L.J., which was affirmed in the House of Lords, contains the following passage in reference to the

(*h*) (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; 45 L. J. Ch. 843; 47 L. J. Ch. 402.

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claim for "the employment of sulphide of calcium in separate purifiers as a means of purifying coal-gas from sulphur existing in other forms than that of sulphuretted hydrogen":

> "There is nothing in this but the enunciation of a chemical truth that pure sulphide of calcium will absorb the sulphur compounds. The plaintiff believed that he had discovered that chemical truth, although it had been taught for many years in many books, and was well known to chemists. There is no invention of any particular process or means of employing the pure sulphide of calcium. If pure sulphide of calcium is to be used, it must be used in some separate purifier, and there is nothing therefore in any previous part of the specification to limit the universality of the claim to the employment of sulphide of calcium for the removal of sulphur in other forms than sulphuretted hydrogen. It is obviously impossible to support such a claim as that, which was plainly based on the plaintiff's mistaken idea that he had discovered that peculiar property in sulphide of calcium."

Dangerfield v. Jones.

In *Dangerfield* v. *Jones*, (*i*) a patent for a mode of bending wood for the handles of walking-sticks, &c., in which the claim was "the application of a flame of gas or other combustible fluid or liquid as described for softening the fibres of the wood while being bent in combination with a clamping apparatus for securing the wood in its bent form until the fibres are set, so that the work may remain permanent as herein set forth," was declared to be perfectly valid, Vice-Chancellor *Wood*, before whom the case was tried, saying: "If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit." (*j*)

Minter v. Wells.

In *Minter* v. *Wells*, (*k*) on motion to nonsuit the plaintiff, who had succeeded in an action against the defendant for infringement of a patent, in the specification of which *Minter* claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described," the defendant contended that

(*i*) (1865) 13 L. T. N. S. 142. (*j*) *Ibid.*
(*k*) (1834) 1 W. P. C. 134.

*Minter* had claimed the principle of the lever, but the Court held that it was the application of a self-adjusting leverage to the back and seat of a chair, the patentee having described what that self-adjusting leverage was. And it was further held that any application of a self-adjusting leverage to the back and seat of a chair producing this effect, that the one acts as a counterbalance to the pressure against the other, would be an infringement of the patent, and it was not a leverage only, but the application of a self-adjusting leverage; and it was not a self-adjusting leverage only, but a self-adjusting leverage producing a particular effect, by means of which the weight on the seat counterbalanced the pressure against the back. *Parke*, B., in reply to the statement that this was nothing more than one of the first principles of mechanics, observed: "But that not being in combination before cannot that be patented? It is only for the application of a self-adjusting leverage to a chair—cannot he patent that? He claims the combination of the two, no matter in what shape you may combine them, but if you combine the self-adjusting leverage, which he thus applies to the subject of a chair, that is an infringement of his patent." Principles.

In the *Electric Telegraph Co.* v. *Brett* (*l*) the patentees claimed, substantially: (1) "We wish it to be understood that we make no claim to the application of the multiplying coils of conducting wires herein described (meaning thereby the galvanometer coils and magnetic needles), but the improvement and the adaptation of magnetic needles for giving signals consists in disposing the needles in vertical planes with fixed horizontal axes, making them heavier at one end than the other, so that they hang perpendicularly, and limiting the angular motion by stops, against which the needles may rest in suitable inclining directions for pointing out on a vertical dial the signification of the signals. (2) The combining several needles, so as to give signals by determinate angular motions. (3) The improvement whereby the complete apparatus for giving signals and sounding alarms, as described, may have duplicates of such apparatus at intermediate places between the two ends, all such duplicates operating simultaneously with each other." In the judgment, *Cresswell*, J., said: "It was insisted that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not Electric Telegraph Co. v. Brett.

(*l*) (1851) 10 C. B. 838; 20 L. J. C. P. 123.

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a new manufacture. But we think that the patentees not only communicated the idea or principle that duplicate signals might be given, but showed how it might be done—*i.e.*, by duplicate apparatus at each station—and that this is a fit subject of a patent."

Claim to a general arrangement distinguished from claim to a principle.

A claim to a particular general arrangement must be distinguished from a claim to a principle itself. If it falls short of a claim to a principle, it does not invalidate the patent. This may be illustrated by a reference to the history of the development of the phonograph. Phonographs were at one time made with a single diaphragm, with a single tool or point for recording and reproducing. Later, two diaphragms were used with separate recording and reproducing points, together with a floating weight applied to give the proper pressure to the reproducing point. Edison then discovered that the floating weight might also be applied to the recording point, and so a single diaphragm with both the points on it might be used. For this discovery a patent was obtained, and the specification claimed (*inter alia*) "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." In an action brought for the infringement of this patent, it was sought on the defendant's behalf to invalidate the grant on the ground that the above claim was a claim for a mere idea of having both points on a single diaphragm divorced from the idea of carrying it out, and might so prevent any one else making a useful and totally different arrangement. It was however held, both by the Judge of first instance and the Court of Appeal, that on the evidence the claim was not for a principle, but for a novel and useful arrangement. (*m*) Lord *Esher*, M.R., in the Court of Appeal, adopted the decision of *Wright*, J., *ipsissimis verbis*, and said (*n*):

> "Now, I have said I have confined this mode of dealing with this patent to the case of a machine, and I therefore adopt precisely the way in which Mr. Justice *Wright* has stated the matter: 'There remains the question whether the patent is invalidated by the first claim. That claim appears to me to be, on the face of it, a claim of monopoly for every form of phonograph in which two styles are attached to one diaphragm, so

(*m*) Edison-Bell Phonograph Corporation v. Smith, (1894) 11 R. P. C. 148, 389.

(*n*) 11 R. P. C. 397.

that each style can be brought to bear on the cylinder. It is stated that such a claim is a claim to monopolise a principle. I think not.' Now that is the part with which I say I agree. 'It is a claim for a particular arrangement of essential parts of a machine, which arrangement has obvious advantages, but has never before been made practicable in a way disclosed by the specification. Such a claim ought properly to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification, and that appears to be sufficient.' I agree with that, and therefore I think that so far as this objection is concerned, applying it to each and every one of the claims, it shows that these claims are none of them wanting in that respect."

Ambit of patent for carrying a new principle into effect.

It has been demonstrated in the foregoing pages that a patent for carrying a principle which is new into effect protects the grantee against all other modes of carrying the same principle into effect. (*o*)

In order that a patent may secure to the patentee the application of a principle by means different to those described in the specification, it is only necessary that the principle itself be new, and the patentee sufficiently describes a means of applying it. It is not necessary that the means, as well as the principle, should be new, for the novelty of the invention consists in applying the new principle by the means specified. If, however, not only the principle but the means is also new, then the means may form the subject of a distinct claim or a separate patent.

Dictum of Alderson, B., explained.

In *Jupe* v. *Pratt*, (*p*) *Alderson*, B., in the course of the argument, laid down the law thus:

"You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all

(*o*) Jupe *v.* Pratt, (1837) 1 W. P. C. 146; Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684; Ashworth *v.* English Card Clothing Co., Ld., (1903) 20 R. P. C. 797; Consolidated Car Heating Co. *v.* Carne, (1903) 20 R. P. C. 767; Sandow *v.* Brooks, (1903) 21 R. P. C. 33, 333; 23 R. P. C. 6; Haskell Golf Ball Co. *v.* Hutchison, (1905) 22 R. P. C. 492; Minter *v.* Wells, (1834) 1 W. P. C. 127; Household Co. *v.* Neilson, (1843) 1 W. P. C. 685; Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Crossley *v.* Beverley, (1829) 1 W. P. C. 106; Badische Anilin und Soda Fabrik *v.* Levenstein, (1883) L. R. 24 Ch. D. 156, 171; Easterbrook *v.* The Great Western Ry. Co., (1885) 2 R. P. C. 201.

(*p*) 1 W. P. C. 145, 146.

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other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

The above expressions of *Alderson*, B., would at first sight appear to establish the proposition, that if a man has invented a new principle, and shows one method of carrying it into effect, he thereupon becomes entitled to protection against every other possible method of carrying out the new principle. That it does do so must now be conceded, since it has been accepted by the House of Lords as a correct statement of the settled state of the law on the subject. (*q*) Before this decision of the House of Lords, there was some doubt as to whether the dictum must be considered a correct statement of the law. For instance, *Cotton*, L.J., pointed out that the above language of *Alderson*, B., was used during the discussion of the case, probably to meet something that was said by counsel, and did not express his full opinion. The Lord Justice s' ed that in his opinion a patentee could prevent any one from using the same method of carrying a new principle into effect, or from using the same thing with only a colourable difference. Where there is a principle first applied in a machine, capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether, in effect, although the mode is not exactly the same, it is only a colourable difference—a mechanical equivalent for a substantial part of the patentee's invention, being looked upon as a mere colourable difference, and therefore he is entitled to an injunction against that mode of carrying out his principle, which is only the same in substance as that which he patented, though there are colourable differences. (*r*) There is no longer any necessity for this qualification of Baron *Alderson's* dictum, since, as stated by Lord *Davey*, the question in every case is in what consists the originality and merit, or to use the well-known phrase of Lord *Cairns*, the "pith and marrow," of the patented invention. If that includes the discovery or suggestion of a new principle, as well as the means of carrying it into effect,

(*q*) Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684.

(*r*) See judgment of Cotton, L.J., Automatic Weighing Machine Co. *v.* Knight, (1889) 6 P. O. R. 304-305; see also Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 P. O. R. 367; Automatic Weighing Machine Co. *v.* National Exhibitions Association, (1891) 8 R. P. C. 345; 9 R. P. C. 41, 44; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 527, 530.

an infringer is not entitled to take the principle although he uses somewhat different machinery for the application of it to a particular purpose. (*s*) If a patentee desires to claim a general principle he should in his own interest make it clear that he does so, (*t*) and he should be careful not to frame his claim so that it will be construed as one for a particular combination only. (*u*) Processes.

If a principle is not new, whether or not it has been successfully applied before does not matter, (*x*) a patent for a method of applying it only secures to the patentee protection in respect of the particular method specified, and there may be other perfectly valid patents in respect of different methods of carrying the same principle into effect. (*y*) Ambit of patent for carrying old principle into effect.

Thus it has been held that finishing hosiery and other goods by pressing them between rollers heated by steam was no infringement of a patent for finishing such goods by pressing them between flat-sided boxes filled with steam. (*z*)

## Processes.

The proposition that a method or process of itself and apart from the thing produced, or result, can be the subject-matter of a valid patent was finally established by the decision in *Crane* v. *Price*, (*a*) in 1842. Processes are subject-matter.

For some time prior to that decision there were many cases and dicta of the Judges indicating the general opinion that grants made in respect of such subject-matter were not invalid. *Abbot*, C.J., in *R.* v. *Wheeler*, (*b*) pointed out that the word "manufacture" "may perhaps extend to a new History of the cases.

(*s*) Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684; Consolidated Car Heating Co. *v.* Caine, (1903) 20 R. P. C. 767; Ashworth *v.* English Card Clothing Co., Ld. (1903) 20 R. P. C. 797, 798; Sandow *v.* Brooks, (1903) 21 R. P. C. 33, 333; 23 R. P. C. 6; Haskell Golf Ball Co. *v.* Hutchison, (1905) 22 R. P. C. 492.

(*t*) See p. 207 *post*.

(*u*) See Ackroyd and Best, Ld. *v.* Thomas, (1904) 21 R. P. C. 737.

(*x*) Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 673.

(*y*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113; Siddell *v.* Vickers, (1888) 5 R. P. C. 416; Needham *v.* Johnson, (1888) 5 R. P. C. 49; Bovill *v.* Pimm, (1856) 1 Ex. R. 718, 739; Barber *v.* Grace, (1847) 1 Ex. R. 339; 17 L. J. Ex. 122; Jupe *v.* Pratt, (1837), 1 W. P. C. 145; Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 *n.*; Lister *v.* Leather, (1857) 8 E. & B. 1004, 1033; Saxby *v.* Clunes, (1877) 43 L. J. Ex. 228; Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34; Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61; Hocking *v.* Hocking, (1889) 6 R. P. C. 76.

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

(*a*) 4 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81; see p. 55 *post*.

(*b*) (1830) 2 B. & Ald. 493.

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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 or more useful kind." In *Boulton* v. *Bull*, (c) the Court was divided in opinion, but *Eyre*, C.J., made the following remarks:

"It was admitted in the argument at the Bar that the word '*manufacture*' in the statute (*d*) was of extensive signification, that it applied not only to things made but to the *practice of making*, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us presume this admission. Under *things made* we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the *practice of making* we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art producing effects useful to the public. When the effect produced is some new substance or composition of things, it would seem that the privilege of the sole working or making ought to be for such new substance, or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. . . . When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, *for the process, if it be a new method of operating*, with or without old mechanism, by which the effect is produced. . . . In the list of patents with which I have been furnished there are several for *new methods* of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of time and expense, and thereby lowering the price of the article and introducing it into more general use. Now I think these *methods* may be said to be new manufactures. . . . The patent cannot be for the effect produced, for it is either no substance at all, or, what is exactly the same thing as to the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed; it must then be for the method; and I would say, in the very significant words of Lord *Mansfield*, in the great case of the copyright, (*e*) it must be for the method detached from all physical existence whatever."

(c) (1795) 2 H. Bl. 463; 3 Revised Reports, 439.
(d) 21 Jac. I. c. 3.
(e) 4 Burr. 2397.

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*Hall* v. *Jarvis* (*f*) decided that though the application of the flame of oil to remove the superfluous fibres from lace and other goods was a mere process, yet a patent for this invention could be upheld on the ground of subject-matter. In *Hill* v. *Thompson*, (*g*) Lord *Eldon*, L.C., stated that "there may be a valid patent for a new combination of materials previously in use for the same purpose, *or for a new method of applying such materials*." So also in *Morgan* v. *Seaward*, (*h*) *Parke*, B., said that the word "manufacture" in the statute (*i*) must be construed in one of two ways; it may mean the machine when completed, *or the mode of constructing the machine*; but in *Gibson* v. *Brand*, (*k*) *Tindal*, C.J., pointed out that it was not necessary in that case to go into the question whether or not a patent can be supported for a *process* only. If the specification were properly prepared it probably might be considered a fit subject for a patent.

Law settled by Crane v. Price.

*Crane* v. *Price*, (*l*) tried in 1842, finally settled the question. In this case the patent related to the use of anthracite or stone coal, in conjunction with a hot-air blast, for the smelting of iron, and the claim was in the following terms: "The application of anthracite or stone coal combined with the using of a hot-air blast in the smelting and manufacture of iron." In delivering the judgment of the Court of Common Pleas, *Tindal*, C.J., said:

> "The question becomes this, whether admitting the using of the hot-air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal to have been known before in the manufacture of iron with the cold blast, but that the combination of the two together (the hot-air blast and the anthracite) was not known before in the manufacture of iron—such combination can be the subject of a patent. We are of opinion that, if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination may well become the subject of a patent."

Decision in Crane v. Price doubtful upon the facts.

Though the above statement of the law by *Tindal*, C.J., in *Crane* v. *Price* has never been questioned, Judges have expressed doubts as to whether, upon the facts, the case was

(*f*) (1822) 1 W. P. C. 100, approved in Losh *v.* Hague, (1838) 1 W. C. P. 207, and Crane *v.* Price, (1842) 5 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81.
(*g*) (1817) 1 W. P. C. 237.
(*h*) (1837) 2 M. & W. 558.
(*i*) 21 Jac. I. c. 3, s. 6.
(*k*) (1841) 4 M. & G. 179; 1 W. P. C. 627.
(*l*) (1842) 4 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81.

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correctly decided. (*m*) Novelty of the result is, no doubt, evidence of invention in the process which produces it, but it is not necessarily conclusive evidence. (*n*) If the case were open to review on the facts, another Court would probably come to the conclusion that since the hot-air blast was known with bituminous coal, and the cold blast was in use with anthracite, and both processes were used for the manufacture of iron, the patent could not be supported; for all that the patentee did was to apply the hot blast in conjunction with anthracite to the manufacture of iron in a manner analogous to the former application of the hot blast to bituminous coal for the same purpose, and though the discovery was commercially very important, it was not one involving the exercise of invention. Further, the grant of the patent was an undue curtailment of the right of the public to use the hot blast in the manufacture of iron with bituminous coal, anthracite, or any other known fuel.

Sometimes in a patent case a conclusion may be arrived at in favour of the defendant by considering the infringement apart from the patent. If it can be shown that the alleged infringement is an act which, having regard to the state of public knowledge prior to the date of the patent, the public actually did or had the right to do (*i.e.*, passing from what was actually known or done to the act complained of involved no inventive step), the patentee cannot complain. He is in this dilemma, either the patent includes that which was actually done before or that which the public had the right to do—that is, something which involved no invention—in which case the patent is bad for want of novelty; or it does not include it, in which case the defendant is not an infringer.

The analogous case of Partington v. Hartlepools Pulp and Paper Co.

In *Partington* v. *Hartlepools Pulp and Paper Co.*, (*o*) which is somewhat analogous to *Crane* v. *Price*, it appeared that paraffin had been used to make wood-pulp pass more easily through the meshes of machines in which it was manufactured, and had also been used for the purpose of cleaning the machine from resin deposited from the pulp. The patentee discovered that if the machine were perfectly clean to start with, the addition of paraffin to the contents of the machine thus prevented the formation of objectionable specks of a pitchy or

(*m*) See Bamlett *v.* Picksley, (1875) Griff. 40; Rushton *v.* Crawley, (1870) L. R. 10 Eq. 522; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570.

(*n*) Steiner *v.* Heald, 6 Exch. 607; Booth *v.* Kennard, (1856) 1 H. & N. 527, 531; Higgs *v.* Goodwin, (1858) E. B. & E. 585.

(*o*) (1895) 12 R. P. C. 295.

resinous nature in the pulp, and also the partial coating or fouling of the machine. *Romer*, J., held that this commercially important discovery was not the subject-matter for a patent, since all the patentee claimed was to use the old process of adding paraffin, but in a clean machine where the process effected the additional advantages discovered by him. Had the patent been upheld the public would have been prevented from using the old process *with clean machines*, whether for the purpose of making the wood-pulp pass through the meshes as previously, or for the sake of the additional advantage discovered by the patentee. A patent which so curtailed the public right could not be supported. (*p*) Processes.

On the other hand, a new method of using an old machine in a manner not analogous to any use to which it has hitherto been put may, as the outcome of invention, be good subject-matter—*e.g.*, a new method of using an existing weaving machine requiring no structural alteration in the machine, but producing a novel and useful result. (*q*) New method of using old machine.

The strengthening, in a manner obvious when the desirability of strengthening is appreciated, of a part of a known or suggested combination of parts may be good subject-matter, if the performance of what is in fact a new and useful process is thereby rendered possible. For instance, the patent for the vacuum carpet cleaner, the subject-matter of which was not the mere general known but ineffective statement of a combination of extractor, dust collector, and pump at large, but the new and useful process comprising the use of an implement which sits lightly on the carpet so that there is practically similarity of vacuum both at the instrument end and at the filter end, which vacuum must be at least five pounds per square inch; (*r*) or *Lyons* patent for the process of disinfecting articles by subjecting them to contact with dry superheated steam in a container jacketed with superheated steam, when all that had to be done to effect the new process was to strengthen various parts of an existing apparatus. (*s*) Strengthening of a part.

A man cannot have a patent merely because he discovers the theory and reason of that which has before been done empirically. On the other hand, if by reason of knowing the theory he is enabled to make some improvements he may Discovery of theory of what was done before only empirically.

(*p*) See also Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; p. 78 *post*.

(*q*) Dowling *v.* Billington, (1883) 7 R. P. C. 191; see also p. 42 *ante*.

(*r*) British Vacuum Cleaner Co., Ld. *v.* Suction Cleaners, Ld., (1904) 21 R. P. C. 303.

(*s*) Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 334.

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take out a patent for those improvements, but he cannot have a patent to prevent others from using what they had used before, though empirically. (*t*)

Theory of action not part of consideration for patent.

A patentee, further, in his specification is under no obligation to give any theory of the action of a combination or process which he directs to be constructed or carried out, and he is not to be injuriously affected by the fact that he has given a wrong theory in the absence of a statement which, if acted upon, would lead to failure. (*u*)

Use on commercial scale of process used on small scale.

A process which results in a larger yield of a known article, when the new process is not an obvious one, may well form the subject-matter of a valid patent; (*v*) but it is not a patentable invention merely to adopt and use on a commercial scale a process which has been previously known and used to produce the same result on a small scale. (*x*)

Discovery of a hidden property or virtue.

The discoverer of a hidden and concealed virtue in something known before, which enables him to apply the known thing to some useful purpose of life to which it has not been applied before, is entitled to patent the novel application. Thus, in *Muntz* v. *Foster*, (*y*) it appeared that *Muntz*, by experiment, ascertained that a certain mixture of the alloy of zinc with copper in certain proportions, when made into plates and used for the purpose of sheathing the bottoms of ships, possessed great advantages over the ordinary copper plates previously in use for the same purpose, by reason of the plates of the alloy possessing the property of oxydating just in sufficient quantities—*i.e.*, not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep, by its wearing, the bottom of the vessel clean from those impurities which attached to it. *Muntz* obtained a patent for his invention, the title of which was "An improved manufacture of metal plates for sheathing the bottoms of ships or other vessels." The action was brought for the infringement of the patent, and the defendant objected to the validity on the ground (*inter alia*) that the invention above described was not subject-

(*t*) Patterson *v.* Gas Light and Coke Co., (1877) L. R. 3 App. Cas. 246; judgment of Lord Blackburn.

(*u*) See per Finlay, S.G., Dellwik's Patent, (1898) 15 R. P. C. 687; p. 202 *post*; Atkins and Applegarth *v.* Castner-Kelner Alkali Co., (1901) 18 R. P. C. 294; Badische Anilin, &c. *v.* Levinstein, (1887) 4 R. P. C. 449; Monnet *v.* Beck, (1897) 14 R. P. C. 817; Badische Anilin, &c. *v.* La Société Chemique des Usines du Rhone, (1898) 15 R. P. C. 368.

(*v*) Saccharin Corporation *v.* Chimical and Drug Co., (1899) 17 R. P. C. 28.

(*x*) Acetylene Illuminating Co. *v.* United Alkali Co., (1902) 19 R. P. C. 213; 20 R. P. C. 161; 22 R. P. C. 145.

(*y*) (1814) 2 W. P. C. 96; see also Newton *v.* Vaucher, p. 102 *post*.

matter; but the objection was not sustained. *Tindal*, C.J., in his charge to the jury, directed them thus (*z*): — Processes.

> "I cannot think, as at present advised, that if it was shown —as possibly it might be—that sheets had been made of metal before, in the same proportions which he has pointed out, that if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground—that is the opinion which I form upon it. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined, that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, such application has been considered as the ground, and a proper ground, of a patent; and therefore when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose."

Again, a valuable and validly claimed process for the extraction of gold from its ore, was founded on the discovery of the selective action possessed by a dilute solution of cyanide of potassium, and its application to the extraction of gold from ores in which other baser metals occur. (*a*)

In the case of the valuable patent for Lanolin, the patentee discovered that if wool-fat (which was known in the days of *Dioscorides*, and a preparation of which was then used as an unguent) be thoroughly freed from the constituent fatty acids and other impurities, the remaining cholesterine fats when kneaded with water possess a great capacity for taking up water, and yield the highly useful unguent Lanolin. The process formed the subject-matter of a patent, which was declared valid both by the Judge of first instance and the Court of Appeal. (*b*)

It is sometimes objected that to speak of a patentable process is in reality a misuse of terms, for the subject of the patent is *a manufacture according to a new process*, and therefore a new Objection to the term "patentable process."

(*z*) 2 W. P. C. 103.

(*a*) Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232.

(*b*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 11 R. P. C. 93, 261.

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manufacture. To take the above case of *Crane* v. *Price*, (*c*) the subject there was the manufacture of iron by a new process —*i.e.*, the combination of a hot-air blast and anthracite in the furnace.

This idea seems to have been in the mind of *Pollock*, C.B., when he gave judgment in *Stevens* v. *Keating*, (*d*) and made use of the words, "the real invention may be, not so much the *thing when produced*, as *the mode in which it is produced*; and its novelty may consist, not so much in its existence as a new substance as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt, and therefore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture; therefore, although I think this is a patent for the process rather than the product, I think it may be a patent for the product."

Bearing in mind, however, the very wide interpretation given to the word "manufacture" as used in the Act of James I., the exposition of which term, "as far as usage will expound it, has gone very much beyond the letter," (*e*) the above excuse by way of explanation becomes unnecessary. For instance, the word "manufacture" has a very wide and extended meaning, and may be interpreted "invention," (*f*) and it includes both process and result. (*g*) Lord *Westbury*, in discussing the meaning of the word, said, "By the large interpretation given to the word 'manufacture,' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced it will comprehend a new machine, or a new combination of machinery; it will comprehend a new process or an improvement of an old process." (*h*)

"Manufacture" is a wider term than "process," and for this reason a patentee, who desired to do so, was not allowed to amend his specification by altering the words *a process of*

(*c*) (1842) 2 M. & G. 580; p. 55 *ante*.
(*d*) (1847) 2 W. P. C. 182.
(*e*) Eyre, C.J., in Boulton *v.* Bull, (1795) 2 H. Bl. 463.
(*f*) Cornish *v.* Keene, (1835) 1 W. P. C. 508.
(*g*) Bush *v.* Fox, (1852) Macr. P. C. 176.
(*h*) Ralston *v.* Smith, (1865) 11 H. L. C. 223.

*preparing, &c.*, in a claiming clause to *the manufacture of, &c.*, since such an amendment would be contrary to the provisions of sub-sec. 8 of sec. 18 of the Patents Act 1883. (*i*)

Processes.

A reference to the cases will show that patents have again and again been granted and held valid for processes pure and simple. For example, the application of a known detonating powder to the discharge of known kinds of fire-arms was held (*k*) to be a patentable invention. And (*l*) a patent was granted and upheld for the application of metal plates, made in a known way, to ships and buildings, for the purpose of protecting them against fire by preventing the access of air. In the case of the *Electric Telegraph Co.* v. *Brett*, (*m*) a patent was upheld for a method of giving duplicate signals at intermediate stations; and in *Newall* v. *Elliott*, (*n*) where the patent was for improvements in apparatus employed in laying down submarine telegraph wires, and the claim was, "First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of the rings in continuation with the cone as described," the Court declared the patent valid, and overruled the objection that the invention claimed was merely a mode of coiling and paying out cables, and not a new manufacture, and therefore incapable of being the subject-matter of a patent.

Many patents have been granted for processes pure and simple. Examples.

A new process which consists merely in the omission of a step hitherto thought to be important from an old process may support a patent.

Thus a process for the manufacture of gelatine by cutting hides into thin slices and then submitting them in that state to the action of caustic alkali, whereby the use of blood, as in the method previously used, was rendered unnecessary, was declared to be subject-matter. (*o*)

And vegetable gas having been obtained from oils which were separated from seeds and other oleaginous substances by pressure, the discovery that the same gas might be distilled at once from the seeds, &c., without separating the oils, was held to be fit subject-matter, (*p*) though the patent was upset on other grounds.

(*i*) Vidal's Patent, (1898) 15 R. P. C. 721.

(*k*) Forsyth *v.* Riviere, (1819) 1 Carp. Rop. 401.

(*l*) Hartley's Patent, (1777) 1 W. P. C. 54.

(*m*) (1851) 1 C. B. 838.

(*n*) Newall *v.* Elliott, (1858) 13 W. R. 11.

(*o*) Wallington *v.* Dale, (1852) 7 Exch. 888.

(*p*) Booth *v.* Kennard, (1856) 1 H. & N. 527.

**Processes.**

Ambit of patent for a process.

Questions sometimes arise as to the ambit of patents for processes. As a result of the cases, (*q*) the wide dicta in the earlier of which were questioned in some of the later ones, it may be stated that when a patentee has discovered a process for arriving at a new result or product not known before—*i.e.*, the patent is a pioneer patent or master patent (*r*)—and in the specification there is described one process which is effectual for the purpose of arriving at that result, new at the time when the patent is taken out, the patentee will be protected against all other *analogous equivalent* processes for arriving at the same result, and no one can without infringing his patent adopt simply an equivalent process to achieve the same result. Where, on the other hand, the invention is a process which achieves what at the date of the patent is a known result, any other person may obtain another patent for any new though analogous process for arriving at the same result; or he may use any other process without infringing the patent first taken out. (*q*)

Per Lord Westbury, L.C.

Lord *Westbury*, L.C., in *Curtis* v. *Platt*, (*s*) referring to a patent for a new means of attaining an old object, laid down the law thus:—

> "If the invention be, as I have already described, nothing more than a particular means to attain a given result which is perfectly well known, then you can no more say that the invention of one distinct set of means interferes with the invention of another than you could say originally that there ought not to be patents for the inventions of distinct means to an end. I would illustrate it familiarly by this example. If we suppose a patent may be for a ladder to go down a pit, that patent may be made to comprehend all ladders, whether constructed of wood or of iron, or of hemp or of wire; but if another man invented a mode of letting men down the pit by a rope and pulley, it would be impossible to say that the one means of attaining that particular end was to be regarded as identical with or comprehended in the other. . . . It is extremely

(*q*) Jupe *v.* Pratt, (1837) 1 W. P. C. 145; The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 673; Curtis *v.* Platt, (1863) L. R. 3 Ch. 135 *n.*; L. R. 1 H. L. 337; Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) 2 R. P. C. 89; L. R. 24 Ch. D. 156; Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11; Gosnell *v.* Bishop, (1888) 5 R. P. C. 158; Bovill *v.* Pimm, (1856) 11 Exch. 718, 739; Barber *v.* Grace, (1847) 1 Exch. 339; 17 L. J. Exch. 122; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 304; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 519, 527; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, Ld., (1896) 13 R. P. C. 331; see pp. 51–53, *ante*.

(*r*) See chap. viii. *post*.

(*s*) (1863) L. R. 3 Ch. D. 139 *n.*

desirable that when a beneficial idea has been started by one man he should have the benefit of his invention, and that it should not be curtailed or destroyed by another man simply improving upon the idea; but if the idea be nothing in the world more than the discovery of a road to attain a particular end, it does not at all interfere with another man discovering another road to attain that end, any more than it would be reasonable to say that if one man has a good road to go to Brighton by Croydon, another man shall not have a road to go to Brighton by Dorking." Processes.

Lord *Halsbury*, L.C., in *Moore* v. *Thomson*, (*t*) referring to the ambit of Lord *Kelvin's* invention of a card for the mariner's compass—which was in fact the first card in which the principle or system of employing a very light card with the greater part of its weight thrown on to the periphery was successfully applied in practice with all the attendant advantages of reduction of frictional and other sources of error—and overruling the judgment of the Irish *Master of the Rolls*, who had construed the patent as being merely for a new means of attaining an old object, stated the law applicable to the case in like manner thus:— Per Lord Halsbury, L.C.

"Now what appears to me with all submission to be the fallacy, to be found in the very lucid and learned judgment of the *Master of the Rolls*, is that he has used the phrase 'a new instrument, and a new end, and a new means of attaining an old end,' as if those words in themselves were sufficient to explain the subject-matter to which he applied them. In certain relations those words may be sufficiently clear; but I will take the illustration which I think is that of Lord *Westbury* in one of the cases relied on, (*u*) in which he points out that the end and object (that is to say, the end in the Greek sense) of a ladder is to get down to the bottom of a pit, and that a man might have taken out a patent for a ladder which would include all sorts of instruments of that kind, but that, if somebody invented a mode of lowering a man to the bottom of a pit with a rope, that could not be said to be an infringement of a patent for any sort of ladder, and yet the end and object of the invention would be the same, to get to the bottom of the pit. When the *Master of the Rolls*, using the word 'end' in that sense, says that the end and object of both instruments here is to obtain a mariner's compass which shall, under all circumstances, as nearly as possible point to the true north, he

(*t*) (1890) 7 R. P. C. 332.
(*u*) See quotation from Lord Westbury's judgment in Curtis *v.* Platt, above.

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seems to me to omit to consider the machinery by which that is effected. I do not mean merely the construction of the particular machine, but he omits to consider that there may be new principles of construction by which that end is to be attained, as distinct as the lowering by a rope is from the lowering by a ladder. . . . The moment you come to apply yourself to see how this compass differs from all other compasses which have been hitherto in use, you perceive (at least it appears to me to be so, as a matter of fact, upon the evidence) that it is absolutely different from any compass which anybody has ever seen before. Upon principles, the ascertainment of which was the result undoubtedly of great study and wonderful powers of invention, Sir *William Thomson* found out that he could obtain those great things which had been pointed out as most material for the purpose of securing the steadiness of the needle, that which should keep the needle in its position, notwithstanding the rolling of the ship, in whatever direction it should take place, and he invented an instrument accomplishing that object. I think it is a fallacy to say that this is an old instrument; it is not an old instrument; it is a new instrument. It is an instrument in which the end is attained by certain expedients, by the weight being thrown on to the circumference, and being in the position in which it is and the weight of the whole compass card, as it is called, being reduced."

Upon the motion of his Lordship the House held that a compass card, which differed in its details from the card specified and claimed by the patentee, but resembled it in that it possessed the characteristics above described, which were the real substance of the invention, was an infringement of the patent.

## Products.

Is a patent for a product valid?

The question arises whether a grant of a patent for a product is valid. There is no reported case in which the point has been fully discussed and definitely decided, though there are dicta of various Judges which appear, at first sight at any rate, to be conflicting. (*x*)

The word "product" is defined in "Webster's Dictionary" as "anything that is produced, whether as the result of

(*x*) See Boulton *v.* Bull, (1795) Dav. P. C. 208; Ralston *v.* Smith, (1865) 35 L. J. C. P. 49; 11 H. L. C. 223; Vorwerk *v.* Evans, (1890) 7 R. P. C. 265; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297; Nobel's Explosives Co. *v.* Anderson, (1894-95) 11 R. P. C. 519; 12 R. P. C. 164; Riekmann *v.* Thierry, (1896) 14 R. P. C. 106; Lancashire Explosives Co. *v.* Roburite Co., (1896) 13 R. P. C. 429, 476; 14 R. P. C. 303; Kopp *v.* Rosenwald, (1902) 19 R. P. C. 211.

generation, growth, labour, or thought, or by the operation of involuntary causes, as the *products* of the seasons, or of the farm; the *products* of manufactures, the *products* of the brain." Products.

It is submitted that a patent for a product is valid when the claim of the patentee to the product involves a claim to the use of a newly invented art, (*y*) which is the real invention of the patentee; but a patent for a product would be bad in law, if the claim amounted to a claim to something which, though new, is not, in fact, the result of the exercise of an art invented by the patentee. When a claim for a product is good and when bad.

The following three hypothetical examples may be taken as illustrating the submission above made.

First, suppose a man finds a deposit of ore which is new to science, and contains a metal never isolated by chemists before. The discoverer of the ore applies to it a perfectly well-known process of refining and treatment which has been applied to other ores before, but he obtains, to his astonishment, the new metal, instead of what he expected, some known metal, *e.g.*, iron. Could he prevent, by means of a patent, other people from obtaining the new metal in the same way from similar ore, should they find it on their land? It is submitted he could not do so. The discoverer of the new ore could not have a patent for the application of the old process to the new-found ore, for it is *ex hypothesi* a mere analogous use, (*z*) though it yields a result which in a sense is new. To grant the man a patent which would enable him to stop others from applying the old process to the new-found ore, and so obtaining the new metal, would be unduly to curtail the right of the public to apply the old process to any ore which comes to their hands, and would surely be "mischievous to the State . . . by hurt of trade and generally inconvenient," and consequently void at Common Law, as stated in the sixth section of the Statute of Monopolies. (*a*) The new metal is not a new product, in the sense of an article made by a new art. In the words of *Cotton*, L.J., (*b*) "a thing is not to be called new, in the sense of *Crane* v. *Price*, simply because that particular thing has never been

(*y*) See p. 24 *ante*; see also Kopp v. Rosenwald, (1902) 19 R. P. C. 211.
(*z*) See p. 81 *post*.
(*a*) p. 3 *ante*.
(*b*) Blakey v. Latham, (1889) 6. R. P. C. 187; see also Thierry v. Rickmann, (1895) 12 R. P. C. 547-548; judgment of Kay, L.J.; Rockliffe v. Priestman, (1898) 15 R. P. C. 155.

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seen before. To be new, in a patent sense, it is necessary that the novelty must show invention."

Secondly, take the case of a man who by the exercise of invention produces a new machine—*e.g.*, a gig-mill, as in *Moser* v. *Marsden*. (*c*) This is a product produced as the result of labour and thought. The claim to the new machine is good. The real invention here was the arrangement, in combination, of parts forming the new and useful machine, and it is this *art* which is really protected by the claim to the product or machine.

Thirdly, take the case of a new chemical dye. Suppose a chemist by experiment finds a process of treating certain salts never treated in the same way before, and thereby obtains a new compound which is a valuable dye. After describing how he obtains the new product he could, no doubt, claim the product as a "new manufacture" within the Statute of Monopolies, provided that the claim to the product, when construed as it must be by reference to the specification as a whole, (*d*) is really a claim to the product produced substantially by the exercise of the new art or process which is the real invention, and the novelty of which is evidenced by the novelty of the result. (*e*)

In the first supposed case the claim to the new product could not be supported, because it does not involve a claim to any new invented *art;* whereas in the second and third cases the claim to the product could be sustained because it does involve a claim to a new invented *art*.

Ambit of legitimate claim to a new product,

It is submitted that a claim to a new product, which under the circumstances of the case is a legitimate one, does not secure to the patentee protection against all means or methods of producing it, which, upon a fair construction of the specification, have not been directly, or by analogy, described and claimed. That is to say, where the product legitimately claimed is a *new* one, the Courts would give to the patentee protection in respect of all means of producing the new product which could be fairly said to be analogous to the

(*c*) (1893–96) 10 R. P. C. 205, 350; 13 R. P. C. 24.

(*d*) p. 277 *post*.

(*e*) In Farbenfabriken vormals Friedrich Bayer & Co. v. Chemiche Fabrik von Heyden, (1905) 22 R. P. C. 501, the plaintiff's specification was construed as claiming, as a new manufacture, a new body (acetyl salicylic acid) quite apart from any process for producing it. The Court held the patent bad on the ground that the so-called new body was not new but was known at the date of the patent. The point that the claim to the product irrespective to any process for producing it, in itself, invalidated the patent does not appear to have been taken at the bar.

means or method described in the specification, but would not extend the ambit of the claim further. Combinations.

In the case of a claim to a new means or method of producing an *old* product the Courts restrict the patentee very closely to the new means or method described. (*f*) a new means of producing an old product.

## Combinations.

The art of combining two or more parts, whether they be new or old, or partly new and partly old, so as to obtain a new result, or a known result in a better, cheaper, or more expeditious manner, is valid subject-matter if it is presumable that invention in the sense of thought, design, or skilful ingenuity was necessary to make the combination. A new combination is subject-matter.

In fact, many of the most important inventions, from a practical and commercial point of view, are inventions of this kind, being merely the combination in a new way of new or old, or partly new and partly old, parts.

The *ratio decidendi* for holding valid such grants of letters patent is, that there is sufficient evidence of the presumption of thought, design, or skilful ingenuity in the invention and novelty in the combination. (*g*)

The merit of a new combination very much depends on the result produced. When a very slight alteration turns that which was practically useless into what is useful and important, the Courts consider that, though the invention was apparently small, yet the result being the difference between failure and success, it is fit subject-matter. (*h*) Thus, the mere placing of two flat wicks parallel to each other in an oil lamp, two concentric round wicks having been previously Merit depends largely on result produced.

(*f*) Cf. p. 53 *ante*.

(*g*) Boulton *v.* Bull, (1795) 2 H. & Bl. 487; Dav. P. C. 199; Bovill *v.* Moor, (1815) 2 Coop. App. Cas. 56; Dav. P. C. 361; 2 Marsh, R. 211; Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541; Huddart *v.* Grimshaw, (1803) Dav. P. C. 265; 1 W. P. C. 85; Lister *v.* Leather, (1857) 8 E. & B. 1004; 27 L. J. Q. B. 295; Hill *v.* Thompson, (1817) 1 W. P. C. 237; Lewis *v.* Davis, (1829) C. & P. 502; 1 W. P. C. 488; 1 Carp. P. C. 471; Saunders *v.* Aston, (1832) 1 Carp. P. C. 510; Carpenter *v.* Smith, (1841) 1 W. P. C. 538; Allen *v.* Rawson, (1845) 1 C. B. 551; Bovill *v.* Keyworth, (1857) 7 E. & B. 725; 29 L. T. 194; Spencer *v.* Jack, (1862–64) 3 De G. J. & S. 346; 11 L. T. N. S. 242; Morton *v.* Middleton, 1 Court of Session, 3rd series, 721; Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 251; Procter *v.* Bennis, (1887) L. R. 36 Ch. D. 740.

(*h*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 615; *Re* Bell's Patent, (1846) 1 Moo. P. C. N. S. 49; Wallington *v.* Dale, (1852) 7 Exch. 888; Moss *v.* Malings, (1886) 3 R. P. C. 373; Edison *v.* Woodhouse, (1887) 4 R. P. C. 79; Patent Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 549.

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combined, and flat wicks being perfectly well known, has been held sufficient to merit a patent; (*i*) so also has the substitution of a filament, carbonised before formation, for a thin rod in an incandescent electric lamp; (*j*) the alteration, in the shape of the handle of a tennis racket; (*k*) and the combination of a basin and chamber, formerly separated, forming an automatic-flushing device, which, for the purpose, was a great improvement on all others known at the date of the patent, since the combination allowed the putting in the chamber of a tipper so large that it protruded into the basin and gave a very strong vertical flow. (*l*)

In the words of *Tindal*, C.J., (*m*) there are numerous instances of patents which have been granted where the invention consisted in no more than the use of things already known and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public. (*n*)

Objection to the use of the word "combination" in Crane *v.* Price.

In *Crane* v. *Price* (*o*) a patent for a new combination of the use of the known hot-air blast with the use of the known anthracite or stone-coal in the process of smelting iron was declared valid by *Tindal*, C.J. (*p*) *James*, L J., in the case of *Murray* v. *Clayton*, (*q*) took objection to the use of the word "combination" by *Tindal*, C.J., in *Crane* v. *Price*, but agreed with the principle of the decision of the learned Chief Justice in the following words: "No doubt this case (*Crane* v. *Price*) has been questioned, but, if I may be permitted to say so, with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, is simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other

(*i*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 615.

(*j*) Edison *v.* Woodhouse, (1887) 4 R. P. C. 92; Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*k*) Moss *v.* Malings, (1886) 3 R. P. C. 373. But see 6 R. P. C. 232.

(*l*) Ducketts *v.* Whitehead, (1895) 12 R. P. C. 187, 376.

(*m*) Crane *v.* Price, (1842) 4 M. & G. 589; 1 W. P. C. 409.

(*n*) *E.g.*, Hall's Patent, (1817) 1 W. P. C. 97; Derosne's Patent, (1830) 1 W. P. C. 152; Hill's Patent, (1863) 3 Mer. 629; Daniell's Patent, Godson Pat. 274.

(*o*) (1842) 4 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81.

(*p*) But see p. 55 *ante*.

(*q*) (1872) L. R. 7 Ch. 570; L. R. 15 Eq. 115; 21 W. R. 498, 42 L. J. Ch. 191; see also Lyon *v.* Goddard, (1893) 10 R. P. C. 346.

Judge has ever questioned the principle upon which that case was decided."

Combinations.

When the result of a combination is "either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such a combination may well become the subject of a patent." (*r*)

A combination, the result of which is a new, better, or cheaper article than that produced by an old method, is good subject-matter;

For example, in *Hayward* v. *Hamilton*, (*s*) a patent for an improved pavement light was upheld by the Court of Appeal, under the following state of facts. Pavement lights, prior to the date of the patent, had been made by fastening in an iron frame, by certain ledges, certain lumps of glass of a rhomboidal or rectangular form, or sometimes in a bull's-eye shape. It occurred to the inventor that it would be a very good thing to take prisms such as were used in a camera obscura, and put the prism forms into an old iron frame, fitted in the old way. The consequence of this arrangement was that the perpendicular rays of light falling upon the horizontal surface were reflected from the inclined surface, and were so caused to enter into a room, cellar, or any other place that it was desired to illuminate. It was proved in evidence that prisms had been used as deck lights in ships, in cameras, and that a man named *Darke* had put one in the shutter for the purpose of directing an intense pencil of light to fall upon his work, whilst doing some fine metallic work, the rest of the room being dark. The Court of Appeal upheld *Hayward's* patent, on the ground that his pavement light was a new manufactured thing, and though all the parts were old, the introduction of the old prism constituted a new and improved result, and the combination was good subject-matter. The judgment of *Bramwell*, L.J., contains the following passage :—

> "It seems to me then that the plaintiff really is an inventor; he has found out something. He makes an article that was not made before. This particular case may be, no doubt, upon the verge, but one cannot help making this remark, that it is very strange, if it is no invention, that it has never been done before. Why has it never been done before? Why, because nobody had found it out, which I take to be equivalent to invention."

In *Morgan* v. *Windover*, (*t*) the House of Lords held a

(*r*) Per Tindal, C.J., Crane *v.* Price, 1 W. P. C. 409; see also Murray *v.* Clayton, (1872) L. R. 7 Ch. 584; 1 W. P. C. 71 *n.*: p. 163 *post.*

(*s*) (1879-81) Griff. P. C. 115.

(*t*) (1888) 7 R. P. C. 131.

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patent bad for applying "C" springs to the front wheels of a carriage when they had been previously applied to the back wheels. The case was decided on the view that what was claimed was not a new combination of "C" springs on both back and front wheels, but the mere analogous use of the old "C" spring as regards the front wheels, it having been used on the back wheels. Had the claim been for the new combination, the patent might possibly have been supported on the above principle.

In *Fawcett* v. *Homan*, (*u*) the patentee produced by a new and useful combination of old parts a self-supporting concrete floor not abutting on lintels, which, if the lintels were removed, would still be a fire-proof floor. The Court of Appeal reversing the Court below held that the objections of want of novelty and subject-matter urged against the patent failed.

also a new combination which attains an old result in a simpler manner.

A combination of parts which attains an old result in a manner similar to that in which a previous known combination attained it, but which is simpler and more direct in its operation, is good subject-matter—*e.g.*, a combination of detector mechanism in a machine for winding, doubling and twisting yarn or thread, whereby a detector lever was enabled to stop the winding at once on the breaking of a thread without the intervention of any intermediate parts. (*x*)

New combination of materials previously used for same purpose, or new method of applying such materials, may be good subject-matter.

A new combination of materials previously in use for the same purpose, or a new method of applying such materials, will support a patent, but the inventor must claim only the new combination, under pain of vitiating his grant. (*y*) The combination must also be the outcome of invention. The mere addition to a well-known article of an old and well-known part for an old and well-known purpose without invention will not do. (*z*)

Claim to use of an old thing in a particular combination.

When a thing is old, but has not been used for the particular purpose for which the patentee uses it, a claim may be valid for its use in the particular combination described, but the patentee will be strictly limited to the particular arrangement shown. Thus, where a friction clutch or

(*u*) (1896) 13 R. P. C. 268, 398.

(*x*) Boyd *v.* Horrocks, (1886-89) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

(*y*) Hill *v.* Thompson, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; Murray *v.* Clayton, (1872) L. R. 7 Ch. 584; Patents Exploitation, Ld. *v.* American Electrical Novelty and Manufacturing Co., Ld., (1903) 20 R. P. C. 697; Patent Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1902) 20 R. P. C. 225; 21 R. P. C. 541; chap. v.

(*z*) Wood *v.* Raphael, (1896) 13 R. P. C. 730.

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apparatus was old, but had never been previously employed in a hoisting machine, the House of Lords held a patent valid which claimed protection for an arrangement by which the friction clutch was adapted to and employed in a hoisting machine, but the House held also that the patentee could not patent the mere idea of so employing it, or obtain a monopoly of its use in such a machine, apart from the particular method of using it which he described. (*a*)

Novelty of parts not necessary.

Each of the parts of which the combination consists may, in itself, be old, (*b*) or some of the parts may be old and some new, (*c*) or the whole of the parts may be new. (*d*)

If a new combination consists of some new parts, together with others which are old, or entirely of new parts, the patentee may claim as his invention the combination as a whole, and also each of the new parts separately, but a claim to the combination will not entitle him to a new part separately, nor will a claim to a new part separately entitle him to the combination. (*e*)

In what a new combination may consist.

A new combination which will support a patent may consist merely in the omission of something from an old combination, when that something was previously thought to be essential, and the omission required the exercise of invention on the part of the person making it; (*f*) or similarly it may consist in the addition to an old combination of a part (*g*) even though previously used for a similar purpose; (*h*) if making the addition was an act of invention (*i*)—*e.g.*, if the addition of a device to an old combination enables results to be attained that could not be attained before. (*k*)

(*a*) Morris *v.* Young, (1895) 455, 462.

(*b*) Lister *v.* Leather, (1857) 8 E. & B. 1004; 27 L. J. Q. B. 295; Bovill *v.* Moor, (1815) 2 Coop. App. Cas. 56; Dav. P. C. 361; 2 Marsh R. 211; Bovill *v.* Keyworth, (1857) 7 E. & B. 725; 3 Jur. N. S. 817; Crane *v.* Price, (1842) 4 M. & G. 580; 1 W. P. C. 377; 12 L. J. C. P. 81.

(*c*) Potter *v.* Parr, 2 B. & S. 216 *n.*; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 327; Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61.

(*d*) Lister *v.* Leather, 2 El. & Bl. 1004; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 327.

(*e*) p. 256 *post*; Lister *v.* Leather, (1857) 8 El. & Bl. 1004; 27 L. J. Q. B. 295; Foxwell *v.* Bostock, (1863) 12 W. R. 723; 4 De G. J. & S. 298; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Clark *v.* Adie, (1873) 2 App. Cas. 328; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 239.

(*f*) Russell *v.* Cowley, (1834) 1 W. P. C. 459; 1 Cr. M. & R. 864; Minter *v.* Mower, (1835) 6 A. & E. 703; 1 W. P. C. 142; Booth *v.* Kennard, (1856) 1 H. & N. 527; 2 H. & N. 84; Saxby *v.* Gloucester Waggon Co., (1881) L. R. 7 Q. B. D 305; 50 L. J. Q. B. 577; Pneumatic Tyre Co. *v.* Tubeless Tyre and Capon Heaton, Ld., (1897) 15 R. P. C. 74, 237; 16 R. P. C. 77.

(*g*) Morris *v.* Bransom, (1776) 2 W. P. C. 51; Bull N. P. 76.

(*h*) Vickers *v.* Siddel, (1890) L. R. 15 App. Cas. 496; 7 R. P. C. 292.

(*i*) *Ibid.*; p. 70 *ante*; Wood *v.* Raphael, (1896) 13 R. P. C. 730.

(*k*) Moser *v.* Marsden, (1895) 13 R. P. C. 30.

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The parts of which a combination consists may be old or new processes, and the combination of such processes will support a patent if the result be new and useful. (*l*)

Thus in *Cannington* v. *Nuttall*, (*m*) *Pocheron's* patent for "improvements in the manufacture of glass" was upheld by the House of Lords on the ground of subject-matter. The invention consisted in the combination of a tank, instead of pots, the fire placed laterally to the tank instead of immediately beneath it, and a channel formed all round the tank in order that the atmospheric air might circulate freely and exert a cooling effect. Lord *Westbury*, in moving the judgment of the House, said: "Now, the only thing that appears to have been regarded by the patentee as a new discovery (apart from the apparatus) was the application of the external air to the sides of the tank. It was a discovery, certainly, but it was a thing for which, independently of the other apparatus, probably no patent could have been obtained. . . . The refrigerating effect of the air upon the sides of the tank was not a thing for which, *per se*, a patent could be claimed; but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air, so as to produce a most useful effect, constitutes an invention to which the merit of novelty attaches, and for which a patent may be taken out."

Special rearrangement of old parts.

A special rearrangement of old parts acted upon as described by the patentee may constitute a new combination, which will support a patent—*e.g.*, *Birch's* sewing machine, (*n*) or *Evans'* mattress, the novelty of which consisted in the arrangement of the coiled supporting springs in an oblique or diagonal position, and in opposite directions from the centre of each end, in such a manner as to direct the tension from all the springs on to the middle portion of the wire mesh: whereas formerly such springs had been arranged parallel with the length of the mattress. (*o*) The combination of known ingredients so arranged as to satisfy definite conditions, the combination of the ingredients in the manner and form pointed out in the specification being new, is good subject-matter. (*p*)

(*l*) Cannington *v.* Nuttall, (1871) L. R. 5. E. & I. App. 205; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241.

(*m*) (1871) L. R. 5 E. & I. App. 205.

(*n*) Birch *v.* Harrop, (1896) 13 R. P. C. 615; see p. 70 *ante*.

(*o*) Evans and Taunton, Ld. *v.* Hoskins and Sewell, Ld., (1904) 21 R. P. C. 675.

(*p*) Patent Exploitation Co., Ld. *v.* American Electrical Novelty and

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Definite relative arrangement of parts.

A definite relative arrangement of parts may also be of the essence of the invention in the case of a new combination by placing the parts in particular positions. (*q*) But in one case (*r*) it was held that, on the facts, there was no invention in altering the position of the centre of a bent lever in an old combination, and in another case (*s*) it was no invention to substitute a pivot for a hinge in a nail-punching machine. Neither is there invention in merely relatively altering parts which have been used in combination for an analogous purpose before. (*t*)

Substitution of equivalents in prior combinations.

A combination which differs only from a previous combination in that there is substituted an equivalent part or process in the place of some part or process found in the prior combination, is good subject-matter when the equivalent part or process judged by the standard of public knowledge at the date of the prior patent is not obviously and demonstrably an equivalent, (*u*) but if the equivalent judged by the standard of public knowledge at the date of the patent is obviously an equivalent the mere substituting it in the combination would most probably be an infringement, and is not subject-matter for a fresh patent. (*x*)

Examples of patents held void as being merely for substitution of known equivalents.

The following may be taken as instances of patents which have been held void on the ground of lack of subject-matter, the novelty being merely the substitution of one equivalent for another in an old combination of parts or processes, and requiring the exercise of no invention. *Rushton's* patent for "improvements in the manufacture of artificial hair," which consisted of the use of Russian tops or similar wool in the manufacture of chignons, which were formerly made from

Manufacturing Co., Ld., (1903) 20, R. P. C. 697; Patent Exploitation Co. Ld. *v.* Siemens Brothers & Co., Ld., (1902) 20 R. P. C. 225; 21 R. P. C. 541.

(*q*) Muirhead *v.* Commercial Cable Co., (1894) 12 R. P. C. 54; see Reason Manufacturing Co. *v.* Ernest F. May, Ld., (1902) 19 R. P. C. 409; 20 R. P. C. 205.

(*r*) Herrburger *v.* Squire, (1889) 6 R. P. C. 194.

(*s*) United Horse-shoe and Nail Co. *v.* Swedish Horse-nail Co., (1889) 6 R. P. C. 1.

(*t*) Savage *v.* Harris, (1896) 13 R. P. C. 364.

(*u*) Unwin *v.* Heath, (1855) 5 H. L. Cas. 505, 522, 543; Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) 2 R. P. C. 90; see p. 353 *post*.

(*x*) See p. 353 *post*; Bateman *v.* Gray, (1853) Macr. P. C. 102; Electric Telegraph Co. *v.* Brett, (1851) 10 C. B. 838; 20 L. J. C. P. 123; Ormson *v.* Clarke, (1862) 13 C. B. 339; 14 C. B. 490; Stevens *v.* Keating, (1847) 1 Ex. R. 339; 17 L. J. Ex. 122; Gamble *v.* Kurtz, (1846) 3 C. B. 435; Walton *v.* Potter, (1841) 1 W. P. C. 586; Russell *v.* Cowley, (1834) 1 W. P. C. 463; Morgan *v.* Seaward, (1836) 1 W. P. C. 171; Bovill *v.* Moore, (1815) Dav. P. C. 405; Hill *v.* Thompson, (1818) 1 W. P. 242; R. *v.* Lister, (1826) Webster on Patents, 80; Hancock *v.* Moulton, (1852) Johns. Pat. Man. 6th ed. 251; Cochrane *v.* Braithwaite, 3 Lon. Journ. N. S. 42; Neilson *v.* Harford, (1841) 1 W. P. C. 310.

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mohair. (*y*) *Amet's* patent for "improved means of distending articles of dress," which consisted in making the hoops of a petticoat of steel instead of whalebone. (*z*) *Horton's* patent for "improvements in the construction of gas-holders," which consisted in forming a joint of double-angle iron instead of two pieces of single-angle iron. (*a*) *Parkes'* patent for "improvements in lamps," which consisted in the substitution of a hinge for a slide in a known glass lamp. (*b*) *Fletcher's* patent for "improvements in apparatus for cooking and heating by means of gas," which consisted merely in the substitution of a hinge for a slide. (*c*) *Jensen's* patent for "improvements in oil boxes or lubricators for revolving and other parts of machinery," which consisted in the alteration of a known combination of an oil-box with a piston actuated by a screw for the purpose of forcing the oil out, by substituting in the place of the piston a screw filling the whole of the box. (*d*) *Brunton's* patent for "improvements in the manufacture of ship's anchors," &c., which consisted merely in making the two flukes in one with a thickness of metal in the middle sufficient to pierce with a hole for the insertion of the shank instead of joining the flukes by welding them to the shank, as was done formerly. (*e*) *Tickelpenny's* patent for "improvements in, and connected with, the construction and support of fire-proof floors and ceilings," which consisted merely in filling known hollow iron columns with water. (*f*) *Brown's* patent for "improvements in punching nails for shoeing horses and other animals," which consisted merely in the substitution of a pivot for a hinge in a nail-making machine. (*g*) *Winby's* patent for "improvements in points and crossings for tramways," which consisted in the introduction of a spring for a weighted lever in a switch arrangement for a tramway crossing. (*h*) *Nuttall's* patent for a beer barrel tap, which substituted a gauze strainer for a

(*y*) Rushton *v.* Crawley, (1870) L. R. 10 Eq. 522.

(*z*) Thompson *v.* James, (1863) 32 Beav. 570.

(*a*) Horton *v.* Mabon, (1862-64) 16 C. B. N. S. 141; 31 L. J. C. P. 255.

(*b*) Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358.

(*c*) Fletcher *v.* Arden, (1888) 5 R. P. C. 46.

(*d*) Jensen *v.* Smith, (1884) 2 R. P. C. 249.

(*e*) Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541.

(*f*) Tickelpenny *v.* Army and Navy Co-operative Society, (1888) 5 R. P. C. 405.

(*g*) United Horse-shoe and Nail Co. *v.* Swedish Horse-nail Co., (1888) 6 R. P. C. 1; See also Deutsche Nähmaschinen Fabrik Vorm Wertheim *v.* Pfaff, (1890) 7 R. P. C. 251.

(*h*) Winby *v.* The Manchester, &c., Steam Tramways Co., (1890) 8 R. P. C. 61.

metal strainer to keep impurities floating in the beer out of the tap. (*i*)

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Improvement may be subject-matter.

If a man takes an existing and already known manufacture, *e.g.*, a machine or process, and by the exercise of invention makes an alteration, which really is novel and an improvement, whether it be the addition to, (*k*) the omission from, (*l*) or only the rearrangement of (*m*) old parts, the alteration so made is a fresh arrangement. It is now established beyond doubt that such an improvement, provided that it be new and useful, may be the subject-matter of a patent. (*n*)

As was pointed out by Lord *Mansfield*, (*o*) if there could be no patent for an improvement on an existing invention, that objection would go to repeal almost every patent that was ever granted.

Patentee of improvement may not be able to use original invention without licence.

Though an improvement on the subject of a prior and existing patent may be the subject of a second, the second patentee must wait till the expiration of the first grant before he can use the prior invention without the licence of the prior patentee. (*p*)

Argument against legality of patents for improvements.

It may be argued that if a subsequent patent for a combination includes part of an invention already protected it infringes on the property of another, and so is a violation of his right, and ought to be held illegal on account of his interest, and further because the second patent prolongs the monopoly granted by the first. The following

(*i*) Nuttall *v.* Hargreaves, (1891) 8 R. P. C. 273, 450.

(*k*) Morris *v.* Branson, (1776) Bull, N. P. 76; 1 Carp. P. C. 30; 1 W. P. C. 51; R. *v.* Arkwright, (1785) 1 W. P. C. 71; Boulton *v.* Bull, (1795) 2 H. Bl. 463; Dav. P. C. 162; Hornblower *v.* Boulton, (1799) Dav. P. C. 221; 8 T. R. 95; *Ex parte* Fox, (1812) 1 V. & Br. 67; 1 W. P. C. 431; Bovill *v.* Moore, (1815) 2 Coop. Ch. Ca. 56; Dav. P. C. 361; 2 Marsh, R. 211; Lister *v.* Leather, (1857) 8 E. & B. 1017; Ralston *v.* Smith, (1865) 11 H. L. C. 223; Fox *v.* Dellestable, (1866) 15 W. R. 195; Moser *v.* Marsden, (1895) 13 R. P. C. 30.

(*l*) Russell *v.* Cowley, (1843) 1 W. P. C. 463, 465; Wallington *v.* Dale, (1852) 7 Exch. 888; Booth *v.* Kennard, (1856) 1 H. & N. 527.

(*m*) p. 72 *ante*.

(*n*) R. *v.* Arkwright, (1785) Dav. P. C. 61; 1 W. P. C. 64; Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. & Mo. 448; 1 W. P. C. 232; Lewis *v.* Davis, (1829) 3 C. & P. 502; Boulton *v.* Bull, (1795) 2 H. Bl. 469; Harmar *v.* Playne, (1809) 11 East, 101; Crane *v.* Price, (1842) 1 W. P. C. 410.

(*o*) Morris *v.* Bransom, (1776) Bull, N. P. 76; 1 W. P. C. 51.

(*p*) *Ex parte* Fox, (1812) 1 V. & B. 67; 1 W. P. C. 431 *n.*; Fox *v.* Dellestable, (1866) 15 W. R. 195; Crane *v.* Price, (1812) 4 M. & G. 580; 1 W. P. C. 410; 12 L. J. C. P. 81; Lister *v.* Leather, (1857) 8 E. & B. 1017.

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words of Lord *Campbell* form a complete answer to this contention:—

> "The patent for an improvement on an invention, already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without licence, would be an infringement; but with licence, that also would be lawful, as in constant experience. Indeed, the objection was carried to the extent that a patent for an improvement on a patented invention of the same patentee would be void; but this rests only on the assumption that the improvement cannot be distinguished from the invention on which it is made. The assertion that all patents for improvements on existing patents must be void is obviously untenable. The third argument on this point, that a patent for an improvement on a patent is void as contrary to policy because it prolonged the monopoly granted by the first, till the last expired, is already virtually answered. The monopoly in the second patent is for the improvement only; and the use of the former invention without the improvement is free at the expiration of the first patent." (*q*).

Patent for improvement no proof of inutility of original invention.

The fact of a patent for an improvement on an existing invention having been obtained is not proof of the inutility of the original patent, and does not throw the original invention open to the world. (*r*)

Ambit of patent for improvement.

If a person obtains a patent for an improvement on a known process, he is protected against the use of his improvement with the original process, however much it is further altered and improved by subsequent discoveries, so long as it remains substantially the same. (*s*)

Patentee must claim only the improvement.

The patentee of an improvement must be very careful not to lay claim in his specification to the old art or invention which he alleges he has improved, but he must limit his claim to the new art or invention produced by his labour; otherwise he will render his patent void, as claiming in part that which is not new. (*t*)

(*q*) Lister *v.* Leather, (1857) 8 E. & B. 1017.

(*r*) Thomson *v.* Batty, (1889) 6 R. P. C. 100; Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*s*) Electric Telegraph Co. *v.* Brett, (1851) 10 C. B. 881.

(*t*) p. 251 *post*; Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Mo. 448; 1 W. P. C. 229; Bovill *v.* Moor, (1815) 2 Marsh. 211; Dav. P. C. 361; Minter *v.* Mower, (1835) 1 W. P. C. 142; Williams *v.* Brodie, (1785) Dav. P. C. 26; 1 W. P. C. 75; Hornblower *v.* Bolton, (1799) 8 T. R. 103; Jessop's Case, 1 W. P. C. 42 *n.*; Dav. P. C. 182, 203; Crane *v.* Price, (1842) 1 W. P. C. 413; (1857) Lister *v.* Leather, 8 E. & B. 1004; Kynoch *v.* Webb, (1899) 17 R. P. C. 100, 108.

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Thus if the real invention is an improvement on an existing machine, the claim must be for the improvement, and must not include a claim to the old machine, which would render the patent bad; (*u*) and, moreover, the patentee's exclusive right cannot be permitted to exceed the exact terms of his claim as construed with reference to the rest of his specification. (*x*)

Invention necessary to support a patent for an improvement.

In order that an improvement may be good subject-matter it is absolutely necessary that there be the presumption of some degree of invention having been required to make the improvement. (*y*) Thus, in the case of a patent granted to *J. White* for "improvements in ladies' mourning bonnet and hat falls," which claimed forming both sides of ladies' mourning bonnet and hat falls alike by applying thereto the fold above the bottom fold on each side thereof, as explained, the patent was held void on the ground of want of invention, *Malins*, V.C., saying: "Whereas formerly the fold was sewn on one side only, now it is sewn on both sides, so that whichever way it is turned it has a good side outwards. There is no invention in it. However meritorious as an improvement, which might probably have been registered for one or two years, it is not the subject of a patent." (*z*)

Mere working direction though valuable is not subject-matter.

So, an improvement which consists merely in the application of a more skilful and efficient mode of working a known process will not be subject-matter when the application is obvious. (*a*) Thus, in *Patterson* v. *The Gas Light and Coke Co.*, (*b*) in reference to a claim in the specification of a patent for "improvements in the purification of coal gas," which claimed "a method or system of employing lime purifiers in the manner hereinbefore described, whereby the contents of all the said purifiers, or of any required number of them, can be converted into sulphides of calcium, and also (if required) be maintained in that condition," *James*, L.J., delivering the judgment of the Court of Appeal, said:—

Per James, L.J.

> "There is in that no suggestion of any new apparatus—of any new process. There is no device or scheme of any kind. Lime purifiers in succession were in general, almost universal,

(*u*) Leggott *v.* McGeoch, (1893) 10 R. P. C. 429, 435; p. 251 *post*; Kynoch *v.* Webb, (1899) 17 R. P. C. 100.

(*x*) See judgment of Lord Watson, Brown *v.* Jackson, (1895) 12 R. P. C. 324; Kynoch *v.* Webb, (1899) 17 R. P. C. 100.

(*y*) Blakey *v.* Latham, (1889) 6 R. P. C. 188; Thierry *v.* Riekmann, (1895) 12 R. P. C. 548; 14 R. P. C. 105.

(*z*) White *v.* Toms, (1867) 37 L. J. Ch. 204.

(*a*) Tetley *v.* Easton, (1857) 2 C. B. N. S. 706.

(*b*) (1875) L. R. 2 Ch. D. 834.

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use wherever lime could be freely used. . . . What he (the patentee) claims to have discovered is, that if the carbonic acid, which is the first thing taken up by the lime, is not wholly taken up at the beginning, and is allowed to enter the last purifier or purifiers, it *in fact poisons the latter*, decomposes the sulphide of calcium already formed, disengages the other sulphur absorbed by the sulphide, and of course fills the gas again with the sulphur impurities which had been removed. This is a very valuable working caution and direction, but it is impossible to make anything more of it than a working caution and direction. It really amounts to nothing more than a direction to be sufficiently liberal in the use of the caustic lime in the first stage, and an instruction that the moment it is so far carbonated as not to arrest the carbonic acid it should be removed and a fresh supply of lime got. It may be a direction and an instruction of the greatest possible value and utility, but it is utterly impossible to make such a direction and instruction, however valuable, the subject of a patent."

Per Lord Blackburn.

The decision of the Court of Appeal was affirmed by the House of Lords, and Lord *Blackburn* observed :—

"*The appellant appears*, from what he says in his specification, to be of opinion that, if he first discovered the theory and reason of that which had before been done empirically, he is entitled to a patent. I need hardly point out that this is a mistake; if by reason of knowing the theory he is enabled to make some improvements, he may take out a patent for those improvements, but he cannot take out a patent to prevent others using what they had used before, though empirically." (*c*)

More use of known machine in a more beneficial manner is not subject-matter.

In another case it appeared that in the process of calendering woven fabrics the use of a roller and a bowl, and the method of regulating the relative speed of their motions, were well known at the date of the patent. In the process of *calendering* a smooth roller was used, and the speeds of the roller and bowl were different, whilst in the process of *embossing* a roller with a pattern on it was used, and the speeds of the roller and bowl were equal. A patent was obtained for a combination of a patterned roller with a bowl, the roller and bowl moving at unequal speeds. It was held by the Court of Common Pleas and the House of Lords that the alleged invention was not the proper subject-matter of a grant of letters patent, as it was nothing more than the use

(*c*) L. R. 3 App. Cas. 246, p. 56 *ante*.

of an existing machine in a more beneficial manner than previously. (*d*)

Improvements.

Neither is there invention in a mere adaptation of a well-known idea, in a well-known manner, for a well-known purpose, without ingenuity, though the adaptation effects an improvement, which supplants articles already in the market, and is commercially very successful. (*e*) Nor is there invention in what is merely a more skilled application of well understood tools and processes, though the alleged inventor is thereby able to satisfy a want felt by persons in a particular trade. (*f*)

Mere adaptation of a well-known idea is not subject-matter.

It is to be noticed that an improvement in the sense in which the word has been used in the foregoing pages is not always the subject of the invention when the word is used in the title of letters patent—*e.g.*, the title may be "improvements in the manufacture" of a certain article, the object being either the production of the article of a better quality, or at a lower price, and yet the means by which that object is attained may be some entirely new art, or some machine totally different from anything before known or used for the manufacture of that article. Such a title may refer to novelty in a machine, novelty in an improvement on a machine, or a new combination. (*g*)

Meaning of "improvement" as used in titles of letters patent.

When an invention is an improvement on an existing invention the amount of the improvement does not affect the validity of a patent granted in respect of it; if there is an improvement, however small, which is the outcome of invention, that is quite sufficient to support the patent. (*h*)

Amount of improvement does not affect validity.

In *Sykes* v. *Howarth*, (*i*) a patent for "improvements in fancy rollers of machines for carding wool and other fabrics" was held valid. Before the invention, the machines used for carding wool, &c., consisted of a series of large cylinders on which smaller cylinders revolved, the last of the series of smaller cylinders termed a "fancy roller" was used to raise the fibre on the surface of the larger roller. The rollers were covered with "cards" (strips of leather thickly studded with short wires). These cards were cleaned by means of a hand-scraper, a method objectionable because of the fact that the

Examples.

(*d*) Ralston *v.* Smith, (1860) 9 C. B. N. S. 117; 11 H. L. Ca. 223.

(*e*) Longbottom *v.* Shaw, (1888–91) 5 R. P. C. 497; 6 R. P. C. 143; 8 R. P. C. 333; Carter *v.* Leyson, (1902) 19 R. P. C. 473.

(*f*) Dredge *v.* Parnell, (1899) 16 R. P. C. 625.

(*g*) See p. 265 *post*.

(*h*) See Alderson, B., in Morgan *v.* Seaward, (1836) 1 W. P. C. 172, 186.

(*i*) (1879) L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; see also Murray *v.* Clayton, (1872) L. R. 7 Ch. 570.

Improvements.

person using the scraper had to stand at the side of the machine, and was therefore unable to draw the scraper in an exact line with the "gates" of the "cards" (passages between the wires), and some cards were liable to be injured. The improvements for which the patent was granted consisted in the introduction of wide spaces between the cards, which produced an exhaust current of air, and made the rollers operate in their function as fancy rollers. Also the fancy rollers were applicable and employed for cleaning the other card-covered cylinders.

In *Heath* v. *Unwin*, (*k*) the defendant was charged with infringing the plaintiff's patent, which was for "certain improvements in the manufacture of iron and steel," consisting, *inter alia*, in the use of carburet of manganese in any process, whereby iron is converted into cast steel. The alleged infringement consisted in the substitution of the elements of carburet of manganese in the place of the carburet of manganese itself in the plaintiff's process. The evidence showed that the elements combined first in the crucible and formed carburet of manganese, which then acted on the iron in the same way as the ready formed carburet of manganese introduced according to the plaintiff's original process. The Court of Exchequer Chamber, taking this view of the evidence, reversed the decision of the Courts below, and held that the process had been infringed; but the House of Lords, having had the assistance of the opinions of the Judges, (*l*) reversed the decision of the Court of Exchequer Chamber. The process, as carried out by *Unwin*, was a great improvement on that mentioned in the plaintiff's patent, being much neater and effecting a considerable reduction in the cost of the steel; and it was held to be no infringement of the plaintiff's process, and would, therefore, probably have of itself formed the subject of a patent.

### New Uses of Old Appliances.

New use of old appliance may be subject-matter.

The question whether a new use of an old appliance is competent to form the subject-matter of a valid patent must in each particular instance be answered in the affirmative or negative according as invention and ingenuity are present or absent in the new application. (*m*)

(*k*) (1843) 2 W. P. C. 216, 218, 221, 223, 228, 236, 279; 5 H. L. 505.
(*l*) (1854) 2 W. P. C.; 5 H. L. C. 505.
(*m*) See pp. 30–42 *ante*.

New Uses of Old Appliances.

If the new use requires no exercise of invention, *i.e.*, if it is merely analogous to a use of the known thing made before, then a patent cannot be validly granted in respect of it; (*n*) but if the new use is one which lies so far outside and removed from those previously made as necessarily to imply the exercise of invention it will be perfectly good subject-matter. (*o*)

Result of cases referring to new uses stated by Lindley, L.J.

Lord *Lindley*, then *Lindley*, L.J., referring to the numerous cases bearing upon new uses of old things, stated the result of them thus:

"These cases, and many others which might be cited, establish the following propositions:

1. A patent for the mere new 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

(*n*) Losh *v.* Hague, (1838) 1 W. P. C. 207; R. *v.* Cutler, (1816) 14 Q. B. 372 *n.*; Macr. P. C. 133; Tetley *v.* Easton, (1852) 2 C. B. N. S. 706; 26 L. J. C. P. 269; Patent Bottle Envelope Co. *v.* Seymer, (1858) 5 C. B. N. S. 164; 28 L. J. C. P. 22; 5 Jur. N. S. 174; Kay *v.* Marshall, (1839) 2 W. P. C. 71, 79; Horton *v.* Mabon, (1862) 31 L. J. C. P. 255; 12 C. B. N. S. 437; 16 C. B. N. S. 141; Ormson *v.* Clarke, (1862) 32 L. J. C. P. 8; 13 C. B. N. S. 337; 32 L. J. C. P. 291; 14 C. B. N. S. 475; Willis *v.* Davison, (1863) 1 N. R. 234; Harwood *v.* G. N. Ry. Co., (1860) 2 B. & S. 194, 222; 11 H. L. C. 654; Ralston *v.* Smith, (1865) 11 H. L. C. 223; Jordan *v.* Moore, (1866) L. R. 1 C. P. 624; Parkes *v.* Stevens, (1869) L. R. 5 Ch. 36; Cropper *v.* Smith, (1884) 1 R. P. C. 90; Sharp *v.* Bauer, (1886) 3 R. P. C. 196; Rowcliffe *v.* Longford Wire Co., (1887) 4 R. P. C. 281; Albo-Carbon Light Co. *v.* Kidd, (1887) 4 R. P. C. 535; 5 R. P. C. 581; 6 R. P. C. 194; Blakey *v.* Latham, (1889) 6 R. P. C. 184; Longbottom *v.* Shaw, (1889) 6 R. P. C. 143; Morgan *v.* Windover, (1888) 5 R. P. C. 304; 7 P. O. R. 131; Calvert *v.* Ashburn, Pract. Mech. Journ. vol. vii. 2nd ser. p. 97.

(*o*) Hartley's Case, 2 H. Bl. 493; Brunton *v.* Hawkes, (1820) 1 Carp. P. C. 405; Hall *v.* Jarvis, (1822) 1 W. P. C. 100; Kay *v.* Marshall, (1839) 2 W. P. C. 71, 79; Walton *v.* Potter, (1841) 1 W. P. C. 597; Muntz *v.* Foster, (1844) 2 W. P. C. 103; R. *v.* Cutler, (1816) Macr. P. C. 124; Bush *v.* Fox, (1852) Macr. P. C. 164, 178; 5 H. L. C. 707; Pow *v.* Taunton, (1845) 9 Jur. 1056; Steiner *v.* Heald, (1851) 6 Exch. R. 607; 11 Jur. 875; 20 L. J. Ex. 410; Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52; Penn *v.* Bibby, (1866) L. R. 2 Ch. 127; 36 L. J. Ch. 455; White *v.* Toms, (1867) 36 L. J. Ch. 204; 17 L. T. N. S. 399; Rusbton *v.* Crawley, (1870) L. R. 10 Eq. 522; Newton *v.* Vaucher, (1851) 6 Exch. 865; Reynolds *v.* Amos, (1886) 3 R. P. C. 215; American Braided Wire Co. *v.* Thompson, (1887) 4 R. P. C. 316; 5 R. P. C. 113; 6 R. P. C. 518; Pirrie *v.* York Street Flax Spinning Co., (1893) 10 R. P. C. 34; 11 R. P. C. 429; Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1897) 14 R. P. C. 21; Tucker *v.* Kaye, (1891) 8 R. P. C. 58, 230; Embossed Metal Plate Co. *v.* Saupe, (1891) 8 R. P. C. 355; Fairfax *v.* Lyons, (1891) 8 R. P. C. 401; Longbottom *v.* Shaw, (1888) 5 R. P. C. 497; 6 R. P. C. 143, 510; 8 R. P. C. 333; Wilson *v.* Union Oil Mills, (1892) 9 R. P. C. 57; Baker *v.* Kinnell, (1892) 9 R. P. C. 441; Nicoll *v.* Swears, (1893) 10 R. P. C. 240; Sudbury *v.* Lee, (1894) 11 R. P. C. 58; Rose's Patents Co. *v.* Braby, (1894) 11 R. P. C. 198; Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 463; Shaw *v.* Barton, (1895) 12 R. P. C. 282; Rickmann *v.* Thierry, (1896) 14 R. P. C. 105; Haws *v.* Harding, (1897) 14 R. P. C. 105.

New Uses of Old Appliances.

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. Under which of these rules any particular case falls depends on its own special circumstances, and is often a question of very great difficulty, giving rise to considerable difference of opinion, as in the well-known bustle case *American Braided Wire Co.* v. *Thompson*, 6 R. P. C. 518. But the rules themselves are intelligible enough. Their application involves a correct estimate of the degree of ingenuity which amounts to invention. The difficulty of saying where invention sufficient to support a patent exists and where it does not is well known to all persons conversant with patent law." (*p*)

The same by Lord Davey.

Lord *Davey*, in reference to *Willson*'s patent for improved metallic carbides applicable for use in the production of acetylene, and means for producing the same, stated the law thus:

> "I fully agree with the conclusion which has been come to by Lord Justice *Stirling*, whose words I am very glad to adopt. He says this: 'Now, in order that Mr. *Willson* might obtain a valid patent, he is, according to the law as here stated, to produce a mode of using his discovery, in which there is novelty in the mode of user as distinguished from novelty of purpose, or some new modification of the thing, or some new appliance necessary for using it for the purpose, and that such mode of user or application involves some appreciable merit. Mr. *Willson* takes out a patent, and in order to carry out his discovery he directs the use of some pre-existing kind of furnace, particularly the *Siemen's* furnace. But that again is not enough unless there is novelty in the mode of using it. Was there then novelty in the mode of using it? To that it seems to me that *Willson's* own American Patent of 1892 affords an answer. He had there pointed out the very mode of using *Siemen's* arc furnace, which is described in this Patent of 1894, and had gone as far as to indicate that it might be applied to the manufacture of calcium carbide. At the most what he did was to make an analogous use of the mode of user

(*p*) Gadd v. Mayor, &c., of Manchester, (1892) 9 R. P. C. 524.

that was pointed out in the Patent of 1892, and nothing more.'" (*q*)

**New Uses of Old Appliances.**

It is obviously impossible to frame any rule which will serve as a guide to show at once whether any particular instance is one involving invention or not. The authorities are, necessarily, decisions on particular cases, and are useful only as affording some guide to the correct conclusion in any particular instance coming under consideration. Each case must be decided on its own merits, and with reference to its own especial circumstances. (*r*)

**No rule possible.**

There may be an element of novelty in an alleged invention, and yet that novelty may consist only in the new occasion or new use to which an old and well-known thing or method is applied. The principle—*i.e.*, the method of operation, or order of combination—of the alleged new invention may have been discovered and applied before, though not on precisely the same occasions and uses, or with the same materials. If the new application is nothing more than a double use, and shows nothing beyond the mere skill of a constructor in adapting a well-known method to different occasions, the patent cannot be supported.

If there is no novelty in the effect produced, but the occasion only is new, then the use to which the known thing or method has been applied is simply analogous to what was done before; but if the effect is new, then the first application of the known thing or method may constitute the subject-matter of a valid patent.

**Novelty in the sense of doing what has not been done before is not in itself sufficient.**

For a patentee to succeed in upholding his patent, it is necessary for him to show, not merely newness in the sense of doing a thing which has not been done before, but he must show newness in the shape of novelty by producing a thing which, it may be presumed, requires some exertion of mind that could properly be called invention. To apply an old tool to a new material could not be the subject of a patent, although all mankind had been previously using another sort of tool which produced a much inferior effect, and although, therefore, the new application of the old tool had the merit in it that it produced a useful result in the easier working of a material to which that tool had not been applied before: since

(*q*) Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1904) 22 R. P. C. 156.

(*r*) See Lister *v.* Norton, (1886) 3 R. P. C. 205; Morgan *v.* Windover, (1887) 4 R. P. C. 426; see also p. 39 *ante*.

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the new use of the old tool was merely for an analogous purpose to that which all mankind knew it was useful for before, although the application might be new, it could not be said that the application was a novelty, in the sense of invention, which would sustain a patent. (*s*)

Apprehension of a new use may be invention.

In some cases, however, the apprehension of the new use of the old thing is invention sufficient to support a patent for the new use—*e.g.*, the application of an old thing to remove a defect in an old machine (*t*) or the use of retorts inclined at a particular angle for the purpose of saving labour and expense in gas-making though inclined retorts had been used before for purposes other than gas-making. (*u*) As a matter of law where different machines of a certain class or character are well known, if a person selects and applies one specially adapted for the purpose to effect a new object, and with the result of producing a new article, or an old article in a substantially more expeditious and economical way than it was produced before, then he may probably claim as subject-matter of a patent that machine as applied to the new object even though he could not have claimed the machine, *per se*—that is to say, without limitation as to its application. (*x*) And a means of using an old machine which the world had not known the benefit of before may be fit subject-matter for a patent. (*y*)

In the following cases, patents which, in each instance, related to some new application of an old thing or method, were declared invalid, on the ground of lack of invention and consequent want of proper subject-matter.

Cases in which patents for new uses were held bad.

Kay v. Marshall.

In *Kay* v. *Marshall*, (1836) 2 W. P. C. 36, 39, 47, 48, 69, 71, 77, 79; 8 L. J. C. P. 261, (*z*) it appeared that before the patent flax and other fibrous substances were spun with machines, by which the reach was varied according to the staple or fibre of the article to be spun, and that it had been a fundamental principle of dry spinning, known and used before the granting of the patent; and, further, that the reach used in cotton spinning had been less than two and a half inches. The real

(*s*) Tatham *v.* Dania, (1869) Griff. P. C. 213, judgment of Willes, J.

(*t*) Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 398, 399.

(*u*) Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 450.

(*x*) See per Romer, J., Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 21.

(*y*) Kay *v.* Marshall, (1841) 2 W. P. C. 84; Jandus Arc Lamp and Electric Co., Ld. *v.* Arc Lamp Co., (1905) 22 R. P. C. 277, 298.

(*z*) See also Blakey *v.* Latham, (1889) 6 R. P. C. 187; Thierry *v.* Rickmann, (1895) 12 R. P. C. 548.

question in the case was whether, with public knowledge in the state above indicated, a patent could be upheld for placing the retaining rollers, and the drawing rollers, of a spinning machine, which was known and in use before, within two and a half inches of each other, and the Court of Common Pleas held that it could not. *Tindal*, C.J., in delivering the judgment of the Court, said : (*a*)

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Cases in which patents for new uses were held bad.

Kay v. Marshall.

"The application of a reach of two and a half inches to the spinning of flax, when in a state of maceration, by which the fibre of flax will not hold together beyond two and a half inches, does not appear to us to be any new invention or discovery, but is merely the application of a piece of machinery, already known and in use, to the *new* macerated state of flax. . . . And if a patent, taken out for that object separately, would be invalid, so also a patent taken out for an invention consisting of two distinct parts, one of which is the precise object, would be void also. . . . If a part of what is claimed is not properly the subject of a patent, or is not new, the whole must be void."

In *Losh* v. *Hague*, (1837) 1 W. P. C. 200; 5 M. & W. 387, which was an action brought for the alleged infringement of a patent for "improvement in the construction of wheels for carriages *to be used on railways*," it was objected by the defendant that Losh was not the true and first inventor; and it was proved that wheels made on the same principle as that claimed by the patent had been previously known, though they had never been used on railways. The jury by their verdict upheld this objection on the part of the defendant. Lord *Abinger*, C.B., in directing the jury, referred to the case of *Hall* v. *Jarvis*, (1822) 1 W. P. C. 100, and said: "That was the application of a new contrivance to the same purpose; but it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object—that is a very different thing. In the case the learned counsel put, he says, 'If a surgeon goes into a mercer's shop and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he, seeing that, would have a right to take out a patent in order to apply the same scissors to cutting a sore or a patient's skin.' I do not quite agree with that law. I think if a surgeon had gone to him and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say that because all mankind have been accustomed to eat soup with a spoon, a man could take out a

Losh v. Hague.

(*a*) 2 W. P. C. at p. 75.

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Cases in which patents for new uses were held bad.

Losh v. Hague.

patent because he says you might eat peas with a spoon. The law on the subject is this: that you cannot have a patent for applying a well-known thing, that might be applied to fifty thousand different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with, if the scissors were never invented before he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?"

Regina v. Cutler.

In *Regina* v. *Cutler*, 4 Q. B. 372; Macr. P. C. 124; 3 C. & K. 215, the patent was for improvements in the construction of the tubular flues of steam boilers and the patentee claimed the application of iron tubes coated with copper or brass to this purpose. It having been proved that such tubes were not new and that there was no novelty in the manner in which they were applied in the flues, since uncovered tubes had been applied in the same way before the date of the patent, Lord *Denman*, C.J., and *Wightman*, J., on different occasions held that this was the mere application of a known article to a new use, the mode of application having been previously employed in applying analogous articles to the same purpose, and could not therefore be the subject of a valid patent.

Bush v. Fox.

In *Bush* v. *Fox*, Macr. P. C. 164; 23 L. J. Ex. 275; 24 L. J. Ex. 251; 5 H. L. Cas. 707, the patent was for "improvements in the means of, and in the apparatus for, building and working under water," and the patentee claimed "the mode of constructing the interior of a caisson in such manner that the workpeople may be supplied with compressed air, and be able to raise the materials excavated, and to make or construct foundations and buildings, as above described." The defendant proved that the apparatus described in a prior patent was the same in all material respects as the plaintiff's caisson, the mode of working was the same in both cases, and they differed only in their application, the prior patent being for excavating and sinking shafts, &c., on land, the plaintiff's for sinking, excavating and constructing foundations under water. In directing the jury, *Pollock*, C.B., said: "I am of opinion, upon the evidence as it now stands, that the said supposed invention in the declaration mentioned was not an invention of a certain manner of new manufacture in processes and forms as the plaintiff has alleged. I think that an invention must be a production of something that can be used or sold or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied—supposing this to be a new application—an old invention, or part of an old invention, to a new purpose, obtain a patent for such an application. Now, if the construction of this caisson, or pile ,

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Cases in which patents for new uses were held bad.

Bush v. Fox.

or whatever it is to be called, is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture: and the application is such an operation (if so it can be called) that nothing new which results from it can, I think, be the subject of a patent. . . . I think if one man invents a new mode of looking at the moon, somebody else cannot take out a patent for using the same mode to look at the sun, nor for any mere application of it to a different purpose. If a man were to take out a patent for a telescope to be used for making observations on land, I do not think any one could say, 'I will take out another patent for that telescope to be used for making observations on the sea.' I therefore direct you, that, in point of law, in my judgment, the supposed invention was not an invention of any manner of new manufacture in manner and form as the plaintiff has alleged." This ruling was affirmed in the Exchequer Chamber and the House of Lords.

It must be noticed that the learned Judges did not refer to the question of the amount of invention required to adapt the caisson which had been previously used on land to the use under water. If this had required the expenditure of any considerable amount of ingenuity no doubt the patent would have been supported on the ground of subject-matter. From the report of the case it must be concluded that the jury below were of opinion that the evidence showed the application of the caisson under water did not imply the exercise of any ingenuity, but it must be observed that the Court of Exchequer Chamber and the House of Lords upheld the decision of the Court of first instance, not on the ground of mere analogous use, but because the specification describing the mode of construction of a machine for a particular purpose was to be considered as claiming the machine itself, which the evidence showed was old.

Patent Bottle Envelope Co. v. Seymer.

In *The Patent Bottle Envelope Co.* v. *Seymer*, (1858) 5 C. B. N. S. 164; 28 L. J. C. P. 22, the patent was for "improvements in the manufacture of cases or envelopes for covering bottles." The claim was for "the combination of mechanism, and the making of envelopes for bottles, as herein described." The defendants worked a patent for "improvements in the manufacture of cases or packings for bottles or jars," in which they employed a mould or mandril similar to the plaintiff's, and this was the infringement complained of. In delivering the judgment of the Court of Common Pleas, *Willes*, J., said: "The fact that the mould or mandril constitutes part only of the plaintiff's process does not of itself affect the question. The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so as that it

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Cases in which patents for new uses were held bad.

Patent Bottle Envelope Co. v. Seymer.

might be the subject-matter of a patent, and is used by the infringer to effect the object, or part of the object, proposed by the patentee. The question, therefore, is, whether the plaintiffs could have taken out a patent simply for applying a model or mandril in the form of a bottle, or, indeed, a bottle itself, in making envelopes for bottles. We are of opinion that they could not. The use of a model or mandril, for producing given forms of pliable materials, was admitted at the trial, and indeed, without such admission, is well known to have been for ages common and usual in various arts. Such use was part of common knowledge, and a model or mandril for purposes similar to that of this patent was an ordinary and well-known tool. It is merely in respect of the sort of material to which it is applied, and the form of the utensil produced by it, that the plaintiff's application of the model possesses any novelty. The application of a well-known tool to work previously untried materials, or to produce new forms, is not, in my opinion, the subject-matter of a patent. The observations of the Court, in giving judgment in the recent case of *Tetley* v. *Easton*, (1857) 26 L. J. C. P. 269, sustained this proposition. Indeed, to hold the contrary might tend to produce oppressive monopolies in the application of old and well-known implements to new materials, without any further novelty or merit than the discovery of the material or the form into which it is to be worked. Such discovery is not, in our opinion, one of a new 'manufacture' within the statute of James, and a patent for it alone cannot be maintained."

Brook v. Aston.

In *Brook* v. *Aston*, (1857) 8 E. & B. 478; 27 L. J. Q. B. 145; 28 L. J. Q. B. 875; affirmed 5 Jur. N. S. 1025, the action was brought for the infringement of a patent for "improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics." The defendant pleaded that it was not the working or making of any manufacture for which letters patent could by law be granted. The specification stated: "This invention has for its object an improvement in finishing yarns of wool or hair, and consists in causing *yarns of wool or hair*, whilst distended and kept separate, to be subjected to the action of rotatory beaters, or burnishers, by which such yarns will be burnished or polished on all sides." Then followed a description and drawings of the machinery, showing the manner in which the threads were distended and kept separate, and were passed over a revolving circular brush, on their way to some rapidly revolving beaters or burnishers, which gave smoothness to their surface. The first claim was: "causing yarns of wool or hair, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, whereby the fibre is closed and strengthened and the surface effectually polished."

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

Brook v. Aston.

The defendant put in evidence the specification of a former patent granted to *W. L. Brook*, and *C. Brook*, in 1853, for certain improvements in finishing cotton and linen yarns, and in the machinery connected therewith. This specification stated: "Our improvements relate, first, to a method of finishing *cotton and linen* yarns by the application of friction, produced by a peculiar combination of horizontal brushes, with revolving beaters or burnishers, the yarns being extended from end to end, instead of being dressed in the hank or skein, by which means a more perfect adhesion of the fibre with smoothness and a *glacé* effect is produced. The yarns or threads are wound upon a roller at one end of the machine, and pass through the operation of sizing, as in common use, and thence to the finishing end of the machine." The jury found for the plaintiff.

On application to the Court of Queen's Bench, a rule *nisi* to enter a nonsuit was made absolute, Lord *Campbell*, C.J., saying: "It may well be that a patent may be valid for the application of an old invention to a new purpose, but to make it valid there must be some novelty in the application. Here there is none at all. We may suppose that the specification of 1853, instead of extending to cotton and linen yarns, had been confined to cotton yarns only. Could, in that case, a new patent have been supported for applying the same process precisely to linen threads? It is clear it could not. In all the cases in which a patent has been supported there has been some discovery, some invention. It has not been, as in this case, merely the application of the old machinery, in the old manner, to an analogous substance. That cannot be the subject of a patent, and this patent claiming it is void."

On a writ of error being brought in the Court of Exchequer Chamber, *Cockburn*, C.J., said: "Our duty is to look to the two specifications, and construing them in the best manner, to see whether the second involves any infringement of the first. I am of opinion that it does. The second patent includes every material portion of that which was the subject-matter of the first. Mr. *Bovill* has argued on the assumption that the sizing process, which is omitted in the second patent, was an essential part of the first. But I cannot look upon it in that light. . . . There is a *glacé* appearance produced on the linen, and not in the wool. But the main purpose, which is to give strength to the matter operated on, is the same in both. . . . The polish is no essential part of the patent."

*Martin*, B., said: "The question is, whether there was any evidence to go to the jury at the end of the plaintiff's case. . . . I quite concur in the judgment of the Court of Common

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Cases in which patents for new uses were held bad.

Brook v. Aston.

Pleas in the *Patent Bottle Envelope Co.* v. *Seymer*, (1858) 28 L. J. C. P. 22, that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion that the application of this machinery to woollen yarn is not the subject of a patent."

*Willes*, J., said: "I am of the same opinion. The machinery is admitted to be the same in the two patents; the thing operated upon in each is the same, or similar, the one being vegetable, the other animal fibre. The *modus operandi* is the same, namely, by friction, and the result aimed at is the same —the improvement of the thread or yarn to be produced by the friction of the brushes or beaters—the two patents are, in my opinion, for similar, if not for identical purposes."

*Bramwell*, B., said: "The two specifications are substantially identical. Doing to wool identically the same thing which has been done to linen or cotton is not, in my opinion, a new manufacture."

Harwood v. Great Northern Railway Co.

In *Harwood* v. *The Great Northern Railway Co.*, (1860) 2 B. & S. 194, 222; 11 H. L. Cas. 654; 29 L. J. Q. B. 193; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27, a patent for the purpose of connecting the rails of railways by "fishes" was held void on the ground that similar fishes had been previously used to fasten pieces of timber together in the construction of bridges, and also in various articles of machinery. *Willes*, J., in the Court of Exchequer Chamber, held the invention was the mere application of an old contrivance in the old way to an analogous subject without novelty or invention in the mode of applying such old contrivance to the new purpose. On the appeal to the House of Lords, Lord *Westbury*, L.C., thus expressed himself: "The question is, whether there can be any invention in taking that thing which was a fish for a bridge and having applied it as a fish to a railway. Upon that I think the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance if every slight difference in the application of a well-known thing should be held to constitute ground for a patent. There is the familiar contrivance of the button to the button-hole taken from the waistcoat or the coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied. But it would be an idle thing, if it were possible, to take a well-known mechanical contrivance and by applying it to a subject to which it has not hitherto been applied, to constitute that application the subject of a patent to be granted as for a new invention. No sounder or more wholesome doctrine, I think, was ever established than that which was

established by the decisions 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 when it is applied in a manner, or to a purpose, which is not quite the same, but is analogous to the manner or purpose in or to which it has been hitherto notoriously used."

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Cases in which patents for new uses were held bad.

In *Jordan* v. *Moore*, (1866) L. R. 1 C. P. 624; 35 L. J. C. P. 268, the question was whether the application of wooden planking to the iron frame of a ship (without any peculiarity in the nature of the planking) could be the subject of a patent. The Court of Common Pleas held it could not, on the ground that it was not only the substitution of one well-known and analogous material for another—that is, wood for iron—to effect the same purpose on an iron ship, but it was the application of an old invention—viz., planking with timber, which was formerly done on a wooden frame—to an analogous purpose, or rather the same purpose on an iron frame, and *Harwood* v. *Great Northern Railway Co.* (1860) 2 B. & S. 194, 222; 11 H. L. Cas. 654; 29 L. J. Q. B. 193; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27, was directly in point, and decisive against the patent.

Jordan v. Moore.

In *Parkes* v. *Stevens*, (1869) L. R. 5 Ch. 36; L. R. 8 Eq. 358; 38 L. J. Ch. 627, Lord *Hatherley*, L.C., held that the adaptation of a sliding door to a spherical lamp—sliding doors having been previously applied to cylindrical lamps and other glazed surfaces—could not of itself be the subject of a patent.

Parkes v. Stevens.

*Horton* v. *Mabon*, (1862) 12 C. B. N. S. 437; 16 C. B. N. S. 141; 31 L. J. C. B. 255, the patent sued on was held void by the Court of Common Pleas, and on appeal the Court of Exchequer Chamber upheld the judgment below, and came to the conclusion that what the plaintiff claimed as part of his invention was merely the substitution of *double* angle iron for two pieces of *single* angle iron, in the formation of hydraulic cups or joints to telescopic gas-holders. It was matter of general knowledge that the cups might be formed by riveting two pieces of *single* angle iron to a plate, and the Court held that the mere substitution of *double* angle iron—an article well known in the trade—was not an invention for which a patent could be granted.

Horton v. Mabon.

In *Ormson* v. *Clarke*, (1862) 13 C. B. N. S. 337; 14 C. B. N. S. 475; 32 L. J. C. P. S. 291, the patent was for "an improvement in the manufacture of cast tubular boilers," and the invention consisted in causing the upright tubes and the lower hollow ring (which connected the tubes together at their lower ends) to be cast at one time, and thus form one casting. It appeared that similar boilers had been previously made in

Ormson v. Clarke.

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Cases in which patents for new uses were held bad.

several pieces, which were afterwards fastened together by means of cement. The Court of Common Pleas and on appeal, the Court of Exchequer Chamber, held that the alleged invention, which was merely the casting in one piece that which used formerly to be cast in several pieces, was not proper subject-matter.

Bamlett v. Picksley.

In *Bamlett* v. *Picksley*, (1875) Griff. P. C. 40, the patent related to improvements in machines for both reaping and mowing, and the alleged invention consisted in making the cutting knife revolve quicker for mowing grass than for cutting corn. This was accomplished by the application of an arrangement of shaft and wheels identical with one used by a previous inventor in a hay-making or tedding machine, for the purpose of driving the tossing rakes slower or faster at will. The patent was declared void on the ground that the alleged invention was not proper subject-matter.

Philpot v. Hanbury.

In *Philpot* v. *Hanbury*, (1885) 2 R. P. C. 33, an action for the infringement of a patent for "improvements in apparatus for use in drafting patterns for ladies' dresses and under garments," *Grove*, J., held that the state of public knowledge at the date of the plaintiff's specification, disclosed by three prior specifications, made his claim to be for what was virtually an application of a known method in a known way, or in a variety of ways open to everybody else.

Sharp v. Brauer.

In *Sharp* v. *Brauer*, (1886) 3 R. P. C. 193, the plaintiff's patent was for "a new or improved window screen or blind," and the specification stated that the invention related to screens or blinds for windows, and the improvement consisted in forming them of cardboard, millboard, &c. The evidence showed that similar screens were old and well known, and all that the patentee had done was to apply them in an obvious way to a window.

Rowcliffe v. Longford Wire Co.

In *Rowcliffe* v. *Longford Wire Co.*, (1887) 4 R. P. C. 281, a patent for "improvement in frames for woven or elastic wire net mattresses" was declared invalid on the ground that the patentees claimed merely a rectangular framework which differed only from the old four-post bedstead in not having any legs or posts, by sliding the transverse piece not in grooves but on the top of the sides, and by making the foot and head, instead of being flush with the sides, raised above the sides.

Albo-Carbon Light Co. v. Kidd.

In *Albo-Carbon Light Co.* v. *Kidd*, (1887) 4 R. P. C. 535, the patent called in question by the defendant related to the use of solid naphthaline for the purpose of enriching gas, and the patentee claimed "The use of solid naphthaline, prepared in the form of sticks, rods or pellets, for the enrichment of combustible gas, substantially as herein described." The defendant proved that liquid naphthaline prior to the patent had

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been used for the purpose for which the patentee used solid naphthaline, and that solid naphthaline had been prepared before the patent as a well-known article of commerce.

Cases in which patents for new uses were held bad.

In *Calvert* v. *Ashburn*, Pract. Tech. Journ. vol. vii. 2nd ser. p. 97, it was held, that as caustic alkali had been previously used to dissolve gluten in the manufacture of *starch*, it was not the subject-matter of a patent to apply caustic alkalis to dissolve gluten in the manufacture of *size* from flour. Calvert v. Ashburn.

In *Herrburger* v. *Squire*, (1888) 5 R. P. C. 581; 6 R. P. C. 194, it was held that the mere alteration of the arc in which a damper for a pianoforte string was worked, though useful, was not proper subject-matter, on the authority of *Kay* v. *Marshall*, (1836) 2 W. P. C. 36. Herrburger v. Squire.

In *Blakey* v. *Latham*, (1889) 6 R. P. C. 29, 184, it was held that to put a plate on the heel of a boot, which had been previously used on the toe, was not subject-matter. Blakey v. Latham.

In *Longbottom* v. *Shaw*, (1888–91) 5 R. P. C. 497, 6 R. P. C. 143, 510, 8 R. P. C. 333, a patent which related to reels or frames for holding pile or other fabrics was declared void by the Courts below and the House of Lords under the following circumstances. The invention claimed by the patentee consisted in forming a row of hooks upon a foundation piece of metal, either by stamping the hooks out of the metal, or by soldering the hooks on to the metal in a groove and then attaching the row of hooks so formed to a reel or frame for the purpose of holding the pile. It was admitted that reels or frames with a row of hooks were well known at the date of the patent, and also that the idea of attaching a row of hooks to a strip of metal so that the strip of metal with the hooks could be applied when required was not new, though it had in fact never been applied to reels or frames. It was proved in evidence that the plaintiff had effected an improvement, and that the article produced by him had supplanted the old article in the market; but there was no evidence that the defects of the old article had been much felt, or had caused a demand for an improved article, or that attention had been called to the removal of those defects. Longbottom v. Shaw.

In *Morgan* v. *Windover*, (1888) 5 R. P. C. 304; 7 R. P. C. 131, the Court of first instance and the Court of Appeal upheld a patent for turning springs, which had been formerly used at the back of carriages, and inverting them and putting them to the front of carriages in such a manner as not to interfere with the fore wheels and their motion in turning the carriage. The Court thought that there was invention in selecting the proper spring to effect the desired purpose of giving horizontal motion, and in adopting it in the proper way to the carriage. The House of Lords, however, held the Morgan v. Windover.

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Cases in which patents for new uses were held bad.

patent void on the ground that it was merely the application of a known article to an analogous purpose without any ingenuity, and that it was not patentable, though advantages were produced which were not produced before.

Tucker v. Kaye.

In *Tucker* v. *Kaye*, (1891) 8 R. P. C. 58, 230, the patent was for a door lock consisting of a combination with the main bolt urged forwards by a spring, a detent holding the bolt back when the door is open, but released by the projection on the striking plate in the act of closing the door. Each part of the combination was old, but in the prior locks the mechanism for moving the catch was placed at the side and the bolts projected or protruded. The Courts held that no invention was required to change the side action to a facial action, and to provide bolts which did not project or protrude; and the patent was therefore bad for want of subject-matter.

Embossed Metal Plate Co. v. Saupe.

In *Embossed Metal Plate Co.* v. *Saupe*, (1891) 8 R. P. C. 355, a patent for embossing thick metal plates by stamping them from the reverse side on to a soft indiarubber pad was declared void upon proof that, at the date of the patent, it was old to emboss thick metal sheets between non-elastic dies; also to emboss thick metal by tools upon pitch; and it was also old to emboss thin plates between engraved rollers and india-rubber.

Fairfax v. Lyons.

In *Fairfax* v. *Lyons*, (1891) 8 R. P. C. 401, a patent for mechanical means for moving targets was declared void on the ground that substantially similar means had been used for the same purpose before.

Wilson v. Union Oil Mills Co.

In *Wilson* v. *Union Oil Mills Co.*, (1892) 9 R. P. C. 57, the patentee sought to protect a process for bleaching and deodorising soda made from soda and "railway grease," which is dark in colour and has a bad smell, by the application of chlorine or boiling hypochlorite of soda to it. It was proved that hypochlorite of soda had been used for bleaching other kinds of soap, and that chlorine water had been used to bleach cotton-seed soap. The patent was therefore void as being for a mere analogous use.

Baker v. Kinnell.

In *Baker* v. *Kinnell*, (1892) 9 R. P. C. 441, it was held that a certain joint having been applied to hot-water coil pipes, there was no invention in making the mere analogous application of the joint to boiler tubes in which the heat was applied outside the tubes.

Nicoll v. Swears.

In *Nicoll* v. *Swears*, (1893) 10 R. P. C. 240, riding-habits having been made with a burstable seam part way up, the discovery that if the burstable seam was extended further up —*i.e.*, right up to the waist—it would work very much better was held not to be subject-matter as being merely the use of a known contrivance for a known purpose.

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Cases in which patents for new uses were held bad.

In *Sudbury* v. *Lee*, (1894) 11 R. P. C. 58, the patentee claimed, in the manufacture of hose, half-hose, and socks, the addition, during the process of manufacture, of one or more widenings to the upper portion of the backs of the heels thereof, so as to make the said heels conform more closely to the shape or contour of the heel of the human foot. The Court held that widening, being an old process, and an obvious method of shaping the upper parts of the heels of hose, although it had never been so employed before the date of the patent, the invention, though useful, was not subject-matter, and the action was dismissed.

Sudbury v. Lee.

In *Rose's Patent Co.* v. *Braby*, (1894) 11 R. P. C. 198, a patent for a portable oil spray lamp for use in large public works where the aid of a powerful light is required, which claimed the application of known mechanical principles to the creation of pressure on the surface of water (which had been previously used for the purpose of creating pressure on the surface of oil) for the purpose of neutralising a back-pressure, was held bad on the ground that there was no patentable subject-matter. It was further held that the system of a continuous current being known, there was no merit in producing it from steam and not from oil, nor in applying a current of steam to produce an oil spray.

Rose's Patent Co. v. Braby.

In *Singer* v. *Rudge Cycle Co.*, (1894) 11 R. P. C. 463, the mere application of an old locking device to the front wheel of a bicycle for the purpose of locking the steering gear when the bicycle was at rest was held not to be subject-matter in face of the fact that the same locking device had been used formerly for the purpose of locking the steering gear when the bicycle was being ridden.

Singer v. Rudge Cycle Co.

In *Shaw* v. *Barton*, (1895) 12 R. P. C. 282, the patentee claimed wire rings for use in securing elastic tyres on bicycles and other wheels in which the joints were made by inserting the two ends of the wire into a longitudinal split-tube and then introducing solder along the split. Joints of the same kind had been used in ordinary wire work for lamps, hats, and also for centrifugal machines revolving at the rate of 1000 times a minute. The Court held that, though the patentee had made an improvement on the joints previously used for bicycle wheels, there was not sufficient invention to support a patent for the analogous application of such joints to bicycle wheels.

Shaw v. Barton.

In *Rickmann* v. *Thierry*, (1896) 14 R. P. C. 105, the coating of an eyelet for boots with celluloid and so producing an eyelet which was very useful and largely adopted, was held by the House of Lords, though not unanimously and differing from both Courts below, not to be subject-matter, having regard to the fact that studs and the upper part of lacing hooks had

Rickmann v. Thierry.

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been treated in the same way, and the patentee made no claim to any particular process, but claimed merely "any eyelet of any metal if covered with celluloid or any similar material."

Haws v. Harding.

In *Haws* v. *Harding*, (1897) 14 R. P. C. 105, the combination of various old parts to form a watering pot possessing alleged advantages was, in the absence of any special novelty and advantage arising from the combination, held not to be subject-matter.

Waterson v. W. A. Lloyd's Cycle Fittings, Ld.

In *Waterson* v. *W. A. Lloyd's Cycle Fittings, Ld.*, (1899) 16 R. P. C. 277, the mere application to the side of a bicycle pedal, for the purpose of adjustment to a wide or narrow tread, of a contrivance previously described as applicable to the adjustment of the toe piece of a pedal was held to be no invention.

Hoffmann v. Salsbury.

In *Hoffmann* v. *Salsbury*, (1899) 16 R. P. C. 375, the application of a known form of spring in a known way to a bicycle head lamp instead of to a hanging or hub lamp was held to be no invention.

Cooper & Co. (Birmingham) Ld. v. Baedeker.

In *Cooper & Co. (Birmingham), Ld.* v. *Baedeker*, (1899) 16 R. P. C. 363; 17 R. P. C. 209, the patentee claimed making felt handles for velocipedes by first grooving a piece of sheet felt longitudinally at intervals, then bending the same and securing the uniting ends together so as to form a felt cylinder grooved from end to end on the outside, which is or is not afterwards reduced towards the ends substantially as set forth. It appeared that the material and its application to handles were both old, and also the method of its creation into a handle, or part of a handle, was old. Under these circumstances the Courts held there was neither novelty nor invention, and the patent consequently failed on the ground of subject-matter.

Dredge v. Parnell.

In *Dredge* v. *Parnell*, (1887) 15 R. P. C. 84; 16 R. P. C. 625, the Courts below and the House of Lords were unanimous in holding that the application of the use of a band knife, in its ordinary function as a cutter of piles of substances, to necktie linings when such linings to be cut were clamped together with guides, was not subject-matter, though the application was a very desirable one and largely adopted by the trade.

Case v. Cressy.

In *Case* v. *Cressy*, (1900) 17 R. P. C. 255; 18 R. P. C. 419, it was held that the use of a kind of fence, which had previously been notoriously used on land, as a groyne on the foreshore was a useful discovery of a fresh use for the old form of fence but not an invention, and the patent was consequently declared void.

Carter v. Leyson.

In *Carter* v. *Leyson*, (1902) 19 R. P. C. 473, the Court of Appeal reversing the Court below held that affixing an old

pronged socket to a candlestick base so as to form one entity and to supply a demand, though, in fact, new and useful, was not an invention which could support the patent.

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Cases in which patents for new uses were held bad.

In *British Thomson-Houston Co.* v. *Mayor of Manchester*, (1903) 20 R. P. C. 461, it was proved that at the date of the patent the following facts were all known:—First, the principle of a magnetic blow-out for rupturing an electric arc formed upon breaking circuit; secondly, that the magnet employed might be either a permanent magnet or an electro-magnet, and one with either an iron core or an air core; thirdly, that close proximity of the magnet to the arc which it was desired to rupture was important in that the strength or influence of the magnetic field was largely increased by proximity; fourthly, that proximity increased the probability of the arc springing from the electrode to the magnet itself; fifthly, that if there were close proximity to the electrode, from which the arc might spring, the remedy was insulation; and, lastly, that material which is an insulator to an electric current is not an insulator to magnetic influence. The patentee described the object of the invention as being to increase the efficiency and certainty of operation of arc rupturing devices by permitting them to be brought very close to the point where the arc may form, and he claimed, "In a magnetic arc rupturing device a shield of insulating material located between the surfaces of the electrodes and adjacent conducting surfaces of the device by which the arc is disrupted, as and for the purpose described." The Courts held that on the above facts there was no invention in using such a shield in the manner and for the purpose claimed.

British Thomson-Houston Co. v. Mayor of Manchester.

In *Baxter* v. *Marsden*, (1904) 22 R. P. C. 18, a patent for the substitution of a top drive for a bottom drive in a known double screen stone-breaking and ore-crushing machine was held bad, because it was proved that top driving was old, as applied to single screen machines, and top and bottom drives were interchangeable alternatives perfectly familiar to engineers.

Baxter v. Marsden.

In *McLay* v. *Lawes & Co., Ld.*, (1905) 22 R. P. C. 199, it appeared that calcium sulphate in the form of gypsum had, at the date of the patent sued on, been used and was well known as one of the factors in the manufacture of composition for the covering of boilers, and that calcium sulphate produced by precipitation as a waste product in the manufacture of tartaric acid was chemically substantially the same as gypsum—though physically there might be a slight difference in that the precipitated form was more finely divided than the ground gypsum. The Court held that the patentee's claim, which really amounted to a claim for the use of the waste product instead of native

McLay v. Lawes & Co, Ld.

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gypsum in the known process, was bad for want of subject-matter.

New uses of old appliances which are not analogous to previous ones.

The preceding cases are all illustrations of the rule that a patent cannot be obtained for a mere analogous use of a known thing. When, however, the new use produces an important effect never before produced, or develops or makes practical some new property of matter not previously known, the new use is not analogous to the former uses, and the novelty of the agent becomes immaterial, and a good patent may be granted in respect of such a use. The subject of the patent is really the new art, consisting of the production of the new effect, or the utilisation of the new property of matter, by the use of the known and old thing, and the monopoly is granted as a reward to the patentee for the invention and ingenuity which it is implied he has exercised in making this new application.

There are cases in which an old and known thing is used to produce a new result, when applied to something which is so totally different to anything to which it was previously applied that there is an obvious invention in making the application—*e.g.*, though it was known that macaroni pipe could be made by spinning tough dough into a pipe, an invention of a method of taking red-hot iron and spinning that into pipes in the same manner, might be the subject-matter of a patent. (*b*)

A patent for making salicylic acid by the alleged application of a known process was declared valid, when it appeared that no one before the patentee had ever practically or theoretically taught the world how to make, out of such abundant and cheap materials as soda, carbolic acid, carbonic acid gas, and hydrochloric acid, the rare and expensive thing, salicylic acid; no one had ever taught the world the simple and chemical truth that all that was required to effect this, was to make the carbonate of soda perfectly anhydrous and perfectly desiccated. (*c*)

Applications of newly discovered qualities of natural or artificial products.

When unknown qualities possessed by a natural or artificial product are discovered, and, from the result of experiments, applied to useful purposes, such application is the proper subject-matter of letters patent. (*d*)

Mere advantage in a new use is not sufficient to support a patent.

It should be carefully borne in mind that in order to support a patent for a new use of a known thing there must be

(*b*) See Bamlett *v.* Picksley, (1875) L. R. 14 Ch. D. 230; 50 L. J. Ch. 126. Griff. P. C. 40, 42.

(*c*) Von Heyden *v.* Neustadt, (1880) (*d*) See pp. 58, 59 *ante*.

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evidence that some invention was required to make the alleged analogous application; and it is not sufficient to point out that advantages are obtained which were never before produced. (*c*)

In this connection, Lord *Watson*, in supporting a motion in the House of Lords that the judgment of the Court of Appeal in *Morgan* v. *Windover* (*f*) should be reversed, referred to the decision of the House in *American Braided Wire Co.* v. *Thompson* (*g*) in the following terms: "The learned Judges do not appear to me to have sufficiently considered the principle enunciated by Lord *Westbury*, and accepted by this House in *Harwood* v. *Great Northern Railway Co.*, to the effect that there cannot be a patent 'for a well-known mechanical contrivance merely when it is applied in a manner and to a purpose which is not quite the same, but is analogous to, the manner or the purpose in or to which it has hitherto been notoriously applied.' Your Lordships had recent occasion to consider that principle in *Thompson* v. *American Braided Wire Co.* (*h*) In that case, although your Lordships were not agreed in the result, there was no difference of opinion as to the soundness of the rule which formed the ground of the judgment in *Harwood's Case*. The majority, of whom I happened to be one, rested their judgment upon the fact, which they held to be established, that the particular forms of 'dress improvers' specified and claimed were not *mere* applications of wire braid to an analogous purpose, but that the patentee in his peculiar modes of adapting the old material to its new, though analogous, use had exercised and exhibited a degree of inventive ingenuity just sufficient to protect him from the incidence of the rule. It was for that reason only that the patent was sustained." (*i*)

Cases in which patents for new uses were held good.

In the following cases, patents which, in each instance, related to some new application of an old thing or method were declared valid on the ground that there was some invention in making the new application.

Muntz v. Foster.

In *Muntz* v. *Foster*, (1844) 2 W. P. C. 96, it appeared that at the date of the plaintiff's patent, alloys of zinc and copper were known, but it was not known that an alloy consisting of zinc and copper, in certain definite proportions, by virtue of its

(*e*) See Cole v. Saqui, (1888) 5 R. P. C. 489; Blakey v. Latham, (1889) 6 R. P. C. 29; Morgan v. Windover, 7 P. O. R. 131.

(*f*) (1890) 7 R. P. C. 131.
(*g*) (1889) 6 R. P. C. 518.
(*h*) *Ibid.*
(*i*) (1890) 7 R. P. C. 136.

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oxidating properties, was especially adapted for sheathing the bottoms of ships, which was the object of the invention. The novelty consisted in this, that the patentee by an experiment ascertained that a mixture of the alloy of zinc with copper, in certain definite proportions, has the effect of producing a better sheathing than the copper sheathing previously in use, by reason and by means of its oxidating just in sufficient quantities, and not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep by its wearing the bottom of the vessel clean from the impurities which before attached to it. *Tindal*, C.J., was of opinion that the subject-matter was good, and the jury by their verdict upheld the patent.

Penn v. Bibby.

In *Penn* v. *Bibby*, (1866) L. R. 1 Eq. 548; 2 Ch. 127, the patent related to the construction of hard wood bearings for the shafts of screw propellers. The complete specification described the manner of performing the invention by reference to drawings, and stated (in substance): The inner surfaces of the bearings for a propeller shaft are grooved to receive strips or fillets of wood, which project beyond the inner surfaces of the metal bearings, and allow the water to circulate in the channels so formed. The wood is by preference *lignum vitæ*, the grain being either longitudinal with the fillets, or at right-angles to the bearing surfaces thereof. In other words, the bearings are not continuous metal surfaces, as previously constructed, but a series of wooden fillets or ridges, having water spaces between them, which support the rubbing action of the shaft. It was further stated that the several pieces of wood employed in a bearing might be inclined to the axis instead of parallel to it as shown. Also, that it was not essential that the fillets of wood should be fitted in the interior of fixed metal bearings, as a like effect would be obtained if they were attached to the shaft and revolved therewith, in metal bearings, in the manner shown in the drawings. The claim was "the employment of wood in the construction of the bearings, and brushes for the shafts of screw and submerged propellers, as herein described." The defendant objected, but without success, that this was not subject-matter because the alleged invention was merely the new application of an old and well-known thing, and alleged, as examples of old use, certain grindstones and water-wheels.

Lord *Chelmsford*, L.C., dismissed an application for a new trial, which was made on the ground (*inter alia*) that the invention was not the subject-matter of a patent, saying, "The criterion given by Lord *Campbell*, in *Brook* v. *Aston*, (1857) 8 E. & B. 485, has been frequently cited (as it was in the present argument), that a patent may be valid for the application of an old invention to a new purpose; but to make it valid there must be some novelty

in the application. I cannot help thinking that there must be some inaccuracy in his Lordship's words, because, according to the proposition as he stated it, if the invention be applied to a new purpose there cannot but be some novelty in the application. In every case of this description one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test to the present case, it appears to me impossible to say that the patented invention is merely the application of an old thing to a new purpose. The only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings; but they are of a totally different character, and for a totally different object from the bearings patented. It is difficult to believe that bearings of this description could ever have suggested the application of wood to bearings of screw propellers in the way described in the patent. It is, to my mind, not merely a different application, but something in itself essentially different. It has been found that, in the mode of constructing screw propellers by making metal work upon metal they soon wore out, and occasioned a violent, irregular motion on the vessel. Mr. *Penn* devised the plan of placing fillets of wood upon the inner surface of the bearings, so as to prevent the shaft coming into contact with the metal of the bearings, and so as to admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings, thereby keeping the wood constantly lubricated. The success of this invention has been proved in a remarkable manner. It would be an extraordinary fact if an invention of this kind, so long wanted, and of such great utility, should have been lying in everybody's way who knew anything of the construction of water-wheels or grindstones, and yet should never have been discovered."

**New Uses of Old Appliances.**

Cases in which patents for new uses were held good.

Penn v. Bibby.

In *Steiner* v. *Heald*, (1851) 6 Exch. 620; 20 L. T. Ex. 410; 17 Tur. 875, it appeared that, prior to the plaintiff's patent, a dye called *garancine* had been extracted by a certain process from *fresh* madder. The plaintiff found that it could be extracted by the same process from "*spent*" madder—*i.e.*, madder which had been used in dyeing, and which up to the date of the plaintiff's patent had always been regarded as a waste product. The defendant pleaded that this was no manner of new manufacture, and at the trial the Judge directed the jury to find for the defendant, thereby treating the conclusion to be derived from the evidence as one of law. But the Court of Exchequer granted a new trial, being of opinion that it was a question of fact whether *fresh* madder

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and *spent* madder were so much alike chemically as to be practically the same thing. And if they were not the same thing, then it might require invention to make the application of the old process to the new substance.

Newton v. Vaucher.

In *Newton* v. *Vaucher*, (1851) 6 Exch. 865; 21 L. T. 305, the defendant was the owner of a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, the effect of which was to make certain parts of the machine air and fluid tight. The plaintiff discovered that soft metal had the effect of diminishing friction, and of preventing the evolution of heat, when applied to the surfaces in contact of machines in rapid motion, and subject to pressure, and obtained a patent of later date than the defendants, whereby he claimed as his invention the making or constructing the boxes within which the journals or axles of machinery are to move, by providing them with rims or fillets along their edges, &c., and the lining such boxes with soft metal. The Court held that the plaintiff's application of the soft metal differed essentially from that of the defendant, and that the plaintiff's patent was valid.

Reynolds v. Amos.

In *Reynolds* v. *Amos*, (1886) 3 R. P. C. 215, the patent was for "improved appliances to be used in the manufacture of ensilage," and the invention and value of the process consisted in obtaining the requisite pressure with heaps of ensilage by means of chains furnished with a peg contrivance for retaining the pressure. Before the plaintiff's patent nobody had ever proposed to deal with fodder in the way he did, and his process enabled him to sell for 7*s.* what the defendant had to charge £3 10*s.* for. Though the use of chains was sufficiently obvious, *Bacon*, V.C., held the patent a good one, but he did not in his judgment refer to the fact that the use to which the chain was applied was not one so analogous to the old uses, and self-evident, as not to call for a considerable amount of invention, and he seems to have considered that there was a new combination.

American Braided Wire Co. v. Thompson.

In *American Braided Wire Co.* v. *Thompson*, (1887–89) 4 R. P. C. 316; 5 R. P. C. 113; 6 R. P. C. 518; a patent for "improvements in bustles or dress-improvers" was declared void by the Court of first instance, but the decision was reversed by the Court of Appeal, and a majority of the House of Lords saw no reason for dissenting from the decision of the Court of Appeal, which was accordingly upheld. The invention consisted substantially in the application of tubular sections of braided hard wire to bustles. A specification was produced which specified certain applications of braided wire to satchel-handles and other articles, and mentioned that the material might be applied to bustles. On the hearing of the

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appeal fresh evidence was adduced as to the state of public knowledge at the date of the patent, from which it appeared that the application of braided hard wire to cushions and pillows had been specified, and that it was known that hard wire could be braided in the same manner as soft wire—*i.e.*, in a tubular form on a core—but that there had not been any use of tubular sections of braided hard wire within the realm. The majority of the House of Lords held that the invention was not the mere application of a known thing to an analogous use, but that sufficient ingenuity to support the patent was shown by the patentee's combination in the adoption of tubular wire braids (though a known elastic material) and their application in substitution for other known elastic materials in making bustles, the result obtained being a complete article, effective and capable of being manufactured and sold cheaply.

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Pirrie v. York Street Flax Spinning Co.

In *Pirrie* v. *York Street Flax Spinning Co.*, (1893) 10 R. P. C. 34; 11 R. P. C. 429, it appeared that paper tubes had been used in the *dry* spinning of cotton and other yarns, and that the patentee had adapted paper tubes to the *wet* spinning of flax and other yarns. The novelty and real invention was the combination of the paper tube with a wooden pivot, bobbin, or socket, serving as a support for the tubes during the process of winding, which would otherwise lose its shape and become useless from the moisture of the yarn, and adapting the paper tubes, previously used only in the *dry* spinning of cotton and such yarns to the *wet* spinning of flax. Two useful results were thus achieved: (1) Greater adhesiveness of the yarn to the tube when wound; (2) Superior cheapness—and the validity of the patent was upheld.

Adamant Stone and Paving Co. v. Corporation of Liverpool.

In *Adamant Stone and Paving Co.* v. *Corporation of Liverpool*, (1897) 14 R. P. C. 21, it appeared that the patentee had, by the selection of a known form of filter press from amongst others of a less suitable kind and by its application to the purpose of moulding cement slip, produced from cement a stone or stone-like substance, which was thus produced in a quicker and more economical way than any known before, and being cheap could be used as a paving material and was of great commercial importance. The patent for the process was under these circumstances upheld.

Brooks v. Lamplugh.

In *Brooks* v. *Lamplugh*, (1897) 15 R. P. C. 33; 16 R. P. C. 41, the House of Lords did not differ from the judgments below which held the use of the old and well-known trussed beam, but in a particular way, in the base framing of a bicycle saddle was good subject-matter, notwithstanding that such a trussed beam had been used in bridge construction.

Geipel v. Lord Mayor, &c., of Manchester.

In *Geipel* v. *Lord Mayor, &c., of Manchester*, (1903), 21 R. P. C. 41, the defendants urged that the alleged invention

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was merely the combination of a spring with an expansive steam tap, with the object of avoiding jamming or straining of the valve seating, common to all taps, and that since a spring had been used prior to the patent to obviate this difficulty there was no invention in doing what the plaintiff claimed. The Judge held, however, that the arrangement of the new combination was invention, and the patent was therefore valid. (*k*)

Heine, Solly & Co. v. Coninco Incandescent Light Co.

In *Heine, Solly & Co.* v. *Coninco Incandescent Light Co.*, (1904), 21 R. P. C. 202, the Courts held that the new application in an automatic gas lighter of an old form of covering to protect the igniting pellets from the action of the atmosphere, which application resulted in the production of a new commercial article, involved sufficient inventive ingenuity to support the patent.

Halden v. Hall.

In *Halden* v. *Hall*, (1904) 21 R. P. C. 609, though trunnions had at the date of the patent been used with flat frames and with slightly curved frames for sun printing and also in connection with many cylinders of various kinds, the application of trunnions to a known form of cylinder used in conjunction with an arc light for producing drawings by photography was held good subject-matter. It appeared that trunnions had never been used in connection with any apparatus such as was described in the plaintiff's specification, and beyond doubt the apparatus was new and useful, and the trunnions were for the first time applied to the cylinder in question for a particular advantageous purpose.

Antivibration Incandescent Lighting Co., Ld. v. Crossley.

In *Antivibration Incandescent Lighting Co., Ld.* v. *Crossley*, (1904) 22 R.P.C. 157, 441, it was established that the evil effects of vibration in incandescent gas lamps had long been felt, and that many contrivances for breaking the rigid connection between the source of vibration and the mantle had been tried without success when the patentee hit upon the simple plan of using a flexible feeding tube in conjunction with an elastic or spring suspension for the lamp as an antivibrator, and thereby solved the problem. Under these circumstances, notwithstanding that incandescent lamps had been previously fed by flexible tubes, which, however, had been applied for the purpose of enabling the lamp to be carried about, and not with the object of mitigating or destroying vibration, and elastic or spring suspension was a well-known device for lessening vibration, the Courts decided that the patentee's use of a flexible tube with a fixed elastically suspended lamp was a patentable invention.

(*k*) See also In the Matter of Geipel's Patent, (1904) 21 R. P. C. 379.

# CHAPTER III.

## NOVELTY.

### Novelty at Common Law.

Novelty an essential at Common Law.

It is absolutely essential that every invention capable of sustaining a grant of letters patent must be new at the time the grant is made. The novelty of the invention is, in fact, in every case in which a patent is in practice granted, part of the consideration in exchange for which the Crown, (*a*) acting on behalf of, (*b*) and for the benefit of, the public, (*c*) gives the monopoly conferred by the grant.

The Sovereign has no prerogative extending to anything injurious to his subjects, (*d*) nor can he by his patent do wrong, (*e*) or enable another to do so. (*f*)

*Primâ facie* right of public.

Everybody has alike a *primâ facie* right to make experiments, and to use in any manner he pleases any invention which is the product of his skill or good fortune. The grant of letters patent vesting in one individual the exclusive privilege of making, using, exercising and vending an invention, curtails this *primâ facie* right of the public, for it excludes the rest of the public from using that invention, even though they should, quite independently of the information contained in the patentee's specification, make it for themselves. It is, therefore, only equitable that the public should receive some consideration in return for the curtailment of their rights which the patent thus effects.

Consideration fails if invention is not new.

The only consideration which the patentee gives to the public is a knowledge of the invention, which they are at liberty to use freely after the expiration of the term for which the patent is granted. If the invention were not new, it is quite evident the patentee would not have given to the public

(*a*) Harmar *v.* Playne, (1807) 14 Ves. 131, 136.
(*b*) *Ibid.* 132.
(*c*) Bac. Abr. tit. Prerog.; Year Book, 40 Edw. III. fol. 18.
(*d*) Finch, 84.
(*e*) 1 Co. R. 44$^b$, 45$^b$; Noy, R. 182; 3 Shep. Abr. 48.
(*f*) Godb. 254.

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any consideration at all, for the invention being public property at the date of the patent, the public would be in the same position after its expiration that they were in before it was granted. The patent would, therefore, be void for want of consideration. A patent may be considered as, in effect, a bargain made by the Crown on behalf of the public (*g*) on the one hand, and the patentee on the other, and, as in the case of other contracts not made by deed, it would upon this view be void if there were no consideration for the grant. (*h*) In the language of Lord *Loughborough*, L.C., "A bargain without consideration is a contradiction in terms and cannot exist." (*i*)

Common Law authorities.

The Common Law, as expressed in the cases decided before the passing of the Statute of Monopolies, required that an invention should possess the element of novelty in order to render a patent for it valid. (*k*)

(*g*) Harmar *v.* Playne, (1807) 14 Ves. 132; Tubes, Ld. *v.* Perfecta Seamless Steel Tube Co., Ld., (1902) 20 R. P. C. 94, 96.

(*h*) Rann *v.* Hughes, (1797) 7 T. R. 350 *n.*; Anson on Contracts, 68.

(*i*) Myddelton *v.* Lord Kenyon, (1794) 2 Ves. Jr. 408.

(*k*) It was contended in Darcy *v.* Allin, (1602) Noy. R. 178; 1 W. P. C. 6, decided in 1602, that: "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, that in such cases the King may grant to him a monopoly patent, for some reasonable time, until the subjects may learn the same, *in consideration of the good that he doth bring by his invention to the Commonwealth*, otherwise not."

In Hastings' Patent (Noy, R. 182; 1 W. P. C. 6), it appeared that a patent was granted to Mr. Hastings in consideration that he brought in the skill of making frisadoes, as they were made in Haarlem and Amsterdam, beyond the seas, *being not used in England*, and on action brought for the infringement of the patent it was upset on the ground that such frisadoes as Mr. Hastings' were made in England before the date of the patent.

In Humphrey's Patent (Noy, R. 183; 1 W. P. C. 7), the Court of Exchequer Chamber held that, if the sieve or instrument for melting lead which formed the subject of the patent were used in this country before, the patentee should not have the sole use thereof.

In Moore's Reports (p. 672), it is laid down that the King cannot grant a patent to restrain people in their usual trades and occupations; and that no occupation can be prohibited or put in monopoly, *but only such things as are newly invented* by the skill of man.

In The Clothworkers of Ipswich Case, (1615) Godb. R. 252; 1 Roll R. 4, it was decided that: "If a man hath brought in a new manufacture, and a *new* trade within the kingdom in peril of his life, and consumption of his estate or stock, or if a man hath made a *new* discovery of anything; in such cases the King of his grace and favour in recompence of his costs and travail, may grant by charter unto him that he only shall use such a trade or traffique for a certain time, *because at the first the people of the kingdom are ignorant, and have not the knowledge or skill to use it;* but when the patent is expired the King cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it." And again: "Of a *new invention* the King can grant a patent;" but "*where there is no invention* the King cannot by his patent hinder any trade."

**Novelty at Common Law.**

The power retained to the Crown, by the Statute of Monopolies, of granting patents for inventions, is limited to granting patents and grants of privilege "of the sole working or making of any manner of *new* manufacture within this realm, to *the true and first inventor and inventors* of such manufacture, *which others at the time of making such letters patents and grants shall not use.*" (*l*) Thus, it appears that, in virtue of this statute, as well as of the Common Law, novelty is a requisite of a valid patent, for the section concludes with the statement that the grants thereby allowed "shall be of such force as they should be if this Act had never been made and of none other."

Limit of Crown's authority to grant patents for inventions.

Novelty requisite by statute as well as Common Law.

The section provides that (1) the subject of the grant must be a manufacture which is *new* within this realm; (2) the grantee must be the true and *first* inventor; and (3) the subject of the grant must be a *new* manufacture which others shall not use. All these three conditions necessarily imply the element of novelty.

We have seen (*m*) what is the meaning of the words "true and first inventor," and that they do not imply that the grantee must necessarily be the man who actually first made the discovery, but that, if he be the man who first published the invention within this realm, he is deemed to be the true and first inventor within the legal meaning of the term.

Prior use by others renders patent bad.

Although the grantee be the true and first inventor, the patent will be void if he has allowed the invention to be used by others before obtaining the grant, and there is a "sound distinction in the abstract" between the two issues raised by a denial that the patentee is the true and first inventor and that the invention has not been used before. (*n*) Moreover, in an action for the infringement of the patent, each ought to be pleaded separately if either party desires to rely on both. (*o*)

The fact that the prior use relied upon was only in conjunction with the patentee will not save the patent, unless it be also established that the person other than the patentee who made the prior use was under terms of secrecy, or otherwise in a fiduciary relationship towards the patentee. (*p*)

The grantee may, in fact, have made the discovery himself

(*l*) 21 Jac. I. c. 3, s. 6.
(*m*) pp. 5–19 *ante*.
(*n*) The Household Co. *v.* Neilson, (1843) 1 W. P. C. 689; Cornish *v.* Keene, (1835) 1 W. P. C. 507.
(*o*) *Ibid.*; see chap. viii. *post*.
(*p*) Hoe *v.* Foster, (1898) 16 R. P. C. 33, 38.

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without assistance from any source other than his own ingenuity. Yet, if it turn out that the invention was the property of the public before, although unknown to the patentee, his patent will be void, for it is not because a patentee does not know what was in existence before that he can get a monopoly; otherwise, as a learned Judge once said, a patentee would get a patent for exclusive ignorance instead of exclusive knowledge. (*q*)

It should be borne in mind that not every novelty which is useful can be the subject-matter of a patent: the novelty must be *de jure* as well as *de facto*. (*r*) A thing is not patentable merely because it is new and useful and has not been made before; to be patentable the novelty must show invention. (*s*)

## Public Knowledge.

Meaning of public knowledge.

If the public once become possessed of an invention, by any means whatever, no subsequent patent for it can be granted, either to the true and first inventor himself or to any other person. In such circumstances the public cannot be deprived of the right to use the invention, and a patentee could not give to the public any consideration for the grant, as the public already possess everything he could give. It is not necessary that the invention should be used by the public as well as known to the public; if the invention and the mode in which it can be used has been made known to the public, it is public property, and any subsequent patent in respect of it would be invalid. (*t*)

If some of the public, therefore, not under terms of secrecy or confidence to the inventor, become, at any time before the date of the patent, acquainted with the invention, this will be quite sufficient to render the grant void; and the question in an action upon a patent, the validity of which is put in issue on the ground of previous publication, is: "Is it the fair

(*q*) Young *v.* Rosenthal, (1881) 1 R. P. C. 32.

(*r*) See p. 31 *ante*; Ralston *v.* Smith, (1866) 11 H. L. C. 223; Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 673, 687; Brook *v.* Ashton, (1857) 8 Ell. & B. 472; 27 L. J. Q. B. 145; 28 L. J. Q. B. 175; Longbottom *v.* Shaw, (1888) 8 R. P. C. 333; 6 R. P. C. 143; 5 R. P. C. 497; Riekmann *v.* Thierry, (1896) 14 R. P. C. 105; Rowcliffe *v.* Priestman, (1898) 15 R. P. C. 155; Klaber's Patent, (1902) 19 R. P. C. 174; Carter *v.* Leyson, (1902) 19 R. P. C. 478.

(*s*) See p. 29 *ante*; Thierry *v.* Riekmann, (1895) 12 R. P. C. 548.

(*t*) Patterson *v.* The Gas Light and Coke Co., (1875) L. R. 3 App. Cas. 239; Humpherson *v.* Syer, (1887) 4 R. P. C. 414.

conclusion from the evidence that some English people, under no obligation of secrecy (*u*) arising from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent?" (*v*)

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*Jessel*, M.R., in *Plimpton* v. *Malcolmson*, (*w*) discussing the question, What is meant by a thing being known to the public in England, said—

Per Jessel, M.R.

"Here, again, we must have recourse to authority, and also must consider what the principle is that is to be deduced from the authorities. When you say a thing is known to the public, and part of common knowledge, of course you do not mean that every individual member of the public knows it. That would be absurd. What is meant is, that if it is a manufacture connected with a particular trade the people in the trade shall know something about it; if it is a thing connected with a chemical invention people conversant with chemistry shall know something about it. And it need not go so far as that. You need not show that the bulk or even a large number of those people know it. If a sufficient number know it or if the communication is such that a sufficient number may be presumed or assumed to know it, that will do. Now, how are they to know it? They are to know it by being told of it, or informed of it in some way. You may show that they know it by showing that the trade had commonly used it. That is the best evidence you can have. You may show the thing was known because it was used and brought into practice, which is a case I have not now to consider. But you may show that they knew it in another way—that it was published or made known to the public. I use the word 'published' in that sense. How made known to the public? It has been held that if it is in a specification, certainly in a modern specification, which has been enrolled in the Patent Office, and not published besides, that will do. And it has also been held that, as a common rule, if the description has been printed in *England*, and published in *England*, in a book which circulates in *England*, that will do. But, after all, it is a question of fact. The Judge must decide, from the evidence brought before him, whether it has, in fact, been sufficiently published to come within the definition of being made known within the realm."

It has been shown (*x*) that an invention may be perfectly good subject-matter for a patent, though some or all of the

Test of novelty.

(*u*) p. 140 *post*.

(*v*) Per Fry, L.J., Humpherson *v.* Syer, (1887) 4 R. P. C. 407, 414; Tickelpenny *v.* Army and Navy Co-operative Society, (1888) 5 R. P. C. 405.

(*w*) (1876) L. R. 3 Ch. D. 556.

(*x*) p. 71 *ante*.

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parts of which it consists may be old, if the entire combination is a new manufacture. The proper test as to the novelty of the invention is whether the subject-matter claimed *as a whole is new*, though it may consist of old parts, provided the patentee does not claim them, but only the combination of the old with the new. (*y*)

Per Lord Hatherley, L.C.

Lord *Hatherley*, L.C., in *Cannington* v. *Nuttall*, (*z*) stated the test of novelty in the following words:—

> "Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a particular result not yet obtained, and I take it that the test of novelty is this: Is the product which is the result of an apparatus for which the inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have combined into one valuable whole for the purpose of effecting the object you have in view?"

Per Lord Westbury, L.C.

Lord *Westbury*, L.C., in *Hill* v. *Evans*, (*a*) referring to the principle upon which prior publication will vitiate a subsequent patent for an invention, said:—

> "The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it. . . . Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent—viz., such a knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use."

(*y*) Newton *v.* The Grand Junction Railway Co., (1846) 5 Exch. 331; 20 L. J. Ex. 427 *n.*; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205; 40 L. J. Ch. 739.

(*z*) (1871) L. R. 5 H. L. 216.

(*a*) (1862) 13 L. J. Ch. 457.

In *Betts* v. *Menzies*, (*b*) Lord *Westbury* explained the principle thus :— Public Knowledge.

> "I pass on to the next conclusion which is involved in the answer of the learned Judges to your Lordships' question, and that conclusion, I think, is also of great importance to the law of patents because it results from that opinion that an antecedent specification ought not to be held an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery. Here we attain at length to a certain undoubted and useful rule. For the law laid down, with regard to the interpretation of a subsequent specification, is equally applicable to the construction to be put upon publications or treatises previously given to the world, and which are frequently brought forward for the purpose of showing that the invention has been anticipated. The effect of this opinion I take to be this, if your Lordships shall affirm it, that a barren, general description, probably containing some suggested information, or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding, for want of novelty, a subsequent specification or invention which involves a practical truth, productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information." (*c*)

Statement that a result is desirable is no anticipation.

The mere statement of the desirability of achieving an unattained result does not invalidate a patent for an invention which actually achieves that result. (*d*)

Mere scientific curiosity is no anticipation.

Also an alleged anticipation which is merely a scientific curiosity of no practical value for the purpose for which the patentee proves his invention to be practically valuable will not destroy the subsequent patent, *e.g.*, the unguent *œsypus* described by *Dioscorides* was no publication of *Lanolin*, which formed the subject-matter of a valid and valuable patent. (*e*)

Combination capable of yielding unobserved result does not anticipate invention which utilises it.

A combination which is, in fact, capable of yielding a result which has never been observed and appreciated by any person using the combination is not a publication which will vitiate the patent of a man who perceives the result, points it out

(*b*) (1862) H. & C. 154.

(*c*) See also per Lord Chelmsford, L.C., Betts *v.* Neilson, (1868) L. R. 3 Ch. App. 435.

(*d*) Thomson *v.* Batty, (1889) 6 R. P. C. 84.

(*e*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 11 R. P. C. 93, 261; see also Young *v.* Fernie, (1863) 4 Griff. 577, 611.

Public Knowledge.

and utilises it. (*f*) Thus, *Hopkinson's* patent for the three-wire system for the economic distribution of electricity was not anticipated by a previous and similar arrangement of three wires, which had only been used for the purpose of working lamps in "wings," as was evident from the fact that the return cable was of thick section. This did not anticipate the patentee's discovery that the three-wire system could be used to effect a great saving, by making the centre and return cable of thin cross section, and using it according to the patentee's plan shown in the specification. (*g*) Again, when the invention of the patentee is a combination which is designed for a particular class of purposes, and is the first combination actually applied with success to carry out such purposes, then prior similar combinations, not identically the same, are not considered publications of the combination which actually does accomplish the patentee's object. The Courts consider that in such a case invention was requisite to make the necessary alterations from the old combinations to enable them to be applied to the object the patentee had in view. (*h*)

A patent for an apparatus, which is suitable for a particular and novel purpose—*e.g.*, disinfecting by steam at high pressure—for which no previous apparatus is suited, and is also stated in the specification to be suited for a purpose for which a previous and very similar apparatus is suited, is not vitiated by that previous apparatus if the claim is confined to the use of the new apparatus for the new purpose. (*i*).

## Want of Novelty in Part.

Consideration is entire.

The consideration upon the strength of which a patent is granted is in law said to be "entire," that is, a failure of part of the consideration will have the same effect on the validity of the patent as the failure of the whole consideration would have. Hence it follows that, if the patent includes more than one head of invention, the want of novelty in any one of those heads will invalidate the whole on the ground of failure of part of the consideration. (*j*) And that, if, in the case of a single

(*f*) Hopkinson *v.* St. James's and Pall Mall Electric Light Co., (1893) 10 R. P. C. 46, 60.

(*g*) *Ibid.*

(*h*) See Chadburn *v.* Mechan, (1895) 12 R. P. C. 120, 134.

(*i*) Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 334; 11 R. P. C. 354, at p. 362.

(*j*) Turner *v.* Winter, (1787) 1 W. P. C. 77; 1 T. R. 602; Bloxam *v.* Elsee, (1825) 6 B. & C. 178; 1 Carp. 444; Morgan *v.* Seaward, (1837) 1 W. P. C.

invention, the subject-matter of an individual claiming clause turns out to be old the patent will be rendered entirely void. (*k*)

Want of Novelty in Part.

In either of the above cases the patent would also be void on the ground of false suggestion, for, before the grant was made, the patentee in his application must have declared himself to be in possession of an invention of which he, or, in the case of a joint application, one or more of the applicants, claimed to be the true and first inventor or inventors, and which was not in use by any other person or persons. (*l*) Moreover, the patent contains an express condition avoiding it in the event of the representation as to true and first inventor, and prior use, turning out to be untrue. (*m*) Although the Statute of Monopolies invalidates a patent in the event of there being no novelty in the invention, and consequently 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 in the event of a material part turning out to be old is that "the consideration for the grant is the novelty of all, and, the consideration failing, or, in other words, the Crown having been deceived in its grant, the patent is void, and no action maintainable upon it." (*n*)

Consideration is entire.

For example, in *Brunton* v. *Hawkes* (*o*) the patent was for an invention of improvements in the manufacture of ships' anchors, windlasses, and chain cables. At the trial it was proved that the mode of manufacturing anchors described in the plaintiff's specification had never been applied before to ships' anchors. But it had been applied to the adze anchor and the mushroom anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary; and are never taken on board. The jury found a verdict for the plaintiff, and the defendant obtained a rule *nisi* for a new trial, which the Court made *absolute*. In delivering judgment, *Abbott*, C.J., said :—

196; Kay *v.* Marshall, (1837) 2 W. P. C. 71; Cropper *v.* Smith, (1884) 1 R. P. C. 87; 2 P. O. R. 61; Fairfax *v.* Lyons, (1891) 8 R. P. C. 401.

(*k*) Crossley *v.* Beverley, (1829) 1 W. P. C. 106; Hill *v.* Thompson, (1817) 8 Taunt. 382; 2 B. Moore, 443; Morgan *v.* Seaward, (1837) 1 W. P. C. 192; Manton *v.* Parker, (1815) Dav. P. C. 327; 1 W. P. C. 192 *n.*; Bloxam *v.* Elsee, (1825) 6 B. & C. 169; 1 Carp. 444; Roberts *v.* Heywood, (1879) 27 W. R. 454; Gibson *v.* Brand, (1842) 1 W. P. C. 636; Hill *v.* Tombs, (1881) Engineer, 51, p. 274. Under the Act of 1883 patents do not usually comprise more than one invention. See pp. 241 and Vol. II. p. 8.

(*l*) p. 297 *post*.

(*m*) See Form of letters patent in Appendix.

(*n*) Per Parke, B., in Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 196.

(*o*) (1820) 4 B. & Ald. 541.

Want of Novelty in Part.

Consideration is entire.

Judgment of Abbott, C.J., in Brunton v. Hawkes.

"I think that so much of the plaintiff's invention as respects the anchor is not new, and that the whole patent is therefore void. The mode of joining the shank to the flukes of the anchor is to put the end of the shank, which is in the form of a solid cylinder, through the hollow and conical aperture, and it is then made to fill up the hollow and to unite itself with it. Now that is precisely the mode by which the shank of the mushroom anchor is united to the mushroom top, by which the shank of the adze anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer and the pickaxe also are united together. Now a patent for a machine each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good, because there is a novelty in the combination. But here the case is perfectly different: formerly three pieces were united together; the plaintiff only unites two, and, *if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent;* but unfortunately the mode was well known and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, *when that union is effected in a mode well known and long practised for a similar purpose.* It seems to me, therefore, that there is no novelty in that part of the patent as affects the anchor, and if the patent had been taken out for that alone I should have had no hesitation in declaring it bad. Then, if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part as to the mooring chain? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if the party applies for a patent, reciting that he has discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me that the case of *Hill* v. *Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. In that case the patent was granted to the plaintiff for the invention of certain

improvements in the smelting and working of iron; and the Court of Common Pleas appears to have considered that the improvement introduced by the plaintiff into what may properly be called the smelting of iron was the obtaining iron from that cinder and slag which before had been thrown away as refuse, and that may be considered as new. It appeared, however, that the plaintiff claimed further the merit of having discovered that the application of lime in certain stages of the process would cure a disease common to all iron, not merely to that which he was to produce, but to iron originally manufactured from the fresh ore. Now it turned out that that was not a discovery, for the application of lime to iron made from the cinder, originally used in making ore, was known and practised before. No two things can be more distinct in their nature than the obtaining of iron from a material from which it was impracticable to obtain it before, and the cure or prevention of a disease to which all iron was subjected. In that case, however, the Court of Common Pleas held that, admitting there was novelty in the one, yet as there was no novelty in the other, the patent was wholly void. The only difference between that case and this is, that here the plaintiff, instead of saying that he has made certain improvements, states the improvements; but still he claims the merit of having invented improvements in all the three, and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention."

Want of Novelty in Part.

Consideration is entire.

Though want of novelty in an essential part of the consideration (*p*) invalidates a patent, if a specification claims an old thing for use only in connection with, and as subsidiary to, something else which is new, want of novelty in the old thing forming the basis of the subsidiary claim does not invalidate the grant. (*q*)

Claim to an old thing is not fatal if subsidiary to something new.

Thus, in *Plimpton* v. *Spiller*, (*r*) a patentee claimed first a mode of applying rollers and runners to the footstand of skates so that they might be cramped or turned so as to cause the skate to run in a curved line by the canting or tilting of the footstand; and secondly, the mode of securing the runners and making them reversible, as described. The

(*p*) p. 113 *ante*.
(*q*) p. 260 *post*.
(*r*) (1877) L. R. 6 Ch. D. 412; *co* p. 260 *post*.

Analogous Uses. Novelty and Discovery.

Court of Appeal held that, assuming there was nothing novel in the mode of securing the runners to the footstand, yet the want of novelty in the second claim did not invalidate the patent, because the second claim was for a subsidiary invention to be used only in connection with the principal invention.

## Analogous Uses.

Prior analogous use may or may not be publication.

A perfectly valid patent may be obtained for an invention which consists in a new application of a thing which was perfectly well known before. Of course the application which is the subject of the subsequent patent must be totally distinct and novel as compared with any application previously made, and it is always a question of evidence as to whether former applications are so analogous to the one claimed by the subsequent patentee as to amount virtually to the same and so render his patent bad as claiming that which is in fact not new. (*s*) The use of a thing for one purpose is not an anticipation of a patent which claims the use of the same thing for a totally different purpose. (*t*)

## Novelty and Discovery.

Distinction between novelty and discovery.

There is a great distinction between novelty and discovery; for a thing may have been discovered before, and in that sense not be new, but if the previous discovery has never been made public, or substantially used, it will not be sufficient to upset the patent of a subsequent discoverer on the ground of want of novelty. (*u*)

This will appear from a contrast of *Dollond's Case* (*x*) with *Tennant's Case*,(*y*) and *R.* v. *Arkwright*.(*z*) In *Dollond's Case* the question was, "Who was the true inventor within the meaning of the statute? *Hall* had made the discovery in his closet, but had never made it public; and, on this ground, *Dollond's* patent was confirmed. In *Tennant's Case* the great utility of the invention, which related to bleaching, was proved by the evidence of persons engaged in the trade. On the other hand, a bleacher near Nottingham deposed that

(*s*) pp. 80–98 *ante*.

(*t*) *Ibid.*; Westley *v.* Tolley, (1894) 11 R. P. C. 602; Mathews *v.* Parmenter, (1896) 13 R. P. C. 511.

(*u*) Hill *v.* Thompson, (1818) per Dallas, J., Holt, N. P. C. 636; 2 Moore, 429; 8 B. Taunt. 382; 1 W. P. C. 244; see also p. 136 *post*.

(*x*) (1776) 1 W. P. C. 43.

(*y*) (1795) 1 W. P. C. 125 *n*.

(*z*) (1785) 1 W. P. C. 71.

Anticipation and Publication.

he had used the same means of preparing bleaching liquor for six years previous to the date of the patent, but that he had kept his method a secret from all but his two partners and his two servants concerned in preparing it. In addition to this, different conversations were proved to have passed between *Tennant* and a chemist of Glasgow, before the patent, and in these conversations the chemist had suggested to *Tennant* the basis of the improvement in question. Under these circumstances, *Tennant* was deemed not to be the inventor, and a nonsuit was obtained. In the case of *Arkwright's* patent, with respect to a particular roller forming part of a machine, the evidence was that *Arkwright* had been told of it by one *Kay*; that, being satisfied of its value, he took *Kay* as a servant, kept him for two years, employed him to make models, and afterwards claimed it as his own invention, and made it the foundation of a patent. The same fact was proved as to a crank, which had been discovered by a person of the name of *Hargreave*, which also had been adopted by *Arkwright*. And although it had been made use of to some extent before by a few, a general ignorance with respect to it was proved by a great number of persons in the trade. *Buller*, J., was of opinion that, though it might be perfectly true—that is, the general ignorance as to these improvements—it signified nothing; the fact that the witnesses on the part of the defendant had not heard of those improvements was no contradiction of previous knowledge and previous use by others.

## Anticipation and Publication.

Distinction between anticipation and publication.

It must also be noticed that there is a great distinction between anticipation and publication. An invention has been anticipated when it has been previously made; and it has been published when it has been previously made and disclosed. In the case of *Dollond's* patent, (*a*) *Hall's* discovery was an anticipation of *Dollond's*, but not a publication of it, whereas in *Tennant's Case*, and *R.* v. *Arkwright*, (*b*) the subject of the patent, in each, had not only been anticipated, but had also been published before.

(*a*) p. 116 *ante*.

(*b*) p. 116 *ante*.

Equivalents.

## Equivalents.

Rediscovery of a Lost Art.

If an invention differs only from a previous invention in that for one part in the former invention there is substituted an equivalent, though somewhat different part in the latter, the mere substitution of the equivalent will not be sufficient to sustain a patent for the second invention, if the analogous parts were known at the date of the first patent to be equivalents; (*c*) but any person may obtain a patent, valid as regards novelty, for the use of equivalents, which were not taken to be equivalents at the time the patent for the former discovery was granted. (*d*)

Prior use of equivalents may or may not be publication.

## Rediscovery of a Lost Art.

Is the rediscovery of a lost art a patentable novelty?

It may be questioned whether if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of, such a state of facts would prevent, on the ground of want of novelty, a person who subsequently rediscovered the invention from obtaining a valid patent in respect of it.

There does not appear to be any judicial decision one way or the other on this point, which was noticed by Lord *Lyndhurst*, L.C., in *The Househill Co.* v. *Neilson*. (*e*) The House of Lords in that case purposely refrained from expressing an opinion on the question, which did not then call for decision. It would appear from an application of the principles in this chapter discussed, that if the invention has ever been the subject of a patent less than fifty years old, or has been described in some written document, which can be produced, the fact that the invention has been lost sight of, and not been used by the public for a long time, will not enable a later discoverer to obtain a patent for it, as he would clearly not be the true and first inventor. (*f*) A state of facts might, however, be supposed in which the case would be different. For instance, (*g*) an encaustic tile or a particular kind of stained glass might be perfectly well known to exist at the present day, but the mode of producing the tile, or the particular kind

(*c*) Heath *v.* Unwin, (1854) 5 H. L. Cas. 505; 2 W. P. C. 279; see p. 73 *ante*.

(*d*) Heath *v.* Unwin, (1854) 5 H. L. Cas. 505, 538; Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) 2 R. P. C. 90; see p. 73 *ante*.

(*e*) (1843) 1 W. P. C. 717.

(*f*) See p. 72 *ante*.

(*g*) 1 W. P. C. 718 *n*.

Prior User.

of glass, might be a long-lost art. In such a case, if an inventor newly discovers the art of producing the encaustic tile, or the particular kind of glass, there does not appear to be any rule of law depriving the Crown of the right to grant a patent securing to the inventor the monopoly of the art which he may have discovered. For it must be observed that the fact of the existence of the result which the alleged newly discovered art produces only proves conclusively that *an art* of producing that result must have been previously known, not that *the art* which the patentee has described was ever before practised. There may be many ways of arriving at a known result, and, as has been pointed out, (*h*) each one of those ways, provided they are all different, may be the subject of a patent. (*i*) If the existing result convey at once to an observer information as to the way in which it was obtained, and that way is an exercise of the art which the patentee has described, then the previous existence of the result would make the patent void, there being no consideration given to the public. In such circumstances the patentee would only have described an invention which the public was already possessed of, as shown by the existence of the result. (*j*)

## Publication by Prior User.

Prior unsuccessful experiment or useless machine is no publication.

It is evident that a knowledge of an invention cannot possibly be communicated to the public until the invention has been completed either by the patentee or some one else before him, and it therefore follows that any experiment made prior to the date of the patent, which resulted in failure, or only a partial success, cannot, even though published, amount to a disclosure of a perfected discovery. A machine which is useless, and a failure, is not an anticipation of a similar machine effecting the object for which the useless machine was designed, though there may be a degree of similarity in the details of the two. (*k*)

Thus, a machine designed by the patentee to be used for

(*h*) p. 63 *ante*.

(*i*) See Morgan *v.* Windover, (1888) 5 R. P. C. 306.

(*j*) See Milner's Patent, (1898) 15 R. P. C. 205.

(*k*) Cornish *v.* Keene, (1835) 1 W. P. C. 508; Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570; 15 Eq. 115; 1 W. R. 498; 42 L. J. Ch. 191; Tangye *v.* Stott, (1865) W. N. 1886, p. 63; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Stead *v.* Williams, (1843) 2 W. P. C. 135; Barlow *v.* Bayliss, (1875) 1 Griff. P. C. 44; Shaw *v.* Jones, (1889) 6 R. P. C. 336; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205.

Prior User.

the novel process of disinfecting by steam at high pressure, was held not to be anticipated by a very similar machine which was structurally incapable of being used with steam at high pressure. (*l*)

A mere experiment, supposed by the person making it to be fruitless, and abandoned because it was not brought to a complete result, will not prevent a more successful investigator, who adds the last link of improvement towards bringing it to a state of perfection, from maintaining a patent for the invention; (*m*) nor does the publication of a method of achieving a particular result vitiate a patent for achieving that result by different means involving the exercise of invention. (*n*)

Law of anticipation by experiments stated by Tindal, C.J.

*Tindal*, C.J., in *Cornish* v. *Keene*, (*o*) stated the law of anticipation by experiments in the following words:—

> "A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiments and therefore that he was not the first discoverer of it, because there may be many discoverers starting at the same time, and many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and enjoy its benefits."

And again, the same learned Judge directed a jury that a mere experiment, or a mere course of experiments, for the purpose of producing a result, which is not brought to its completion, but begins and ends in uncertain experiments, is not such an invention as should prevent another person, who is more successful or pursues with greater industry the chain

(*l*) Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 334; 11 R. P. C. 354.

(*m*) Galloway *v.* Bleadon, (1839) 1 W. P. C. 529; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Tangue *v.* Stott, (1865) W. N. 1886, p. 68; Stead *v.* Williams, (1843) 2 W. P. C. 135; Hills *v.* London Gas Light Co., (1860) 5 H. & N. 312; Otto *v.* Linford, 46 L. T. N. S. 39.

(*n*) pp. 62-64 *ante*; Hills *v.* London Gas Light Co., (1861) 5 H. & N. 312; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Hullett *v.* Hague, (1831) 1 Carp. R. 501; 2 B. & A. 370; Minter *v.* Mower, (1835) 1 W. P. C. 140.

(*o*) Cornish *v.* Keene, (1835) 1 W. P. C. 508; but see Vol. II. chap. i.

in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it. (*p*)

Prior User.

It is a question of fact in each case whether a prior user, which is relied on as a publication of the invention claimed by a subsequent patentee, was a complete publication or only an incomplete experimental user. (*q*)

Publication by experiment or abandoned user is a question of fact.

An invention abandoned must be *primâ facie* presumed not to have been completed, but to have rested in experiment and trial; but if it was completed it does not signify whether it was completely abandoned, or whether it was continued to be used down to the very date of the patent, provided that it was published. (*r*)

An invention abandoned is presumed to have been a failure.

The following cases illustrate this point:—

Illustrative cases.

In *Taylor's Patent*, (1896) 13 R. P. C. 482, it appeared that the patentee had made certain experimental trials of the patented article (a grate) in his own house, and also had used the complete article in the presence of visitors to whom it had been explained. The Court held that though part of the use relied on to invalidate the patent was merely experimental, yet there had also been public user before the date of the patent, and so made an order for its revocation.

Taylor's patent.

In *Jones* v. *Pearce*, (1832) 1 W. P. C. 122, the patent called in question was for "improvements in wheels for carriages," and the defendant proved at the trial that, prior to the date of the plaintiff's patent, wheels similar to those described in the specification had been made by a Mr. *Strutt*. *Patterson*, J., directed the jury that if they were of opinion that Mr. *Strutt's* invention was an experiment, that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects of Mr. *Strutt's* wheel, then there was no reason for saying that the plaintiff's patent was not good.

Jones v. Pearce.

(*p*) Galloway *v.* Bleadon, (1839) 1 W. P. C. 529; see also Bereton *v.* Richardson, (1884) 1 R. P. C. 165; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 211; Humpherson *v.* Syer, (1887) 4 R. P. C. 184, 188; Morgan *v.* Windover, (1887) 4 R. P. C. 417; 5 R. P. C. 295; 7 R. P. C. 131; Edison *v.* Swan, (1889) 6 R. P. C. 277; Winby *v.* Manchester Tramways Co., (1889) 6 R. P. C. 359; 7 R. P. C. 30.

(*q*) Mathews *v.* Parmenter, (1896) 13 R. P. C. 514; Williams *v.* Gowan, (1895) 12 R. P. C. 387; Hagginmacher *v.* Watson, (1897) 14 R. P. C. 349, 631; Dutton *v.* Brierley, (1897) 14 R. P. C. 685; Dowler *v.* Keeling, (1898) 15 R. P. C. 214; Haskell Golf Ball Co., Ld. *v.* Hutchison, (1905) 22 R. P. C. 477; 23 R. P. C.

(*r*) The Household Co. *v.* Neilson. (1843) 1 W. P. C. 709, 713; Galloway *v.* Bleaden. (1839) 1 W. P. C. 525; Morgan *v.* Windover, (1888) 5 R. P. C. 295, 303; Dowrance *v.* Fletcher, (1899) 16 R. P. C. 150; Crossley *v.* Coates. (1904) 21 R. P. C. 282; Haskell Golf Ball Co., Ld. *v.* Hutchison, (1905) 22 R. P. C. 477.

**Prior User.**

Publication by experiment or abandoned user is a question of fact. Illustrative cases.

Carpenter *v.* Smith.

In *Carpenter* v. *Smith*, (1841) 1 W. P. C. 534, Lord *Abinger*, C.B., expressed the same thing thus: "A man is entitled to a patent for a new invention, and if his invention is new and useful he shall not be prejudiced by any other man having invented that before and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them."

Household Co. *v.* Neilson.

In *Household Co.* v. *Neilson*, (1843) 1 W. P. C. 673, the Lord Justice-Clerk *Hope* had directed the jury to the effect that a prior abandoned user of the invention was not fatal to the validity of the patent, and, on the finding of the jury, had entered a verdict for the plaintiff. The defendant company thereupon appealed to the House of Lords, and the House held that the direction of the learned Lord Justice-Clerk was bad in law, and reversed the judgment of the Court of Session. The judgment of Lord *Brougham* contains the following passage (1 W. P. C. 713):—

"Now, see how this mistake, with respect to the abandonment and continuance, arose. If an invention has not been completed, but if it all rests in experiment and trial, then it is a most material circumstance as a test whether any given act of a party other than the invention [*sic*, inventor] was trial or complete invention; it is a most salutary and important test to apply with a view to ascertain that, to see whether he abandoned or continued it. If he abandoned it, if he gave it up altogether, and for twenty or thirty years did nothing, it is a very strong presumption that it was only experimental—not an invention completed. But suppose it was complete, and suppose it is admitted not to have been a trial—suppose it is allowed to have been an invention executed, if I may so speak, not merely executory, or not merely in the progress of invention, but an invention completed—then it is one of the greatest errors that can be committed, in point of law, to say that, with respect to such an invention as that, it signifies one rush whether it was completely abandoned or whether it was continued to be used down to the very date of the patent. Provided it was invented and publicly used at the time, twenty or thirty years ago, in this case forty years ago, it is perfectly immaterial, not immaterial to the second question, the second condition—namely, whether it was used or not at the time of the granting of the patent—but totally immaterial to the other question, which is equally necessary to be ascertained in the inventor's favour, whether or not he was the first and true inventor—for he must be the first and true inventor, as well as the only

person using it at the time, otherwise he is not entitled to the letters patent. Therein lies the error which has been committed by the learned Judge."

Prior User.

Publication by experiment or abandoned user is a question of fact.

Illustrative cases.

In *Walton* v. *Bateman*, 1 W. P. C. 619, (s) the validity of *Walton's* patent for "improvements in cards for carding wool, cotton, silk, and other fibrous substances," was questioned, on the ground that the improvement consisting in using caoutchouc as a substitute for leather as an elastic bed in which to fix the teeth, was not novel. It appeared in evidence that a certain material called "*Hancock's* patent leather," had been manufactured and sold prior to the date of the patent, and it was contended that this "*Hancock's* patent leather" was substantially the same thing as the elastic bed in which the teeth of the plaintiff's cards were fixed, and further, that *Hancock's* material had been supplied to certain manufacturers during a period of about a year and a half, several years before the date of the plaintiff's patent, and that it had been used in the construction of cards, but had not been so used since that time. *Cresswell*, J., said to the jury: "Supposing that the article did embody the principle of the plaintiff so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be whether that use is not to be considered rather in the nature of an experiment than of any public user of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture."

Walton v. Bateman.

And, in *Stead* v. *Williams*, (1843) 2 W. P. C. 135, the same learned Judge observed: "I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a mere experiment that had been found to be a failure, and thrown aside. If a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside, and the thing is forgotten and gone by, then another person re-introducing it may, within the meaning of the Act, be the inventor and the first user of it, so as to justify a patent."

Stead v. Williams.

In *Hills* v. *London Gas Light Co.*, (1860) 5 H. & N. 312, the finding of the jury that one *Croll* had by means of the method for which the plaintiff had subsequently obtained a patent, purified many thousand feet of gas, but that this user was by way of experiment only, saved *Hills'* patent from being upset on the ground of want of novelty. And the Court refused to grant a new trial, the judgment containing the following passage: "The word 'experiment,' in the cases referred to, has been used, not as the sole test upon a matter of this sort, but

Hills v. London Gas Light Co.

(s) See also Tangye *v.* Stott, W. N. 1866, p. 68; 14 W. R. 128, 386.

**Prior User.**

Publication by experiment or abandoned user is a question of fact.

Illustrative cases.

as indicating a class of practice, and for the purpose of showing that if there has been a user of an invention not of a substantial character, but in the character of an experiment, then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what *Croll* did may not have been strictly in the nature of an experiment, still the jury have so found it, and we cannot grant a new trial." (*t*)

Re Adamson's patent.

In *Re Adamson's Patent*, (1856) 6 De G. M. & G. 420; 25 L. J. Ch. 456, on the other hand, where a person invented certain machinery during the fulfilment of a contract for the building of a pier, and used that machinery for four months in a place to which the public had access, before applying for the patent, and, after the utility of the machinery in question had been determined and profit had been derived from the public user, made an application, he was held not to be entitled to a patent.

Experimental user, though pecuniarily profitable, is not necessarily publication.

An inventor may, in certain cases, derive pecuniary profit from an experimental user of his invention before applying for protection, without rendering his patent subsequently obtained deficient on the ground of want of novelty. Thus, in the case of *Newall's* patent for "improvements in apparatus employed in laying down submarine electric telegraph wires," experiments on dry land were necessarily not sufficient to prove the utility of the apparatus for the purpose for which it was designed, and *Newall* accordingly tested the practicability of the invention during the laying of a submarine cable under a Government contract. The Court held that this user, notwithstanding the fact that *Newall* had unavoidably disclosed it to others and had derived profit from it, was only experimental, and did not prevent him obtaining a valid patent for the invention. (*u*) The point in *Newall's* case is that there the experimental trial was to prove and test the utility of the invention itself in contradistinction to the working efficiency of a complicated machine, constructed according to an invention already known to be useful. This distinguishes *Newall* v. *Elliott* from the above-cited case of *Re Adamson's Patent*, or a case like *Hoe* v. *Foster*, (*v*) where it was unsuccessfully sought to establish that certain preliminary trials and alterations in a complicated machine constructed according to an invention subsequently patented, but at the date of the trials

(*t*) See also Lewis *v.* Marling, (1829) 10 B. & C. 22; 4 Car. & P. 57; 1 W. P. C. 493.

(*u*) Newall *v.* Elliott, (1858) 4 C. B. N. S. 269; see also Morgan *v.* Seaward, (1837) 1 W. P. C. 194.

(*v*) (1898) 16 R. P. C. 33.

known to be useful, were only experiments which did not invalidate the subsequently obtained patent. The preliminary trials were made by persons other than the patentee (though probably only in conjunction with the patentee) and not under terms of secrecy towards him; and the machine satisfactorily performed its functions before the date of the patent and was not constructed for the purpose of testing the utility of the invention which was already established. Prior User.

Apart from experimental user it is to be observed that it is competent for a person himself before the date of a patent to use the invention, the subject of the grant, in either or both of two ways. First, he may use it openly in such a manner that the user will convey to the mind of any one seeing it a knowledge of what the invention consists, *e.g.*, if the alleged invention relate to the particular construction of a lock, any person who has before the date of the patent so constructed a lock, and publicly used it in this country so as to exhibit the construction, will thereby have published the invention, and any subsequent patent for it could not be sustained. (*x*) Secondly, the inventor may so use his invention that the user will not enable any one seeing it to discover in what the invention really consists—*e.g.*, in the case of a chemical invention, a dye for instance, the dye might be produced and known, but the existence of it would not demonstrate the method according to which it was prepared, and no person other than the manufacturer in possession of the secret would be able to produce it—in such a case it is submitted, for reasons which will appear hereafter, (*y*) that such a user would not prevent the manufacturer, though it might prevent another person who should discover the secret, from obtaining a patent valid on the ground of novelty for the invention. (*z*) Thus, a prior user of an invention may be made in public or in secret. It is well settled law that, if the invention has been used publicly, a subsequent patent would, under sec. 6 of the Statute of Monopolies, be void, (*a*) whereas if the user has only been secret, the grant *may* be sustained, (*b*) and this Prior user of the invention by the patentee himself.

(*x*) See Carpenter *v.* Smith, (1841) 1 W. P. C. 530, 534; also Stead *v.* Williams, 2 W. P. C. 136; Heath *v.* Smith, (1854) 2 W. P. C. 278; Honiball *v.* Bloomer, (1854) 10 Exch. 588; Honiball's Patent, (1855) 2 W. P. C. 209; Young *v.* Fernie, (1863) 4 Giff. 577; Bereton *v.* Richardson, (1884) 1 R. P. C. 177; Poulton's Patent, (1906) 23 R. P. C. 183.

(*y*) pp. 135-137 *post.*

(*z*) See Hancock *v.* Somervell, (1851) 39 Newton, L. J. 158.

(*a*) Cornish *v.* Keene, (1835) 1 W. P. C. 508.

(*b*) Dollond's Case, (1776) 1 W. P. C. 43; but see p. 136 *post.*

Prior User.

whether the user has been by the inventor himself, (*c*) or by a manufacturer for the inventor under terms of secrecy to him, (*d*) or his workmen. (*e*) It may be open to question, however, as to whether if a patentee has made profit by a prior secret user of the invention, he has not thereby rendered his subsequent patent null and void. (*f*)

Prior public use of one specimen sufficient to invalidate the patent.

The public use of only one specimen of a patented article, (*g*) even if by only one person, (*h*) is quite sufficient to invalidate a subsequent patent.

Meaning of "public use and exercise," per Lord Abinger.

Lord *Abinger*, explaining to a jury what in the patent law sense is meant by the "public use and exercise" of an invention which will render a subsequent patent void on the ground of want of novelty, used the following words :—

> "I think that what is meant by 'public use and exercise' is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a celebrated work by the Marquis of *Worcester*, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. So that the meaning of these words, 'public use,' is this: that a man shall not by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right which another man has to a patent for the same invention. Now, 'public use' means this: that the use of it shall not be secret, but public. . . . If a man invents a thing for his own use, whether he sells it or not—if he invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what

(*c*) Smith *v.* Davidson, (1857) 19 Court of Sessions, 2nd ser. 691; Bentley *v.* Flemming, (1844) 1 Car. & K. 587.

(*d*) Morgan *v.* Seaward, (1837) 1 W. P. C. 187; Useful Patents Co. *v.* Rylands, (1885) 2 R. P. C. 235; Humpherson *v.* Syer, (1887) 4 R. P. C. 407; Kurtz *v.* Spence, (1888) 5 R. P. C. 161.

(*e*) Betts *v.* Menzies, (1857) 1 E. & E. 1008.

(*f*) See pp. 135-137 *post*.

(*g*) Honiball *v.* Bloomer, (1854) 10 Exch. 538; Honiball's Patent, (1855) 2 W. P. C. 201, 209; Carpenter *v.* Smith, (1841) 1 W. P. C. 530, 534; Young *v.* Fernie, (1863) 4 Giff. P. C. 577; Berdon *v.* Richardson, (1884) 1 R. P. C. 177; Sinnett's Patent, (1898) 15 R. P. C. 761.

(*h*) Stead *v.* Williams, (1843) 2 W. P. C. 136; Heath *v.* Smith, (1854) 2 W. P. C. 278.

the consequences would be. If Mr. *Davies* has a lock which he directed to be made and put on his gate sixteen years ago at least; if that was not a public use which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it. How can he be the inventor of it? Because, to obtain a patent, a man must be the inventor; and if it has been once in public use (that is, used in a public manner, not used by the public), yet if it has been used by half a dozen individuals or one in a public manner, any man having access to it, how can he be said to be the inventor if by merely gaining access to that he takes out a patent? . . . A man cannot be said to be the inventor of that which has been exposed to public view, and to which he might have had access if he had thought fit. . . . If you are of opinion (not that they were generally adopted by the public and used by the public, for that in my opinion is a perfect fallacy) that the use of them is public, and the exercise of the invention was public, and not kept secret so that the public might have no benefit from it, then I think that part of the issue you ought to find for the defendant." (*i*) The jury found for the defendant, and on a motion for a new trial, on the ground of misdirection, the Court of Exchequer approved of the statement of the law made by Lord *Abinger*, *Alderson*, B., adding these words: (*k*) "Public use means a use in public, so as to come to the knowledge of others than the inventor as contradistinguished from the use of it by himself in his chamber." (*l*)

Prior User.

Per Alderson, B.

To rebut the claim of novelty, it is not necessary to show that the invention has been used by the public; it is quite sufficient to establish that it has been used in public as contradistinguished from being used in secret, (*m*)—*e.g.*, to show that an article has been openly manufactured (*n*) or exhibited in a workshop, (*o*) where all or some of the workmen knew the process of its manufacture, or that a model has been exhibited to persons interested in the subject-matter of the invention without any concealment, secrecy, or confidence, (*p*)

Use in public not necessarily use by the public, avoids a patent

(*i*) Carpenter *v.* Smith, (1841) 1 W. P. C. 530, 534, 535, 540.

(*k*) 1 W. P. C. 542.

(*l*) See Croysdale *v.* Fisher, (1884) 1 R. P. C. 21.

(*m*) Carpenter *v.* Smith, (1841) 1 W. P. C. 530; Stead *v.* Williams, (1843) 2 W. P. C. 136; Stead *v.* Anderson, (1846) 2 W. P. C. 149; Hancock *v.* Somervell, 39 Newton, L. J. 158; Honiball *v.* Bloomer, (1854) 2 W. P. C. 199; Young *v.* Rosenthal, (1884) 1 R. P. C. 32.

(*n*) Croysdale *v.* Fisher, (1884) 1 R. P. C. 17; Lister *v.* Norton, (1886) 3 R. P. C. 199; Heath *v.* Smith, (1854) 3 E. & B. 256; Betts *v.* Neilson, (1868) L. R. 3 Ch. 436.

(*o*) Humpherson *v.* Syer, (1887) 4 R. P. C. 407; but see Electroplating Apparatus Co. *v.* Holland, (1901) 18 R. P. C. 527.

(*p*) Winby *v.* The Manchester, &c., Steam Tramways Co., (1891) 8 R. P. C. 61.

Prior User.

or that the article has been used in a private house under such circumstances that visitors thereto could comprehend the invention. (*q*)

The following are illustrative cases :—

Tennant's case.

In *Tennant's Case*, (1798) 1 W. P. C. 125, the patent was for a method of using certain calcareous earths instead of alkaline substances, by neutralising the oxygenated muriatic acid used in bleaching, &c. The great utility of the invention, and the general ignorance of bleachers with respect to such bleaching liquor before the date of the patent, were established in evidence. It was, however, proved that a bleacher had used the same means of preparing his bleaching liquor for five or six years prior to the date of the plaintiff's patent, and that he had kept his method a secret from all but his two partners and two servants concerned in preparing it ; and a chemist deposed that having, in 1796, had frequent conversations with the plaintiff on the means of improving bleaching liquor, he had in one of them suggested that he would probably attain his end by keeping the lime water constantly agitated ; that the plaintiff afterwards had found the method successful and embodied it in his claim. Lord *Ellenborough*, C.J., who tried the case, nonsuited the plaintiff, holding that the above evidence established a prior publication of the invention.

Losh v. Hague.

*Losh* v. *Hague*, (1838) 1 W. P. C. 202, was a case in which damages were sought for the infringement of *Losh's* patent for "certain improvements in the construction of wheels for carriages to be used on railways," and it was established, to the satisfaction of the jury, that wheels made on the same principle as those claimed by *Losh*, had been constructed before the date of his patent, though they had not been previously used on railways. The invention was, under these circumstances, held not to be novel, Lord *Abinger*, C.B., pointing out to the jury that if the wheels had been made and sold to any one individual, it made no difference though the public did not want them, because there were no railways, and they were not adapted to any particular use to which at that time the public could apply them (1 W. P. C. 205).

Muntz v. Foster.

In *Muntz* v. *Foster*, (1844) 2 W. P. C. 96, it was proved that *Muntz* discovered, in a particular combination of metals made before, a hidden virtue or quality which had never before been noticed, and in consequence of this discovery he was enabled to apply the metal to a new and useful purpose, and thereby became entitled to a patent for the application, under the name of "an improved manufacture of metal plates for strengthening

(*q*) Taylor's Patent, (1836) 13 R. P. C. 432; Stead *v.* Williams, (1843) 2 W. P. C. 136.

the bottoms of ships or other such vessels." *Tindal*, C.J., in summing up to the jury, used these words: "I look upon the invention to consist in this, that *Muntz* has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing by reason and by means of its oxidating just in sufficient quantities—that is, not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep by its wearing the bottom of the vessel clean from those impurities which before attached to it. And if it was shown, as it possibly might be, that sheets had been made of metal before, in the same proportions which he had pointed out, and if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground, and proper ground, of a patent; and therefore when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose. . . . I do not think that the circumstance of showing that the combination of these two materials in a metal plate will of itself destroy this patent, when no attention at the time was paid to the purpose for which this patent was taken out, and it was made merely in the ordinary course of melters of metal for the various and ordinary purposes of life. I do not think that the circumstances of showing that in the long time that has passed before us in the different, and, I may say, infinitely varying, combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose; it does not appear to me that such destroys the patent." Prior User.

*Muntz* v. *Foster*, (1844) 2 W. P. C. 96, is to be distinguished from *Losh* v. *Hague*, (1838) 1 W. P. C. 203, in that in the former case the patent was for a result which had been arrived at casually before, and there was merit in discovering a hidden virtue in the result which made it applicable to a particular Muntz v. Foster and Losh v. Hague distinguished.

Prior User.

purpose and capable of sustaining a patent, whereas, in the latter case, the result was known before, but the application to the particular purpose (which was self-evident) was not made because the occasion had never arisen, and the patent was therefore held void.

Lewis *v.* Marling.

In *Lewis* v. *Marling*, (1829) 10 B. & C. 22; 4 Cas. & P. 57; 1 W. P. C. 493, the patent related to a shearing machine in which the novelty consisted in shearing from list to list. It was proved at the trial that a similar machine had been made previously to the patent, and was tried by a person called on behalf of the defendant, but he did not think it answered, and soon discontinued the use of it. It was also proved that a model had been sent over from America and shown to a few persons, but no machine was made from it, and also that a specification had been brought over from America and two persons employed to make a machine from this, which, however, was never completed, so that, before the patentee's, no machine was publicly known or used in this country for shearing from list to list. Lord *Tenterden*, C.J., directed the jury that if it could be shown that the patentees had seen the model or specification, that might answer the claim of invention, but there was no evidence of that kind, and he left it to the jury to say whether the machine had been in public use and operation before the patent was granted, and they found that it had not.

On a motion for a rule *nisi* for a new trial this direction of Lord *Tenterden*, C.J., was approved of, *Bayley*, J., saying: "If I make a discovery and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else had made a similar discovery by his mind, unless it has become public. So if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have received previously a communication from abroad which would have enabled him to have made the machine."

Heath v. Smith.

In *Heath* v. *Smith*, (1854) 2 W. P. C. 268, it was proved that the process included in the plaintiff's claim had been practised by five manufacturers in the course of their trade before the date of the patent, and that whilst two of these manufacturers had kept the process a secret and the other three had practised it openly, it was not generally known till the plaintiff stated it in his specification. The Court of Queen's Bench held that there had been a public use of the process and that the patent was consequently invalid.

Abandoned prior user avoids a patent.

As has been already stated, (*r*) it is not necessary to show that the prior use relied on was continued up to the date

(*r*) p. 121 *ante*.

Prior User.

of the patent, for if there be a complete anticipation, by prior use, the abandonment of it is nothing, yet when it is a question whether there really was a machine perfected in accordance with the alleged invention, the fact that it had never been used for a number of years before the patentee took out his patent is most material, as leading to the conclusion that that which was made many years ago was not a machine in accordance with the invention. (*s*)

Applicant for a patent provisionally protected against public use of the invention.

An inventor who, before applying for a patent, uses his invention in such a manner as to convey to the public a knowledge of it, or allows it to be used by the public, will thereby render his patent just as invalid on the ground of want of novelty as if a prior public use and exercise by persons other than himself were shown to have existed. (*t*) But after the inventor has sent in his application for a patent, and the same has been accepted, and before the patent is sealed, he is justified in using the invention in public, and will not by such use render the grant void; but he is not entitled to use, in connection with the apparatus manufactured according to the invention, the word "patent" until his complete specification has been accepted. (*u*) Any use or publication during the period of provisional protection of an invention for which an application has been made in fraud of the true and first inventor, will not invalidate a patent granted to him. (*v*)

Fiduciary communications of invention prior to application.

An inventor may, before making application for a patent, entrust his invention to another person, bound to him by terms of confidence and secrecy, for the purpose of making experiments, with a view to rendering the invention more perfect and efficient, and such an experimental user, though to a certain extent a user in public, will not necessarily invalidate a subsequent patent. (*x*)

Foreign applicant protected against publication.

The combined effect of Art. 4 of the International Convention of 1883, (*y*) secs. 103 and 104 of the Act of 1883, and sec. 1 of the Act of 1901, is to protect any person who has duly registered

(*s*) Per Lord Brougham, The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 673; Tangye *v.* Stott, (1865) W. N. 1866, p. 68; Morgan *v.* Windover, (1888) 5 R. P. C. 303; King, Brown & Co. *v.* Anglo-American Brush Co., (1889) 6 R. P. C. 414; pp. 119-121, *ante*.

(*t*) p. 125 *ante*.

(*u*) 46 & 47 Vict. c. 57, ss. 14, 15; R. *v.* Townsend, (1876) 13 R. P. C. 265; In Row on the prosecution of Crow *v.* Wallis, (1886) 3 R. P. C. 1; and R. *v.* Crampton, (1886) 3 R. P. C. 367, the complete specification had not been accepted.

(*v*) See 46 & 47 Vict. c. 57, s. 35, Vol. II. p. 216.

(*x*) Bentley *v.* Flemming, (1844) 1 Car. & K. 578; Morgan *v.* Seaward, (1837) 1 W. P. C. 193, 195; Humpherson *v.* Syer, (1887) 4 R. P. C. 414; Useful Patents Co. *v.* Rylands, (1885) 2 R. P. C. 262.

(*y*) See Appendix, Vol. II.

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an application for a patent in any of the States of the Union, during a period of twelve months from the date of such application, against the ordinary consequences of publication of the invention in this country. Such a person has a right of priority to a British patent at any time before the expiration of such period of twelve months from the date of his application in the foreign State, notwithstanding that in the meanwhile the invention may have been published in this country.

It must be remembered that the period of twelve months, during which protection from publication is afforded to the inventor, dates from the first application in one of the States of the Union, and not from the last of several applications in different States.

Exhibition of invention at industrial or international exhibitions prior to application for a patent.

If an inventor desires to exhibit at an industrial or international exhibition an invention for which he has not applied, but intends to apply, for protection by letters patent, he can do so without thereby rendering his subsequent patent, if obtained, null and void, by proceeding under sec. 39 of the Patents, &c., Act, 1883, and Rule 27 of the Patent Rules, 1903. The section of the Act referred to enacts that the exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purposes of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor, or his legal personal representative, to apply for, and obtain, provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:

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

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

Rule 27 of the Patent Rules, 1903, (*z*) provides that the inventor shall give to the Comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the

(*z*) See Appendix, Vol. II.

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case may be, and for the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

Delay in applying for a patent is undesirable.

The fact of an inventor having kept his invention secret, after it has been brought to completion, does not, at any rate if there has been no profitable use of it, (*a*) deprive the Crown of its right to grant a patent on the application of such inventor, (*b*) but delay on the part of the applicant is extremely undesirable, because it is always possible that some one else may make an application first, and so get a prior right to a patent. (*c*)

Offering for sale is publication;

If an inventor manufacture and offer for sale an article made in accordance with his invention before the date of his patent, even though no sale actually take place, he will thereby, if the nature of the invention can be understood from an inspection of the article, publish his invention and deprive himself of any right to become a patentee in respect of it. (*d*)

The public sale of a single specimen of a patented article before the date of the patent is sufficient to render the grant null and void, (*e*) though the sale was for export, (*f*) or as an experiment to ascertain whether there would be a demand for the article. (*g*)

but not if the article sold or offered for sale does not show the manner of its manufacture.

But if the article does not on the face of it show the manner in which it was made, it may be doubted whether such a manufacture and offering for sale by the inventor himself would deprive him of his right to a subsequent patent for the process of manufacture, (*h*) and the bare fact of the article having been made before the patent was obtained would not alone render it bad. (*i*)

(*a*) See p. 135 *post*.

(*b*) Bentley *v.* Flemming, (1844) 1 C. & R. 587; Bowman *v.* Taylor, (1834) 1 W. P. C. 293.

(*c*) Hancock *v.* Somervell, (1851) 39 Newton, L. J. 158.

(*d*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; Wood *v.* Zimmer, (1815) 1 Holt, N. P. C. 57; 1 W. P. C. 44; Morgan *v.* Seaward, (1837) 1 W. P. C. 194; Mullins *v.* Hart, (1852) 3 Car. & K. 297; Lister *v.* Norton, (1886) 3 R. P. C. 192, 207; Lifeboat Co. *v.* Chambers, (1891) 8 R. P. C. 418.

(*e*) Horniball *v.* Bloomer, (1885) 2 R. P. C. 199; Germ Milling Co. *v.* Robinson, No. 2, (1886) 3 R. P. C. 399; Hollins *v.* Capper, (1888) 5 R. P. C. 289.

(*f*) Carpenter *v.* Smith, (1842) 1 W. P. C. 541.

(*g*) Lister *v.* Norton, (1886) 3 R. P. C. 207.

(*h*) See p. 135 *post*; Hancock *v.* Somervell, (1851) 39 Newton, L. J. 158.

(*i*) Bramah *v.* Hardcastle, (1789) Holroyd, 81; Lewis *v.* Marling, (1829) 4 C. & P. 57; Moss *v.* Malings, (1886) 3 R. P. C. 378.

Prior User.

Publication is always a question of fact. In one case the manufacture of two pairs of paddle-wheels, under an injunction of secrecy, which were sold, boarded up, and shipped abroad, was held to be no publication. (*k*)

It has been held that when delay has arisen in the granting of a patent from causes over which the patentee had no control, the manufacture by him of articles made according to, and before the date of the patent, for sale after the seal of the Patent Office has been obtained, will not vitiate the patent. (*l*)

Loan of an article for the purpose of experiment need not be publication.

The loan of an article for the purpose of experiment, before the application for a patent in respect of it, need not amount to publication sufficient to avoid the patent when obtained.

Thus, in *Bentley* v. *Fleming*, (*m*) it appeared that a machine manufactured according to the invention had, before the date of the patent, been lent by the patentee to a friend for the purpose of trial, and that the machine was fixed in a room in a mill to which workpeople had access. *Cresswell*, J., who tried the case, held that the machine having been merely lent for the purpose of testing it, the use of it did not under the circumstances amount to a publication of the invention.

Manufacture by one person confidentially related to another.

In *Morgan* v. *Seaward*, (*n*) the Court of Exchequer thought that the manufacture of two pieces of machinery for a person connected in business with the patentee, under an injunction of secrecy and their user abroad, might not be such a publication as would vitiate a subsequent grant.

When an article has been manufactured and openly sold in England, even though it be manufactured and sold expressly for exportation abroad, the article has been published, and a subsequent patent for it will consequently be bad for want of novelty; but this must not be taken to mean that if a man abroad employ an agent in England to see if he can get an article manufactured according to a particular model, not with a view of making it public at all, but with the object of taking out a patent for it himself, he is thereby disentitled to the invention afterwards, because he employs a workman to assist him in it; or that if he had failed entirely some other man might not make the invention in England. (*o*)

(*k*) Morgan *v.* Seaward, (1837) 1 W. P. C. 187.

(*l*) Betts *v.* Menzies, (1862) 4 Jur. N. S. 477.

(*m*) (1844) 1 C. & R. 587.

(*n*) (1837) 1 W. P. C. 195.

(*o*) Per Lord Abinger, C.B., in Carpenter *v.* Smith, (1841) 1 W. P. C. 536.

Prior User.

Prior user in colony no legal bar.

Prior secret profitable user by the inventor.

It has been held that the prior user of an invention in a colony forms no legal bar to the granting of a patent for the same invention in this country. (*p*)

We have now to consider the question whether the fact of an inventor having made pecuniary profit by a secret user of his invention before the date of a subsequent grant of letters patent will render the grant invalid.

The question has never been judicially decided, though Lord *Campbell*, C.J., is reported, in *Heath* v. *Smith*, (*q*) to have given expression to the following *obiter dictum*: "If one party only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." And in *The Germ Milling Co., Ld.* v. *Robinson*, (*r*) the plaintiff elected to be nonsuited, on his own evidence of prior user of the invention, the validity of which was in contest, and did not take up the position of such prior user being secret.

The above remarks of Lord *Campbell*, C.J., must, from the context, be assumed to refer to a user by a person other than the patentee, and so do not directly bear on the question now under consideration. It is submitted, from the first principles of the patent law, that there does not appear any reason why an inventor should not be capable of receiving a grant of letters patent from the Crown at any time before he has disclosed his invention to the public and enabled them to practise it for themselves. The bargain between the patentee and the Crown (*s*) is, that the former discloses his invention and the manner in which it is to be performed, in exchange for a patent for a limited period from the latter, and it is evident that the patentee is capable of carrying out his part of the bargain, whether or not he has derived profit from what has hitherto been a secret use of the inventor.

The argument (*t*) that the patentee, by keeping the invention secret and making profit by its use before applying for a patent, would thereby obtain a monopoly longer than fourteen years, or the usual duration of the grant, is not at all conclusive; for it must be remembered that the Crown offers patent grants as rewards for the disclosure of useful inventions and the means

(*p*) Rolls *v.* Isaacs, (1878) L. R. 19 Ch. D. 268.

(*q*) (1854) 2 W. P. C. 278; but see Miller's Patent, (1898) 15 R. P. C. 213. See also Wood *v.* Zimmer, (1815) G. P. C. 502.

(*r*) (1886) 3 R. P. C. 254, 259.

(*s*) p. 106 *ante*.

(*t*) Morgan *v.* Seaward, (1837) 194; Germ Milling Co. Ld. *v.* Robinson, (1886) 3 R. P. C. 408, 409.

Prior User.

of performing them, for the public good, and it does not go into the past history of the inventor and insist on his having made the discovery within any fixed time prior to his application, but merely requires that it shall be a new manufacture which others shall not use. (*u*) Further, the patentee has no legal monopoly until the patent is granted.

Moreover, the bare fact of an article having been made before a patent for its manufacture is obtained does not alone render the grant void, (*r*) and it would be absurd to hold that profit would render public that which otherwise would have been a secret use, though of course the fact of profit having been derived might influence the Court against the contention of secrecy. Again, the argument that common law rights of workmen are abridged by such a grant as that now under consideration is surely futile. Publication is, of course, a question of fact, but it would scarcely be possible to maintain that the invention had been kept secret if the patentee had, before the grant, employed workmen, other than those perhaps in a specially and strict fiduciary relationship to himself, to carry the invention into effect.

Distinction between prior secret user by the inventor and by others.

There is a considerable difference between a prior secret user of the invention, which is subsequently patented, by a person other than the patentee and by the patentee himself. If it be established that a person or persons other than the patentee were in the habit of using the invention, though secretly, for the purposes of trade before the date of the grant, such prior secret user renders the patent void on the ground that the invention does not fulfil the requirements of the sixth section of the Statute of Monopolies, (*x*) as being one "which others at the time of making such letters patent and grants shall not use." (*y*) Thus in *Tennant's Case* (*z*) a secret user by persons other than the patentee was held to vitiate the grant. And in the more recent case of *Cheetham* v. *Oldham* (*a*) the prior sale of hats in appearance the same as those treated by the patentee's process, but from which it could not be conclusively inferred that the patentee's process had been used, together with the statements of the defendant's witnesses to the effect that such process had been used in their manufacture,

(*u*) 21 Jac. I. c. 3, s. 6.

(*r*) Bramah *v.* Hardcastle, (1789) Holroyd, 81; 1 Carp. P. C. 168; Morgan *v.* Seaward, (1835) 2 M. & W. 558; 1 W. P. C. 44 *n.*

(*x*) p. 3 *ante.*

(*y*) See Heath *v.* Unwin, (1854) 2 W. P. C. 276, 278; Cornish *v.* Keene (1835) 1 W. P. C. 511.

(*z*) (1798) 1 W. P. C. 125.

(*a*) (1890) 7 R. P. C. 124.

was held to invalidate the patent. (*b*) For some time after the date of the Statute of Monopolies—*i.e.*, until the reign of Queen Anne—*publication* of the invention was not made a condition of the grant of the patent. (*c*) And patents were sometimes granted for the introduction of a *secret* trade or mystery, (*d*) but it may be doubted whether such patents were really valid, for, if there was no publication, the public obtained no benefit in return for the grant. (*e*)

Prior User.

A question closely connected with the above is, will the publication in this country of an article made *abroad* be a publication of the *invention* by the exercise of which the article was made? If the article made abroad shows on the face of it how it was made, its sale in this country is a publication of the invention; (*f*) but there is authority for saying that such will not be the case if the article does not show on the face of it how it was made. It is submitted that it is a false argument to say that if the article which forms the subject of the grant has been imported, sold, and used within the realm, the Crown cannot grant the whole profits of the invention without prejudicing the rights of the merchant, retailer, or user within the realm. In the first place the Crown does not purport to grant the whole profits of the invention, but only the profits arising from it during the period for which the patent is granted. Further, no rights of the merchant, retailer or user within the realm would be interfered with by a subsequent grant, because the continued sale or user of articles made and imported before the patent would not be an infringement. (*g*) The patent would only apply to articles actually made within, or imported into, the realm after the date of the grant. Of course proof that such imported articles were in fact made according to the patent and so infringements might in some cases be a matter of practical impossibility. (*h*)

Importation of an article made abroad.

In *Hancock* v. *Somervell* (*i*) it was sought to upset *Hancock's* patent for improvements in the preparation of caoutchouc consisting in combining sulphur with it, and thus rendering it elastic at all temperatures. The evidence established the

(*b*) See also Hill *v.* Thompson, (1818) 1 W. P. C. 240; Cornish *v.* Keene, (1835) 1 W. P. C. 511.

(*c*) The Small Patents, (1606) 1 W. P. C. 9; Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1074.

(*d*) Mansell's Patent, (1624) 1 W. P. C. 19.

(*e*) See p. 106 *ante*.

(*f*) Jenson *v.* Smith, (1885) 2 R. P. C. 249; Miller's Patent, (1898) 15 R. P. C. 205.

(*g*) See p. 335 *post*.

(*h*) See *infra* and p. 467 *post*.

(*i*) (1851) 39 Newton, L. J. 158.

Prior User.

fact that shoes had been imported from America made of caoutchouc which on analysis was found to contain sulphur as well as oxide of lead and other ingredients. Prior to the plaintiff's patent samples of caoutchouc prepared by sulphur were sent to England by one *Goodyear* of New York, and were shown to *Hancock*, but the secret of their manufacture was not communicated to him. It was attempted to negotiate a sale of the invention to *Hancock*, but this was never completed. *Goodyear's* agent left the samples with *Hancock* under the impression that it would not be possible for him to discover the secret of their manufacture. As the result of experiments, *Hancock*, however, discovered that sulphur made caoutchouc elastic at all temperatures, and he then obtained his patent for his method of manufacturing it. *Williams*, J., directed the jury to say whether, supposing the shoes to have been manufactured in England, they could have been made without infringing the plaintiff's patent, and made use of the following words: "The defendants do not deny that *Hancock* is to be considered the inventor, notwithstanding *Goodyear* had previously made the discovery, provided the invention had not been published or in use in this country before the date of the patent. The defence consists of this: not only had *Goodyear* discovered the invention first, but also that the invention had been substantially published and was in use—not in secret use, but in public use—before the date of the patent; that the material being in public use, the ready means of performing the invention were also necessarily before the public; because it is said the article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to reproduce the article. If you should be of opinion that the material was in use before the date of the patent, then the question resolves itself into this: What is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that notwithstanding the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use. If, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary that the use should be actual sale—if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, hauding about the country for the

purpose of attracting customers): if you should think, also, that the material being so in use it was so palpable how you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it; if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have been describing." The jury found a verdict for the plaintiff, and his patent was accordingly upheld. Prior User.

In the recent case of *Sunlight Incandescent Gas Lamp Co.* v. *Incandescent Gas Light Co.*, (*k*) *Wills*, J., held that *Rawson's* patent for stiffening incandescent gas mantles was not anticipated by the prior importation into this country of *Clamond's* magnesium baskets, stiffened by substantially the same process, because an inspection of the baskets did not disclose the process according to which they were stiffened.

The foregoing cases appear to establish that the prior use of a foreign made and subsequently patented article is not a publication of the invention, if the article does not on the face of it show how it was constructed—*i.e.*, the patentee is capable under such circumstances of communicating to the Crown an invention, which is a new manufacture within the sixth section of the Statute of Monopolies. It may be urged, however, that a patent so obtained is bad, because the Crown has been deceived in its grant seeing that the applicant has, on application, to declare that the invention is not in use by any other person or persons to the best of his knowledge and belief. (*l*) There are two answers to this contention. First, if the circumstances permit, that the declaration is true from all points of view, because the use of the articles in question was unknown to the applicant. Secondly, the fact is that the invention is the art of producing the article and not the article itself, (*m*) and it is, therefore, true that the invention was not in use within the realm by any other person or persons. If it be urged that the Courts, over and over again, restrain the use of foreign made goods as being infringements of British patents, the reply consists in the consideration that such infringement is restrained on the ground not of direct use of the invention, but for the reason that the use in this country of the foreign made article causes loss of profit to the patentee. (*n*) It must be borne in

(*k*) (1897) 14 R. P. C. 757.
(*l*) Vol. II. p. 315.
(*m*) p. 24 *ante*.
(*n*) See Von Heyden *v.* Neustadt, (1880) L. R. 14 Ch. D. 230; p. 376 *post*.

Personal Communications. Prior Documents.

mind that the consideration for the grant is the information how to do something which the public did not know how to do before, viz., how to produce the article, (*o*) and that an act which, if done after the grant, would amount to an infringement of a patent is not, necessarily, a publication of the invention. (*p*)

### Publication by Personal Communications.

Prior communications made by the patentee personally.

When a patentee has communicated his invention to others before applying for a patent, it is always a question of evidence whether the communications were of a fiduciary nature, and whether the persons to whom they were made have kept faith with the patentee, or whether the communications were made to individuals as members of the public, or such individuals have broken faith with the patentee by publishing the invention to the world at large. In one case (*q*) it was proved that the patentee had, before application for a patent, confidentially communicated the invention to nine separate people, but the Court of first instance and the Court of Appeal held on the facts there was no publication which vitiated the patent. In another case it appeared that the patentee entrusted his invention—a pince-nez—to an optician in Paris, whose employee showed it to a third party, who wrote a description of it in a French scientific publication, three or four copies of which came over to this country and were in public libraries before the date of the patent. The House of Lords held that under these circumstances the patent was bad for want of novelty. (*r*)

### Publication by Documents.

Books and documents as means of publication.

Besides the different ways heretofore indicated, a knowledge of an invention may be made the property of the public, so as to render a subsequent patent for it void on the ground of want of novelty, by a description of it being contained in a printed or written book or document or specification published in this country in such a manner that the public have access

(*o*) p. 174 *post*.

(*p*) See p. 152 *post*.

(*q*) Gadd *v.* Mayor, &c., of Manchester, (1892) 9 R. P. C. 249, 516, see also Pilkington *v.* Yeakley Vacuum Hammer Co., (1901) 18 R. P. C. 459, 463.

(*r*) Pickard *v.* Prescott, (1892) 9 R. P. C. 195; A. C. (1892) 263; see also Blank *v.* Footman, (1888) 5 R. P. C. 653, 656.

to such document or specification, and may, therefore, be presumed or assumed to have a knowledge of its contents. (*s*)

Prior Documents.

There is a considerable difference as to the effect on the question of publication of an invention between the production of a machine made prior to the date of the patent and a document published before that date. In the former case the production of a machine made for a particular purpose, which would accomplish, when used, results which were not thought of when it was made, might possibly, without any user, be an anticipation of a patent for the application of the machine to produce such results. It would be a question of evidence as to whether it required invention to make the application. If the machine were used in such a way as to make clear to the public what it would effect, it would be a sufficient publication to defeat any subsequent patent for any such result. (*t*).

Difference between a prior machine and a prior document as publications.

In the case of a written document it is not apparent, except from the language thereof, what results the contemplated machine would accomplish. It is not sufficient to defeat a patent to say that, if a machine were made by following the description in a document, something in that machine would anticipate the invention of the patentee, unless that something is apparent from the description itself. When the publication is in writing, and in writing only, it is necessary to show that a person conversant with such matters, on reading it, would find a reasonably clear description of the invention in the writing alone. If it be necessary that the machine should be made in order that the publication may be seen, the subsequent inventor is not obliged, when his attention is called to a mere writing, to make a machine from it in order to see what will be the effect. If the document is to invalidate the subsequent patent, it must contain on the face of it a description of the invention. (*u*)

It has been held that an invention is published if a description of it is contained in a foreign book which has been

Foreign books.

(*s*) Rex *v.* Arkwright, (1785) 1 W. P. C. 72; Huddart *v.* Grimshaw, (1803) 1 W. P. C. 86; Jones *v.* Berger, (1843) 1 W. P. C. 550; Cornish *v.* Keene, (1835) 1 W. P. C. 507; Heurteloup's Patent, (1836) 1 W. P. C. 553; Dobbs *v.* Penn, (1849) 3 Exch. Rep. 427; The Housebill Co. *v.* Neilson, (1843) 1 W. P. C. 573; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412; Lawrence *v.* Perry, (1885) 2 R. P. C. 180; United Horseshoe and Nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 133; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 429.

(*t*) Fawcett *v.* Homan, (1896) 13 R. P. C. 410.

(*u*) Hills *v.* Evans, (1862) 31 L. J. Ch. 457; 4 De G. F. & J. 288; Betts *v.* Menzies, (1862) 10 H. L. Cas. 152–154; Betts *v.* Neilson, (1868) L. R. 3 Ch. App. 435; Otto *v.* Linford, (1881) 46 L. T. N. S. 44; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 535.

Prior Documents.

circulated in England, (*x*) in such a manner that some English people may be fairly supposed to know of it, (*y*) whether the foreign book be in a foreign language or English; (*z*) but it would appear that if the foreign book is in a remote language with which very few English people would be acquainted, it might not amount to such a publication as would vitiate a subsequent patent. (*a*)

Publication in a foreign book, only four copies of which were sent over to this country and exposed for sale (only one copy of which was actually sold), has been held sufficient to vitiate a patent. (*b*)

Unnecessary to prove that the patentee ever saw the prior book or document relied on.

In order to invalidate a patent on the ground of prior publication in a book or document, it is not necessary to show that the patentee actually derived his knowledge of the invention from such prior book or document; it is quite sufficient to show that the prior book or document was open to public inspection before the date of the patent. (*c*)

Thus, where an American book was kept in a private room at the Patent Office, and not entered in the donation book or in the catalogue, (*d*) it was held that there was not sufficient publication to upset an English patent. (*e*) Again, the fact that a French book containing a description of an invention was mentioned in catalogues distributed in this country, was held, in the absence of any proof that a single copy of the French book had ever been brought to this country, to be no publication of the invention. (*f*) If, however, the foreign book or document is catalogued and in a library to which the public have access, it will amount to a publication of the invention, though only one person has seen it, (*g*) or it is the only copy accessible to the public. (*h*)

Publication by prior document is always a question of fact.

The question whether a particular document has really become part of the stock of public knowledge, or at any rate

(*x*) Reg. *v.* Seine, 40 Newton, L. J. 71; The United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*y*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 429; remarks of Cotton and Lindley, L.JJ.

(*z*) Lang *v.* Gisborne, (1862) 31 Beav. 133; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; Otto *v.* Steele, (1884) L. R. 31 Ch. D. 241; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416.

(*a*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 426.

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

(*c*) Stead *v.* Williams, (1844) 2 W. P. C. 142.

(*d*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531.

(*e*) See Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412.

(*f*) Otto *v.* Steel, (1887) L. R. 31 Ch. D. 241.

(*g*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 426; 3 R. P. C. 383; 4 R. P. C. 225.

(*h*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 721, 731.

part of the knowledge of that portion of the public interested in the invention, is in every case a matter of evidence. (*i*) In the words of *Tindal*, C.J. :— Prior Documents.

> "The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be whether, on the whole evidence, there has been such a publication as to make the description a part of the public stock of information." (*k*) Per Tindal, C.J.

It is idle to lay down any general canon of what will be the result of a given case. The effect, extent, and operation of the document by which the invention is supposed to be communicated to the public in this country, so as to anticipate the invention of the person who first takes out letters patent for the invention, vary infinitely, as the facts must vary. In a great variety of instances it may very well be that the mere fact of an invention being completely disclosed in a written paper and that written paper brought into this country would, notwithstanding those circumstances, not in the smallest degree amount to publication, and would not interfere with a patent afterwards taken out. In other cases the inference, which is simply a question of fact, may be irresistible that the invention was communicated in the strictest sense to the public in such a way as to prevent the operation of letters patent taken out after the date of that publication. (*l*)

In *Plimpton* v. *Malcolmson*, (*m*) the facts proved were that a copy of a book published in America containing a short description of the invention forming the subject of the patent in dispute was sent over to this country before the date of the patent, and placed in the library of the Patent Office, but it was not entered in the catalogue of the library, and was not placed on the shelves of the room to which the public had access, but in a private room; and it was also proved that

(*i*) The Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Stead *v.* Williams, (1844) 2 W. P. C. 137; Stead *v.* Anderson, (1846) 2 W. P. C. 147; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531.

(*k*) Stead *v.* Williams, (1844) 2 W. P. C. 143; see also Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; judgment of Jessel, M.R., at p. 561, and his explanation of the dictum of Romilly, M.R., in Lang *v.* Gisborne, (1862) 31 Beav. 133; see also Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412; Von Heyden *v.* Neustadt, (1880) 50 L. J. N. S. Ch. 126; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*l*) See observations of Halsbury, L.C., in Pickard *v.* Prescott, (1892) 9 R. P. C. 195.

(*m*) L. R. (1876) 3 Ch. D. 531.

Prior Documents.

the book did not come to light till ten years or more after the date of the patent. Under these circumstances, *Jessel*, M.R., held that there had not been such a publication of the invention as would deprive the man who first made it known in this country of that merit—the only merit so far as an importer is concerned—which consists in making known a useful invention to the public. This decision was in a subsequent case (*n*) upheld by the Court of Appeal.

Document is sometimes public property the moment it is written.

A document containing a description of an invention may under some circumstances, however, be public property from the moment it is written. For example, where a referee appointed by Act of Parliament to inspect the works of the London Gas Companies, whilst engaged in the prosecution of his duties discovered a process for purifying gas and obtained a patent for the invention, after the report of himself and his co-referees embodying the principle of the process had been drawn up, it was held by the House of Lords that the patent was void for lack of novelty, because the report conveying a knowledge of the invention had become public property from the time it was written. (*o*)

Terms of art used in different documents may not have the same meaning.

It is not always possible to predict of two documents which make use of terms of art *ipsissimis verbis* the same, that they describe the same invention, if they were composed at different periods. For it must not be forgotten that terms of art are liable to constant changes of meaning during the progress and development of any particular department of science, and therefore, in considering whether a description in an earlier published book or document is really the same as that in a later specification, it must be carefully ascertained that the terms of art used in the two denote the same thing. In the words of Lord *Westbury*: "Even if there is identity of language in two specifications, and (remembering that those specifications describe external things) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predict of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification, and denote the same external objects at the date of the one specification as they do at the date of the other." (*p*)

(*n*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412.

(*o*) Patterson *v.* Gas Light and Coke Co., (1856) L. R. 3 App. Cas. 239.

(*p*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 152.

Prior Documents.

A document which upon its true construction points away from the use of a certain thing, or the use of a certain thing in a particular manner, cannot be successfully pleaded as a publication of an invention which consists in the use of the thing, or in its use in a particular manner. (*q*)

Document which points away from the patentee's claim is no publication.

Provisional specifications which are filed in the Patent Office and subsequently abandoned by the applicant, are under the present practice never published. Consequently, an abandonment of a provisional specification will not amount to a publication of the invention, which may form the subject-matter of a subsequent patent. (*r*)

Provisional specifications.

Power of Court to order production of abandoned provisional specifications.

The Courts have power to order the production of an abandoned provisional specification if it is required in the interests of justice—*e.g.*, when in an action on a subsequent patent the defendant pleads invalidity by reason of his own prior user, and states that he has filed but abandoned a provisional specification for the thing which he alleges he used about the date of the abandoned provisional specification, and which he contends was an anticipation of the plaintiff's claim. (*s*)

Sec. 1 of Patents Act, 1902.

An invention covered by any patent granted on an application to which sec. 1 of the Patents Act 1902 applies is not deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to a prior application made in the United Kingdom not less than fifty years previously, or of its publication in a provisional specification of any date not followed by a complete specification. (*t*)

In *Lister* v. *Norton*, (*x*) the facts were these: the plaintiff, on 24th July 1880, under the Act of 1852, filed a provisional specification of an invention for "improvements in the manufacture of pile fabrics in imitation of sealskin and other similar fabrics." This specification was abandoned by the plaintiff, and on the 21st January 1881 he filed a second provisional specification of an invention for "improvements in the manufacture of velvets and of pile fabrics in imitation

(*q*) See Nobel's Explosives Co. *v.* Anderson, (1895) 12 R. C. P. 164; Morris *v.* Young, (1895) 12 R. P. C. 461; Monnet *r.* Beck, (1897) 14 R. P. C. 777; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875.

(*r*) 48 & 49 Vict. c. 63, s. 4; Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; Lister *r.* Norton, (1886) 3 R. P. C. 199.

(*s*) Pneumatic Tyre Co. *v.* English Cycle and Tyre Co., (1897) 14 R. P. C. 851.

(*t*) See Kaye *r.* Chubb, (1888) 5 R. P. C. 641, 648; 2 Edw. VII. c. 34, s. 2.

(*x*) (1886) 3 R. P. C. 199.

Prior Documents.

of *scalskin and other similar materials.*" On the 21st July 1881 he obtained a grant of letters patent on his provisional specification of 21st January 1881. The invention claimed consisted in a new combination of materials for use in the manufacture of the fabrics referred to—the employment of a mixture of mohair and silk in the raw state, combined and blended before spinning. It was held that, assuming the invention in the two provisional specifications to be identical, the abandonment of this first provisional specification did not avoid the patent which was granted, *i.e.*, dated, within the period of provisional protection secured by the first provisional specification, even if actual user during such period could be shown. (*y*)

Not necessary to prove that a prior published invention has been actually used.

A prior description, which has become the property of the public, of a machine or combination, though that machine or combination has never been actually made and publicly used, will render a subsequent patent for that machine or combination bad both on the ground that the patentee is not the true and first inventor, and because the invention is not new. (*z*)

As has been shown, the subject of a patent is really the art of producing the new and useful result, (*a*) and it is not necessary to avoid a patent that the art should have actually been put in practice—*i.e.*, the machine, for instance, made by the exercise of it, need not have been constructed, provided that the public are, at the date of the patent, in possession of full and sufficient information to enable them to produce, without the exercise of further invention, the result claimed by the patentee. (*b*) The question whether a description has really become the property of the public so as to vitiate a subsequent patent is therefore always one of evidence, when that description has not been acted upon and no machine has been made in accordance with it. (*c*)

Lord *Blackburn*, in the House of Lords, (*d*) pointed out that in order to vitiate a patent on the ground of want of novelty it is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used have been made known to the

(*y*) See also Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58.

(*z*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 92.

(*a*) p. 24 *ante*.

(*b*) p. 108 *ante*.

(*c*) Humpherson *v.* Syer, (1887) 4 R. P. C. 407; Tickelpenny *v.* Army and Navy Co-operative Society, Ld., (1888) 5 R. P. C. 405.

(*d*) Patterson *v.* Gas Light and Coke Co., (1875) L. R 3 App. Cas. 239.

public by a description in a work which has been publicly circulated (*e*) or a specification duly enrolled, (*f*) it avoids the patent, though there is no proof that the invention was ever actually put in use. Prior Documents.

If the document relied on as a publication contain *merely a suggestion* of the invention, it will be immaterial to the novelty of a subsequent patent, which will only be upset on the ground of prior publication, if the document contain a description which is such that the invention could be easily carried out from it. (*g*) Mere suggestion is not publication.

The law requires the inventor in the specification which he is compelled to lodge at the Patent Office (*h*) to describe his invention and the mode of performing it in language so accurate and explicit as will enable an ordinary and intelligent workman in the trade, to which the invention relates, to put it in practice. The question arises as to whether it is necessary that a document containing an alleged anticipation of a subsequently patented invention should be framed in language equally accurate and explicit as that which is required in the specification itself. In other words, will an alleged anticipating document, which is sufficiently accurate and explicit to enable a highly skilled person to perceive without effort and perform the invention, though it is not intelligible to a less skilled ordinary workman, amount to a prior disclosure of the discovery which will render a subsequent patent void on the ground of want of novelty?

In *Betts* v. *Menzies* (*i*) it was held that an antecedent description must disclose a practicable mode of producing the result of the subsequent discovery if the description is to be held sufficient to invalidate the subsequent patent. In this case *Dobbs'* specification was relied on as an anticipation of *Betts'*, but it was not contended that the former would enable any skilled person to perform the invention. It appeared that proportions and subsidiary processes not disclosed by *Dobbs*

(*e*) Stead *v.* Williams, (1844) 7 M. & G. 818, 842; 2 W. P. C. 141.

(*f*) Bush *v.* Fox, (1856) 5 H. L. C. 707; Betts *v.* Menzies, (1862) 10 H. L. C. 117.

(*g*) Woodcroft's Patent, (1846) 2 W. P. C. 23; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Betts *v.* De Vitre, (1862) 11 L. T. N. S. 445; Von Heyden *v.* Neustadt, (1880) L. R. 14 Ch. D. 230; 50 L. J. N. S. Ch. 126; Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 252; Bray *v.* Gardner, 4 P. O. R. 405; Haslam *v.* Hall, (1888) 5 R. P. C. 19; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Thompson *v.* American Braided Wire Co., (1887) 4 R. P. C. 316; 5 R. P. C. 113; 6 R. P. C. 518; Winby *v.* Manchester, &c., Steam Tramways Co., (1889) 6 R. P. C. 359; Shaw *v.* Jones, (1889) 6 R. P. C. 336.

(*h*) 46 & 47 Vict. c. 57, s. 3; see chap. v.

(*i*) 10 H. L. Cas. 152.

Prior Documents.

were necessary. *Dobbs'* was held not to be an anticipation of *Betts'*. The information given would clearly not enable *any one* without experiments to perform the invention, and the point of it being intelligible to a skilled person was not raised at the Bar.

As was remarked by Lord *Abinger*, (*k*) many patents have been taken out upon suggestions contained in a celebrated work by the Marquis of *Worcester*, and from hints and speculations from the same author, and his Lordship seemed of opinion that these patents would have been good as regards anticipation by the Marquis of *Worcester*. All the Marquis did in his writings was to make suggestions and speculations, not to describe perfected inventions in language which would disclose them, as such, to any one, however skilled he might be. This is a very different thing to a description of an invention in terms that would enable skilled persons, though not the ordinary workman, to perceive and carry it out.

Sufficiency of description necessary in an anticipating document.

The real point to be considered in determining whether a prior description is sufficiently explicit to vitiate a subsequent patent is: will the prior description enable any person, *without the exercise of invention*, to carry out the alleged new discovery? It may be that a given prior description will enable a highly skilled person to perform an invention for which a patent is subsequently taken out, whereas a less skilled ordinary workman in the trade would not be able to carry the invention into effect from the hints and suggestions contained in that prior description. If the highly skilled person has to exercise any ingenuity or invention to enable him to arrive at the result achieved by the patentee, it is submitted, the prior description is not one which will vitiate a subsequent patent; otherwise it is. It must be borne in mind that the sufficiency or insufficiency of a specification does not afford a crucial test as to whether there is publication of an invention by it or not. (*l*)

Rule in Hills v. Evans.

Lord *Westbury*, L.C., in *Hills* v. *Evans* (*m*) first laid down authoritatively the rule on the subject of what must be the nature of an antecedent paper publication in order that it may be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty. The rule in *Hills* v. *Evans* has been slightly modified and brought up to date by

(*k*) Carpenter *v.* Smith, (1841) 1 W. P. C. 534.

(*l*) King, Brown & Co. *v.* Anglo-American Brush Corporation, (1891) 9 R. P. C. 313.

(*m*) 4 De Gex, Fisher and Jones, 289.

subsequent cases. The following extract from the judgment of *Lindley*, L.J., in *Savage* v. *Harris*, (*n*) contains a clear statement of what the law upon the subject now is :—

Prior Documents.

"I cannot do better than refer to the well-known judgment of Lord *Westbury* in the case of *Hills* v. *Evans*, which is to be found in 4 De Gex, Fisher, and Jones, at page 289. He says: 'I have therefore to consider and to give my opinion upon the question that has been argued, namely, whether there be or be not anything in these specifications which has rendered the plaintiff's invention matter of public knowledge, and therefore matter of public property, anterior to the granting of the patent. I was extremely desirous to ascertain, in the course of the argument, whether any clear rule has been laid down on the subject of what shall be the nature of the antecedent publication which shall be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty.' After saying that a specification is not to be distinguished in principle from any other publication, he says: 'The question, then, is—What must be the nature of the antecedent statement? I apprehend that the principle is correctly thus expressed.' I will show that that has been corrected more recently. 'The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent.' And after commenting on the statute of James, he goes on: 'The information as to the alleged invention given by the prior publication must for the purposes of practical utility be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication.' With the exception to which I have called attention—I mean about the ordinary workman—that is the law. Mr. Justice *Grove* was the first to call attention to the fact that there might be prior anticipation by publication, although the specification was defective in the directions given to the workman. His judgment upon that point will be found in *Philpott* v. *Hanbury*, 2

Statement of the present law by Lindley, L.J.

(*n*) (1896) 13 R. P. C. 368.

Prior Documents.

R. P. C. 43, and it has been adopted. I do not know whether expressly or not, but the same criticism and the same observations will be found in the House of Lords cases for 1892, at page 378, in the case of the *Anglo-American Brush Electric Light Corporation* v. *King, Brown & Co.*, 9 R. P. C. 313. The question there was whether a specification of one *Varley* was an anticipation of the plaintiff's patent, and Lord *Watson* says this: 'I do not think it necessary to deal with the conflict of testimony as to the sufficiency of *Varley's* specification for the guidance of a skilled workman. The Lord Ordinary was of opinion that the appellants had failed to prove that part of their case. But I agree with his Lordship and with the learned Judges of the First Division in holding that the sufficiency or insufficiency of the specification for that purpose does not afford a crucial test of prior publication. 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 a man 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.' With that correction of Lord *Westbury's* judgment, the judgment stands, and, applying it to this case, I confess I cannot see what on earth there is in the plaintiff's specification which is not to be found in *O'Connor's*; I do not say in actual words, but to anybody who reflects upon it and thinks about it and grasps it." (*o*)

Evidence of a skilled person, with knowledge of the patent, as to anticipations.

When, however, a skilled person with the knowledge of the patentee's specification produces a successful result and says he obtained it by following only the directions of an old and unused paper anticipation, the Courts look very carefully at such evidence before accepting it. (*p*)

(*o*) See also Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 256; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 532; Shrewsbury and Talbot Cab Co. *v.* Sterckx, (1896) 13 R. P. C. 53; Edison *v.* Holland, (1887) 5 R. P. C. 459; 6 R. P. C. 243; Dick *v.* Ellams Duplicator Co., (1899) 16 R. P. C. 414, 423; 17 R. P. C. 196.

(*p*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 573–576; Defries *v.* Sherwood, (1897) 14 R. P. C. 321; see pp. 462, 464 *post*.

Prior Documents.

In *Otto* v. *Linford* (*q*) a prior specification was relied on as a publication of the invention claimed by *Otto*. *Brett*, L.J., said that the question to be considered was whether the prior specification, fairly read by a person conversant with such matters, would give a reasonably clear description of the latter invention. In other words, supposing it to relate to a machine, would it give such a reasonably clear description of a machine that would accomplish what the machine of the later inventor effected.

Unless all essential features of the invention are disclosed by an anticipating document it will not be a publication.

In *Stoner* v. *Todd*, (*r*) it appeared that a certain provisional specification contained a partial description of a piece of mechanism which was not mentioned in the corresponding complete specification. A subsequent patent was taken out for the piece of mechanism, and this was held not to be invalidated by the incomplete description in the prior provisional specification.

In the words of Lord *Westbury*: "An antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery; (*s*) and in the language of Lord *Wensleydale*, 'the mere production of a notion that a particular article might be made, without any information or means of knowledge communicated to the public, does not prevent a subsequent first inventor of those means from taking out a patent.'" (*t*)

In order that a description in a prior document may invalidate, on the ground of want of novelty, a subsequent patent, it is necessary that *all* the essential features of the alleged invention should be disclosed by the prior document. Thus, a patented process for "improvements in the manufacture of grooved tyres for wheels" consisted in rolling a flat bar of iron so as to get it into a curved form with flanges set up upon each side, and then to roll so as to get the curved form into a flat base, but not so as to get merely rectangular flanges, but to roll (which necessitated rollers of a novel and peculiar kind) so as to get flanges at an acute angle to the flat base; or, if not at an acute angle, by rolling, to get flanges with bead-shaped heads whereby to produce an iron tyre with an

(*q*) 46 L. T. N. S. 35.
(*r*) L. R. 4 Ch. D. 58.
(*s*) Betts *v.* Menzies, (1881) 10 H. L. Cas. 154; see also Woodcroft's Patent, (1846) 2 W. P. C. 23.
(*t*) Betts *v.* Menzies, (1862) 10 H L. Cas. 157; see also Muntz *v.* Foster, (1844) 2 W. P. C. 105; Galloway *v.* Bladen, (1839) 1 W. P. C. 501; Thomson *v.* Batty, (1889) 6 R. P. C. 84.

Prior Documents.

undercut dovetailed section which would grip the india-rubber tyre and would have a flat base in order that it might accurately fit on to the felloe of the wooden wheel and that the india-rubber might lie perfectly flat upon it when extended round it. This was held not to be anticipated by a specification which did not disclose the attainment of the undercut dovetailed section, though it did disclose the attainment of the other essential features. (*u*)

Highly scientific inventions.

With reference to the publication of a highly scientific—*e.g.*, a chemical—invention it is to be remembered that there are two distinct forms of literature on the subject: the systematic scientific literature, and the technical literature; and the distinction is one very important to be borne in mind in dealing with such patents, since publications having reference to chemical science will be studied by scientific chemists, but speaking generally such publications are not sought after and studied by the practical working chemists. (*x*)

The existence of a chemical patent wherein the combined effect of two or more chemicals is claimed, in order to bring about a desired result, does not by any means, necessarily, constitute an anticipation of a subsequent discovery that by the use of any one of the named chemicals the desired result can be attained, and *à fortiori* when the compound of the two has failed to do so, for there are any number of cases known in chemistry where two things when put together act very differently from what they do apart. (*y*)

Though an anticipation might be an infringement, it is not necessarily a publication.

It does not at all follow that an unused paper anticipation which, if carried out, might be held to be an infringement of a subsequent patent, is an anticipation of that subsequent patent. A clumsy imitation of a patented machine or a patented article may be an infringement, although it is not such as would have been, if prior in date, an anticipation defeating an inventor's right to a patent. (*z*) Thus, in the case of *Welch's* patent for holding on bicycle tyres by inextensible wire rings, it was objected that this was anticipated by a prior specification of *Latta*. Two figures in *Welch's*

(*u*) Shrewsbury and Talbot Cab Co. *v.* Sterckx, (1895) 12 R. P. C. 336; 13 R. P. C. 44.

(*x*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) L. R. 29 Ch. D. 384.

(*y*) In judgment of C. A., Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 256.

(*z*) Caldwell *v.* Van Vlissengen, (1851) 9 Hare, 421; Murray *v.* Clayton, (1872) L. R. 7 Ch. 585; Daw *v.* Eley, (1865) L. R. 3 Eq. 492, 501 *n.*; Newton *v.* Grand Junction Ry. Co., (1846) 5 Ex. 334; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 103; 14 R. P. C. 573.

specification, showing extreme cases of the application of his invention, approximated in appearance to a figure in *Latta's* specification. From *Latta's* specification, however, it was clear that he proposed to use the wires—of which he had three—for a different object to *Welch*—viz., to hold on the tyre by means of the pressure of the wires and rubber on the rim; and *Latta* further stated that if any one of his wires were cut the tyre would still be held on. This clearly showed that his object was different to *Welch's*, and as there was no evidence of user of *Latta's* invention the Court held that it did not anticipate *Welch*—though, no doubt, if after *Welch's* patent some one adopted *Latta's* figure and was really intending to use *Welch's* invention, and merely putting in the third wire as a colourable distinction, such conduct would be an infringement of *Welch's* patent. (*a*)

Prior Documents.

Though a documentary publication may not be an anticipation of a subsequent patent, notwithstanding that it describes the main features of the invention, still such a publication may very much narrow the ambit of the patentee's claim; and an alleged infringer may consequently be held not to have infringed, whereas had it not been for the prior publication he might have been an infringer. (*b*)

A document which is not a publication may narrow the ambit of the claim.

A general statement that a class of bodies will effect a certain purpose is no anticipation of an invention which consists in the application of one member of the class which possesses particular advantages not shared by the other members of the class. (*c*) So also the use in a particular way of a limited number of a larger class of bodies mentioned in a prior document may form the subject-matter of a valid patent when the inventor has, by the particular use of the limited suitable members of the class, been enabled to produce a new result. (*d*)

General statement as to a class no publication of selection of a particular member.

A drawing alone which has been published so as to become the property of the public is quite sufficient to invalidate a subsequent patent, if the drawing is intelligible to machinists

Drawings.

(*a*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 102; 14 R. P. C. 573.

(*b*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113; Automatic Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine Co. *v.* National Exhibitions Association, (1892) 8 R. P. C. 345; 9 R. P. C. 41; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 475; Vorwerk *v.* Evans, (1890) 7 R. P. C. 265; Beavis *v.* Rylands Engineering Co., (1900) 17 R. P. C. 711.

(*c*) Hills *v.* The London Gas Light Co., (1857) 27 L. J. Ex. 60; 5 H. & N. 312; 29 L. J. Ex. 409; Wylie and *Norton's Application*, (1896) 13 R. P. C. 97; see p. 41 *ante*.

(*d*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 478; 13 R. P. C. 429; 14 R. P. C. 303.

Prior Documents.

and enables them by its aid alone to make the machine indicated;(*e*) and a description that will enable competent workmen to carry out an invention will vitiate a subsequent patent for that invention, even though at the time of the prior description no one did use the machine made according to the description, provided that its use is indicated in such description. (*f*)

Description of a useless machine is no publication of a useful one.

If a prior description when completely carried out results in the production of an impracticable and useless machine, it will be no anticipation and publication of the result arrived at by a subsequent inventor which is both practicable and useful. (*g*) It might well be that the description of a machine which was useless without the application of a subsequent discovery would vitiate a later patent taken out for the same machine upon the same description, but after the discovery which rendered it practicable had been published and become general knowledge, and a thing which the public would apply from the description in question when read in the light of that essential knowledge. (*h*)

So also if the alleged anticipation describes a machine which has a practical defect, and a subsequent invention removes that defect, the prior description is no publication of the later invention. Thus, in the case of a sewing machine to be used for stitching boots, a prior description of a machine in which a forked looper and an auxiliary looper were used and the thread was presented to the point of the needle, was relied on to defeat the patent of the plaintiff. The auxiliary looper and the presentation of the thread to the point of the needle were shown to be defects, and the plaintiff's invention, according to which he removed the auxiliary looper and presented the thread to the notch of the needle instead of to the point, and so removed the defect, was held to be good subject-matter of a valid patent. (*i*)

Invention may be partly published by one document and partly by another.

An invention may be anticipated partly by one prior publication and partly by another, so that in the result the whole

(*e*) Herrburger *v.* Squire, (1889) 6 R. P. C. 194; Electrical Construction Co. *v.* Imperial Tramways Co., (1900) 17 R. P. C. 53; cf. Lewis and Stirkler's Patent, (1896) 14 R. P. C. 24, in which, on the facts, a drawing was held no publication.

(*f*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705. judgment of Fry, J.; see p. 147 *ante*.

(*g*) See pp. 151, 119, *ante*.

(*h*) Tubeless Pneumatic Tyre and Capon Heaton, Ld. *v.* Trench Tubeless Tyre Co., (1899) 16 R. P. C. 313; Gaulard and Gibbs' Patent, (1890) 7 R. P. C. 367; see p. 220 *post*.

(*i*) English and American Machinery Co. *v.* Union Boot and Shoe Machinery Co., (1894) 11 R. P. C. 137, 367.

Prior Documents.

invention may have been previously published. It is not, however, allowable to take a mosaic construction of previous publications, and thereby deny the want of novelty in an invention, which consists in the construction of a whole, the component parts of which have never before been put together in the manner shown by the subsequent inventor. (*k*)

Mosaic of extracts from prior documents not a publication.

Two or more documents which are public knowledge, and which indicate discussion, invention, or discovery in the same line may be honestly taken together and form a publication of a subsequent alleged invention; but it is not allowable, for the purpose of showing the publication of a combination which has never in fact existed or been described prior to the time the patentee discloses his invention, to piece together parts of prior documents which describe things now found to be useful, but which were never before intended to be put in combination. (*l*)

*James*, L.J., delivering the judgment of the Court of Appeal in *Von Heyden* v. *Neustadt*, (*m*) and commenting on a number of extracts and papers relied on as evidence of the prior publication of the invention which was the subject of the action, 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 defendant's contention, that contention stands thereby self-condemned. . . . And even if it could be shown that a patentee had made his discovery of a constructive 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."

It is to be remembered that there is no case in which a new commercial article consisting of a *de jure* new combination of parts produced for the first time has been held to be published by a separate description of any one or more of those parts alone, or of some combinations of them. (*o*) It is no detraction from the merit of an inventor to point out that one detail is to be found in one obscure

(*k*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317; Von Heyden *v.* Neustadt, (1880) 50 L. J. N. S. Ch. 126; Young *v.* Fernie, (1866) 4 Giff. 577; L. R. 1 H. L. 36.

(*l*) See Otto *v.* Linford, (1881) 46 L. T. N. S. 35.

(*m*) (1880) 50 L. J. N. S. Ch. 128.

(*o*) Otto *v.* Linford, 46 L. T. N. S. 35; Pneumatic Tyre Co. *v.* Casswell (1896) 13 R. P. C. 375.

Prior Documents.

specification, and another detail in another, and so on, and to say that all he had to do was to put these things together. The getting of the idea, and the putting together of that idea, with the mechanical means of attaining it, may constitute invention. (*p*)

(*p*) Fawcett *v.* Homan (1896) 13 R. P. C. 410

# CHAPTER IV.

## UTILITY.

### Utility at Common Law.

Utility is a requisite at Common Law.

There do not appear to be any words in the sixth section of the Statute of Monopolies directly implying that the subject of a patent must be an invention which is useful, but "utility" is a condition imposed by the Common Law quite independently of enactment.

The Crown in exercising any of its prerogatives must do so for the good of the public, otherwise it would be acting contrary to the law. (*a*) The Sovereign has no power to charge its subjects, or abridge any of their liberties, excepting it be for their benefit, or in exchange for a sufficient consideration. (*b*) It is evident that during the continuance of a patent, which grants to the patentee and his nominees the sole use and enjoyment of the invention forming the subject of the grant, the public are not able to exercise the invention without the licence of the owner for the time being of the patent, even though they should, independently of the information contained in the specification, (*c*) make the discovery for themselves, and if they desire to procure articles made according to the invention they are obliged to pay whatever price the owner of the patent right chooses to demand. (*d*) The Sovereign in making the grant really acts on behalf of the public, (*e*) and it is therefore only equitable that they should obtain some consideration in respect of the benefit they confer on the grantee.

The subject-matter of every patent must be an art, (*f*) and if such art is incapable of producing useful results in its application to any of the purposes in respect of which the grantee claims protection, it is clear that the public can get

(*a*) Bac. Abr. tit. "Prerog."
(*b*) 2 Rol. Abr. 172, s. 20.
(*c*) See chap. v. *post*.
(*d*) As to compulsory licences, see Vol. II. p. 136.
(*e*) Per Lord Eldon, L.C., in Harmar *v.* Playne, (1809) 14 Ves. 130, 136.
(*f*) p. 24 *ante*.

Utility at Common Law.

no benefit from its application, and the grant will be therefore void on the ground that the necessary consideration for its support is wanting.

Utility is requisite at Common Law;

Moreover, every patent contains a recital to the effect that the Sovereign, being willing to give encouragement to all arts and inventions which may be for the public good, is pleased to condescend to the applicant's request. It is the evident intention, therefore, that the patentee should give as a consideration to the public an art or invention which is for their good, whereas one devoid of utility would not be. In this latter case the Crown would have been deceived in its grant, which would be void on the ground of the failure of part of the consideration in respect of which the grant was made, (*g*) that is to say, because there was no utility in the invention. (*h*)

It is, of course, the subject of the patent—*i.e.*, the art by the exercise of which the manufactured articles are produced, which must possess the quality of utility. (*i*) The utility of the articles produced by the exercise of the protected art is necessarily the measure of the utility of the art itself, for an art incapable of yielding useful results cannot possess this quality, which is essential for its protection by letters patent.

It is requisite at Common Law, as stated in cases earlier and later than the Statute of Monopolies, that an invention to be capable of substantiating a patent shall possess the element of utility. (*k*)

(*g*) Vin. Abr. Prerog. M.C.

(*h*) p. 166 *post*.

(*i*) See Palmer *v.* Wagstaff, Newton, L.J., vol. xliii. p. 151.

(*k*) It was argued in Darcy *v.* Allin, (1602) Noy, R. 182, that when a man brings into the realm any new trade, and that for the good of the realm, the King may grant him a monopoly for a reasonable time "in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not."

And again, in Sheppard's Abridgment (Part iii. p. 61), it was stated that the King may for a reasonable time grant a monopoly patent for a new trade or device, or any new engine tending to the furtherance of it, for the good of the realm.

In a *scire facias* to repeal a patent, Buller, J., held that it was a question for the jury to decide whether the only new part of the machinery described in the specification was material or useful, and that if they came to the conclusion that such was not the fact the patent was void. The jury gave their verdict against the patent, and on the motion for a new trial no objection was taken to this direction of the Judge (R. *v.* Arkwright, Dav. P. C. 138).

In Boulton *v.* Bull, (1795) 2 H. Bl. 463; Dav. P. C. 162, Rooke, J., said the public had a right to receive a meritorious consideration in return for the protection which the patent claimed.

In Turner *v.* Winter, (1785) 1 T. R. 602; Dav. P. C. 151, Ashurst, J., stated that a patent would be contrary to law were it not for the advantages which the public derive from the communication of the invention.

In Manton *v.* Parker, (1815) Dav. P. C. 327, Thomson, L.C.B., holding the plaintiff's patent void on the ground of the utility of the invention having failed, nonsuited him.

In Manton *v.* Manton, (1815) Dav. P. C. 333, Gibbs, L.C.J., held that in

**Utility at Common Law.**

As we have seen, (*l*) the Statute of Monopolies did not confer *any new right on the Crown, but only reserved to it the* privilege which it had long enjoyed before the statute, of granting monopolies in respect of new inventions, and the *concluding words of the reserving clause* (*m*) *expressly declared* that such privileges are not to be "contrary to the law, nor mischievous to the State by raising the prices of commodities *at home, or hurt of trade, or generally inconvenient.*" And the section concludes with a declaration that grants made in virtue of the power thereby reserved to the Crown shall be "*of such force as they should be if this Act had never been* made, and of none other," clearly indicating that all the provisions imposed by the Common Law were to be preserved, whether *expressly mentioned in the Act* or not. Thus the element of utility is as much a requisite, since the passing of the statute, as it was before it, for the enactment made no *difference in this respect, and every case relative to utility* decided since the statute is a fresh declaration of the Common Law on the subject.

**and is preserved by the Statute of Monopolies.**

Sir *Edward Coke*, commenting on the words "mischievous to the State by raising the prices of commodities at home," in 21 Jac. I. c. 3, s. 6, says: "In every such new manufacture as deserves a privilege there must be *urgens necessitas* and *evidens utilitas*," and that the reason why such a privilege is good in law is "because the inventor bringeth to and for the commonwealth a new manufacture by his invention, costs, and charges, and therefore it is reason that he should

order to support a right to the exclusive enjoyment of a patent, it is necessary that the party who takes out *a patent should show that the invention* is useful to the public.

In Bovill *v.* Moore, (1815) Dav. P. C. 399, the same learned Judge held that it was necessary that the plaintiff should prove that his invention was useful.

In Huddart *v.* Grimshaw, (1803) Dav. P. C. 265, Ellenborough, C.J., *held that in order to support the* patent the invention ought to be beneficial to the public.

In Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541, Abbott, C.J., put it to the jury to say whether the invention was useful. And in Russell *v.* Cowley, 1 W. P. C. 459, Lyndhurst, C.B., said that the first question respecting the invention was whether it was *new* and useful; and the rest of the Court concurred in this statement.

In Hill *v.* Thompson, (1817) 1 W. P. C. 235, Eldon, L.C., concurred in the direction of Dallas, J., to the jury who *tried the case in the Court of Common* Pleas, that the invention to support a patent must be useful. And in Minter *v.* Wells, 1 W. P. C. 129, Alderson, B., stated the same fact. And again, in Morgan *v.* Seaward, 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 170, the same learned Judge said, that if the invention was useful it was a *subject to be protected by patent; but* if it was of no use then it was not a subject to be protected by patent.

In Neilson *v.* Harford, (1841) 8 M. & W. 806; 1 W. P. C. 331, the Court of Exchequer held that a machine produced according to the invention must be beneficial to the public in order that the patent may be valid.

(*l*) p. 1 *ante.*

(*m*) s. 6.

Utility at Common Law.

have a privilege for his reward (and the encouragement of the like) for a convenient time."

Patents only used for purpose of obstructing improvements are void.

It scarcely admits of doubt that a patent for a useless invention which might be employed for the purpose of obstructing improvements would be void as being "prejudicial or inconvenient to our subjects in general" within the meaning of the first proviso in the grant itself, (*n*) and might, consequently, be annulled under the terms of that condition. It might also be annulled as being "mischievous to the State, to the hurt of trade, and generally inconvenient" within the meaning of the Statute of Monopolies.

Thus *Parke*, B., (*o*) assigned as the reason why the law requires an invention to be useful in order to merit protection by patent, "that a grant of a monopoly for an invention which is altogether useless may well be considered as 'mischievous to the State, to the hurt of trade, or generally inconvenient' within the meaning of the Statute of Jac. I., which requires, as a condition of the patent, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly without obliging the person making use of it to purchase the useless invention."

It has been stated that on a review of the cases it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question whether the patent be void under the Statute of Monopolies. So in *Palmer* v. *Wagstaff*, where the evidence showed (*p*) that the patent, the subject of the action, had never been worked, and no attempt had been made to bring the articles, manufactured according to the method stated in the specification, before the public, and that the patent was only being used for the purpose of stopping the defendant from making improvements in the manufacture of candles, *Pollock*, C.B., said that in legal language it is a fraud on the law of patents for any person to take out a patent with a view to the obstruction of improvements. And again, the same learned Judge in *Crossley* v. *Potter* (*q*) held that a patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the

(*n*) Vol. II. p. 373.
(*o*) Morgan v. Seaward, (1836) 1 W. P. C. 197.
(*p*) (1853) Newton, L.J., vol. xliii. p. 131.
(*q*) (1853) Macr. P. C. 240.

Utility at Common Law.

introduction of other inventions adapted to the particular subject to which the invention may be applicable, could not in his judgment be supported.

The ground of the above dicta of *Pollock*, C.B., appears to be the assumption that the patentee is under the obligation of using the invention within the realm, and, if required, of licensing subsequent inventors to do so. It is submitted that, apart from the provisions of sec. 3 of the Patents Act of 1902, the patentee is not under any such obligation at common law, or in consequence of any statutory enactment. In order that a patent may be found void under the first proviso of the grant it is essential that the alleged invention *per se* must be shown to be "prejudicial or inconvenient to our subjects in general." The fact that the patentee, in the exercise of his common law rights (which are, of course, now curtailed by sec. 3 of the Patents Act 1902) to allow or prohibit the actual working of a new and useful patented invention at will, does, in a sense, actually prejudice some subsequent inventor, or other person desirous of using it, is not sufficient. Such prejudice to the subsequent inventor, or other person, does not arise from the nature of the alleged invention, but from the manner in which the patentee, acting within his common law rights, chooses to conduct his business, and there is no prejudice to the King's subjects in general within the meaning of the proviso. If, however, an alleged invention which is not useful were put in monopoly, the grant would obviously be "mischievous to the State, to the hurt of trade, and generally inconvenient," as well as "prejudicial to our subjects in general," and *ipso facto* void both under the terms of the sixth section of the Statute of Monopolies and the proviso in the patent. This will appear from a consideration of the fact that a subsequent inventor who had perfected the useless invention could not use the result of his skill without paying royalty to the patentee of the useless invention, who would thus be enjoying a privilege though having made no invention for the public good, and, consequently, having deceived the Crown in its grant. (*r*) It is further submitted that the real ground of the decisions in *Palmer* v. *Wagstaff* and *Crossley* v. *Potter* should have been the presumption of want of utility arising from non-user.

It is to be remembered that not every useful novelty is

(*r*) p. 158 *ante*.

Meaning of Utility in Law.

patentable. To be patentable the novelty, besides being useful, must be the outcome of inventive ingenuity. (*s*)

It is not necessary that the invention should be actually put in practice, and the articles produced by its exercise sold, in order that the requisite utility in the invention to merit protection by letters patent may be established; it is quite sufficient if there is evidence to the effect that the invention, if put in practice, would produce useful results. (*t*)

## Meaning of Utility in Law.

Utility does not mean abstract utility;

The kind of utility which the law requires that an invention must possess to make it fit subject-matter for a patent is not abstract utility.

In a case in which the validity of a patent for improvements in the manufacture of stays and corsets was questioned, on the ground that the invention was not useful, *Grove*, J., directed the jury that, though they might be of opinion that stays are very bad things in themselves, they ought not to say that the invention was useless for that reason, for utility in law means "an invention better than the preceding knowledge of the trade as to a particular fabric." (*u*)

or necessarily an improvement from all points of view.

This definition given by *Grove*, J., requires some modification, for it may well be that a person might produce a new article not so good as the best of its kind, but still *good* and readily sold because it is cheaper. It is submitted that an article which is *good* and cheaper, by reason of its manufacture, than an intrinsically *better* prior article may be sufficiently useful to support a patent on the ground of utility. (*x*) Further, it is no objection to a patent on the ground of want of utility, provided the thing is useful for the purpose for which the patentee intends it, to point out that it has not come into general use because something else more recent has been preferred. Comparative utility in this sense has

(*s*) Brook *v.* Aston, (1857) 8 Ell. & B. 478; Ralston *v.* Smith, (1865) 11 H. L. C. 223; Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 673, 687; Riekmann *v.* Thierry, (1896) 14 R. P. C. 185; p. 30 *ante*.

(*t*) Otto *v.* Linford, (1881) 46 L. T. N. S. 39; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 313; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Edison *v.* Holland, (1889) 6 R. P. C. 277.

(*u*) Young *v.* Rosenthal, (1884) 1 R. P. C. 34, 41; see also Manton *v.* Parker, (1815) Dav. P. C. 327; 1 W. P. C. 192 *n.*; Manton *v.* Manton, (1815) Dav. P. C. 348; 1 W. P. C. 192 *n.*; 1 Carp. P. C. 278.

(*x*) See judgment of Buckley, J., Welsbach Incandescent Gas Light Co. *v.* New Incandescent (Sunlight Patent) Gas Light Co., (1900) 17 R. P. C. 252, which practically adopts the above submission.

Meaning of Utility in Law.

nothing to do with it so long as the thing is useful for the purpose intended. (*y*) It would appear that an "invention" is useful in the eye of the law when it is capable of commercial existence as a process of manufacture, (*z*) or the public are thereby enabled to do something which they could not do before, or to do something which they could do before, but in a more advantageous manner; (*a*) provided always that the thing in question is not contrary to the law, nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient. In short, an invention is patentable which offers to the public a useful choice, (*b*) *i.e.*, useful in some cases though not in all cases, unless the patentee has represented it as useful in all cases. (*c*)

Commercial utility.

When the validity of a patent is put in issue, in an action at law, on the ground of lack of utility, it is not always necessary, for the purpose of supporting the patent, to establish that the invention is *commercially* useful. The reason why it has not been adopted in commerce may be that it has been immediately superseded by simpler and better or cheaper constructions, involving the same principle. (*d*) There is in fact in many cases no necessary relationship between the commercial pecuniary success of an invention and its utility in patent law; (*e*) but, of course, when the question is one of improvement by reason of cheaper production, the consideration of commercial utility is of the very essence of the patent, and the thing claimed has not really been invented unless that condition has been fulfilled. (*f*)

The circumstance that an invention has not come into general use merely raises a strong presumption against its utility, (*g*) and commercial success is not necessarily evidence

(*y*) Fawcett *v.* Homan, (1896) 13 R. P. C. 405.

(*z*) Wilson Brothers Bobbin Co. *v.* Wilson & Co., Ld., (1902) 20 R. P. C.

(*a*) See note (*u*) *ante*.

(*b*) Welsbach Incandescent Gas Light Co. *v.* New Incandescent (Sunlight Patent) Gas Light Co., (1900) 17 R. P. C. 252; Ward *v.* Hill, (1901) 18 R. P. C. 481; 20 R. P. C. 189.

(*c*) Ward *v.* Hill, (1903) 20 R. P. C. 199, 203.

(*d*) Galloway's Patent, (1843) 1 W. P. C. 724; Bovill *v.* Moore, (1815) Dav. P. C. 361; Otto *v.* Linford, (1881) 46 L. T. N. S. 41; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 313; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Edison *v.* Holland, (1889) 6 R. P. C. 277; Wilson *v.* Union Oil Mills, (1891) 9 R. P. C. 70.

(*e*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 712; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Kurtz *v.* Spence, (1887) 5 R. P. C. 182; Fawcett *v.* Homan, (1896) 13 R. P. C. 274; Atkins and Applegarth *v.* Castner-Kellner Alkali Co., (1901) 18 R. P. C. 295.

(*f*) See Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 12 App. Cas. 712; see also 1 W. P. C. 71 *n.*; pp. 12, 69 *ante*.

(*g*) Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Tetley *v.* Easton, (1852) Macr. P. C. 56.

Amount of utility. Invention must be Useful as Specified.

that the subject-matter of the patent, though useful, is the outcome of *invention* and so fit to support the patent. (*h*)

An alleged invention which differs from a prior invention only in that it contains an ingredient which does neither good nor harm does not possess sufficient utility to merit a patent. (*i*)

### Amount of Utility.

Slight amount of utility is sufficient to support a patent.

The law does not require that an invention, to be worthy of a patent, must possess any definite amount of utility; but it has been decided, over and over again, that a very slight amount of utility will be sufficient (*k*) provided that the Crown has not been deceived as to the extent of the utility of the invention. (*l*) Thus, when the validity of *Galloway's* patent for improvements in steam-engines came into question, *Alderson*, B., told the jury, with regard to the utility of the invention, that the question for them to decide was, whether the steam-engine was a useful invention, and that he thought, if *Galloway's* engine was of a different construction from any other steam-engine, and of any use to the public, that was sufficient. (*m*)

### Invention must be Useful as Specified, and for the Purpose Stated.

Invention is useless unless it does what the patentee states it will do.

The patent will be void unless the invention be useful exactly as it is specified by the patentee, notwithstanding that it may be useful in a modified form, (*n*) or in conjunction with some subsequently discovered material or device. (*o*) In other words, the question always is, Does the invention really do, when put in practice by a competent man, what it assumes to do? And unless the public are enabled to do what the inventor says they can do by means of his invention

(*h*) p. 108 *ante*; Fawcett *v.* Homan, (1896) 13 R. P. C. 274.

(*i*) Lawrence *v.* Perry, (1885) 2 R. P. C. 184.

(*k*) Philpot *v.* Hanbury, (1895) 2 R. P. C. 37; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 582; Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Scott *v.* Hambling & Co., (1897) 14 R. P. C. 123.

(*l*) Pirrie *v.* York Street Flax Spinning Co., (1893) 10 R. P. C. 39; 11 R. P. C. 429.

(*m*) Morgan *v.* Seaward, (1836) 1 W. P. C. 172, 186.

(*n*) Tolson *v.* Speight, (1896) 13 R. P. C. 718; Wilson Brothers Bobbin Co., Ld. *v.* Wilson & Co., Ld., (1902) 20 R. P. C. 1.

(*o*) Tubeless Pneumatic Tyre and Capon Heaton, Ld. *v.* Trench Tubeless Tyre Co., Ld., (1899) 16 R. P. C. 291, 312.

—*i.e.*, the invention is useful for the purpose for which the inventor intended it—the patent is void. (*p*)

Invention must be Useful as Specified.

The fact that one mode of carrying out the invention described by the patentee in his specification is preferable to, and more useful than, other modes described, all being useful, is no objection to the patent. (*q*) Neither is a patent invalid merely because it turns out that the most sanguine expectation of the patentee is not realised in full. (*r*) When an invention does what it is intended by the patentee to do, and the end attained is itself useful, the invention is a useful one. A patent for such an invention is not to be held bad for want of utility, by comparing it with other known methods or things which may be preferred to it. An invention may be useful, although, owing to other circumstances, the public will not use it; but if they do use it no better proof of utility can be had, (*s*) and the fact that a defendant has attempted to infringe a patent is most cogent evidence as to its utility. (*t*)

Per Lindley, L.J.

Upon the point that an invention must be useful, as specified, and for the purpose for which it is stated by the patentee to be useful, the following passage from the judgment of Lord *Lindley*, then *Lindley*, L.J., in *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co., Ld.*, (*u*) with reference to the facts of that case, may be quoted with advantage:—

> "The utility of the alleged invention depends, not on whether by following the directions in the complete specification all the results necessary for commercial success can be obtained, but on whether by such directions the effects which the patentee professed to produce could be produced, and on the practical utility of those effects. Can it be said that the invention, as described in the amended specification, was, in 1878, a practically useful addition to the then stock of inventions? To judge of utility the directions in the amended specification must be followed, and if the result is that the object sought to

(*p*) Cornish *v.* Keene, (1835) 1 W. P. C. 507; Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 210; 3 R. P. C. 94; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 462; L. R. 12 App. Cas. 712, 719, 720; Wilson *v.* Union Oil Mills, (1892) 9 R. P. C. 70; Fawcett *v.* Homan, (1896) 13 R. P. C. 268; Tubeless Pneumatic Tyre and Capon Heaton, Ld. *v.* Trench Tubeless Tyre Co., Ld., (1899) 16 R. P. C. 201; Atkins and Applegarth *v.* Castner-Kellner Alkali Co., (1901) 18 R. P. C. 295.

(*q*) Miller *v.* Searle, (1893) 10 R. P. C. 106.

(*r*) Saccharin Corporation *v.* Chemical and Drugs Co., (1899) 17 R. P. C. 38.

(*s*) Fawcett *v.* Homan, (1896) 13 R P. C. 405.

(*t*) Lucas *v.* Miller, (1885) 2 R. P. C. 155: Miller *v.* Barker, (1893) 10 R. P. C. 111.

(*u*) (1892) 9 R. P. C. 417.

Invention must be Useful as Specified.

be attained by the patentee can be attained, and is practically useful at the time when the patent is granted, the test of utility is satisfied. Utility is often a question of degree, and always has reference to some object. 'Useful for what?' is a question which must be always asked, and the answer must be, 'Useful for the purposes indicated by the patentee.' See, per Lord Chief Justice *Tindal* in *Cornish* v. *Keene*, 1 W. P. C. on p. 507; *Edison* v. *Holland*, 6 R. P. C. 243; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 12 App. Cas. on pp. 712, 719, 720. An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purpose; useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. This is, in my opinion, the real truth with respect to the plaintiff's invention as now claimed by him. He made a distinct and important step in advance. The plaintiff was the pioneer; he showed others the road to be followed, but he did not give the traveller the information necessary to enable him to travel on it. There were difficulties to be overcome which the patentee did not foresee, and against which he naturally made no provision. There is an enormous mass of conflicting evidence upon the possibility of obtaining practically useful results by following the directions contained in his specification. Much of the evidence adduced against the patentee merely goes to show that by following the directions in the specification you cannot produce such good results as are produced by the defendants. This obviously is wholly immaterial. . . . I have studied the whole evidence with all the care I can bestow upon it, and have come to the conclusion that the plaintiff had not in 1878 invented what he now says he had—namely, a practical method of keeping the electro-motive force in the mains constant at about 100 volts by means of secondary batteries and dynamos used simultaneously as described."

Lack of utility in an essential part is fatal.

If any material part of the representation, with regard to utility, upon the strength of which a patent was granted, turns out to be untrue, the patent will be void, because of the partial failure of the consideration, (*x*) and also on the ground that the representation being false, the Crown has been deceived in its grant. (*y*) In the words of *Dallas*, J.: "If any part of the alleged discovery, being a material part, fail (the

(*x*) Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Moore, 448; 1 W. P. C. 232; Bloxam *v.* Elsee, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93; United Horse-shoe and Nail Co. *v.* Swedish Horse-nail Co., (1889) 6 R. P. C. 8.

(*y*) Morgan *v.* Seaward, (1836) 2 M. & W. 561; 1 W. P. C. 172.

discovery in its entirety forming one entire consideration) the patent is altogether void." (z)

Invention must be Useful as Specified.

So if a patentee claims several inventions under different claiming clauses, and it turns out that any one of them, which is an essential part of the consideration for the grant, is useless, the patent is void. (a)

Illustrations.

Thus, in the case of *Manton* v. *Parker*, 1815, (b) the whole purpose for which the invention, in the specification, was said to be useful, failed, and the patent was declared to be consequently void. The invention was "for a hammer of an improved construction, for the locks of all kinds of fowling-pieces and small arms," and a material part of the invention consisted in a means of letting out the air from the barrel and causing a communication between the powder in the pan and in the barrel. The evidence, however, showed that the powder passed through the same hole as the air; and *Thomson*, L.C.B., held that the utility of the invention, and the purpose of the hole, as described in the specification, wholly failed; for the purpose of the hole as described was to let the air pass through, and, at the same time, secure the powder from passing through.

Again, in *Easterbrook* v. *The Great Western Railway Co.*, (c) the main object of an invention of "improvements in machinery and apparatus for actuating and controlling railway points and signals" was to prevent points and signals being set antagonistic to each other. The defendants, who set up the invalidity of the patent, upon the ground (*inter alia*) of absence of utility in the invention, proved at the trial that the apparatus could be so worked as to give conflicting signals, or signals conflicting with the points. The Court held that the patent was bad, because the invention was not only not useful, but dangerous.

In *Turner* v. *Winter* (d) the plaintiff's patent was declared void, on the ground that it claimed to produce three different things by one and the same process; and the evidence distinctly showed that the process would not produce one of them (white lead) at all. On a motion for a new trial, made in the Court of King's Bench, *Ashurst*, J., laid down that:

(z) Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Moore, 448.

(a) Morgan *v.* Seaward, (1836) 1 W. P. C. 171; 2 M. & W. 558; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 315; Templeton *v.* Macfarlane, (1848) 1 H. L. C. 595; United Horse-nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

(b) Dav. P. C. 327; 1 W. P. C. 192 *n.*, 481 *n.*

(c) (1885) 2 R. P. C. 201.

(d) (1787) 1 T. R. 602; 1 W. P. C. 77.

Invention must be Useful as Specified.

Illustrations.

"If the process, as directed by the specification, does not produce that which the patent professes to do, the patent is void." And *Buller*, J.: "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

*Bloxam* v. *Elsee* (*e*) was an action brought for the infringement of two patents belonging to the plaintiff. Both patents were, however, held void on the ground that the second depended on the first, which was bad for want of utility. The judgment of *Abbott*, C.J., who tried the case, was to the effect that by the patent (the first patent) it appeared that the patentee had represented to the Crown that he was in possession of *a machine* for making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent was granted. The consideration for the grant was the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration had failed in part, and the grant was consequently void, and a defendant in an action for infringement had a right to say that it was so. If the representation was (as the learned Chief Justice thought it was) that paper of various widths might be obtained from one and the same machine, the evidence must be looked to to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing that object, and, unfortunately, the evidence showed that he was not. The patentee was at the time possessed of one machine and one only, and that adapted to one degree of width and one degree only. And he was not then possessed of any method by which different degrees of width might be manufactured by that machine or by any other.

A patent, the title of which was "improvements in steam-engines, and in machinery for propelling vessels, which improvements are applicable to other purposes," was declared void by the Court of Exchequer on the ground that, upon the face of the patent as set out in the record, it appeared that an improvement in steam-engines was suggested by the

(*e*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

patentee, and that the jury having found that the invention was not an improvement in steam-engines, though it was an improvement in machinery for propelling vessels, the grant was void for false suggestion. (*f*)

Invention must be Useful as Specified.

Illustrations.

Again, in another case in the Court of Exchequer, Lord *Abinger*, C.B., directed the jury to consider whether an invention of improvements in wheels for railway carriages was worth a patent or not, or whether the improvements were, as the defendant alleged, only trifling and insignificant alterations. The jury found that there were substantial improvements in the invention, but, had they come to the opposite conclusion, the Court would no doubt have declared the patent bad on the ground of false suggestion.

If an invention is useful for the generality of purposes for which it is stated in the specification so to be, the fact that it is altogether useless for one purpose falling within the statement will not necessarily vitiate the patent.

If invention is useful for most purposes within a general statement, the fact that it fails for one purpose within such statement is not necessarily fatal.

Thus, in *Haworth* v. *Hardcastle* (*g*) the patent was for "certain machinery, or apparatus adapted to facilitate the operation of drying calicoes, linens, or other similar fabrics," and on a motion for a nonsuit and to set aside a verdict given for the plaintiff on the finding of a jury that the invention was new and useful on the whole, but that the machine was not useful in some cases for taking off goods, the Court, consisting of *Tindal*, C.J., *Parke*, *Gaselee*, and *Bosanquet*, JJ., held that they would not be justified in setting aside a verdict given on such a finding, and in holding that the patent was void on the ground that the machine was altogether useless for one of the purposes described in the specification.

If an entire machine or subject is, as a whole, useful, a want of utility in a part or parts, provided that the useless part or parts form no part of the consideration in respect of which the patent was granted, will not vitiate a patent in respect of such machine or subject, (*h*) and a minor claim the subject of which is found not to be useful will not be fatal, provided there is no concealment, and the subject of the claim does not form part of the consideration for the grant.(*i*)

Lack of utility in non-essential part is no bar.

(*f*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187; see also Owen's Patent, (1899) 17 R. P. C. 68, 78.

(*g*) (1834) 4 M. & Sc. 790; 1 Bing. N. S. 182; 1 W. C. P. 480.

(*h*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187; Lewis *v.* Marling, (1829) 1 W. P. C. 490; United Horse-nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 131.

(*i*) United Horse-shoe Co. *v.* Swedish Horse-nail Co., (1888) 6 R. P. C. 8; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 450.

Invention must be Useful as Specified.

If an invention as a whole is useful, it is not necessary that each part of it should possess the same amount of utility. (*k*)

A patent is void if an essential part of the invention is impracticable and useless, (*l*) but if part of an invention, as described in a specification, turn out to be not necessary, the inutility of that part will not vitiate the patent unless it is claimed as *essential*. (*m*)

In *Lewis* v. *Marling*, (*n*) the patent was for improvements in shearing machines, for shearing or cropping woollen and other cloths. And it appeared in evidence that a brush, described in the specification, and intended to raise the wool, was unnecessary and useless. The Court of King's Bench held that the inutility of this brush, which was not claimed as *essential*, did not render the patent bad. *Tenterden*, C.J., saying: "As to the objection on the ground that the application of a brush was claimed as part of the invention, adverting to the specification, it does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent they had made a machine to which the brush was affixed, but before any machine was made for sale they discovered it to be unnecessary. I agree, that if the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and thereby 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." *Bayley*, J., saying: "Now, at the period when this specification was made, the brush was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. 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 brush was unnecessary is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad, on the ground that this was deception, but if he

(*k*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 103.

(*l*) United Horse-nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

(*m*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 1 W. P. C. 493; Morgan *v.* Seaward, (1837) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153: United Horse-nail Co. *v.* Stewart, (1885) 2 R. P. C. 132.

(*n*) (1829) 10 B. & C. 22; 4 Car. & P. 57; 1 W. P. C. 493.

thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection."

Utility of Improvements.

## Utility of Improvements.

In the case of a patent for an invention which is an improvement on a former invention, the want of utility in the former invention will not vitiate the patent for the improvement, which will be perfectly valid as regards utility, if the machine manufactured according to it is useful. (*o*)

Lack of utility in a prior invention is no bar to a patent for an improvement upon it.

*Bloxam* v. *Elsee* (*p*) at first sight appears to be a decision contrary to the above proposition, but it must be observed that *Bloxam* v. *Elsee* was decided on the ground that the subsequent patent was granted on the strength of the suggestion contained in the prior patent, which turned out to be false.

In the case of a patent for an invention which is an improvement on a former patented invention, the question always is, What is the representation on the strength of which the second patent was granted? If the second patent was granted on the same representation as rendered the first void it is bad also; but if the second patent was granted on a true representation the fact that the first patent was bad will not vitiate the second.

(*o*) Lewis *v.* Davies, (1829) 3 Car. & P. 502; 1 W. P. C. 488; per Lord Tenterden, C.J.; Tetley *v.* Easton, (1852) Macr. P. C. 56; Murray *v.* Clayton, (1877) L. R. 7 Ch. 581; Morgan *v.* Windover, (1888) 5 R. P. C. 303; Jones *v.* Pearce, (1832) 1 W. P. C. 121, 122; Shaw *v.* Jones, (1889) 6 P. O. R. 336.

(*p*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; L. J. (O. S.) Q. B. 93; see p. 169 *ante*.

# CHAPTER V.

## THE SPECIFICATIONS.

### Origin and Development.

Historical.

When a person becomes the recipient of the exclusive privilege of exercising any particular art under a grant of letters patent from the Crown, it is of the utmost importance, in the interests of the rest of the community, that definite information should be given as to what it is they are, without the sanction of the patentee, prohibited from doing during the existence of the monopoly. It is also very essential, in the interests both of the patentee himself and the public, that the exact invention which forms the subject of the grant of letters patent and the best means of performing it should be clearly defined. An invention without the knowledge of the means of putting it into practical operation is of no use to its possessor; and the patent may be considered substantially as amounting to a bargain between the patentee and the Crown, according to which the former shall disclose the means of putting the invention into practice for the benefit of the public, so that, after the expiration of the time for which the monopoly is granted, all may alike enjoy the benefits of the discovery, if minded to do so. (*a*)

It was formerly the practice to insert in the letters patent a recital, amounting to a description of the invention, which was the subject of the grant, and this recital, which was usually very meagre, was, except in so far as the patentee verbally instructed particular members of the public, the only source of information as to what the invention really was and how it was to be performed.

Great inconvenience was found to arise from this practice, and certainly as early as the reign of Queen Anne a plan was devised to obviate this objection. This plan consisted in making it a condition that the patentee should, within six

(*a*) p. 106 *ante*.

months, "particularly describe and ascertain the invention, and the manner in which it is to be performed," and in inserting in the letters patent a declaration that an omission to do this would render the grant null and void. This was the origin of the modern instruments known as specifications. Before this period of six months had elapsed, there being no provisional specification, it must have been a question of evidence as to what was the invention for which the patentee went to the Crown, and for which the Crown granted a monopoly. (*b*)

Origin and Development.

The Patent Act of 1852 introduced a further improvement by providing that would-be patentees should, at the time of application for letters patent, deposit a provisional specification, which is a very different instrument to that required after the grant under the earlier practice. Instead of requiring that the patentee should, in the provisional specification, "particularly describe and ascertain the nature of the invention, and in what manner the same shall be performed," the Act of 1852 only insisted that in the provisional specification, which the applicant was to leave with the law officer of the Crown when he applied for a patent, he should state the nature of the invention; and the Act further provided that when the law officer of the Crown had looked at the specification, if he were of opinion that it did not state the nature of the invention, he should be competent to require the document to be amended in that particular, but if he thought it properly stated the nature of the invention he could grant a certificate authorising the applicant to use the invention publicly without thereby making a publication which would render the patent, if granted afterwards, invalid.

The provisional specification was introduced for the benefit of the patentee, who, during the period of protection from the effects of publication which the certificate of the law officer of the Crown secured, was enabled to make further experiments and improve the means of carrying out his invention before filing his second and complete specification, in which he was required not only to "describe the nature of the invention," but to "state in what manner the same shall be performed." It was, moreover, under the Act of 1852, competent for the applicant, if he thought fit, to file his complete and final specification on making application for the grant of letters patent, instead of putting in a provisional specification; but it would clearly not be his interest as a rule to do so, for he would

(*b*) Bailey *v.* Roberton, (1878) 3 App. Cas. 1074, per Lord Blackburn.

Origin and Development.

thereby deprive himself of the right to make further legitimate improvements before obtaining the great seal.

The practice in this matter under the Patents, Designs, and Trade Marks Act 1883, is practically the same as that under the Act of 1852, excepting that the leaving of a complete specification is now always a condition precedent to the grant of a patent; and it is enacted that an application for a patent must be accompanied by either a provisional or a complete specification, and that a provisional specification must *describe the nature of the invention*, whilst a complete specification, whether left on application or subsequently, must *particularly describe and ascertain the nature of the invention, and in what manner it is to be performed*; and a provisional or complete specification must, if required, be accompanied by drawings. (*c*)

Consideration for letters patent.

There are some who maintain that the consideration for the grant of the patent is the introduction and setting up within the realm of a manufacture according to the new and useful invention: whereas there are others who contend (and it is submitted rightly contend) that the consideration is the disclosure of the invention and the manner of performing it, whereby the public is instructed how they may, after the expiration of the monopoly, enjoy the invention for themselves, if minded so to do. The point is one of considerable academic interest, but a minute discussion of it would be foreign to the scope of this work and occupy too much space to permit of it being entered upon here. The practical conclusion of the matter is that the legislature, as voiced in the present Patents Acts, and various Courts by their decisions, (*d*) have acted upon the view that disclosure of the new and useful invention and the means of performing it, as distinguished from the actual setting up of a manufacture according to the invention within the realm, is the essence of the consideration. The correct view supported by existing decisions (*e*) appears to be that a patentee is not *primâ facie* bound to himself work the invention within the realm, or to licence others to do so. Sec. 3 of the Patents Act 1902, as was the repealed sec. 22 of the Act 1883, is specially framed to deal with the public inconvenience likely to arise if the patentee, during the currency of the patent, does not either himself work the invention

(*c*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2, 3, 4.

(*d*) *E.g.*, Badische Anilin und Soda Fabrik *v.* Thomson, (1904) 21 R. P. C. 473.

(*e*) *Ibid.*

within the realm, or, upon just terms, permit others to do so. (*f*) The Title.

It may well be that the necessity for the filing of a full and sufficient specification has displaced the older necessity at common law, if it ever existed, of inculcating a knowledge of the invention by its actual working and introduction as a trade within the realm. It must be remembered that the specification on its introduction was a condition subsequent to the grant, whereas now it is a condition precedent. This fact is indicative of the evolution from an earlier common law view that the introduction of the invention itself within the realm, as a trade, was the price paid for the patent to the more modern doctrine, which fixes the price paid as merely the introduction or communication within the realm of a knowledge of the invention and the best means known to the patentee of performing it.

## THE TITLE.

A specification, whether provisional or complete, must commence with the title, (*g*) which is virtually a short and concise statement of the invention. (*h*) Before the days of provisional specifications the title was of far greater importance than it is now. In those days its functions were largely those of the provisional specifications now, and a discrepancy between the title and the specification subsequently enrolled was a matter of vital importance, as it rendered the patent utterly void. Titles should be drafted in conformity with certain rules.

Since the passing of the Act of 1883, defective titles have not been, nor are they likely to be, so frequent as they were formerly, for it is expressly provided by the sixth section of that Act that the Comptroller shall refer every application to an examiner, who is required to examine the specification and to ascertain that the title sufficiently indicates the subject-matter of the invention. There is, in fact, no reported case since the Act of 1883 in which a patent has been declared void on the ground of a defective title, and there appears to be only one (*i*) in which the question has been raised. Still, if the title after it has passed the examiner, or after amendment, remains defective, it may be an objection to the validity of the patent; and it must not be forgotten that under the practice before the Act

(*f*) See Vol. II. p. 259 *post.*
(*g*) 46 & 47 Vict. c. 57, s. 5, sub-s. 5.
(*h*) Household Co. *v.* Neilson, (1843) 1 W. P. C. 678.
(*i*) Pirrie *v.* York Street Spinning Co., (1892) 10 R. P. C. 31.

The Title.

of 1883 an examination of the title was supposed to be made by the patent clerks of the law officers of the Crown before the great seal was obtained, and that, notwithstanding this precaution, it was not uncommon for patents to be vitiated through defects in their titles.

The specification is to be construed as a whole, and a defect in the title may consequently be remedied in the body of the specification. (*j*) Further, a patentee is entitled to frame the title in his own way, provided he does not infringe the rules of the statute. (*k*)

It is not uncommon for the Comptroller-General, or, on appeal from him, the law officer, to make the amendment of titles as originally drafted a condition of the grant of letters patent. (*l*)

Rules in conformity with which titles should be drafted.

Titles should be drafted in conformity with the following rules. As inferred above, the cases quoted in support of the rules were all decided before the Act of 1883, but under the present practice, assuming that the provision in the Act of 1883 for reference to an examiner has not removed the objection of defective title against a patent which has been accepted by the examiner, (*m*) in the event of a title being defective, the principles of these cases would still apply; and the authorities at the Patent Office require titles to substantially conform to the rules hereafter stated. Of course it is a question of fact in each instance whether the title is at variance with any one or more of the rules under consideration.

I. *The title must not be too extensive so as to embrace more than the patentee has really discovered, for this may make the patent void on the ground that it has been granted for more than the patentee is entitled to.*

Thus, in *Cochrane* v. *Smethurst*, (*n*) where a man had invented a glazed street lamp, and obtained a patent for it under the title "an invented method of more completely lighting cities, towns, and villages," he was nonsuited in an action for infringement of his patent, on the ground that he had obtained it, not for an improved street lamp, but for an improved method of lighting streets, towns, and villages. (*o*) And in *Felton* v. *Greaves*, (*p*)

(*j*) Vol. II. p. 277 *post*.
(*k*) Brown's Patent, (1887) Griff. L. O. C. 1.
(*l*) Vol. II. p. 6 *post*.
(*m*) See p. 175 *ante*; *cf.* Vol. II. p. 66.
(*n*) (1816) 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.
(*o*) See remarks of Tindal, C.J., Cook v. Pearce, (1844) 8 Q. B. 1051, 1062; 13 L. J. Q. B. 189.
(*p*) (1829) 3 Car. & P. 611.

where a man took out a patent under the title "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments," and the machine, as described in the specification, was not capable of giving an edge to scissors, the patent was held to be bad for want of sufficiency.

The Title.

Rules in conformity with which titles should be drafted.

In *Campion* v. *Benyon* (*q*) a rule *nisi* to set aside the verdict for the plaintiff, and to enter a nonsuit, was made absolute by the Court of Common Pleas. The title of the patent in question was "an improved method of making and manufacturing double canvas and sailcoth with hemp and flax, or either of them, *without any starch whatever*." It was sought, on the part of the plaintiff to show from the specification that the omission of the use of starch (which was old) was no part of what the plaintiff claimed. *Dallas*, C.J., delivering his *judgment*, said:—

> "With respect to patents, every patent being a monopoly, that is, an infringement of public right, and having for its object to give public warning of the precise extent of the privilege conferred on the patentee, the Court (without going into the controversy whether it is politic that such privileges should be conferred or not) is bound to require that such warning should be clear, and accurately describe what the inventor claims as his own. If the instrument contain an ambiguity on a material point that is a ground on which it may be avoided altogether. From the first time I read this patent down to the present day, I thought that the object of the patent was to make cloth without starch. Then, as to the specification, if that be different from the patent, the whole is void; if it coincides it is open to the same objection as the patent. Whether we look to the patent or the specification, I have no doubt that the claim of the plaintiff is too extensive; it is not confined to an improved method of weaving the cloth, or twisting the threads, but also comprehends another mode of proceeding, which is not a new discovery."

It has been held, on the other hand, that where the title was "improvements in the manufacture of plaited fabrics," the objection that only one improvement was disclosed by the specification was not sufficient to upset the patent, *Tindal*, C.J., remarking:—

> "This is, certainly, a most subtle objection; if the term 'improvement' had been used, it would have been *nomen collectivum*,

(*q*) (1821) 6 B. Moo. 71; 3 Brod. & Bing. 5.

The Title.

Rules in conformity with which titles should be drafted.

and would have covered any number of improvements. I cannot see why the variance, if it be one, should vitiate the patent, the objection being merely to the title of the patent, without fraud upon the Crown or detriment to the public." (*r*)

And, again, where the word "improvements," being in the plural number, was relied on as an objection to the patent in question, Lord *Abinger*, C.B., thought that it was of no consequence, because the plaintiff might mean every part of his process to be treated as an improvement, forming, together, a series. (*s*)

II. *The title should not be too narrow, so as to exclude something which the patentee has invented, for, if it be so, he may not obtain protection in respect of that to which he may be justly entitled.*

Thus, in *Croll* v. *Edge*, (*t*) a patent was granted under the title "improvements in the manufacture of gas for the purpose of illumination, and in apparatus used when transmitting and measuring gas." From the specification it appeared that the patentee had invented an improved method of making retorts. In that instrument it was stated that the invention consisted in "improvements in the manufacture of gas for the purpose of illumination, and apparatus used therein, and when transmitting and measuring gas," but the Court held that the patentee was not entitled to protection in respect of the retorts, as the title did not profess to comprehend improvements in any apparatus used in making gas, and that the insertion of the words "therein and" amounted to a substantial extension of the grant of the Crown.

In *Oxley* v. *Holden*, (*u*) in which the title of the patent was "improvements in the doors and sashes of carriages," the specification stated that the patentee had shown the invention, as applied to railway carriage doors and window fittings, although it was equally applicable to the doors and windows of any other description of carriage, or in any case where windows and doors are subject to jar and vibration. The Court held that the invention claimed was not larger than the title, and the judgment of *Erle*, C.J., contained the following passage:—

(*r*) Nickels v. Haslam, (1844) 7 M. & G. 378; 8 Scott, N. R. 97; 13 L. J. C. P. 146.

(*s*) Derosne v. Fairie, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476; 1 W. P. C. 154.

(*t*) (1847) 9 C. B. 479; 19 L. J. C. P. 261.

(*u*) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

The Title.

Rules in conformity with which titles should be drafted.

"The invention specified and claimed is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined, accordingly, to the doors and windows of carriages. The present case has no analogy to the decision of this Court in *Croll* v. *Edge*, (1847) 9 C. B. 479; 19 L. J. C. P. 261, where the patent was, in effect, for improvements in the apparatus for the manufacture, and also in that of the transmission, of gas. The specification, therefore, related to an apparatus additional to and beyond that referred to in the title. Here the title and the specification relate to one and the same apparatus."

III. *The title should not be vague or ambiguous.*

There is authority for saying that the mere vagueness or ambiguity of the title is an objection which may well be taken on the part of the Crown—that is to say, by the Comptroller-General, (*v*) before a patent is granted, but it affords no ground for avoiding the patent after it has been granted, provided that the ambiguity is explained by the specification, and the title is not at variance with it. (*w*)

Thus, in *Sturz* v. *De la Rue* (*x*) a patent for a method of fixing folding shutters in carriages in which *German* shutters were used was upheld, notwithstanding the objection that the title "improvements in carriages" was too vague.

And in *Neilson* v. *Harford* (*y*) a patent for the application of the *hot blast* in the smelting of iron, under the title "an improved application of air," was upheld.

IV. *The title should not contain a misdescription of the invention, for this may be a fatal objection if not corrected in the body of the specification.*

In *Rex* v. *Metcalf*, (*z*) a patent under the title "a tapered hair or head brush" was upset, on the ground that from the description in the specification it appeared that the brush invented by the patentee did not taper, but was only unequal. (*a*)

(*v*) Vol. II. chap. i.

(*w*) Cook *v.* Pearce, (1844) 8 Q B. 1044; 13 L. J. Q. B. 189.

(*x*) (1828) 5 Russ. 322; 7 L. J. (O. S.) Ch. 47.

(*y*) (1841) 1 W. P. C. 295; 8 M. & W. 806; 2 Coop. Ch. Cas. 61; 11 L. J. Ex. 20.

(*z*) (1817) 2 Stark. R. 219.

(*a*) See also Neilson *v.* Harford, (1841) 1 W. P. C. 333.

The Title.

Rules in conformity with which titles should be drafted.

In *Bainbridge* v. *Wrigley*, (*b*) Lord *Ellenborough* held a patent void which was for "certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that were never before produced," on the ground that the instrument described, as a matter of fact, produced only one new note.

In *Fisher* v. *Dewick* (*c*) the title of the patent in question was "improvements in machinery for the manufacture of bobbin net lace," and the defendant objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part of the process, and being useless when that addition was not wanted, and that the title should have been "for a mode of making spots in bobbin net lace." *Coltman*, J., ruled that the invention was inapplicable to anything but the making of bobbin net lace, and that it was an improvement. The Court of Common Pleas supported the ruling of the Court below, *Tindal*, C.J., observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net lace.

V. *A false suggestion in the title may be fatal to the validity of the patent, for the Crown may have been deceived in its grant.*

Thus, in *Morgan* v. *Seaward*, (*d*) the case of *Galloway's* patent for "improvements in steam-engines and in machinery for propelling vessels," the defendants in an action for infringement obtained a verdict on the issue that the invention was not an improvement in steam-engines.

In *Bloxam* v. *Elsee* (*e*) the patent was held void on the ground of false suggestion, it appearing that the patentee had by the title represented that he was in possession of "an invention of making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length," whereas from the evidence it appeared that the machine he claimed to have invented would only make paper of one particular degree of width and length.

It is not uncommon to find the titles of patents commencing

(*b*) (1810) Parl. Rep. 197.
(*c*) (1838) 4 Bing. N. C. 706.
(*d*) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.
(*e*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

with the words "a new or improved method or process," and it would appear that if the method or process be partly new, so as to produce a result which as a whole is new, or if the method or process be entirely new, it may properly be called a new or improved method or process; (*f*) whereas, if the method or process be not new, but improved, the patent with such a title may be bad. (*g*)

The Title.

Rules in conformity with which titles should be drafted.

VI. *If the title insufficiently or inaccurately describe what is really the invention, it will not render the patent void, if it is comprehensive enough to include the actual invention.*

In *Hills* v. *The London Gas Light Co.*, (*h*) the title as amended was "an improved method of purifying coal-gas," and it appeared from the specification that the invention really consisted in a method of removing the sulphuretted hydrogen which occurs as an impurity in coal-gas. The Court of Exchequer overruled the objection that the invention specified was different from that for which the patent was granted, *Watson*, B., saying:—

> "The patentee made a mistake in stating for what he wanted his patent, but in reality he wanted a patent for his invention; it has been granted to him for that and the title comprehends it. If, indeed, the jury had found either that when he applied for the patent he had not invented the thing specified, or that, in truth, he did not apply for it, a different question might have arisen; but the jury must be taken to have found that, although he has inaccurately or insufficiently described what he was asking for, in reality he was asking for a patent for this invention." (*i*)

In *The Electric Telegraph Co.* v. *Brett*, (*k*) the defendants objected that the plaintiffs' patent being described in the title as an "Invention of improvements in giving signals and sounding alarums in distant places, *by means of electric currents transmitted through metallic circuits*," it was impossible for them, the defendants, to infringe as long as the circuit they used was not metallic throughout, but to a substantial extent

(*f*) Beard *v.* Egerton, (1846) 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

(*g*) Gibson *v.* Brand, (1842) 1 W. P. C. 634.

(*h*) (1860) 29 L. J. Ex. 409; 5 H. & N. 312.

(*i*) See also Regina *v.* Mill, (1851) 10 C. B. 389; 14 Beav. 312; 20 L. J. C. P. 16.

(*k*) (1851) 10 C. B. 838; 20 L. J. C. P. 123.

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*non-metallic.* The jury, however, found a verdict for the plaintiffs, which was upheld by the Court of Common Pleas, *Creswell*, J., saying:—

"Now, the patentees, by their specification, do not make any claim to metallic circuits. What they claim is improvements in giving signals by means of electric currents transmitted through metallic circuits, and the improvements, as appears by the specification, consist entirely in the methods and instruments for using the electric current. The circuit used by the defendant is metallic in all that part which operates in giving signals, and it is no condition necessary to the existence of the improvements that the circuit should be metallic in any other part than that which contains the coils and operates on the needles. It appears to us reasonable to hold that a claim for a patent for improvement in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed and their application."

## The Provisional Specification.

Provisional specification is optional.

An applicant for a patent is required to accompany his application by a specification, but it is optional whether this shall be provisional or complete.(*l*) It is, however, in virtue of the difference between the requisites of the provisional and complete specifications, very rarely to the interests and advantage of a would-be patentee to depart from the general practice of accompanying his application by a provisional specification, and availing himself of the time allowed him under the Act wherein to consider and fulfil the obligations which the necessity of ultimately filing a complete specification imposes upon him.

Differences between provisional and complete specifications.

**Functions of Provisional Specifications.**—The provisional differs from the complete specification in that the former must describe the nature of the invention, and the latter must *particularly* describe and ascertain the nature of the invention and *in what manner it is to be performed.* (*m*) It thus appears

(*l*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2; for forms of provisional and complete specification, see Vol. II. pp. 350, 351.

(*m*) 46 & 47 Vict. c. 57, s. 5, sub-s. 3, 4.

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that, as regards the description of the invention, there is a difference in the accuracy with which this is required to be given by the two specifications. The provisional specification need not enter in detail into all the means by which the invention is to be carried out; (*n*) nor is it necessary that it should describe any mode of carrying it out at all; (*o*) nor is it necessary that it should state all the objects to which the invention may be applied. On the contrary, the invention may in the complete specification be described and claimed as applied to objects not mentioned in, or contemplated by the patentee at the date of, the provisional. (*p*) The provisional specification was never intended to be more than a mode of protecting an inventor until the time for filing the complete specification; nor was it intended to contain a complete description of the discovery such as would enable a skilled person, and, therefore, much less a workman of mere ordinary skill, to carry it out. (*q*) It is quite sufficient if the provisional specification inform the Comptroller-General roughly what the invention is for which protection is sought; but it must do this fairly and honestly, and must indicate the whole invention of which the would-be patentee is in possession at the date of his application, and for which he desires to obtain protection. (*r*)

Object of provisional specification is to avoid disputes thereafter as to what the invention is for which the monopoly was granted.

The object of this is to show that the invention subsequently fully specified is the same as that which is presented to the Comptroller in the first instance. (*s*)

In cases of subsequent dispute the question is not whether the provisional specification is defective, but whether the complete specification is excessive. (*t*) The provisional may go

(*n*) *Re* Newall *v.* Elliott, (1858) 4 C. B. N. S. 269; 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 132; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Morgan *v.* Windover, (1887) 4 R. P. C. 422; 5 R. P. C. 295; Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1899) 16 R. P. C. 541.

(*o*) See United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 747; p. 239 *post*.

(*p*) p. 192 *post*; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 101, 573; Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1899) 16 R. P. C. 531; Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 19; Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 16 R. P. C. 16.

(*q*) Stoner *v.* Todd, (1874) L. R. 4 Ch. D. 58; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; Nuttall *v.* Hargreaves, (1892) 8 R. P. C. 450; L. R. 1 Ch. 94; 61 L. J. Ch. 94.

(*r*) Stoner *v.* Todd, (1874) L. R. 4 Ch. D. 58; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 743, 747; Woodward *v.* Sansum, (1887) 4 R. P. C. 166, 174; Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92.

(*s*) Newall *v.* Elliott, (1863) 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; 4 C. B. N. S. 269.

(*t*) Siddell *v.* Vickers, (1888) L. R.

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beyond the complete, and anything contained in the provisional may be dropped in the complete, provided the omission does not alter the nature of the invention. (*u*)

There is the authority of Lord *Chelmsford*, L.C., (*x*) for the statement that "it is clear that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officers" (now the Comptroller-General) "what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes carried out. That is left to the complete specification."

Further, as pointed out by *Lopes*, L.J., (*y*) 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 till the time for filing the final or complete specification, but permitting him in the mean time to perfect any details, to modify, supplement, and develop his invention, always keeping within what may be called the ambit of his invention as disclosed in his provisional specification.

And as observed by *Smith*, L.J., (*z*) "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 the 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."

Thus, one of the objects of the provisional specification is to determine that the invention described and claimed by the final is really one and the same as that described by the provisional specification. The patent is altogether void if the final comprise an invention which is not comprehended by the provisional specification. (*a*)

Details stated in the com-

It is not, however, necessary that all the details of the

39 Ch. D. 92, 97; Curtis *v.* Platt, (1888) Griff. L. O. C. 53; 5 R. P. C. 87 *n.*

(*u*) Penn *v.* Bibby, (1866) L. R. 2 Ch. 127; 36 L. J. Ch. 455; Ward *v.* Hill, (1903) 20 R. P. C. 198, 200, 203; p. 188 *post.*

(*x*) Penn *v.* Bibby, (1875) L. R. 2 Ch. 127.

(*y*) Woodward *v.* Sansum, (1887) 4 R. P. C. 166.

(*z*) The Cassel Gold Extracting Co. *v.* The Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 257.

(*a*) Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055; Crossley *v.* Potter, (1853) Macr. P. C. 240.

invention described in the final should be identical with those indicated in the provisional specification, provided that the invention remain substantially the same. The complete specification is, in a sense, supplemental to the provisional, not going beyond, nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the period of provisional protection, as to the manner in which the invention is to be performed. (*b*)

**Provisional Specification.**

**plete may differ from those stated in the provisional,**

It is not legitimate to draw the inference that, because a detailed way of performing the invention which is referred to in the provisional is not mentioned in the complete, therefore the detailed method referred to in the provisional is not within the claim of the complete. (*c*)

Any subordinate matter, or point, or detail, may be abandoned in the final specification without affecting the validity of the patent, provided always that such abandonment does not change the nature of the invention, and make it really a different one to that described in the provisional; and such an abandonment may be a notification to the public that the inventor could not work it, or thought it useless, and consequently omitted it altogether. (*d*)

**or subordinate matters may be abandoned;**

In *Thomas* v. *Welch* (*e*) the defendant contested the validity of the plaintiff's patent for a sewing machine on the ground that the complete specification omitted some of the inventions put forward in the provisional specification. It appeared that the provisional specification described a certain instrument, and then went on to say that "this, *or another acting therewith*, acts to hold the work during the insertion of the needle." It was contended that the complete specification contained nothing corresponding to this second alternative. The Court of Common Pleas overruled this objection, and *Erle*, C.J., in his judgment said :—

> "Assuming that this is so, I do not think the objection ought to prevail. The difference is a slight one, and injured nobody; and it may be that the patentee had something in his mind

(*b*) Per Chelmsford, L.C., Penn *v.* Bibby, (1875) L. R. 2 Ch. 127.

(*c*) Sandow *v.* Szalay, (1905) 22 R. P. C. 15; 23 R. P. C. 6.

(*d*) Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58; 46 L. J. Ch. 32; Hutchison *v.* Pattullo, (1888) 5 R. P. C. 351; Thomas *v.* Welch, (1866) L. R. 1 C. P. 192; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 134; Everitt's Patent, (1888) Griff. L. O. C. 27; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 573; but see Sandow, Ld. *v.* Szalay, (1905) 23 R. P. C. 6.

(*e*) (1866) L. R. 1. C. P. 192; 35 L. J. C. P. 200.

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when he filed his provisional specification, which he found afterwards would be useless. As he could not disclaim, formally, part of the provisional specification, he might, I think, in such a case as the present, have omitted it from his complete specification. It may be, however, that one form, if mentioned in the complete specification, which is in two parts, is what was referred to in the expression, '*and another acting therewith.*'"

but the provisional cannot be read to supply an omission in the complete specification.

If, however, the patentee omits in the complete specification anything which is described in the provisional specification, he cannot afterwards read the provisional to supply a defect in the final specification.

Thus, in *Mackelcan* v. *Rennie*, (*f*) the patent related to "improvements in floating docks;" and the provisional specification stated: "I construct a pontoon or vessel of iron-framing, sheeted over entirely with *plate-iron*, so as to form an air-tight chamber subdivided into compartments." And the complete specification stated: "Having in a provisional specification described the nature of my invention, I will now proceed particularly to describe the same," and went on to explain the arrangement of parts, and the method of employing the dock, but said nothing about its being constructed of iron. The claim was "the arrangement and combination of all the parts of any floating dock as represented and described." It appeared at the trial that floating docks, constructed of timber, were well known before the patent, and that the plaintiff's invention consisted in constructing such docks of iron. There being, however, no mention of iron in the complete specification, *Erle*, C.J., held that the provisional specification could not be produced in aid for the purpose of supplying a defect in the complete specification, and the plaintiff was nonsuited. The Court of Common Pleas refused a motion for a new trial, and approved the course the learned Chief Justice had taken in the Court below; and indicated an opinion that, even if the defect had been supplied, the alleged invention could not properly be the subject of a patent.

Drawings may be necessary.

It must not be forgotten that a provisional, like a complete, specification, must be accompanied by drawings, if required; (*g*) and from a consideration of the foregoing pages it will be apparent that great skill and care must be expended in the preparation of the instrument, so as to make it comprehensive enough to cover all that the patentee, after developing the

(*f*) (1862) 13 C. B. N. S. 52.

(*g*) 46 & 47 Vict. c. 57, s. 5, sub-s. 3.

discovery, may possibly wish to include and claim in the final and complete specification.

**Provisional Protection.**

**Provisional Protection.**—The Act of 1888 especially provides that where an application for a patent in respect of an invention has been accepted the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in the Act referred to as provisional protection. (*h*)

Provisional protection is limited to consequences of publication.

This provisional protection only protects the patentee against the consequences of his own publication of the invention, and thus enables him to employ workmen and assistants in helping him to perform experiments and exercise the invention with a view to bringing it to a state of perfection before filing the complete specification. (*i*) It does not confer on the patentee any rights against the public, and it is expressly provided that he shall not institute any legal proceedings for infringements committed before the acceptance of the complete specification. (*k*)

The effect of filing the provisional specification is therefore to secure six months provisional protection, (*l*) and the object of this protection evidently is to enable the patentee to perfect his invention by experiments which, although open and known, will not be a use and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in the complete specification, as the result of experience, the best manner of performing the invention. It clearly appears, therefore, that the complete is in a sense supplemental to the provisional specification, not going beyond nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional protection, as to the manner in which the invention is to be performed. (*m*)

The letters patent when granted bear date as of the day of application—*i.e.*, the date of the provisional specification in cases where the applicant avails himself of the advantages of filing a provisional specification. (*n*)

(*h*) 46 & 47 Vict. c. 57, s. 14.
(*i*) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577.
(*k*) 46 & 47 Vict. c. 57, s. 13.
(*l*) *Ibid.* s. 8; 2 Edw. VII. c. 34, s. 1 (8).
(*m*) 46 & 47 Vict. c. 57, s. 8; p. 173 *ante*.
(*n*) Vol. II. p. 53.

Variations between the Specifications.

What are legitimate developments.

## Variations between the Specifications.

**Legitimate Developments of the Invention.**—If the complete specification, filed as it must be after the provisional, describe and claim any invention different from that described in the provisional specification, it is evident that the patentee has never applied for a patent or received provisional protection in respect of that different invention, and the whole grant is void, because the specification claims that which has never been granted, and consequently that to which the patentee has no right—viz., the monopoly of the invention which differs from that described in the provisional specification. (*o*)

Lord *Blackburn*, (*p*) commenting on the effect of experiments and developments made during the period of provisional protection, pointed out that the proper process is to say: "Look at the nature of the invention described in the provisional specification, and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described, in that case you are protected; but if it is a new and separate invention and a different one, then you are not protected." The learned Lord also pointed out that "it becomes pretty clear, when the nature of an invention has been described in the provisional specification, if something were found out during the period of provisional protection to make the invention work better, or with respect to the mode in which the operation may be performed —a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular will not work as smoothly as he expected, and it is necessary to supplement it—still the nature of his invention remaining the same, and it is no objection that in the complete specification, which comes afterwards, the invention or application is described more particularly and in more detail, or 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. If nothing more is done than that, I think it is good; but as soon as it comes to be more than that, and the patentee says in the provisional specification 'I describe my invention as A.,' and in the complete specification he says 'I hereby describe A. and also

(*o*) Watling *v.* Stevens, (1886) 3 R. P. C. 151; Newall *v.* Elliott, (1863) 10 Jur. N. S. 955; 4 C. B. N. S. 269; Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298; Siddell *r.* Vickers, (1888) L. R. 39 Ch. D. 92; 5 P. O. R. 81, 416.

(*p*) Bailey *r.* Roberton, (1878) L. R. 3 App. Cas. 1074.

B.,' then as far as regards B. it is void, because the patent was granted for the invention that was described in the provisional specification and does not cover the [*sic*, further] invention that is described in the other." (*q*)

Variations between the Specifications.

*It will be seen hereafter* (*r*) that, in such a case, so long as B. remains in the complete specification it renders the whole grant bad, but the defect is one which may be amended by excision, so as to secure to the patentee protection in respect of A.

Improvements in details.

Improvements in the arrangement of the machinery, of 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 on the ground of disconformity. (*s*)

Better and different methods.

If the provisional specification describe a method of carrying the invention into effect, and a totally different method is described in the complete specification, the latter document will not be void for disconformity, if the two methods are within the invention described in the two specifications. (*t*) The reason of this is that the patentee is bound to describe the best and latest method known to him of carrying out the invention. (*u*) It is not only his privilege, but his duty to do this, for the object of the complete specification, whether filed with the application or subsequently, is to tell the public how the invention is to be best carried out. "That is the price which the man who wants to be a patentee has to pay to the public for it." (*v*)

Legitimate development always a pure question of fact.

It is always a question of fact, to be determined with reference to the peculiar circumstances of each case, whether, when the complete specification differs from the provisional, the difference is merely a legitimate development and improvement made during the period of provisional protection, upon

(*q*) See also Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 382, 397; Siddell *v.* Vickers, (1888) 5 R. P. C. 81, 426; Woodward *v.* Sansum, (1887) 4 R. P. C. 178.

(*r*) Vol. II. chap. ii.

(*s*) Per Lopes, L.J., Woodward *v.* Sansum, (1877) 4 R. P. C. 178; Geipels' Patent, (1904) 21 R. P. C. 379.

(*t*) Woodward *v.* Sansum, (1887) 4 R. P. C. 175; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Morgan *v.* Windover, (1887) 4 R. P. C. 422; 5 R. P. C. 295; Ward *v.* Hill, (1903) 20 R. P. C. 189; Geipels' Patent, (1904) 21 R. P. C. 379.

(*u*) p. 235 *post*.

(*v*) Per Lord Field, then Field, J., Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 382; see 6 R. P. C. 287.

Variations between the Specifications.

the invention foreshadowed by the provisional. (*x*) Therefore, one case, though it may be a guide, is no authority for the decision of another case. In the note (*y*) at the foot of the page reference will be found to some important cases in which variations between the complete and provisional specifications have been held, upon the facts, to be merely legitimate developments and improvements.

Disconformity is a fatal objection to validity.

**Disconformity.**—The provisional specification, as appears from the foregoing pages, must contain a description of the invention for which the patentee desires protection, and though his description may be a mere rough outline, it is absolutely essential that it shall be honest, fair, explicit, and wide enough to comprise all that is described and claimed in the final specification when that instrument is filed, and, speaking generally, the two specifications ought not so to differ that the nature of the invention described in the one is materially different from that described in the other. (*z*)

This is expressed in the phraseology of modern practitioners by saying that there must not be a disconformity between the specifications.

Ever since the Patent Act of 1852, which first introduced provisional specifications, disconformity has been held to be a fatal objection to the validity of a patent. It was at one time urged by some that the operation of sec. 9 of the Act of 1883, (*a*) which casts upon the Comptroller-General the duty of ascertaining whether the invention particularly described in the complete specification is substantially the same as that described in the provisional, was to render disconformity no longer an objection to the validity of the patent. This, however, is not so, for sec. 26 of the Act of 1883, which abolishes

(*x*) See Geipels' Patent, (1904) 21 R. P. C. 389.

(*y*) Newall *v.* Elliott, (1858) 4 C. B. N. S. 269; 27 L. J. Ch. 337; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Penn *v.* Bibby, (1866) L. R. 2 Ch. 127, 135; 36 L. J. Ch. 455; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 533; Crampton *v.* The Patent Investments Co., (1889) 6 R. P. C. 294; King, Brown & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; 9 R. P. C. 313; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 516; Miller *v.* Searle, (1893) 10 R. P. C. 106; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 257; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77; Automatic Coal Gas Retort Co. *v.* The Mayor, &c., of Salford, (1897) 14 R. P. C. 450; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 853; Ward *v.* Hill, (1903) 20 R. P. C. 189; Geipels' Patent, (1904) 21 R. P. C. 379.

(*z*) Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298.

(*a*) 46 & 47 Vict. c. 57, s. 9.

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the proceeding by *scire facias* to repeal a patent, provides that "every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias*, shall be available by way of defence to an action of infringement, and shall also be a ground of revocation." Disconformity was one of the grounds on which a patent could be repealed by *scire facias* before the Act of 1883, (*b*) and therefore it is still fatal to the validity of a patent, and, as such, a defence to an action for infringement, and a ground on which a patent may be revoked on petition for revocation. (*c*)

The point has been decided substantially as above stated by the Court of Appeal, but it has not yet been directly decided by the House of Lords, though a dictum of Lord *Halsbury*, L.C., supports the conclusion of the Court of Appeal, (*d*) and the House of Lords has adjudicated upon the fact of disconformity since the Act of 1883 came into force, without, however, discussing the effect of sec. 9. (*e*)

Disconformity between an amended complete and a provisional specification.

If a specification is amended (*f*) and there is a disconformity between the complete and provisional specifications as they stand after amendment, the objection is still fatal. (*g*) An amended claim, however, when once allowed, even if it is for an invention substantially larger than or different to the invention originally claimed by the complete specification, will not vitiate the patent, provided that the invention comprised by the amended claim is to be found fairly foreshadowed and described within the provisional specification. (*h*)

Method of deciding questions of fact as to disconformity.

In arriving at a conclusion as to the question of fact, whether in any particular instance there is a disconformity between two specifications, or the alleged excess in the complete is merely a legitimate development of the invention described in the provisional, it is well to consider separately the two questions: (1) What is the nature of the invention for which the patentee has obtained provisional protection —*i.e.*, what is the nature of the invention described in the provisional specification? (2) Is what is described in the

(*b*) Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055.

(*c*) See Nuttall *v.* Hargreaves, (1891) 8 R. P. C. 450; Vickers *v.* Siddell, (1890) 7 R. P. C. 292.

(*d*) See Vickers *v.* Siddell, (1890) 7 R. P. C. 292.

(*e*) Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1899) 16 R. P. C. 531; Castner-Kellner Alkali Co. *v.* Commercial Development Corporation, (1900) 17 R. P. C. 593.

(*f*) See Vol. II. chap. ii.

(*g*) Gaulard and Gibbs' Patent, (1890) 7 R. P. C. 367; Lane Fox *v.* Kensington and Knightsbridge Electric Lighting Co. (1892) 9 R. P. C. 221, 413.

(*h*) See Moser *v.* Marsden, (1895) 13 R. P. C. 24; Vol. II. p. 66.

**Variations between the Specifications.**

complete specification an invention of a different nature from that described in the provisional? (*i*)

Thus, in a case where the proportions of the ingredients used in a process were not of the essence of the invention, and the complete specification stated and made a separate claim to definite suitable proportions, but the provisional did not refer to any specific proportions of the ingredients, the Court of Appeal held that there was no disconformity, since the proportions used in the process were not of the essence of the invention, and the real invention described in each specification was the same. (*k*)

The Acts of 1883 and 1888 (*l*) provide for the comparison of the complete specification with the provisional by an examiner at the Patent Office, and having regard to this fact the Courts do not decide against the validity of a patent on the ground of disconformity, unless the invention claimed by the complete specification is unmistakably different from that described in the provisional specification. "If a case is on the border line, the patent ought to be held good rather than bad." (*m*)

**Effect of detailing advantages of the invention in the provisional specification.**

The patentee is not bound in the provisional specification to detail the advantages of his invention. If he does detail advantages, all of which are present when the invention is used for one purpose which is principally referred to in the provisional specification, the fact that only some of those advantages are present when the invention is applied to another purpose mentioned in the complete specification, is not a sound argument to support the proposition that the second purpose is an illegitimate extension, and so renders the patent bad on the ground of disconformity. (*n*) In the words of *Romer*, J., "A patented invention may, owing to subsequent discoveries of others, prove more valuable and have a wider field of usefulness than what was contemplated by the patentee at the time of his invention; and yet the patentee is entitled to the full benefit of the use of his

(*i*) See Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 526, 529; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 257; Castner-Kellner Alkali Co. *v.* Commercial Development Corporation, (1900), 17 R. P. C. 603-4.

(*k*) Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 257.

(*l*) 46 & 47 Vict. c. 57, s. 9; and 51 & 52 Vict. c. 50, s. 4.

(*m*) Per Lindley, L.J., Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 527; in Chadburn *v.* Mechan, (1895) 12 R. P. C. 121. Romer, J., applied this principle to the facts of that case.

(*n*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 99.

invention if taken and applied for the purpose of those subsequent discoveries, and if the subsequent discoveries have taken place after the provisional and before the final specification, there would be nothing improper in the patentee referring to them in the final, and there showing the manner in which his invention could be best applied to them." (*o*)

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To put it in another way, when the invention described in the provisional specification is, during the period of provisional protection, found by the patentee or some one else to be applicable to a purpose not thought of at the date of the provisional and there are special advantages in that application the patentee may claim those advantages legitimately in the complete specification. (*p*) Further, the use of the invention for such additional purpose, even though there is no distinct claim to such use, would be an infringement, provided it is not disclaimed. (*q*).

And as pointed out by *Wills*, J., it is settled law that "so far as the objection of want of conformity is concerned, the patentee, merely by condescending to particulars in respect of the things which he has thought out, never loses the benefit of general expressions in the provisional specification as to matters which he has not thought out. Of course he may use words which may tie his hands afterwards to detail. But that is merely saying that his language may be such as to exclude an area which might otherwise be within more general phraseology." (*r*)

Illustrative cases.

There are many instances in which patents have been rendered void because the patentee has in his final specification described and claimed inventions which the Courts have held were not included in the description given in the provisional specification. (*s*) The following may be taken as illustrative cases :—

(*o*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 101; Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 19; Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 16 R. P. C. 16; Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre and Automatic Valve Co. (1899) 16 R. P. C. 541.

(*p*) See Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 100, 101, 573; with special reference to claim 18 of Welch's specification.

(*q*) *Ibid.*; Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 19; *p.* 379 *post.*

(*r*) Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 869.

(*s*) See Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 743; Horrocks *v.* Stubbs, (1885) 3 R. P. C. 233, 226; Hutchison *v.* Patullo, (1888) 5 R. P. C. 351; King, Brown & Co *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; Nuttall *v.* Hargreaves, (1891) 8 R. P. C. 450; Lane Fox *v.* Kensington

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Bailey v. Roberton.

In *Bailey* v. *Roberton*, (1878) L. R. 3 App. Cas. 1055, the patent related to a method of preserving meat. The patentees in the provisional specification stated: "We dissolve the ordinary commercial gelatine in boiling water, using about 2 lbs. of gelatine to 10 lbs. of water. We then add, while hot, a volume equal to the volume of solution of gelatine of a solution of bisulphite of lime ($CaO_2SO_2$) in water of about the specific gravity 1070. While the solution of gelatine and bisulphite of lime is still warm and liquid, we coat the substance to be preserved with it, either by dipping the substance in it, or by brushing it over with two or three coats of the solution." The complete specification described a solution consisting of bisulphite of lime alone, and it was contended that it laid claim to the use of this solution by itself for preserving animal substances. The House of Lords held that a claim to the use of bisulphite of lime alone, which was not foreshadowed by the provisional specification, would invalidate the patent, but that the claim did not, in fact, include the use of bisulphite of lime alone. Lord *Cairns*, L.C., pointed out that it could not be doubted that the invention, which those who wrote out the provisional specification conceived, was not an invention merely of the chemical application of bisulphite of lime to animal substances, such as meat and fish, but was a mode of applying a coating or film to the outside of animal substances, which coating or film was to consist of gelatine, or some substance of the same kind mixed with a solution of bisulphite of lime. The patentees could only claim the use of the solution of bisulphite of lime separately by claiming an invention through the medium of the complete specification which was not mentioned in the provisional specification, and as to the mode of exercising or applying which they could not, in that specification, point out any claim, or any information given to the public.

Castner-Kellner Alkali Co. v. Commercial Development Corporation.

In *Castner-Kellner Alkali Co.* v. *Commercial Development Corporation*, (1900) 17 R. P. C. 593, the action was founded upon *Kellner's* patent for an invention relating to a machine intended to carry out an old and well-known process of producing caustic soda by electrolysis. Other machines differing in mechanical arrangement but carrying out the same process were well known at the date of *Kellner's* patent. The essential feature of the patented invention was the use of a stationary mercury cathode. In the complete specification the patentee claimed the use of a

Electric Lighting Co., (1892) 9 R. P. C. 221, 413; Cem Light Co. v. Dobbie, (1892) 11 R. P. C. 10; Magee v. Tangyes, (1897) 14 R. P. C. 255; Brooks v. Lamplugh, (1897) 15 R. P. C. 33; Osmond's, Ld. v. Balmoral Cycle Co., (1898) 15 R. P. C. 505; Tubeless Pneumatic Tyre and Capon Heaton, Ld. v. Trench Tubeless Tyre Co., Ld., (1899) 16 R. P. C. 291; Savage Brothers, Ld. v. Brindle, (1900) 17 R. P. C. 228; Castner-Kellner Alkali Co. v. Commercial Development Corporation, (1900) 17 R. P. C. 593.

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rotating vessel containing the mercury cathode. The dispute arose as to the proper construction of the word "stationary" as used in the provisional specification. It was contended for the patentee that "stationary" was to be construed as meaning "stationary in relation to the vessel containing the mercury," and not as "stationary in relation to space generally." The House of Lords held that upon the true construction of the provisional specification the patentee, when he filed that document, never contemplated the movement in any sense of the mercurial cathode, and that "stationary" was to be read in its primary meaning, which implies the absence of movement of any kind. Consequently, the House further held that the claim in the complete specification to a machine which comprised a rotating vessel containing the mercury cathode was a claim to an invention different from that described in the provisional specification, and that the patent was, therefore, void on the ground of disconformity.

United Telephone Co. v. Harrison.

In *United Telephone Co.* v. *Harrison*, (1882) L. R. 21 Ch. D. 743, *Edison's* patent for the telephone under the title "improvements in instruments for controlling by sound the transmission of electric currents, and the reproduction of corresponding sounds at a distance," was held invalid by *Fry*, J., and afterwards by the Court of Appeal. One of the grounds for so holding was the fact that the final specification described and claimed the phonograph whilst it was not disclosed in the provisional specification, although it was admitted that portions of the provisional specification explained, or might be held to refer to, an instrument like the phonograph. *Fry*, J., after stating the fact that *Edison* had discovered an instrument of the highest ingenuity, the phonograph, which is purely mechanical, and has nothing to do with electric or magnetic science, and nothing necessarily to do with the transmission of sound to a distance, observed: "Has that remarkable invention so made by *Edison* been in any manner described in the provisional specification? . . . Now, no doubt some of these words do explain or might be held to refer to an instrument like the phonograph, but when I ask myself whether they in any manner describe the nature of the invention, I am bound to say that they do not. . . . I agree that the provisional specification need not describe the manner in which an invention is to be carried into effect—I agree that it need not describe the nature of the invention otherwise than roughly; but it ought to do so fairly and honestly; and if Mr. *Edison* was at the time at which these letters patent were granted in possession of that very remarkable mechanical invention by which speech could be reproduced, not necessarily at a distance, but in the same room as that in which it was uttered, I do not

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think the provisional specification was an honest statement of the nature of the discovery. On that ground I come to the conclusion that Mr. *Edison's* patent cannot be upheld."

Illustrative cases in which the objection of disconformity failed.

The following cases may be taken as instances among many reported cases (*t*) in which the objection of disconformity was not sustained.

Newall v. Elliott.

*Newall* v. *Elliott*, (1858) 4 C. B. N. S. 269; 27 L. J. C. P. 337, was a case in which the validity of *Newall's* patent for "improvements in apparatus for laying down submarine telegraph wires" was questioned on the ground of disconformity. The provisional specification described the nature of the invention in the following words: "The cable or rope containing this insulated wire or wires is passed round a cone, so that the cable, in being drawn off the coil, is prevented from kinking by means of the cone, and there is a cylinder on the outside which prevents the coil from shifting in its place." The complete specification, besides containing words to the above effect, continued the description in the following terms: "When the cable is to be laid down I place over the cone an *apex* or top which is conoidal, as shown (the drawing showed a short conoidal head placed on the flat top of the truncated cone) and around this I suspend *several rings* of iron by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed. The two rings nearest the coil are lowered to about six and twelve inches respectively from the coil (the drawing showed four rings arranged in gradations of size, the smallest being at the top, and acting as a mouthpiece, for the exit of the cable which was thus carried close over the conoidal top of the cone)." The claims included one for the use of rings in combination with a cone as described. The matters in dispute were referred to an arbitrator, who made an award, and stated a special case for the opinion of the Court, in which one of the questions for decision was: "Whether there

(*t*) See Newall *v.* Elliott, (1858) 4 C. B. N. S. 269: 27 L. J. C. 337; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 135; Lucas *v.* Millar, (1885) 2 R. P. C. 155; Watling *v.* Stevens, (1886) 3 R. P. C. 42; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 533; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221; King, Brown & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; Crampton *v.* The Patent Investment Co., (1889) 6 R. P. C. 294; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 249, 516; Miller *v.* Searle, (1893) 10 R. P. C. 106; Cassel Gold Extracting Recovery Co., (1895) 12 R. P. C. 232, 257; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 853; Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1899) 16 R. P. C. 531.

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

In *Wright* v. *Hitchcock*, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97, the patent was for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification stated: "The invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism," &c., whilst the complete specification stated: "The invention relates to a peculiar manufacture of frills, ruffles, or *trimmings*, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same." It was objected on behalf of the defendants that there was an inconsistency between the provisional and final specification, the word *trimmings* being added in the latter. *Kelly*, C.B., overruled this objection, and held that by whatever name it was described the thing was in substance identical. Wright v. Hitchcock.

In *Pneumatic Tyre Co.* v. *East London Rubber Co.*, (1896) 14 R. P. C. 77, 573, and also in *Pneumatic Tyre Co.* v. *Leicester Pneumatic Tyre and Automatic Valve Co.*, (1898) 15 R. P. C. 159; 16 R. P. C. 50, 531, which related to an infringement Pneumatic Tyre Co. v. East London Rubber Co.

(*u*) 15 & 16 Vict. c. 83; cf. 46 & 47 Vict. c. 57, s. 5.

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of *Welch's* invention of the method of securing a tyre to a bicycle rim by means of inextensible rings or rims, it was objected that the provisional specification did not describe that the invention was intended to relate to a pneumatic tyre, or a cover for a pneumatic tube or tyre, or for affixing a pneumatic tube or its cover to a wheel rim. It was also alleged that the inventions set out and claimed in certain claiming clauses, which related to pneumatic tyres, were inventions none of which were disclosed or hinted at in the provisional and were not legitimate developments of anything disclosed in the provisional.

These objections were overruled by the Court of first instance, the Court of Appeal, and the House of Lords, on the ground that the real nature of the invention was sufficiently described in the provisional, and the use of it with pneumatic tyres as claimed in the complete specification was a legitimate development sufficiently hinted at in the provisional. As was pointed out by Lord *Lindley*, then *Lindley*, L.J., (14 R. P. C. 581) it is easier to ascertain the nature of an invention from a complete specification, which shows how it is to be applied, than from a provisional specification which describes the nature of an invention in general language, but which seldom shows how it is to be performed.

Applicant's course in case of doubt as to disconformity.

There may be a real doubt as to whether a specific thing is a legitimate development, or is of such a nature that a claim embracing it would make the patent bad on the ground of disconformity, and the applicant may feel that his conduct, during the period of provisional protection, might amount to such a publication of the specific thing as would invalidate a later patent for it. In such circumstances his best course is to include it in the complete specification, and, before such specification is open to public inspection, to apply for the grant of a second patent limited to the specific thing in question. The second patent will be of the nature of a confirmatory deed of conveyance. Assuming no publication is proved against the patentee, the monopoly of the specific thing is secured to him under either the first or the second patent, but, of course, not under both. It cannot be said that there is any monopoly created for a period greater than fourteen years; because the monopoly in the specific thing originates at the date of either the first or the second patent, but it is not created by both patents. If, in fact, it is created by the first, then, true, the second patent is invalid, and its effect is to enable the grantee

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to *assert* a monopoly after the expiration of fourteen years from the date on which it was created. The *assertion* of an invalid patent right, even if it be known to be invalid, is not *per se* a ground for revocation, but it does give rise to the statutory right of action created by sec. 32 of the Patents Act, 1883. Before the Act of 1883 the only remedy for a threat of proceedings on an invalid patent was an action for damages, which, moreover, only lay when the threat was made *malâ fide*. (*x*) A petition for the revocation of the second patent, on the ground of prior grant by the first, would fail, because the grant of a monopoly of the specific thing to the grantee, who *ex hypothesi* is the true and first inventor, is lawful, and it is immaterial to the public which patent was the effective document. Moreover, the presentation of a petition would be an abuse of the process of the Court, because it would be asking the Court to investigate the validity of the first patent at large, the question being, not, assuming validity, is the specific thing within the ambit of the claim of the first patent, but the very different question is the first a valid grant.

The above suggested plan will obviously not protect the applicant, if it turn out that the specific thing in question was not a legitimate development of what was described in the provisional specification of the first patent, and that, in fact, it was published before the date of the second patent.

## The Complete Specification.

Object of complete specifications.

The Patents, &c., Act, 1883, like the previous Act of 1852, enacts that the patentee shall in the complete specification *particularly* describe and ascertain the nature of the invention, and in what manner it is to be performed, and further requires that this instrument shall be accompanied by drawings if necessary. (*y*)

The patentee is required to *particularly* describe and ascertain the nature of his invention, so that the public may know what they are prohibited from doing without his leave or licence, during the continuance of the patent; and he is required to state in what manner the invention is to be performed, in order that the rest of the public may, when the patent expires,

(*x*) See p. 310 *post*.

(*y*) s. 5, sub-s. 41; see P. R. 1903.

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be able to put the invention into practice, and thus enjoy the benefit of the discovery. (*z*)

In fact, upon the view that letters patent are virtually a bargain between the Crown and the public, the price which the patentee pays for his monopoly is the fulfilment of the obligation he is under of lodging such an account of his discovery as will enable the public at the expiration of the time for which the grant is made to have as free and unreserved use of the invention as he himself. (*a*)

The title and provisional specification (*b*) are sufficient if they give a mere rough and incomplete description of the invention; from them the public, except in the case of very simple inventions, obtain but little information of the real nature of the manufacture they are prohibited from using, and unless some specific and detailed information were given respecting what they are commanded by the terms of the grant to refrain from doing, during the continuance of the monopoly, it would be unfair to punish them for any violation of the patent right committed without the means of ascertaining its nature and extent.

It is apparent that, in every case in which an action for infringement is brought against a member of the public in respect of a particular patent, it is necessary to ascertain whether the act complained of is described in the complete specification, and claimed by implication, or otherwise, and whether the exclusive privilege of carrying out that particular operation is conferred upon the patentee.

If the specification does not sufficiently describe some art of manufacture which is substantially the same as that used by the alleged infringer, no action lies against him.

Complete specification is generally a difficult document to draft.

The complete specification requires the exercise of the greatest skill and care in drafting it, and is by no means easy to draw. The reason of this is that the conditions and tests which the law requires the document to satisfy are very numerous, and a failure in any one of them will not only make the specification bad, but will render the whole grant void.

It must be borne in mind that the object for which the complete specification exists is to give sufficient and complete

(*z*) Young *v.* Rosenthal, (1884) 1 R. P. C. 31; Macfarlane *v.* Price, (1816) 1 Stark. N. P. 201; Allen *v.* Duckett, (1893) 10 R. P. C. 397.

(*a*) Gibson *v.* Brand, (1842) 1 W. P. C. 627; 4 M. & G. 179; 4 Scott, N. R. 844; 11 L. J. C. P. 177; Wood *v.* Zimmer, (1815) Holt, N. P. 58; 1 W. P. C. 82 *n.*

(*b*) p. 182 *ante*.

information to the public of what they are prohibited from doing, without the sanction of the patentee, during the continuance of the patent, and what they will be able to do after it has expired. Complete Specification.

The conditions which the law requires the complete specification to satisfy may be conveniently considered under the following heads :— Requisites of complete specification.

I. The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention or any material part of it, or otherwise mislead the public.

II. The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.

III. The complete specification must be intelligible to an ordinary workman, possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.

IV. The complete specification must particularly describe and ascertain the nature of the invention and how the same is to be performed.

V. The complete specification need not describe any step or process which is necessarily implied.

VI. The complete specification need not describe minutely any known thing to which it refers.

VII. The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.

VIII. The complete specification must describe the best method known to the patentee of performing the invention and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection prior to the date of filing the complete specification.

IX. The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.

X. If the complete specification describe anything which

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is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.

I. *The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention, or any material part of it, or otherwise mislead the public.*

Patent a bargain with the public.

A patent may be considered as a bargain with the public, and the specification ought to be construed on the same principle of good faith as that which regulates all other contracts. (*c*) If any statement in the specification turn out to be untrue, or of a nature calculated to mislead or puzzle the public, the grant of the letters patent will thereby be rendered void, either on the ground that the untruth is part of the representation on the strength of which the grant was made, or that the patentee has not properly described and ascertained the nature of the invention and in what manner the same is to be performed.

Must not mislead by commission,

As stated by *Buller*, J., in *R.* v. *Arkwright*, (*d*) and acted upon by many Judges since, if the specification, in any part of it, be materially false and defective, the patent is against law and cannot be supported. Further, if certain things mentioned in the specification are of no use, and merely thrown in *malâ fide* to puzzle, the patent is equally void; though invalidity is not the necessary result of a misleading statement which does not, in fact, lead to absolute failure, and which the patentee *bonâ fide* believed to be true when the specification was filed. (*e*) Thus a patentee is under no obligation to explain any theory of action of a combination or process which he directs to be constructed or carried out, (*f*) and, if he do give a theory, he is not to be injuriously affected by the fact that it turns out to be a wrong theory, (*g*) for the theory of action

(*c*) Per Lord Eldon, Cartwright *v.* Eamer, (1890) 14 Ves. 131, 136; Sturz *v.* De la Rue, (1828) 5 Russ. 322; 7 L. J. (O. S.) Ch. 47.

(*d*) (1785) Dav. P. C. 61; 1 W. P. C. 64.

(*e*) See Lewis *v.* Marling, 1 W. P. C. 496; Monnet *v.* Beck, (1897) 14 R. P. C. 847; pp. 207, 215, 233, cf. Owen's Patent, (1899) 17 R. P. C. 68, 78, in which the decision appears to ignore this principle.

(*f*) Atkins and Applegarth *v.* Castner-Kellner Alkali Co., (1900) 18 R. P. C. 294; Delwick's Patent, (1898) 15 R. P. C. 687; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 449; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1898) 15 R. P. C. 368.

(*g*) See per Finlay, S.-G., Delwik's Patent, (1898) 15 R. P. C. 687; *ibid.*

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is no part of the consideration for the grant. Neither is a patent to be held bad merely because the patentee is too sanguine in his statement as to the quantity of a useful result which will be obtained by the use of his invention. (*h*)

If there is anything introduced into the specification which tends to mislead the public into failure, or if the process as directed by the specification does not produce that which the patent professes to do, the patent itself is void. (*i*) Also if the patentee can make the article, which is the subject of the patent, with two or three of the ingredients specified, and he insert others which will not produce the effects stated, the patent will be void. (*k*)

or omission.

Further, if the patentee suppress anything, or mislead, his specification is bad—*e.g.*, if he say there are many modes of doing a thing, when in fact there is only one, this will avoid the patent. If he maintain, as an essential ingredient in the patented article, that which is not so, or even useful, and thereby misleads the public, his patent may be void. (*l*)

Must not describe methods which will not answer.

Again, if the specification describes and claims two ways of doing a thing, and it turns out that by one of the ways specified it cannot be done, (*m*) or that one of the alternatives is not new, (*n*) the specification is bad and the patent void. So also if the patentee, misled by theory, describes and claims as an essential step in a process—*e.g.*, a chemical process—the production of something which is in fact an impossibility, the patent is void. (*o*)

Distinction between a false description and a claim to something useless.

A false description of a method of performing the invention, or a part of it, must not be confused with a claim to something which turns out to be useless. In the latter case, if the useless part is a non-essential, the patent may be perfectly good, notwithstanding the claim; (*p*) but in the former case the patent cannot be sustained.

Thus in *Neilson* v. *Harford*, (*q*) *Parke*, B., at the trial, said that his strong opinion, as then advised, was that a certain

(*h*) Saccharin Corporation *v.* Chemical and Drugs Co., (1899) 17 R. P. C. 38.

(*i*) Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; Palmer *v.* Wagstaff, (1853) Newtons' L. J. vol. xliii. p. 131.

(*k*) *Ibid.*; see Bickford *v.* Skewes, (1838) 1 W. P. C. 211.

(*l*) Lewis *v.* Marling, (1829) 1 W. P. C. 453; see also p. 231 *post*.

(*m*) Beard *v.* Egerton, (1846) 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36; R. *v.* Cutler, Macr. P. C. 137; Savory *v.* Price, (1823) Ry. & M. 1; 1 W. P. C. 83; Kurtz *v.* Spence, (1888) 5 R. P. C. 161, 184.

(*n*) Pether *v.* Shaw, (1893) 10 R. P. C. 293; p. 112 *ante*.

(*o*) Monnet *v.* Beck, (1897) 14 R. P. C. 777.

(*p*) R. *v.* Cutler, (1816) Macr. P. C. 137; Lewis *v.* Marling, (1829) 10 B. & C. 22; 1 W. P. C. 493.

(*q*) (1841) 1 W. P. C. 313; 8 M. & W. 806.

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statement in the specification was incorrect and untrue, and that it being clearly untrue, it vitiated the specification, and prevented the patent from being a good patent. The jury, by their verdict, agreed with the view the learned Baron took of the statement in question; but the Court of Exchequer, of which he was also a member, construed it differently, and *Parke*, B., is reported to have said (*r*):—

> "At the trial, I construed this passage as meaning that the shape was immaterial to the degree of effect in making the blast; and, if this were so, the jury having by their finding negatived the truth and accuracy of this statement, the specification would be bad, as containing a false statement in a material circumstance of a nature that, if literally acted upon by a competent workman, would mislead him, and cause the experiment to fail. . . . But my Lords and my brothers, after considerable hesitation, are of opinion that a construction may be reasonably put upon this clause which will support the patent; and though I myself still entertain great doubt whether such is the true construction, I am not prepared to say that it is not."

Must not give problems.

As has been said by *Jessel*, M.R.: "You must not mislead people by telling them to do something wrong, and leaving them to find out the mistake. . . . You must not give people mechanical problems and call them specifications." (*s*)

The invention described must be useful for the object stated.

It is also a fatal defect if the invention is not useful for the purpose for which the patentee says it is useful. The question always is, Does the invention really do when put in practice by a competent man what the patentee states it will do? (*t*)

If the specification contain what amounts to a false suggestion on the part of the patentee—*e.g.*, the machine claimed is represented as capable of sharpening knives, scissors, and razors, whereas, in fact, it will only sharpen knives; (*u*) or if the specification give only an insufficient description of the invention and the manner of performing it, the patent will in each case be equally bad. In the former it

(*r*) (1841) 1 W. P. C. 371.

(*s*) Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 576; see also Lewis and Strickler's Patent, (1897) 14 R. P. C. 24, 36.

(*t*) Morgan *v.* Seaward, (1836) 1 W. P. C. 185; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 462; Easterbrook *v.* Great Western Railway Co., (1885) 2 R. P. C. 210; 3 R. P. C. 94; Fawcett *v.* Homan, (1896) 13 R. P. C. 268, and cases following in the text, pp. 205–206 *post*.

(*u*) See Felton *v.* Greaves, (1829) 3 C. & P. 611.

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will be void on the same principle that an ordinary grant of lands or tenements from the Crown is by a false suggestion of the grantee rendered inoperative, not merely against the Crown, but in a suit against a third person; (*x*) and in the latter it will be bad, because the statutory requirements have not been complied with. (*y*) But a statement in a specification to the effect that an invention is applicable to other purposes than that specified will not vitiate the patent, as there is no objection to a patentee stating that what he has invented with reference to one particular machine may be applicable to other machines. (*z*) A statement in a specification to the effect that a certain thing is important which is in fact not so, (*a*) or that something is immaterial which is in reality material, (*b*) will, it is submitted, amount to an attempt to deceive, and so render the patent void.

Illustrative cases.

The following cases illustrate the application of the principles stated in the last paragraph.

Bloxam v. Elsee.

*Bloxam* v. *Elsee*, (1825) B. & C. 169; 1 C. & P. 558, is an instance of a specification which was rendered void, because the patentee thereby represented that the machine described was capable of doing more than it really could do—viz., making paper of different widths, whereas it was in reality only suited to paper of one definite width. And in *Crossley* v. *Potter*, (1825) Macr. P. C. 240, a patent was declared bad on the ground that the specification represented that the machine as described was applicable to the weaving of carpets as well as of coach lace, whereas such was not in reality the case. The direction of *Pollock*, C.B., to the jury contained the following instructive passage: "In my mind, the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing; and a jury will always take care that, if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius."

Crossley v. Potter.

R. v. Metcalf.

In *R.* v. *Metcalf*, (1817) 3 Car. & P. 611, the patentee, both in the title and body of the specification, described the object for which the patent was obtained to be the manufacture of

(*x*) Travell *v.* Carteret, 3 Lev. 135; Alcock *v.* Cooke, 5 Bing. 340; Morgan *v.* Seaward, (1837) 2 M. & W. 544; Owen's Patent, (1899) 17 R. P. C. 78.

(*y*) See 1 W. P. C., and cases there referred to.

(*z*) Cole *v.* Saqui, (1888) 5 R. P. C. 494, cf. p. 264 *post*.

(*a*) Huddart *v.* Grimshaw, (1803) 1 W. P. C. 85.

(*b*) Neilson *v.* Harford, (1841) 1 W. P. C. 313.

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"a tapered hair or head brush," and the method of manufacture to consist in cutting hair in lengths of about one inch and a quarter, and then mixing it by hand and shaking it together as unevenly as possible, and finally attaching the hairs so cut and mixed to the stock by means of wires. At the trial it appeared that the patented brushes had bristles of unequal length mixed indiscriminately together. Lord *Ellenborough*, C.J., held that the invention was improperly described, and said: "Tapering means gradually converging to a point. According to the specification the bristles would be of an unequal length, but there would be no tapering to a point which the description assumes. If the word 'tapering' be used in its general sense, the description is defective—there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical consideration can be removed." After further evidence his Lordship advised the jury to find that it was not a *tapering*, but only an unequal brush, which they accordingly did. A rule for a new trial was refused.

Felton v. Greaves.

In *Felton* v. *Greaves*, (1829) 2 Stark. N. P. 249, the plaintiff had obtained his patent for "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments," and it appeared that the invention, which was stated in the specification to consist in a machine for sharpening various cutting instruments by passing their cutting edges backward and forward in the angle formed by the intersection of two or more circular files in the manner explained, was suitable for sharpening knives, but it would not do for sharpening scissors. The files were stated to be in the form of cylinders, and at the trial it appeared in evidence that in order to adapt the instrument to the sharpening of scissors it was necessary to have one of them smooth, which the specification did not describe, and Lord *Tenterden*, C.J., on this ground directed a nonsuit.

Bainbridge v. Wigley.

In *Bainbridge* v. *Wigley*, (1810) Parl. Rep. 192; 1 Carp. P. C. 270, the specification stated that the invention consisted in certain improvements in the English flute, whereby the fingering was rendered more easy and certain notes produced that were never before produced, whilst it appeared in evidence that, as a matter of fact, only one new note was produced. Lord *Ellenborough* held that this was fatal to the patent, the consideration on which it was granted not being truly set forth. The patentee had stated that, by his improvement, he gave new notes, when in fact he had given but one new note.

II. *The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.*

Complete Specification.

The principle about to be discussed is closely allied to that which has been considered in the preceding pages. It is now proposed to demonstrate that ambiguous or misleading statements in essential particulars as to the nature of the invention, or the manner of carrying it out, even though *bonâ fide* on the part of the patentee render the grant invalid.

Must be clear and unequivocal.

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 appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. . . . It is certainly of consequence that the terms of a specification should express the invention in the clearest and most specific manner; so that the persons to whom it is addressed may be able to produce the thing intended, without the necessity of trying experiments, (*c*) and, as was pointed out by *Dallas*, L.C.J., (*d*) if the instrument contains an ambiguity in a material point that is a ground on which it may be avoided altogether.

In the case of a written contract or similar document, the Court is bound to find a meaning, but in the case of a specification the Court has no such duty, and, if the fact is that it is not possible to say that the language of the specification is unambiguous, and the point is pressed, the Court ought to declare the patent void, on the ground that the patentee has not complied with the condition of the grant. (*e*) Thus it is fatal for the patentee to state so many alternatives in different parts of the processes he describes, and generally to so frame his specification that it cannot be properly gathered what are the essential parts of his invention or what is the extent of his claim. (*f*)

Perfect precision in language is not possible.

Absolute or perfect precision in the language of the specification is impossible, and cannot therefore be required. It will be quite sufficient if the document is comprehensible to

(*c*) Per Ashurst, J., Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; but see p. 189.

(*d*) Campion *v.* Benyon, (1827) 6 B. Mo. 71; 3 Brod. & B. 5.

(*e*) See Tubes, Ld. *v.* Perfecta Seamless Tube Co., Ld., (1902) 20 R. P. C. 101, judgment of Lord Davey; Ackroyd and Best, Ld. *v.* Thomas, (1904) 21 R. P. C. 737.

(*f*) Klaber's Patent, (1904) 22 R. P. C. 414.

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the ordinary workman in the trade to which the invention relates.

The following remarks of *Grove*, J., are instructive upon this point:—

> "Every word I give will be open to exception, and no human being probably could criticise my language more than I could myself, if I were to sit upon it, because I am one of those who believe that there is no form of words which can be used with such accuracy as to exclude every other conclusion but the one which the speaker or the writer intends to express. I have never yet seen any form of words, even of moderate length, upon which a person reading it in an adverse spirit might not put a different conclusion from that which the author intends, and those who have written books, or have had to deal with drawing legal documents, or other matters of that sort, know how impossible it is to give any definition, or use any form of words, which may not be excepted to." (*g*)

If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention, and if there is any studied ambiguity in it, so as to conceal from the public that of which the patentee is, for a term, enjoying the exclusive benefit, the patent itself will be completely void. (*h*)

Must not include what will not as well as what will answer.

A statement, or claiming clause, which is so indefinite as to include what will not answer the purpose in view as well as what will is, in accordance with the principles above stated, fatal to the validity of the grant. That is to say, if the specification, in describing any materials or ingredients which are necessary for the purpose of carrying out the invention, uses language wide enough to include what is unsuitable as well as what is suitable for the purpose, the ambiguity will be fatal. (*i*)

(*g*) Philpot *v.* Hanbury, (1885) 2 R. P. C. 38; see also Boulton *v.* Bull, (1795) Dav. P. C. 216; Arkwright *v.* Nightingale, (1785) Dav. P. C. 37; Tubes, Ld., *v.* Perfecta Seamless Tube Co., Ld., (1902) 20 R. P. C. 96.

(*h*) Per Tindal, C.J., Galloway *v.* Bleadon, (1839) 1 W. P. C. 521.

(*i*) Ralston *v.* Smith, (1865) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v.* Kennard, (1857) 2 H. & N. 84; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Saunders *v.* Aston, (1832) 3 B. & Ad. 881, 886; 1 W. P. C. 75 *n.*; Kurtz *v.* Spence, (1888) 5 R. P. C. 161; Stevens *v.* Keating, (1848) 2 W. P. C. 194; Muntz *v.* Foster, (1844) 2 W. P. C. 109; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409; Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1070; Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 875; 15 R. P. C. 359; Hattersley *v.* Hodgson, (1903) 20 R. P. C. 591; but see 21 R. P. C. 517.

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For example, in *Stevens* v. *Keating* (*k*) the Court of Exchequer upheld a verdict, given in the Court below for the defendant, on the question of the sufficiency of the plaintiff's specification. One of the patents in question in the action related to a method of making cement, by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated: "Other alkalis and acids, besides those hereinbefore mentioned, will answer the purpose of my invention, though none that I have tried answer as well as the alkali and acid hereinbefore set forth;" and concluded with a claim for the process of mixing the powdered materials, alkalis, and acids, as described, and subsequently burning, heating, or calcining the same, for the purposes set forth. *Pollock*, C.B., in the Court of Exchequer, upholding the verdict below, pointed out in his judgment that only one alkali (potash) and one acid (sulphuric) were mentioned in the specification, but manifestly the inventor did not confine himself to them; if he did, the defendant would be entitled to a verdict, on the plea of no infringement, for he used neither. The learned Chief Baron continued thus:—

> "To what extent, then, does the claim go beyond the alkali and acid named? If it be a claim of all acids and alkalis, it is clearly bad, as there are some that will not answer the purpose. If it be a claim of those only which will answer the purpose, it is clearly bad, in consequence of not stating those which will answer the purpose and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not; and this was expressly so determined by the Court of Queen's Bench in *R.* v. *Wheeler*, (1819) 2 B. & Ald. 345; where they say that a specification which casts on the public the expense and labour of experiment and trial is bad. In my view, therefore, this specification is defective."

In *Wegmann* v. *Corcoran* (*l*) the Court of Appeal upheld a decision of the Court below, which declared a patent for an improved machine or apparatus for treating or preparing

(*k*) 2 W. P. C. 175; 19 L. J. Ex. 57. (*l*) (1879) L. R. 13 Ch. D. 65.

Complete Specification.

meal void on the ground of the ambiguity of the language used by the specification. The patentee stated that the squeezing rollers of the improved machine were to have "a surface consisting of a material containing so much silica as not to colour the meal or flour," and went on to say that he preferred to make them of "iron coated with china, and finely turned with diamond tools." It was proved in evidence that there are two kinds of china—Oriental or Chinese china, containing 73 per cent. of silica, and very hard, and the china usually made in this country, containing only about 40 per cent. of silica, and much softer. The evidence also established that the first kind of china would answer the purpose, but the second would not, and that the invention was useful in milling operations. The Courts held that the specification was bad, as being ambiguous and inadequate, in so far as it did not state what kind of china was to be employed.

So also in *Badische Anilin und Soda Fabrik* v. *La Société Chimique des Usines du Rhône*, (*m*) where the patentee directed that a certain process was to be carried out in "an autoclave," and it appeared that it was essential that the vessel in question should be of iron unenamelled, and it also appeared that at the date of the specification both unenamelled and enamelled autoclaves were in general use, and that it was first discovered during the trial of the action that the process could only be effected in an unenamelled autoclave, the specification was held to be fatally insufficient on the ground that it did not point out that the use of an unenamelled iron autoclave was an essential element of success.

It must not, however, be forgotten that the meaning of words is liable to change with the progress of science and discovery, and a term which, for the purpose of the specification, is sufficiently accurate, may, in future years, include that which will not answer the purpose the patentee has in view. In such a case the specification will be read with reference to the state of knowledge at the time it was prepared, and if the term used include nothing *then* known that would not answer, it will not be held to be ambiguous, though the use of the same term subsequently might be. (*n*) This is only equitable, for a patentee is not entitled to a

(*m*) (1897) 14 R. P. C. 875.

(*n*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 410; 4 R. P. C. 449; Crossley *v.* Beverley, (1829) 3 Car. & P. 513; 1 W. P. C. 112.

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monopoly of ingredients and materials which were unknown at the date of the specification, and which, viewed in the light of the knowledge at the date of the specification, would not be perceived to be the equivalents of materials mentioned, even though the language used be sufficiently wide to include them. (*o*) It would be manifestly unfair to hold that language which, by the advance of knowledge, has come to include more than the patentee contemplated should vitiate the grant.

Thus, for instance, when the directions given in a specification for the preparation of the article, which is the subject-matter of the patent, necessitate the use of a practically chemically pure substance, and, at the date of the patent, the person to whom the specification is addressed would, by using the knowledge of the period, obtain the substance sufficiently pure and would succeed, it is no valid objection to the utility of the invention and the sufficiency of the specification that, at a subsequent date, the same person using the *then* commercial article (*which has only come into existence as a commercial product after the date of the patent*) would fail. (*p*)

It is always a question for the jury, or the Court acting as a jury, to say whether or not the specification describes with sufficient accuracy the ingredients or materials which the patentee directs to be used, (*q*) but a patentee is not obliged, in referring to materials and ingredients, to enter into minute details as to them if they are known in commerce and can be readily procured under the names which he gives them. (*r*) The names of articles mentioned must be taken to be used in their ordinary commercial sense. (*s*)

The specification of *Medlock's* patent for improvements in the preparation of red and purple dyes directed the use of *dry* arsenic acid in a part of the process, and this was held by Lord *Westbury*, L.C., to refer to the ordinary arsenic acid of

(*o*) Tetley *v.* Easton, (1852) Macr. P. C. 77; 18 C. B. 643; 25 L. J. C. & P. 293; p. 353 *post.*

(*p*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 324, 326.

(*q*) Bickford *v.* Skewes, (1837) 1 W. P. C. 214; Derosne *v.* Fairie, (1835) 1 W. P. C. 154; Elliott *v.* Turner, (1845) 2 C. B. 446; Wallington *v.* Dale, (1852) 7 Exch. 888.

(*r*) MacIntosh *v.* Everington, 2 Carp. R. 180, 191.

(*s*) Simpson *v.* Holliday, (1864) 2 Newton, L. J. 118; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; Stevens *v.* Keating, (1847) 2 W. P. C. 183, 187; 19 L. J. Ex. 57; Muntz *v.* Foster, (1844) 2 W. P. C. 104; Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327; Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 710; (1887), 4 R. P. C. 449.

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commerce (which is dry to the touch, although it contains water of hydration), which would answer, and not to the anhydrous form, which would not answer; (*t*) but in a case where the specification directed the use of "the finest and purest chemical white lead," and it appeared in evidence that there was no substance known in the trade by that name, but that white lead only was known, the specification was held to be defective on the ground of ambiguity. (*u*)

*E.g.*, proportions.

In the case of an invention of a new use of known substances in new proportions, (*x*) the patentee in his complete specification is bound to state the most suitable proportions within his knowledge, (*y*) but he is not obliged to limit his claim to the precise proportions mentioned. (*z*) Though proportions of substances used may be of importance, yet if the proportions specified as an instance yield good and satisfactory results, the fact that different proportions yield results differing in utility is not a fatal objection to the sufficiency of the specification. (*a*) If on the true construction proportions are claimed which will not yield without further experiment and discovery the result aimed at by the patentee, the patent is bad for insufficiency of the specification. (*b*) On the other hand, if the specification on its true construction is limited to certain definite proportions of the ingredients used, then, no doubt, it is no infringement to use proportions outside the limits stated. (*c*)

In *The Patent Type Founding Co.* v. *Richards* (*d*) the patent was for "improvements in the manufacture of type," and the specification stated "the object of the invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin and twenty-five of antimony, but this may be to some extent varied; and when lead is also used I find that it must not exceed fifty parts in one hundred of the combined metals employed."

(*t*) Simpson *v.* Holliday, (1866) 5 N. R. 340; L. R. 1 H. L. 315.

(*u*) Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327.

(*x*) p. 80 *ante*.

(*y*) See p. 231 *post*.

(*z*) The Patent Type Foundry Co. *v.* Richards, (1860) 6 Jur. N. S. 39; Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Gas Mantle Co., (1899) 17 R. P. C. 147; Neilson *v.* Betts, (1871) L. R. 5 H. L. 21.

(*a*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 326.

(*b*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671; Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Gas Mantle Co., (1899) 17 R. P. C. 147.

(*c*) *Ibid.*

(*d*) (1860), 6 Jur. N. S. 39; 1 Johns. 381; 2 L. T. N. S. 359.

*Wood*, V.C., overruled a demurrer on the ground that this specification was bad for uncertainty, and said:— Complete Specification.

"What I have to determine is whether this specification is so clearly and manifestly bad that no explanation by workmen or other experts . . . could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. . . . A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say 'I limit my claim to these precise proportions.' Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent. It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is that the specification is not void on the face of it."

In *British Dynamite Co.* v. *Krebs*, (*e*) the patent the validity of which was in question was for "improvements in explosive compounds and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe to use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into powder, which I call dynamite or *Nobel's* safety powder." Objection was taken at the trial to the specification, on the ground that the above was not a sufficient statement of the quantity of the nitro-glycerine to be used. The Judge of first instance overruled the objection, but the Court of Appeal held it fatal to the validity of the patent. The House of Lords, however, held that, under the circumstances, the specification was sufficient upon the ground stated by Lord *Cairns*, L.C., thus (*f*):—

"Where you speak of a porous substance absorbing a fluid, if the porous substance is in one piece you naturally expect

(*e*) (1878–79), S. P. C. 88; 13 R. P. C. 190; cf. Otto *v.* Linford, (1881–82) per Jessel, M.R., 46 L. T. 40.
(*f*) 13 R. P. C. 192.

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that the absorption will continue up to the point where the porous substance can hold no more; and when the absorbing substance is, and is to continue, a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become, not a powder but a paste."

It is settled law that a person, to be entitled to the benefit of a patent, must disclose his secret and specify his invention in such a way that others of the same trade may be taught to do that for which the patent is granted, by following the directions in the specification, without any new invention or addition of their own. (*g*) And the specification ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have.

Test of sufficiency.

In judging of the sufficiency of the specification, the proper criterion is whether a person to whom the specification is addressed, by using only the existing knowledge common to the trade at the date of the patent, would be able to exercise the invention without using information derived from any other source. (*h*) *Tindal*, C.J., directing the jury in *Muntz* v. *Foster* (*i*) as to the sufficiency of the specification, used the following words: "People are not to go on and make experiments, at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the easy and certain procurement of the commodity for which the patent was granted; that is a question upon the evidence." And, in the language of *Jessel*, M.R., "you are not to tell a man to make an experiment, but to tell him how to do the thing. (*k*)

When necessity for experiments renders a specification bad, and when not.

If the specification be such that the persons to whom it is addressed are not able, by following its directions, to produce *any* beneficial result without the further necessity of performing experiments and trials involving invention, it is bad. It

(*g*) Per Buller, J., R. *v.* Arkwright, (1785) Dav. P. C. 106; 1 W. P. C. 66, and note.

(*h*) Per Alderson, B., Morgan *v.* Seaward, (1836) 1 W. P. C. 173, 174; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710; 4 R. P. C. 463; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 88; 13 R. P. C. 190; Neilson *v.* Harford, (1841) 1 W. P. C. 371; Rex *v.* Arkwright, (1785) 1 W. P. C. 66.

(*i*) (1844) 2 W. P. C. 109.

(*k*) British Dynamite Co. *v.* Krebs, (1875-79) G. P. C. 90.

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may not, however, be bad if *a* beneficial result can be obtained by strictly carrying out the directions given, though further experiments may be necessary to obtain the result in a higher degree, (*l*) provided that the patentee has given the best means known to him of carrying out the invention. (*m*)

If the specification contain language which is calculated to mislead the public into performing experiments which the patentee knows must fail, such language will be a fatal defect in the specification. Thus, in *Crompton* v. *Ibbotson* (*n*) a patent for "improvements in dyeing and finishing paper," was held bad on this ground. 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." One of the witnesses for the plaintiff admitted that as to the conducting medium he had tried several things, but he was not aware that anything would answer the purpose except the material which the patentee said he preferred, and the plaintiff was nonsuited. The Court of King's Bench refused to set the nonsuit aside, Lord *Tenterden*, C.J., pointing out that the patent was obtained for the discovery of a proper conducting medium and that the plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in the specification, whilst he said that the cloth might be of any suitable material, and merely that he preferred the particular kind in the specification mentioned. Other persons, misled by this statement, might be induced to make experiments, which the patentee knew would fail. The public, therefore, had not the full and entire benefit of the invention. In *Winter* v. *Turner* (*o*) a patent was held void (*inter alia*) on the ground of a similar ambiguity in the specification.

*Leonhardt* v. *Kallé* (*p*) indicates that the above two old cases would be differently decided by the Courts now. The invention consisted in the production of various colouring matters fast to alkali by the action of suitable oxidisable substances and free alkalies upon a certain substance under heat. It was objected that the specification was ambiguous and misleading on four points, viz.: (a) because it showed no means

(*l*) Neilson *v.* Harford, (1841) 1 W. P. C. 295, 318; Macnamara *v.* Hulse, (1842) Car. & M. 471; 2 W. P. C. 128 *n.*; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*m*) p. 231 *post*.

(*n*) (1828) 6 L. J. (O. S.) K. B. 214.

(*o*) (1787) 1 T. R. 602; 1 W. P. C. 77.

(*p*) (1895) 12 R. P. C. 103.

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of ascertaining which oxidisable substances were not suitable; (b) because the proportions in which the various alternative oxidisable substances were to be used were not stated; (c) nor how the process could be varied to produce the several shades of colour mentioned; (d) the specification entirely failed to state the chemical nature of the compound, the product of the process. *Romer*, J., who tried the case, held that upon the facts all these objections failed, and as to some of them remarked that if they were held valid they would render it practically impossible to draw a specification for an invention like that of the patentee that could be free from objection. The reasons for holding the objections invalid were, shortly:—

As to (a), It was unreasonable 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 what could not give very useful results, or which might be disregarded. Having given numerous examples of different classes of oxidisable substances that could be used, he was entitled to say, as was true, that there were others which could be used. Following the directions of the specification and with such precautions as chemists would know how to use, oxidisable substances not expressly mentioned in the specification could be successfully used. As to (b), the patentee had given directions as to how to obtain the best results, in fact, with the different oxidisable substances specially mentioned which necessitated the use of the right proportions. He was not bound to enunciate any general theory. With regard to oxidisable substances not specifically mentioned, chemists would have no difficulty in ascertaining into which example or examples given any such unmentioned oxidisable substance fell, and in applying the directions given as regards the said example or examples. As to (c), the patentee had pointed out which colours his dyes produced; and also the colours that were produced from his process were rightly stated by the limits given in the specification. A person wanting to use the dyes could test the examples given without difficulty. Shades of colour vary infinitely, and are almost impossible to describe. The patentee was not bound to take every oxidisable substance and define what shade of colour it would produce. As to (d), this was an unfair objection, and the patentee was not bound to state anything of the kind, which, as a matter of fact, having regard to the state of chemical

knowledge, it would have been impossible for him to do with any certainty.

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III. *The complete specification must be intelligible to ordinary workmen possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.*

Meaning of "ordinary workman."

The often repeated statement to the effect that the specification is insufficient unless it be comprehensible to the "ordinary workmen" in the trade to which the invention relates is apt to lead to great confusion, if it be not clearly borne in mind that the "ordinary workman" is to be regarded as a person of very different knowledge and skill according to the nature of the field of invention with which the patentee in a particular case is dealing. Thus, if the invention is merely the construction of a mechanical combination of parts for a purpose readily understood—*e.g.*, a bicycle—then the "ordinary workman" is, no doubt, a mechanic used to the construction of machines; but if the invention is the production of something by a process, or series of processes, to understand which the highest scientific knowledge and attainments are requisite, the "ordinary workman" then becomes a highly trained scientific person, who may be called upon to give the necessary instructions to his less highly instructed and skilful subordinates to enable the process to be carried out by them—*e.g.*, if the invention relates to the production of a chemical product by a process, or series of processes to the understanding of which a knowledge of the most recent developments of chemical theories and ascertained facts is indispensable, then the "ordinary workman" becomes a highly trained chemist, who may be properly called upon to bring his special knowledge of the particular branch to which the invention relates into play, for the purpose of giving minute directions to his less skilful subordinates so as to enable them to perform the operations necessary to the carrying out of the process, which they, by their lack of knowledge, may not be able to fully appreciate.

If the above remarks be borne in mind, some of the statements of the law in the following pages, which might

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otherwise be considered conflicting, will at once appear in perfect harmony.

In *Morgan* v. *Seaward* (*q*) *Alderson*, B., told the jury that a specification is addressed to all the world: and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification, and the specification should be such as to enable a workman of *ordinary* skill to make the machine. (*r*) *Parke*, B., in *Neilson* v. *Harford*, (*s*) alluding to an invention relating to a machine, laid down the law in the following terms:—

Statement of the law as to "ordinary workman" in a particular case by Parke, B.

> "You are not to ask yourselves the question whether persons of great skill—a first-rate engineer or a second-class engineer—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed—it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity on the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, whatever its shape was, according to the terms of this specification, then I think that this specification is good, and that the patent may be supported so far as it relates to that."

The same by Jessel, M.R.

The following passage, from the judgment of *Jessel*, M.R., in *Plimpton* v. *Malcolmson*, (*t*) in reference to patents for mechanical inventions, has been approved of in subsequent cases as a correct statement of the law as to whom a complete specification must be intelligible (*u*):—

> "It is plain that the specification is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But there are various kinds of people who know something about it. If it is a

(*q*) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

(*r*) See also Gibson *v.* Brand, (1842) 1 W. P. C. 631; Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327; Beard *v.* Egerton, (1849) 8 C. B. 165; Bickford *v.* Skewes, (1839) 1 W. P. C. 218.

(*s*) (1841) 1 W. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20.

(*t*) (1875) L. R. 3 Ch. D. 531, 568; 44 L. J. Ch. 257.

(*u*) Edison *v.* Woodhouse, (1887) 4 R. P. C. 79; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 242; Bray *v.* Gardner, (1887) 4 R. P. C. 400, 406; Edison *v.* Holland, (1889) 6 R. P. C. 243.

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mechanical invention you have first of all scientific mechanicians of the first-class, eminent engineers; then you have scientific mechanicians of the second-class, managers of great factories, great employers of labour, persons who have studied mechanics. . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and, still more, from imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. This is what I would say of the two first classes, which I call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. . . . It will be a bad specification if the first two classes only understand it, and if the third class do not." (*x*)

The same by Maule, J.

It is sufficient if the complete specification define the invention so that an ordinarily skilful workman can carry it out. (*y*) Thus, *Maule*, J., in reference to the specification of an invention relating to photography, said:—

> "If so much nicety of description is required it would be impossible to draw a specification at all. It is enough if it be so explicit as to enable a man of ordinary, competent skill, and willing to learn, to perform the operation. A competent workman must be taken to know the known properties of iodine, of silver, and of nitric acid, or else the specification should have included a statement of the properties of each of these substances." (*z*)

Sufficiency of specification when the invention can only be appreciated by persons of great skill and knowledge.

Every inventor capable of sustaining a patent for his invention adds, it is clear, something to what was known before, and it is submitted that the ordinary skilled workman, to whom it may be supposed that his specification is addressed, must in

(*x*) See also Neilson *v.* Harford, (1841) 1 W. P. C. 314.

(*y*) Wallington *v.* Dale, (1852) 7 Exch. 888; 23 L. J. Ex. 49.

(*z*) Beard *v.* Egerton, (1846) 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 30; see also Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710, 713; 4 R. P. C. 449; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241, 253.

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most cases be interpreted to mean a person having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and a reasonably competent skill in the practical mode of doing what was then known: (*a*) but in cases where the invention relates to a subject which only appeals to and can only be appreciated by persons of great skill and knowledge in some particular department of science, then the ordinary skilled workman must be interpreted to mean a person possessed of the greatest skill and knowledge. (*b*)

If it appear in evidence that a person possessed of the highest scientific knowledge might be left in doubt as to the exact meaning of a direction contained in the complete specification, whereas a person possessing merely ordinary knowledge on the subject has no difficulty in interpreting the invention, the patent will be upheld with respect to the sufficiency of the specification. (*c*)

Specifications are not addressed to persons ignorant of the subject-matter.

The specification, in fact, is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufacture to which it relates. (*d*)

Thus, Lord *Loughborough*, in *Arkwright* v. *Nightingale*, (*e*) stated that a specification is addressed to persons having skill in the subject, and not to men of ignorance, and if it be understood by those whose business leads them to be conversant in such subjects it is sufficient. And in *Rex* v. *Arkwright*, (*f*) a case in which the patent called in question related to a mechanical invention, *Buller*, J., said, that if the specification be such that mechanical men of common understanding can comprehend it, so as to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

(*a*) See Edison *v.* Holland, (1889) 6 R. P. C. 243, 280.

(*b*) See p. 217 *ante*; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875, judgment of Willes, J.

(*c*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 12 App. Cas. 710; 4 R. P. C. 449.

(*d*) Huddart *v.* Grimshaw, (1803) 1 W. P. C. 85, 87; Bickford *v.* Skewes, (1837) 1 W. P. C. 218; Hornblower *v.* Boulton, (1799) Dav. P. C. 221, 228; Edison *v.* Holland, (1889) 6 R. P. C. 243, 277, 278, 280; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875.

(*e*) (1785) Dav. P. C. 39; 1 W. P. C. 60.

(*f*) (1785) Dav. P. C. 61; 1 W. P. C. 64.

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When *it is said that the meaning of the* specification is that others may be taught to do the thing for which the patent is granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no sort of specification would, probably, enable a ploughman, utterly ignorant of the whole art, to make a watch; and a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions. (*g*)

Person to whom the specification is addressed is presumed to possess all the existing knowledge common to the trade, but not more.

The *patentee must not leave the description of the* way in which the invention is to be performed in such a state that persons desirous of carrying it out would find that they had virtually to solve a problem before they could do so. The person reading the specification is called upon to bring to bear, in interpreting the specification, all the existing knowledge common to the trade; and he must not be called upon to exercise anything more. The specification must be drawn in such a manner as not to call on a person reading it to have *recourse to more than those ordinary means of* knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. (*h*) For example, if the proper dimensions of a part necessary to effect the patentee's object are a matter of calculation, the person to whom the specification is addressed may be called upon to make the calculation. (*i*) There is the authority of the House of Lords (*k*) for the proposition that a person to whom the specification may be supposed to be addressed must be taken *to* have *a* knowledge of *prior specifications* (and *sic*, other documents) relating to the same subject-matter, even though only recently published; and the actual ignorance of one or more eminent scientific witnesses of a particular specification is unavailing to prove that the knowledge of others was equally defective. (*l*)

In *Turner* v. *Winter*, (*m*) it appeared that in carrying out the invention in dispute it was necessary that during the process the materials used should be fused, though the specification only alluded to calcination. The specification

(*g*) Per Lord Ellenborough, C.J., *in* Harmar *v.* Playne, (1809) Dav. P. C. 318; 11 East, 181.

(*h*) Morgan *v.* Seaward, (1837) 1 W. P. C. 174.

(*i*) Scott's Patent, (1902) 19 R. P. C. 273.

(*k*) King, Brown & Co. *v.* Anglo-American Brush Corporation, (1892) 9 R. P. C. 313.

(*l*) See judgment of Lord Watson, 9 R. P. C. 320; cf. p. 153 *ante*.

(*m*) (1787) 1 T. R. 602; 1 W. P. C. 77.

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mentioned the use, as an alternative for other substances, of *fossil salt*, but it appeared at the trial that *fossil salt* was a generic term, including several species, and that *sal gem* was the only species of it which would answer the purpose. The patent was declared void, the specification not being intelligible, in so far as it did not state the degree of heat necessary, and the particular species of fossil salt which would answer the purpose.

If the specification be not intelligible to the public to whom it is addressed, the patentee will not have fulfilled the obligation which the law imposes upon him of telling the public for what it is that he claims the invention. (*n*) And in the words of Lord *Eldon*, L.C., "in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the time for which it was granted is at an end." (*o*)

If the specification is not sufficiently explicit to enable others to practise the invention, then it defeats one of the objects for which it was required—viz., "that useful novelties may be given to the public, of which, at the end of the term granted to the patentee, they shall have the full benefit." (*p*)

If the patentee use a word inaccurately, but from the context it is perfectly clear in what sense he intends it to be understood, such an inaccuracy will not be an objection which could be successfully urged against the validity of the specification. (*q*)

A specification which discloses in one set of words both the nature of the invention and the mode of performing it is sufficient. (*r*)

Errors in the specification and their effect.

All that is necessary is that the specification shall be intelligible to the persons to whom it is addressed, and enable them to perform the invention; and a specification so intelligible will not be vitiated by the fact that it contains slight mistakes and errors which any workman of ordinary skill and experience would perceive and correct. (*s*)

(*n*) Neilson *v.* Thompson, (1841) 1 W. P. C. 283.

(*o*) Newbury *v.* James, 2 Mer. 446, 451; 1 Carp. P. C. 367.

(*p*) Holmes *v.* London and North Western Ry. Co., (1852) Macr. P. C. 13, 16; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312, 340.

(*q*) Derosne *v.* Fairie, (1835) 1 W. P. C. 154, 157; Minter *v.* Mower, (1835) 1 W. P. C. 141; see also R. *v.* Metcalf, (1817) 1 W. P. C. 141 *n.*; 3 Car. & P. 611.

(*r*) Edison *v.* Holland, (1889) 6 R. P C. 280.

(*s*) Simpson *v.* Holliday, (1864) 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; Otto *v.* Linford, (1881)

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But this last statement must be understood as referring only to errors which appear on the face of the specification, or the drawings therein referred to, or which would be at once discovered and corrected in following out the instructions given, for such errors cannct possibly mislead; (*t*) and it must not be understood as a correct statement of the law where errors are discoverable only by experiment and further inquiry. The proposition, moreover, is not true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describe several processes or several combinations of machinery, and affirm that they will all produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman. (*u*)

A workman is not to be called upon to correct any error unless there is something to correct it by. (*x*) Thus, in the case of *Hinks'* patent for the paraffin lamp the drawing did not show, and the letterpress did not describe, a certain small opening in the second burner which was necessary to the effective working of the lamp. *Jessel*, M.R., held this to be a fatal defect which a workman could not be called on to remedy. In the case of an invention the whole merit of which is very small indeed, if people are told how to do things better they must be told properly, without the necessity for invention or much trouble. (*y*)

Objections to the working of a patent are not usually allowed when a patent has stood for a long time the test of inquiry. (*z*)

The objection to the sufficiency of a specification, on the ground that it made use of *French* expressions, such as *vis de*

46 L. T. N. S. 35; Morgan *v.* Seaward, (1836) 1 W. P. C. 176; Derosne *v.* Fairie, (1835) 1 W. P. C. 157; 1 W. P. C. 42 *n.* 41; Gandy *v.* Reddaway, (1883) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Hopkinson *v.* St. James's Electric Light Co., (1892) 10 R. P. C. 46; Miller *v.* Searle, (1893) 10 R. P. C. 106.

(*t*) p. 202 *ante*.

(*u*) See remarks by Lord Westbury, L.C., in Simpson *v.* Holliday, (1864) 13 W. R. 577; 5 N. R. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; p. 202. *ante*.

(*x*) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 190; 13 R. P. C. 190; *Hinks v.* Safety Lighting Co., (1876) 4 Ch. D. 615; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*y*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 615; 46 L. J. Ch. 185.

(*z*) Betts *v.* Neilson, (1871) L. R. 5 H. L. 121; per Lord Westbury, L.C.

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*pression*, *vis de répulsion*, and *vis de réaction*, for different screws, and *centimètres* for inches, was taken in *Bloxam* v. *Elsee*, (*a*) but was not sustained, as it appeared that, although these terms would not be understood by *English* mechanics, yet a skilful workman could construct the machine by the aid of the drawings annexed to the specification, *Abbott*, C.J., saying: "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if by a comparison of the words and drawing the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

The use of the word "discolour," as meaning "discharge the colour," being a bad translation of the French word "discoleur," has been held not to be of sufficient importance to upset a specification. (*b*)

Effect of statements rendering experiments necessary.

A specification will be sufficient which contains directions enabling a person having a reasonably competent knowledge and skill of the subject to make the article described without further invention, though it may be necessary for him to make some trial and experiment before succeeding; (*c*) but a specification which does not contain sufficient information to enable this to be done without the necessity for experiments, involving the exercise of the inventive faculty of the experimenter, is absolutely fatal to the validity of the patent. (*d*)

It is to be observed that what in one particular case, having regard to the nature of the invention and the public to whom the specification may rightly be supposed to be addressed, is a mere affair of practice before being able to succeed, ought in another particular case to be regarded by the Court as a matter of experiment, the necessity for which is fatal to the patent on the ground of insufficiency of the specification. Thus *Wills*, J., has stated that, in his opinion, a chemical patent dealing with

(*a*) (1825) 1 Car. & P. 558; 6 B. & C. 169.

(*b*) Tetley v. Easton, (1852) Newton, L.J., vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293; but see Bradford Dyers' Association v. Bury, (1900) 18 R. P. C. 161; 19 R. P. C. 1.

(*c*) Edison v. Holland, (1889) 6 R. P. C. 243; Haskell Golf Ball Co. v. Hutchison, (1905) 22 R. P. C. 493.

(*d*) Liardet v. Johnson, (1778) 1 W. P. C. 53; R. v. Arkwright, (1785) 1 W. P. C. 70; Neilson v. Harford, (1845) 1 W. P. C. 317; Hinks v. Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; Bailey v. Roberton, (1878) L. R. 3 App. Cas. 1055; Pooley v. Pointon, (1885) 2 R. P. C. 167; Hutchison v. Patulle, (1888) 5 R. P. C. 351; Elkington v. Clark, (1888) 5 R. P. C. 327; Gaulard and Gibbs's Patent, (1888) 5 R. P. C. 535; Plimpton v. Malcolmson, (1876) L. R. 3 Ch. D. 531; 45 L. J. Ch. 505; Simpson v. Holliday, (1886) L. R. 1 H. L. 315; The Lifeboat Co. v. Chambers, (1891) 8 R. P. C. 418.

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very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes. (*e*)

The following passage from the judgment of *Lindley*, L.J., in *Edison* v. *Holland*, (*f*) illustrates the point that, though trial may be necessary before success is attained, yet the specification may be sufficient:—

> "If a person is told to carbonise a thread, and for want of thought or practice he takes a porous crucible for the purpose, and does not protect his thread, and fails, when, 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 instructor, if a little thought and consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that a 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. . . . If a patentee says that something must be done which a reasonably competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand."

IV. *The complete specification must particularly describe and ascertain the nature of the invention and in what manner the same is to be performed.*

Now a statutory as well as a common law requisite.

This was specially enacted by the Act of 1883, s. 4; but *before that statute* the public had a Common Law right to a fair, full, and true description; (*g*) and it was laid down by *Ashurst*, J., (*h*) that 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 that it is of consequence that the terms used should express the invention in the clearest and most specific manner. *Buller*, J., (*i*)

(*e*) Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 891.

(*f*) (1889) 6 R. P. C. 282.

(*g*) R. v. Arkwright, (1785) Dav. P. C. 61; Macfarlane v. Price, (1816) 1 Stark. N. P. 199; 1 W. P. C. 74 *n.*; Gibson v. Brand, (1842) 1 W. P. C. 640.

(*h*) Turner v. Winter, (1787) 1 W. P. C. 77; 1 T. R. 602.

(*i*) *Ibid.*

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declared that where attempts were made to evade a fair patent he was strongly inclined in favour of the patent, but when the discovery is not fully made the Court ought to look with a very watchful eye to prevent any imposition on the public.

In *Hastings* v. *Brown*, (*k*) a patent granted for "certain improved arrangements for raising ships' anchors and other purposes" was upset on the ground that the language used in the specification was ambiguous. The patent related to a windlass, the drum of which was grooved in a V form, the sides of the V groove being scalloped or recessed into a series of shell-like indentations, which formed a hold for the links of a chain cable, and the words used in the specification to describe the object of the invention were, "the scallop shell is upon a new plan, intended to hold, without slipping, *a chain cable of any size*, as shown by the opening form of the scallop at the top and bottom of Figure 2." The drawing referred to (*l*) merely showed an indented V groove. It was established in evidence that before the date of the patent no cable-holder was known which would hold chains of different sizes, and the invention claimed by the pleadings as a novelty was the application of a single windlass to different sizes of chain cable. It was also established that a windlass, capable of holding a chain cable of a given size, was no novelty. The defendant's case was that the patent was void because the language used in the specification left it doubtful whether the claim was for holding a chain of a given size or for holding chains of different sizes. The jury gave a verdict in favour of the patent. The Court of Queen's Bench subsequently, however, directed a nonsuit to be entered, on the ground that the specification was bad, Lord *Campbell*, C.J., saying:—

> "It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of the monopoly. This is not done by this specification. The claim is for an invention by which a single windlass may raise cables of different diameter, which is allowed to be a great improvement. But is that pointed out by the specification? The words are at best equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty; and the vice of the specification is that it does not

(*k*) (1853) 1 Ex. B. 450; 22 L. J. Q. B. 161. (*l*) Fig. 2.

assert that more can be done by the invention. The title tells us nothing. The words of the specification are, 'a chain cable of any size.' 'A' applies to one only. At all events, the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing, which would do no more than that."

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It is a fatal defect if the specification does not disclose the object of the invention, and also how the same is to be effected. (*m*)

In *Kopp* v. *Rosenwald* (*n*) the Court of Appeal held that the claim was, when properly construed, for a process of making a new article, which depended upon the use of a braiding machine having a particular number of heads and spindles according to the number of strips of whalebone selected to compose the new article, and that, as the specification only gave a prescription which would be found useful in the case of two strips of whalebone, and was silent as to the number of heads and spindles required in other cases, the patent was void.

*Lyon* v. *Goddard* (*o*) is a case which illustrates the importance of clearly stating on the face of the specification the purpose for which a combination, which is the subject-matter of the patent, is designed and claimed. In that case, after a great deal of argument, which might have been rendered unnecessary by a more clearly drawn specification, it was finally decided by the House of Lords that, upon the true construction of the specification, the machine which was the subject of the patent was specially designed for use with high-pressure steam, and the claim was limited to its use with high-pressure steam for the purpose of disinfecting. The consequence was that a certain prior machine which could be used with low-pressure steam only was no anticipation of the plaintiff's invention, and so this ground of attack upon the patent failed.

Whilst, in order to support a patent, it is necessary that the patentee should fully disclose to the public what is the nature and object of the invention, and how the same is to be

Disclosure of nature and object of invention and how it is to

(*m*) p. 225 *ante*; Allen *v.* Duckett, (1893) 10 R. P. C. 397.

(*n*) (1902) 20 R. P. C. 154.

(*o*) (1893) 11 P. O. R. 369.

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carried out, (*p*) yet, if he make a full and fair disclosure *as far as his knowledge at the time extends*, he has done all that is required. (*q*)

be performed as far as patentee's knowledge at the time extends is sufficient.

*Sirdar Rubber Co.* v. *Wallington*, (*r*) is an illustration of the patent being declared bad expressly on the ground that the specification did not particularly describe and ascertain the nature of the invention and the manner in which it was to be performed. The reason why a full disclosure is required, is that a party who obtains a patent is bound clearly to define in his specification what it is he claims as his invention, in order that the public may know with certainty what they may, or may not, do without incurring the risk of an action for infringement of the patent, (*s*) and that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect. (*t*)

It is a condition, without the fulfilment of which the patent is void, that the patentee shall state the nature of his invention, in order that persons reading his specification shall know, and shall know with reasonable clearness and facility, what they are prohibited from using by the letters patent without permission or licence. (*u*)

In the case of patents for improvements on existing inventions the patentee must be specially careful to claim only the improvement and not the old invention. (*x*)

Sufficiency of description necessary, when invention consists of several parts.

If the invention consists of more than one part, the specification must contain a full, accurate, and intelligible description of every such part, and the means of carrying it into effect.

Thus in *Morgan* v. *Seaward*, (*y*) *Alderson*, B., charging the jury in terms which have never been questioned, told them that the patentee had in his specification described two inventions, and that the patent would fail if either of them were insufficiently specified; for if a person run the hazard

(*p*) Allen *v.* Duckett, (1893) 10 R. P. C. 397; p. 225 *ante*.

(*q*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 1 W. P. C. 496.

(*r*) (1905) 22 R. P. C. 257; 23 R. P. C. 132.

(*s*) Per Cresswell, J., Gibson *v.* Brand, (1841) 1 W. P. C. 627.

(*t*) Per Alderson, B., Morgan *v.* Seaward, (1836) 1 W. P. C. 174, 179.

(*u*) Philpot *v.* Hanbury, per Grove, J., (1885) 2 R. P. C. 33; see also Fairburn *v.* Household, (1886) 3 R. P. C. 128, 263; Rowcliffe *v.* Morris, (1886) 3 R. P. C. 17.

(*x*) Eades *v.* Starbuck Waggon Co., W. N. 1881, p. 160; p. 76 *ante*.

(*y*) (1836) 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153; see also Reg. *v.* Wheeler, (1819) 2 B. & Ald. 345; Macnamara *v.* Hulse, (1842) Car. & M. 471; Stevens *v.* Keating, (1847) 2 W. P. C. 175; 19 L. J. Ex. 57.

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of putting two inventions into one patent, he cannot hold his patent, unless each can be supported separately. He told the jury this after having previously directed them that, in law, the patentee is required to state fairly to the public what the invention really is, in order that other persons may know what is the prohibited ground, and that the public may be made acquainted with the means by which the invention is to be carried into effect. The learned Baron also pointed cut that it is of great importance to the public, and by law absolutely necessary, that the patentee should state in his specification not only the nature of his invention, but how that invention may be carried into effect. Unless he be required to do this, monopolies would be given for a term of years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect.

### V. *The complete specification need not describe any step or process which is necessarily implied.*

Things necessarily implied need not be specifically described.

For instance, in the case of a specification of a newly invented chemical process, which directed that some particular chemical substance should be poured upon gold in a state of fusion, it would not be necessary that the specification should describe the obvious fact that, in order to carry out this direction, the gold would have to be put into a crucible and melted; nor would it be necessary to specify the manner in, nor the utensils with which the operation of putting gold into a state of fusion was to be performed, these being mere incidents with which every man acquainted with the subject must be familiar. (*z*)

In *Crossley* v. *Beverley* (*a*) it was sought to upset a patent for an "improved gas apparatus," on the ground that the specification did not specify the use of a condenser, without which the apparatus would not work satisfactorily. Lord

(*z*) Boulton *v.* Bull, (1795) Dav. P. C. 162; 2 H. Bl. 498.

(*a*) (1829) 3 Car. & P. 513; 1 W. P. C. 106.

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*Tenterden*, C.J., however, overruled this objection, holding that any workman capable of making a gas apparatus would know that he must put in a condenser, and the specification did not direct that the condenser should be left out.

In *Russell* v. *Cowley* (*b*) the specification of an invention for the manufacture of iron tubes without the use of a mandril was held sufficient, though it did not specifically state that the mandril was to be left out. The ground of the decision was that an ordinarily intelligent workman would, from the general purport of the specification, sufficiently understand that the mandril was to be omitted. (*c*)

### VI. *The complete specification need not necessarily describe minutely any known thing to which it refers.*

Not necessary to describe a known thing referred to.

For example, in the case of an invention which consists of an improvement on an existing machine, it would not be necessary for the patentee in the specification to enter into a minute description of the old machine, or the preparation of a known compound though the same is but little known and its manufacture difficult; (*d*) but it must not be forgotten that the language used must be such as will distinguish the invention from that which is old. (*e*)

In *Harmar* v. *Playne* (*f*) the patent related to improvements in machinery secured by previous letters patent. It was admitted by the defendant that the improvements for which the second patent was granted were included in the second specification, which gave a full and proper description of the whole machine in its improved state. It was objected, on the other hand, that the second specification did not, in any manner, point out or explain the improvements upon the former patented machine for which the second patent was granted, and, therefore, that it was insufficient. The Court of King's Bench, however, held the specification sufficient, Lord *Ellenborough*, C.J., remarking that the difficulty which pressed most was, whether this mode of making the specification was not calculated to mislead a person looking at it, and

(*b*) (1832) 1 W. P. C. 459.

(*c*) See also Beard v. Egerton, (1846) 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

(*d*) See Badische Anilin und Soda Fabrik v. Levinstein, (1887) 4 R. P. C. 469.

(*e*) See 241 *post*.

(*f*) (1809) 14 Ves. 130; 11 East, 101; Dav. P. C. 311; see also Tubes, Ld. v. Perfecta Seamless Tube Co Ld., (1902) 20 R. P. C. 77, 97.

induce him to suppose that the term for which the patent was granted might extend to preclude the imitation of other parts of the machine than those for which the new patent was granted, when he could only tell, by comparing it with some other patent, what were the new and what were the old parts; and if that might be done with reference to one, why not with reference to many other patents, so as to render the investigation very complicated?

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It may not be necessary, in drafting a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and to apply to those the improvements, but it may be sufficient to refer generally to them; *e.g.*, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them.

VII. *The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.*

Thus, in *Neilson's* specification of his invention of an improved application of air in furnaces, the patentee stated that the form of the vessel in which the air was heated was quite immaterial, and the Court of Exchequer ruled that, on the evidence, the specification was sufficient in that particular. (*g*)

VIII. *The complete specification must describe the best method known to the patentee of performing the invention, and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection, prior to the date of filing the complete specification.*

Specification must extend to the best of the patentee's knowledge.

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed, (*h*) and the description will not be sufficient unless it include the best means known to him at the time of filing the document. In fact, a man has no right to patent an invention and give the public only the humblest means

(*g*) (1841) 1 W. P. C. 295, 328.

(*h*) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.

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that can be devised for carrying it into effect, and reserve to himself all the better part of it, and to box up his improvements, and to say to the world, "You are at liberty to perform my invention in this way, but it will be of very little use." (*i*) He must, on the other hand, put the public in possession of the discovery in as ample and beneficial a way as he himself uses it, (*k*) and place them in a position to derive the same benefit from it which he himself does. (*l*)

To use the words of *Gibbs*, C.J.: "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention; not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the knowledge of the patentee at the time; for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefits than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends, yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him." (*m*) And in the language of *Alderson*, B., "If a patentee is acquainted with any particular mode by which his invention may most conveniently be carried into effect he ought to state it in his specification." (*n*)

Thus in *Savory* v. *Price* (*o*) the patent was for the "invention of a neutral salt, under the name of *Seidlitz* powder," and the specification, to the misleading of the public, set out three distinct recipes for making the ingredients of the powder—viz., (1) Rochelle salt (*i.e.*, a double tartrate of

(*i*) Tetley *v.* Easton, (1852) Mac. P. C. 48.

(*k*) R. *v.* Arkwright, (1785) Dav. P. C. 61; 1 W. P. C. 64.

(*l*) Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh, R. 211; Wood *v.* Zimmer, (1815) Holt, N. P. 57; Tetley *v.* Easton, (1852) Mac. P. C. 48; Savory *v.* Price, (1823) 1 Ry. & Mo. 1; 1 W. P. C. 83; Walton *v.* Bateman, (1842) 1 W. P. C. 613; Heath *v.* Unwin, (1852) 2 W. P. C. 243; Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 531, 582.

(*m*) Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh, R. 211.

(*n*) Morgan *v.* Seaward, (1836) 1 W. P. C. 174.

(*o*) (1823) Ry. & M. 1; 1 W. P. C. 83

potash and soda); (2) carbonate of soda; (3) tartaric acid—all of which were well-known substances before the date of the patent and readily procurable. The specification further and properly stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. The plaintiff was nevertheless nonsuited, *Abbott*, C.J., saying:— Complete Specification.

> "It is the duty of any one to whom a patent is granted to point out the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported."

Patentee need not necessarily state the best way of carrying out the invention, but must state the best way known to him,

It is evident that the patentee may not be in possession of the very best possible way of carrying out the invention. In that case the specification will not be bad if it turn out afterwards that it does not describe the best possible way of performing the invention; all that is necessary is that it should give the best method known to the patentee. (*p*) Neither is it incumbent on the patentee to describe all the possible advantages which may in future accrue from the improved use of his invention. He is only bound, under the statute and the patent law, to give the world the benefit of such information as he actually possesses. (*q*)

In the case of an invention made abroad it is the usual practice for the foreign inventor who is desirous of protection in this country to employ an agent to take out the patent for him, and the grant is made to the agent, who is therefore in law the patentee. (*r*) Under such circumstances the fact that

(*p*) Neilson *v.* Harford, (1841) 1 W. P. C. 317, 356; The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 693; Wood *v.* Zimmer, (1815) Holt, N. P. 57; 1 W. P. C. 82 *n.*; Savory *v.* Price, (1823) 1 Ry. & Mo. 1; 1 W. P. C. 83; Turner *v.* Winter, (1787) 1 W. P. C. 81; Morgan *v.* Seaward, (1836) 1 W. P. C. 170; Sturtz *v.* De la Rue, (1828) 1 Carp. Rep. 463; 5 Russ. 322; 1 W. P. C. 83; Tetley *v.* Easton, (1852) Mac. P. C. 76; Derosne *v.* Fairie, (1835) 1 W. P. C. 158; Walton *v.* Bateman, (1842) 1 W. P. C. 622; Heath *v.* Unwin, (1852) 2 W. P. C. 243.

(*q*) Lyon *v.* Goddard, (1893) 10 R. P. C. 345, judgment of Bowen, L.J.

(*r*) pp. 16-19 *ante*.

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the foreign inventor was possessed of knowledge not in the specification will not render that instrument bad if it appear that the agent did not possess such knowledge, for the agent is the patentee, and it is only necessary that the specification should contain a description of the best means known to him of carrying out the invention (*s*). On the other hand, if the agent, the actual patentee, be possessed of knowledge not in the specification, it is no answer to an objection on the ground of insufficiency to say that the specification contains all the information which the agent received from the foreign inventor. (*t*)

If the specification do not describe everything which is necessary to the working of the invention to the best of the patentee's ability, it will not "particularly describe and ascertain the manner in which the invention is to be performed," as required by the Act of 1883. Hence the patentee must give the public every information which is necessary to enable them completely to perform every part of the invention, although it may be sufficient merely to refer in general terms to such things and processes as are old. And it also follows that if a material part, or anything which the patentee knows to be useful, is omitted, the specification will be insufficient.

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing it with tallow, and for want of that Lord *Mansfield* held it void. (*u*)

In the case of *Galloway's* patent for improvements in steam-engines and machinery for propelling vessels it appeared that a slight difference in the length of certain rods was a necessary feature in the successful working of the invention, and the specification did not state this fact. At the trial of an action (*x*) relating to this patent, *Alderson*, B., told the jury that the small necessary difference in the lengths of the rods ought to have been specified; and if it could not have been ascertained fully it should have been so stated. The small adjustment of the different lengths might have been made for the purpose of making the machine work more smoothly, and, if so, it was just as necessary that it should be so stated in the specification as it was that the tallow should be

(*s*) Plimpton *v.* Malcolmson, (1875) 3 Ch. D. 531, 582.

(*t*) Wegmann *v.* Corcoran, (1879) 13 Ch. D. 66; 41 L. T. N. S. 358.

(*u*) See Liardet *v.* Johnson, (1778) 1 W. P. C. 53.

(*x*) Morgan *v.* Seaward, (1836) 1 W. P. C. 182.

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mentioned in *Liardet* v. *Johnson*. The true criterion is this: "Has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him."

and must not suppress anything essential thereto.

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad, (*y*) for it is the duty of a patentee, possessed of a mode of carrying on his invention in a beneficial manner, to disclose the means of producing it in equal perfection and with as little expense and labour as he himself incurred. To enable the public, at the expiration of the monopoly, to perform the invention in the same way, and with the same advantages as himself, is the price which the grantee pays for the patent, and the specification is void if anything which gives an advantageous operation to the invention be concealed. Thus, in the case of *Wood* v. *Zimmer*, (*z*) a patent for a method of manufacturing verdigris was held void on the ground of the insufficiency of the specification, which did not disclose the fact that the patentee was accustomed to use *aqua fortis* in a boiler to facilitate the solution of copper, the evidence having established that the use of *aqua fortis* enabled the operation to be carried on in a much more satisfactory manner than the method described by the patent.

Examples.

In the case of the *Hinks'* patent for the duplex lamp, the drawing attached to the specification did not show, and the letterpress did not describe, a certain aperture through which air was admitted to the second burner, and without which the lamp would not work. *Jessel*, M.R., on this ground, held that the specification was bad. (*a*)

In the case of *Mackelcan's* patent for improvements in floating docks, the patentee was unable to support his contention that his invention consisted in the use of *iron* for the construction of the floating dock described by the complete specification, because that document omitted all mention of

(*y*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 4 Car. & P. 56; 1 W. P. C. 496; Savory *v.* Price, (1823) Ry. & M. 1; 1 W. P. C. 83; p. 202 *ante*.

(*z*) (1815) Holt, N. P. 58; 1 W. P. C. 82 *n*.

(*a*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

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the material of which the dock was to be constructed, and the patent was accordingly declared void, as it appeared that floating docks constructed of *wood* and of design similar to that described by the patentee were old. (*b*)

In *Derosne* v. *Fairie* (*c*) it appeared that it was desirable and necessary for the most beneficial working of the plaintiff's patented process for extracting sugar or syrup from cane juice and other substances containing sugar, and for refining sugar and other syrups, to remove all iron from the bituminous schistus used in the operation, and the complete specification did not state how this was to be done. The Court of Exchequer set aside the verdict given for the plaintiff, and directed a new trial, on the ground that there was no evidence to show that the process carried on with bituminous schistus in combination with any iron whatsoever would answer at all. The plaintiff had himself declared that in the bituminous schistus which he himself furnished the whole iron was extracted, and it appeared that it was admitted by counsel that the presence of iron would not only be disadvantageous but injurious. Further, without considering whether or not the patent would be avoided by the patentee keeping secret the means requisite to extract the iron from the bituminous schistus, it was clear that the patentee had not shown that what he had described in the patent could be used as so described without injury to the material going through the process. Under all the circumstances, the Court thought the plaintiff ought to have given some evidence to show that bituminous schistus, in the state in which it is found and known in *England*, could be used in the process with advantage; and, as he had not done that, the defendant was entitled to a nonsuit; but, at the same time, as it was alleged that the plaintiff might, on a new trial, supply the defect of proof as to the schistus by other evidence, the Court was desirous that the patent, if a good one, should not be affected by their judgment, and therefore they granted the new trial.

It was laid down by *Parke*, B., to the jury in *Neilson* v. *Harford*, (*d*) that if the patentee knew that internal partitions in a certain cylinder, interposed between a blowing apparatus and a furnace, were useful, the omission to state that fact in

(*b*) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.
(*c*) (1835) 5 Tyr. 393; 1 W. P. C. 154.
(*d*) (1841) 1 W. P. C. 317, 321.

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the specification would be a fatal defect. (*e*) And in *Rex* v. *Arkwright* (*f*) it was proved that for the successful working of the defendant's spinning machinery it was necessary that the difference in the velocity of certain rollers should be adjusted, and the specification was silent on this point. *Buller*, J., commenting on the evidence which the defendant adduced to show what his invention really was, used the following words: "The man that comes to give an account of the invention says, 'I had calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers and velocity, and it is left to people to find it out as chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

*It is not requisite that all processes claimed shall be equally successful.*

Though it is essential that all the processes described and claimed should be successful, (*g*) it is not necessary that all the processes described in a specification should prove equally successful, or of equal commercial value. The fact that persons to whom the specification is addressed have to try them to determine which is the best commercially, or that even the patentee himself does not know which is the best at the time, will not invalidate the patent. (*h*)

Lord *Herschell*, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik* v. *Levinstein* (*i*) after having pointed out the causes which may give a different commercial value to a given product at given times, continued—

> "It was urged by the learned counsel for the respondents that a patentee is bound to disclose the means by which his invention may be carried into effect, and that, if he leaves this to be ascertained by experiments, his patent cannot be supported. This is, no doubt, correct. But I think the patent under consideration does show how the colouring matters are to be produced, and that what it leaves a skilled person of the class to

(*e*) See also Macnamara *v.* Hulse, (1842) Car. & M. 471; 2 W. P. C. 128 *n.*

(*f*) (1785) 1 W. P. C. 70.

(*g*) Beard *v.* Egerton, (1846–49) 19 L. J. C. P. 39; *Derosne v. Fairie*, (1835) 1 W. P. C. 165; Cole *v.* Saqui, (1883) 5 R. P. C. 494.

(*h*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 449; L. R. 12 App. Cas. 710; Thomson *v. Batty*, (1889) 6 R. P. C. 84, 97.

(*i*) (1887) 4 R. P. C. 466; L. R. 12 App. Cas. 710.

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whom the specification is addressed to discover, is, only, which of these colouring matters will best answer his purpose at any particular time. There is, in my opinion, no warrant for asserting that this invalidates the patent."

When an improved method discovered during the period of provisional protection should be included, and when it should not be included.

The question may arise as to whether, if an inventor, after having lodged a provisional, but before filing a complete specification, discover an improvement on the invention covered by such provisional specification, he must include a description of the improvement in his final specification (on the ground that the document would be insufficient without it, the improvement being the best means known to the patentee of performing the invention), or whether the improvement may form the subject-matter of a separate and further patent. In such a case it would appear that the real point to decide would be the nature of the improvement in question. It is submitted that, if the evidence establish this to be only a method or means of carrying out the invention covered by the provisional specification, the omission of a description of it would render the final specification bad on the ground that the document did not contain the best method known to the patentee of performing the invention. If, however, the improvement consist in an invention which is really distinct from that comprised by the provisional specification, it may be capable of forming the subject of a separate patent, (*k*) and a distinct claim to it *per se* in the final specification would be a fatal defect; for the claim to the improvement in that case would be a claim to an invention in respect of which the provisional specification gave no protection, and the patent therefore could not include it. (*l*)

Provisional protection is granted to the patentee for the express purpose of enabling him to bring the invention to a state of perfection, and it is only equitable that he should be compelled to disclose the latest and best information he possesses, so that the public may profit by it when the patent expires.

If the improvements made during the period of provisional protection be of such a nature as not to fall within the limits of the provisional, they must not be inserted in the final specification, as a claim to them would probably render the

(*k*) Edison *v.* Woodhouse, (1887) L. R. 32 Ch. D. 520.

(*l*) *Ibid.*: Crossley *v.* Potter, (1853) Mac. P. C. 240: Bailey *v.* Roberton, (1878) L. R. 3 & 5 App. Cas. 1055; Penn *v.* Bibby, (1866) L. R. 2 Ch. 27; Siddell *v.* Vickers, (1888) 39 Ch. D. 105.

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patent void; (*m*) moreover, the patentee, by a general claim, cannot include in his patent improvements of which he was ignorant at the date of the patent. (*n*)

*Bailey*, J., speaking at a time when the patent was granted before, and subject to, the filing of a final specification, 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 it better to effectuate 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 that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification." (*o*)

And *Tindal*, C.J., speaking at a like period, declared that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification. (*p*).

A patentee filing a provisional specification which shows the nature of his invention is not bound to describe therein any mode of carrying it into effect; but if he does so, and before filing his complete specification discovers an improvement in such mode, he is bound to give to the public in his complete specification the benefit of what he has discovered as to the mode of carrying the invention into effect; and a statement in the complete specification of improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view to producing the same results, the substitution of mechanical equivalents, modifications and developments within the scope of the invention set out in the provisional specification will not invalidate a patent on the ground of disconformity between the provisional and complete specification. (*q*).

When a patentee explained the objection to his specification,

(*m*) pp. 190-199 *ante*.

(*n*) Tetley *v.* Easton, (1852) Macr. P. C. 77.

(*o*) Crossley *v.* Beverley, (1829) 1 W. P. C. 117; 3 C. & P. 513.

(*p*) Jones *v.* Heaton, 1 W. P. C. 404 *n.*; see also Crossley *v.* Beverley, (1829) 1 W. P. C. 117; Woodward *v.* Sansum, (1887) 4 R. P. C. 166; Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 397.

(*q*) Woodward *v.* Sansum, (1887) 4 R. P. C. 166; Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92, 103; Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 531, 580; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 382, 397; Ward *v.* Hill, (1903) 20 R. P. C. 189; see pp. 188-199 *ante*.

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that it did not contain all the knowledge he possessed relative to carrying out the invention, by saying that, at the date of the patent, he did not think a certain substitute for a method given equally good to that described, and that, though since the date of the patent he had actually patented the new method he had in fact returned to the original, the Court held that the patent was not invalidated. (*r*)

And when, during the interval between the filing of the provisional and complete specifications of an invention of an electric lamp with which comprised a carbon filament in combination with other parts, the patentee lodged a provisional specification of an invention for a method of making the carbon filament, the Court held that it was no objection to the validity of the patent for the first invention that the patentee did not in the complete specification filed in respect of it, disclose the method of making the filament which formed the subject of the invention disclosed by the second provisional specification. The decision was based on the ground that the method of manufacturing the filament did not form the basis of any claim made under the first patent. (*s*)

### IX. *The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.*

No necessity to state every means of producing a desired result.

It is not necessary that the specification should state precisely every means that will produce a given effect. Thus the specification of *Bickford's* miners' safety fuse, which was formed of several strands of flax, hemp, &c., enclosing within the interior a small core of fine powder, stated: "I manufacture flax, hemp, cotton, or other suitable materials, spun, twisted, and countered, and otherwise treated in the manner of twine spinning and cord-making, by means whereof I embrace in the centre of my fuse a small portion or compressed cylinder or rod of gunpowder or *other proper combustible matter*, prepared in the usual pyrotechnical manner of firework for the discharging of ordnance." It appeared in the evidence, at a trial in which the sufficiency of the specification was in issue, that gunpowder was, in fact, the material used by the patentee, but, in the opinion of one witness, detonating powder would

(*r*) Thomson *v.* Batty, (1889) 6 R. P. C. 84, 100.

(*s*) Edison *v.* Woodhouse, (1887) L. R. 32 Ch. D. 520.

answer the purpose, but less effectively. The jury gave a verdict for the patentee on the issue of sufficiency, and a rule *nisi* for a new trial was discharged by the Court of Queen's Bench, who were of opinion that it was immaterial if other materials, not specified, but within the description given, would answer the purpose, and that it was certainly not necessary to specify all. (*t*)

Complete Specification.

If the specification state the best method known to the patentee of carrying the invention into effect, (*u*) it is not necessary to give every means of so doing. A general claim may not entitle the patentee to improvements of which he was ignorant at the date of the patent. (*x*)

X. *If the complete specification describes anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.*

Distinct claim to something old is fatal.

The Act of 1883 (*y*) requires that the complete specification shall particularly describe and ascertain the invention; it is impossible to contend that a specification does this, if it describes things which are old as well as the novelty, which is the real invention, without distinguishing the one from the other. The point to be carefully borne in mind in considering the question is whether or not the claim amounts to a claim to anything which is old, in which case the specification will be bad, and the patent void, on the ground that the patentee has claimed something which lacks the essential feature of novelty. (*z*)

Claim may be only apparently for something old.

It is, however, to be observed that sometimes a claim may appear to include something which is old, whereas on the true construction of the specification it does not really amount to more than a statement that the invention is equally as useful for some purpose for which an alleged anticipation was useful as it is for the purpose which is the subject of the claim, and for which the alleged anticipation is wholly useless. Such a claim will not vitiate the patent, though it may be objectionable from the draughtsman's point of view as not being as clearly drawn as it might be. (*a*)

(*t*) Bickford *v.* Skewes, (1838) 1 W. P. C. 211, 218.
(*u*) pp. 231–240 *ante*.
(*x*) p. 353 *post*.
(*y*) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.
(*z*) Chap. iii. *ante*, p. 251 *post*.
(*a*) See Lyon *v.* Goddard, (1891) 11 R. P. C. 361.

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In the case of a patent for a combination which consists of new and old parts, if the combination is only claimed as a whole, it is not necessary to specify which of the parts are new and which old. (*b*)

Claim to improvements on old things, and combinations of old parts.

An improvement on an existing machine may be the subject-matter of a new patent; (*c*) but if the specification does not distinguish clearly the improvement from the old parts, and claim only the new improvement, the patent will be void, for it cannot include both the addition and the old machine. (*d*)

And if, in the case of a combination patent, the combination as a whole is not new, but there is some particular improvement in some particular part, the specification will be insufficient if it claims the whole combination as new. It must condescend upon that which is improved, and specifically lay claim to that and that only. (*e*)

Thus, if a compensation pendulum were now for the first time invented, it would not do to patent improvements in clocks in general terms, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and combination. The patentee ought to say expressly: "I claim the invention of a compensation pendulum, and make it thus." (*f*)

A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent. (*g*) If a combination of a certain number of these parts existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specification will be bad if the claim includes the old combination separately. (*h*) If all the parts are old, the specification will be bad unless it claim only the new

(*b*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 142; Foxwell *v.* Bostock, (1864) 4 De G. J. & S. 298; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Proctor *v.* Bennis, (1887) 4 R. P. C. 333, 358; Kaye *v.* Chubb, (1888) 5 R. P. C. 641; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328; Patent Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1901) 21 R. P. C. 546–47.

(*c*) p. 75 *ante*.

(*d*) Rex *v.* Else, (1785) 1 W. P. C. 76; Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 561; Potter *v.* Parr, (1815) 2 B. & S. 216 *n.*; Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 366.

(*e*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143; Philpot *v.* Hanbury, (1885) 2 R. P. C. 33, 39.

(*f*) Per James, V.C., Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 365.

(*g*) p. 75 *ante*.

(*h*) See Bovill *v.* Moore, (1815) per Gibbs, L.C.J., Dav. P. C. 404.

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combination. (*i*) A patentee is required to set forth in the complete specification a true account and description of his invention, and it is necessary that he should state what his invention is—what he claims to be new, and what he admits to be old; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole, as new, then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turn out to be old, or the combination itself be not new. (*k*)

Again, if the specification describe both old and new parts without clearly making it appear that that which is old is not claimed, the patentee must be taken to lay claim to all, and the specification will be consequently bad. (*l*) But this rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new. (*m*)

In the case of an invention which is alleged to be an improvement on something which has been done before, it is necessary that the complete specification should state in what the improvement consists. If the invention be claimed as an improvement, and nothing is said of any previous use of which the thing proposed is an improvement, the patent may incur the risk of being construed as a claim of entire and original discovery. (*n*)

In *Holmes* v. *The London and North Western Railway Co.* (*o*) it appeared that the plaintiff had obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's

(*i*) Lister *v.* Leather, (1857) 3 Jur. N. S. 811; 8 E. & B. 1004; Seed *v.* Higgins, (1860) 8 H. L. Cas. 550; Potter *v.* Parr, 2 B. & S. 216 *n.*; Kay *v.* Marshall, (1837) 2 W. P. C. 71; Moore *v* Bennett, (1884) 1 R. P. C. 129; Proctor *v.* Bennis, (1887) 4 R. P. C. 333, 358; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328.

(*k*) Per Abinger, C.B., Carpenter *v.* Smith, (1841) 1 W. P. C. 530.

(*l*) Tetley *v.* Easton, (1852) Macr. P. C. 48.

(*m*) Per Coleridge, J., Macr. P. C. 87.

(*n*) Hill *v.* Thompson, (1818) 1 W. P. C. 247; Leggott *v.* McGeort, (1893) 10 R. P. C. 429, 435.

(*o*) (1852) Macr. P. C. 4; 12 C. B. 831; 22 L. J. C. P. 57.

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patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument, and gave a verdict for the plaintiff, which was, however, ordered by the Court of Common Pleas to be entered for the defendant, on the ground that the specification was bad, as not distinguishing between the new and the old.

So in *Macfarlane* v. *Price* (*p*) the omission of a distinction between the new and old matters mentioned in the specification proved a fatal defect to the plaintiff's patent for "improvements in umbrellas," and in *Saunders* v. *Aston* (*q*) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification. (*r*)

Rule in Foxwell *v.* Bostock.

Lord *Westbury*, L.C., in *Foxwell* v. *Bostock*, (*s*) laid down the rule, as following from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the general description of the entire machine; it must assign the *differentia* of the new combination.

If an improved machine is the result of several combinations, the claims may be so framed that the several combinations leading up to the one principal combination may be themselves divided into several parts in which each specific combination, A, B, and C, may be considered as a separate integer, and each such integer may in itself be the subject of a claim or separate letters patent, and also in their combination the several inventions, A, B, and C, may produce a total result which may also be the subject of a claim or separate letters patent. (*t*)

In *Lister* v. *Leather* (*u*) it was stated by Lord *Campbell*, C.J., and approved by the Court of Exchequer, that if the combination, the subject of the patent, was new and useful, though each of the parts which entered into it were old, still the combination might be the subject of a valid patent, and a patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has often been decided.

(*p*) (1816) 1 Stark. R. 199.
(*q*) (1832) 1 W. P. C. 75.
(*r*) See also Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.
(*s*) (1864) 4 De G. J. & S. 298, 313.
(*t*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 327.
(*u*) (1857) 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

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Further, a valid patent for an entire combination for a process gives protection to each part thereof that is new and material *for that process*, without any express claim of particular parts, and notwithstanding that parts of the combination are old.

Explanation of the rule in Foxwell v. Bostock.

The decisions in *Foxwell* v. *Bostock*, and *Lister* v. *Leather*, deserve careful consideration, and have formed the subject of judicial explanation and comment. First, *Foxwell* v. *Bostock* must not be taken as deciding that where there is a patent for a combination there must be a discovery or explanation of the novelty of each respective part, and that the specification must also show what is the novelty and what the merit of the invention. On the contrary, in the case of a patent for a combination the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which must be proved by evidence. And the claim to it is a sufficient description (*x*). The rule in *Foxwell* v. *Bostock*, when properly explained, really only means that when a claim is made to a general combination and arrangement of the different parts of a machine, if the combination is not new, but there is some particular improvement in some particular part of, or addition to, the parts previously combined, it will not do to claim the whole combination as new, but the patentee must condescend upon that which is improved. For example, if a machine exactly similar to another had been in long use in a particular trade, and some particular improvement, say, in the arrangement of a cog, or in the arrangement of some other portion of an old combination, which was new and useful, or an addition to the known machine, say, of the nature of a gridiron pendulum to a clock, had been made, the general combination remaining the same, then it would be a misdescription to describe it as a new combination, because the thing discovered would be a particular improvement upon a particular part or element of that combination, or an addition thereto, and the patentee must not claim the whole machine but he must indicate and claim the improvement or addition. (*y*)

If it is clear that the claim is for a combination, and nothing but a combination, there can be no infringement of the patent

(*x*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 576, 580; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333; Kynoch & Co. *v.* Webb, (1899) 17 R. P. C. 100; British Shoe Machinery Co. *v.* Thompson, (1904) 22 R. P. C. 198.

(*y*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143; British Shoe Machinery Co. *v.* Thompson, (1904) 22 R. P. C. 198; see pp. 75-80 *ante*.

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unless the whole combination, or such combination of some or all other parts as amounts only to a colourable imitation, be used; (z) and it is in that way immaterial whether any or which of the parts are new. It might, however, be left open on the specification for the patentee to claim not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister* v. *Leather*; in such a case, in accordance with the true meaning of the rule in *Foxwell* v. *Bostock*, it would appear that the specification would be defective if, by merely giving a general description of the whole combination, it left in doubt what claim to parts in addition to the claim to the combination the patentee meant to assert. The specification must not mix up the real novelty with the old parts mentioned, and so render it necessary for a person reading it to get rid of a large portion by eliminating all that is old and commonplace, all that has formed the subjects of other patents and other improvements, before he is able to discover in what the new invention made by the patentee really consists. (a)

*Bowen*, L.J., commenting on the decision in *Foxwell* v. *Bostock*, and in reference to the fact that the case was discussed and distinguished by the House of Lords in *Harrison* v. *Anderston Foundry Co.*, (b) in a subsequent case, said:—

> "When a combination and nothing more is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to be the true law as laid down in *Harrison* v. *The Anderston Foundry Co.*, without a reference to which case *Foxwell* v. *Bostock* ought not to be read, because it is possible to misread *Foxwell* v. *Bostock*, unless you correct your impression of it afterwards by the judgment of the House of Lords, *Harrison* v. *The Anderston Foundry Co.*" (c)

(z) Clark *v.* Adie, (1873) 2 App. Cas. 315, 320; p. 348 *post*.

(a) Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574, 579; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 365; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328; Proctor *v.* Bennis, (1887) 4 R. P. C. 333, 350; Moore *v.* Bennett, (1884) 1 R. P. C. 129; Kynoch & Co. *v.* Webb, (1899) 17 R. P. C. 100; British Shoe Machinery Co. *v.* Thompson, (1904) 22 R. P. C. 177.

(b) (1876) L. R. 1 App. Cas. 574.

(c) Proctor *v.* Bennis, (1887) 4 R. P. C. 358; see also Watling *v.* Stevens,

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The rule in *Foxwell* v. *Bostock*, (*d*) as explained in the foregoing pages, was adopted and applied by the House of Lords in the more recent case of *Kynoch* v. *Webb*, (*e*) where, reversing the Courts below, the House held the patent void on the ground that the patentee had not differentiated his invention from what was old and that, upon its true construction, the claim was not limited to the novel feature of the machine which was the real invention. In *British United Shoe Machinery Co.* v. *Thompson* (*f*) the Court decided that the rule in *Foxwell* v. *Bostock* did not apply to the circumstances of that case, because there the invention was a new arrangement and user of the constituent parts of a known machine in a particular way so as to produce a novel and useful result.

An apparent but not real exception to the rule in Foxwell v. Bostock.

*Harmar* v. *Playne* (*g*) at first sight appears an exception to the rule in *Foxwell* v. *Bostock*, but it is not so. It there appeared that a patent was taken out for a machine, and that the inventor afterwards discovered an improvement and obtained a second patent for the improved machine, describing in the specification the whole machine without distinguishing the improvement. The Court overruled the objection that the specification was bad, saying that the patentee had, in the second specification, recited the first, and that recital being in immediate comparison with the new specification, furnished *in gremis* of the new patent, the means of distinguishing the new from the old. The same point of view was adopted by the House of Lords in the more recent case of *Tubes, Ld.* v. *Perfecta Seamless Tube Co., Ld.* (*h*)

Claim to an entire combination for a process protects all parts new and material for that process.

The marginal note in *Lister* v. *Leather*, if hastily read, is calculated to give colour to the erroneous conclusion that a claim for a combination or arrangement is a distinct claim for everything that is new and material, and goes to make up the combination. A careful consideration of the judgment, however, shows that there is really no warrant for this notion. What the decision really amounts to is a declaration that a valid patent, for an entire combination for a process, gives protection to each part thereof that is new and material *for that process*; which is really nothing more than saying, in

(1886) 3 R. P. C. 153; Keely *v.* Heathman, (1890) 7 R. P. C. 343; Peckover *v.* Rowland, (1893) 10 R. P. C. 118, 234; Patent Exploitation. Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 546.

(*d*) p. 244 *ante*.
(*e*) (1899) 17 R. P. C. 100.
(*f*) (1904) 22 R. P. C. 177, 198.
(*g*) (1809) 11 East, 101; 14 Ves. 130; Dav. P. C. 311.
(*h*) (1902) 20 R. P. C. 77, 87.

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other words, that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question is in every case a question of fact—is it really and substantially a part of the invention? (*i*) If a man is desirous of securing to himself protection by letters patent, in respect of not only the whole, but something less than the whole, of a new arrangement, construction, or combination of parts, he must clearly show that he claims that something less more specifically than by merely describing and claiming the whole. (*k*) If, on the other hand, the invention is for the combination only, and not any of the specific parts, the specification must make it clear that it is the combination, and not any of the specific parts, which is claimed. (*l*)

## The Claiming Clauses.

Distinct claiming clauses are in practice required, but are not absolutely necessary.

Previous to the passing of the Patents Designs and Trade Marks Act 1883, a distinct claim was not a necessary part of the complete specification, but it had long been the practice to insert one, in spite of the fact that it had been held that neither a claim nor a disclaimer was essential; and further, that that which appeared to be the invention, or part of it, would be protected though there were no distinct claim, and those matters which manifestly formed no part of the invention need not be disclaimed. (*m*)

The Act of 1883, however, expressly provides (*n*) that the complete specification must, in every case, end with a distinct statement of the invention claimed, but this provision is only in the nature of a direction, and a failure to comply with it will not invalidate the patent. (*o*) Consequently, it is no more necessary since the Act of 1883 than before it that the complete specification should end with a distinct claim, if what the patentee claims can be gathered from the specification;

(*i*) Per James, V.C., Parkes *v.* Stevens, (1869) L. R. 8 Eq. 365; Clark *v.* Adie, (1873) L. R. 10 Ch. 674; L. R. 2 App. Cas. 315.

(*k*) Clark *v.* Adie, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

(*l*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 17; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570, 578; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 241; Watling *v.* Stevens, (1886) 3 R. P. C. 37; pp. 244-247 *ante*.

(*m*) Lister *v.* Leather, (1857) 8 E. & B. 1004; Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34, 54; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426.

(*n*) s. 4, sub-s. 5.

(*o*) Siddell *v.* Vickers, (1888) 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 148, 163, 389; Tubes, Ld. *v.* Perfecta Seamless Steel Tube Co., Ld., (1902) 2 R. P. C. 77.

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though it must not be forgotten that, independently of the provisions of sec. 5, sub-s. 5, of the Act of 1883, the specification may be so indefinite as to be bad, on the ground that the patentee has not fulfilled the obligation of properly describing the invention for which he claims the protection of the law. (*p*)

A "distinct statement" means something more than a separate paragraph. It should be a concise statement of the main features of the invention, something to which the reader may readily refer, and learn therefrom, without referring to the body of the specification, what are the characteristic features of the invention claimed. (*q*)

Claim operates as a security for the patentee.

The claim is not to be considered as a description of the means of performing the invention, but it is introduced as a security for the patentee. It is evident that the patentee may in the specification have alluded to things which are not new, in his endeavour to describe the invention, and the manner of performing it; in such a case, the claim is introduced, not with the object of aiding the description, but so that the patentee may limit his claim to protection only to such matters as he can prove are his invention and new. (*r*) The real object is not to claim anything which is not mentioned by the specification, but to limit the claim, and, in the language of *James*, L.J.,

> "A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use. He describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says, 'But take notice, I do not claim the whole of that machine: I do not claim the whole of that *modus operandi*, but that which I claim is that which I am now about to state.' That surely is the legitimate object of a claim, and you must always construe a claim with reference to the whole of a specification." (*s*)

(*p*) Siddell *v.* Vickers, (1888) 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 148, 163, 389; Tubes, Ld. *v.* Perfecta Seamless Steel Tube Co., Ld., (1902) 2 R. P. C. 77.

(*q*) Siddell *v.* Vickers, (1888) 5 R. P. C.; L. R. 39 Ch. D. 109; Bancroft's Patent, (1905) 23 R. P. C. 89.

(*r*) Kay *v.* Marshall, (1836) 2 W. P. C. 39.

(*s*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426; see Edison *v.* Woodhouse, (1886) 32 Ch. D. 520; Daw *v.* Eley, (1867) 14 W. R. 126; L. R. 3 Eq. 496; Russell *v.* Cowley, (1835) 1

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A claim is by implication a disclaimer.

It is a frequent practice for a patentee in his specification to state that he does not claim such and such a thing described; but when a clear and distinct claim is made the patentee is not bound further to distinguish between what is claimed and what is disclaimed, for everything which is not included in the claim is thereby disclaimed. (*t*) And, consequently, if a patentee has described in his specification a number of distinct inventions which are all new and useful, but so related as probably to come within one patent, (*u*) and he has chosen to claim only one, he has thereby made a present of the rest to the public, and he can only be protected in respect of the one he has claimed. (*x*) Thus, where a patentee claimed a general combination, and also certain subsidiary parts, the House of Lords held that the claim to those specified subsidiary parts excluded the possibility of a claim for any other parts. (*y*) Again the omission to include an essential part in a combination claim may be fatal on the ground that the combination actually claimed is not useful, and is not subject-matter. (*z*)

Rules to be observed in drafting claiming clauses.

The following are the chief features to be observed in drafting claims:—

I. The claim must not be too extensive, so as to embrace more than the patentee has invented.

II. The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.

III. If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.

IV. A claim to something old, when that claim is not made *in gross*, but only as *appendant* to something new, will not vitiate the patent.

V. A patent for the production of a new and useful

W. P. C. 465; Thomas *v.* Welch, (1866) L. R. 1 C. P. 192; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 401.

(*t*) Harrison *v.* The Anderston Foundry Co., (1876) 1 App. Cas. 574, 579; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 201, 208; Lucas *v.* Miller, (1885) 2 R. P. C. 159; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 721, 741.

(*u*) See Vol. II. p. 8 *post*.

(*x*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; Jackson *v.* Wolstenholmes, (1884) 1 R. P. C. 105; Fairburn *v.* Household, (1886) 3 R. P. C. 263; Parkinson *v.* Simon, (1895) 12 R. P. C. 406.

(*y*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574, 578.

(*z*) Weir *v.* Denny, (1894) 11 R. P. C. 657.

material will not be vitiated by a claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent. Claims.

## I. *The claim must not be too extensive, so as to embrace more than the patentee has invented.*

If the patentee lay claim to anything he has in fact not invented, (*a*) or not described, (*b*) he will thereby render his patent bad, notwithstanding that the specification may describe and claim things which are new and of which he was the undoubted discoverer. Thus, if the specification describe both a machine and a method of using it, and the evidence establish that the machine was old, but that the method was new, the patent cannot be supported, unless the claim is strictly limited to the method of using the machine. (*c*) Again, if the real invention be an ingenious new use of an old and known thing, and the claims are not limited to the new use, but are wide enough to definitely claim the old thing itself apart from the novel application, the patent is void. (*d*) So also a patent is void when upon the true construction of the specification the claim includes both a process and separately an apparatus for carrying it out, and one or other is old. (*e*) If the claim be for a process as carried out by an apparatus, the lack of novelty in the apparatus would no doubt be no objection to the validity of the patent, for there would then be no separate claim to it. (*f*)

Claim which extends to what patentee has not invented or described is fatal.

If the claim, upon a true construction, be for a method as distinct from an apparatus and the method be old, the patent is void; in this connection it is not unimportant to remember

(*a*) Chap. iii., p. 211 *ante;* R. *v.* Else, (1785) 1 W. P. C. 76; Thomas *v.* Foxwell, (1858) 5 Jur. N. S. 37; 6 Jur. N. S. 271; Crossley *v.* Potter, (1853) Macr. P. C. 240; Ralston *v.* Smith, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v.* Kennard, (1856) 2 H. & N. 84; Saunders *v.* Aston, (1832) 3 B. & Ad. 881; 1 W. P. C. 75; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Jordan *v.* Moore, (1866) L. R. 1 C. P. 624; Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; Bailey *v.* Roberton, (1876) L. R. 3 App. Cas. 1055; Cropper *v.* Smith, (1884) 1 R. P. C. 81; Gandy *v.* Reddaway, (1885) 2 R. P. C. 49; Leadbeater *v.* Kitchin, (1890) 7 R. P. C. 235; Kynoch & Co. *v.* Webb, (1899) 17 R. P. C. 100; Dick *v.* Ellam's Duplicator Co., (1900) 17 R. P. C. 196, 200.

(*b*) Monnet *v.* Bock, (1897) 14 R. P. C. 777.

(*c*) Hill *v.* Thompson, (1817) 1 W. P. C. 232; Tetley *v.* Easton, (1852) 2 E. & B. 956.

(*d*) Dick *v.* Ellam's Duplicator Co., (1900) 17 R. P. C. 196, 202.

(*e*) Tolson *v.* Speight, (1896) 13 R. P. C. 718; Kynoch & Co. *v.* Webb, (1899) 17 R. P. C. 100.

(*f*) Tolson *v.* Speight, (1896) 13 R. P. C. 721; p. 260 *post.*

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that references to drawings may be construed as for the purpose of illustration only, and not as having the effect of restricting the claim to a particular apparatus. (*g*) On the other hand, in some cases, the very contrary may be the effect of a reference to the drawings. (*h*) A claim which, *nominatim*, refers to a method may upon its true construction be confined to the method when carried out by a particular machine—*e.g.*, where the method involves the performance of a process which a novel machine, the subject of the other claims is expressly designed to effect, and the only instance of the performance of the process referred to in the specification is that effected by the use of the patented machine. (*i*)

If a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported. (*k*)

*Hill's* patent, for an invention of improvements in the smelting of iron, was rendered void because in the specification he claimed both the usefulness of lime in the process, and the use of a certain specified quantity, whereas it appeared in evidence that the use of lime for the purpose was not new. The patent was therefore declared void, although it might possibly have been good if the claim had been limited to the use of the specified quantity. (*l*)

*Minter's* patent for an improvement in the construction of chairs suffered from a like defect in the specification, and was consequently declared void by the Court when its validity was questioned. It appeared that a chair on the same principle as *Minter's* had been invented before the patent, but encumbered with additional parts, and, unfortunately for *Minter*, the claim in his specification included not only the chair as made by him, but also the former one, and covered, therefore, more than he had invented. In fact, it would, if upheld, have prevented the former inventor from continuing to make the same chair that he had made before *Minter's* discovery.

*Claim to something useless for purpose in view is fatal,*

A claim to something which is useless for the purpose the patentee has in view is fatal. Thus a patent for extracting gold from ore by cyanide of potassium was held bad because the patentee claimed the use of all strengths of solution of

(*g*) See British Motor Traction Co. *v.* Friswell, (1901) 18 R. P. C. 487.

(*h*) See Hattersley *v.* Hodgson, (1904) 21 R. P. C. 517; 23 R. P. C. 192.

(*i*) See Gammons *v.* Battersby, (1904) 20 R. P. C. 540; 21 R. P. C. 322.

(*k*) Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239.

(*l*) Hill *v.* Thompson, (1817) 1 W. P. C. 232.

cyanide, whereas the evidence established that a weak solution alone would do, and a strong solution was utterly useless for the purpose the patentee had in view. (*m*)

but not so a claim to something of limited utility.

On the other hand, a patentee who discovers a valuable invention does not invalidate his patent by a claim for a second purpose less valuable than the main purpose, unless the second purpose has absolutely no utility, or has been anticipated, or required no invention. (*n*)

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent; (*o*) but a claim must be very extensive indeed to justify the Court in saying, without evidence, that it is impossible to sustain a patent based upon it. (*p*)

If the patentee claims more than he has invented, he by so doing makes his patent null and void. But if he thinks he has invented more than he has in fact invented, and describes advantages arising from what is not, as well as what is, his own invention, it does not follow that the patent may not be a good one; for it can be sustained if the invention, as claimed, is so limited as not to cover things in prior use, though it does refer to advantages common to the use of old things and what the patentee has invented. (*q*)

Also an inventor is entitled to claim not only the use of an improved apparatus for the purpose for which he primarily designed it, but also its use for analogous purposes; and it is no objection to such a claim that there are some analogous purposes not mentioned to which the patentee's invention would not be applicable. (*r*)

If the complete specification describe any method of carrying out the invention which will not answer, and so lead the public to perform operations which must necessarily fail, the patent will be bad; (*s*) much more, then, if a distinct claim is made to any such useless method must the patent be void. If the specification claims a number of methods, and any one of them turns out to be bad, the whole patent will be void. (*t*)

(*m*) Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1894) 11 R. P. C. 638; 12 R. P. C. 232, 256; see also p. 164 *ante*.

(*n*) See Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 11.

(*o*) Neilson *v.* Harford, (1871) 1 W. P. C. 355; Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706.

(*p*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706; Wyeth *v.* Stone, 1 Story, 273.

(*q*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 58.

(*r*) Chadburn *v.* Mechan, (1895) 12 R. P. C. 120, 134.

(*s*) p. 208 *ante*.

(*t*) Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.

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## II. *The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.*

Purely speculative claims may prove fatal.

The law will allow a patentee to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but it will not allow him to claim that which is the mere subject of his speculation and imagination, or of his endeavouring to possess more than he is entitled to; and while the Court is bound to give as far as possible the fullest effect to an invention, it is also equally bound to oppose endeavours to make a patent embrace matters that were never in the head of the inventor. (*u*) Moreover, a claim which is general may not entitle a man to improvements of which he was ignorant at the date of the patent. (*v*)

In the language of *Pollock*, C.B., the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves especially to one good thing, and *a jury will always take care that if that be* the real invention no man under colour of improvement shall be allowed to interfere with that which is the offspring of their genius. (*x*)

*Pollock*, C.B., also, in a case where a patentee in his specification had described the use of atmospheric air in a particular way to charge a certain portion of his machinery, and stated: "If any gases or elastic media, other than atmospheric air, are used, with which to charge the case, I claim the sole right to do so," directed a jury that the patentee had, in point of law, no right to make such a claim, and that the law would not permit a patentee to claim more than he had invented. The learned Baron told the jury that a statement in the specification to the effect that the patentee proposed to construct a certain wheel of every variety of configuration, so long as it was constructed with a channel in the interior, would not do. It appeared that the defendant had used a wheel with *curved* hollow arms, and the patentee desired to treat this as an infringement of his wheel, in which the arms were not curved, but, as the curving of the arms was a further invention and improvement, the patentee's claim failed. To hold that it was good would be to reward a man who had rashly and ignorantly taken out a patent on a subject he

(*u*) Tetley *v.* Easton, (1852) Macr. P. C. 48, 76.

(*v*) p. 353 *post*.

(*x*) Crossley *v.* Potter, (1853) Macr. P. C. 256.

had not appreciated. (*y*) His Lordship's direction was, probably, unsound. (*z*) **Claims.**

If the patentee claims to perform an operation by the use of one or more of several substances, some of which will not answer, and the claim is so ambiguous that it may be read as including those which will not do as well as those which will do, the patent will be void. (*a*) A claim which is so ambiguous that it may be read as including what will not answer the purpose in view as well as what will, is fatal.

The following important cases may be given as illustrating this point (*b*) :—

*Stevens* v. *Keating*, (1847) 2 W. P. C. 181, was an action brought to restrain the infringement of two patents belonging to the plaintiff, one of which related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated that "other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth;" and then claimed "the process of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning or calcining the same for the purposes hereinbefore set forth." It was proved at the trial that, though there were certain acids other than sulphuric that would answer, there were other acids that would not answer the purpose of the patentee at all; and *Pollock*, C.B., directed the jury that if the construction was that every acid was claimed, then all acids would not do, and the specification was bad; and if the construction was that some acids were claimed beyond sulphuric acid the patentee did not say whether that was claimed which would do or that which would not do, and to take it, as he in his second specification explained, he said, "I claim all that will succeed." No person can be allowed to take that course, and to say, "Whereas other substances will succeed, I claim all those substances that may succeed." (*c*) And his Lordship directed a verdict for the Examples. Stevens *v.* Keating.

(*y*) Tetley *v.* Easton, (1852) Macr. P. C. 48.

(*z*) See p. 353 *post*.

(*a*) Stevens *v.* Keating, (1847) 2 W. P. C. 181; Tetley *v.* Easton, (1852) Macr. P. C. 48; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312; Ralston *v.* Smith, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v.* Kennard, (1857) 2 H. & N. 84; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 480; Saunders *v.* Aston, (1832) 13 B. & Ad. 881; 1 W. P. C. 75 *n.*; Kurtz *v.* Spence, (1888) 5 R. P. C. 161; Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671; 15 R. P. C. 421.

(*b*) See also other cases *ibid.*

(*c*) (1847) 2 W. P. C. 181.

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Hills *v.* London Gas Light Co.

defendant on the issue of the sufficiency of the specification, which was upheld by the Court of Exchequer.

In *Hills* v. *London Gas Light Co.*, (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409, the plaintiff in his specification claimed the use of "hydrated *or* precipitated oxide of iron" for the purification of gas. It was proved that some of the hydrated oxides of iron would not effect the purpose the patentee had in view. It was objected on behalf of the defendant that the claim included all hydrated oxides of iron, and was therefore bad. The Court of Exchequer, however, admitted that the language was not accurate, but, in its desire to uphold the patent, decided that the patentee meant to refer to such hydrated oxides as were precipitated.

In *Bailey* v. *Roberton*, (1878) L. R. 3 App. Cas. 1055, 1078, it was held by the House of Lords that a claim to the use of "the alkaline and earthy sulphites" in a specification under a patent for improvements in preserving animal substances would be bad, on the ground of ambiguity, where it appeared that some of the earthy sulphites are poisonous, and that some of the alkaline sulphites possess properties which render them unsuitable for the purpose the patentee had in view. Such a claim would be too wide and vague, and the specification ought to define more precisely the materials to be used, which, as a matter of fact in the particular case, it did.

In *Booth* v. *Kennard*, (1856) 2 H. & N. 84; 26 L. J. N. S. Ex. 23, 305, *Booth's* patent for "improvements in the manufacture of gas" was declared to be invalid, on the ground that the claim was a claim, not to any particular mode of manufacturing gas from seeds, but to the manufacture of gas from seeds however carried out.

### III. *If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.*

If protection is desired for subordinate parts alone, they must be claimed separately.

It is evident that an invention may consist of any number of different parts—A, B, C, and D—of which A may be a totally new thing, and B may be a combination of things which in themselves are perfectly old, but which have never been combined in that particular way before, and C and D may be old parts. Now, in such a case, the inventor would in law be entitled to protection, both in respect of the whole invention, consisting of the combination A, B, C, and D, and also in respect of the subordinate inventions A and B; but he would not obtain such protection in respect of the subordinate parts

alone by laying claim to the combination of the four elements. He must, if he desire it, specifically claim protection in respect of the new subordinate integers of the larger invention. (*d*)

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In considering the above paragraph, the reader must be careful to notice that the integers of the supposed invention are perfectly distinct and separate from the combination A, B, C, D, as a whole. A claim to a combination will no doubt protect the patentee against the use of any of the elements of that combination, if the use of such elements, either alone or together with others, would amount to only a colourable departure from the patentee's specified combination; (*e*) and very little merit will do to support a claim to a subsidiary part of a great invention. (*f*)

*Clark* v. *Adie* is the leading case which illustrates the fact that a patentee who does not properly claim all he may be entitled to claim thereby loses protection in respect of subordinate parts which he might legitimately have claimed. It is the leading authority for the proposition that the patentee is not protected against the use by others of what he might have claimed, but what he has, upon a fair construction, whether from timidity or any other cause, in fact not claimed. The case may be epitomised from this point of view as follows:—

Patentee is protected only in respect of what he actually claims—not in respect of what he might have claimed.

In *Clark* v. *Adie*, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315, it was alleged that the defendant had infringed a patent for "improvements in apparatus for clipping or shearing horses," granted to one *Grayson*, but at the date of the action the property of the plaintiff, *Clark*, by purchase. The specification described the instrument or clipper by reference to drawings, and showed a fluted guide or comb-plate, with a straight edge, like a musical-box comb, the points of the teeth being tapered so as to be raised a little above the surface. A thin plate of steel, with V-shaped cutters, traversed to and fro over the comb, being guided by steerers working in rectangular slots, cut parallel to its edge. The drawings showed the cutter-bar in plan and section, the latter view representing it as somewhat arched or convex in the middle, so as to take its bearing only at the edges. The specification, however, did not allude by any words of description to this peculiarity of form. The two handles were

Clark *v.* Adie is the leading case on this point.

(*d*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 320, 321; Cropper *v.* Smith, (1884) 1 R. P. C. 87.

(*e*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 320; pp. 245-246 *ante*.

(*f*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

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pivoted on a strong stem, set in a square hole in the comb-plate, and secured by a nut on the screwed end of the stud. One of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions, to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the comb could be regulated by means of nuts and washers. By the removal of the nuts on the stems and stud, the instrument could be readily taken to pieces.

The claim was in the following terms: "The general arrangement, construction, and combination of parts, whereby I am enabled to construct an apparatus for clipping and shearing horses and other animals, in such a manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animals: and whereby the shearing or clipping may be regulated to the exact extent required, without shaving the hair too closely, and, without injuring the animal, leaving a smooth surface without marks, the apparatus being capable of being taken to pieces and adjusted for sharpening or renewing the cutter-bar, or for other purposes, all substantially as herein specified and shown."

It appeared that the plaintiff had bought *Grayson's* patent in order to free himself from any interference in respect of a horse-clipper, made by himself but not patented, which incorporated the arched cutter-bar, the movement thereof parallel to the line of the comb, and the substitution of strong stems secured by nuts and washers instead of being screwed into the comb-plate, but which did not resemble *Grayson's* instrument in other respects.

The alleged infringement consisted in the making of horse-clippers in exact imitation of those brought out by *Clark*, as above stated, and it was contended that there had been infringement of *Grayson's* patent in four particulars—viz., (1) In the use of fixed stems which could not be shaken loose; (2) In applying nuts and washers to the tops of the fixed stems above the cutting plate so as to adjust the friction; (3) In forming the cutter-plate in an arch and thereby rendering it elastic; (4) In the mode of communicating motion to the upper or cutting plate, so as to bring it to the true line of cutting. It was argued that, although the defendant had not copied the whole of the apparatus patented, yet he had taken so much of that which was the pith and marrow of it as to make up a subordinate integral part of the invention, and that by taking such subordinate integer, which was in itself matter of protection, he had infringed the patent.

*Bacon*, V.C., decided the case in favour of the plaintiff, but

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the Court of Appeal and the House of Lords both decided that the defendant, not having taken anything claimed by the patent, had committed no infringement.

Lord *Cairns*, L.C., pointed out that the subordinate integer which was said to be protected, and which the respondent was alleged to have taken, was described as consisting of four different matters—viz., in the first place, what was called the fixed stems, springing from the under or comb-plate, which could not be shaken loose; in the second place, the nuts and washers applied to the top of those fixed stems, above the cutting plate, so as to adjust the friction; in the third place, the shape of the cutter-plate made in an arch, by which the bearing of the cutter-plate upon the comb-plate was better adjusted; and fourthly, the mode of communicating the motion to the upper or cutting plate, so as to bring it to the true line of cutting. In reference to the third of these items, his Lordship said that he had read with great care the specification of *Grayson*, and there was not a word in the letterpress of that specification, from beginning to end, which referred in any shape or form to the arching of the cutter-plate or to the advantage to be derived from that arching; and in answer to a suggestion of the appellant's counsel that the arch form of the cutter-plate was designed in order to bring into play elasticity as produced by the arching, his Lordship pointed out that the cutter-plate was adjusted and fitted to a solid rigid bolt at the back thereof, which restrained any elastic yielding, and stated that he was compelled in the first place to put aside altogether the idea of the advantage of the elasticity of the cutter-plate as an afterthought, which was in no way present to the mind of the patentee. It might be an advantage, but if it was an advantage it was an advantage which subsequent practice and experiment had brought to light, and it was not an advantage which appeared to suggest itself to the mind of the patentee when he made the specification.

In reference to the remaining three items which were alleged to produce the combination, his Lordship remarked that each of them was not, in itself, a new invention, but an old step well known in the making of a clipper, and said: "I have read and re-read, with the greatest anxiety, the specification in the present case. I cannot find from beginning to end of it any sentence or any number of sentences as to which, by any reasonable interpretation, you can say that they make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture, a thing to be protected by the patent." The House agreed with the conclusions arrived at by the *Lord Chancellor*, and decided in favour of the respondent.

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IV. *A claim to something old, when that claim is not made in gross, but only as appendant to something new, will not vitiate the patent.*

Subsidiary claims to old things.

A claim which is only subsidiary, even though the thing claimed is old, will not vitiate a patent if it is within the main claim or is only for one of the merits and advantages of the entire construction which the patentee has described, and does not enlarge the monopoly; but if the alleged subsidiary claim really enlarges the main claim and is for something old, then it will be fatal. (*g*)

A claim which is subsidiary to the main claim may be really surplusage as being consequentially protected by the main claim. The patentee should avoid the objection of surplusage in drafting the specification, as he may thereby place himself in an unnecessary position of difficulty should he be called upon to support his patent in a court of law. This will appear from the judgment of Lord *Hatherley* in *British Dynamite Co. v. Krebs* (*h*) quoted below. (*i*)

Leading cases.

The above stated principles, which are often of vital importance, are illustrated by the leading cases given in epitome as follows:—

British Dynamite Co. *v.* Krebs.

In *The British Dynamite Co.* v. *Krebs*, (1875) G. P. C. 88; 13 R. P. C. 190, it was sought to upset a patent for "improvements in explosive compounds, and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into a powder which I call *dynamite* or *Nobel's* safety powder. By this absorption of the nitro-glycerine in some porous substances it acquires the property of being in a higher degree insensible to shocks, and it can also be burned over fire without

(*g*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 21; 40 L. J. Ch. 317; Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 286; 6 Ch. D. 412; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 94; 13 R. P. C. 190; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437; Parker *v.* Satchwell, (1901) 18 R. P. C. 299.

(*h*) 13 R. P. C. 196; see also Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 180.

(*i*) p. 262 *post*; see also Thompson *v.* American Braided Wire Co., (1889) 6 R. P. C. 528; Fawcett *v.* Homan, (1896) 13 R. P. C. 398, in judgment of Rigby, L.J., p. 410; Van Berkel *v.* Simpson, (1906) 23 R. P. C. 237.

exploding. The aforesaid safety powder or dynamite is exploded: *First*, when under close or resisting confinement, by means of a spark or any mode of ignition used for firing ordinary gunpowder. *Secondly*, without or during confinement by means of a special fulminating cap, containing a strong charge of fulminate, which is adapted to the end of a fuse and is strongly squeezed to the latter for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation. *Thirdly*, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off even when it is only partially confined. Claims.

"*Claim:* I claim, as the invention secured to me by letters patent as aforesaid, the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth."

*Fry*, J., on trying the case, gave judgment for the plaintiff, with costs, but the Court of Appeal (*Jessel*, M.R., *James* and *Thesiger*, L.JJ.) reversed the order and dismissed the action, with costs, on the ground of the insufficiency of the specification and that the claim, in so far as it claimed the modes of firing the dynamite by special ignition set forth, claimed that which was not new. On appeal, however, to the House of Lords, the order of the Court of Appeal was reversed, and the order of *Fry*, J., was restored, with costs to the appellants, on the ground that the specification was sufficient, and that the patentee did not claim the means of explosion *in gross*, but only as *appendant* to dynamite.

Earl *Cairns*, L.C., speaking on the question of the extent of the claim, made the following instructive observations (13 R. P. C. 193): "I will assume that the modes of firing by special ignition, or some of them, were known before the date of the patent, and therefore that if the patentee claimed them as independent inventions (inventions, if I may use the expression, *in gross*), his claim would be too large and his patent void. But is that what he here does or means to do? It is to be observed that the mere manufacture of an explosive substance, such as dynamite, would not, *per se*, have constituted an invention, or, at all events, a useful and practical invention, which could be protected by a patent. An explosive substance like dynamite would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . I look upon the means of explosion, even assuming them to be known as applicable to the other substances, to be part and parcel of the invention, which the patentee was bound to give to the public as a complete invention, and I

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understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed, under this patent, to claim them for any other purpose. In other words, he claims, in the first claim, the dynamite, the substance itself; and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the use of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

Lord *Hatherley* upon the same point spoke as follows (13 R. P. C. 196):—

"The patentee having, as I have said, discovered a material which will not go off at a moment's notice, it is necessary to show that it will go off somehow or other. And in order that you may know how it will go off the patentee must tell you how to set it off. If he has discovered it he is bound to tell you the best way of doing it. Mr. *Nobel* accordingly tells you that one mode, amongst other modes, is by a percussion cap. That is a mode which has been used for exploding gunpowder and other things, but which, he said, he found would explode this new material called 'dynamite.' Having described his invention, he says in his claim at the end: 'I claim as the invention secured to me by Letters Patent as aforesaid the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth.' It is a mode of 'special ignition.' He claims the mode of manufacturing safety powder or dynamite and the 'modes of firing the same,' that is the dynamite. The worst that can be said in the way of objection to this is that there is surplusage. The objection of surplusage must be admitted to be one which ought, no doubt, to be very carefully avoided by a patentee. The most that can be said adverse to the patent here is that the patentee might have been quite content to sit still and say: 'Now I have shown you how to make the dynamite. I have shown you what the dynamite is, and I have shown you how to set it off; that is the invention,' without mentioning the firing in the claim. But then, as was well urged by the learned counsel in argument, it cannot be said that this claim deprives any human being, past, present, or to come, of any possible right they might otherwise acquire, because they could not acquire any right in the dynamite without laying themselves open to an

infringement of the letters patent in respect of the use of the dynamite. It is the firing of the dynamite, and only dynamite, in this peculiar mode that is claimed; and you must make use of the patentee's dynamite before you can explode it. He says, 'I am not going to tell you a useless thing. If I did not tell you how to ignite it, you might say that my dynamite is useless, because when it is put in a quarry it will not go off at all, and so I tell you here is my dynamite, and here is my means of igniting it; if you are willing to pay me for it I will hand over to you the full benefit of my invention, first the mode of making the material itself, and then the mode of setting it off.'" Claims.

In *Plimpton* v. *Spiller*, (1875) 4 Ch. D. 286; 6 Ch. D. 412, it appeared that *Plimpton's* specification for the roller skate stated that the invention related to an improvement in attaching the rollers or runners to the stock or footstand of a skate whereby the rollers or runners were made to turn or cant by the rocking of the stock or footstand so as to assume radii of a circle, and facilitate the performing with ease gyrations or evolutions without taxing unduly the muscles of the foot or ankles. The specification then went on to describe the construction of the skate as a whole, including a description of a mode of attaching the runners and making them reversible, and the two claims were: (1) Applying rollers or runners to the stock or footstand of a skate, as described, so that the said rollers or runners may be cramped or turned, so as to cause the skate to run in a curved line, either to the right or left, by the turning, canting, or tilting of the stock or footstand. (2) The mode of securing the runners and making them reversible as above described. It was held by the Court of Appeal that the want of novelty in the method included in the second claim would not vitiate the patent, as this only amounted to a claim to one of the merits and advantages of the entire construction which the patentee had described, and not in any way to a claim which would enlarge the monopoly secured under the first claim. Plimpton v. Spiller.

In *The United Telephone Co.* v. *Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, one of the questions in issue was whether the claim in the plaintiff's patent, which was in the words, "In an instrument for transmitting electric impulses by sound, a diaphragm or tympan of mica, substantially as set forth," amounted to a claim for the mica diaphragm or tympan in all instruments for transmitting electrical impulses by sound, in which case it would be bad, as being merely a claim to the application of an old thing to a particular purpose, without the use of any ingenuity in that application; or whether it was a claim only to the mica diaphragm or tympan in the particular instrument for transmitting electrical impulses by United Telephone Co. v. Harrison.

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sound described in the specification. *Fry*, J., was of opinion that the claim related only to the mica diaphragm in combination with the rest of the instrument, and that the specification was good in regard to that objection. This ruling was upheld by the Court of Appeal, consisting of *Jessel*, M.R., *Lindley* and *Bowen*, L.JJ.

Some subordinate claims are fatal.

It is important to bear in mind that the above statements of the law merely relate to the construction of the specifications in certain particular cases. When there are separate claims for different combinations, the first being for a general combination and the others for combinations of some of the integers which constitute the general combination, it is not right to say that the smaller claims are only to be considered as pointing out what the patentee considers material. On the contrary, when there are more than one separate claim, the first of which is for a general combination, the others may be separate and independent claims for subordinate combinations which will render the patent void if those subordinate parts or combinations are old. (*l*)

V. *A patent for the production of a new and useful material will not be vitiated by a further claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.*

Claim to a use of a new material may be good though the use in itself is not subject-matter.

Thus, in *Betts* v. *Neilson*, (*m*) it was objected (*inter alia*) to *Betts'* patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," that the manufacture of capsules from the patented material was not the subject-matter of a patent. (*n*)

The specification claimed, *First:* "The manufacture of the new material, lead combined with tin on one or both of its surfaces, by rolling or mechanical pressure, as herein described. *Secondly:* The manufacture of capsules of the new material of lead and tin combined by mechanical pressure as herein described."

*Wood*, V.C., the Lords Justices, Lord Chancellor *Chelmsford*, and the House of Lords, all separately held that the objection to the validity of the patent on the ground of the second claim

(*l*) Cropper *v.* Smith, (1884) 1 R. P. C. 88, 90, 91; Murchland *v.* Nicholson, (1893) 10 R. P. C. 417; Electric Construction Co. *v.* Imperial Tramways Co., (1900) 17 R. P. C. 537, 549, 552.

(*m*) (1868) L. R. 3 Ch. 429; 5 H. L. 1.

(*n*) See p. 80 *ante*.

was invalid, and awarded the plaintiff damages in respect of infringements committed by the defendant. Construction.

Lord *Westbury*, addressing the House of Lords, said :—

"The last objection to the patent is one of a very material character; it is this: that after having described the process and the material, and claiming the material as the result of the process, so that the material is not claimed independently of the process, nor the process independently of the product, the specification concludes with a claim of the manufacture of capsules out of the material. But the manufacture of capsules out of the material would be one purpose only to which the material could be applied; and if a claim to the material can be substantiated by the patent the specification of a particular use of it, comprehended in the general uses claimed, cannot for a moment be accepted as a ground for vitiating the patent."

## Construction of the Specifications.

Construction of the specifications is usually necessary in legal proceedings.

During the course of proceedings in which the validity of a patent is contested, it usually becomes necessary to decide, first, whether or not the specification is sufficiently explicit in its directions to enable a person to whom it is addressed to perceive what is the exact invention covered by the patent, and how to carry that invention into practical operation; and, secondly, what is the true construction to be put on the language of the specification when its meaning is dubious, and more than one interpretation is possible. The determination of the first question, which is one of fact, is for the jury, if there be one, otherwise for the Judge acting as a jury. (*o*) The determination of the second question is one of law, and is in all cases for the Court alone. (*p*) The Judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result. (*q*)

Sufficiency is a question for the jury: construction is for the Court.

(*o*) Walton *v.* Bateman, (1842) 1 W. P. C. 621; Beard *v.* Egerton, (1846) 8 C. B. 165; 19 L. J. (N. S.) C. P. 36; Hill *v.* Thompson, (1817) 1 Web. P. C. 237; Bickford *v.* Skewes, (1837) 1 Q. B. 938; Neilson *v.* Harford, (1841) 1 W. P. C. 370; Wallington *v.* Dale, (1852) 7 Exch. 888; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358; L. R. 5 Ch. App. Cas. 36.

(*p*) Hill *v.* Evans, (1862) 31 L. J. Ch. 460; Neilson *v.* Harford, (1841) 1 W. P. C. 370; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 91; 13 R. P. C. 190; R. *v.* Wheeler, (1830) 2 B. & Ald. 345; Seed *v.* Higgins, (1860) 8 H. L. Cas. 561; Bovill *v.* Pimm, (1856) 11 Ex. 740.

(*q*) Per Cresswell, J., Beard *v.* Egerton, (1849) 19 L. J. (N. S.) C. P. 38: see also Neilson *v.* Harford, (1841) 1 W. P. C. 370.

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Test of sufficiency.

The "ordinary workman" test (*r*) is the proper one to employ for the purpose of settling the question of sufficiency, as is manifest from the following words of Lord *Lindley*, then Lord Justice *Lindley*, taken from the judgment of the Court in *Edison and Swan Electric Lighting Co.* v. *Woodhouse*.(*s*) "If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court, and not for a workman, to construe the specification; but, if a workman says it is sufficient guide to him, and the Court believes him, the Court must hold, as regards clearness of description, the specification is, in point of law, sufficient." (*t*)

When the language used in a claiming clause, either directly or by reference to the body of the specification, is dubious, the point of construction should, logically, be determined before the other issues raised in the action are gone into; but for obvious reasons this course is rarely practicable under the present practice. (*u*)

Interpretation of language used in specifications.

The Court in construing specifications gives to their language the ordinary meaning, unless there are circumstances to show that any word or expression is a term of art, and would be understood by the person to whom the specification may be supposed to be addressed in a particular sense. It is a well-established rule that the Court will receive and consider evidence as to the exact sense in which the patentee intended a word or expression to be understood, and will give full effect to such meaning in the construction of the specification. (*x*)

The Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate. (*y*)

In construing specifications it is often important to remember that human language is, after all, an imperfect instrument for the embodiment of human thought. Both the

(*r*) See p. 217 *ante*.
(*s*) (1887) 4 R. P. C. 108.
(*t*) See also per Halsbury, L.C., Tubes, Ld. v. Perfecta Seamless Steel Tube Co., Ld., (1902) 20 R. P. C. 95, 96.
(*u*) British Motor Syndicate *v.* J. E. H. Andrews, (1899) 16 R. P. C. 586, 587; 18 R. P. C. 93.
(*x*) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 91; 13 R. P. C. 190; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 436; Neilson *v.* Harford, (1841) 1 W. P. C. 313; Elliott *v.* Turner, (1845) 2 C. B. 446; Walton *v.* Potter, (1841) 1 W. P. C. 595; Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581.
(*y*) Per Pollock, B., Kaye *v.* Chubb, (1887) 4 R. P. C. 299.

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context and the subject-matter dealt with must often modify and expound the meaning of a word—*e.g.*, it would be an intelligible distinction to say that Mont Blanc was a flat mountain compared with Monte Rosa, which is a sharp peak, though Mont Blanc is not flat and Monte Rosa is not sharp, in the sense of the word sharp, when a knife or razor is spoken of. (*z*)

Technical terms.

It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes requiring the aid of the light derived from surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words in technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described, are all matters of fact, upon which evidence may be given, and contradictory testimony may be adduced, between which it is for a jury to decide. (*a*)

The Court ought to construe the specification like all written instruments, taking the words, and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification which is addressed, not to the world at large, but to a particular class—for instance, skilled mechanicians, possessing a certain amount of knowledge—it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanicians, and to see what the words of the specification mean when applied to such a subject as skilled mechanicians would know, and then to say what the words of the specification mean when applied to such a subject-matter. (*b*)

The patent for the preparation of Lanolin (*c*) affords a good instance of the application of this principle. In that case one of the alternative processes for the further purification of raw Lanolin described was dissolution by a *solvent*, and amongst other solvents specifically mentioned was methylated spirit. The defendants contended that this was not a useful solvent,

(*z*) See per Halsbury, L.C., Leeds Forge Co., Ld. *v.* Deighton's Patent Flue and Tube Co., Ld., (1904) 21 R. P. C. 494.

(*a*) Hill *v.* Evans, (1862) 31 L. J. Ch. 460.

(*b*) Per Lord Blackburn, Clark *v.* Adie, (1873) L. R. 2 App. Cas. 436; see also Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Simpson *v.* Holliday, (1866) 13 W. R. 577; L. R. 1 H. L. 315; Edison *v.* Holland, (1888) 5 R. P. C. 474.

(*c*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1894) 11 R. P. C. 93, 261.

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as, though it might dissolve impurities and so be useful as a purifier, it did not dissolve except with difficulty the pure cholesterine fats, and they said that according to the strict wording of the specification a person would gather that all the raw Lanolin was to be dissolved. *Romer*, J., decided at the trial that, upon the evidence adduced as to the scientific meaning of the word *solvent* and upon the true construction of the specification, the solvent referred to was to be used as a purifier according to its known properties, and no one would imagine that in every case it was essential to dissolve the whole of the raw Lanolin, and the Judge being satisfied that it could be used usefully as a purifier, though not so efficaciously as some of the other solvents specifically mentioned, the objection against the validity of the patent therefore failed. The patent was also upheld by the Court of Appeal.

Even in cases where it is sought to establish that an invention described in a specification is not new by reason of the existence of a prior specification, which, it is alleged, describes the same invention, the Court will not, without evidence, assume that words or terms of art, which are common to the two specifications, bear in each the same meaning, but will receive and consider evidence on the point. (*d*)

Variations in meaning.

It is impossible to predict, of two documents framed at different periods, that the terms of art common to the two had the same signification, and indicated the same identical thing at the date of each respectively, for terms of art are liable to constant change of meaning with the progress of science and invention; and the cases establish that the identity of signification between two written documents containing the same description must belong to the province of evidence, and not to the province of construction. (*e*)

Spirit in which specifications should be construed.

The former practice of construing specifications very strictly against the patentee and in favour of the Crown, which was indulged in by Judges who had not freed themselves from the general prejudice against monopolies of all kinds and did not accept the view that patents for useful inventions are to be encouraged on the ground of public policy, drew from Lord

(*d*) Thomas *v.* Foxwell, (1858) 5 Jur. N. S. 37; Robertson *v.* French, (1803) 4 East, 135, 136; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117, 152; Hill *v.* Evans, (1862) 6 L. T. N. S. 70; Neilson *v.* Harford, (1841) 8 M. & W. 806; 1 W. P. C. 331; Hills *v.* The London Gas Light Co., (1857) 5 H. & N. 312; Jupe *v.* Pratt, (1837) 1 W. P. C. 141; Walton *v.* Potter, (1841) 1 W. P. C. 585; Steiner *v.* Heald, 6 Exch. 607.

(*e*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 152.

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*Tenterden*, C.J., (*f*) the remark: "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them;" and from *Barry*, L.J., (*g*) the comment following: "I would wish to have made some observations upon the propositions of law and the authorities which have been so strongly pressed upon us, but which, in my opinion, seem to indicate, on the part of the source from which they emanate—I do not mean counsel at the bar, I mean the cases that were cited—a seeking for technical reasons for defeating the protection that a man is entitled to for the results of his industry, his skill, and his talent, rather than to promote any interest of the public. It seems to me that we hear a great deal too much about the danger of monopoly, and allowing the public to be deprived of the benefit of inventions. It seems to me that we ought rather to endeavour to give the public the benefit of an invention by protecting the inventor when he has invented something good."

Nothing is to be intended either in favour of a specification or against it.

It is now a rule of construction accepted by the Courts that nothing is to be intended either in favour of a specification or against it, but that it is to be dealt with just as it appears, and a true and right and fair construction is to be put upon every allegation and every fact connected with it, such construction being neither a benign nor a strict one. (*h*)

It may at one time be the interest of the patentee to endeavour to induce the Court to put a wide construction on the specification, so that it may be held to include and claim a particular thing, which an alleged infringer uses, and at another time it may be to the advantage of the patentee to obtain a narrow construction, so that the specification may be held not to include something which is old. (*i*) Whether it is for the interest of one side or the other, it is the duty of the Court to fairly construe the specification, neither favouring the one side nor the other: neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent, if

(*f*) Huddart *v.* Grimshaw, (1803) 2 B. & Ald. 377.

(*g*) Dowling *v.* Billington, (1890) 7 R. P. C. 203.

(*h*) Stevens *v.* Keating, (1847) 2 W. P. C. 187; Russell *v.* Cowley, (1832) 1 W. P. C. 465; 1 Cr. M. & R. 864; Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581; Young *v.* Rosenthal, (1884) 1 R. P. C. 33; Westinghouse *v.* The Lancashire and Yorkshire Ry. Co., (1884) 1. R. P. C. 229.

(*i*) Stevens *v.* Keating, (1847) 2 W. P. C. 194; Downes *v.* Falcon Works, (1886) 3 R. P. C. 70; Kaye *v.* Chubb, (1887) 4 R. P. C. 289; Hutchinson *v.* Patullo, (1887) 4 R. P. C. 329; Gosnell *v.* Bishop, (1888) 5 R. P. C. 151, 158; Ellington *v.* Clark, (1888) 5 R. P. C. 319, 327.

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it is said that the patent is void, nor putting an unfair gloss or construction upon it in order to extend the patent, and make it take in something which might be thought to be an unhandsome taking of the fruits of his invention from the patentee, if it is not really an infringement of the patent. (*k*) The Courts endeavour to hold a fair hand between the patentee and the public, being willing to grant to the patentee on his part the reward of a valuable patent, but taking care to secure to the public, on the other hand, the benefit of the provision that the patentee must clearly define both the invention and the method of performing it. (*l*)

*Construction must be logical, fair, and impartial.*

The construction of the specification must be logical, fair, and impartial. It is proper for the Courts, seeing that patents for a limited period operate as an encouragement to the production of useful inventions, of which the public get the benefit after the monopoly is expired, to endeavour, if it can fairly and honestly be done, to support the patent, and to adopt a construction of the specification which will give it validity when it can fairly be interpreted so as to achieve this result. (*m*)

*Doctrine that patentee would not intend to claim anything which would render the patent void.*

The adoption of such a construction, though it supports the validity of the patent, not unfrequently tells against the plaintiff on the question of infringement. (*n*)

It is a proper assumption to make that a patentee would not be so absurd as to claim anything which would render his grant void; for instance, anything which he knew, or which he was aware everybody else knew, to be old; and the Court will avoid such an absurdity if by any legitimate construction of the words used it can do so. (*o*)

Thus in *Neilson* v. *Harford* (*p*) on a motion being made to the Court of Exchequer to enter a verdict for the plaintiff on the issue of sufficiency of the specification, the question arose as to the proper construction to put on the statement that "the shape of the receptacle is immaterial to the effect, and

(*k*) Per Lord Blackburn, Dudgeon *v.* Thompson, (1877) L. R. 3 App. Cas. 53; see remarks of Tindal, C.J., Haworth *v.* Hardcastle, (1834) 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

(*l*) Neilson *v.* Harford, (1841) 1 W. P. C. 310.

(*m*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 612; 46 L. J. Ch. 185; Plimpton *v.* Spiller, (1876) L. R. 6 Ch. D. 422; Russell *v.* Cowley, (1832) 1 Cr. M. & R. 864; 1 W. P. C. 460; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297, 307; Morris *v.* Young, (1895) 12 R. P. C. 463.

(*n*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671.

(*o*) Clark *v.* Adie, (1873) L. R. 3 Ch. D. 142; Electric Construction Co. *v.* Imperial Tramways Co., (1900) 17 R. P. C. 547.

(*p*) (1841) 1 W. P. C. 331.

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may be adapted to the local circumstances." The invention consisted in the application of hot air to the blast furnace, and the receptacle above referred to was the chamber in which the air was to be heated before being passed into the furnace. The jury in the Court below had found that the shape and form was material to the effect—*i.e.*, to the extent of beneficial effect—produced, not to producing some effect, for some beneficial result would be produced from any shape, but as to producing the extent of beneficial effect the form and shape was material. If the proper construction of the patentee's statement was that the shape of the receptacle was immaterial to the degree of effect in heating the blast, in the face of the finding of the jury, the specification would be bad as containing a false statement in a material circumstance, of such a nature that, if literally acted upon by a competent workman, it would mislead him and cause the experiments to fail. *Parke*, B., who tried the case in the Court below, was at first of opinion that this was the proper construction, but in the Court of Exchequer he concurred in the opinion of the other Judges, that from the context of the specification, taken as a whole, the word "effect" might reasonably be construed to mean "beneficial effect," and that such meaning ought to be adopted, as it would support the patent. This latter being the proper construction, and the jury having found as a matter of fact that any shape in which the air-vessel could reasonably be expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery, the Court was of opinion that the verdict ought to be entered for the plaintiff on the issue of sufficiency, and consequently the patent was upheld on this point.

Again, in *Oxley* v. *Holden* (*q*) the question was as to the true meaning in the specification of the words, "I claim the metal fittings and the mode of applying the same described herein as the second part of my invention." If these words meant that the patentee claimed separately the metal fittings themselves and the mode of applying them, the evidence showed that the metal fittings had been anticipated and published; but if the true construction was that the claim was for the metal fittings and the mode of applying them, as one part of the invention, then the patent would be good as regarded novelty. The Court of Common Pleas thought that from the context of the specification the patentee intended

(*q*) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

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the latter construction, and he must have intended the patent to be valid. This construction was the more probable, and to support the first construction it would have been necessary to assume on the part of the patentee extreme ignorance in respect of the metal fittings, or extreme confusion in describing particular metal fittings.

Limit to doctrine of construction according to patentee's intention.

The doctrine that the patentee intends his patent to be a good one must not be pushed too far in construing the specification. In the above case what the patentee was held to have intended turned out to be favourable to the validity of the patent, and the Court took into consideration the fact that he must have intended it to be valid, though that did not alone decide the Judges in adopting the construction they did. Independently of this fact the construction adopted was the more probable. The specification should be construed rather by trying to see what it says than by what the draughtsman meant, for frequently the draughtsman's object is to be as vague as possible without endangering the patent. (*r*) What is put in the form of a claiming clause may in reality only be the statement of a method of carrying out the invention and not a claim at all. When this is so, the patentee will be protected against his own folly in not putting the description into the body of the specification instead of in the form of a claiming clause. (*s*)

Thus the argument of absurdity cannot be used in favour of the patentee if the wording of the specification is perfectly clear. (*t*)

It will not do to argue that a great part of that which is covered by the patent is old and therefore bad, but some little part is new and therefore good, and that the Court ought consequently to confine the patent to that which is good. (*u*) The utmost extent to which the doctrine can be pushed in favour of the patentee is the conclusion that when two or more constructions are equally tenable the Court will adopt the one which will give validity to the patent, in preference to all others. (*x*)

Court is not astute to find flaws.

The Court will construe the specification so as to support

(*r*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 320.

(*s*) Per Kekewich, J., Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 164, 181.

(*t*) Cropper *v.* Smith, (1884) 1 R. P. C. 90; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 423, 437.

(*u*) Clark *v.* Adie, (1873) L. R. 3 Ch. D. 142.

(*x*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 307; Needham *v.* Johnson, (1884) 1 R. P. C. 58; Vorwerk *v.* Evans, (1890) 7 R. P. C. 167, 265.

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the patent, if it can be fairly done, (*y*) and will not be astute to find flaws in small matters in a specification with a view to overthrow it. (*z*) Where any expression is ambiguous, the Court will endeavour to give effect to the intentions of the patentee. (*a*)

In *Palmer* v. *Wagstaffe* (*b*) the plaintiff obtained an injunction against the defendant, restraining the infringement of a patent for "improvements in the manufacture of candles." The second claim was, "the mode of manufacturing candles by the application of two or more plaited wicks as herein described." The evidence of infringement was the production of a candle purchased by the plaintiff at the defendant's manufactory which was identical with those made by the plaintiff according to his process. It was not proved, however, that the defendant's candle had been made according to the patented process, and therefore, in order to support the verdict in the Court below, it became necessary for him to contend that his patent was for the candle, and not merely the process of producing it. The Court of Exchequer, however, made absolute a rule *nisi* to enter a verdict for the defendant, on the ground that the patent was for the method and not the candle, and consequently infringement had not been proved. *Pollock*, C.B., and *Parke*, B., both agreed that a specification should be construed as the patentee intended, and that, if any expressions were ambiguous, the Court should give effect to the intention; but the Court must not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.

Doctrine of benevolent construction.

It is sometimes contended that Judges should put a benevolent construction on the specification, so as to support the patent for the encouragement of inventors; but the true rule of construction is that the language of the specification should not be subjected either to a benign interpretation or to a strict one, (*c*) but should be construed like all written instruments

(*y*) p. 270 *ante*; Russell *v.* Cowley, (1832) 1 W. P. C. 457; 1 Cr. M. & R. 864.

(*z*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35, 39; Plimpton *v.* Spiller, (1876) L. R. 6 Ch. D. 422.

(*a*) Russell *v.* Cowley, (1832) 1 W. P. C. 470; Palmer *v.* Wagstaffe, (1854) 9 Exch. 494, 501. The above paragraph was referred to with approval by Kay, L.J., in Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 400, and the principles therein involved were applied in that case.

(*b*) (1853) 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

(*c*) Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Needham *v.* Johnson, (1884) 1 R. P. C. 58; see p. 104; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 307.

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impartially according to its true meaning, (*d*) unless the language is ambiguous, (*e*) the Courts then adopting a construction which will support the patent in preference to one which will not, where this can fairly and honestly be done. (*f*)

In *Boulton* v. *Bull* (*g*) it was attempted, in the Court of Common Pleas, to upset a patent, on the ground that a certain Act of Parliament, by which the original period of the duration of the monopoly was extended, purported to deal with a different kind of invention to that comprised by the patent. The Court was equally divided, so no judgment was given. But *Eyre*, C.J., was of opinion that the patent could be supported, on the ground that—(1) it was not for an abstract principle, but for a practical embodiment of a principle; (2) the Act and specification were referable to the same thing; and, when taken with their correlation, they were perfectly intelligible; and in his desire to reward the patentee he declared that he would, if necessary, resort to the exposition of the word "engine" in the body of the Act to mean a "method," in order to support the patent, "*ut res magis valeat quam pereat.*" *Pollock*, C.B., in another case, (*h*) said: "I agree that we are to construe the specification '*ut res magis valeat quam pereat,*' but still we are bound to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter, which may very much control the judgment to be given."

True limits to the doctrine.

The true limits within which the doctrine of benevolent construction may be applied in favour of the patentee are, it is submitted, clearly defined in the two following extracts from judgments of Sir *George Jessel*, M.R., and the late Lord *Bowen* respectively:—

> In *Hinks* v. *Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607, 612, *Jessel*, M.R., said: "I am anxious, as I believe every Judge is, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections

(*d*) Clark *v.* Adie, (1875) L. R. 2 App. Cas. 436; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Simpson *v.* Holliday, (1864) 13 W. R. 577; L. R. 1 H. L. 315; Edison *v.* Holland, (1888) 5 R. P. C. 474.

(*e*) Parkinson *v.* Simon, (1895) 12 R. P. C. 406, 407; Patents Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 549.

(*f*) pp. 269, 270 *ante*.

(*g*) (1795) D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

(*h*) Thomas *v.* Foxwell, (1859) 6 Jur. N. S. 272.

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or on mere cavillings with the language of their specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use; but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him, whether or not it was an invention unknown to himself." (*i*)

In *Cropper* v. *Smith*, (1884) 1 R. P. C. 89, *Bowen*, L.J., stated the duty of the Court in the following terms, which were quoted with approval by *Lindley*, L.J., in the subsequent case of *Benno Jaffé und Darmstaedter Lanolin Fabrik* v. *Richardson & Co.*, (1894) 11 R. P. C. 271:—

"We were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as *Coke* and *Shepherd's* Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign. *Verba debent intelligi cum effectu ut res magis valeat quam pereat.* Now that is only a caution against excessive formalism, it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is, as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by

(*i*) See also Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Cropper *v.* Smith, (1884) 1 R. P. C. 89.

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their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole document. It is almost always coupled with another maxim, which seems to be nearly the same thing in another shape: *Verba intentioni debent inservire.* You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly can never be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing a document."

If a claim can be read in two ways—one claiming something that has the merit of novelty, and the other claiming something which would show the patentee to be ignorant of all the ordinary appliances used to affect a particular purpose, it is the duty of the Judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction which makes the patent utterly absurd; (*k*) but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were not new at the date of the patent, and were generally thought to be old, the Court is not, therefore, to narrow down the claim so as to exclude the old matters. Such a proceeding would be contrary to the decisions, and would afford a very simple precedent for saying that no patent is to be upset on the grounds of novelty. (*l*) In the words of Lord *Hatherley*, "the Courts will not alter the construction in order to save a patent where the patentee has himself explained his meaning in the claiming clauses." (*m*)

In construing a claim, however, if there is nothing else in the matter, it is the duty of the Judge to adopt that construction which makes sense of the patent instead of that which makes it useless. (*n*) And there is, as there ought to be, a bias between different constructions in favour of the real

(*k*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R.P. C. 98; Cropper *v.* Smith, (1884) 1 R. P. C. 81; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Needham *v.* Johnson, (1884) 1 R. P. C. 58; Morris *v.* Young, (1895) 12 R. P. C. 463.

(*l*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 433, 437.

(*m*) Clark *v.* Adie, (1877) 2 App. Cas. 431.

(*n*) Per Jessel, M.R., Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422.

improvement and genuine invention to adopt that construction which supports an invention. (*o*)

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Benevolent construction of the grant.

It may be pointed out that the considerations above discussed affect the question of the benevolent construction of the specification, a document prepared by the patentee himself, and that this is a different question to that of the benevolent construction of the grant contained in the actual letters patent, which by its express terms is to be considered in the most beneficial sense for the advantage of the patentee.

Word used in a popular sense is not construed according to its exact meaning.

Where a word is used in a specification in a popular sense, it is not to bear its strict mathematical meaning—*e.g.*, a patentee in his specification referred to a certain comb-plate "being cut with teeth pointed like a comb, and in parallel portions." It was objected that the teeth, if pointed, could not be parallel, but the House of Lords adopted the view of Lord *Cairns*, that the patentee explained in the clearest way that he used the word in a popular and not in a mathematical sense, and that the word must be construed in that sense. (*p*)

Claims are construed with reference to the whole specification, and after a consideration of it.

The claiming clauses of the specification are construed with reference to the title, (*q*) and with reference to the whole of the specification. (*r*)

The claims are not to be read as isolated sentences, but they must be interpreted by a reference to the body of the specification of which they form a part. (*s*) Consequently, a claim which, isolated, would be bad as being too extensive, may, when explained and narrowed down by a reference to the specification, be perfectly valid. (*t*) On the other hand, the effect of narrowing down the generality of a claim by the particularity of the descriptive part of the specification may be to invalidate the patent. (*u*)

It is not right for the Court which has to construe the claim

(*o*) Per Jessel, M.R., Otto *v.* Linford, (1881) 46 L. T. N. S. 39.

(*p*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 426.

(*q*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; Newton *v.* Vaucher, (1851) 6 Exch. 859; 21 L. J. Ex. 305.

(*r*) Neilson *v.* Harford, (1841) 1 W. P. C. 312, 373; Lister *v.* Norton, (1886) 3 R. P. C. 203; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426; Wegmann *v.* Corcoran, (1876) L. R. 13 Ch. D. 65, 77; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Kaye *v.* Chubb, (1888) 5 R. P. C. 641; Leadbitter *v.* Kitchin, (1890) 7 R. P. C. 233; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403.

(*s*) Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403.

(*t*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Kay *v.* Marshall, (1835) 2 W. P. C. 36; Beard *v.* Egerton, (1819) 8 C. B. 165, 215.

(*u*) See Corrigall *v.* Armstrong, Whitworth & Co., Ld., (1905) 22 R. P. C. 268.

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to look first at the claim and then at the full description of the invention; but the proper course is for the Court first to read the description of the invention in the body of the specification, so as to be prepared to understand what the inventor is about to claim, and then determine whether the claim really goes further than what is described. (*x*)

Thus, in the case of *Newton* v. *Vaucher* (*y*) it was material to decide whether the patentee claimed the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether he did not also claim the application of soft metal in the case of stuffing-rods for the purpose of excluding air, water, or other fluid. On reading the title and specification with reference to each other, the Court was convinced that the claim was confined to bearings in cases where there is pressure with motion, and adopted that construction accordingly.

Again, in *Montgomerie* v. *Paterson*, (*z*) the patent was for the discovery and preparation of a diastasic mixture and its application to or mixture with a batch of bread or other food, so as with the aid of heat to convert flour into maltose and predigest the food. The claim was "the mode and means and combination of mixtures with the special preparation of malt-extract herein distinguished for manufacturing or making bread and biscuits substantially in the new or improved manner herein described." The defendant contended that this claim was wholly unintelligible, but that, construed in the most favourable sense, it amounted merely to a claim for the combining, or for the mode of combining (1) the described special mixture with (2) certain other described mixtures forming the bulk of the batch; and further, that if this combination involved no difficulty it had no merit, and was therefore not patentable, and if it did involve difficulty the mode of performing the operation was not described sufficiently to enable it to be successfully performed. The Courts, however, held that, looking at the specification as a whole, it could be gathered what the patentee meant—*i.e.*, he did not claim the mere combining of his special mixture (*i.e.*, the separate mixture in which the diastase was produced) with the various

(*x*) Arnold *v.* Bradbury, (1871) L. R. 6 App. Cas., judgment of Lord Hatherley, L.C., p. 712; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 389, judgment of Esher, M.R., pp. 395, 396; Tubes, Ld. *v.* Perfecta Seamless Steel Tube Co., Ld., (1900) 17 R. P. C. 588.

(*y*) (1851) 6 Exch. 859; 21 L. J. Ex. 305.

(*z*) (1894) 11 R. P. C. 221, 633.

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mixtures which he suggested as suitable for the dough forming the rest of the batch. What he did claim was the mode described of preparing the various mixtures forming the dough or bulk of the batch (a mode perfectly well described) and then the combining of those mixtures with his special or separate mixture, the mode of preparing which latter was also well described. The claim so read possessing novelty and utility, the patent was upheld.

In *Leonhardt* v. *Kallé*, (*a*) the subject-matter of the patent was the production of various colouring-matters fast to alkali by the action of suitable oxidisable substances, and free alkalies upon a certain substance under heat. It was objected that the claim was too general, as it stated that oxidisable substances other than those specifically mentioned could be used, and this would include zinc dust, the action of which on the certain substance was already known, and further, because whilst claiming colouring matters the specification did not indicate the processes necessary to produce particular shades. But *Romer*, J., who tried the case, held that this objection failed because the claim, read with the body of the specification, was limited to an oxidation by the zinc dust further—*i.e.*, more complete—than that already known; and the patentee having pointed out the limits of colours his process could produce, it was not incumbent on him to attempt the almost impossible task of defining shades of colour. A chemist would have no difficulty in selecting any shade he might require.

In *Evans and Taunton, Ld.* v. *Hoskins and Sewell, Ld.*, (*b*) the invention was the arrangement of the coiled supporting springs of a wire mattress in an oblique or diagonal position, and in opposite directions from the centre of each end, in such a manner as to direct the tension from all the springs on to the middle portion of the wire-mesh. The defendants did not dispute that the plaintiffs' arrangement would produce the result desired, when the network of the mattress was diagonal, but they contended that with a network of square pattern made movable on its points of contact the diagonally arranged springs would not direct any strain on the centre, and, inasmuch as the specification stated that forms of net-work other than the diagonal one shown in the drawings could be used, the claim covered the square form with which the invention was useless. The Court decided that the

(*a*) (1895) 12 R. P. C. 103. (*b*) (1904) 21 R. P. C. 675.

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answer to the argument was that the patentee had not claimed such an unworkable method of carrying his invention into effect; he described an arrangement for a diagonally directed strain to the centre of the bed, and showed in his drawings a proper way of doing it, and when he said that other patterns of linkwork would do, he obviously meant meshes which will carry diagonal strains. The evidence was that there are a very large number of meshes of patterns which will carry diagonal strains, and any engineer would say which mesh would carry diagonal strains and which would not. In the opinion of the Court, therefore, the patentee had not claimed a square mesh as carrying out his invention.

So if the claim is for the use of a whole class of articles, and only one kind will do, but the evidence shows that although the words of the claim do on the face of them claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, then the claim might be construed as being for that part which an ordinary workman would take, and not for that part which an ordinary workman would not take. (*c*) It is always a question of evidence whether or not the ordinary workman, using only common knowledge, would eliminate the members of the class which would not do. (*d*) In one case, where it was not discovered till the actual trial of an action upon the patent that one member of a class could not be used with success, the patent was held void. (*e*)

Distinct effective meaning is, if possible, to be given to each claim.

When there are several claims, a distinct effective meaning must, if possible, be given to each, for the rule is that each part of the specification should be effectively construed, and if several claims mean the same thing they cannot be said to be effective. (*f*) If, however, it is not possible to give a distinct effective meaning to all the claims, the fact that some are redundant does not invalidate the patent. (*g*)

Essence of an invention may be protected though the claim does not specifically mention it.

The claims should specifically refer to all that is of the essence of the invention in respect of which the patentee desires to be protected. If, however, some essential feature is not directly mentioned in the claims, though the thing

(*c*) Gandy *v.* Reddaway, (1885) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107. (*d*) *Ibid.*

(*e*) Badische Anilin und Soda Fabrik *v.* La Société Chemique des Usines du Rhône, (1897) 14 R. P. C. 875.

(*f*) Parkinson *v.* Simon, (1894) 11 R. P. C. 502; Jordan *v.* Moore, (1866) L. R. 1 C. P. 624; see Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 257; British Shoe Machinery Co., Ld. *v.* Hugh Claughton, Ld., (1906) 23 R. P. C. 321..

(*g*) Wenham Gas Co. *v.* Champion Gas Lamp Co., (1892) 9 R. P. C. 55.

described *necessarily* possesses that essential feature, the claim is sufficient and the use of the essential feature in question would be an infringement. (*h*) Thus, in *Tweedale* v. *Ashworth*, (*i*) one essential element in the success of the patentee's contrivance for an improved flat and fastener for securing carding cloth thereon, was that the material should be stretched at the same time and by the same operation as completed the machine. Though this was not directly mentioned in the claim, it followed as a consequence from the thing claimed and described. The House of Lords held the patent valid, but that the defendant had not infringed, as he had not taken this essential feature in question. In the subsequent case of *Tweeddale* v. *Howard*, (*j*) the Court held that upon the facts the defendant had infringed, because he had adopted by a mere colourable imitation the essential element of the patentee's contrivance. In *Tweedale* v. *Ashworth*, (*k*) Lord *Halsbury*, L.C., said: "Now, my Lords, looking to the patent itself and the specification, I am unable to give any other construction to the patent here than that which involves the particular thing, with its own particular incidents, which is therein described; and I think that the fallacy of the argument which has been ingeniously suggested to us is this: It is said that there is no claim for the stretching. If by that is meant that there is in the claim no such word as 'stretching,' I agree the word 'stretching' does not occur; but what there is in the claim is this—there is a claim for a thing which is described and illustrated by the description in the letterpress and by the illustration which is given in the drawing, and both the letterpress and the drawing describe a machine, and describe the mode of manufacturing the machine, which, of itself, necessarily involves, as one of the merits of the invention, the power of stretching the material at the same time and by the same operation as completing the machine. That, I believe, is the merit of the invention, and a very material merit of the invention, and it appears to me that, that being one of the important elements forming

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(*h*) See pp. 340–369 *post*; and Ashworth *v.* English Card Clothing Co., Ld., (1903) 20 R. P. C. 797; Tweeddale *v.* Ashworth, (1892) 9 R. P. C. 127; Proctor *v.* Bennis, (1887) 4 R. P. C. 333; Automatic Weighing Machine Co. *v.* National Exhibitions Association, (1891) 8 R. P. C. 350, 351; 9 R. P. C. 41; Incandescent Gas Light Co., Ld. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 330; Bunge *v.* Higginbottom & Co., Ld., (1902) 19 R. P. C. 193; Hattersley *v.* Hodgson, (1905) 21 R. P. C. 517; 23 R. P. C. 192.

(*i*) (1892) 9 R. P. C. 127.

(*j*) (1896) 13 R. P. C. 522.

(*k*) (1892) 9 R. P. C. 127.

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the substance of the invention, it is one which the defendants have in no way invaded."

Again, in *Boyd* v. *Horrocks*, (*l*) the House of Lords, upon the same principle, held that, though a claim in question was for an arrangement which attained an old result in a similar way to an alleged anticipation, it was not limited to the particular form of parts specified, but involved the possession of a certain essential and novel feature, by the taking of which the defendant had infringed the patent. (*m*)

And in *Aktiebolaget Separator* v. *Dairy Outfit Co.*, (*n*) the Court of Appeal held in reference to a claim worded as follows: "In centrifugal separators or creamers the combination of the conical plates, *c'* with the rotating drum or bowl, *a* substantially as described," the *sine quâ non* of the invention as claimed was the rigidity of the conical plates in the form of a solid block. In consequence of this construction the claim was held to have been infringed by a defendant who left out the suitable means described for forming the separator of conical plates into a solid block in the bowl, and used a block solid in itself but with inclined narrow radial passages intersecting it through which the cream and milk flowed, when centrifugal force was applied to the bowl, in the same manner as in the patented mechanism.

Principle of introducing claim by implication is employed with great caution.

It must be remembered that the Courts, in all cases, only apply this principle of introducing, by implication, a claim not expressly contained in a specification with the greatest possible caution. (*o*)

Frequently claiming clauses end with such words as "*substantially as described*," or "*substantially as and for the purpose hereinbefore described*," which are usually introduced with the object of limitation. Whether such words have any or what effect depends in each case upon the construction of the specification as a whole. (*p*)

(*l*) (1892) 9 R. P. C. 77.

(*m*) Moore *v.* Thompson, (1890) 7 R. P. C. 325; and Gormally and Jefferey Manufacturing Co. *v.* North British Rubber Co., (1898) 15 R. P. C. 245, are other decisions of the House of Lords involving the application of this principle.

(*n*) (1898) 15 R. P. C. 327.

(*o*) Muirhead *v.* Commercial Cable Co., (1895) 12 R. P. C. 39, 56.

(*p*) For instances see Young *v.* Rosenthal, (1883) 1 R. P. C. 33; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 241; Lawrence *v.* Perry, (1885) 2 R. P. C. 183; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 208; United Telephone Co. *v.* Bassano, (1888) 3 R. P. C. 295; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232; Parkinson *v.* Simon, (1895) 12 R. P. C. 403; Brooks *v.* Lamplugh, (1897) 15 R. P. C. 33; 16 R. P. C. 41; Marshalls, Ld. *v.* Chambers Patents Manufacturing Co., Ld., (1901) 18 R. P. C. 403.

In the following cases the words

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Provisional cannot be called in aid to construe complete specification.

Specification is construed with reference to public knowledge at the date of the patent,

The complete specification must be construed without calling in the aid of the provisional to explain or enlarge its meaning; (*q*) though the Court may look at the provisional specification for the purpose of ascertaining the real object of the invention claimed in the complete. (*r*)

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of description, by reference to the knowledge of the world existing at the date of the patent; and the Court, for purposes of construction, will not take notice of any subsequently acquired information, but will endeavour to divest itself of such knowledge, and place itself in the position of the person to whom the specification may have been supposed to be addressed at the date of the patent; (*s*) and generally the prior history of the art and the surrounding circumstances are matters to which the Court gives due weight, when necessary, (*t*) in arriving at the true construction of the specification and what it includes and excludes. (*u*)

printed in italics were interpreted with reference to the rest of the specification in each case:—

*As above described.*—Plating Co. *v.* Farquharson, (1879) Griff. 191; Barber *v.* Grace, (1847) 1 Ex. 122; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607.

*As above set forth.*—Bray *v.* Gardner, (1887) 4 R. P. C. 403.

*Substantially as set forth.*—United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 315; Patents Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1901) 21 R. P. C. 547.

*As described and illustrated.*—Fairburn *v.* Household, (1886) 3 R. P. C. 267.

*Other substances.*—Crossley *v.* Beverley, (1829) 9 B. & C. 63; Bickford *v.* Skewes, (1841) 1 Q. B. 918; 1 W. P. C. 218.

*Any mechanical equivalent.*—Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 137 *n.*

*Analogous.*—Brown's Patent, Griff. L. O. C. 1.

*More or less.*—Plating Co. *v.* Farquharson, (1879-83); Griff. P. C. 187, 190.

*Or.*—Simpson *v.* Holliday, (1864) 20 Newton's Lond. Journal (N. S.) 108; Elliot *v.* Turner, (1845) 2 C. B. 446; 15 L. J. C. P. 49; Hills *v.* London Gas Light Co., (1860) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409.

*Causing.*—British Motor Syndicate *v.* J. E. H. Andrews & Co., (1899) 16 R. P. C. 577; 18 R. P. C. 85.

*Float.*—In a weaving patent, Lister *v.* Dix, (1898) 16 R. P. C. 89.

*Should.*—W. T. Glover & Co. *v.* American Steel and Wire Co., (1902) 19 R. P. C. 110.

*Sharp.*—Leeds Forge, Ld. *v.* Deighton's Patents, Ld., (1904) 21 R. P. C. 487.

*Plastic.*—Patents Exploitation, Ld. *v.* Siemens Brothers & Co., Ld., (1904) 21 R. P. C. 541; Patents Exploitation, Ld. *v.* American Electrical Novelty and Manufacturing Co., Ld., (1905) 22 R. P. C. 316.

(*q*) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.

(*r*) Parkinson *v.* Simon, (1894) 11 R. P. C. 502.

(*s*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710; 14 R. P. C. 449; Edison *v.* Woodhouse, (1887) 4 R. R. P. 94; Boyd *v.* Horrocks, (1892) 9 R. P. C. 295; King Brown *v.* Anglo-American Brush Corporation, (1892) 9 R. P. C. 313, 317, 319, 321; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 523; Jandus Arc Lamp and Electric Co., Ld. *v.* Johnson, (1900) 17 R. P. C. 361, 376; Welsbach Incandescent Gas Light Co. *v.* New Incandescent (Sunlight Patent) Gas Lighting Co., (1900) 17 R. P. C. 23; see also p. 220 *ante*.

(*t*) See pp. 285, 469 *post*.

(*u*) See Pneumatic Tyre Co., Ld. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1898) 16 R. P. C. 53, 55.

Construction.

Thus in *Nobel's Explosives Co.* v. *Anderson*, (*x*) the question was whether the term "soluble" nitro-cellulose as used in the specification included a form of nitro-cellulose which the defendant at a later date claimed to use in the manufacture of an explosive as "insoluble" nitro-cellulose. The evidence was conflicting, but it was decided that the term "soluble" nitro-cellulose at the date of the plaintiff's patent did not, according to the meaning attributed to it then by chemists, include the form of nitro-cellulose used by the defendant and described by him as "insoluble," and so there was no infringement.

and with reference to what it would lead the person to whom it is addressed to do.

Moreover, in determining the sufficiency of the specification, the Court will not take cognisance of what the patentee says he intended, but only of what the ordinary intelligent workman, to whom the specification may be supposed to be addressed, says it would lead him to do. (*y*)

In *Badische Anilin und Soda Fabrik* v. *Levinstein*, (*z*) a question arose as to the meaning of the term "*Naphthylamine*," in the specification of the plaintiff's patent for "improvements in the production of colouring matters suitable for dyeing and printing," taken out in 1878. All the amines are capable of existing in three different isomeric modifications. At the date of the action, which was 1883, two of the isomeric naphthylamines known as alpha- and beta-naphthylamine respectively, were generally known. It was also established in evidence that, though these two isomers were known at the date of the patent, the beta-naphthylamine was only known to the highly trained organic chemists acquainted with the latest discoveries of the day, and it had not found its way into use in the arts. The question really was, would the direction to use "*Naphthylamine*," taking into account only the state of public knowledge at the date of the patent, lead the public to use the alpha isomer which would answer, and not the beta isomer which would not answer.

*Pearson*, J., in the Chancery Division, (*a*) upheld the patent, but in the Court of Appeal it was declared void on the ground of insufficiency of the specification. *Bowen* and *Fry*, L.JJ., thought that the specification being addressed to highly skilled experts—"advanced students of organic chemistry"—the

(*x*) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(*y*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289; see p. 217 *ante*.

(*z*) (1883) L. R. 24 Ch. D. 156; L. R. 29 Ch. D. 366; L. R. 12 App. Cas. 710; 2 R. P. C. 73; 4 R. P. C. 419.

(*a*) L. R. 24 Ch. D. 156; 29 Ch. D. 384, 406, 411.

Construction.

term "*naphthylamine*" would include both isomers, and therefore be bad for ambiguity. Whilst *Baggallay*, L.J., drew a distinction between different classes of literature, and concluded that in the knowledge of practical men at the date of the patent the term "*naphthylamine*" would mean only the *alpha-naphthylamine*, and this view was finally adopted by the House of Lords, (*b*) who supported the patent, thus upholding the decision of *Pearson*, J., and reversing that of the Court of Appeal. (*c*)

Limit to the latter canon of construction.

The doctrine that the specification is to be construed to mean what an ordinary workman would understand it to mean must not be pushed too far. It is only applicable when there appears to be an ambiguity. If the Court is clear as to the meaning of a specification it will not accept the evidence of a workman, or anybody else, on the point, but will construe it as it is bound to do according to its own view. In the words of *Esher*, M.R., the doctrine is applicable "only when a particular description of work mentioned in the specification, or something to be done, appears to be ambiguous. If you read it without knowledge it appears to be ambiguous, but then it is said: 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literary accuracy there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done. That does not apply to this case, for it is not suggested that any one of the many things which have been added to this instrument by this invention is described in any ambiguous way whatever."

Effect of publications on construction of specifications.

In *Clark* v. *Adie*, (*d*) the question arose as to how far the Court is justified in looking at antecedent publications for the purpose of construing a specification in dispute, but the House of Lords did not admit the evidence, on the ground that there was no ambiguity in the specification involved, and refused to

(*b*) L. R. 12 App. Cas. 710.
(*c*) See opinion of Lord Halsbury, L.C., L. R. 12 App. Cas. 714.
(*d*) (1873) L. R. 2 App. Cas. 423, 431.

Construction.

lay down any general rule, and so far none has been stated. Lord *Cairns*, L.C., however, pointed out that it might be open to the patentee or licensee to refer, in launching his case, to the state of manufacture up to, and at the time, when the patent was granted.

In *Westinghouse* v. *Lancashire and Yorkshire Railway Co.*, (*e*) *Denman*, J., held that it was necessary to look at the state of knowledge at the time of the publication of the specification in order to decide whether a particular claim was a claim to a combination, or a claim to several distinct inventions: (*f*) and in *Couchman* v. *Greener*, (*g*) Lord *Esher*, M.R., said that if there be any doubt on the construction of the plaintiff's patent you may look at former patents for the purpose of seeing what is the proper construction of the plaintiff's patent: and in *Leeds Forge Co.* v. *Deighton's Patent Flue and Tube Co.* (*h*) the Lords Justices expressly construed the specification, for the purpose of fixing the ambit of the claim, by the aid of prior knowledge as disclosed by the prior specifications cited in the particulars of objections, though the construction at which they arrived was not upheld by the House of Lords. On the other hand, *Mauisty*, J., in a case between licensor and licensee, in the absence of ambiguity in the licensor's specification or necessity for explanation, refused to admit evidence of the state of public knowledge at the date of the plaintiff's patent. (*i*) And *Farwell*, J., also in an action between licensor and licensee refused to admit prior specifications in evidence on the question of construction on the ground that the language [illegible] was perfectly plain and in nowise of a special nature requiring any skilled explanation, and, further, since the invention, in fact, was not a particular improvement on a prior invention, his lordship rejected the argument that the occurrence of the word "improvement" in the title gave the right to refer to prior specifications as an aid to construction. (*k*)

Prior public knowledge as disclosed by antecedent specifications, or otherwise, does undoubtedly in one sense affect the question of construction. Thus it is a well-established canon that, if two constructions are possible, the Court will adopt that which will support the patent in preference to one which

(*e*) (1884) 1 R. P. C. 98, 101.
(*f*) See also Ellington *v.* Clark, (1888) 5 R. P. C. 325.
(*g*) (1884) 1 R. P. C. 197, 199.
(*h*) (1902) 19 R. P. C. 285
(*i*) Crosthwaite *v.* Steel, (1889) 6 R. P. C. 190.
(*k*) Jandus Arc Lamp and Electric Co., Ld. *v.* Johnson, (1900) 17 R. P. C. 370.

Construction.

will not, (*l*) and with this object in view the Courts do consider the state of public knowledge at the date of the patent. (*m*) When, however, the Court construing a claim, as it must do, like any other written instrument, comes to the conclusion that it unequivocally includes what is old, it is not competent to the patentee to call in aid common knowledge as a reason why the Court should limit the claim by excluding that which was old and known. (*n*)

Drawings in relation to construction.

The law provides that both the provisional and complete specifications are to be accompanied by explanatory drawings, if required. (*o*) Such drawings are part of, and are to be read with, the specification to which they are attached, and of which they form a part as much as the letterpress. In the words of *Abbott*, C.J.: (*p*) "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient." (*q*)

Drawings are subsidiary to the verbal part of the specification, and not the verbal part to them, and a patentee is not allowed to rely on an ambiguous drawing as being a description of a material part of his invention when there is no reference whatever to such material part in the body of the specification. (*r*) Moreover, the Act of 1883 only says the specification must be accompanied by drawings, if required, not that it must have them in every case; and it is no objection to a specification that it has no drawings annexed to it, if it sufficiently describes the invention. (*s*) Nor is it an objection that the drawings are roughly executed, if they are sufficient with the verbal part of the specification to enable a competent person to use the invention. (*t*)

(*l*) p. 270 *ante*.

(*m*) See pp. 270–272 *ante*.

(*n*) See pp. 273, 276 *ante*; Kynoch & Co. *v.* Webb, (1899) 17 R. P. C. 108; Electric Construction Co. *v.* Imperial Tramways Co., (1900) 17 R. P. C. 545, 546.

(*o*) 46 & 47 Vict. c. 51, s. 5, sub-s. 3 and 4.

(*p*) Bloxam *v.* Elsee, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. T. (O. S.) Q. B. 93; see also Milles *v.* Searle, (1893) 10 R. P. C. 106.

(*q*) See also Hattersley *v.* Hodgson, (1904) 21 R. P. C. 517; 23 R. P. C. 192.

(*r*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 315; P. O. R.

(*s*) Per Rook, J., in Boulton *v.* Bull, (1795) D. P. C. 188, 189.

(*t*) Per Gibbs, C.J., in Bovill *v.* Moore, (1815) D. P. C. 369; see also Hinks *v.* Safety Lighting Co., (1876) L. R. 4. Ch. D. 607; 46 L. J. Ch. 185.

Construction.

On the point as to how far the drawings may aid the description in the specification, the following observations of Lord *Blackburn*, made in reference to a case in which the drawing was ambiguous, are instructive: (*u*) "The next thing as to which there is said to be an infringement is the plate being made with a curve, so that it is elastic. . . . Now we have to look at *Grayson's* patent in order to see whether that merit is claimed in any part. It is admitted that throughout the whole of the letterpress there is never an allusion to any curved or elastic plate at all; but in one of the figures, No. 2, in profile, there does appear a curved plate, and it is said that the fact that there appears a curved plate upon that figure is enough to indicate that in the description of his invention *Grayson* described that curved plate, and claimed it as part of his invention. Now, I will not stop to inquire how far a mere picture may be a description of an invention and help the letterpress. It may be so to some extent—how far, I do not stop to inquire. But upon that drawing there is represented a curved plate with a curved bolt attached to it in a way which, if it were carried out according to the drawing, would prevent the elasticity. . . . Whatever you may say about the picture being part of the description, and so bringing the curved plate within your invention, when the only drawing which shows a curved plate shows that curved plate in a position in which it would not give elasticity, it seems to me to be quite plain that you cannot say that the advantage resulting from a curved plate was contemplated as being included in the invention at all." (*x*)

If the drawing is unambiguous and not merely illustrative but is put forward as descriptive of the invention and the claim is for a thing shown and described, the fact that there is no reference in the letterpress to an essential feature which is shown on the drawing will not invalidate the patent on the ground of insufficiency of specification, nor will it exclude the essential feature in question from the claim. (*y*)

Correction of errors by other parts of the specification.

The specification is to be read as a whole, and if one part corrects what is evidently a slight error contained in another part, it is proper to make the correction, and the presence of such an error will not vitiate the specification; (*z*) but the

(*u*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 338.

(*x*) See also Otto *v.* Linford, (1881) 46 L. T. N. S. 40.

(*y*) Hattersley *v.* Hodgson, (1904) 21 R. P. C. 517; 23 R. P. C. 192.

(*z*) Totley *v.* Easton, (1852) Macr. P. C. 47; Wegmann *v.* Corcoran, (1879) L. R. 13 Ch. D. 65.

provisional and complete specifications cannot be read together in order that the provisional shall supply an omission from the complete specification of a statement which is material to the validity of that document; (*a*) in other words, the complete specification must itself completely describe the nature of the invention, and in what manner it is to be performed, and if it omits to do either the one or the other, or does the one or the other erroneously, it will be no answer to say that the omission may be supplied by a reference to the provisional. Construction.

An error in the drawings or on the face of the specification which a competent workman would at once perceive and correct will form no substantial objection; (*b*) but the public to whom the specification is addressed, are not to be called upon to exercise any invention in supplying its defects, and unless there is something in the document itself by which the error can be corrected it will be fatal. (*c*)

It cannot be contended that errors on the face of the specification, or in the drawings, which would at once be made apparent and corrected in following out the directions given, tend in any way to mislead; on the other hand, errors which are discoverable only by experiment and further inquiry are absolutely fatal to the specification, on the ground that the public are not to be misled into performing experiments which must fail. It is, moreover, a fatal defect if the specification contain any erroneous statements, amounting to a false suggestion, even though such error would be at once observed by a workman possessed of ordinary knowledge of the subject. (*d*)

(*a*) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52; p. 186 *ante*.

(*b*) Otto *v.* Linford, (1861) 46 L. T. N. S. 40; Morgan *v.* Seaward, (1836) 1 W. P. C. 174; Simpson *v.* Holliday, (1865) 13 W. R. 578; 12 L. T. N. S. 93; Derosne *v.* Fairie, (1835) 1 W. P. C. 157; Gandy *v.* Reddaway, (1883) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Hopkinson *v.* St. James's Electric Light Co., (1892) 10 R. P. C. 46; Miller *v.* Searle, (1893) 10 R. P. C. 106.

(*c*) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 90; 13 R. P. C. 190; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 616; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; Muntz *v.* Foster, (1844) 2 W. P. C. 108.

(*d*) Simpson *v.* Holliday, (1864) 5 N. R. 340; see also p. 202 *ante*.

# CHAPTER VI.

## REVOCATION OF LETTERS PATENT.

### The Petition.

Effect of grant of letters patent.

LETTERS PATENT for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition (*a*) they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity, if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied. (*b*)

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all his Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves. (*c*) As we have seen, the justification for making the grant is the consideration that the patentee is the first to give the public a knowledge of the invention and the means of making practical use of it. (*d*)

It is evident that, if a grant of letters patent for an invention be made, which is in fact void, so long as the grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

Validity may be questioned by defendant in an action for infringement.

We shall see hereafter that in the event of a patentee bringing an action against any member of the public in respect of any act alleged to be an infringement of his rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which in law render it void, so as to obtain the declaration of the Court on the point, which, if found in the defendant's favour, is a complete answer to the action. (*e*)

(*a*) Vol. II. p. 23.
(*b*) Vol. II. p. 1 *ante*.
(*c*) p. 105 *ante*.
(*d*) p. 105 *ante*.
(*e*) p. 401 *post*.

The Petition.

A member of the public may have an interest in obtaining a revocation.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement. For instance, where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has long provided a means to enable an aggrieved member of the public to obtain the repeal of a void patent. Formerly the procedure was by *scire facias*; but now it consists in the presentation of a petition to the Court, under sec. 26 of the Act of 1883, (*f*) for the revocation of the patent.

Petition for revocation substituted for the old procedure by *scire facias*.

Under the old practice, if two persons had obtained patents for the same invention the Courts would not interfere between them, but left them to determine their rights by *scire facias*, (*g*) for which proceeding the presentation of a petition for revocation has been substituted by the Act of 1883. (*h*)

Declaration of invalidity.

Notwithstanding the statutory provision of procedure by petition for revocation of a patent, it may be that the Court would, under special circumstances, entertain and adjudicate upon a request for a declaration of invalidity; (*i*) but there is no precedent which justifies an action for a declaration of invalidity as against a petition for revocation, whether the patent is current or has expired at the date of the proceedings. (*k*)

Conditions of letters patent.

The presentation of a petition for revocation of a patent, as did the prosecution of a *scire facias*, entails expense on the part of the person presenting it, and in order that the public may not be put to the trouble or cost of resisting an unlawful patent, the Crown imposes a condition on the grantee of every letters patent for an invention. This condition is a proviso in the letters patent to the effect that, if at any time during the term for which the patent is granted it be made to appear to the King, his heirs, or successors, or any six or more of his Privy Council, that the grant is contrary to law, or prejudicial, or inconvenient to his Majesty's subjects

(*f*) Vol. II. p. 213 *post*.

(*g*) Copeland *v.* Webb, (1862) 11 W. R. 134; 1 N. R. 119; Baskett *v.* Cunningham, (1762) 2 Eden, 137.

(*h*) s. 26.

(*i*) See Leeds Forge Co., Ld. *v.* Clayton & Sons, Ld., (1905) 22 R. P. C. 325; Alexander Turnbull & Co., Ld., *v.* Cruikshank, (1905) 22 R. P. C. 521; North Eastern Marine Engineering Co., Ld. *v.* Leeds Forge Co., Ld., (1905) 23 R. P. C. 96.

(*k*) See *ibid.*

The Petition.

in general, or that the invention is not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within the realm, the letters patent shall forthwith determine and be void to all intents and purposes. (*l*)

There is no instance in modern times of the determination of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign. (*m*)

Under sec. 3 of the Patents Act, 1902, the Privy Council has power to revoke patents which are not worked in the United Kingdom. This statutory provision was probably necessary to give the Privy Council power to enforce the condition mentioned in the grant in view of sec. 2 of the Statute of Monopolies, which declared that patents should be tried according to the common law and not otherwise. (*o*)

Revocation in part of the United Kingdom is applicable to the whole.

The Act of 1883 defines the term "patent" as meaning letters patent for an invention (*p*) which have effect throughout the United Kingdom and the Isle of Man, (*q*) and therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Revocation may be obtained in England, Scotland, or Ireland.

The words of sec. 26 of the Act of 1883, (*r*) which establish the proceeding by petition are: "Revocation of a patent may be obtained on petition to the Court," and it is submitted that in view of the evident contemplation by the Act of proceedings in England, Scotland, and Ireland, (*s*) the "Court" must be taken to mean in England his Majesty's High Court of Justice in England; (*t*) in Scotland, any Lord Ordinary of the Court of Session; (*u*) and in Ireland, the High Court of Justice in Ireland. (*x*)

Power of the County Palatine of Lancaster to revoke a patent on petition.

Before the Chancery of Lancaster Act, 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to

(*l*) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

(*m*) See Hindmarch on Patents, p. 432. See also Remb. 98, 223.

(*n*) Universities of Oxford and Cambridge *v.* Richardson d'Ewes, (1802) 652; 6 Ves. 712; judgment of Lord Eldon, L.C., Matthey's Patent, Darcy *v.* Allin, (1602) Noy. R. 183.

(*o*) See Badische Anilin und Soda Fabrik *v.* Thompson, (1904) 21 R. P. C. 473.

(*p*) s. 46. (*q*) s. 16.

(*r*) Vol. II. p. 213 *post*.

(*s*) See s. 26 (4) (a) (b).

(*t*) 46 & 47 Vict. c. 57, s. 117.

(*u*) *Ibid.* s. 111.

(*x*) *Ibid.*

entertain a petition for revocation, but it would appear that it has jurisdiction to do so now. (*y*)

The Petitioner.

In Scotland, proceedings for revocation of a patent are in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only; and service of all writs and summonses in the action must be made according to the forms and practice existing at the commencement of the Act of 1883. (*z*)

Action of reduction in Scotland.

In Ireland, all parties have their remedies under or in respect of a patent as if it had been granted to extend to Ireland only. (*a*)

Revocation in Ireland.

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to his Majesty's Principal Secretary of State for the War Department, and in respect of which such Secretary of State has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller his opinion that, in the interests of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret. (*b*)

Improvements in munitions of war.

### The Petitioner.

It is to be noticed that sec. 26 sub-s. 4 of the Act of 1883 authorises various persons to present a petition for the revocation of a patent; but, whereas by sec. 109 the proceeding for revocation in Scotland is further limited, the only persons entitled to initiate proceedings for the revocation of a patent in Scotland are the Lord Advocate and persons having an interest, with his concurrence.

Persons who are entitled to take proceedings for revocation.

The Act of 1883, by sec. 26 sub-s. 4, (*c*) authorises the following persons to present a petition for the revocation of a patent:—

(1) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(2) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(*y*) 53 & 54 Vict. c. 23, s. 3; Proctor *v.* Sutton Lodge Chemical Co., (1888) R. P. C. 184.

(*z*) 46 & 47 Vict. c. 57, s. 109.

(*a*) 46 & 47 Vict. c. 57, s. 110.

(*b*) *Ibid.* s. 44 (9) (1) (3).

(*c*) Vol. II. p. 213 *post*.

The Petitioner.

(3) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.

(4) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.

(5) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

With regard to (3) the power of presenting a petition for the revocation conferred on "any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims" (*d*) relates only to cases of fraud, and will not be extended to cases of mistake, notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent rights. (*e*) Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it, or any part of it, was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the inventor might be advised to present as a person claiming to be the first and true inventor. (*f*)

If the petitioner is qualified under (3), (4), or (5), he presents his petition as of right; any other person must obtain the fiat of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, authorising the presentation.

When once the petitioner has a *locus standi* to present the petition he can impeach the patent on any lawful ground he

(*d*) *supra*.
(*e*) *In re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.
(*f*) *Ibid.*

chooses. Consequently, if he is qualified to present the petition without the fiat on any one ground, he does not need the fiat if he wishes to add other grounds. (*g*)

The Petitioner.

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General or the Lord Advocate, as the case requires, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi*. (*h*) But any person who presents a petition under any one of the above clauses is, as above stated, if he proves his right to do so, entitled to impeach the patent on any other lawful ground. (*i*)

Fiat of the Attorney-General where necessary.

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to lodge the following papers at the Law Officers Department Royal Courts of Justice.

Procedure to obtain the fiat of the Attorney-General.

1. Memorial to the Attorney-General asking for his authority and stating all the circumstances.
2. Statutory declaration on judicature paper verifying the statements in the memorial, and stating that there are no pending proceedings in the United Kingdom wherein the issues proposed to be raised by the petition or particulars of objections could be determined.
3. Two copies on brief paper of the proposed petition, and of the particulars proposed to be delivered with it, and prints of specifications and copies of documents referred to in the memorial, petition, or particulars. (*k*)
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of course; (*l*) neither does a petitioner under the present practice obtain the fiat as of right, for the Attorney-General grants or

(*g*) Morgan's Patent, (1887) 5 R. P. C. 186.

(*h*) *In re* Avery's Patent, (1887) L. R. 36 Ch. D. 307, 322; 4 R. P. C. 152, 322; see p. 296 *post*.

(*i*) Morgan's Patent, (1888) 5 R. P. C. 186.

(*k*) For forms, see Appendix.

(*l*) 1 W. P. C. 671 *n.*; R. *v.* Prosser, 14 Beav. 306.

The Petitioner.

refuses it at his discretion; though it is usual for the Attorney-General to exercise his discretion in favour of the petitioner when there is anything like a *primâ facie* case. (*m*)

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties be heard before him.

Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees; (*n*) so likewise where an action for infringement of the patent had been commenced but abandoned. (*o*) Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary. (*p*) Where the applicant was a licensee under the patent notice was directed to be given to the patentee; (*q*) so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of first instance and the hearing of an appeal; (*r*) and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month. (*s*)

Attorney-General may grant his fiat *nunc pro tunc.*

The Attorney-General has authority to grant the fiat *nunc pro tunc*. Thus in cases where the fiat is necessary to give the petitioner a *locus standi* and the petition comes on for hearing without it, the practice is to grant an adjournment in order to allow the petitioner an opportunity of obtaining the fiat *nunc pro tunc*. (*t*)

Costs of proceedings necessary to obtain Attorney-General's fiat.

The Act of 1883 gives the Attorney-General power to award the costs of proceedings before him, (*u*) including a petition for his fiat, which is heard out; but it does not give him any authority over the costs of a petition presented to him praying

(*m*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 533.

(*n*) Gaulard and Gibbs' Patent, Griff. P. C. 320.

(*o*) Bothwell's Patent, Griff. P. C. 320.

(*p*) Bell and Coleman's Patent, Griff. P. C. 320; see also *In re* Young's Patent, P. M. J. 2nd series, vol. vii. p. 44.

(*q*) Martin's Patent, Griff. P. C. 320.

(*r*) Watling's Patent, Griff. P. C. 320.

(*s*) Siddell's Patent, Griff. P. C. 320.

(*t*) Dodge's Patent, (1895) 12 R. P. C.; Jameson's Patent, (1902) 19 R. P. C. 246.

(*u*) s. 38.

for the grant of his fiat when that petition is subsequently abandoned. (x)

Grounds for Revocation.

## Grounds for Revocation.

A patent may be revoked on any ground on which previous to the Act of 1883 it could have been repealed by *scire facias*. (y)

Grounds on which patents are revoked.

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute. (z)

(1) When the King by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.

(2) When the King granteth anything that is grantable upon a false suggestion, the King by his prerogative, *jure regio*, may have a *scire facias* to repeal his own grant.

(3) When the King doth grant anything which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

It was laid down by another well-known authority (a) that the grounds on which a patent could be repealed by *scire facias* were: "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent." (b)

Thus a patent may be revoked on the grounds that the patentee was not the true and first inventor, that the alleged invention is not proper subject-matter, or lacks the essential elements of utility or novelty, or that the specifications are defective, or on any one of those grounds singly. It may also be revoked on the ground that it was obtained in fraud of the rights of the petitioner. (c) Also where the specification directs a certain thing to be done, which turns out to be not only unnecessary, but also disadvantageous and useless, the patent may be revoked on the ground of false suggestion. (d)

(x) Martin's Patent, Griff. P. C. 320.
(y) 46 & 47 Vict. c. 57, s. 26 (3).
(z) p. 88.
(a) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.
(b) See R. v. Cutler, (1847) Macr. P. C. 124; R. v. Arkwright, (1785) 1 W. P. C. 66.
(c) p. 294 *ante*; p. 300 *post*.
(d) Owen's Patent, (1899) 17 R. P. C. 68.

Grounds for Revocation.

*Parke*, B., delivering the judgment of the Court of Exchequer in a case where a patent was upset on the ground of false suggestion, said—

> The question is "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 land or tenements from the Crown is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person. (*e*) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* and *Brunton* v. *Hawkes*; 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." (*f*)

Recitals in the letters patent.

Under the present practice, all letters patent contain a recital to the effect that the patentee has represented to the Crown that he is in possession of an invention of which he is the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief; (*g*) and a further recital to the effect that the patentee has by and in his complete specification particularly described the nature of his invention. (*h*)

Distinction between a false representation recited in the patent and a false statement in the specification.

The distinction between a false representation made by the patentee and recited in the letters patent and a false statement, as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as

(*e*) Travell *v.* Carteret, 3 Lev. 135; Alcock *v.* Cooke, (1829) 5 Bing. 340.
(*f*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; 1 W. P. C. 196.
(*g*) Appendix.
(*h*) *Ibid.*

affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. (*i*)

Grounds for Revocation.

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result and the later patentee shows a different way of dealing with knowledge common at the date of the first patent. (*k*) If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle, if the method apart from the principle is not subject-matter—*i.e.*, is not an invention. (*l*)

Inventions with the same objects.

In a case (*m*) where revocation of a patent for "improvements in the preparation of foods for infants and invalids" was sought, on the ground that the petitioner had for many years previous to the date of the patent been manufacturing foods by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, *Kay*, J., in giving judgment for the petitioner said—

> "This is an application to recall a patent. It is made under the statute of 1883, which provides that a petition for revocation of a patent may be presented by, among other people, 'any person alleging that he or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.' Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked."

(*i*) See 1 W. P. C. 42 *n.*
(*k*) Walker *v.* Hydrocarbon Syndicate, Ld., (1885) 2 R. P. C. 3.
(*l*) See p. 51 *ante.*
(*m*) In the Matter of Haddan's Patent, (1885) 2 R. P. C. 219.

**Grounds for Revocation.**

Cases of revocation on the ground that the patent was obtained in fraud of the petitioner's right.

Under the following circumstances patents have been revoked on the ground that they were obtained in fraud of the rights of the petitioner. Where it appeared that the petitioner and respondent had jointly put in a provisional specification, which had been allowed to lapse, and the respondent had thereupon, without the knowledge of the petitioner, obtained the patent for the invention of which the petitioner was the first and true inventor. (*n*) And where the evidence showed that experiments finally resulting in the invention were not made by one of two separate petitioners under the direction of the patentee as the patentee contended, but by the other separate petitioner assisted by the first petitioner, and the patentee, not being the true and first inventor, had obtained the patent in fraud of the latter petitioner's rights. (*o*) And also where the petitioner was a workman in the employ of a company, one of the directors of which had asked him to invent a tap which would produce certain desired results, and the petitioner worked up the invention, made drawings and models, and perfected the tap in all details and was paid for overtime work on the models. (*p*) This last case may be contrasted with another in which the facts were that the petitioner had merely suggested to the patentee a want which was hitherto unsatisfied, but had not given any indication as to the means of supplying it, and the petition consequently failed. (*q*)

A fresh patent may be granted to the petitioner when he succeeds on the ground that the original patent was obtained in fraud of his rights, but not when he succeeds on any other ground.

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent will be revoked, and a fresh patent may be granted to the petitioner, (*r*) bearing the same date as the revoked patent, and terminating on the expiration of the term for which the revoked patent was granted, (*s*) but such a patent will not be granted as matter of course; the Comptroller-General has a discretion in the matter. (*t*)

Where the petitioner succeeds on the ground that the patent was obtained in fraud of his rights it is proper for the Court,

(*n*) Gale's Patent, (1891) 8 R. P. C. 438.

(*o*) Norwood's Patent, (1895) 12 R. P. C. 214; see also Avery's Patent, (1887) 4 R. P. C. 152; L. R. 36 Ch. D. 307: Norwood's Patent (No. 2), (1898) 15 R. P. C. 99; Marshall and Naylor's Patent, (1900) 17 R. P. C. 556.

(*p*) Marshall and Naylor's Patent, (1900) 17 R. P. C. 553.

(*q*) Jackson's Patent, (1905) 22 R. P. C. 384.

(*r*) 46 & 47 Vict. c. 57, s. 26 (8); Avery's Patent, (1887) L. R. 36 Ch. D. 326; 4 R. P. C. 152, 322; Marshall and Naylor's Patent, (1900) 17 R. P. C. 556.

(*s*) 46 & 47 Vict. c. 57, s. 26 (8).

(*t*) Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

in addition to making an order for the revocation of the patent, to grant a declaration to the effect that the respondent was not the true and first inventor of the invention; that the petitioner was the true and first inventor thereof; and that the respondent obtained the invention from him, and obtained the grant of the letters patent in fraud of the rights of the petitioner. (*u*) Practice.

When fraud is alleged, it is incumbent upon the petitioner to give strict proof of it, and if he fails to do so the petition cannot succeed. (*x*)

When the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent. (*y*)

## PRACTICE.

Every petition for the revocation of a patent must be presented in the name of the person making the allegations in respect of which the revocation is sought, such person, when necessary, being duly authorised by the fiat of the Attorney-General; (*z*) and all persons having an interest in the patent must be made respondents. (*a*) Parties.

Under the old practice it was not competent for two persons to have a *scire facias* for the same patent, (*b*) and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other. (*c*)

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition the name of the assignee may, on payment of a sum into Court, be substituted for that of the patentee as respondent. (*d*)

The petitioner is required to deliver with his petition Particulars of objections.

(*u*) Marshall and Naylor's Patent, (1900) 17 R. P. C. 553.

(*x*) Jameson's Patent, (1902) 19 R. P. C. 254.

(*y*) Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent, (1898) 15 R. P. C. 99.

(*z*) p. 295 *ante*.

(*a*) *Re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*b*) R. *v.* Neilson, (1842) 1 W. P. C. 673.

(*c*) R. *v.* Betts, (1850) 15 Q. B. 540; L. J. Q. B. 13, 53.

(*d*) *Re* Haddan's Patent, (1885) 2 R. P. C. 218.

Practice.

particulars of the objections on which he means to rely.(e) These particulars may be, from time to time, amended by leave of the Court or a Judge, (*f*) and no evidence will, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars have not been delivered.(*g*)

In a case of *scire facias*, though particulars of objection were not specially requisite, ambiguous charges were not allowed. Thus it was held that a suggestion in the words "the grant is prejudicial and inconvenient to our subjects in general" was too vague, and the Court refused to hear evidence on this issue.(*h*) Again, after a verdict had been given for the Crown it was held to be no ground for granting a new trial that the patentee could bring further evidence, if there was no allegation of surprise, or the discovery of further evidence. (*i*)

Certificate as to particulars not necessary.

In an action for infringement it is necessary for the successful party to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such particulars may be allowed on taxation; (*k*) but this does not seem necessary in the case of a petition for the revocation of a patent, and it would appear that the Court or a Judge has no power to give such a certificate. (*l*)

Interrogatories.

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement. (*m*)

Service of the petition,

All persons interested in the patent ought to be made respondents and served with the petition. (*n*)

out of the jurisdiction.

The Act of 1883 does not, however, provide any special procedure for the service of the petition out of the jurisdiction. It is therefore sufficient if such notice is given as is required by natural justice. (*o*)

In *Drummond's Patent* (*p*) it appeared that the patentee was resident and domiciled in Scotland. After a copy of the petition, together with the particulars of objection, was

(*e*) 46 & 47 Vict. c. 57, s. 26 (5). For a form of particulars of objection to be delivered with a petition for the revocation of a patent, the reader is referred to In the Matter of Haddan's Patent, (1885) 2 R. P. C. 218: and further detailed information, relative to particulars of objections, will be found at pp. 412–426 *post*.

(*f*) 46 & 47 Vict. c. 57, s. 26 (6).

(*g*) *Ibid.* (5).

(*h*) R. *v.* Arkwright, (1785) 1 W. P. C. 64 *n.*

(*i*) *Ibid.* 61, 74.

(*k*) 46 & 47 Vict. c. 57, s. 29 (6).

(*l*) *Ibid.* s. 26; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 525, 537; Waterhouse's Patent (1905) 23 R. P. C. 64.

(*m*) Haddan's Patent, (1884) 54 L. J. Ch. N. S. 126; 51 L. T. N. S. 190; W. R. (1884) 192.

(*n*) Avery's Patent, (1887) L. R. 3 Ch. D. 307; 4 R. P. C. 152.

(*o*) See King & Co.'s Trade Mark, [1892] L. R. 2 Ch. 463.

(*p*) (1889) 6 R. P. C. 756.

delivered to him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction. Practice.

In *Goerz and Hough's Patent* (*q*) the respondents were both domiciled out of the jurisdiction, and on an application for directions as to service, *North*, J., pointed out that the respondents could not be served at all, but that the proper thing for the petitioner to do was to follow the procedure adopted in *Drummond's Patent* above referred to. The Judge also stated that he could not authorise the petitioner to do anything, but that if he (the Judge) was satisfied that the respondents had had proper notice he might proceed in their absence.

In *Hirschfeld's Patent*, (*r*) on motion for directions as to service of the petition on a foreigner resident abroad, leave was given to the petitioner to send to the respondent by registered letter a copy of the petition, together with a notice that the petition had been ordered to go into the witness list. The respondent did not appear, and the patent was revoked in his absence.

In *Kay's Patent* (*s*) one of three respondent joint patentees was out of the jurisdiction, and the petition had been duly served on the other two within the jurisdiction. On motion for directions, it was ordered that the petition should go into the witness list; but unless the third patentee appeared by counsel on notice given to him (*t*) it should not come on for hearing without leave; and liberty was given to either party to apply.

In *Allison's Patent* (*u*) the foreign owners being resident abroad, and solicitors who had appeared for them in an action against the petitioners declining to undertake to appear, the petition, upon an application for directions, was ordered to go into the witness list and the petitioners were directed to give notice to the solicitors, and, by registered letter, to the owners abroad, with a copy of the petition.

(*q*) (1895) 12 R. P. C. 370.
(*r*) (1895) 11 R. P. C. 514.
(*s*) (1894) 11 R. P. C. 279.
(*t*) As in King & Co.'s Trade Mark, 9 R. P. C. 350.
(*u*) (1900) 17 R. P. C. 297.

Practice.

Respondent out of the jurisdiction cannot be compelled to give security for costs.

The Court will not compel a respondent out of the jurisdiction to give security for costs, since he does not appear before the Court in consequence of his own application. (*v*)

Respondent has the right to begin at the hearing.

At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has, by statute, the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent. (*x*)

In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *primâ facie* case. (*y*)

Petition is an action and tried like other actions.

A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *vivâ voce* evidence—if either of the parties desires to have it so determined. (*z*)

Form of order.

The proper form of order upon a successful petition varies according as the Court finds that all or only some of the claiming clauses of the specification are bad. (*a*) Sometimes the Court by the order imposes conditions with regard to future actions brought upon the specification, if amended. (*b*)

Mode and date of trial.

If it is desired to have the petition tried with witnesses the proper course is to make an application, on the day on which the petition is returnable, that the petition should go into the witness list, at or after a named date, to be tried on oral evidence. (*c*) The parties, when arranging the date, should be careful to fix a date by which they are likely to be ready for trial, otherwise the petition may be struck out, though it may be set down again without the necessity of serving a fresh petition. (*d*)

Discovery and inspection.

The day on which the petition is returnable and comes into the list is the proper time for the parties, or either of them, if they want discovery or inspection, or anything else, to say so, and the petition ought not to be put into the witness list until it is effective for hearing. (*e*)

Trial on affidavit evidence.

When the petition is to be tried by the Court on affidavit evidence, it is proper for the party who has the right to begin

(*v*) Miller's Patent, (1894) 11 R. P. C. 55; La Société Anonyme Trade Mark, (1893) 10 R. P. C. 290.

(*x*) 46 & 47 Vict. c. 57, s. 26 (7).

(*y*) R. *v.* Cutler, Macr. P. C. 124, 133, 134.

(*z*) *In re* Gaulard and Gibbs' Patent, (1886) L. R. 34 Ch. D. 396.

(*a*) See Vol. II. p. 83.

(*b*) See Vol. II. pp. 95-99.

(*c*) Miller's Patent, (1894) 11 R. P. C. 55; Borrowman's Patent, (1902) 19 R P. C. 160.

(*d*) See Borrowman's Patent, (1902) 19 R. P. C. 160.

(*e*) Scott's Patent, (1902) 276.

to file his evidence in chief first, and if there is any cross-examination of any of the witnesses of either side such cross-examination ought to be brought before the Court at the trial. (*f*) Practice.

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. (*g*) Trial with assessor.

Unless the Court otherwise decide, the petition is, by statutory provision, heard without a jury. (*h*) Trial without a jury.

To suit the convenience of the parties to the petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes. (*i*) Trial at assizes.

Again, if there is an action for infringement of the patent pending, an order may be obtained for the hearing of the petition at the same time as the trial of the action. (*k*) If there is a pending appeal in an action on the patent, an order may be obtained, in a proper case, for the postponement of the hearing of the petition till after the determination of the appeal. (*l*) Hearing at same time as an action for infringement.

As a rule joint petitioners must appear by the same counsel, but in *Norwood's Patents* (*m*) two joint petitioners were, under the peculiar circumstances of the case, allowed to appear separately, and one conducted his case in person. (*n*) Joint petitioners must appear by same counsel.

Where the respondent consents, an order for revocation with costs will be made when the petition comes on for directions. (*o*) Judgment for revocation should be pronounced in open Court and not, even by consent, in Chambers. (*p*) Revocation when respondent consents.

When the respondent does not appear the patent may be revoked at once on the petition coming on and the production of affidavits verifying the service and the grounds of revocation stated in the petition. (*q*) And since petition is the only way open to a member of the public to obtain the revocation Revocation when respondent does not appear.

(*f*) Gale's Patent, (1891) 8 R. P. C. 438.

(*g*) 46 & 47 Vict. c. 57, s. 28.

(*h*) *Ibid.*

(*i*) R. S. C. O. 36, r. 8; In the Matter of Edmond's Patent, (1889) 6 R. P. C. 355.

(*k*) Edge's Patent, (1890) W. N. 149.

(*l*) Hitchcock's Patent, (1903) 20 R. P. C. 767.

(*m*) (1895) 12 R. P. C. 214.

(*n*) Norwood's Patents, (1895) 12 R. P. C. 219, 221.

(*o*) Sleight's Patent, (1893) 10 R. P. C. 447; Rendell's Patent, (1894) 11 R. P. C. 277; Wilkinson's Patent, (1894) 11 R. P. C. 298.

(*p*) Clifton's Patent, [1904] 2 Ch. 357; 21 R. P. C. 515.

(*q*) Hirschfeld's Patent, (1894) 11 R. P. C. 514; Vaisey's Patent, (1894) 11 R. P. C. 553; Ingram's Patent, (1896) 13 R. P. C. 446; Cerckel's Patent, (1898) 15 R. P. C. 500; Partridge's Patent, (1903) 20 R. P. C. 459; Lee's Patent, (1906) 23 R. P. C. 233.

Practice.

of a void patent, costs will be given against a respondent patentee who does not appear. (*r*) Also costs will be given against a respondent who abandons his case. (*s*)

No estoppel against an unsuccessful defendant to an action for infringement.

There is no estoppel against a petitioner for revocation who has been an unsuccessful defendant to an action for infringement of the patent brought at the instance of the respondent. The reason of this is, that the petitioner on the petition appears as a member of the public, and consequently there is no *res judicata* between him and the respondent in that capacity. (*t*) And this fact will materially influence the Court of Appeal in exercising its discretion to allow fresh evidence of invalidity upon the appeal of an unsuccessful defendant to an action for infringement. (*u*)

Old practice as to nonsuits and postponements of actions for infringements pending a *scire facias*.

Under the old practice, the fact of a *scire facias* pending was a ground for refusing a nonsuit on an objection to a patent in an action for infringement. (*x*) Where a *scire facias* was sued out after a verdict in an infringement action, and a rule obtained to show cause why a nonsuit should not be entered, the Court refused to extend the time for this rule until after the hearing of the *scire facias*. *Tindal*, C.J., pointed out that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objections taken at the trial of the cause. (*y*) So also the Court refused to deprive the plaintiff in an action for infringement of his Common Law right to try where a *scire facias* had been set down. (*z*) As a general rule, the plaintiff had a right to have his cause go on to trial, according to the ordinary course of business, but there might be special circumstances upon which the Court might see fit to interpose. (*a*)

Where, in a case in the Common Pleas, an action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, the Court suspended judgment upon the rule for a new trial, and ordered the trial of the

(*r*) Wallace's Patent, (1895) 12 R. P. C. 444; Simmon's Patent, (1895) 12 R. P. C. 446.

(*s*) Dodge's Patent, (1895) 12 R. P. C. 448.

(*t*) Deeley's Patent, (1895) 12 R. P. C. 192, 199; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 533; Lewis and Stirkler's Patent, (1897) 14 L. R. 24, 35.

(*u*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530, 533.

(*x*) Haworth *v.* Hardcastle, (1834) 1 W. P. C. 485.

(*y*) *Ibid.* 486 *n.*

(*z*) Muntz *v.* Foster, (1843) 2 W. P. C. 93 *n.*

(*a*) *Ibid.*

Practice.

other action to be postponed until after the trial of the *scire facias*; (*b*) and in another action in the Common Pleas, where it appeared that the defendants had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench, and the defendant in the Common Pleas gave notice of trial *by proviso*, the Court upon the application of the plaintiff made a rule absolute for postponing the trial. (*c*)

Fresh evidence on appeal from order for revocation.

In *Walker* v. *The Hydrocarbon Syndicate* (*d*) an application for the postponement of an appeal in a petition for revocation, on the ground that the petitioner could not be found at the hearing, and for leave to adduce further evidence, was refused.

Amendment of specification pending proceedings for revocation.

The respondent may, if he thinks fit, on obtaining the leave of the Court or a Judge, during a proceeding for the revocation of his patent, apply at the Patent Office for leave to amend his specification by way of disclaimer—*i.e.*, a mere disclaimer and not an amendment amounting to a correction or explanation, (*e*) and a postponement of the hearing may be granted to allow of this being done. (*f*)

Stay of proceedings on order for revocation pending an appeal.

If a petitioner succeeds in obtaining the order of the Court for the revocation of a patent he must forthwith leave at the Patent Office a copy of such order, and the purport of it will be duly entered in the Register of Patents, (*g*) but the Patents Act, 1883, (*h*) and the Patent Rules, 1903–5, do not deprive the Court of its power to stay proceedings on an order pending an appeal; (*i*) and it is submitted that in all cases the order should, in view of questions which may arise as to its effect, be suspended until the disposal of an appeal or an application to amend the specification if the respondent asks for such suspension. (*k*)

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled, (*l*) but recent legislation has not provided for the

(*b*) Patteson *v.* Holland, Hindmarch Patents, p. 293.
(*c*) Smith *v.* Upton, (1843) 6 M. & G. 251.
(*d*) (1886) 3 R. P. C. 253.
(*e*) Owen's Patent, (1898) 43 S. J. 43.
(*f*) 46 & 47 Vict. c. 57, s. 19; Vol. II. p. 209.
(*g*) P. R. (1890) r. 74.
(*h*) ss. 18 and 19.
(*i*) Armstrong's Patent, (1897) 14 R. P. C. 755; Owen's Patent, (1899) 17 R. P. C. 79.
(*k*) See Vol. II. p. 83.
(*l*) R. *v.* Newton, Hindmarch on Patents, p. 427; R. *v.* Eastern Archipelago Co., (1853) 4 De G. M. & G. 199.

Practice.

delivering up of a patent which has been revoked by a decision of the Court.

Effect of an order for revocation.

The judgment of the Court itself is a revocation of the patent, and the practice now is for the Comptroller to register the judgment. If this judgment of revocation is reversed by a Court of Appeal, the judgment of that Court is then entered on the register, and the patent is resuscitated again. (*m*) It is proper for the Court to stay proceedings on the order for revocation pending an appeal. (*n*)

It is to be noticed that a decision of the Court in an infringement action against the validity of the patent does not absolutely annul the patent, since it is not an order for the revocation of the patent; (*o*) and it is open to a patentee by amendment of the specification to remove the ground on which the Court has held the patent to be bad; and, if there is sufficient subject-matter left, he may thus make the patent perfectly valid, (*p*) though it may still be liable to attacks by petition for revocation on the ground that what is left is, in fact, not subject-matter. (*q*)

*Costs.*

The Act of 1883 does not contain any special provision as to the costs on the hearing of a petition for revocation, but the Court, acting under its general jurisdiction, awards the costs of the petition at its discretion, (*r*) but does not include the costs (if any) occasioned by an application to the law officer for his fiat to present the petition. (*s*)

(*m*) Deeley *v.* Perks, (1896) 13 R. P. C. 586, 587; Armstrong's Patent, (1897) 14 R. P. C. 755.

(*n*) Armstrong's Patent, (1897) 14 R. P. C. 755; Deeley *v.* Perks, (1896) 13 R. P. C. 586, 587.

(*o*) Deeley's Patent, (1894) 11 R. P. C. 75; Deeley *v.* Perks, (1896) 13 R. P. C. 581; [1896] A. C. 498.

(*p*) Vol. II. p. 65.

(*q*) Deeley's Patent, (1895) 12 R. P. C. 192; 13 R. P. C. 581.

(*r*) In the Matter of Haddan's Patent, (1885) 2 R. P. C. 218; In the Matter of Edmond's Patent, (1889) 6 R. P. C. 358.

(*s*) Rendell's Patent, (1894) 11 R. P. C. 279.

# CHAPTER VII.

## ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

### PART I.—GENERAL.

SEC. 32 of the Patents, Designs, and Trade Marks Act of 1883 enacts that:— Sec. 32 of Act of 1883,

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

The principle embodied in this enactment seems to have been recognised by *Malins*, V.C., as early as 1871, (*a*) though the conclusion at which the learned Judge arrived—viz., that at that date the Court would restrain a patentee from issuing circulars threatening legal proceedings against alleged infringers unless he would undertake to commence proceedings to assert the validity of the patent—appears to have been based on the erroneous assumption that there is no presumption at law in favour of the validity of a patent which has not been declared void. (*b*) It was subsequently held by creates a statutory right.

(*a*) *Rollins v. Hinks*, (1872) L. R. 13 Eq. 355; *Axman v. Land*, (1874) L. R. 18 Eq. 330.

(*b*) *Judgment of Jessel*, M.R., *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 520, 523.

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*Jessel*, M.R., and affirmed on appeal, (*c*) that no such principle at that date existed, and that a patentee was, in the absence of *mala fides*, justified in giving notice that his rights were being infringed without following up such notice by an action for the alleged infringement.

Slanderous statements made by patentee may be restrained apart from s. 32 of Act of 1883.

The Court has and always had power, by injunction, to restrain any person from making slanderous statements calculated to injure the business of another person, whether the statements complained of are oral or written, (*d*) and damages for the slander of title may be obtained upon proof of the absence of privilege and the existence of express malice on the part of the slanderer. (*e*)

Cases within either of the saving clauses of s. 32 of Act of 1883 are governed by the law in existence before the Act of 1883.

It is to be noticed that the foregoing section of the Act of 1883 does not apply to cases which are within either of the saving clauses—that is to say, to cases where the alleged manufacture, use, sale, or purchase to which the threats related are in fact an infringement of any legal rights of the person making such threats, and to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within either of the saving clauses of sec. 32 of the Act of 1883 are still governed by the law as it existed prior to the Act. (*f*)

Statement of such law.

The law thus referred to as applicable to such cases was, and is, that a patentee was not liable for issuing circulars or other threats warning persons against using articles which he alleged were infringements of his patent, provided that he issued such notices *bonâ fide* and in the belief that the articles in question were really infringements. (*g*) Moreover, a patentee was not liable to be restrained by injunction from continuing to issue notices that the articles complained of were infringements, unless such statements were proved to be untrue, so that the further issue of them would not be *bonâ fide*, and would damnify the person threatened. (*h*)

(*c*) Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

(*d*) Loog *v.* Bean, (1884) L. R. 26 Ch. D. 306; Thomas *v.* Williams, (1880) L. R. 14 Ch. D. 864; Beddow *v.* Beddow, (1878) L. R. 9 Ch. D. 89; Saxby *v.* Easterbrook, (1878) L. R. 3 C. P. D. 339; Thorley's Cattle Food Co. *v.* Massam, (1877) L. R. 6 Ch. D. 582; Riding *v.* Smith, (1877) L. R. 1 Ex. D. 91.

(*e*) *Ibid.*; Montgomerie *v.* Paterson, (1894) 11 R. P. C. 221, 633.

(*f*) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(*g*) Wren *v.* Wield, (1869) L. R. 4 Q. B. 730; Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; Sharp *v.* Brauer, (1886) 3 R. P. C. 193; Skinner *v.* Shew, (1893) L. R. 1 Ch. 413.

(*h*) Burnett *v.* Tate, (1883) 45 L. T. N. S. 743; Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 390; Sugg *v.* Bray, (1885) 2 R. P. C.

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Though the patentee was entitled to issue notices containing statements that articles being sold by others were infringements of his rights, if such statements were made with reasonable and probable cause, (*i*) an action would lie if the statements were not simply allegations of infringements, but went on to allege, as matters of fact, assertions which were not true. A question of infringement is one of law, and, in the words of *Bramwell*, L.J., (*k*) "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts."

In some cases the patentee makes threats against persons making, using, selling, or purchasing articles which he considers to be infringements of his patent rights, as a means of protecting his own property; on the other hand, sometimes such threats are circulated maliciously, and *malâ fide*, with the intention of injuring the trade of the person against whom they are made.

Before the Act of 1883, it was held that if a statement as to infringement was made by the patentee in defence of his own property, although it injured and was untrue, it was a privileged statement; it was a statement that the defendant had a right to make, unless, besides its untruth, and besides its injury, express malice was proved—that is to say, want of *bona fides* and the presence of *mala fides*. (*l*) In other words, if such a statement was made *bonâ fide*, though the party affected might be able to prove *damnum*, he could not at Common Law establish *injuria*, and consequently, it being merely a case of *damnum sine injuria*, he could not saddle the patentee with the commission of any tort. (*m*) It was also held that there was no obligation on the part of a person, who had issued notices stating that the acts of another were an infringement of his patent rights, to follow up such statements with an action for infringement against the person mentioned, for he might desist, and render such action unnecessary, or he might not be worth suing at all. (*n*)

Plaintiff intending to rely on the old

If the plaintiff in an action to restrain the issue of threats

224; Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 40; 49 L. J. Ch. 812. As to Interlocutory Injunctions see Dredge *v.* Parnell, (1896) 13 R. P. C. 392.

(*i*) Per Baggallay, L.J., Halsey *v.* Brotherhood, (1881) L. R. 19 Ch. D. 390.

(*k*) Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 22.

(*l*) Per Coleridge, L.C.J., Halsey *v.* Brotherhood, (1881) L. R. 19 Ch. D. 383; Sugg *v.* Bray, (1885) 2 R. P. C. 243; see also Skinner *v.* Shew, (1893) L. R. 1 Ch. 413.

(*m*) Commercial Development Corporation, Ld. *v.* Castner-Kellner Alkali Co., (1897) 14 R. P. C. 939.

(*n*) Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 518.

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law must disclose his case as to *mala fides*.

of legal proceedings intends to rely on the old law and not on sec. 32 of the Act of 1883, he should disclose his case as to *mala fides* in his affidavits in support of his motion for an injunction. (*o*)

Law altered by Act of 1883.

The Act of 1883 has completely altered the law with regard to cases within sec. 32 in favour of the public, for it provides that if a person claiming to be a patentee, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability, in respect of any alleged manufacture, use, sale, or purchase of the invention, and does not with due diligence commence and prosecute an action for the infringement of his patent, he is liable to be sued by the person or persons who are aggrieved by such threats, and an injunction restraining the continuance thereof may be obtained, and damages awarded against him, if it turns out that the alleged manufacture, use, sale, or purchase was not, in fact, an infringement of any of his legal rights. (*p*)

*Bona fides* of the patentee immaterial when s. 32 of Act of 1883 applies.

If the case is within sec. 32 and a person aggrieved brings an action against the patentee to restrain the issue of threats of legal proceedings, or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, the question of the *bona fides* of the patentee does not affect the case one way or the other. (*q*) The only defence open to the patentee, if he has not at the date of the action with due diligence commenced and prosecuted an action for infringement of his patent, is to show that the allegations contained in the threatening notices were, in fact, true. (*r*) Thus an injunction was granted where the defendant refused to bring an action for infringement or to test the validity of his patent which was put in issue by the plaintiff. (*s*) The burden of proof that the patentee's statements are untrue lies, *primâ facie*, on the plaintiff, (*t*) as it did before the Act of 1883, (*u*) though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true. (*x*)

(*o*) English and American Machinery Co. *v.* Gare Machine Co., (1894) 11 R. P. C. 631.

(*p*) p. 309 *ante*.

(*q*) Kurtz *v.* Spence, (1888) 5 R. P. C. 161; *Herrburger v. Squire*, (1888) 5 R. P. C. 581; Skinner *v.* Shew, (1893) L. R. 1 Ch. 413.

(*r*) Crampton *v.* Patents Investment Co., (1888) 5 R. P. C. 382; 6 R. P. C. 287; Automatic Weighing Machine Co. *v.* Combined Weighing and Measuring Machine Co., (1889) 6 R. P. C. 120.

(*s*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 45.

(*t*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363; Barney *v.* United Telephone Co., Ld., (1885) 2 R. P. C. 173.

(*u*) Burnett *v.* Tate, (1882) 45 L. T. N. S. 743; Anderson *v.* Liebig's Extract of Meat Co., (1881) 45 L. T. N. S. 757, 759.

(*x*) Challender *v.* Royle, (1887) L. R. 39 Ch. D. 435; 4 R. P. C. 363.

A person who merely holds an agreement for an assignment of *the* patent upon terms does not possess legal rights of which the acts referred to in a threat could be an infringement; (*y*) neither, it would appear, does a patentee who has obtained leave under sec. 19 of the Act of 1883 in a pending action for infringement or a petition for revocation of the patent, for the fact of asking for leave to amend amounts to an admission that the patent is bad without amendment of the specification, and he is not, therefore, entitled to issue threatening notices till the amendment is actually made. (*z*) In such a case an injunction restraining the issue of the threats may be obtained upon motion in the pending proceeding. (*a*)

Person Aggrieved.

Equitable assignee, or a patentee who has obtained leave to amend under s. 19 of Act of 1883, does not possess legal rights of which acts complained of in a threat could be an infringement.

*It would appear doubtful whether the section applies in the* case of threats made by a licensee or other person having only a limited interest in the patent. It must be remembered that a mere licensee cannot sue alone for an infringement of the patent, and it is doubtful whether an exclusive licensee can do so, (*b*) because the term "patentee" as used in the Act means the person for the time being entitled to the benefit of the patent, (*c*) and it is doubtful whether this term would be held to include an exclusive licensee. (*d*) If an exclusive licensee cannot justify an action for the infringement of the patent, he cannot avail himself of the proviso, and it is submitted, *therefore, in such case* the section could not be held to apply.

Threats by a licensee.

**Person aggrieved.**—The right of action conferred by sec. 32 of the Act of 1883 is given to "any person aggrieved." In founding the action, therefore, it is always necessary to consider whether the proposed plaintiff is really a person aggrieved. When threats are made against the customers of the person who supplies or agrees to supply the articles in respect of which the threats are made, that person is a person aggrieved and may bring the action, (*e*) and he is none the less a "person aggrieved" because he has a binding contract with his customer which he might have enforced, if minded so to do. (*f*) Also if the threats are made against the plaintiff's

Who is a person aggrieved.

(*y*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

(*z*) Fusee Vesta Co. *v.* Bryant and May (No. 2), (1887) 4 R. P. C. 191.

(*a*) *Ibid.*

(*b*) Vol. II. p. 156.

(*c*) 46 & 47 Vict. c. 57, s. 46.

(*d*) Barnett *v.* Barrett's Screw Stopper Bottling Co., (1884) 1 R. P. C. 9.

(*e*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; Colley *v.* Hart, (1898) L. R. 44 Ch. D. 179; 7 R. P. C. 101; Skinner *v.* Shew, (1893) L. R. 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

(*f*) Hoffnung *v.* Salsbury, (1899) 16 R. P. C. 375.

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licensee the plaintiff is a person aggrieved. (*g*) In one case an injunction was granted where the threat was addressed to a person manufacturing for the plaintiff, but the point whether the plaintiff was a person aggrieved does not appear to have been argued. (*h*)

The evil which s. 32 of the Act of 1883 was intended to guard against.

**What is a Threat?**—In considering the question what are threats within the meaning of sec. 32 of the Act of 1883, it is well to bear clearly in mind what the evil was which the enactment of the section was intended to guard against. Before the section became law, a person aggrieved by the issue of threats of legal proceedings, or liability, at the instance of a person claiming to be the patentee of an invention in respect of which the threats were made, could only obtain the injunction of the Court restraining such threats and damages in respect of them, if he was able to discharge the *onus* which was upon him of proving that the threats were issued *malâ fide* and without reasonable excuse. This *onus* of proof, which was upon the party aggrieved, almost nullified the remedy by injunction because of the extreme difficulty of proving that the patentee had put forward his assertion of patent rights maliciously and without just cause or excuse. The threat of a patent action is well calculated to paralyse the business of persons aggrieved, and in the words of *Bowen*, L.J., (*i*) "the Legislature desires that threats of patent actions shall not hang over a man's head—that the sword of Damocles, in such a case, should either not be suspended or should fall at once, and it is with that view that the section seems to be framed." The object of the Legislature, therefore, was to prevent persons claiming to be patentees from issuing *any* kind of threat the result of which might be to paralyse a man in his trade by having an action on a patent suspended before his eyes without the opportunity of determining the suspense at once and bringing the question to a speedy and immediate issue. (*k*) Upon this view of the evil which the section was designed to guard against, the Court of Appeal have held that the words "*or otherwise*," as used in the section, are not to be construed *ejusdem generis* with "*circulars*" and "*advertisements*," but that, on the contrary, the words "*circulars*" and "*advertisements*" enlarge the meaning of the words "*or otherwise*" so as to include within the section all threats of whatsoever kind made

Effect of the words "or otherwise" as used in s. 32 of the Act of 1883.

(*g*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

(*h*) Webb *v.* Levinstein, (1898) 15 R. P. C. 78.

(*i*) Skinner *v.* Shew, [1893] 1 Ch. 425.

(*k*) *Ibid.*

in respect of any alleged manufacture, use, sale, or purchase of an invention by a person claiming to be the patentee thereof. (*l*)

**What is a Threat?**

Threats within sec. 32 may, as above stated, be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter, (*m*) in a private letter, (*n*) and in a letter written without prejudice, (*o*) or in answer to an inquiry as to whether the patentee considered a certain article an infringement of his patent, (*p*) are actionable. Further, a statement made by the patentee, or on his behalf, though it does not contain any direct reference to the patent, may, nevertheless, amount to a threat within the section. Thus, where the defendant wrote to probable customers of the plaintiff that they must not be surprised if he, the defendant, applied for an injunction against the plaintiff to restrain him from selling the articles in question, the Court held that such statement amounted to a threat in respect of the patent, and granted an injunction in the terms of the section. (*q*) It is submitted that the Court has power under this section to restrain oral statements which contain threats of legal proceedings against, or liability on the part of, persons aggrieved by allegations made by the patentee to the effect that they have infringed his patent. (*r*)

Nature of threats which have been held to be within s. 32 of the Act of 1883.

Continuation of threats by a person within the proviso of s. 32 of Act of 1883 pending action.

The question may arise as to how far a person who has issued threats within the meaning of sec. 32 of the Act of 1883, and brought himself within the proviso by, with due diligence, commencing and prosecuting an action for infringement, is justified in continuing the threats whilst the action is pending. In this connection there is the authority of *Kekewich*, J., in *Fenner* v. *Wilson*, (*s*) for the proposition that, quite apart from sec. 32 of the Act of 1883, a plaintiff in a pending action for infringement may, on motion in the action, be restrained from issuing advertisements warning the public that they are

(*l*) Skinner *v.* Shew, [1893] 1 Ch. 413; Bishop *v.* Inman, (1900) 17 R. P. C. 755.

(*m*) Duffield *v.* Waterloo, (1886) 3 R. P. C. 46; L. R. 31 Ch. D. 638; Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 393; The Combined Weighing and Advertising Machine Co. *v.* The Automatic Weighing Machine Co., (1889) 6 R. P. C. 592; Edlin *v.* Pneumatic Tyre and Brooks Cycle Agency, (1893) 10 R. P. C. 312; Hoffnung *v.* Salsbury, (1899) 16 R. P. C. 377; Engels *v.* Hubert Unchangeable Eylet Syndicate, (1902) 19 R. P. C. 201.

(*n*) Walker *v.* Clarke, (1887) 4 R. P. C. 113; Burt *v.* Morgan, R. P. C. 278.

(*o*) Kurtz *v.* Spence, (1888) 5 R. P. C. 173.

(*p*) Skinner *v.* Shew, [1893] 1 Ch. 413; but see Beven *v.* Welsbach Incandescent Gas Light Co., Ld., (1902) 20 R. P. C. 69.

(*q*) Douglass *v.* Pintsch's Patent Lighting Co., (1896) 13 R. P. C. 673.

(*r*) Kurtz *v.* Spence, (1888) 5 R. P. C. 161, 172, 173.

(*s*) (1893) 10 R. P. C. 283; see also Goulard *v.* Lindsay, (1887) 4 R. P. C. 189.

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liable in damages for using the subject-matter of the plaintiff's patent, if such advertisements amount to statements that the pending action must succeed. The injunction is granted on the ground that the issue of such advertisements may prejudice the defendant, and so be an interference with the even course of justice; (*t*) and in such a case the order ought not to contain any undertaking as to damages, since, though subject to appeal, it is not obtained on interlocutory proceedings in the true sense. (*u*) It is submitted that there is at least great doubt upon the question of fact as to whether such a warning by a patentee could be an interference with the course of justice and as such a contempt of Court in respect of which the Court should issue an injunction. (*v*) The Court of Appeal, in *Fenner* v. *Wilson*, without expressing any opinion on the proposition of law above formulated, stated that they could not consider the advertisements complained of in that case as amounting to contempt of Court. (*x*) In *De Mare's Patent* (*y*) it was pointed out by *Byrne*, J., that if, and so far as, threats might but for the section have been held, by reason of their being threats, to fall within the rule of the Court in reference to comment upon public proceedings, the section may have made a change in the case of a person who has brought himself within the proviso by with due diligence commencing and prosecuting an action for infringement. The learned Judge expressed himself to be clearly of opinion that the section was never meant, to a greater extent than possibly as above stated, to justify any public discussion on the merits of pending litigation.

*Bonâ fide* notice by plaintiff to customers of defendant in an infringement action.

The plaintiff in a pending action for infringement is entitled to give *bonâ fide* notice to the defendant's customers that, by dealing in the goods supplied by the defendant, they expose themselves to the risk of actions by the plaintiff, and that, in the event of the plaintiff succeeding against them in such actions, they are liable to pay damages and costs and to have their goods which were so purchased destroyed by order of the Court. (*z*)

(*t*) Fenner *v.* Wilson, (1893) 10 R. P. C. 283; Goulard *v.* Lindsay, (1887) 4 R. P. C. 189.

(*u*) Fenner *v.* Wilson, (1893) 10 R. P. C. 287.

(*v*) See Haskell Golf Ball Co. *v.* Hutchison, (1904) 21 R. P. C. 497.

(*x*) Fenner *v.* Wilson, (1893) 10 R. P. C. 287.

(*y*) (1899) 16 R. P. C. 530.

(*z*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1897) 14 R. P. C. 180; see also Dunlop Pneumatic Tyre Co. *v.* New Seddon Pneumatic Tyre and Self-closing Tube Co., (1897) 14 R. P. C. 332; Nähmaschinen Fabrik *v.* Singer Manufacturing Co., (1893) 10 R. P. C. 310; Dunlop Pneumatic Tyre Co., Ld. *v.* Clifton Rubber Co., Ld., (1902) 19 R. P. C. 527.

**What is a Threat?**

The question whether a threat, to be actionable under sec. 32 of the Act of 1883, must be not merely a warning about something that is going to be done, but must be a threat about an act done—*i.e.*, whether it must be a threat of legal proceedings in respect of an alleged actual manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase, cannot be said to have been, as yet, definitely decided by the Courts. There are expressions in the judgments delivered by the Court of Appeal, especially in that of *Bowen*, L.J., in *Challender* v. *Royle*, (*a*) which, if read apart from the particular case, support the view that a threat in respect of a proposed manufacture, use, sale, or purchase, would not be a "threat" within the meaning of the section; but in the later case of *Johnson* v. *Edge*, (*b*) the Court of Appeal without deciding the point, which was not necessary to the decision of that case, expressed grave doubts as to whether upon the true construction of the section it does exclude intended infringements which have not actually taken place, and as to whether the language used by *Bowen*, L.J., in the judgment above referred to is to be taken to mean that, in all cases, such intended infringements are so excluded. It is submitted that the first part of the section should be construed as correlative with the proviso; and that consequently all threats of legal proceedings or liability in respect of any alleged past or future manufacture, use, sale, or purchase of an invention issued by or on behalf of a person claiming to be the patentee of such invention, are threats within the section, if the person claiming to be a patentee is in a position when the threats are issued to found an action for the infringement of his patent upon the past or future Acts referred to therein. A patentee may found an action upon a threatened infringement, even though no actual infringement has taken place. (*c*) And, it is submitted, sec. 32 must be interpreted as including any threat made by the patentee in respect of any alleged intended infringement, when the person threatened has actually done something which the patentee is justified in construing as an expression of an intention to infringe.

Question whether threat to be actionable under s. 32 of Act of 1883 must relate only to an act done, or whether it may relate to something proposed to be done.

Sec. 32 of the Act of 1883, according to this view of its construction, does not in any way limit the right of every

*General warning to infringers issued by a patentee.*

(*a*) (1887) L. R. 36 Ch. D. 425.

(*b*) (1892) 9 R. P. C. 142; see also judgment of Kekewich, J., in Kurtz v. Spence, (1888) 5 R. P. C. 171; and of Day, J., in Willcugluby *v.* Taylor, (1894) 11 R. P. C. 52.

(*c*) See p. 384 *post*.

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patentee to issue a general warning to infringers, and to advise the public that the patent to which he is entitled, and under which he claims, is one which he intends to enforce. (*d*) It must, however, be remembered that what at first sight appears to be a justifiable general warning may, in view of the peculiar circumstances of a particular case, well be construed as a threat directed against a particular individual, and so actionable under the section. (*e*)

In the event of a patentee obtaining an injunction and damages against a manufacturer, he is entitled to warn purchasers from the manufacturer not to pay the purchase-money to him, and that, if the manufacturer fails to pay the damages, he (the plaintiff) will claim from the purchasers. (*f*)

Use of a thing *simpliciter* as distinguished from use in a particular manner.

If the use *simpliciter* of a certain apparatus does not amount to an infringement of the patent, but the use of that apparatus in a particular manner does amount to such an infringement, the patentee cannot escape liability for issuing threats to the users of such apparatus, unless he makes it perfectly clear that what he complains of is not the use *simpliciter*, but the use in the particular manner specified. (*g*)

Threat not withdrawn.

A threat which is not withdrawn is considered as continuing. (*h*)

**The Proviso.**—Sec. 32 of the Act of 1883 provides that the remedy created by the section shall not be applicable, if the person making the threats complained of, with due diligence, commences and prosecutes an action for infringement of his patent.

Nature of infringement action which will secure the benefit of the proviso.

The question naturally arises, By whom and against whom and when must such an action be commenced and prosecuted, so as to bring the case within the proviso?

The proviso will not be satisfied unless the action for infringement is brought by the person making the threats—*e.g.*, an action brought by the equitable or legal assignee of the defendant to the threats action will not do. (*i*) Also the proviso will not be satisfied unless the action for infringement is in respect of the patent to which the threats relate, but, if

(*d*) Johnson *v.* Edge, (1892) 9 R. P. C. 142; Challender *v.* Royle, (1887) 2 R. 36 Ch. D. 428; Crowther *v.* United Flexible Metallic Tubing Co., Ld., (1905) 22 R. P. C. 549.

(*e*) Johnson *v.* Edge, (1892) 9 R. P. C. 142, 148; Bishop *v.* Inman, (1900) 17 R. P. C. 760.

(*f*) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305, 312.

(*g*) Burt *v.* Morgan, (1887) 4 R. P. C. 278.

(*h*) Driffield *v.* Waterloo, (1886) L. R. 31 Ch. D. 638, 643.

(*i*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

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several patents relate to the same general subject-matter, it is not necessary that the patentee bring the action in respect of all such patents. (*k*) When the threat complained of was issued subsequently to the determination of one action of infringement adversely to the patentee, the proviso is satisfied by the commencement and prosecution with due diligence of a fresh action of infringement against another alleged infringer. (*l*)

It is not always possible for the defendant to a threats action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee of a rival machine would necessarily be a person aggrieved if threats were made against him; but if such person does not manufacture and sell, but only licenses the manufacture and sale of such rival machine, there would be no means of bringing an action for infringement against him.

It would appear that what the words of the proviso point at is a case where some act has been done which can be tested whether or not it is an infringement. The words, "if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats," clearly point to an act done or contemplated which has been alleged to be, but as a matter of fact is not, an infringement of the patent of the person issuing the threat, and the mere fact that, where the owner of a rival patent is the aggrieved person, it is in many cases impossible that an action for infringement should be brought against him, precludes the notion that the action mentioned in the proviso must be confined to an action against the aggrieved party. (*m*) On the contrary, the proper view seems to be that the proviso will be satisfied if an action for infringement of the patent be honestly brought and diligently prosecuted against any person to whom the threats complained of are applicable; (*n*) and probably also if an action for infringement is commenced and prosecuted with due diligence against a person to whom the threats cannot be said to relate at all; (*o*) but there is authority for saying that an action commenced against a third party in respect of

(*k*) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(*l*) Waite and Saville, Ld. *v.* Johnson Die Press Co., Ld., (1900) 18 R. P. C. 1.

(*m*) See p. 313 *ante*.

(*n*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Day *v.* Foster, (1890) 7 R. P. C. 54.

(*o*) See Lycett Saddle and Motor Accessories Co., Ld. *v.* J. B. Brook & Co., Ld., (1904) 21 R. P. C. 656.

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infringements totally different to those alleged against the plaintiff to the threat action is not an action for infringement within the meaning of sec. 32, (*p*) though there is authority pointing the other way, (*q*) and it would appear to be clear that if the article referred to in the threat is of a class which would come into the account in the event of the infringement action succeeding the proviso is satisfied. (*r*)

If the action for infringement be brought, not against the party aggrieved, but against a third party, and if that action be not prosecuted with due diligence, or, if it be collusive, or if it be settled and the threats subsequently continued, (*s*) then, no doubt, the person claiming an injunction to restrain threats would be entitled to contend that the case was within the section, and that such an infringement action did not bring it within the proviso. (*t*) Thus, in a case where the defendant had commenced an action for infringement against the plaintiff, and undertook to prosecute it with due diligence, the Court refused an injunction to restrain the issue of a threatening circular, which, however, was granted subsequently, on the ground that the defendants were not, as a matter of fact, prosecuting their infringement action diligently. (*u*)

An action against licensees for royalties in respect of articles which the defendant alleges were manufactured under another patent and not under the licence is an action for infringement within the meaning of sec. 32 of the Act of 1883. (*x*)

A counterclaim in an action commenced under sec. 32 of the Patents Act, 1883, is sufficient to bring the case within the proviso, if on the facts the issue of infringement is raised with due diligence. (*y*)

Due diligence.

In considering the question whether an action for infringement has been commenced and prosecuted with due diligence, so as to bring the case within the proviso of sec. 32, it must be noticed that the section is silent on the point whether it is

(*p*) The Combined Weighing and Advertising Machine Co. *v.* The Automatic Weighing Machine Co., (1889) 6 R. P. C. 502; L. R. 42 Ch. D. 665; 58 L. J. Ch. 709; per Smith, L.J., Skinner *v.* Perry, (1892) 10 R. P. C. 8.

(*q*) Lycett Saddle and Motor Accessories Co., Ld. *v.* J. B. Brooks, Ld., (1901) 21 R. P. C. 656.

(*r*) *Ibid.*

(*s*) Engels *v.* Hubert Unchangeable Eylet Syndicate, (1902) 19 R. P. C. 201.

(*t*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425, 439; 4 R. P. C. 363; see also Engels *v.* Hubert Unchangeable Eylet Syndicate, (1902) 19 R. P. C. 201.

(*u*) Household *v.* Fairburn, (1884) 1 R. P. C. 109; 2 R. P. C. 142.

(*x*) Day *v.* Foster, (1890) 7 R. P. C. 54.

(*y*) Alfred Appleby's Twin Roller Chain, Ld. *v.* Albert Edie Chain, Ld., (1899) 16 R. P. C. 330.

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necessary that the action for infringement must be commenced before or after the action for threats. It has been held that, if a threatened action for infringement be commenced and prosecuted with due diligence, there is no ground upon which an action under sec. 32 can be commenced at all. (*z*)

Moreover, an action for infringement commenced before the issue of the threats complained of is sufficient to bring the case within the proviso of sec. 32, if the alleged infringements are the same as those forming the subject of the threats, and it is not necessary that the action for infringement should be one in which the issue of validity can be contested. (*a*)

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of threats, account must be taken of the time that has elapsed since the threats complained of were first issued and the infringement action was commenced, and not of the time since the defendant first became aware that the plaintiff was doing the acts which are alleged in the threatening notices to be an infringement of the defendant's right. (*b*)

There is no rule as to the length of time within which a patentee must bring an infringement action in order to escape liability in respect of threatened proceedings. (*c*) If delay in bringing the infringement action were caused by negotiations between the parties, it would no doubt be held that the conditions of the proviso were satisfied. (*d*) But where the defendants in a threat action did not commence an action for infringement till over two months after the threats complained of were issued, and then only issued writs against two persons, not the plaintiffs in the threat action, and subsequently entered a counterclaim in the threat action alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence; (*e*) and where the defendants had issued a writ out of Court, but had expressed an intention not to serve it, and first raised the issue of infringement by way of counterclaim,

(*z*) Day *v.* Foster, (1890) 7 R. P. C. 54, 60.

(*a*) *Ibid.* 54; Berliner *v.* Edison-Bell Consolidated Phonograph Co., (1899) 16 R. P. C. 336.

(*b*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 435, 437; 4 R. C. P. 363; Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 502; Haskell Golf Ball Co. *v.* Hutchison, (1904) 21 R. P. C. 497.

(*c*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 106.

(*d*) Edlin *v.* Pneumatic Tyre and Brooks Cycle Co., (1893) 10 R. P. C. 311.

(*e*) Herrburger *v.* Squire, (1888) 5 R. P. C. 581; 6 R. P. C. 194; but see Challender *v.* Royle, (1887) L. R. 36 Ch. D. 437.

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a jury found that the infringement action commenced under such circumstances was not commenced with due diligence. (*f*)

It has been held that an action commenced and subsequently discontinued by consent is not an action prosecuted with due diligence, so as to entitle a defendant in a threat action to exemption from liability; (*g*) though this decision would appear to be wrong in view of the fact that subsequent cases have decided that an action which is abandoned because the defendant gives in, and desists from the infringement, or because the plaintiff is advised that the action must fail, is an action for infringement prosecuted with due diligence. (*h*) Moreover, it cannot be contended that an action for infringement to come within the meaning of the proviso of sec. 32 of the Act of 1883 must be prosecuted down to a successful result; on the contrary, the action may be within the proviso though it is discontinued, or judgment is against the plaintiff, (*i*) or it was originally in respect of several patents and was dropped in respect of some of them. (*k*)

The fact that a patentee, who has commenced an action for infringement against a person subsequently claiming an injunction restraining the continuance of threats, has not applied for an interlocutory injunction, is not evidence that he has not prosecuted his action with due diligence. (*l*)

An action commenced to obtain an injunction to restrain the defendant from passing off his goods as and for the plaintiffs, and tardily after the issue of the writ in an action under sec. 32 amended to an infringement action, is not commenced and prosecuted with due diligence. (*m*)

A jury has held that a delay of several months in taking up an order for inspection which, if acted upon, would have led to the discontinuance of the action on the ground of non-infringement amounted to a lack of prosecution with due diligence. (*n*) On the other hand, Lord *Alverstone*, L.C.J., in a case where delays amounting to eighteen months had

(*f*) Alfred Appleby's Twin Roller Chain, Ld. *v.* Albert Eadie Chain, Ld., (1899) 16 R. P. C. 318.

(*g*) Crampton *v.* Patents Investment Co., (1888) 5 R. P. C. 382, 393; but see Colley *v.* Hart, (1890) 7 R. P. C. 101.

(*h*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 108, 110; English and American Machinery Co. *v.* Garo Machinery Co., (1894) 11 R. P. C. 627. As to continuation of threats after an action for infringement has been settled, see p. 320 *ante*.

(*i*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 109, 110; English and American Machinery Co. *v.* Garo Machinery Co., (1894) 11 R. P. C. 627.

(*k*) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(*l*) Anderson *v.* Liebig's Extract of Meat Co., (1881) 45 L. T. N. S. 757.

(*m*) Johnson *v.* Edge, (1892) 9 R. P. C. 142.

(*n*) Bishop *v.* Inman, (1900) 17 R. P. C. 749, 756, 759.

occurred in the various steps of an infringement action, and there was pending, on the application of the defendants in that action, an application for leave to obtain evidence abroad, held that, under the circumstances, there had been no want of due diligence. (*o*)

Pleadings. Issues.

## PART II.—PRACTICE.

**Pleadings.**—Specimens of the pleadings in an action under sec. 32 of the Act of 1883 will be found in the Appendix. (*p*) The action for breach of the statutory right created by sec. 32 of the Act of 1883 lies against individuals, and also against a corporation. (*q*)

Pleadings.

**Issues.**—In any action brought under sec. 32 of the Act of 1883 to restrain threats of legal proceedings, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate; (*r*) and it is therefore open to the plaintiff to prove, in either of two ways, that he has not infringed any legal right of the defendant. Either he may say, "The patent is valid, but I have not infringed it;" or he may say, "The patent is invalid, and, therefore, I have not infringed any legal right of the person making the threats." (*s*) That is to say, in order to act on the above-mentioned section, the Court must be satisfied, at the hearing of the action, that the articles in respect of which the threats were made are not "an infringement of any legal rights of the person making such threats." The question, therefore, whether the patent of the person making the threats is a valid patent must come into consideration, if the plaintiff in the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee. (*t*)

Issues of infringement and also validity of the patent may be raised.

It would appear to be the more correct course for the plaintiff not to plead the invalidity of the defendant's patent in the statement of claim, but to leave the defendant to raise

Practice in pleading.

(*o*) Voelker Incandescent Mantle *v.* Welsbach Incandescent Gas Light Co., (1901) 18 R. P. C. 494.

(*p*) Vol. II. p. 404 *post*.

(*q*) Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) L. R. 42 Ch. D. 669; Fusee Vesta Co. *v.* Bryant and May, (1887) 4 R. P. C. 194; Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; L. R. (1891) 2 Ch. 579.

(*r*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Kurtz *v.* Spence, (1887) 4 R. P. C. 427; Herrburger *v.* Squire, (1888) 5 R. P. C. 589.

(*s*) Per Charles, J., Herrburger *v.* Squire, (1888) 5 R. P. C. 589.

(*t*) See judgment of Cotton, L.J., Challender *v.* Royle, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363.

Particulars.

the issue in the defence. The plaintiff is at liberty to deny the validity in the reply, and to deliver particulars of objections therewith, and such further pleadings as may be necessary are allowed. (*u*) It is, however, competent to the plaintiff, if he is so minded, to raise the issue of the validity of the patent by a denial in the statement of claim. (*x*)

The burden of proof of the fact of infringement is on the defendant. (*y*)

Particulars of breaches.

**Particulars.**—The defendant may be ordered to furnish particulars of breaches, pointing out how the acts complained of are infringements of his patent, and pointing out, by reference to pages and lines of the specification, which parts of the invention therein described he alleges have been infringed; (*z*) and the plaintiff, if he denies the validity of the defendant's patent, may be required to deliver to the defendant particulars of his objections. (*a*)

If the defendant is the owner of more than one patent, it is proper that he should deliver particulars of the patents on which he relies to support the threats before the plaintiff delivers his particulars, which may be confined to the patents mentioned in the defendant's list. (*b*)

If the plaintiff pleads non-infringement of any legal right of the defendant, and the defendant, though not admitting the plea, does not allege infringement of any particular legal right, the plaintiff cannot claim particulars showing in what respect the defendant alleges the infringement of his legal rights, or in what respect he does not admit that the plaintiff does not infringe his (the defendants') alleged legal rights. (*c*)

Particulars of objections.

The defendant is entitled to particulars of objections before he delivers his defence if invalidity is pleaded in the statement of claim. (*d*)

When the plaintiff alleges that the threats were made by the

(*u*) Dowson Taylor *v.* Drosophore Co., (1895) 12 R. P. C. 95; *see* Kopp *v.* Rosenwald, (1902) 19 R. P. C. 208; 20 R. P. C. 154.

(*x*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 47.

(*y*) Ungar *v.* Sugg, (1889) 6 R. P. C. 337.

(*z*) Wren *v.* Weild, (1869) L. R. 4 Q. B. 213; Union Electrical Power and Light Co. *v.* Electrical Power Storage Co., (1888) 5 R. P. C. 329; Law *v.* Ashworth, (1890) 7 R. P. C. 86; Hoffnung *v.* Salsbury, (1899) 16 R. P. C. 378.

(*a*) Union Electrical Power and Light Co. *v.* The Electrical Power Storage Co., (1888) 5 R. P. C. 329; Smith *v.* Laing, (1890) 7 R. P. C. 148.

(*b*) *Ibid.* Particulars of breaches and objections are discussed more fully at pp. 395 and 412 *post*.

(*c*) Dowson Taylor *v.* Drosophore Co., (1894) 11 R. P. C. 653.

(*d*) Law *v.* Ashworth, (1890) 7 R. P. C. 86.

defendant's agents, he may be compelled to give particulars of the names of such agents. (*e*)

**Interlocutory Injunction.**

**Interlocutory Injunction.**—In cases where the defendant brings an infringement action which satisfies the conditions of the proviso of sec. 32 of the Act of 1883, it is the usual course for the Court, on motion by the plaintiff for an interlocutory injunction, to make no order except that the threats action be stayed until the trial of the infringement action or further order, and that the costs of the threats action be costs in the infringement action; and the defendant usually gives an undertaking to prosecute the infringement action diligently, and disclaims any intention of issuing new threats in the mean time. (*f*) In the event of the defendant not prosecuting the infringement action with due diligence, the plaintiff has thus an opportunity of moving again. (*g*)

**Usual course where defendant brings an action for infringement.**

An injunction to restrain threats of legal proceedings or liability in respect of alleged infringement of a patent will not, as a rule, be given on an *ex parte* application, and there does not appear to be any reported case in which this has been done, though no doubt, under very special circumstances, the Court might do so, if the interests of justice would not be otherwise satisfied.

**Ex parte applications.**

It is usual to allow short notice of motion to be given in the ordinary way: (*h*) but when threats are issued by an agent in this country at the instigation of a foreigner abroad, and the agent appears, though the foreign patentee has not been served, the practice is for the Court to grant an *ex parte* injunction against the foreigner, his servants, and agents. The order indicates that the agent defendant appears, and it is directed in particular against him as agent. The plaintiff should give an undertaking to accept short service of notice to dissolve the injunction. (*i*)

In an action to restrain threats under sec. 32 the Court will not grant an interlocutory injunction unless it is satisfied that the plaintiff has made out a *primâ facie* case to the effect either that he has not infringed the defendant's patent or that the patent is void; and, unless there is such a *primâ facie*

**Primâ facie case of non-infringement or invalidity is essential without which the Court does not consider the balance of convenience to the parties.**

(*e*) Dowson Taylor *v.* Drosophore Co., (1894) 11 R. P. C. 536.

(*f*) Mackie *v.* Salvo Laundry Co., (1892) 9 R. P. C. 465; Edlin *v.* Pneumatic Tyre and Booth's Cycle Agency, (1893) 10 R. P. C. 316; English and American Machinery Co. *v.* Gare Machinery Co., (1894) 11 R. P. C. 628; Dowson Taylor *v.* Drosophore, (1895) 12 R. P. C. 95.

(*g*) *Ibid.*

(*h*) Wilson & Co. *v.* Walter E. Church Engineering Co., Ld., (1885) 2 R. P. C. 175.

(*i*) Overton *v.* Burns, (1896) 13 R. P. C. 455.

Interlocutory Injunction.

case, the Court does not take into consideration the balance of convenience to the parties. (*k*)

*Cotton*, L.J., commenting in the Court of Appeal on a decision (*l*) to the effect that the Court has power to grant an interlocutory injunction in a threat action, though it is not proved that the plaintiff has not infringed the defendant's patent, and also on the suggestion that the question whether an interlocutory injunction should be granted depends upon the balance of convenience to the parties, said (*m*)—

> "It is very true that in all cases of interlocutory injunction the Court does consider, and ought to consider, the balance of convenience and inconvenience in granting or refusing the injunction. But there is another very material question to be considered: Has the plaintiff made out a *primâ facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, although I quite agree that the Court ought not, on an interlocutory injunction, to attempt finally to decide the question whether the Act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of those two points the plaintiff in the action has made out a *primâ facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction, merely on the ground that it cannot do the defendant any harm. Injunctions ought to be granted only on a case made out entitling the plaintiff to that particular remedy."

If the Court is satisfied, on a motion for an interlocutory injunction, that the plaintiff has made out a *primâ facie* case of non-infringement, it will grant the interlocutory injunction restraining the defendant until the trial of the action from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or

(*k*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Barney *v.* United Telephone Co., (1885) L. R. 28 Ch. D. 394. In Engels *v.* Hubert Unchangeable Eylet Syndicate, (1902) 19 R. P. C. 201, Byrne, J., granted an interlocutory injunction though the point as to *primâ facie* case does not appear to have been taken on behalf of the defendant; the judgment went on the ground that there was no pending action for infringement to satisfy the proviso of sec. 32 of the Patents Act, 1883.

(*l*) Walker *v.* Clarke, (1887) 4 R. P. C. 111; Challender *v.* Royle, (1887) L. R. 36 Ch. D. 428; 4 R. P. C. 363.

(*m*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 436; 4 R. P. C. 363.

purchase of his invention. (*n*) On the other hand, where the Court is of opinion that the plaintiff, by his affidavits, fails to raise a probable case of non-infringement, and that there is a conflict of testimony on the question, an injunction will be refused. (*o*) The Court, in deciding whether the defendant has made out a *primâ facie* case of infringement, takes into consideration the fact whether or not he has commenced an action for infringement, and, if he has not done so, this fact is evidence against him. (*p*) Damages.

When there is a question as to whether the alleged threat is really a threat within the section which would be better decided at the trial, and the defendant denies any intention of making threats, this circumstance induces the Court to order the motion to stand to the trial, with liberty to the plaintiff to bring it on again in the interval upon two days' notice. (*q*) Other considerations on motion for interlocutory injunction.

Where (*r*) it appeared that the defendants were only exclusive licensees for a limited area of the patent referred to, and that the patentee had commenced an action for infringement against the plaintiff, in which the defendants were to be made co-plaintiffs, the Court ordered the motion for an injunction restraining the further issue of the circular to stand over till after the hearing of the infringement action. (*s*)

Another circumstance which may influence the Court to grant an interlocutory injunction is the probable incapacity of the defendant to satisfy the plaintiff's claim if ultimately defeated. (*t*)

**Damages.**—Damages are only awarded when the plaintiff shows that he has really suffered loss owing to the defendant's conduct. (*u*) Moreover, the defendant is only liable for damage directly caused by the threats. He is not liable for damage resulting from the mere rumour of legal disputes or legitimate general statements, or by threats unauthorised by him, though he may be liable in respect of a falling off in the plaintiff's general business traceable to the threats in respect of a particular article dealt in by the plaintiff. (*x*) Damages to be recoverable must result directly from the threat.

(*n*) Colley *v.* Hart, (1888) 6 R. P. C. 17.

(*o*) Barney *v.* United Telephone Co., (1885) 2 R. P. C. 173.

(*p*) Colley *v.* Hart, (1889) 6 R. P. C. 17.

(*q*) Douglass *v.* Pintsch's Patent Lighting Co., (1895) 13 R. P. C. 60.

(*r*) Barnett *v.* Barrett's Screw Stopper Bottling Co., Ld., (1884) 1 R. P. C. 9.

(*s*) See also Combined Weighing and Advertising Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 502.

(*t*) p. 438 *post*.

(*u*) Driffield *v.* Waterlow, (1886) L. R. 31 Ch. D. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*x*) Ungar *v.* Sugg, (1891) 8 R. P. C. 385; 9 R. P. C. 113, in which the principles on which damages for threats ought to be assessed are discussed.

Certificates.

When it can be shown that the plaintiff has lost a contract in consequence of the threats the measure of damage is the loss of profit, (*y*) and the fact of breach is sufficient to entitle the plaintiff to an inquiry as to damages, notwithstanding that he might have enforced his contract, if so minded. (*z*)

Similarly, if the effect of the threats was to compel the plaintiff to accept a contract at a lower price than he would otherwise have obtained, the damage is the difference between the price which the plaintiff would but for the threats have obtained and the price actually accepted. (*a*)

If the Judge is able to assess the damages at the trial it is right that he should do so instead of sending the case to an inquiry. (*b*)

Can a certificate of validity be given in an action to restrain threats?

**Certificate of Validity.**—It is submitted that an action which is in the form of one to restrain the issue of threats under sec. 32 of the Act of 1883, but in which the validity of the patent is put in issue and decided in favour of the patentee, is an "action for infringement" within the meaning of sec. 31, and that the Court has, therefore, jurisdiction to give a certificate of validity under that section. The authorities, however, appear to be in conflict. (*c*) It is submitted that the object of the Legislature in framing sec. 31 was to protect patentees, who have once established the validity of their patents in expensive litigation, from being unduly harassed by having the same question raised against them again by the parties to different proceedings; and that the section ought not to be so construed as to limit it to cases in which the action is one for infringement in the ordinary sense, and to exclude cases in which the action, though in substance one for infringement, is not so in mere form.

Is certificate as to particulars necessary on taxation?

**Certificate as to Particulars.**—It does not appear to have been definitely decided whether or not in order for a successful party in an action under sec. 32, in which the questions of infringement and validity of the patents were in issue, to be entitled to the costs of his particulars, it is necessary for him to obtain the Judge's certificate under sec. 29, sub-s. 6 of the

(*y*) Skinner *v.* Perry, (1894) 11 R. P. C. 406.

(*z*) Hoffnung *v.* Salsbury, (1899) 16 R. P. C. 375.

(*a*) See Alfred Appleby's Twin Roller Chain, Ld. *v.* Albert Eadie Chain, Ld., (1899) 16 R. P. C. 318, 324.

(*b*) Ungar *v.* Sugg, (1892) 9 R. P. C. 113; Herrberger *v.* Squire, (1887) 5 R. P. C. 596; 6 R. P. C. 194; Kurtz *v.* Spence, (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

(*c*) Kurtz *v.* Spence, (1885, 1888) 5 R. P. C. 184; Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 404; Herrburger *v.* Squire, (1888) 5 R. P. C. 595.

Act of 1883, to the effect that such particulars delivered by him were proven or reasonable and proper. (*d*) It is submitted that an action under sec. 32, in which the issues of infringement and validity of the defendant's patent are properly raised, whether or not the defendant counterclaims for damages, is in all but mere form an action for the infringement of the patent and that the term "action for infringement" as used in sec. 29 should be construed as including such an action, with the result that the Court has jurisdiction to grant the certificate in a threats action, and that, on taxation, no costs should be allowed in respect of any particular which has not been duly certified by the Court. It is to be observed that the submission is the other way in the case of a petition for the revocation of a patent, for sec. 26 of the Act of 1883 is confined expressly to the practice in cases of revocation of a patent upon petition, whereas sec. 28 refers to "an action or proceeding for infringement *or* revocation of a patent," and sec. 29 commences "In an action for infringement of a patent," and makes no reference to proceedings for revocation upon petition. Secs. 26 and 29 contain analogous directions as to the delivery of particulars and confining the evidence to them, but sec. 26 does not contain the clause which is in sec. 29, having reference to the certificate. (*e*)

Breach of Injunction.

**Breach of Injunction.**—It is submitted that a defendant, who is restrained from issuing threats of legal proceedings by an injunction which follows the terms of sec. 32 of the Act of 1883, does not commit any breach by circulating threats made by a third party, provided that such circulation is not a mere cloak to conceal threats really made by the defendant. (*f*)

Scope of injunction.

No doubt the Court would, if it thought fit, so word the injunction as to include the circulation, by the defendant, of threats made by a person or persons other than himself.

In a case where an undertaking had been given practically in the terms of the section, and subsequently an action for infringement had been brought, the Court, upon motion for sequestration against the defendant company and attachment of its directors, decided that the bringing of the infringement action was no breach of the undertaking. (*g*)

There is no precedent for the extension of the injunction by

(*d*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 45.
(*e*) p. 302 *ante*.
(*f*) See Ellam *v.* Martyn, (1898) 16 R. P. C. 28, 33.
(*g*) Beven *v.* Welsbach Incandescent Gas Light Co., Ld., (1902) 20 R. P. C. 69.

Costs.

the Court so as to include assignees of the defendant's patent, and in one case (*h*) an application for such extension was expressly refused. Under some circumstances the issue of threats by an enjoined defendant's assignee would amount to a contempt of Court. (*i*)

Ordinary jurisdiction of the Court applies.

**Costs.**—The general costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction.

It is the duty of the defendant to a threat action who brings a cross-action for infringement to endeavour by arrangement to avoid causing unnecessary costs by trying the same action in two different forms. (*k*)

Where the plaintiff obtains judgment with costs the Master will, on taxation, tax in favour of the defendant any issues upon which he has been wholly successful; (*l*) but see above as to costs of particular breaches and objections.

(*h*) Engels *v.* Hubert Unchangeable Eylet Syndicate, (1902) 19 R. P. C. 204.

(*i*) See *ibid.* For usual form of injunction see Moutain *v.* Parker, (1903) 20 R. P. C. 774.

(*k*) Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 367, 502; Colley *v.* Hart, (1890) 7 R. P. C. 101, 108, 189.

(*l*) Herrburger *v.* Squire, (1888) 5 R. P. C. 596; Longbottom *v.* Shaw, (1888) 5 R. P. C. 502.

# CHAPTER VIII.

## ACTION OF INFRINGEMENT.

### General.

Former spirit of interpretation of letters patent.

It was not for two hundred years after the Statute of Monopolies became law that the popular prejudices against patent privileges disappeared, and Judges began to determine questions arising between patentees and the public in a fair and impartial spirit. Formerly the Courts were only too ready to seize on any slight defects to declare a patent null and void. They were, no doubt, actuated by the deep-seated prejudice which was extremely general in the public mind, and which was the direct outcome of the monstrous oppression practised by means of patent grants before the statute of James I.

Modern spirit of interpretation.

The Courts now recognise the principle laid down by Lord *Eldon*, L.C., (*a*) that the patent may be considered as in the nature of a bargain between the public (represented by the Crown) and the patentee, and the specification, therefore, must be construed on the same principle of good faith as that which regulates all other contracts. Consequently, all questions which arise between patentees and the public are determined between the parties without any bias or strained construction put upon the law or patent in favour of either.

The privilege conferred by letters patent for an invention, which is created by the law, (*b*) would be of no practical use to the grantee if he did not possess legal remedies against persons found to have invaded it.

Remedies for infringement.

It is open to a patentee, whose exclusive privilege is being invaded, to bring an action for infringement against the offending party, and so vindicate his right by a proceeding in which, if he succeeds, he may be entitled, not only to an

(*a*) Cartwright *v.* Eamer, (1807) cited and approved 14 Ves. 131, 136; Tubes, Ld. *v.* Perfecta Seamless Tube Co., Ld., (1902) 20 R. P. C. 95, 96. A patent is, of course, not actually a contract: it is a royal grant, see Feather *v.* Queen, (1865) 6 B. & S. 257.

(*b*) Vol. II. pp. 104, 105.

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injunction of the Court restraining a continuance of the wrongful acts, but also to an account of profits made by the infringer, or damages against him, and the costs of the litigation, together with destruction of the infringing article. A patentee is also entitled to sue in one and the same action for the recovery of royalties from a defendant alleged to be a licensee, or in the alternative for the usual relief consequent on infringement. (*c*)

Secret use of an invention.

A secret use by the patentee of an invention before the date of letters patent will not, at any rate if there has been no profit derived therefrom, invalidate the patent subsequently obtained. (*d*) The question suggests itself, Can a patentee who has obtained letters patent for an invention, by an injunction of the Court, prevent another man from continuing what before the date of the patent had been the secret use of the invention? It is submitted that he could not do so, for the patent under such circumstances is invalid because the requirements of the sixth section of the Statute of Monopolies are not satisfied, in that it cannot be said that the invention is one which falls within the class "which others at the time of making such letters patent and grants shall not use." (*e*) The prior secret user would no doubt be required to establish a very strong case, for the Courts would be inclined to the conclusion that an alleged prior secret use was merely experimental and incomplete, in which case it would not invalidate the subsequent patent for the completed invention. (*f*)

The man who uses an invention and keeps the method of performing it a secret really inflicts a hardship on the public, for, if he never discloses it, the public may have no further advantage of it beyond that which the secret user chooses to give. It is open to the secret user, if he be the true and first inventor, to obtain a patent and enjoy the exclusive privilege of using the invention during the term for which it is granted. (*g*)

If any person has *openly* practised an invention before the date of subsequent letters patent, he clearly cannot be prevented from continuing to do, after the patent, that which he did before it, since the patent is bad in law on the ground of lack of novelty. (*h*)

(*c*) Wilson *v.* Union Oil Mills Co., (1892) 9 R. P. C. 57.
(*d*) pp. 125, 135 *ante*.
(*e*) p. 136 *ante*.
(*f*) p. 121 *ante*.
(*g*) pp. 125, 135 *ante*.
(*h*) p. 126 *ante*.

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Sale of goods in fraud of a patentee.

Beside the remedy of an action for infringement, patentees are entitled, in common with other persons, to bring an action at common law against any one who sells or otherwise passes off goods manufactured by himself or another in such a manner as to induce the purchasing public to believe that such goods are manufactured by the patentee or his nominees, when, in fact, they have not been so manufactured. It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name, (*i*) word, (*k*) mark, or device (*l*) upon the spurious articles themselves, or upon the wrappers in which they may be wrapped, (*m*) or by using any other means to deceive the public into purchasing goods as the goods of the patentee when they are really not so. (*n*)

A plaintiff who succeeds in showing that the defendant has sold goods in a manner calculated to make the public believe that they were, contrary to the actual fact, purchasing the manufacture of the plaintiff, is entitled to an injunction against the defendant, and also to an account or damages. (*o*) And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff. (*p*)

Further, a person selling goods in a manner which induces the purchaser to believe that he is buying the goods of another is liable to an action, notwithstanding the fact that he in a sense makes no actual misrepresentation. Thus, in a case where it appeared that the plaintiff made and sold goods which he was accustomed to mark with the words "Sykes' patent," and the defendant (who was of the same name as the plaintiff) made and sold similar goods to the retailers which he also marked with the words "Sykes' patent," and the patent right had expired, the defendant was restrained by the injunction of the Court, on the ground that he was selling his goods as and for those manufactured by the plaintiff; and this notwithstanding the fact that he did not himself

(*i*) Ransome *v.* Bentall, (1834) 3 L. J. N. S. 161; Singer Manufacturing Co. *v.* Loog, (1880) L. R. 18 Ch. D. 395, 422.

(*k*) Knott *v.* Morgan, 2 Keen, 213; Wotherspoon *v.* Currie, L. R. 5 E. & I. App. 508; Ford *v.* Foster, L. R. 7 Ch. App. 611; Siegert *v.* Findlater, L. R. 7 Ch. D. 801.

(*l*) *In re* Worthington, L. R. 14 Ch. D. 8; Orr Ewing *v.* Johnson, L. R. 13 Ch. D. 434; L. R. 7 App. Cas. 219; Seixo *v.* Provezende, L. R. 1 Ch. App. 192.

(*m*) Blofield *v.* Payne, 4 B. & A. 410; Blackwell *v.* Crabb, 36 L. J. Ch. 501; Upmann *v.* Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130.

(*n*) See Reddaway *v.* Banham, (1896) A. C. 204.

(*o*) See *post*.

(*p*) Blofield *v.* Payne, 4 B. & A. 410.

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represent his goods to be of the plaintiff's manufacture. (*q*) A rule *nisi* for a new trial was refused by the Court of King's Bench. (*r*)

On the other hand, any person who becomes acquainted with the process of making an article which is merely a secret, and not the subject of an existing patent, is entitled to manufacture it; and, if the name of the first manufacturer has become descriptive of the article apart from its origin, any person is entitled to describe it by such name, provided he does not so use the name as to lead the public to believe that they are buying goods made by such original manufacturer. (*s*)

Patentee may sue in one action in respect of infringement and passing off.

A person is liable to be sued in one and the same action both for the infringement of a patent or copyright, or in the alternative for passing off his goods as and for those of the plaintiff. (*t*)

Different causes of action against different persons must not be joined, but where the action is limited to a cause of action resulting from the joint conduct of two persons, they may be joined as defendants. (*u*)

Security of public against illegal patents.

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection:—

*First:* Any member of the public against whom proceedings are taken by the patentee is entitled to show that the patent in question is void, (*v*) and so defeat the action, for there can be no infringement of an invalid patent; and, unless the patent has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement. (*x*)

*Secondly:* Any person entitled as of right so to do, or authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, may obtain the revocation of an illegal patent on petition to the Court. (*y*)

*Thirdly:* Every patent contains a proviso to the effect that it shall forthwith determine and be void to all intents and

(*q*) Sykes *v.* Sykes, 3 B. & C. 541; cf. Turton *v.* Turton, (1889) L. R. 42 Ch. D. 128.

(*r*) 3 L. J. N. S. 161.

(*s*) Massam *v.* J. W. Thorley's Cattle Food Co., L. R. 6 Ch. D. 574; 14 Ch. D. 748.

(*t*) Lees *v.* West London Cycle Works, (1892) 9 R. P. C. 300; Hewett *v.* Nurse, (1900) 17 R. P. C. 264; Chameleon Patents Manufacturing Co. *v.* Marshalls, (1900) 17 R. P. C. 527; Parker *v.* Satchwell, (1903) 18 R. P. C. 299; Poulton *v.* Kelley, (1904) 21 R. P. C. 392.

(*u*) Saccharin Corporation, Ld. *v.* D. T. J. Lyle & Sons, Ld., (1904) 21 R. P. C. 604.

(*v*) But see p. 406 *post*.

(*x*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 37.

(*y*) p. 293 *ante*.

purposes, if at any time during the term for which it is granted it be made to appear to the King, his heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial or inconvenient to the subjects in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor *thereof within this realm.* (*z*)

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## Infringement.

A person invades the exclusive rights of a patentee and commits an infringement when, without the licence of the owner for the time being of the patent, he directly or indirectly during the lifetime of the patent uses the art or invention which is the subject of the patent, and applies it in any way for his own profit or benefit, otherwise than for the purpose of *bonâ fide* experiment.

Definition of infringement.

There is no infringement unless that which is protected by the patent—*i.e.*, that which is claimed—is taken without the leave and licence of the patentee. (*a*)

Thus in a recent case it was held that a claim for a process for stiffening incandescent gas mantles, which was limited upon its proper construction to the use of suitable materials which set by cooling, was not infringed by the use of other suitable materials which set by evaporation. (*b*)

Sometimes it is open to a patentee to claim more than he actually does claim, *e.g.*, he may be in a position to claim both a process and a machine, (*c*) or a result, (*d*) but he prefers to limit his claim to the one or the other and not to make it wide enough to include both. There are obvious dangers in making too wide a claim and there are obvious disadvantages in making it narrower than the patentee is obliged to do, having regard to the validity of the patent. (*c*)

Patentee may fix the ambit of his claim.

(*z*) Vol. II. p. 373.

(*a*) Bradford Dyers Association *v.* Bury, (1901) 19 R. P. C. 1; Bunge *v.* Higginbottom & Co., Ld., (1902) 19 R. P. C. 187; see p. 339 *post.*

(*b*) Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 757.

(*c*) See Peters *v.* Owen, (1899) 16 R. P. C. 83.

(*d*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1897) 14 R. P. C. 311, 312.

(*e*) *Ibid.*; Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 17 R. P. C. 146.

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It must also be remembered that what is not embraced by the claim is to be considered as disclaimed, and, consequently, open to all the world. (*f*)

Also, if a patentee in his specification points away from the use of a certain thing, he cannot complain of its adoption by an alleged infringer. (*g*)

No infringement of the equity of a patent.

Formerly there used to be an idea that it was possible to infringe upon the equity of a statute. If it were not possible to show that the words of the statute had been infringed, it was contended that the equity had been invaded; and, similarly, by a confusion of ideas a notion was prevalent that there might be an infringement of the equity of a patent. There is, however, no sound principle of this kind in the patent law; that which is protected is that which is specified and claimed, and that which is held to be an infringement must be an infringement of that which is specified and claimed, though it may not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding. (*h*)

Intention and its effect.

It is not material to consider the intention of a person who commits an infringement of a patent; (*i*) evidence of intention may be material for the consideration of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, an infringement is committed. (*j*) An infringer is liable for what he does, not for what he intends; (*k*) and there may be an indirect infringement, as well as a direct one, though the intention of

(*f*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 741; Jackson *v.* Wolstenholmes, (1884) 1 R. P. C. 108; Lucas *v.* Miller, (1885) 2 R. P. C. 159; Easterbrook *v.* G. W. Ry. Co., (1885) 2 R. P. C. 208; Ticket Punch Register Co. *v.* Colley's Patents, (1896) 12 R. P. C. 171; Nobel's Explosives *v.* Anderson, (1894) 11 R. P. C. 128, 525, 526; Davies *v.* Townsend, (1899) 16 R. P. C. 497; Ashworth *v.* English Card Clothing Co., (1901) 18 R. P. C. 367; 20 R. P. C. 790; Pilkington *v.* Massey, (1904) 21 R. P. C. 709.

(*g*) Nobel's Explosives Co. *v.* Anderson, (1895) 12 R. P. C. 164; Morris *v.* Young, (1895) 12 R. P. C. 466.

(*h*) Dudgeon *v.* Thomson, (1874) 30 L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C. See also per Smith, L.J., Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 185; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1889) 14 R. P. C. 311, 312; p. 432 *post*.

(*i*) McCormick *v.* Gray, (1861) 7 H. & N. 25, 39; 31 L. J. Ex. 42; Heath *v.* Unwin, 15 Sm. 552; Stead *v.* Anderson, 2 W. P. C. (1847) 156; 4 C. B. 834; Seed *v.* Higgins, (1858) 5 Jur. N. S. 540; 8 E. & B. 771; Young *v.* Rosenthal, (1884) 1 R. P. C. 29, 39.

(*j*) 2 W. P. C. 227 *n*.

(*k*) Stead *v.* Anderson, (1847) 2 W. P. C. 156; 4 C. B. 834; Newall *v.* Elliott, (1864) 10 Jur. N. S. 954; Nobel's Explosives Co. *v.* Jones, (1882) L. R. 8 App. Cas. 12, 13.

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the party be perfectly innocent, (*l*) and even though he may not know of the existence of the patent itself, (*m*) or that the thing he was dealing with was an infringement. (*n*) Neither is it a sufficient answer to a motion to commit, for breach of an injunction, to say that the defendant did not intend to infringe; (*o*) nor is ignorance a valid defence. (*p*)

Evidence of intention may be of some value to a jury in dealing with the question whether an infringement has taken place or not; (*q*) and also the Court takes it into account when deciding whether to grant or refuse an injunction, (*r*) and how to deal with the cost of the action. (*s*)

*Jessel*, M.R., in a case of infringement of copyright, stated that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, nor omission or neglect which would induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. (*t*)

On the other hand, where the defendant was a retail dealer who unwittingly sold articles which were an infringement of the plaintiff's patent, *James*, V.C., held that he was not liable for the costs of an action to restrain the infringement, if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more. (*u*) And, adopting the same principle, Lord *Hatherley*, in a trade-mark case, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery, and gave all information in their power immediately on being informed

(*l*) United Telephone Co. *v.* London, &c., Telephone Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; Adair *v.* Young, (1879) L. R. 12 Ch. D. 13.

(*m*) Heath *v.* Unwin, (1854) 2 W. P. C. 228, 315; 5 H. L. C. 505; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Young *v.* Rosenthal, (1884) 1 R. P. C. 39; Saccharin Corporation, Ld. *v.* Reitmeyer, (1900) 17 R. P. C. 612.

(*n*) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Geary *v.* Norton, (1846) 1 De G. & S. 9; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302.

(*o*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286, 288.

(*p*) Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231; Wittman *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Geary *v.* Norton, (1846) 1 De G. & S. 9; Young *v.* Morris, (1894) 11 R. P. C. 617.

(*q*) Heath *v.* Unwin, (1845) 2 W. P. C. 227 *n.*; see above.

(*r*) p. 488 *post*.

(*s*) p. 512 *post*.

(*t*) Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 501; see also Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231.

(*u*) Betts *v.* Wilmott, (1870) 18 W. R. 946; Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; see also Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

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thereof, were not liable to the costs of an action brought to restrain the sale of such cigars. (*v*)

Act done under subsequent patent is an infringement of a prior patent for the same invention.

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an infringement of that which bears the earliest date; (*x*) and if an invention is shown to be new and useful, the fact that it is much more useful with a subsequent improvement affords no ground for infringing the original invention by using it with the subsequent improvement; (*y*) neither can the infringer escape liability on the plea that the later patent was unsuccessfully opposed before the Comptroller by the plaintiff in the action. The proceedings before the Comptroller are irrelevant and immaterial to the action. (*z*)

Necessity for a determination of the exact invention protected.

In determining whether an act complained of is really an infringement of a patent or not, it is always most important to ascertain from the specifications what is the exact invention protected. If this invention is taken by the defendant, an infringement is committed, and it will not save the defendant from the consequences that, though he has taken the invention, he has dressed it up colourably, added something to it, or taken something away from it, provided that of the whole it can be said that the machine or process is either the plaintiff's or differs from it only colourably. (*a*) Thus in a chemical case, where the plaintiff claimed the use of a mixture of hydrocarbons obtained according to a defined process and distilling over between 170° and 200° C. for the purpose of preparing artificial musk, the use for the same purpose of one specific hydrocarbon boiling when pure at 200° to 202°, but small quantities of which would distill over from the

(*v*) Upmann *v.* Elkan, (1871) L. R. 7 Ch. App. Cas. 130.

(*x*) Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210.

(*y*) Thomson *v.* Batty, (1889) 6 R. P. C. 84, 100.

(*z*) Ticket Punch Register Co. *v.* Colley's Patents, (1893) 12 R. P. C. 1, 15.

(*a*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34; Minter *v.* Wells, (1834) 1 W. P. C. 134; Stevens *v.* Keating, (1847) 2 W. P. C. 181; Muntz *v.* Foster (1843) 2 W. P. C. 95; Walton *v.* Potter, (1841) 1 W. P. C. 585; Gamble *v.* Kurtz, (1846) 3 C. B. 425; Trotman *v.* Wood, (1864) 16 C. B. N. S. 479; Hayward *v.* Pavement Light Co., (1884) 1 R. P. C. 207; Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61; Walker *v.* Hydrocarbon Syndicate, (1885) 2 R. P. C. 8; Sugg *v.* Bray, (1885) 2 R. P. C. 233; United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 321; Richardson *v.* Castrey, (1887) 4 R. P. C. 265; Ellington *v.* Clark, (1888) 5 R. P. C. 135, 319; Wenham *v.* May, (1887) 4 R. P. C. 303; Proctor *v.* Bennis (1887) 4 R. P. C. 333; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 198, 437; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 528; Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 121, 367; Shaw *v.* Jones, (1889) 6 R. P. C. 328; Winby *v.* Manchester, &c., Steam Tramways Co., (1889) 6 R. P. C. 359, 365; 7 R. P. C. 30.

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mixture produced by the patentee at the temperature indicated by him was held to be within the legitimate scope of his claim. (*b*)

Objection to the use of the word "colourable" or "colourably.

The use of the word "colourable" or "colourably" in reference to an infringement is highly inappropriate, and apt to lead to great confusion, as connecting the idea that a patent may be infringed though the invention is not identically or substantially copied, if it is forgotten that the real question always is, Has the property of the patentee been taken? (*c*) The identity of the invention may be disguised, but there is no infringement unless what the infringer does is to take identically and substantially the patentee's invention. So a patent may be infringed by a colourable imitation, though there would be no infringement in the use of a mechanical or chemical equivalent. (*d*)

Right way to consider the question of infringement.

The question of infringement is really a mixed one of law and fact. (*e*) It is the duty of the Court to construe the specification and claims together, (*f*) and thus to ascertain what is the invention protected by the patent; and this question must be determined by the Court independently of a jury, expert, or other witness. This is a rule which is often lost sight of by counsel in examining witnesses. (*g*) Expert evidence may, however, be relied on to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of any differences between the plaintiff's invention and the alleged infringement, (*h*) as also the relative importance of the different parts of the invention, in order to ascertain whether the substance has been appropriated. (*i*) It is the duty of the Court to construe the specification quite apart from what the defendant has done.

(*b*) Fabriques de Produit's Chemique de Thann et de Mulhouse *v.* Lafitte, (1899) 16 R. P. C. 61.

(*c*) See note (*a*), p. 338 *supra*.

(*d*) Tweedale *v.* Howard and Bullough, (1896) 13 R. P. C. 536, in conjunction with Tweedale *v.* Ashworth, (1892) 9 R. P. C. 121; also Scott *v.* Hull Steam Fishing Co., (1897) 14 R. P. C. 143, in conjunction with Scott *v.* Hamling, (1897) 14 R. P. C. 123; Tweedale *v.* Ashworth, (1909) 17 R. P. C. 625; also p. 354, *post*.

(*e*) p. 265 *ante*; Seed *v.* Higgins, (1860) 8 H. L. C. 555; Curtis *v.* Platt, (1866) 35 L. J. Ch. 852.

(*f*) p. 277 *ante*.

(*g*) Brooks *v.* Steel, (1896) 14 R. P. C. 47; pp. 458, 467 *post*.

(*h*) Brooks *v.* Steel, (1896) 14 R. P. C. 47.

(*i*) Clark *v.* Adie, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 302; Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 765; pp. 343, 458, *post*.

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The first canon of construction is that the specification must be construed, like all other written instruments or business documents, as if the Court had to construe it the day after it was published; and the Court is bound to construe the specification as if it had to be construed before the defendant was born, if the patent was before that time. (*k*)

Importance of ascertaining the principle of the invention protected.

In this connection it is always most important to consider what is the principle of the invention. (*l*) The reader must observe that the word "principle," when thus used, is not intended to signify any of those first principles or laws of nature which cannot be the subject of a valid patent, (*m*) but is intended to mean a practical application of one or more of those first principles which is properly denominated an art by means of which articles of commerce may be manufactured; and an art of this description is that which must necessarily be the subject of every valid patent. (*n*) Thus, in the case of *Watt's* steam-engine, *Watt* invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. Whenever it can be shown that any act done without the sanction of the patentee comes, in this sense of the word, within the principle of the invention, the act is an infringement of the patent, for it necessarily implies that the art invented by the patentee has been used contrary to the prohibition in the grant. The law intends a patent to reward the patentee for his invention by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege by making some mechanical variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be frustrated, for no one would pay the patentee a profit for the patented article, if he could obtain an article substantially the same at a cheaper rate. (*o*)

(*k*) Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 523, judgment of Esher, M.R.

(*l*) Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684; Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 765; Sandow *v.* Szalay, (1903) 21 R. P. C. 33, 393; 23 R. P. C. 6; Lambert Co. *v.* International Phonograph Indestructible Record Co., Ld., (1904) 21 R. P. C. 285; Thomson *v.* Moore, (1889) 6 R. P. C. 426, 450.

(*m*) p. 43, *ante*.

(*n*) p. 24, *ante*.

(*o*) Hindmarch on Patents, pp. 493, 494; Thomson *v.* Moore, (1889) 6 R. P. C. 426, 450.

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Adoption of the principle of the invention protected, though details differ, is an infringement.

Thus, when a principle in the above sense is invented and the infringer takes the principle and alters the details, and yet it is obvious that he has taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing, the Court can look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor. (*p*) In another class of cases, although a certain principle is common to a variety of manufactures, the subject-matter of the patent is really the particular mechanical mode by which that common principle is carried into effect, (*q*) and such patents are only infringed when the particular mechanical mode which is the subject-matter of the patent is copied.

*Crossley* v. *Beverley* (*r*) may be given as an example of the point under discussion. In that case it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patented machine, the principles applied in the plaintiff's machine and in the defendant's being the same. The plaintiff accordingly obtained a verdict.

Baron *Alderson*, in a subsequent case, commenting on *Crossley* v. *Beverley*, said: "There never was a more instructive case than that. I remember very well the argument put by the Lord Chief Baron, who led the case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve. The scientific men, all of them, said the moment a practical scientific man has got that principle in his head he

(*p*) Tweedale *v.* Ashworth, (1892) 9 R. P. C. 126; Moor *v.* Thomson, (1890) 7 R. P. C. 325; Badische Anilin und Soda Fabrik *v.* Levinstein, 24 Ch. D. 170; Sellers *v.* Dickinson, (1850) 5 Ex. R. 312, 324, in which cases the infringement was quite outside the specification, but not the invention; see also p. 280 *ante*.

(*q*) Per Halsbury, L.C., Tweedale *v.* Ashworth, (1892) 9 R. P. C. 126: Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 *n*.

(*r*) (1829) 1 W. P. C. 106.

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can multiply without end the forms in which that principle can be made to operate." (*s*)

In short, if the pith and marrow—*i.e.*, substance—of the patentee's invention be taken, an infringement is committed, and such a taking is none the less actionable because the infringer has added something to the invention which constitutes an improvement. (*t*) Further, it is not proper for the Court to determine the question whether or not the substance of an invention has been taken upon a consideration of the specification alone. In addition to a consideration of the specification, the Court must also regard the evidence as to existing knowledge on the subject at the date of the patent, and as to the operation of the machine or process. (*u*)

It rarely happens that an infringer takes the identical thing described and claimed by the patentee. He usually modifies it or dresses it up with some additional matters. Nevertheless, if he has taken the substance or pith and marrow of the patentee's invention he is guilty of an actionable infringement, (*x*) and this notwithstanding the fact that everything done by the patentee since the date of the patent may be an improvement upon it. The question is whether the defendant has taken the substance or pith and marrow of the plaintiff's

(*s*) Jupe *v.* Pratt, (1837) 1 W. P. C. 146; see also Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684.

(*t*) Erlich *v.* Ihlee, (1888) 5 R. P. C. 437; Hayward *v.* Hamilton, (1881) Griff. P. C. 115, 124; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740, 756; Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. 205; 40 L. J. Ch. 739; Neilson *v.* Harford, (1841) 1 W. P. C. 310; Russell *v.* Ledsam, (1847) 14 M. & W. 579; Bateman *v.* Gray, (1853) Macr. P. C. 102; Saxby *v.* Clunes, 43 L. J. Ex. 228-241; Thorn *v.* Worthing Skating Rink Co., (1877) L. R. 6 Ch. D. 415; Plimpton *v.* Spiller, (1875) L. R. 4 Ch. D. 286; Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 *n.*; 35 L. J. Ch. 852; Spencer *v.* Ancoats, &c., Co., (1889) 6 R. P. C. 46; Thompson *v.* Batty, (1889) 6 R. P. C. 84; Thompson *v.* Moore, (1889) 6 R. P. C. 428; 7 R. P. C. 325; Wilson *v.* Barbour, (1888) 5 R. P. C. 245. 675; Nordenfelt *v.* Gardner, 1 R. P. C. 61; Automatic Weighing Machine Co.'s cases; Boyd *v.* Horrocks, 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; Montgomerie *v.* Paterson, 11 R. P. C. 221, 633; Wenham Gas Co. *v.* Champion Gas Lamp Co., 8 R. P. C. 373; 9 R. P. C. 49; Actien Gesellschaft für Cartonnagen Industrie *v.* Schroeder, 13 R. P. C. 466; Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559; Proctor *v.* Bennis (1877) L. R. 36 Ch. D. 740; Clark *v.* Adie, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315; North British Rubber Co. *v.* Macintosh. (1894) 11 R. P. C. 477; North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; Lane *v.* Herold, (1892) 9 R. P. C. 447; English and American Machinery Co. *v.* Union Boot and Shoe Co., (1894) 11 R. P. C. 137, 367; Chamberlain and Hookham *v.* Mayor, &c., of Bradford. (1903) 20 R. P. C. 684.

(*u*) See Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 745. which contradicts the view expressed by Esher, M.R., in Lyon *v.* Goddard, (1893) 10 R. P. C. 341, and by Wills, J., in Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896), 13 R. P. C. 330; Morris *v.* Young, (1895) 12 R. P. C. 456, 461.

(*x*) See note (*t*) *supra*.

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invention as claimed in his specification; and this invention may be infringed although the defendant uses it in conjunction with an improvement which is not within the ambit of the patentee's claim, (*y*) for in the pertinent words of Lord *Bowen*, "the superadding of ingenuity to robbery does not make the operation justifiable." (*z*)

Relative importance of parts is a question to be settled by evidence.

The relative importance of the different parts of the patentee's combination or process is a question to be settled by evidence. (*a*) The fact, if such be the case, that the patentee in the specification attaches an undue importance to the use of something, handicaps him, no doubt, in a contest as to infringement, but has no further weight, and the Court is free to exercise its own judgment in weighing this fact with others when dealing with the question of infringement. (*b*)

Though a claim to a process may mention *nominatim* the use of a specific thing, it may be none the less infringed by the adoption in the process specified of a manufacturing equivalent for the specific thing mentioned, when such specific thing is not of the essence of the invention—*e.g.*, the substitution of a depositing tank for the centrifugal separating machine mentioned in the claim for the patented process for the manufacture of lanolin. (*c*)

With regard to the true way in which to determine what is important and what is of subsidiary consequence in reference to the patentee's invention, the following passage from the judgment of *Wills*, J., in *Incandescent Gas Light and Coke Co.* v. *De Mare Incandescent Gas Light System*, (*d*) may be quoted with great advantage as dealing with some of the older cases on the subject:—

> "It is contended by the defendants that what is important and what is of subsidiary consequence can only be gathered from the specification itself. I am satisfied that that neither is, nor can be, the law. Certainly *Dudgeon* v. *Thomson*, (1877) L. R. 3 App. Cas. 34, which is cited as an authority to that effect,

(*y*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34.

(*z*) Wenham Gas Co. *v.* Champion Gas Lamp Co., (1890) 9 R. P. C. 56.

(*a*) Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 765; *infra*.

(*b*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 331; judgment of Wills, J.; but see Bungo *v.* Higginbottom, (1901) 18 R. P. C. 201, judgment of Kekewich, J., which appears to conflict with the above judgment of Wills, J., and also with the dictum of Vaughan Williams, L.J., at 19 R. P. C. 193.

(*c*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 11 R. P. C. 93, 261; see also Aktiebolaget Separator *v.* Dairy Outfit Co., (1898) 15 R. P. C. 327.

(*d*) (1896) 13 R. P. C. 330.

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says nothing of the kind. 'Additions and subtractions,' says Lord *Cairns*, 'may exist, and yet the thing protected by the specification may be taken notwithstanding.' There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be infringement notwithstanding 'slight variations.' (*e*) 'So again,' says *Cotton*, L.J., (*f*) 'omissions and additions may be very material in considering whether, in fact, the machine of the defendant is an infringement of the combination which the plaintiff claims.' Omissions and additions may even be improvements, but that fact 'does not enable you,' says *Bowen*, L.J., 'to take the substance of the plaintiff's patent.' (*g*) 'If the instrument patented,' says Lord *Cairns*, 'consists of twelve different steps producing in the result the improved clipper, an infringer who had taken eight, nine, or ten of those steps might be held by the tribunal judging of the patent to have taken the substance, the pith and marrow of the invention, although there are one, two, three, four, five steps which might not actually have been taken.' (*h*) In such a case, as far as the specification went, the patentee would, under ordinary circumstances, treat the whole of the twelve steps as essential parts of his combination, and, so far as the specification went, there would be nothing to indicate that any one of them was not indispensable or was of less importance than the others. In *Proctor* v. *Bennis* there was nothing to indicate that the patentee thought the parts of his combination omitted or varied by the defendant of anything but cardinal importance. How was the question suggested by *Cotton*, L.J., whether the variations were 'slight' to be ascertained, except by evidence as to the relative importance of the variations in question as compared with the patented combination as a whole? 'There is, or may be,' says *James*, L.J., and *Mellish*, L.J., 'an essence or substance of the invention underlying the mere accident of form: and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated

(*e*) Cotton, L.J., in Proctor v. Bennis, (1887) L. R. 36 Ch. D. 740-754.
(*f*) *Ibid.* p. 756.
(*g*) Proctor v. Bennis, (1887) L. R. 36 Ch. D. 756.
(*h*) Clark v. Adie, (1873) L. R. 2 App. Cas. 315-320.

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form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.' (*i*) Drop the word 'combination,' which is perfectly immaterial as regards the principle, and every word is applicable to the present case. Mr. *Bousfield* says I am not entitled to take this as an accurate statement of the law, as the case went to the House of Lords, and no such doctrine is, as he contends, enunciated by the Law Lords. This, however, is a mistake. Lord *Cairns* expressly says: 'I am quite satisfied with the judgment of the learned Lords Justices, and I should have been content to rest the decision of this case upon that judgment, but for its importance.'" (*k*)

Substance and principle of the invention is always the important question.

In each case the substance of the invention and the principle of the machine and not the mere form are to be looked to. If what the defendant does is in principle not the same but really different there is no infringement; (*l*) and the question always is, not whether the substantial part of the process or combination said to be an infringement has been taken from the patentee's specification, but the very different one, whether what is done or proposed to be done takes from the patentee the substance of his invention as claimed. "A process might be wholly gathered from a specification and nowhere else, and yet be no infringement if it did not take substantially the thing invented." (*m*)

Though it may be lawful to take the pith and marrow in one sense of a patented invention, it is never lawful to take its substance without licence.

Thus a person may be entitled to take the pith and marrow in one sense of the patentee's invention; (*n*) what he is not entitled to do is to take its substance. The term "pith and marrow" used by Lord *Cairns* and many Judges since is, as *Wills*, J., has pointed out, not so good a one to use as "substance of the invention," for it is very easy to misapply it, and it would be very likely to mislead a jury. To quote *Wills*, J., again: "'Pith' is a great deal less than the substance of the vegetable structure of which it is part, and 'marrow' is a great deal less than the substance of the

(*i*) Clark *v.* Adie, (1873) L. R. 10 Ch. App. 667–675.

(*k*) (1877) L. R. 2 App. Cas. 326; see also Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 765.

(*l*) Morgan *v.* Seaward, (1836) 1 W. P. C. 171; Ferranti *v.* British Thomson-Houston Co., Ld., (1902) 19 R. P. C. 147; 20 R. P. C. 145; see also p. 280 *ante*.

(*m*) Per Wills, J., Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C 330; see also Pneumatic Tyre Co. *v.* Tubeless Pneumatic Tyre and Capon Heaton, Ld., (1897) 15 R. P. C. 74. 237; 16 R. P. C. 77; Allen *v.* Abraham Pyatt & Co., (1898) 15 R. P. C. 723; 16 R. P. C. 135.

(*n*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 345; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1897) 14 R. P. C. 303.

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animal structure of which it is part. Metaphors are very apt to mislead, as they are seldom close enough to the things to which they are applied." (*o*)

The "pith and marrow" of the *Welsbach* process of gas illumination is the construction of a mantle or skeleton of materials which will incandesce when subjected to the heat of a flame, but the "substance" of the invention *claimed* in the *Welsbach* specification is moulding the illuminant into shape by a certain chemical process of reduction from salts of substances mentioned by the patentee or substances substantially the same as those, with the necessary consequence that the skeleton is homogeneous throughout. It has been held that it is no infringement of this claim to produce a mantle which will incandesce, by a process consisting in first forming a mantle of alumina and zirconia homogeneous throughout and strong, but giving little incandescence, and secondly, coating this with a thin layer of oxide of chromium, which incandesces well, and is not a substance substantially the same as those mentioned and claimed by the patentee. In such a structure the illuminant is not (as in the *Welsbach* process) that portion of a homogeneous mantle which is exposed to the flame, but a foreign substance laid on in a thin film and quite absent from the bulk of the skeleton. Though this is an appropriation of the pith and marrow of the *Welsbach* invention, it is not such a taking of the substance of it as will constitute an infringement of the claim. The patentee did not and could not claim the formation of a skeleton by other means and of other substances than those pointed out in the specification, or by means substantially identical and apart from the contemporaneous formation of the illuminants, and so the Court was reluctantly compelled to hold that there was no infringement. (*p*)

On the other hand, it has been held that to vary by omission and alteration the non-essential details of the chemical process claimed in the *Welsbach* specification, but at the same time to produce an illuminant which is homogeneous throughout, though in a form of a fringe of threads instead of a mantle as described in the specification, is to take the substance of the *Welsbach* invention and so to commit an infringement. (*q*)

(*o*) Per Wills, J., Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 332.

(*p*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 345.

(*q*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559.

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Again, in an action brought for the infringement of *Bartlett's* patent for "improvements in tyres or rims for cycles and other vehicles," (*r*) *Romer*, J., held that the essence of *Bartlett's* invention was the combination of an outside flexible tyre that can be easily removed, because it is not itself a complete tube, and of an inside complete tube capable of inflation, so that when the inside tube is inflated the flexible tyre is kept on to the grooved metal rim of the wheel by the pressure of the sides of the flexible tyre against the groove. The patentee in his specification pointed out that by thickening the sides or edges of the flexible tyre the grip could be increased; and obviously the more the grip was increased the more difficult it would be for the inside complete tube, if made elastic, to force the flexible tyre out of the narrow mouth of the grooved metal rim. The defendants took the patentee's idea and the essence or substance of his invention. All they did, by way of alteration, was to increase the size of the outside flexible tyre and the thickening of its edges, and to exaggerate the dovetailing of the metal grooved rim, so as to give a greater grip, and to render it more difficult for the flexible tyre to be forced out of the mouth of the groove, and thus they were enabled to employ for the inflatable inside tube a more elastic tube than that mentioned in the body of the specification. The Judge held that the defendants' tyre might be an improvement upon the plaintiff's, but still, in substance, it was the plaintiff's and an infringement of the patent. Other points incidental to the structure of the different parts of the combination used by the defendants were urged as differentiating it from the plaintiff's, but unsuccessfully, in face of the finding of the Court that the essence or substance of the plaintiff's invention was present in the defendants' combination. (*s*)

(*r*) North British Rubber Co. *v.* Macintosh, (1894) 11 R. P. C. 477.

(*s*) See also North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; Pneumatic Tyre Co. *v.* Tubeless Tyre, (1897) 15 R. P. C. 74, 236; 16 R. P. C. 77; White *v.* Bortrams, (1897) 14 R. P. C. 501, 735; Dunlop Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 16 R. P. C. 16; and as to the true construction of the claims of the Welch patent for bicycle tyres and what was and what was not held to be an infringement see the following cases: Pneumatic Tyre Co. *v.* Caswell, (1896) 13 R. P. C. 164, 375; Pneumatic Tyre Co. *v.* East London Rubber Co., (1897) 14 R. P. C. 77, 573; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 853, approved by C. A., 16 R. P. C. 17; Dunlop Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 16 R. P. C. 16; Dunlop Pneumatic Tyre Co. *v.* Wapshare Tube Co., Ld., (1900) 17 R. P. C. 433; Dunlop Pneumatic Tyre Co. *v.* Clifton Rubber Co., (1902) 19 R. P. C. 433; 20 R. P. C. 393;

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So also a patent for a chemical mixture or compound suitable for a beetle poison was held to be infringed by the addition of non-material ingredients to the material ingredients specified by the patentee. (*t*) And in a case where the defendants took what was the merit of the plaintiff's improved sewing machine—*i.e.*, using a looper in such a way and with such a variety of machinery as to present the thread at a sufficient tension to the notch of the needle, though they introduced a portion of an alleged anticipating but useless machine, which was not necessary to the plaintiff's mechanism, they were held to have infringed. (*u*)

*Criterion of novelty and infringement are not the same.*

An arrangement, though it be an infringement of a prior patent, may be such as would itself support a patent on the ground of novelty. The criterion of novelty and infringement in this respect are not the same. This point was stated by *Pollock*, C.B., in *Newton* v. *Grand Junction Railway Co.* (*x*) Thus:—

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

*Combination may be infringed by an unlawful taking of its substance.*

In further pursuance of the principle under discussion, viz., that there is no infringement unless the substance of the invention claimed is pirated by the alleged infringer, the following remarks of Lord *Cairns*, L.C., and Lord *Esher*, M.R., made in reference to patents for combinations, may be usefully quoted:—

Dunlop Pneumatic Tyre Co. *v.* United Rubber Works, Ld., (1902) 19 R. P. C. 406; Dunlop Pneumatic Tyre Co. *v.* New Lamb Tyre Co., (1902) 20 R. P. C. 303; Dunlop Pneumatic Tyre Co. *v.* Hyde Rubber Co., (1904) 21 R. P. C. 208.

(*t*) Lane *v.* Herold, (1892) 9 R. P. C. 447.

(*u*) English and American Machinery Co. *v.* Union Boot and Shoe Co., (1894) 11 R. P. C. 137, 367.

(*x*) (1846) Ex. R. 331; 20 L. J. Ex. 427 *n.*

(*y*) See p. 339 *ante*.

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Lord *Cairns* in *Clark* v. *Adie*, (1877) L. R. 2 App. Cas. 320, speaking in the House of Lords on the different possible modes of infringing a patent for a horse-clipper which consisted of a combination of several parts, said: "One mode of infringement would be a very simple and clear one: the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument here described; he might make an instrument which in many respects might resemble the patent instrument, but would not resemble it in all its parts. And then the question would be, either for a Judge or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term "combination." Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind and has intended to claim protection for those subordinate integers; and, moreover, he is, as was said by

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the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Lord *Esher*, M.R., speaking on the same question, in reference to the patent for the *Nordenfelt* gun in *Nordenfelt* v. *Gardner*, (1884) 1 R. P. C. 61, 65, said: "That seems to me to claim the feeding apparatus as a combination, and to claim the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and the putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

In order to answer a charge of infringing a patent for a combination of several parts by the omission of one of them,

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it is not necessary for a defendant to prove that the part omitted was an essential element in the combination in the sense that the machine would not work without it; but he must at least show that it is a material element and not a mere detail which may be varied or omitted altogether without serious detriment to the successful working of the combination. (*z*)

Thus, the substitution of a weighted valve for a water valve or column in a combination forming a milking machine was held to be an infringement. (*a*) Also the substitution of a pump, though contrived with great ingenuity, for a bellows in a smoke-testing and fumigating apparatus. (*b*) Again, a patent for an improved carriage lamp, in which the candle tube was prevented from falling out by means of a flat sliding bolt which engaged with a knob on the tube being pushed home by the coachman's hand, or simply by shutting the door of the lamp, and kept in its place by contact with the door when shut, was infringed by a sliding bolt with spring engaging with a collar on the tube and kept in position by the shut door of the lamp. (*c*)

But if the defendant's combination is really a different one to the plaintiff's there is no infringement, (*d*) *i.e.*, if an essential feature of the plaintiff's combination is not to be found in the defendant's combination. (*e*)

Special claims for subsidiary parts of a combination.

It has been explained (*f*) that in the case of a patent for a combination of several parts a claim may be made to the combination as a whole, and also to any one or more of the several parts separately, or in combination as a minor invention. The question whether the use of one or more of the component parts of a combination is an infringement or not, depends upon whether or not the parts are claimed separately, or whether taken together they are claimed as a subsidiary combination. It is not possible to say in the abstract whether the use of two parts, A and B, of a combination consisting of A, B, and C, is or is not using part of the invention; nor can it be decided in the abstract whether or not the specification

(*z*) Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 766.

(*a*) (1893) 10 R. P. C. 417.

(*b*) Macdonald *v.* Fraser, (1893) 10 R. P. C. 386; 11 R. P. C. 169.

(*c*) Howes *v.* Webber, (1895) 12 R. P. C. 465; 13 R. P. C. 39.

(*d*) Automatic Diversions Syndicate *v.* Urry, (1897) 14 R. P. C. 365.

(*e*) Griffiths *v.* The Birmingham Stopper and Cycle Component's Co., (1899) 16 R. P. C. 383; Brooks *v.* Lamplugh, (1898) 16 R. P. C. 41; Pneumatic Tyre Co. *v.* Tubeless Pneumatic Tyre and Capon Heaton, Ld., (1898) 16 R. P. C. 77; Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 745; Hardmuth *v.* Baker, (1904) 21 R. P. C. 66.

(*f*) p. 256 *ante*.

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shows that A and B is claimed separately or whether they are claimed together as a separate subordinate combination within the larger combination consisting of A, B, and C. (*g*)

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material and is the subject of a claim; (*h*) though, if the patent is for a combination of two or more old inventions, the use of only one of them will not be an infringement, since the patentable novelty claimed is the combination of the two. (*i*)

Thus, if a man invents a machine consisting of three parts, of which one is a very useful invention, and the other two are found to be of less practical use, it is not free for a person to adopt the useful part, and contrive some other mode of carrying out the less useful parts. (*k*) The question always is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (*l*)

Equivalents substituted for specified parts.

When the ambit of the claim is not limited to the particular thing specified, the law will not allow a person in lieu of a part described by the patentee to employ a substitute in its place, for the purpose of effecting the same end, by means of an equivalent, using the skill and knowledge which he may possess to evade the patent. (*m*)

In fact, when, having regard to the state of public knowledge, a narrow construction is not to be put upon the claim, (*n*) it is an infringement to substitute mechanical

(*g*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 335.

(*h*) Lister *v.* Leather, (1857) 8 E. & B. 1004; Parkes *v* Stevens, (1869) L. R. 8 Eq. 358, 366; L. R. 5 Ch. App. 36; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Foxwell *v.* Bostock, (1863) 12 W. R. 723; Sellers *v.* Dickinson, (1850) 5 Ex. 312; Newton *v.* Grand Junction Ry., (1846) 5 Exch. 331; Smith *v.* London and North-Western Ry., (1853) 2 E. & B. 69; Young *v.* Rosenthal, (1884) 1 R. P. C. 33; Clark *v.* Adie, (1873) L. R. 10 Ch. App. Cas. 667; 3 Ch. D. 134, 143; 2 App. Cas. 315, 327, 335; Consolidated Car Heating Co. *v.* Came, (1903) 20 R. P. C. 763.

(*i*) Smith *v.* London and North-Western Ry., (1853) 2 E. & B. 69, 76.

(*k*) *Ibid.*

(*l*) See per Cotton, L.J., Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 254, 740; 4 R. P. C. 333; see also Burnett *v.* Tato, (1882) 45 L. T. N. S. 143; Murray *v.* Clayton, L. R. 10 Ch. App. Cas. 675 *n.*; Kaye *v.* Chubb, (1888) 5 R. P. C. 641; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563; Combination Hubs, Ld. *v.* Seabrook, (1906) 23 R. P. C. 205.

(*m*) Bateman *v.* Gray, (1853) Macr. P. C. 102; Morgan *v.* Seaward, (1837) 1 W. P. C. 171; Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 *n.*; United Telephone Co. *v.* Harrison Cox-Walker, (1882) L. R. 21 Ch. D. 720; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 295; United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 321; Hancock *v.* Moulton, Johns. Pat. Man. 5th ed. p. 254.

(*n*) p. 353 *post*.

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equivalents for parts of the patentee's invention and add at the same time an improvement; (*o*) or to omit some part or parts of a patented combination and add anything, whilst at the same time using the substance and essence of it. (*p*)

Rule in Sellers v. Dickinson.

It is an accepted proposition of patent law, known as the rule in *Sellers* v. *Dickinson*, (*q*) that if a portion of a patented new arrangement of machinery is in itself new and useful, and a person, for the purpose of producing the same effect as it produces, uses that portion of the arrangement, and substitutes another mechanical equivalent for the other matters combined with it, he thereby commits an infringement of the patent.

*It is important to remember that the novelty connoted in* the above paragraph may, in some cases, be the employment for the first time for a particular purpose of an underlying principle, and, in other cases, the novelty may be the employment of details whereby an old principle is carried into effect in a new way. The doctrine of infringement by the substitution of equivalents is applicable only to cases of the first of the above-indicated two classes. (*r*)

Equivalents not known at the date of the patent.

*In order, however, that the substitution of an equivalent* for any part of a patented mechanical combination or process may constitute an infringement, the equivalent must, judged by the standard of public knowledge at the date of the patent, be obviously and demonstrably an equivalent. To produce the result arrived at by the patentee by the use of an equivalent means, which required subsequent discovery to demonstrate that it is an equivalent, may be perfectly good subject-matter for a subsequent grant of letters patent, and no infringement of the prior patent. (*s*) Thus, rendering cast steel easy to weld and malleable by subsequently discovered equivalents, viz., the addition of coal tar and black oxide of manganese to a crucible containing bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, and

(*o*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437, 454.

(*p*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; 36 Ch. D. 740, 755; Needham *v.* Johnson, (1884) 1 R. P. C. 49; Gwynne *v.* Drysdale, (1886) 3 R P. C. 65, 67; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205.

(*q*) 5 Exch. 312, 326; 20 L. J. N. S. Ex. 417.

(*r*) See p. 341 *ante*, and pp. 354, 366 *post*.

(*s*) Heath *v.* Unwin, (1855) 5 H. L. C. 545; Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156, 170–173; L. R. 12 App. Cas. 710; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113, 300; Thomson *v.* Moore, (1889) 6 R. P. C. 426; 7 R. P. C. 329.

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heated to the proper heat for melting the materials, was held by the House of Lords (*t*) to be no infringement of a claim made by a prior patentee for doing the same thing by means of carburet of manganese, although there was evidence to the effect that carburet of manganese was formed by exposing the mixture of carbon and oxide of manganese to a high temperature. This decision of the House of Lords was based upon the fact that, at the date of the patent sued on, it was not known that coal tar and oxide of manganese would be chemical equivalents of the carburet of manganese claimed by the patentee, (*u*) *i.e.*, judged by the light of public knowledge at the date of the patent coal tar and oxide of manganese were not obviously and demonstrably the equivalent of carburet of manganese. As stated by Lord *Abinger*, C.B., in the Court of Exchequer, the materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the claim of the letters patent. (*v*) The foregoing remarks must not be taken to imply that the substitution for a part in the patented combination or process of a subsequently invented or discovered equivalent, which itself may possibly be subject-matter for valid letters patent, is necessarily no infringement. Assuming a particular case to be one to which the doctrine of infringement by the substitution of equivalents is applicable, (*x*) it is submitted the real point for determination is whether or not the newly invented or discovered equivalent is, when judged by the light of public knowledge at the date of the patent alone, clearly and obviously an equivalent *qua* the function of the part for which it is substituted.

State of public knowledge affects the question whether or not the substitution of known equivalents is an infringement in a particular case, *i.e.*, public

With regard to the question of the infringement of patents by the substitution of equivalents for parts described by the patentee in the specification, it must be remembered that it is necessary first to determine the true construction of the specification, and so ascertain what is the real invention claimed. (*y*) It must also be borne in mind that the true construction of the specification and ambit of the claim may be affected (*inter alia*) by the state of public knowledge at the

(*t*) Heath *v.* Unwin, (1855) 5 H. L. Cas. 505.

(*u*) 5 H. L. C. 515, 548.

(*v*) Heath *v.* Unwin, (1855) 2 W. P. C. 217; 5 H. L. C. 545, 548; Nobel's Explosives Co. *v.* Anderson, (1895) 12 R. P. C. 167, 168.

(*x*) See *infra*.

(*y*) pp. 265, 338, 353 *ante*.

date of the patent. (*z*) The substitution of an equivalent in the place of a part mentioned in the patentee's specification may, or may not, be an infringement according as the state of public knowledge affects the true construction and ambit of the claim. (*a*)

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knowledge affects the true ambit of the claim.

When the invention relates to the production by means of a novel combination of old parts of an old result, or to a machine of a known type, *i.e.*, a machine utilising an old principle or system, the patentee is protected only in respect of the particular means he sets forth in the specification; and under such circumstances it may be no infringement to achieve the same result by the use of well-known equivalents. (*b*) In other words, when the invention claimed is the particular arrangement of old parts previously used in combination, the doctrine of infringement by substitution of equivalents, *i.e.*, different mechanical contrivances formerly used for the same purpose or of newly invented mechanical contrivances, is not applicable, and the patentee cannot complain of the use of different mechanical appliances in lieu of one or more of the parts, (*c*) though, no doubt, he might restrain the substitution of mere colourable variations for a part or parts in the new arrangement. (*d*) In such cases it is the rule of the Court, if it can fairly and logically be done, to give the claim the limited construction above indicated, for the rule is that the specification is to be construed so as to support the patent, if it can fairly and logically be done, (*e*) and if a wider construction were put upon it under the circumstances indicated it would claim what had been done before, and so make the patent void for want of novelty.

On the other hand, when the invention consists in the production of a new result, or a machine which is of a totally new type, *i.e.*, a machine involving the use of a new principle or system, the patentee is not tied down strictly to the particular means, or the identical parts he sets forth in the specification; and under such circumstances it is an infringement to substitute obvious equivalents for the parts specified,

(*z*) pp. 283, 285 *ante*, and p. 467 *post*.

(*a*) See p. 342 *ante*, and p. 366 *post*.

(*b*) Curtis *v.* Platt, (1866) L. R. 3 Ch. D. 135 *n.*; Seed *v.* Higgins, (1860) 8 H. L. C. 550; Gosnell *v.* Bishop, (1888) 5 R. P. C. 550; Hick *v.* Simmonds, (1904) 21 R. P. C. 632; Hardmuth *v.* Baker, (1904) 21 R. P. C. 66.

(*c*) See Brooks *v.* Lamplugh, (1898) 16 R. P. C. 48.

(*d*) See p. 339 *ante*, and pp. 358, 363, 365, 366 *post*.

(*e*) p. 286 *ante*.

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and at the same time to make use of the novel principle the carrying of which into effect is the real substance of the patentee's invention. (*f*).

Curtis v. Platt and Proctor v. Bennis as types of the two classes of cases.

*Curtis* v. *Platt*, (*g*) which followed the earlier House of Lords' decision in *Seed* v. *Higgins*, (*h*) and the principle of which was also applied by the House of Lords in *Boyd* v. *Horrocks*, (*i*) and in *Morris* v. *Young*, (*j*) *Chamberlain and Hookham* v. *Mayor, &c., of Bradford*, (*k*) and *Ashworth* v. *English Card Clothing Co.*, (*l*) is usually cited as the leading authority with reference to the first class of cases, and *Proctor* v. *Bennis*, (*m*) the principle of which was approved by the House of Lords in *Moore* v. *Thomson*, (*n*) is the leading authority with reference to the second class of cases.

Curtis v. Platt.

In *Curtis* v. *Platt*, (*o*) where the patent was for certain improvements in spinning mules, a class of machine previously well known, and the invention consisted in a novel combination of old parts, all of which had been previously used before, and the invention was, consequently, a particular means of effecting an old result, though not in the same combination, for a similar purpose, Lord *Hatherley* (then Vice-Chancellor *Page Wood*) and Lord *Westbury*, L.C., and the House of Lords followed the rule laid down by the House of Lords in *Seed* v. *Higgins*, (*p*) which applies to patents for means of achieving known results, viz., that if you find a specific mechanical improvement claimed, then you must hold the person strictly to that particular mechanical device

(*f*) Clark *v.* Adie, (1887) L. R. 2 App. Cas. 315; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; Boyd *v.* Horrocks, (1891) 9 R. P. C. 77; Chamberlain and Hookham *v.* Mayor, &c., of Bradford, (1903) 20 R. P. C. 684.

(*g*) (1863) L. R. 3 Ch. D. 135 *n.*; L. R. 1 H. L. 337; 35 L. J. Ch. 852.

(*h*) (1860) 8 H. L. C. 550.

(*i*) (1892) 9 R. P. C. 77.

(*j*) (1895) 12 R. P. C. 455. The rule in Curtis *v.* Platt was also applied in the following cases: Bovill *v.* Pimm, (1856) 11 Exch. 718; British Tanning Co. *v.* Groth, (1891) 8 R. P. C. 113; Jahncke *v.* Bell, (1892) 9 R. P. C. 94; Nettlefolds *v.* Reynolds, (1892) 9 R. P. C. 270; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493; Ticket Punch Registor Co. *v.* Colley's Patents, (1894) 12 R. P. C. 1, 171; Shoe Machinery Co. *v.* Cutlan (No. 2), (1896) 13 R. P. C. 141; Cleaver *v.* Wallwork, (1896) 13 R. P. C. 277; Birch *v.* Harrap (1896) 13 R. P. C. 615; Scott *v.* Hamling, (1897) 14 R. P. C. 123; Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143; Brooks *v.* Lamplugh, (1898) 16 R. P. C. 41; Bailey *v.* Airey, (1905) 22 R. P. C. 461; 23 R. P. C. 277.

(*k*) (1903) 20 R. P. C. 684.

(*l*) (1903) 20 R. P. C. 790.

(*m*) (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

(*n*) (1890) 7 R. P. C. 325. The rule in Proctor *v.* Bennis was held to apply in Gosnell *v.* Bishop, (1887) 5 R. P. C. 41, 151; Peckover *v.* Rowland, (1893) 118, 234; Jardine *v.* King, Mendham & Co., (1896) 13 R. P. C. 411; Presto Gear Case and Component's Co. *v.* Simplex Gear Case Co., (1898) 15 R. P. C. 635; Presto Gear Case and Component's Co. *v.* Orm, Evans & Co., (1900) 17 R. P. C. 218; 18 R. P. C. 17.

(*o*) (1863) L. R. 3 Ch. D. 135 *n.*; L. R. 1 H. L. 337; 35 L. J. Ch. 852.

(*p*) (1860) 8 H. L. Cas. 550.

which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed.

Lord *Hatherley*, then *Page Wood*, V.C., stated the law thus—

> "Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect." (*q*)

Lord *Westbury*, L.C., stated the law thus—

> "The mechanism that Mr. *Wain* [the patentee] describes is the proximate means of making the clutch-box operate for the purpose of making a break in the rotation of the shaft, it is, therefore, nothing more than a particular means for effecting a given result. That being so, I cannot but think that in patents of that description the doctrine of mechanical equivalents is not by any means applicable. The thing itself is nothing more than a particular agent for attaining a certain end, and if Mr. *Wain* was entitled to a patent for the particular agency by which he effected in a more convenient manner the opening and shutting of the clutch-box, any person is, on the same principle, entitled to a patent for the means of effecting the same result, provided those means are not a colourable evasion of Mr. *Wain's* patent, or provided those means do not embody Mr. *Wain's* patent with an improvement." (*r*)

It has wrongly been alleged that *Curtis* v. *Platt* laid down the principle that, when an invention is claimed for improvements in machinery consisting only in combination, the patentee must be held to the description which he gives of the particular means by which his invention is to be carried

(*q*) L. R. 3 Ch. D. 136 *n*.

(*r*) L. R. 3 Ch. D. 138, 139 *n*.

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into effect, and that there can be no infringement by the substitution of parts. What *Curtis* v. *Platt* really lays down is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims and the mode which he points out of effecting the improvement." (*s*) Or, to put it in another way, where at the date of the patent there were other known combinations of elements equivalent to the elements of the patentee's combination, and the real invention is neither more nor less than the substitution of a combination of elements for and mechanically equivalent to the elements of the mechanism previously known and used to attain the same end as the patentee's combination attains, the patentee is not in a position to take benefit from the principle of mechanical equivalents. In such circumstances there can be no infringement unless the apparatus complained of is in substance identical with the combination claimed by the patentee. (*t*) Consequently under such circumstances a claim for a particular means to effect certain purposes is not infringed where the same purposes are effected by different means; (*u*) nor is a combination to effect certain results infringed by a combination of similar parts operating in a different manner, though the results effected are the same; (*v*) but the claim is infringed when a variation in detail which amounts only to a colourable imitation is used. (*w*) When there is not only novelty in the machine, but also novelty in the result it produces, *Curtis* v. *Platt* does not apply. (*x*)

Proctor v. Bennis.

In *Proctor* v. *Bennis* (*y*) the patent in question related to a new combination of tappets, shafts and springs in connection

(*s*) Per Cotton, L.J., Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 756, 757; see also Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 558; Thomson *v.* Moore, (1889) 6 R. P. C. 426; Brown *v.* Jackson, (1895) 12 R. P. C. 324.

(*t*) Miller *v.* Clyde Bridge Steel Co., (1891) 8 R. P. C. 198; 9 R. P. C. 470, 478; Gosnell *v.* Bishop, (1888) 5 R. P. C. 159, judgment of Bowen, L.J.

(*u*) Sugg *v.* Bray, (1885) 2 R. P. C. 233-39; 19 R. P. C. 285; Crocker *v.* Aerators, Ld., (1903) 20 R. P. C. 621; p. 355 *ante*.

(*v*) Lawrence *v.* Perry, (1885) 2 R. P. C. 179, 188; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152; 9 R. P. C. 77; Automatic Weighing Co. *v.* Knight, (1889) 6 R. P. C. 113, 297.

(*w*) See per Westbury, L.C., p. 357 *ante*; Boyd *v.* Horrocks, (1888-91) 5 R. P. C. 557; 6 R. P. C. 152.

(*x*) Per Cotton, L.J., Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 756, 757; see also Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 558; Thomson *v.* Moore, (1889) 6 R. P. C. 426; Brown *v.* Jackson, (1895) 12 R. P. C. 324; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113.

(*y*) (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

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with a flap or door, producing a new kind of mechanical intermittent radial stoker for distributing coal on the fires of furnaces. The novel feature and underlying principle of this machine as compared with others was that in it the result of throwing coal on to the furnace by the intermittent radial action of a flap or door was for the first time applied. There was thus not only novelty in the machine, but there was novelty in the effect and the result produced. The defendant did not copy exactly the plaintiff's machine; on the contrary, the defendant's combination looked at first sight very different to the plaintiff's. What the defendant really did was to omit certain parts from the patented combination and to substitute mechanical equivalents for other parts, at the same time retaining the novel underlying principle of intermittent radial action. Therefore, although the defendant had not got the exact combination, yet he had got the combination in substance and result by adopting the underlying principle and putting mere mechanical equivalents for those things which were specifically mentioned in the plaintiff's specification.

The Court of Appeal held that, notwithstanding the substitution of the equivalents above referred to for analogous parts in the plaintiff's combination as specified, the defendant infringed because he had adopted the substance of the plaintiff's patented invention, which was the employment of the novel principle of intermittent radial action of the flap or door in the machine, and not the less so though he had added certain further improvements. *Cotton*, L.J., (*z*) referring to *Curtis* v. *Platt*, (*a*) and distinguishing that case from the present, in his judgment said—

> "The plaintiff there was a patentee or the assignee of a patent for improvements in spinning mules. A spinning mule was a well-known machine, working and acting long before the patent on which the plaintiff in that case relied was taken out, and it was necessary in such a machine that there should be an intermission of the action of certain parts, although the motive power was still acting on the machine as a whole. That result had been produced before the patent in question by, amongst other means, the patent of *Roberts* and the patent of *Lakin* and *Rhodes*, and they had done it by adopting certain mechanical means. What the patentee whose patent was relied on by the

(*z*) 4 R. P. C. 355.
(*a*) (1866) L. R. 3 Ch. D. 135 *n.*; 35 L. J. Ch. 852.

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plaintiff did was to correct and improve the means which they described in their patents for the purpose of obtaining that result; and that, therefore, is a most material matter, because I find at page 857 of the 35 L. J. Ch., where the specification of the patent is set out, that what the patentee claimed was 'the novel construction, combination, and application of mechanism as hereinbefore described, whereby one half of the clutch or catch-box hereinbefore, and in the said specification of *Robert Lakin* and *William Henry Rhodes* described, or any mechanical equivalent therefor, is connected with and acts upon the cams or other similar parts of mechanism for effecting the changes in the action of the mule.' So that there he refers to that previous patent, and I think he also had done so with reference to the previous patent of the other patentee which I have mentioned. It was specially to introduce improvements into the mechanical means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore, in that case, in applying those words used by the Judges we must deal with the case before them and must come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous, though imperfect, machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the Judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect and in the result to be produced by that machine. In my opinion, therefore, we must come to the conclusion that here the defendant *Bennis*, and also the other defendants, do, in fact, infringe that which is claimed by the plaintiff as his combination, and that so far as that goes the appeal of *Bennis* fails."

Tweedale's invention and Everitt's in-

The history of the litigation in connection with *Tweedale's* invention, which related to cotton and wool carding and

consisted in improvements in flats and fasteners for securing the carding cloth thereon and thereto; and also *Everitt's* invention of the so-called penny-in-the-slot or coin-freed weighing apparatus, afford good illustrations of the application of the principles of *Curtis* v. *Platt* and *Proctor* v. *Bennis* respectively.

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vention as illustrating the application of the doctrines of Curtis v. Platt and Proctor v. Bennis respectively.

*Tweedale's* invention of "improvements in flats and fasteners for securing the card clothing thereon and thereto" was merely a new mechanical mode of obtaining an old result, *i.e.*, stretching evenly and fastening a carding cloth or fillet on the flat, and did not involve a question of principle. The claim, properly construed, was for the mode of achieving the result and the thing described. As pointed out by Lord *Watson*, the plain object of the invention was to substitute better mechanical equivalents for those already known and used as a means to the same end. (*b*) Consequently the rule in *Curtis* v. *Platt* (*c*) governed the question of infringement, and the doctrine of substitution of mechanical equivalents did not apply. Though *Tweedale's* invention was useful, ingenious, and meritorious, the claim was not infringed by another means of attaining the same result, the details of which were different. The new means adopted by *Tweedale* to attain the old result were thus described by Lord *Watson* (*d*) in the House of Lords: "The 'flat' consists of a straight bar of solid metal, to the surface of which there is attached a wire brush. What in ordinary language would be described as the back of the brush is of elastic material, and is technically termed its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and shall remain so in course of working. The attainment of that result has been found in practice to depend mainly, if not wholly, upon the manner in which the foundation of the brush is fastened to the bar of metal upon which it rests. At the date of the patent there appears to have been only two known modes of attachment. The foundation was placed upon the bar, and its edges fastened to the bar either by a series of rivets about half an inch apart, or by substituting a wire thread, with stitches of that length, for the rivets. Both the methods were liable to the same defects. In attaching it to the bar the foundation was apt to

History of the litigation in connection with Tweedale's invention.

(*b*) Tweedale v. Ashworth, (1892) 9 R. P. C. 129; (1900) 17 R. P. C. 625.
(*c*) (1886) L. R. 3 Ch. D. 135 *n.*; 35 L. J. Ch. 852; pp. 355-356 *ante*.
(*d*) Tweedale v. Ashworth, (1892) 9 R. P. C. 128.

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become puckered, thereby causing inequalities in the surface of the brush; and in working the exposed edges of the foundation became frayed, and caused an accumulation of waste from the material carded. The patentee's invention obviated these defects by introducing a different mode of fastening the foundation of the brush to the bar. The fasteners which he employed were thin strips of metal, one for each side of the bar. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, independently of the bar; the other edge of the strip was moulded so as to fit and grip a ridge cast upon the back of the bar. After a strip was attached to each edge of the foundation, the bar was inserted, producing a degree of tension which made the foundation adhere to it flatly and evenly, and then the other edges of the strips were made to grip the ridges cast on the other side of the bar, the result being that the surface of the brush was made and kept uniformly level, and that the edges of the foundation were, by the encasing metal, protected from fraying and becoming a receptacle for waste."

In *Tweedale* v. *Ashworth* (*e*) it appeared that the alleged infringer attained the old result, *i.e.*, secured the carding cloth to the "flat" in the following manner: By a long strip of metal he clasped one side of the fillet to the bar, and then, by a steel comb operating like a carpet stretcher, he stretched the elastic material of the fillet to the other side, and then clamped this other side of the fillet to the bar by a long strip of metal, precisely as he had already clamped the first side of the fillet and bar together. The stretching was thus produced by external mechanical means. This different means was held by the Court of first instance, the Court of Appeal, and the House of Lords to be no infringement of the means claimed by the patentee, which necessarily involved as one of the merits of the invention the power of stretching the material of the fillet at the same time and by the same operation as completed the machine. An essential feature of the patentee's invention was the gripping the edges of the fillet independently of the bar; and, as stated in the specification, it was evident that the forms of the edges of the bar and of the bent portions of the strips might be varied, so long as it is provided that one edge of each strip secures a firm grip upon the foundation of the fillet, and the other edge secures a tight grip upon the under portion of the bar.

(*e*) (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121.

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In *Tweedale* v. *Ashworth* (No. 2),(*f*) in the form there complained of the defendant fixed teeth in the top of the fastener, which, as in the above case, was a long strip of metal, but, as in the above case, the stretching was done by the external means of a steel comb operating like a carpet-stretcher, and the strip did not "grip" the edge or selvage of the foundation, neither did the insertion of the bar effect a stretching. Under these circumstances it was held by all the Courts that there was no infringement. The higher Courts, however, did not adopt the view of the Judge of first instance that the defendant's production was identical with that of the plaintiff, but held there was an all-important and very essential difference.

In *Tweedale* v. *Howard* and *Bullough*, (*g*) which was intermediate in date between the two cases above referred to, the infringers there slightly varied the form of the parts employed, but attained the result by a "colourable imitation" of the patentee's invention, in that they obtain a sufficient grip of the fillet independently of, and before, the insertion of the bar, which grip was increased when the strip was clamped upon the bar, and the insertion of the bar effected the desired stretching. The following *résumé* of the evidence (*h*) shows the variations in form adopted by the infringers. The defendants' fastener was a continuous strip of metal bent horizontally at the top and bottom, so that it firmly fixed the foundation of the clothing to the bar. There was no longitudinal rib, as in *Tweedale's*, under the bar, but the under side of the bar was bevelled for some distance in a slightly slanting upward direction, so as to admit of the fasteners being applied firmly. The top part of the strip had a distinct curl, by which it got a direct grip of the foundation, and the pressure applied to fix on the bar increased the curl, so that when the end of this part of the strip penetrated the foundation and was clinched, it got an adequate hold of the foundation, which was necessary for stretching purposes. The foundation was stretched by forcing in the bar. Thus the defendants attained the same end by substantially the same means, and the Court held that they had infringed, since the means used by them were only "colourable" variations of the patentee's means, and not mechanical equivalents for the parts specified by him and claimed in combination.

(*f*) (1899) 16 R. P. C. 145, 520; 17 R. P. C. 620.
(*g*) (1896) 13 R. P. C. 522. (*h*) 13 R. P. C. 532.

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History of the litigation in connection with Everitt's invention.

*Everitt's* invention of the automatic weighing machine consisted essentially in a contrivance by which he set the indicating apparatus in motion by means of a penny placed in the slot. The patentee was clearly not entitled to a patent for this principle apart from the method in which it was carried out as disclosed by the specification; and especially the patentee was not entitled to protection for every mode of operating upon every conceivable indicating apparatus by means of a penny. (*i*) The essential elements in *Everitt's* invention are three, viz.: (a) a weighing apparatus, (b) an indicating apparatus, and (c) a break, or want of continuity between the two, together with a contrivance by means of which the indicating apparatus, broken from the weighing apparatus, is, by a penny placed in the slot, set at work in such a way that the indicator will stop at a point fixed by the weighing apparatus itself, or by a stop upon it, and the index does not operate to show the weight on the dial till the coin is inserted. (*j*)

*Everitt's* invention produced the first machine of its class, which operated by the utilisation of the principle above described, and therefore the rule in *Proctor* v. *Bennis* (*k*) applied as to the infringement of the claim by the use of mechanical equivalents.

The first reported case relating to an infringement of *Everitt's Patent* was *Automatic Weighing Machine Co.* v. *Knight*, (*l*) and both the Judge of first instance and the Court of Appeal held that no infringement had been committed, because the essential features of the patentee's apparatus were not reproduced by the substitution of equivalents, or otherwise in the alleged infringing machine. The defendant's apparatus in this case differed from the patentee's in that it had a stop which prevented the machine being set in operation till a coin was put in the slot and raised a lever, thereby allowing a handle to be moved by the person being weighed, and the machine so to be set in operation; this was in effect equivalent to putting a lock on the machine, and so, though both machines attained the same result by the operation of the coin, the defendant's by the intervention of a different principle did it in a different way to that protected by the claim of the patent.

(*i*) p. 45 *ante*.

(*j*) Automatic Weighing Machine Co. v. National Exhibitions Association, Ld., (1891) 9 R. P. C. 44, 45.

(*k*) (1888) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

(*l*) (1889) 6 R. P. C. 297.

Then in *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, (*m*) it was also held that there was no infringement, where in the defendant's apparatus the coin was first introduced through the slot, and so placed in position that, on an outside knob being pushed by the person being weighed, the coin was moved and made to operate on the lever, which, so to speak, unlocked and set the weighing apparatus in action. Infringement.

These cases were followed by *Automatic Weighing Machine Co.* v. *National Exhibition's Association, Ld.*, (*n*) where it was held, both by the Judge of first instance and the Court of Appeal, that what the defendants had done was an infringement of *Everitt's Patent*, since the essential principle of the invention was pirated, though the defendants had most ingeniously attempted to conceal this fact by bringing about the same result by a somewhat different method. They adopted a lever instead of a wheel and axle, and they employed a different indicating apparatus, in which an electric battery was introduced; but these things were nevertheless held to be nothing but equivalents for the things pointed out by the patentee, and the defendants committed an infringement because they made use of the essential principle or substance of the patentee's machine, and gave effect to it merely in a different way by the substitution of mechanical equivalents for the parts which the patentee described.

In *Automatic Weighing Machine Co.* v. *International Hygienic Society*, (*o*) which was decided before the last-mentioned case, but did not go to the Court of Appeal, it was held that the defendants had infringed by the use of an indicating mechanism in which the indicating was effected by the removal of two shutters exhibiting the figures denoting the weight on a movable dial, which was a mere mechanical equivalent for the patentee's indicating mechanism where the indicating was effected by the movement of an index on a fixed dial, and there was a break between the weighing and indicating part of the mechanism, though the spindles in the defendants' machine were not on the same axial lines.

Again, in *Automatic Weighing Machine Co.* v. *Fearby*, (*p*) the defendant there was held to have infringed by using an apparatus consisting of a weighing apparatus and an indicating apparatus disconnected, in which a coin put in the slot fell

(*m*) (1889) 6 R. P. C. 367.
(*n*) (1891) 8 R. P. C. 345; 9 R. P. C. 41.
(*o*) (1889) 6 R. P. C. 475.
(*p*) (1893) 10 R. P. C. 443.

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into position by its weight and formed a coupling between an exterior handle and a lever. The handle, when turned by the person being weighed, moved a lever, which drew down one arm and released a catch which set free the indicating mechanism and allowed it to fall down by its weight on the weighing mechanism and so indicate the weight.

"Pioneer patent" and "pioneer claim."

The terms "pioneer patent" and "pioneer claim," or "master patent" and "master claim," are sometimes not inaptly used in reference to a claim which, having regard to the state of public knowledge in relation to the art at the date of the patent, is properly construed according to the rule in *Proctor* v. *Bennis*. (*q*)

Correct application of the doctrine of infringement by substitution is a matter of difficulty in some cases.

The doctrine of infringement by substitution is, however, much misunderstood, and, as above indicated, is by no means easy to apply correctly in dealing with many particular cases. It is necessary to consider the step in invention which the patentee has taken, and also the alleged infringement, and to ascertain if, in substance, it is the same. A mechanical equivalent is a mechanical variation, and if the step taken by the patentee is a small one, as in *Curtis* v. *Platt*, then identity means taking the same or only colourably different mechanical variations. An arrangement may be said to be an equivalent of a part in a particular combination as performing the same function, when the general objects of the patent are referred to; but this is not the proper point of view when the ultimate result attained by the patented combination is an old one. In such case the particular mechanical means used by the patentee for arriving at the old result are to be considered of prime importance, and an arrangement substituted by an alleged infringer for one of the parts of the patented combination is in no sense an equivalent, when it performs a different function (*e.g.*, evidenced by the fact that it necessitates the performance of two operations in lieu of one), notwithstanding that the same result is ultimately attained. (*r*) If the invention is detail, difference in detail can be successfully pleaded by the alleged infringer. If on the other hand the step taken by the patentee is a long one, and he is in fact the

(*q*) pp. 354-356 *ante*; see also Proctor *v.* Bennis, (1888) L. R. 36 Ch. D. 764; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, Ld., (1896) 13 R. P. C. 331; Lambert Co. *v.* International Phonograph Indestructible Record Co., Ld., (1904) 21 R. P. C. 255; Brown *v.* Hastie, (1904) 21 R. P. C. 445; 22 R. P. C. 85; 23 R. P. C.; Wallace *v.* Alexander Jack & Sons, Ld., (1905) 22 R. P. C. 590; Van Berkel *v.* Simpson, (1906) 23 R. P. C. 237.

(*r*) See Brooks *v.* Lamplugh, (1898) 16 R. P. C. 41, 48, 49.

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first person to show how some principle which underlies the actual form described by him may be utilised, as in *Proctor* v. *Bennis*, then all the details in an infringement may be different, and, provided there is substantial identity, which is evidenced by the adoption of the underlying principle, mere difference in detail cannot be pleaded as an excuse. In dealing with the facts of particular cases, great difficulty often arises in reference to what, having regard to the state of public knowledge at the date of the patent, is the true ambit of the claim, *i.e.*, whether it is to be construed according to the rule in *Curtis* v. *Platt*, (*s*) or according to the rule in *Proctor* v. *Bennis*. (*t*) This difficulty may be illustrated by a consideration of the following cases, which were finally disposed of by the House of Lords, viz., *Boyd* v. *Horrocks*, (*u*) *Thomson* v. *Moore*, (*x*) *Pneumatic Tyre Co.* v. *Tubeless Tyre and Capon Heaton, Ld.*, (*y*) and *Brooks* v. *Lamplugh*. (*z*)

Illustrations of the difficulty in correctly applying the doctrine of infringement by substitution.

*Boyd* v. *Horrocks*.

In *Boyd* v. *Horrocks* (*a*) the patentee *Boyd* claimed as his invention not only an entire machine, but also a number of subordinate inventions. The invention comprised various improvements applicable to winding and doubling machinery of the same class or type as that described in various prior specifications. Two of the subordinate claims were alleged to have been infringed by a variation of some of the details referred to by the patentee, and the Court of first instance held that such was the fact. The Court of Appeal, however, overruled this finding, on the ground that the claims in question ought to be construed very narrowly so as to limit them to the specific details mentioned, otherwise, if a sufficiently wide construction were put upon them to cover what the alleged infringer had done, they would also embrace a combination which was old and render the patent void for want of novelty. The House of Lords, on the other hand, on a careful consideration of the language of the specification, came to a different conclusion. Their Lordships held that what was claimed was a definite arrangement of parts producing a definite result as a consequence of the arrangement,

(*s*) pp. 355-356 *ante*.
(*t*) *Ibid.*
(*u*) (1888-91) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.
(*x*) (1889-90) 6 R. P. C. 426; 7 R. P. C. 325.
(*y*) (1897-98) 15 R. P. C. 74, 236; 16 R. P. C. 77; see also Gormully and Jeffery Manufacturing Co. *v.* North British Rubber Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 254; Aktiebolaget Separator *v.* Dairy Outfit Co., (1897) 14 R. P. C. 473; 15 R. P. C. 327, 334, 335, 338.
(*z*) (1898) 16 R. P. C. 41.
(*a*) (1888-91) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; see also British United Shoe Machinery Co. *v.* Thompson, (1904) 22 R. P. C. 177.

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and was not restricted to the details of the parts employed; and, further, that as the particular arrangement in question was present in the machine used by the infringer, though the details were different, but was absent from the alleged prior anticipating machine, the claims were valid and had been infringed.

Thomson v. Moore.

In *Thomson* v. *Moore* (*b*) the facts relative to the question of infringement were as follows: The plaintiff, now Lord *Kelvin*, was the patentee of improvements in the mariner's compass. The following were the chief features of the invention: an extremely light card, consisting of a narrow rim of thin paper supported by a thin rim of aluminium on which were marked the cardinal points; the aluminium rim was attached to the central boss, which was also of aluminium, by fine silken filaments in tension; the needles, which were short and light, were arranged in a horizontal plane a little beneath the card and attached to the rim by light silken threads. By this combination three important objects were obtained, viz., (1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment, and consequent amenability to *Airey's* correctors; (3) long vibration period, the magnetic moment being small and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather.

The defendant constructed and sold a card resembling the plaintiff's in the three features of (1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness in virtue of the greater part of the weight being thrown to the periphery. The construction of the defendant's card differed from the plaintiff's in that (a) the circumference consisted of an L-shaped aluminium ring instead of a thin rim; (b) the rim was connected to the boss by flat parallel strips of aluminium instead of silken threads in tension; (c) the short and light needles were arranged in vertical pairs some distance below the card, and were attached to it by aluminium wires instead of silk threads. The same combination of results attended the defendant's combination as were the consequence of the plaintiff's combination—viz., diminution of frictional error, steadiness and amenability to correctors. The defendant contended that his arrangement of the needles was specially adapted to his own patented correctors.

(*b*) (1889) 6 R. P. C. 426; 7 R. P. C. 325.

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The case first came before the Irish Master of the Rolls and the result of his Lordship's view of the effect of the evidence as to the state of public knowledge at the date of the patent was, that the patent being for a new means of attaining a well-known object—viz., to produce a compass-card, which would be steady and true under all circumstances—it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply, and further that the defendant's card not being the same in substance as the plaintiff's there was no infringement. The plaintiff thereupon appealed, and the Court of Appeal in Ireland took a different view of the evidence and held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and shortness of needles as to obtain a combination of results not previously obtained, viz., diminution of frictional error, steadiness, and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied. Further, the question was whether there was a pith and substance underlying the invention; and, if so, had the defendant taken that pith and substance? The Court held that he had done so, since his card attained the same results by substantially the same means, agreeing in essentials with the plaintiff's and differing only in non-essentials, and, consequently, he had infringed. The case ultimately went to the House of Lords, and their Lordships affirmed the decision of the Court of Appeal, and held that the plaintiff had attained a new result—a new instrument—and that the differences between his card and the defendant's were mere colourable differences introduced for the purposes of avoiding the appearance of imitation, and an infringement had been accordingly committed.

Chemical patents and infringement by substitution of equivalents.

As regards the infringement of chemical patents, the rules which have been discussed chiefly with reference to patents for mechanical contrivances have equal force when the subject-matter of the patent is a chemical process or a chemical compound, both as regards the true way in which to fix the ambit of the claims and to determine the question of infringement by the substitution of equivalents for the parts or ingredients referred to in the specification; (e) but it is well to draw

(e) Heath v. Unwin, (1855) 5 H. L. C. 505; as compared with Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System, (1896) 13

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attention to the fact that ingredients are not to be considered substantially different merely because they have different chemical names. (*d*) In many cases having reference to chemical patents the rule that there is no infringement in the substitution of an equivalent, which judged by the light of public knowledge at the date of the patent is not known and demonstrably an equivalent of the process or ingredient for which it is substituted, (*e*) is of the utmost importance in arriving at a true conclusion.

Thus, in *Nobel's Explosives Co.* v. *Anderson*, (*f*) the Court of first instance, the Court of Appeal, and the House of Lords all decided that the claims of the specification were limited to the use of the "soluble" form of nitro-cellulose for the purpose of preparing the explosive compound referred to and that the "insoluble" form was not known to be an equivalent at the date of the patent. The Lord Chancellor (*g*) pointed out that the contention that, though the patentee claimed only the combination of the "soluble" nitro-cellulose with nitro-glycerine, yet an infringement had been committed because all that had been done was that the "insoluble" form had been substituted for the "soluble," and that one chemical equivalent had been substituted for another, had not been made out, and that there was no evidence to show that the two were known to be equivalents at the date of the patent. The evidence was the other way; and the patentee, who obviously had a competent knowledge of the subject, was careful to always stipulate for the use of the "soluble" form. (*h*)

It is no infringement to use proportions of ingredients outside the limits claimed.

When proportions of the substances used are of the essence of the invention, (*i*) there is no infringement by the use of proportions outside the limits included by the claim. (*k*)

Various methods of infringing a patent.

The form (*l*) now used, of all letters patent for inventions, grants to the patentee full power, sole privilege, and authority by himself, his agents, or licensees, to make, use, exercise, and vend the invention, and then forbids the rest of the public

R. P. C. 301, 332, 559, 578; see also Fabriques de Produits Chimiques de Thaun *v.* Caspers, (1897) 15 R. P. C. 94.

(*d*) See Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 17 R. P. C. 146.

(*e*) p. 353 *ante*.

(*f*) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(*g*) 12 R. P. C. 167.

(*h*) Other cases in which the infringement of chemical patents by the use of equivalents was considered are: Muntz *v.* Foster, (1844) 2 W. P. C. 95; Stevens *v.* Keating, (1847) 2 W. P. C. 181; Hancock *v.* Moulton, (1852) John's Pat. Man. 6th ed. 254.

(*i*) pp. 338, 340, 341, 343 *ante*.

(*k*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671; 15 R. P. C. 421.

(*l*) 46 & 47 Vict. c. 5, 1st Schedule, Form D.

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during the continuance of the patent, either directly or indirectly, *to* make use of or put in practice the invention, or any part of the same, or in any wise to imitate the same, or make, or cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent or agreement of the patentee in writing under his hand and seal. Consequently, there are several ways in which a patent privilege may be infringed, *i.e.*, by manufacturing or making articles for use or sale by means of the art which is the subject of the patent; or by using, exercising, or putting the art in practice to the prejudice of the patentee in any other way; by making for use or sale, or vending articles made in pursuance of the invention; or by counterfeiting, or imitating the invention in any other way.

Ordering the construction of a patented article.

It is an infringement to order an article to be made according to a patented process, for he who causes an article to be made may be said to make it himself. (*m*)

Use of patented invention at the instigation of the patentee.

But it is not an actionable infringement to make, use, or sell a patented invention by or at the instigation of a patentee or his duly authorised agent; (*n*) neither is a person who gives another a licence to work under a patent which infringes the patent of a third person himself an infringer of that patent. (*o*)

What the public is by the patent prohibited from doing is to exercise the art which is the subject of the grant. In the case of making an article without proof of sale, the fact that the defendant has not sold the article manufactured according to the patent, and therefore not derived pecuniary profit, does not prove that he has not exercised the art, though it does show that the plaintiff has not suffered any substantial loss, and it is, therefore, an argument in mitigation of damages.

Manufacture and sale of the separate parts of a patented combination.

When the patent is for a combination of various parts, each of which is in itself old, the manufacture and sale in this country of those parts is no infringement, nor is the exportation of them with the intention of putting them together abroad, for the single parts do not make the patented combination, and the making of them is in itself lawful. (*p*) Nor is it any infringement to manufacture or sell an article which

(*m*) Gibson *v.* Brand, (1842) 1 W. P. C. 631.

(*n*) Kelly *v.* Batchelor, (1893) 10 R. P. C. 289.

(*o*) Montgomerie *v.* Paterson, (1894) 11 R. P. C. 221, 633.

(*p*) See Goucher *v.* Clayton, (1865) 11 Jur. N. S. 462; M'Cormick *v.* Gray, (1861) 7 H. & N. 25; Dunlop Pneumatic Tyre Co. *v.* David Moseley & Sons, (1904) 21 R. P. C. 53, 274.

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may be used for the purpose of infringing a patent, whether in ignorance of the patent, (*q*) or even though the person manufacturing and selling it actually knows that it will be used for purposes of infringement, or intends that it shall be so used. (*r*) If, however, upon the facts of a particular case, the person knowing that it will be used for the purpose of infringement sells an article and also constitutes the person who actually uses it in infringement his agent for that purpose, then the vendor is liable as an infringer, for he, indirectly at any rate, puts the invention in practice contrary to the prohibition in the grant. (*s*)

If the circumstances were such that the vendor of a part could be truly said to be a person inciting and procuring another to commit an infringement, an action on the case would probably lie, and an injunction could be obtained against the continuance of such conduct. This point has not yet been discussed in relation to a patent case. There is authority for supposing that an action on the case would lie, and a patentee could obtain the relief above indicated for the reason that the vendor was a person who knowingly and for his own ends procured the violation of the patentee's rights which violation was an actionable wrong. (*t*)

In *Innes* v. *Short* (*u*) the Court restrained the sale of zinc dust in conjunction with an invitation to use it in infringement of a patent for a method of preventing corrosion and incrustation in steam boilers. The alleged invitation consisted merely in printed instructions for use supplied with each patent of the zinc dust. It is submitted that the injunction was wrongly granted, because no complaint could be made in the case of a purchaser who was a licensee of the patentee, or a person having no intention to use the zinc dust for boilers without obtaining the licence of the patentee. The sale of the zinc dust by the defendant was *per se* lawful, and the doctrine *omnia præsumuntur rite et solemniter esse acta* should have been applied in his favour.

(*q*) Savage v. Brindle, (1896) 13 R. P. C. 267.

(*r*) Townsend v. Haworth, (1875) 48 L. J. Ch. N. S. 770; 12 Ch. D. 831 *n.*; Sykes v. Hawarth, (1878) L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; Dunlop Pneumatic Tyre Co. v. David Moseley & Sons, (1903) 21 R. P. C. 53, 274; Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co., (1897) 15 R. P. C. 83, 84.

(*s*) See Sykes v. Howarth, (1879) L. R. 12 Ch. D. 826, 831 *n.*, 832; 48 L. J. Ch. N. S. 773.

(*t*) See Lumley v. Gye, (1853) 2 E. & B. 216; see also Allen v. Flood, [1898] A. C. 495, judgment of Lord Watson, 96, 106, 107; Quinn v. Leatham, [1901] A. C. 495.

(*u*) (1898) 15 R. P. C. 449.

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In *Incandescent Gas Light Co.* v. *New Incandescent Gas Mantle Co.* (*x*) a defendant who sold an unpatented article, which could not be used in conjunction with another and patented article without the licence of the patentee, was restrained from infringing the patent. It appeared the defendant *Tossel* sold the article in question in the lower story of a building whilst his confederate and co-defendant sold the infringing article in an upper story of the same building, and, further, that *Tossel* had in his window for exhibition purposes some specimens of the infringing article. (*y*)

Defendants have been committed for breach of injunctions restraining the sale of complete machines where the breaches alleged consisted in the sale of *all* the component parts in such a way that they could easily be put together by any one. (*z*) Probably a defendant would be restrained if he were party to an infringement in such sense that he would be a principle in the first or second degree if infringement were an indictable offence. (*a*)

Restoration of a patented instrument.

It has been held to be an infringement of a combination patent to restore instruments by renewing parts which were essential to the combination. (*b*)

Infringement by manufacture without actual sale.

The mere making of articles for the purpose of sale or use, and not by way of *bonâ fide* experiment, (*c*) is an infringement, although no actual sale or use has taken place; (*d*) but there is no infringement unless a saleable article is produced; (*e*) though the thing constructed may infringe without being separately prepared and saleable, as in the case of fitting a ship for the reception and laying of a telegraph cable. (*f*)

Use by way of *bonâ fide* experiment is no infringement.

It is no actionable invasion of a patentee's rights for another person to use the invention, and thereby produce the finished product by way of *bonâ fide* experiment or amusement, without the intention of selling or making use of the

(*x*) (1897) 15 R. P. C. 83.

(*y*) See 15 R. P. C. 83.

(*z*) United Telephone Co. *v.* Dale, (1883) L. R. 25 Ch. D. 778; E. M. Bowden's Patents Syndicate *v.* Wilson, (1903) 20 R. P. C. 644.

(*a*) See Dunlop Pneumatic Tyre Co. *v.* David Moseley & Sons, (1904) 21 R. P. C. 280.

(*b*) United Telephone Co. *v.* Neilson, W. N. (1887) 133; see also Dunlop Pneumatic Tyre Co. *v.* Neal, (1899) 16 R. P. C. 247; Dunlop Pneumatic Tyre Co. *v.* Wilson, (1900) 17 R. P. C. 332; Dunlop Pneumatic Tyre Co. *v.* Excelsior Tyre, &c., Co., (1901) 18 R. P. C. 209; Dunlop Pneumatic Tyre Co. *v.* Holborn Tyre Co., (1901) 18 R. P. C. 222.

(*c*) See *infra*.

(*d*) Muntz *v.* Foster, (1844) 2 W. P. C. 101; Jones *v.* Pearce, (1832) 1 W. P. C. 125.

(*e*) Higgs *v.* Goodwin, (1858) E. B. & E. 529; 27 L. J. Q. B. 421.

(*f*) Newall *v.* Elliot, (1863) 10 Jur. N. S. 954.

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thing so made for the purpose for which the patent was granted, but with the view merely of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made. (*g*) In the words of *Jessel*, M.R., (*h*) "patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But, if there be neither using or vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition, and, if it were, it is certainly not the subject for an injunction."

Use for advantage is an infringement.

Use of a pirated article for the purpose of making experiments for the instruction of pupils is use for advantage, and an infringement of the patent under which the article was manufactured. (*i*) Thus, where an English electrician purchased and imported from a foreign manufacturer apparatus made according to an English patent, and maintained that he had only purchased the apparatus for examination and experiment by himself and his pupils, as certain royalty-paid instruments in his possession were too expensive to be taken to pieces, and further insisted that he had never sold, and had never otherwise used the apparatus, the Court held that such use was an infringement, and granted an injunction restraining the continuance of it. (*k*)

Also where it appeared that certain persons purchased infringing machines upon the understanding that they were not to be paid for unless they proved successful, and the machines in question were used by the defendants in their works for several months, the Vice-Chancellor of the Court of the County Palatine of Lancaster held that such use was not experimental; but the Court of Appeal dissolved the injunction on the ground, however, that supposing the infringement was proved, as the defendants were merely users and not manufacturers and the only infringement was put an end to some considerable time ago and there was no evidence of any intention on their part to continue in the wrongful act, an injunction ought not to have been granted. (*l*)

(*g*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48; Jones *v.* Pearce, (1832) 1 W. P. C. 121, 125; Muntz *v.* Foster, (1844) 2 W. P. C. 101; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; Proctor *v.* Bayley, (1889) 6 R. P. C. 107.

(*h*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48.

(*i*) United Telephone Co. *v.* Sharples, (1885) L. R. 29 Ch. D. 164.

(*k*) *Ibid.*

(*l*) Proctor *v.* Bayley, (1889) 6 R. P. C. 106, 538.

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The *ratio decidendi* of cases which decide that a person may be an infringer, though he has derived no pecuniary profit from his infringement, is that such profit is not a condition precedent to liability, but the condition precedent is actual or probable damage to the patentee arising from the acts complained of.

Pecuniary profit is not a condition precedent to liability.

It is an infringement to sell or use an article which was manufactured according to a patented process, (*m*) or by a patented machine, (*n*) or during the manufacture of which a patented article (though not as such constituting an ingredient of the final product) was used, (*o*) without the licence of the patentee; (*m*) whether the article was made in this country or was imported from abroad, (*p*) or whether the sale was to an English or a foreign customer for shipment abroad, (*q*) or whether the articles were shipped from this country to a foreign country to be sold there, (*r*) makes no difference; and a person who accepts an order for an infringing article and forwards it to another for execution, but receives a commission on the transaction is himself liable as an infringer; (*s*) but, if the article was in the first instance manufactured or sold by an unrestricted licensee of the patentee, it is no infringement for the purchaser to resell it, either within or outside the area comprised by the licence. (*t*) If the article is manufactured abroad and sold and delivered by the manufacturer abroad to the person or his agent who imports it, *e.g.*, by the post into this country, such foreign manufacturer aiding and abetting the importation into this country does not thereby make himself amenable to the jurisdiction of the Court, nor is he an infringer, (*u*) since no material part of the sale was done within the realm. (*v*) In

Unlicensed sale of patented article within the area of the patent is an infringement, notwithstanding the *locus* of the manufacture.

(*m*) Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302.

(*n*) Townsend *v.* Howarth (1875) L. R. 12 Ch. D. 831 *n.*

(*o*) Saccharin Corporation *v.* Anglo-Continental Chemical Works, (1900) 17 R. P. C. 307; but see Saccharin Corporation *v.* Reitmeyer, (1900) 17 R. P. C. 611.

(*p*) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Elmslie *v.* Boursier, (1869) L. R. 9 Eq. 217; Von Heyden *v.* Neustadt, (1880) L. R. 14 Ch. D. 230; Société Anonyme des Manufactures de Glaces *v.* Tilghman's Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Cartsburn Sugar Refining Co. *v.* Sharp, (1884) 1 R. P. C. 181; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 31; 29 Ch. D. 164; Saccharin Corporation *v.* Anglo-Continental Chemical Works, (1900) 17 R. P. C. 307.

(*q*) United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; L. R. 29 Ch. D. 164, 167; Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*r*) British Motor Syndicate *v.* John Taylor & Sons, (1899) 17 R. P. C. 723, 728.

(*s*) Incandescent Gas Light Co. *v.* Brogden, (1899) 16 R. P. C. 179.

(*t*) Smith *v.* Buchanan, 26 S. J. 347; p. 377 *post*.

(*u*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919.

(*v*) *Ibid.*; British Motor Syndicate,

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such a case the importer only is the infringer; but if the foreign manufacturer contracts for and, either personally or by means of an agent—*e.g.*, the post or other carrier—makes delivery in this country, he is himself the importer and an infringer. (*y*)

A contract of sale made in this country and followed up by acts such as would, by the law of this country, pass the property in the article to the purchaser is not a vending of the article within the meaning of the letters patent, if the delivery of the article pursuant to the contract does not take place in this country. (*z*) Thus a person who obtains orders on commission in this country for a foreign manufacturer who delivers to an English customer at a foreign port does not thereby import or sell the article in this country, or otherwise make, use, exercise, or vend the invention within the realm so as to make himself liable as an infringer. (*a*)

The *ratio decidendi* of the cases to the effect that the sale in this country of an article made abroad by a machine or process which is patented in this country is an infringement, is that the sale of the article is an indirect use of the invention within the prohibition of the patent. The selling of an article and converting it into money is about the most effectual mode that can be imagined of using the invention whereby it was produced. (*b*) The object of the patent is to give the inventor the profit of his invention; and the most effectual way of defeating that object would be to permit others to derive, from a sale of an article made in infringement of the patent, the profit which it was intended to secure to the patentee. (*c*)

Exposure for sale.

It has been held that the mere exposure for sale of an article made according to a patent, without actual proof of sale, is not an infringement; (*d*) though, on the other hand, it was held by a Court of first instance that where a defendant had manufactured articles, and his traveller had offered them

Ld. *v.* John Taylor & Sons, Ld., (1899) 17 R. P. C. 192. As to liability in the converse case of a transport of a patented article in this country for the purpose of a sale wholly effected abroad see p. 383 *post*.

(*y*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 929.

(*z*) See per Stirling, L.J., Badische Anilin und Soda Fabrik *v.* Hickson, (1905) 22 R. P. C. 580.

(*a*) Saccharin Corporation, Ld. *v.* Reitmeyer, (1900) 17 R. P. C. 606; Badische Anilin und Soda Fabrik *v.* Hickson, (1905) 22 R. P. C. 575.

(*b*) Per Keating, J., Walton *v.* Lavater, (1860) 8 C. B. N. S. 188.

(*c*) Erle, C.J., Walton *v.* Lavater, (1860) 8 C. B. N. S. 185.

(*d*) Minter *v.* Williams, (1835) 4 A. & E. 251.

for sale, though he had not actually sold any, there had been such a use as to amount to an infringement. (*e*) Infringement.

In a recent case in the Court of Appeal the Lords Justices differed as to the truth, in fact, of the above statement, but they were agreed that the principle involved in the latter portion of the paragraph is sound law, viz., that an exposure for sale without actual proof of sale is an actionable infringement. (*f*)

A mere loan of a patented article, without any intention of selling it or evading the patent, is no infringement. (*g*) Mere loan.

Any person who purchases an article made under a British or a foreign patent, whether in this country or abroad, which is sold without any restrictions on the buyer, acquires an absolute right to resell it or otherwise deal with it as he pleases, and he is at liberty to sell it in any country where there is a patent in the possession of, and owned by, the vendor. (*h*) Also a purchaser of a patented article, without notice of an exclusive licence for a limited area, is not affected by the licence, and cannot be restrained from using the machine within the area; (*i*) but a licence to manufacture an article under a foreign patent in a foreign country does not imply permission to sell or use the article in this country in violation of an English patent. (*k*) Unrestricted sale of a patented article by the patentee or his licensee.

An unrestricted licence to manufacture and sell a patent article is an authority to the vendees of the licensee to vend it without the consent of the patentee, and their doing so is no infringement, (*l*) whether they do so inside or outside the area comprised in the licence; for a purchaser from an unrestricted licensee, whether special or general, acquires the patented article for all purposes, and can exercise every right of ownership in respect of it. (*m*) Unrestricted licence to manufacture and sell.

It is competent to a patentee to sell, or to license the sale of, a patented article with a restriction that it shall be used only in a certain way. The maxim *cujus est dare ejus est disponere*, is applicable in such a case. If the purchaser has notice of any such restriction, a breach of Restrictions may be placed on purchaser of a patented article; and breach of restrictions is an infringement.

(*e*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

(*f*) British Motor Syndicate *v.* John Taylor & Sons, (1900) 17 R. P. C. 723.

(*g*) United Telephone Co. *v.* Henry, (1885) 2 R. P. C. 11.

(*h*) Per Cotton, L.J., Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 9; Betts *v.* Wilmott, (1870) L. R. 6 Ch. 239.

(*i*) Heap *v.* Hartley, (1888) 5 R. P. C. 603.

(*k*) Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 1.

(*l*) Thomas *v.* Hunt, (1864) 17 C. B. N. S. 183.

(*m*) Smith *v.* Buchanan, (1882) 26 S. J. 347.

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the restriction will constitute an actionable infringement. Thus, in *Incandescent Gas Light Co.* v. *Cantelo* (*n*) it appeared that the plaintiffs' course of business was to sell only through agents, whose dealings were restricted to their respective localities. The defendant employed a friend, who resided within the district of the plaintiffs' London agent, to purchase from that agent certain goods. After these were paid for by his friend, and, at the request of the latter, consigned direct to the defendant in the Isle of Wight, the defendant discovered, on unpacking them, that each box had a notice on it stating that the goods were sold upon condition that they were to be used only in a certain way. The defendant covered up the notices with his own labels, and resold the goods to his customers. His friend when buying never saw the boxes or notices. The Court held that, as there was insufficient notice, there was no infringement under the circumstances; but the learned Judge, *Wills*, J., stated that, if a purchaser on the sale is cognisant of restrictions put upon the use of the goods, he is bound by them on the principle that "the patentee has the sole right of using and selling the articles, and he may prevent anybody from dealing with them at all. Inasmuch as he has the right to prevent people from using them, or dealing in them at all, he has the right to do the lesser thing—that is to say, to impose his own conditions. It does not matter how unreasonable or how absurd the conditions are. It does not matter what they are if he says at the time when the purchaser proposes to buy, or the person to take a licence, 'Mind, I only give you this licence on this condition,' and the purchaser is free to take it or leave it as he likes. If he takes it, he must be bound by the conditions. It seems to be common sense, and not to depend upon any patent law, or any other particular law." In *Incandescent Gas Light Co.* v. *Brogden*, (*o*) *Kennedy*, J., pointed out that when the purchaser of a patented article has knowledge at the time of purchase that it was sold under a limited licence, it is immaterial whether he purchased from the patentee direct or from a third party, and upon the facts of the case the learned Judge granted an injunction restraining infringement by a purchaser from a licensee in breach of the conditions of a limited licence. The limitations imposed by the patentee upon a licensee probably follow

(*n*) (1895) 12 R. P. C. 262; see also Badische Anilin und Soda Fabrik *v.* Isler, (1906) 23 R. P. C. 173.
(*o*) (1899) 16 R. P. C. 179.

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the goods, and can be enforced against a purchaser from the licensee without notice. (*p*)

Restrictions imposed by licensee.

A restriction imposed by a patentee is quite a different thing to a restriction imposed by a licensee. All the licensee can do is to effect a contract between himself and a purchaser from him; and a subsequent purchaser is not bound by any such contract, even he takes with notice, since there is no privity between him and the original vendor the licensee who has no patent rights. (*q*)

Authority to construct does not necessarily imply permission to use a patented article.

Upon the above-discussed principle it does not follow that authority from the patentee to construct an article necessarily implies permission to use the article when constructed. (*r*) A person may be at one and the same time both a licensee and an infringer—*e.g.*, he may be a licensee in respect of articles actually paid for, but an infringer in respect of articles not paid for. (*s*)

Use for a purpose analogous to the purpose specified by the patentee.

When a patentee draws his specification and claims for his invention chiefly with reference to an application of it to a particular purpose, a person who uses the invention cannot escape the consequences of infringement if he uses it in an analogous manner though for a purpose different from that mentioned by the patentee; provided, of course, that the patentee has not distinctly limited his claim to the use of the invention for the first purpose. Thus, where the invention consisted in the adaptation of a machine (which was not subject-matter in itself) to the manufacture of cement for decorative purposes, an analogous adaptation of the machine to the manufacture of concrete blocks for street paving was held to be an infringement. (*t*) So, generally to adopt a combination of machinery, which originally was directed to one purpose, to make it minister to another and additional purpose is an infringement of the patent which first introduced that combination, provided that there is no invention involved in the adaptation. (*u*)

Claim may be limited to use for one particular purpose.

But where the patentee distinctly limits his claim it is not infringed by a user outside the limitation. Thus, where a patentee distinctly limited his claim to the use of his invention in a process for making manure by chemically treating

(*p*) See Badische Anilin und Soda Fabrik *v.* Isler, (1906) 23 R. P. C. 180, 181.

(*q*) McGruther *v.* Pitcher, [1904] 2 Ch. 307.

(*r*) Basset *v.* Gradon, (1897) 14 R. P. C. 701.

(*s*) Tweedale *v.* Howard and Bullough, (1896) 13 R. P. C. 529, 531.

(*t*) Adamant Stone Paving Co. *v.* The Corporation of Liverpool, (1896) 14 R. P. C. 11, 21.

(*u*) Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. Cas. 205, 239.

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sewage-water with hydrate of lime, the claim was not infringed by a person who used the process for purifying water only, and did not sell or use any of the precipitated manure. (*x*) And where the patentee made an invention which could be applied to open-ended pneumatic hammers, but, by his description and claims, he limited his patent to the use of the invention in open-ended hammers, the Court held that the adaptation of the invention to closed-ended hammers was no infringement. (*y*) Thus a claim for the use of a thing for one purpose is not infringed by the use of the thing for a totally different purpose, requiring different variations in the details of the use of the thing in question. (*z*)

Use for a purpose totally different to the purpose specified.

Possession may amount to an infringement.

The use of an article which will amount to an infringement of a patent for its production may be either active or passive; (*a*) and the mere possession of an article made in infringement of a patent, if there is an evident intention to use it, is infringement and sufficient to entitle the patentee to an injunction; (*b*) and the mere passive exhibition of an unlicensed patented article serving the purpose for which the patentee intends it, even though there is no intention of selling it, amounts to a user which the Court will restrain. (*c*)

Thus, an injunction was granted to restrain the master of a ship from using an invention for pumps, although he denied having used any pumps which were an infringement of the patent, and did not suggest that the owners ought to be parties. It was shown in evidence that the ship was fitted up exclusively with pumps which were an infringement of the patent, but had been so fitted up before the defendant, who was not a part owner, had command of her, and that he had nothing to do with putting them on board, and they had

(*x*) Higgs *v.* Goodwin, (1858) E. B. & E. 529; 27 L. J. Q. B. 421; see also Morewood *v.* Tupper, (1885) 3 C. L. R. 718; Lister *v.* Eastwood, (1864) 9 L. T. N. S. 766.

(*y*) Pilkington *v.* Massey, (1904), 21 R. P. C. 696.

(*z*) Preston *v.* Black, (1894) 11 R. P. C. 299, 574; Fletcher *v.* Glasgow Gas Commissioners, (1887) 4 R. P. C. 386; Edison *v.* Holland, (1888) 5 R. P. C. 482; Pilkington *v.* Massey, (1904) 21 R. P. C. 696.

(*a*) Caldwell *v.* Van Vlissengen, (1851) 9 Hare 415; Betts *v.* Neilson, (1868) 3 De G. J. & S. 82.

(*b*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 13; Proctor *v.* Bayley, (1889) 6 R. P. C. 106; United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; British Motor Syndicate *v.* John Taylor & Sons, (1900) 17 R. P. C. 732; Dunlop Pneumatic Tyre Co. *v.* British and Colonial Motor Car Co., (1901) 18 R. P. C. 315.

(*c*) Dunlop Pneumatic Tyre Co. *v.* British and Colonial Motor Car Co., (1901) 18 R. P. C. 315. As to a foreign corporation carrying on business at a stand in a British exhibition, see Dunlop Pneumatic Tyre Co. *v.* Actien Gesellschaft für Motor, &c., (1902) 19 R. P. C. 46.

never been worked in British waters. The majority of the Court of Appeal held that the defendant, being in command of a ship exclusively fitted with pumps which were an infringement of the patent, was intending to use the invention. (*d*) Infringement.

And where certain defendants, a telephone company, contracted with an American agent for the purchase of a number of telephones, and were supplied accordingly with instruments containing *Blake* transmitters, the subject of both English and American patents, which they kept unused in a warehouse, the Court held that they had infringed the English patent, notwithstanding that they had dismantled the telephones by taking out the *Blake* transmitters, and kept the different parts stored separately. (*e*)

It is no answer to the charge of infringement for the defendant to say that he committed the acts complained of because the plaintiff failed to carry out an agreement whereby the plaintiff undertook to supply him with articles made according to the patent. (*f*) Breach of contract is no justification for an infringement.

The use of a patented invention in a British ship outside British waters is no infringement of a British patent. This is so notwithstanding the doctrine that a vessel of a country is the territory of that country, because the grant of a British patent is by its terms limited to the United Kingdom of Great Britain and Ireland and the Isle of Man. (*g*) Use within British waters is, of course, use in Britain. Use in British vessel.

The use of an invention for the purpose of the navigation of a foreign vessel within the jurisdiction of any of his Majesty's Courts in the United Kingdom or the Isle of Man is by statute no infringement in respect of which the patentee can obtain an injunction. (*h*) Neither is the use of any other invention in a foreign vessel within the jurisdiction of the same Courts, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man. (*i*) Use of a patented invention in a foreign vessel within the jurisdiction of the British Courts.

The above provisions do not extend to vessels of any foreign State of which the laws authorise subjects of such foreign States, having patents or like privileges for the exclusive use

(*d*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 13.

(*e*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766.

(*f*) United Telephone Co. *v.* Tasker, (1888) 5 R. P. C. 628.

(*g*) See Newall *v.* Elliott, (1864) 10 Jur. N.S. 958.

(*h*) 46 & 47 Vict. c. 57, s. 43, sub-s. 1.

(*i*) *Ibid.*

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or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Court, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State. (*k*)

Transhipment of goods may be an infringement.

Transhipment in this country of goods made according to a British patented invention may be such a use as will amount to an infringement of the British patent. Thus, in *Betts* v. *Neilson*, (*l*) which was an action brought for the infringement of an *English* patent for the manufacture of a combined metal to be (amongst other purposes) applied as capsules to put on bottles, the House of Lords held that the defendant, who resided in *Scotland*, and purchased capsules, made according to the patent, from a foreign manufacturer, and *in Scotland* put them on beer bottles, which he sent to *England* for *transhipment and exportation*, was, by the user of the capsules whilst the beer remained in England, guilty of an infringement of the patent, and this notwithstanding that there was no evidence to show that the beer was sold in England for consumption there.

But in *Varasseur* v. *Krupp*, (*m*) where it appeared that certain shells made in Germany for the Mikado of Japan, according to an *English* patent, were brought to this country to be placed on board a ship belonging to the Mikado, it was held that the Court could not interfere to prevent him removing the shells. The ground of this decision was that the Court had no jurisdiction to interfere with the property of a foreign Sovereign; otherwise foreigners are subject to the laws of the country in which they happen to be, and if a foreigner in England infringes an English patent he may not only be restrained by the injunction of the Court, but his property may be ordered to be delivered up to the patentee if necessary to protect the patentee's rights under the patent. (*n*)

A person who is merely the Custom House agent of the actual importer is not responsible for infringements. Thus, in *Nobel's Explosives Co.* v. *Jones, Scott & Co.* (*o*) it appeared that the plaintiffs were the owners of an English patent for

(*k*) 46 & 47 Vict. c. 57, s. 43, sub-s. 2.
(*l*) (1871) L. R. 5 H. L. 1.
(*m*) (1870) L. R. 9 Ch. D. 351.
(*n*) Caldwell *v.* Van Vlissengen, (1851) 9 Hare, 415; 21 L. J. N. S. Ch. 97; L. R. 9 Ch. D. 351; see p. 391 *post*.
(*o*) (1882) L. R. 8 App. Cas. 5.

an invention for rendering nitro-glycerine less dangerous, and that certain foreigners imported into England an article compounded of nitro-glycerine and other substances, which they had manufactured abroad according to the patent, and the respondents, acting as Custom House agents for the importers, passed the article through the Custom House, and obtained permission (*p*) to land and store it in magazines belonging to the importers. The House of Lords held, affirming the decision of the Court of Appeal, that the respondents being only Custom House agents for the importers and not themselves the importers and having neither possession of nor control over the goods, their acts did not amount to an exercise or use of the patent, and that no action could be maintained against them for infringement.

Infringement.

Transport of patented articles in this country for the purpose of sending them abroad for sale abroad may, upon the facts of a particular case, be, if not a use of the patented invention, at any rate, such an indirect use of it within the meaning of the prohibition part of the grant as will constitute an infringement. (*q*)

Every patent is dated and sealed as of the day of the application, but no proceedings can be taken in respect of an infringement committed before the publication of the complete specification; (*r*) and after the acceptance of a complete specification until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, an applicant has 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, but he is not entitled to institute any proceedings for infringement unless and until a patent has been granted to him. (*s*) Consequently, until the patent is actually granted, no proceedings in respect of infringements can be taken at all, nor even then, in respect of any committed before the acceptance of the complete specification; (*t*) but, in an action brought subsequently to the grant of the patent, relief may be obtained in respect of infringements committed during the interval between the acceptance of the complete specification and the actual date of the grant as well as in respect of infringements committed since the grant.

Unauthorised use of an invention prior to the sealing of a patent.

(*p*) As required by the Explosives Act, 1875.

(*q*) British Motor Syndicate, Ld. *v.* John Taylor & Sons, Ld., (1900) 17 R. P. C. 189, 730; Badische Anilin und Soda Fabrik *v.* Johnson, [1898] A. C. 200; 14 R. P. C. 929, 930.

(*r*) 46 & 47 Vict. c. 57, s. 13.

(*s*) *Ibid.* s. 15.

(*t*) *Ibid.* s. 10.

**Infringement.**

If a patentee brings an action for infringement against any member of the public, it is open to the defendant to give evidence showing that the patent is invalid; (*u*) and, if the Court be of opinion that such is the case, a declaration of invalidity will be the result; also it is open to any member of the public, either of right or on obtaining the sanction of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, to obtain a declaration of invalidity on presentation of a petition to the Court. (*x*) The patentee has the right to appeal to the Court of Appeal and the House of Lords from the decision of the Court of first instance declaring the patent void either in an action for infringement or upon a petition for revocation, and the adverse decision may be reversed. It is submitted that any act done by a member of the public during the interval between a decision of the Court of first instance adverse to the patent and its reversal on appeal, which would be an infringement had the patent not been declared void, is, in fact, an infringement which entitles the patentee to damages or an account, because the decision of the Court of Appeal or House of Lords, as the case may be, gives validity to the patent *ab initio*; but it is further submitted that if the defendant could show that what he did was done in reliance on the former decision the plaintiff would only be entitled to nominal damages. (*y*)

Infringement committed in the interval between a decision adverse to the validity of the patent and its reversal on appeal.

Threatened infringements.

A patentee can sustain an action in respect of a threatened infringement of his patent, even though no actual infringement has taken place, for if a person threatens to do an act amounting to an infringement it is sufficient to found an action for an injunction. (*z*) The mere offer, however, to supply an article for the production of which there is an existent patent, which does not lay claim to the production of every kind of such article, in the absence of evidence of positive infringement, is not sufficient to support an application for an injunction. (*a*)

(*u*) p. 401 *post*.

(*x*) p. 293 *ante*.

(*y*) Arkwright *v.* Nightingale, (1785) 1 W. P. C. 60; Deeley *v.* Perkes, (1896) 13 R. P. C. 587.

(*z*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 65; Dowling *v.* Billington, (1890) 7 R. P. C. 191; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 357; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559; Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 333; Castner-Kellner Alkali Corporation, Ld. *v.* Commercial Development Corporation, Ld., (1899) 16 R. P. C. 262; p. 399 *post*.

(*a*) Gwynne *v.* Drysdale, (1885) 2 R. P. C. 160; 3 R. P. C. 65.

## Proceedings before Commencement of Action.

Proceedings before Action.

When a patentee becomes aware of the fact that several persons are infringing his patent he is in a somewhat awkward position, for he cannot join all the infringers as defendants in one action; (*b*) and, if he issues separate writs simultaneously against all the infringers, he will have to uphold the validity of his patent in several distinct proceedings, in each of which he may have to meet different objections, and further he may be guilty of the charge of oppressive litigation. On the other hand, if he singles out one infringer and establishes his patent against him first, as regards the others they are not bound by the decision in the first action, and may raise the question of validity anew; and the conduct of the plaintiff may be construed by the Court to amount to laches, and so disentitle him to interlocutory injunctions against the other infringers, to which, having previously established the validity of the patent, he would have been entitled had he commenced action against them earlier. (*c*) In such a state of circumstances the proper course for a patentee to pursue is that suggested by Lord *Hatherley*, then Vice-Chancellor *Page Wood*, (*d*) viz., after getting information of case after case of infringement to select that which he thinks the best, in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. At the same time, he should write to all the others who are *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you."

Proper course for a patentee to pursue on discovering several infringers.

There is the authority of the Court of Appeal for the proposition that where a patentee brings two separate actions on the same patent and fails at the hearing of the first action to prove infringement this is no ground on which the defendant in the second action can claim to have it stayed or dismissed as frivolous and vexatious pending an appeal in the first action

(*b*) pp. 389, 390 *post*.
(*c*) p. 428 *post*.
(*d*) Bovill *v.* Crate, (1865) L. R. 1 Eq. 391; see also North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 21.

Proceedings before Action.

or otherwise, unless he can show that he would have been bound by judgment in the earlier action. (*e*)

Usual course before commencing an action for infringement.

It is usual and proper for a patentee, before commencing proceedings in respect of an infringement of the patent, to apply to the alleged infringer, warning him not to continue the acts complained of, and asking him voluntarily to afford the relief which, in the event of the patentee bringing an action and succeeding, he would claim from the Court, though he is by no means bound to do so, and is entitled to commence his action without making any such demand. (*f*) Neither is he bound to rely on the infringer's promise not to repeat the wrongful act, but he is entitled to the injunction of the Court in aid of his legal rights, (*g*) though, if his conduct is oppressive, he may lose the costs of the action. (*h*) The Court does not, as a rule, take notice of negotiations between the parties preliminary to the issue of the writ, unless they amount to an accord and satisfaction, or release and binding agreement in relation to the cause of action, or the proceedings are tainted with a lack of good faith. (*i*)

Patentee though successful in the action may be disentitled to an injunction or costs.

Consequently though a patentee has an undoubted right of action against a person who infringes, whether in ignorance of the patent or not, it does not follow, as a matter of course, that he will in all cases succeed in obtaining an injunction or costs of the action. (*k*)

Thus, where a defendant unknowingly sold a few articles in infringement of a patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a Bill for an injunction was dismissed, and he was left to his remedy in damages. (*l*)

In another case, where it appeared that the plaintiff had obtained possession of certain instruments admitted to be made in infringement of his patent, but that the defendant

(*e*) See Dunlop Pneumatic Tyre Co. *v.* Rimington, (1900) 17 R. P. C. 665.

(*f*) Upmann *v.* Elkan, (1871) L. R. 12 Eq. 146; Upmann *v.* Forester, (1883) L. R. 24 Ch. D. 231; Burgess *v.* Hills, (1859) 26 Beav. 244, 247; Burgess *v.* Lately, (1859) 26 Beav. 249.

(*g*) Losh *v.* Hague, (1837) 1 W. P. C. 200; Geary *v.* Norton, (1846) 1 De G. & S. 9; Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; Upmann *v.* Forester, (1883) L. R. 24 C. D. 231; Nicols *v.* Pitman, (1884) L. R. 26 Ch. D. 374; Wittmann *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Fradella *v.* Weller, (1831) 2 Russ. & My. 247; Proctor *v.* Bayley, (1889) 6 R. P. C. 106.

(*h*) Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; Hudson *v.* Bennett, (1866) 14 W. R. 911; Smith *v.* Roberts, (1888) 5 R. P. C. 611; p. 512 *post*.

(*i*) Edelston *v.* Edelston, (1863) 1 De G. J. & S. 203; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 305.

(*k*) pp. 486, 511 *post*.

(*l*) Betts *v.* Willmott, (1870) 16 W. R. 1 Eq. 395; see also Upmann *v.* Elkan, (1871) L. R. 12 Eq. 145; Thornton *v.* Baker, (1886) 3 Times Rep. 715.

had never intended to sell them, and relied on an undertaking for their return, the action was dismissed with costs, but an order was refused for the return of the instruments to the defendant. Parties.

And in a case tried in Scotland, where the facts were that the defendant admitted infringement before the action, but had discontinued and offered to pay damages in respect of such infringement, and the action was brought in respect of a different article which was not an infringement, the Court refused an interdict, and, notwithstanding the previous admitted infringement, condemned the plaintiff in the costs of the action. (*m*)

And when it appeared that there had been only one infringement, which had been discontinued, the Court of Appeal held that in the absence of any evidence of the defendant's intention to continue the unlawful act an injunction should be refused. (*n*)

## Parties.

All persons interested in a patent should be made parties to an action for infringement, either as co-plaintiffs or, if they refuse to join, as defendants, especially if an account is claimed instead of damages, in order that the infringing defendants may not be called upon to account twice, first to the plaintiff and then to the other defendants who claim an interest. (*o*) If the patent is the separate estate of a married woman she is capable of suing alone. (*p*) The owner of a distinct and severable part of a grant can sue alone. (*q*) And a co-owner can do so, if the defendant does not object: (*r*) a defendant who means to object should do so without delay. (*s*) All parties interested should be before the Court.

Assignees have the same rights to sue as the original patentee had, (*t*) whether they are assignees by direct Assignee.

(*m*) Fletcher *v.* Glasgow Gas Commissioners, (1887) 4 R. P. C. 386.

(*n*) Proctor *v.* Bayley, (1889) 6 R. P. C. 538.

(*o*) Westhead *v.* Keene, (1838) 1 Beav. 287, 295; Bergman *v.* MacMillan, (1881) L. R. 17 Ch. D. 423; Hindmarch on Patents, p. 308.

(*p*) See Savage *v.* Harris, (1896) 13 R. P. C. 375, as to the usual order as to costs when an action brought by a married woman is unsuccessful.

(*q*) Dunnicliffe *v.* Mallet, (1859) 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*r*) Davenport *v.* Richards, (1860) 3 L. T. N. S. 503.

(*s*) Sheehan *v.* G. E. Ry. Co., (1880) L. R. 16 Ch. D. 59.

(*t*) Boulton *v.* Bull, (1795) 2 H. Bl. 464; Electric Telegraph Co. *v.* Brett, (1851) 10 C. B. 838; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Vol. II. p. 122.

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assignment or act and operation of law—*e.g.*, trustee in bankruptcy or his assignee (*u*)—or whether they are co-owners. (*x*)

An assignee's title should be registered, but registration is not always a condition precedent to the right to sue. (*y*)

Trustee and *cestui que trust.*

A trustee may sue alone, as also a *cestui que trust.* (*z*)

Mortgagor.

The mortgagor of a patent is entitled to sue in respect of an infringement in his own name without joining the mortgagee as plaintiff, and the mortgagee does not possess such an interest in the patent as to make it necessary that he should be joined as a defendant. (*a*)

Agent.

The mere agent of a foreign patentee cannot, in his own name, maintain an action of infringement. (*b*)

Misjoinder of parties.

It is provided by the Supreme Court Rules of 1883 (*c*) that no cause or matter shall be defeated by reason of the misjoinder or nonjoinder of parties, and the Court may in every cause or matter deal with the matter in controversy so far as regards the rights and interest of the parties actually before it, and the Court or a Judge may, at any stage of the proceedings, either upon or without the application of either party, and on such terms as may appear to the Court or a Judge to be just, order that the names of any parties improperly joined, whether as plaintiffs or as defendants, be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the Court may be necessary in order to enable the Court to effectually and completely adjudicate upon and settle all the questions involved in the cause or matter, be added.

The above rule does not authorise the amendment of the pleadings by allowing a plaintiff who has no right to sue to amend by joining as co-plaintiff a person who has a right to sue; (*d*) but it does authorise a plaintiff entitled to sue to add a necessary party—*e.g.*, in the case of an equitable assignee of a patent his assignor—with his consent, as plaintiff, or, without his consent, as defendant. (*e*)

(*u*) Bloxam *v.* Elsee, (1827) 6 B. & C. 169.

(*x*) Anderson *v.* Patent Oxonite Co., (1886) 3 R. P. C. 279.

(*y*) See Vol. II. p. 128; also Stewart *v.* Casey, (1891) 8 R. P. C. 259.

(*z*) Vol. II. p. 128.

(*a*) Van Gelder Apsimon & Co., Ld. *v.* The Sowerby Bridge Flour Society, Ld., (1890) 7 R. P. C. 208.

(*b*) Adams *v.* North British Ry. Co., (1873) 29 L. T. N. S. 367.

(*c*) R. S. C. (1883) Ord. xvi. r. 11.

(*d*) Walcott *v.* Lyons, (1884) L. R. 29 Ch. D. 584; Van Gelder, Apsimon & Co. *v.* The Sowerby Bridge Flour Society, Ld., (1890) 7 R. P. C. 41, 45; but see 7 R. P. C. 208.

(*e*) See Van Gelder, Apsimon & Co. *v.* Sowerby Bridge Flour Society, Ld. (1890) 7 R. P. C. 208.

Parties.

In a case where it appeared that the plaintiff's rights had during the progress of the trial been transferred to a company, leave was given to add the company as plaintiffs, but the right was reserved to the defendant, if he thought fit, to have the trial postponed, although the fact of the transfer was known to him when he put in his statement of defence; (*f*) but where the defence was that the defendant had not infringed subsequent to the assignment of the patent to the plaintiff, leave, at the trial, was refused to add as co-plaintiffs the predecessors in title of the plaintiff; (*g*) as likewise was an order for leave to add as defendants the assignees of the defendants where it appeared that the assignment had been made pending the action. (*h*)

Any person who infringes or takes part in the infringement of a patent may be made a defendant to an action, and held responsible for his acts, whether he be a principal or an agent; and it is no justification for a servant to say that his master ordered him to commit the infringement; (*i*) nor can the master avoid liability for the acts of his workmen and servants by saying that he gave them directions not to violate the patent, for the principal is always responsible for the acts of his agent which are not done in excess of his authority. (*j*)

Any person who infringes or takes part in an infringement may be made a defendant.

Though one individual partner in a firm may have a right to manufacture and sell under a patent, the firm may have no such right, as, according to the circumstances, the firm may be contractors for and not mere agents of the patentee and so properly made defendants. (*k*)

Firm as distinct from a partner.

Any person who authorises an infringement may properly be made a defendant in conjunction with a person who actually carries out the infringement. (*l*) Thus the directors of a company may be made personally liable, both in damages and costs of the action, for infringements carried out under their

Directors of a company.

(*f*) Ruston *v.* Tobin, (1878) 49 L. J. Ch. 262.

(*g*) Nobel's Explosives Co. *v.* Jones, (1880) 42 L. T. N. S. 754.

(*h*) Brigga *v.* Lardeur, (1885) 2 R. P. C. 13.

(*i*) Betts *v.* De Vitre, (1865) 11 Jur. N. S. 11; Adair *v.* Young, (1879) L. R. 12 Ch. D. 19; Betts *v.* Neilson, (1868) 6 N. R. 221; Denley *v.* Blore, (1851) 38 Lond. Jour. 224; Day *v.* Davies, (1904) 22 R. P. C. 34.

(*j*) Sykes *v.* Howarth, (1878) L. R. 12 Ch. D. 826; Betts *v.* De Vitre, (1873) L. R. 3 Ch. App. Cas. 429; Gregory *v.* Piper, (1829) 9 B. & C. 591; Whatman *v.* Pearson, (1868) L. R. 3 C. P. 422; Sharrod *v.* London and North-Western Ry. Co., (1849) 4 Exch. 580, 587; Gordon *v.* Rolle, (1849) 4 Exch. 365; Lyons *v.* Martin, (1838) 8 A. & E. 512; 3 N. & P. 509.

(*k*) Howard *v.* Tweedale, (1895) 12 R. P. C. 519.

(*l*) Day *v.* Davies, (1904) 22 R. P. C. 34.

Parties.

direction by the workmen employed by the company. (*m*) Of course the company could be made a defendant also.

Foreigners.

Foreigners resident in Great Britain or the Isle of Man are responsible for any infringement of a British patent, just as they are for the infraction of any British law, and they may be made defendants to infringement actions. (*n*)

Manufacturers and persons who have purchased from them may be made defendants to the same action or sued separately.

The usual form in which injunctions are granted against infringers restrains the defendant, his servants, agents, or workmen from continuing the acts complained of. (*o*)

In cases where a plaintiff succeeds in obtaining a verdict against both a manufacturer and a person who uses an article made in infringement of his patent, he is entitled to relief against both, *e.g.*, to an account against the manufacturer and damages against the user. (*p*)

Manufacturers and persons who have purchased from them may be sued as defendants in the same action; (*q*) though if the manufacturer or user be sued alone, the other cannot claim to be joined as a defendant against the wish of the plaintiff. It is not the case of attacking a principal through his agent or the improper selection of a member of a class. (*r*)

Foreign manufacturer.

Further, if a foreign manufacturer is not also an importer, he is not liable to the jurisdiction of the Courts in this country, and is not an infringer. (*s*) Thus, a foreign manufacturer who delivers goods abroad—*e.g.*, by means of the post—to a person who imports them into this country—*e.g.*, by his agent, the post—is no infringer; but a foreign manufacturer who contracts for and makes delivery in this country—*e.g.*, by the post or other carrier—would be an infringer. (*t*)

Purchaser from unlicensed vendor.

A person who has purchased articles from an unlicensed manufacturer and finds himself mulcted in damages at the suit of the patentee, has, in the absence of express warranty,

(*m*) A.-G. *v.* Vestry of Bermondsey, (1883) L. R. 23 Ch. D. 60; Mathias *v.* Yates, (1882) 46 L. T. N. S. 497; Betts *v.* De Vitre, (1865) 11 Jur. N. S. 9; L. R. 3 Ch. App. Cas. 441; Spencer *v.* The Ancoats Rubber Co., (1889) 6 R. P. C. 46; Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 16 R. P. C. 344; Welsbach Incandescent Gas Light Co. *v.* New Incandescent (Sunlight Patent) Gas Lighting Co., (1900) 17 R. P. C. 247.

(*n*) Caldwell *v.* Van Vlissengen, (1851) 21 L. J. N. S. Ch. 97; 9 Hare, 415; Vavasseur *v.* Krupp, (1870) L. R. 9 Ch. D. 351; Toni Tyres, Ld. *v.* Palmer Tyre, Ld., (1905) 22 R. P. C. 369.

(*o*) Seton, p. 352.

(*p*) Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*q*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*r*) Moser *v.* Marsden, (1892) 9 R. P. C. 214.

(*s*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 405, 211; see p. 375 *ante*.

(*t*) *Ibid.*

Parties.

no redress against the vendor. Upon the sale of the goods the property in them passed from the vendor to the purchaser. (*u*) The mere act of sale implies no warranty against the use of the goods by the purchaser being an infringement of existing patent rights. The mere possession of goods in the absence of evidence of intention to use them is not an infringement. (*x*)

Consignees of goods shipped from abroad are proper defendants.

When goods are made in infringement of an English patent, and shipped from abroad, the consignees are proper defendants in an action, and where they were resident out of the jurisdiction of the Court leave was given to serve the writ out of the jurisdiction. (*y*)

When separate actions must be brought against separate infringers.

In other cases of separate infringements of the same patent by different persons separate actions must be brought against each individually; (*z*) though where one person has infringed several patents belonging to the plaintiff he may be sued in respect of all the infringements in one action. (*a*) A plaintiff who brings several actions against the same defendant in respect of infringements of several patents will probably be allowed only the costs to which he would have been entitled had he included all the infringements in one action. (*b*)

Person who has indemnified the defendant may be allowed to take part in the action.

An agreement of indemnity against actions for infringement is not necessarily void as being against public policy. (*c*) In an action for infringement against a person to whom an indemnity had been given by the manufacturers, and where such person gave notice under the third party procedure (*d*) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that, on the manufacturers admitting their liability to indemnify the defendants, they should be at liberty to appear at the trial and take such part therein as the Judge should direct, and that they should be bound by the decision of the Court in the action on any question as to the above indemnity as might arise between them and the defendants, but not further or otherwise. (*e*) The Court of Appeal held that no

(*u*) See Vavasseur *v.* Krupp, (1878) L. R. 9 Ch. D. 360.

(*x*) See *ibid.*; p. 380 *ante*.

(*y*) The Washburn and Moca Manufacturing Co. *v.* The Cunard Steamship Co., (1889) 6 R. P. C. 398; Massey *v.* Haynes, (1888) L. R. 21 Q. B. D. 330.

(*z*) Dilly *v.* Doig, (1794) 2 Ves. 486.

(*a*) Lister *v.* Wood, Seton, 3rd ed. p. 909.

(*b*) United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28.

(*c*) See Townsend *v.* Haworth, (1875) Higgins Digest Appendix, pp. 61, 62.

(*d*) R. S. C. (1883) Ord. xvi. r. 48.

(*e*) Edison *v.* Holland, (1886) 3 R. P. C. 397.

Pleadings. Writ.

injunction could be granted against such manufacturers brought in under the third party rules, as they were not made defendants, and leave to amend was refused, but they were ordered to pay the costs of the action. (*f*)

## Pleadings.

Usual pleadings.

The usual pleadings in an action for the infringement of a patent, after service of the writ with regard to which there is nothing special in patent actions, (*g*) are a statement of claim, particulars of breaches, a statement of defence, and particulars of objections. Further pleadings are not usual in actions of infringement of patent rights, but, if they are required, the practice as to them is regulated by R. S. C. Order xxiii.

Trial without pleadings.

Where the parties to a cause or matter are agreed as to the questions of fact to be decided between them they may, after writ issued and before judgment, by consent and order of the Court or a Judge, proceed to the trial of any such questions of fact without formal pleadings. (*h*)

If the parties to a patent action adopt this course, it is submitted, they will not be exempted from the necessity of delivering particulars of breaches and particulars of objections, but these will be required, as was the case where issues were directed under the old practice by the Court of Chancery. (*i*)

## Writ.

The same rules apply to the service of the writ in patent actions as in other actions. (*k*)

In the case of a foreigner resident abroad who does any act (*e.g.*, importing and selling in this country or obtaining orders in this country by means of a patented article, whether or not the orders are for this country or abroad) which is *primâ facie* an infringement of a British patent, the patentee may, under R. S. C. 1883, Order xi. r. 1 (f), obtain leave to serve notice of the writ out of the jurisdiction; (*l*) but Order xi. r. 1 (f)

(*f*) Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*g*) For forms of indorsement of the writ, see Appendix.

(*h*) R. S. C. (1883) Ord. xxxiv. r. 9.

(*i*) Order in Davenport *v.* Jephson, Seton, p. 346; Bovill *v.* Smith, (1867) W. N. 1867, p. 240; 46 & 47 Vict. c. 57, s. 29; pp. 395, 412 *post*.

(*k*) R. S. C.

(*l*) Badische Anilin und Soda Fabrik *v.* Johnson, [1896] 1 Ch. 25; Badische Anilin und Soda Fabrik *v.* Chemische Fabrik vormals Sandoz, (1903) 20 R.

does not enable the Court to direct service out of the jurisdiction of a writ claiming damages for infringement of a patent which has expired at the date of the writ, and this is so, although an injunction is also sought in respect of another and subsisting patent. (*m*) Similarly interdict may be obtained in Scotland by an English company against an English company, notwithstanding that there is no effectual service within the territory. (*n*) A patentee who desires leave to serve notice of a writ on a foreigner out of the jurisdiction should be careful as to the evidence on which he seeks the leave. (*o*)

Statement of Claim.

## Statement of Claim.

In the statement of claim the patentee should allege the grant of the patent, and if his title is a derivative one it should be clearly stated.

Allegation of grant and title.

It is not necessary to allege that the invention was new at the date of the patent, since the allegation of the grant and the production of the letters patent themselves throws on the defendant the *onus* of disputing the novelty. (*p*)

Not necessary to allege novelty,

It is common to state in the statement of claim that the letters patent are, and since the grant thereof always have been, valid and subsisting; but this is not necessary and the allegation is not contained in the form given in the Appendix to the Supreme Court Rules, 1883. (*q*)

or validity.

It is not necessary to set out in the statement of claim either the whole or any portion of the specifications, (*r*) though this was usually done in bills in Chancery under the old practice.

or to set out the specifications.

If any disclaimer has been entered at the Patent Office, this fact, with the date, should be alleged in the statement of claim.

Disclaimers should be alleged.

The statement of claim must state a sufficient case to justify the injunction asked; (*s*) and must not set out a

Sufficient case to justify the relief asked for must be stated.

P. C. 413; 21 R. P. C. 533; Badische Anilin und Soda Fabrik *v.* W. G. Thompson & Co., Ld., (1902) 20 R. P. C. 422; Badische Anilin und Soda Fabrik *v.* Chemische Fabrik vormals Sandoz in Basel, (1904) 21 R. P. C. 345.

(*m*) Badische Anilin und Soda Fabrik *v.* Chemische Fabrik vormals Sandoz in Basel, (1904), 21 R. P. C. 345.

(*n*) Toni Tyres, Ld. *v.* Palmer Tyre, Ld., (1904) 22 R. P. C. 369.

(*o*) See Chemische Fabrik vormals Sandoz *v.* Badische Anilin und Soda Fabrik, (1904) 21 R. P. C. 533.

(*p*) Amory *v.* Brown, (1869) L. R. 8 Eq. 664.

(*q*) R. S. C. 1883, Appendix C. Form 6.

(*r*) Kay *v.* Marshall, (1836) 2 W. P. C. 39; Westhead *v.* Keene, 1 Beav. 287.

(*s*) Curtis *v.* Cutts, (1839) 8 L. J. N. S. Ch. 184.

**Statement of Claim.**

separate and different cause of action to that endorsed on the writ. (*t*)

Several patents sued on in one action.

More than one patent may be put in suit in the same action; but if the circumstances are such as to render the joining of a plurality of causes of action oppressive as against the defendant, he may, by application before defence, confine the plaintiff to a reasonable number. (*u*) Thus, where the plaintiffs sued on twenty-three patents, alleging that the said patents covered all known ways of producing a certain chemical body, and, though they could not say which particular patent or patents had been infringed, the defendants must have infringed one or more, the Court ordered that the action should in the first instance be limited to such of the patents not exceeding three in number, as the plaintiffs might select, and ordered the plaintiffs to amend their pleadings accordingly. (*x*) It may be doubted whether under such circumstances the Court ought to arbitrarily fix the number of causes of action on which the plaintiffs may proceed. In another case, where the Judge had limited the plaintiff to four patents, the Court of Appeal held that under the circumstances of the particular case the order should be varied by allowing the plaintiffs to sue on seven patents, but on special terms as to costs. (*y*) The order of the Court was as follows: "This Court doth order that the Order, so far as it directed that the plaintiffs should be limited in the first instance at the trial of this action to such number of the letters patent sued on herein, not exceeding four, as they might select, be varied; and it is ordered that the plaintiffs be at liberty to amend their statement of claim and particulars of breaches by discontinuing this action except as to seven patents, and by alleging as one cause of action infringement of one or other patent out of a group of three patents, and, as an additional cause of action, infringements of one or other patent out of another group of four patents. And it is ordered that, if the plaintiffs shall not, as to any of the patents so sued upon, open or proceed upon their case sufficiently to enable the Judge at the trial to decide whether any particulars of objections, which may be delivered by the defendants, are reasonable and proper, the plaintiffs shall be taken to admit that such particulars of objections are reasonable and proper,

(*t*) United Telephone Co. *v.* Tasker (No. 2), (1889) 6 R. P. C. 38.

(*u*) Saccharin Corporation, Ld. *v.* Wild, (1902) 20 R. P. C. 243.

(*x*) *Ibid.*

(*y*) Saccharin Corporation. Ld. *v.* R. White & Sons, Ld., (1903) 20 R. P. C. 454; see also Saccharin Corporation, Ld. *v.* Alliance Chemical Co., Ld., (1905) 22 R. P. C. 175.

and a certificate to that effect shall be granted by the Judge. And it is ordered that the costs of this appeal and in the Court below be costs in the action." (z)

Particulars of Breaches.

It must be remembered that in the cases above referred to the defendants proposed to attack the validity of the patents sued on, and were consequently embarrassed by the great number put in suit; and, further, the Court did not purport to interfere with the plaintiff's right to put all the patents in suit later on, provided they sued upon them fairly. (a) The case, therefore, is no authority for saying that when the defendant does not dispute, or is precluded from disputing, validity it is improper for a plaintiff to sue upon a large number of patents. (b) In a recent case judgment by default was obtained without objection by the Court where the allegation was that all of seven patents sued upon had been infringed. (c)

## Particulars of Breaches.

Particulars of breaches are necessary.

The allegation of infringement in the statement of claim need only be in general terms, for it is specially enacted that the plaintiff must deliver with his statement of claim, or by order of the Court or a Judge at any subsequent time, particulars of the breaches complained of; (d) and at the hearing no evidence can, except by the leave of the Court or a Judge, be admitted in proof of any alleged infringement of which particulars have not been given. (e) Thus, when the particulars of breaches only alleged infringement by user and not by manufacture, the Court at the trial refused to consider the question whether there had been infringement by manufacturing the articles complained of. (f)

According to the practice in Scotland a separate statement of particulars of breaches is not required, but, none the less, particulars of breaches must be set forth on the record such as are required by sec. 29 of the Patents Act, 1883. (g) Apparently the principles governing the English Courts in

(z) 20 R. P. C. 458.

(a) See judgment of Collins, M.R.

(b) See Saccharin Corporation, Ld. v. Jackson, (1903) 20 R. P. C. 616.

(c) Saccharin Corporation, Ld. v. Hopkinson, (1904) 21 R. P. C. 272.

(d) 46 & 47 Vict. c. 57, s. 29, sub-s. 1. For forms of particulars of breaches, see Vol. II. p. 389.

(e) 46 & 47 Vict. c. 57, s. 29, sub-s. 4.

(f) Hensce v. Hardie, (1894) 11 R. P. C. 421.

(g) See Mica Insulator Co. v. Bruce Peebles & Co., Ld., (1905) 22 R. P. C. 527.

Particulars of Breaches.

matters relating to particulars under sec. 29 of the Patents Act, 1883, are applied *mutatis mutandis* by the Judges in Scotland to cases within their jurisdiction. (*h*)

Amendment of particulars of breaches.

The Court or a Judge has power from time to time to grant leave to amend particulars. (*i*) And further and better particulars may be ordered at the instigation of either party, even though the action has actually been put down for trial and notice of trial given. (*k*) Though the Court of Appeal is not a "Court or Judge" within the meaning of sec. 29 of the Act of 1883, yet, when there is an appeal, it has, if not an inherent power, at any rate a special power, under R. S. C. 1883, Order 58, r. 4, to allow an amendment of the particulars of breaches or objections so as to admit further evidence. This power is purely discretionary, and the Court of Appeal is loath to exercise it, and only does so in special cases. (*l*)

Any party desiring an amendment of the particulars of breaches or objections in an action for infringement must satisfy the Court that he is really placed in a difficulty by the particulars as they stand. (*m*)

Where, on a motion for further and better particulars, it appeared that the plaintiff had stated that he was unable to give further particulars till he had obtained discovery from the defendant, the motion was ordered to stand over till after the defendant had given discovery. (*n*)

Particulars must be reasonable and proper.

The plaintiff must take care that the particulars which he furnishes are reasonable and proper ones, otherwise he will fail to obtain the certificate of the Court or a Judge, which is necessary to entitle him to the costs of such particulars on taxation. (*o*)

Sufficient if, with the pleadings, they give the defendant notice of the case to be made against him.

Particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant fair notice of the case to be made against him. (*p*) The object of particulars is not to disclose evidence, but to tell the case to be made at the trial, (*q*) and the office of particulars of breaches is to tell the defendant what the plaintiff says he has done in infringement,

(*h*) See Mica Insulator Co. *v.* Bruce Peebles & Co., Ld., (1905) 22 R. P. C. 527.

(*i*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*k*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 256.

(*l*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530.

(*m*) Haslam *v.* Hall, (1887) 4 R. P. C. 203, 207, per Wills, J.

(*n*) Russell *v.* Hatfield, (1885) 2 R. P. C. 144.

(*o*) 46 & 47 Vict. c. 57, s. 29 (6).

(*p*) Needham *v.* Oxley, (1863) 1 H. & M. 248; Petman *v.* Bull, (1886) 3 R. P. C. 390; S. C. reported in Ledgard *v.* Bull, L. R. 11 App. Cas. 648; Cheetham *v.* Oldham (No. 3), (1888) 5 R. P. C. 624.

(*q*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 260.

and it is not the office of particulars to answer an interrogatory as to the construction of the patent. (*r*)

Particulars of Breaches.

Thus, where the pleadings stated that the defendant's machine included a certain new and important combination which was the plaintiff's invention, and the particulars of breaches simply pointed to certain specified machines, and stated in general terms that these infringed the patent, they were held to be sufficient, in spite of the contention that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement. (*s*) Again, where the particulars of breaches specified a particular article as an infringement, the Court, being of opinion that the defendant must know whether and in what respect he had infringed, refused to compel the plaintiff to specify the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. (*t*) And where the alleged infringement, which is not a complicated structure, is an exhibit in the case, it has been held not to be necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. (*u*)

Where, however, a specification describes two processes wholly distinct from each other, and the defendant's process is capable of being an infringement of the one, but not of the other, particulars of breaches in general terms would not be sufficient. (*x*) And if the specification contain a description of a number of articles, all of which are the subject of the invention, the particulars must point out which part of the specification has been infringed. (*y*)

Must state how the patent has been infringed.

Thus, where the specification contained a description of thirteen different sorts of pens, the plaintiff was ordered to point out specifically which particular pens shown in the drawing he alleged to have been infringed. (*z*)

It is to be noticed that when the alleged infringer is a user

A user may require fuller

(*r*) Wenham Co. *v.* Champion Gas Co., (1891) 8 R. P. C. 22; Cassella *v.* Levinstein, (1891) 8 R. P. C. 473.

(*s*) Needham *v.* Oxley, (1863) 1 H. & M. 248.

(*t*) Talbot *v.* La Roche, (1854) 15 C. B. 310; see also Moseley *v.* Victoria Rubber Co., (1886) 3 R. P. C. 351.

(*u*) Batley *v.* Kynock (No. 2), (1874) L. R. 19 Eq. 229; Needham *v.* Oxley, (1863) 1 H. & M. 248; Perry *v.* Mitchell, (1840) 1 W. P. C. 269.

(*x*) Talbot *v.* La Roche, (1854) 15 C. B. 310, 320; Patent Type Founding Co. *v.* Richards, (1860) 2 L. T. N. S. 359.

(*y*) Perry *v.* Mitchell, (1840) 1 W. P. C. 269; Patent Type Founding Co. *v.* Richards, (1860) 2 L. T. N. S. 359.

(*z*) Perry *v.* Mitchell, (1840) 1 W. P. C. 269.

Particulars of Breaches.

and not a manufacturer the particulars of breaches must be fuller than would be necessary if he were a manufacturer. When the alleged infringer is a manufacturer he knows what the process he uses is, but if the alleged infringer is a user or vendor only he may be dependent for his knowledge of the process used upon the statement of the actual manufacturer. The plaintiff might dispute the manufacturer's statement, and content that some other process mentioned in the specification had been used. Hence the necessity in such a case of giving the user or vendor full notice of which of the plaintiff's processes it will at the trial be contended have in fact been used. (*a*)

particulars than a manufacturer.

Must specify which claims have been infringed, if necessary, by reference to pages and lines of the specification.

The defendant is entitled to a statement in the particulars of breaches as to which one or more of several claims in the specification he is charged with having infringed; (*b*) but it is sufficient if the particulars refer to pages and lines of the specification without direct mention of the claiming clauses. (*c*)

Provided the particulars of breaches give the defendant a fair idea of the case to be made against him, they will be sufficient if they refer to specific claims, and specify certain machines of the defendant as infringements of those claims, and it is not necessary that they should state by reference to pages and lines what portion of the specification has been infringed; (*d*) neither can the plaintiff be compelled to put a construction on his claims or specification in the particulars of breaches; (*e*) though if the invention is a complicated one, or the defendant has any other sufficient grounds for requiring the information in the preparation of his defence, the plaintiff may be compelled to furnish particulars of pages and lines of the specification alleged to have been infringed. (*f*)

Specific instances and dates of some infringements must be given, but certain general words may be added.

The particulars of breaches must not merely refer in general terms to acts of the defendant, but must specify definite instances of infringements committed by him, and give at any rate the date of some of the various occasions

(*a*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 260.

(*b*) Haslam *v.* Hall, (1887) 4 R. P. C. 203.

(*c*) Elsey *v.* Butler, (1884) 1 R. P. C. 189.

(*d*) Walter C. Church Engineering Co. *v.* Wilson, (1886) 3 R. P. C. 123; Electric Telegraph Co. *v.* Nott, (1847) 4 C. B. 462; Talbot *v.* La Roche, (1854) 15 C. B. 310; Batley *v.* Kynock (No. 2), (1875) L. R. 19 Eq. 229; Cheetham *v.* Oldham (No. 3), (1888) 5 R. P. C. 624.

(*e*) Cassella *v.* Levinstein, (1891) 8 R. P. C. 473.

(*f*) Lamb *v.* Nottingham Manufacturing Co., cited L. R. 19 Eq. 230; Wren *v.* Weild, (1869) L. R. 4 Q. B. 213; Jones *v.* Lee, 25 L. J. Ex. 241.

when the infringements took place, and the names and addresses of the persons (if any) concerned as buyers, &c. (*g*)

Particulars of Breaches.

Thus, in an action for infringement, where the particulars of breaches alleged that the defendants had infringed by importing into this country, selling, exposing for sale, and otherwise dealing with glass globes, shades, and moons, having their surfaces wholly or in part roughened in a particular way, the Judge expressed an opinion that the plaintiffs ought to give two or three specific instances of globes which they alleged to be infringements, but ought to be at liberty to add general words so as not to be confined to such instances at the trial, and his Lordship accordingly made an order for further and better particulars. (*h*)

In *Walter C. Church Engineering Co.* v. *Wilson*, (*i*) the words "in particular and by way of illustration" were held to be too wide; but, on the other hand, in *Haslam* v. *Hall*, (*j*) where the particulars of breaches, "*by way of example and not of limitation*," alleged certain machines fitted by the defendants on board the "*Selembria*," and "*all machines made by the defendants similar to them*," to be infringements of the plaintiff's patent, the words in italics were allowed to remain, but the plaintiff was confined, so far as concerned machines fitted to ships, to the "*Selembria*," unless he gave further names.

Though a threatened infringement may be restrained, (*k*) an injunction will not be granted where the action is only framed in respect of, and fails as to *specific* infringements alleged to have been committed prior to the action, and the plaintiff seeks to give evidence of acts of a different nature committed after action as infringements, unless the pleadings are, by leave of the Court on terms, amended so as to include threatened infringements; in which case the subsequent real infringements may be evidence of intention prior to action brought to infringe, otherwise evidence of subsequent infringements will not be admitted at all. (*l*)

Particulars of actual infringements are necessary, and evidence is limited by them, unless the action is solely based on threats to infringe.

The patentee may bring two distinct kinds of action—the one based on the fact that the defendant has infringed before

(*g*) Sykes *v.* Howarth, (1878) L. R. 12 Ch. D. 826; cf. Flower *v.* Lloyd, (1876) 45 L. J. Ch. 476; 25 W. R. 17.

(*h*) Tilghman's Patent Sand Blast Co, Ld. *v.* Wright and Butler Co., Ld., (1884) 1 R. P. C. 103; see also Talbot *v.* La Roche, (1854) 15 C. B. 310.

(*i*) (1886) 3 R. P. C. 123.

(*j*) (1887) 4 R. P. C. 203.

(*k*) p. 384 *ante*.

(*l*) The Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 512; Welsbach Incandescent Gas Light Co. *v.* Dowle, (1899) 16 R. P. C. 391.

Particulars of Breaches.

action brought, and the other based on the fact that the defendant threatens and intends to infringe. These two grounds of action may be combined in one action, but they are quite distinct in themselves. In the first case the plaintiff is entitled to claim damages or an account, and an injunction to prevent similar infringements in the future. In the second case the plaintiff may claim an injunction to restrain the threatened infringement. In so far as the action is based on infringement before action brought the plaintiff is bound to give particulars of breaches, and by statute no evidence can, except by leave of the Court or a Judge, be given, at the hearing, of any breaches other than those stated in the particulars. Of course, in so far as the action is based on threats to infringe no particulars of breaches can be given, but care is always taken that the defendant shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating. (*m*) *Shoe Machinery Co.* v. *Cutlan* (*n*) was on the pleadings an action of the first class referred to above. The plaintiff was obliged to admit that the acts done before action brought were in fact not infringements, but he sought to contend that acts done after action brought were different in nature and infringements. The Judge refused on the pleadings (no amendment of which was asked for) to admit evidence of such latter acts. These latter acts were of such a nature that they would probably have been admissible as evidence of a threat or intention to infringe prior to action brought, if an amendment of the pleadings necessary to include threatened infringement had been asked for. Similarly in *Welsbach Incandescent Gas Light Co.* v. *Dowle*, (*o*) which was also an action of the first class, the Judge held that evidence of the alleged acts prior to the writ was not sufficient to prove the plaintiff's case, and the action being founded on an alleged infringement as distinct from a threatened infringement he refused to admit evidence of alleged acts subsequent to the writ. *Frearson* v. *Loe* (*p*) was a case of the second class, and an injunction was granted to restrain the threatened infringements, evidence of which was on the pleadings clearly admissible. *Dowling* v. *Billington*, (*q*) on the other hand, though in form an action of the first class, was treated by the Judge as one of the

(*m*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 357.
(*n*) (1895) 12 R. P. C. 342.
(*o*) (1899) 16 R. P. C. 391.
(*p*) (1878) L. R. 9 Ch. D. 48.
(*q*) (1890) 7 R. P. C. 191.

Defence.

second class, and under the peculiar circumstances of that case evidence of infringement committed after action brought was admitted. The peculiarity of the case was that the alleged infringements committed before action brought were technically not infringements at all, since the complete specification had not then been accepted. The articles made after action brought were admitted in evidence to be the same in kind as those made before, and since the action was brought in respect of that kind of article the Judge must be taken to have admitted the evidence of infringement after action, on the principle that the defendant had on the pleadings fair notice that the plaintiff would contend at the trial that the future manufacture of such articles would be an infringement and that he claimed an injunction to restrain such future manufacture.

## Defence.

Two main defences.

By way of defence (*r*) it is open to the defendant to defeat an action for infringement of a patent by proving either that he has not committed any infringement, supposing the patent to be a valid one, or that the patent is in fact non-existent or void, and that the acts complained of are consequently no violation of any right vested in the plaintiff. (*s*)

Breach of contract by the plaintiff is not a valid defence.

It is not a valid defence to say that the defendant committed the infringement because the plaintiff failed to carry out an agreement whereby he undertook to supply the defendant with a certain number of the patented machines; but, in such a case, the injunction of the Court restraining further infringements will only be granted on the terms that the plaintiff undertakes to supply the defendant with a certain limited number of machines in the place of those which the injunction would prevent him from using. (*t*) Moreover, the defendant is at liberty to counterclaim for damages consequent on the breach of the agreement. (*u*)

All grounds of defence should be stated.

The defendant should state in his defence the grounds on which he relies, if he disputes the validity of the patent or alleges that the acts complained of were authorised by the plaintiff, for he cannot at the trial bring forward any ground

(*r*) For forms of defence, see Vol. II. p. 390.

(*s*) See Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 37.

(*t*) United Telephone Co. *v.* Tasker, (1888) 5 R. R. C. 628.

(*u*) Heald *v.* Incandescent Gas Light Co., (1893) 10 R. P. C. 165.

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of defence which is not stated in his pleadings. (*x*) He must also be careful that his pleas are not embarrassing, otherwise they may be ordered to be struck out at the instigation of the plaintiff. (*y*)

An order has been made that a defendant should, upon an issue as to the sufficiency of the specification, be at liberty to dispute the utility of the alleged invention, although he had not raised the general issue as to utility. (*z*)

Particulars do not stand in the place of pleas.

Particulars of objections do not stand in the place of pleas, (*a*) and they cannot go outside the pleas, (*b*) though they must give more detailed information, (*c*) and not be merely reiterations. (*d*) The Court has refused to allow a defendant to contend that the patent was illegal when it appeared that he had only given notice of an objection to that effect, and not specially pleaded it. (*e*)

Short form of defence.

Any objection to the validity of a patent will be properly raised if the defence contains a simple denial of the validity of the patent, "on the grounds stated in the particulars of objection delivered herewith"; (*f*) but it is by no means uncommon for the grounds of objection to appear on the defence itself.

Grounds on which invalidity may be pleaded.

The defendant may deny infringement and plead also that the acts complained of were done by the leave and licence of the patentee. (*g*) It is further open to him to plead the invalidity of the patent on any one or more of the following grounds:—

i. The grantee was not the true and first inventor. (*h*)
ii. The alleged invention is not the proper subject-matter of a patent. (*i*)
iii. The invention is not useful. (*k*)
iv. The invention is not new. (*l*)
v. The specification is insufficient. (*m*)

(*x*) Bovill *v.* Goodier (No. 2), (1866) L. R. 2 Eq. 195; see R. S. C. (1883) Appendix D.

(*y*) R. S. C. Ord. 19, r. 27; Ashworth *v.* Law, (1887) 7 R. P. C. 231.

(*z*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531, 536.

(*a*) p. 412 *post*.

(*b*) Macnamara *v.* Halse, (1842) 2 W. P. C. 128; Jones *v.* Berger, (1843) 1 W. P. C. 544.

(*c*) Bulnois *v.* Mackenzie, (1837) 1 W. P. C. 260; Jones *v.* Berger, (1843) 1 W. P. C. 544; Walton *v.* Bateman, (1842) 1 W. P. C. 616.

(*d*) Neilson *v.* Harford, (1841) 1 W. P. C. 370; Betts *v.* Walker, (1850) L. R. 14 Q. B. 363, 368; Walton *v.* Bateman, (1842) 1 W. P. C. 268 *n.*

(*e*) Gillet *v.* Wilby, (1839) 1 W. P. C. 270.

(*f*) See order in Kurtz *v.* Spence, (1887) 36 Ch. D. 776.

(*g*) Hensee *v.* Hardie, (1874) 11 R. P. C. 421; Guyot *v.* Thompson, (1894) L. R. 3 Ch. 388; 11 R. P. C. 541.

(*h*) Chap. i. *ante*.

(*i*) Chap. ii. *ante*.

(*k*) Chap. iv. *ante*.

(*l*) Chap. iii. *ante*.

(*m*) Chap. v. *ante*.

vi. There is some disconformity between the specifications. (*n*) Defence.

vii. The letters patent have lapsed previously to the committal of the acts complained of, in consequence of the non-payment of fees, or the period of their duration having expired. (*o*)

viii. Any ground on which the patent might, at the commencement of the Patents, Designs, and Trade Marks Act, 1883, have been repealed by *scire facias*, (*p*) *i.e.*:

*a.* Letters patent of earlier date than those forming the subject of the action have been granted in respect of the same invention. (*q*)

*b.* The letters patent were granted on a false suggestion. (*r*)

*c.* The grant of the letters patent was not lawful. (*s*)

*d.* Non-compliance on the part of the patentee with the conditions of the letters patent.

*e.* Failure of the essential requisites of novelty or utility.

*f.* Abuse of the privileges granted by the letters patent.

The objection that the invention is not the proper subject-matter of a patent cannot be taken under a plea that the invention is not new, (*t*) or under a plea of insufficiency of the specification. (*u*) Not subject-matter.

As we have seen, (*x*) the requirement of utility does not arise from any express words in the Statute of Monopolies, but is an inference to be drawn from the Common Law and the enactment that the monopoly granted must not be "mischievous to the State, or to the hurt of trade, or generally inconvenient." (*y*) Though it may be thought that the proper form of plea is to plead the statute, and not merely the want of utility, the practice at Common Law, which was adopted by the Court of Chancery, (*z*) viz., to deny the utility Not useful.

(*n*) Chap. v. *ante*.
(*o*) Vol. II. p. 54.
(*p*) 46 & 47 Vict. c. 57, s. 26.
(*q*) Chap. iii. *ante*.
(*r*) *Ibid*.
(*s*) Chap. ii. *ante*.
(*t*) Walton *v.* Potter, (1841) 1 W. P. C. 597; Household Co. *v.* Neilson, 1 W. P. C. 677.
(*u*) 21 Jac. I. c. 3, s. 6; Household Co. *v.* Neilson, (1843) 1 W. P. C. 677; Jupe *v.* Pratt, (1837) 1 W. P. C. 151; Walton *v.* Potter, (1841) 1 W. P. C. 597.
(*x*) p. 157 *ante*.
(*y*) Morgan *v.* Seaward, (1837) 1 W. P. C. 197; 21 Jac. I. c. 3, s. 6.
(*z*) Seton, 4th ed. p. 347; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531, 536.

Defence.

in general terms, is that usually followed. (*a*) The defence of want of utility cannot be raised under a plea that the invention is not a new manufacture if the plaintiff objects. (*b*)

If the specification describes different modes of carrying out the invention, which vary in utility, though all are to some extent useful, this fact cannot be made a valid ground of defence. (*c*)

Not new.

The issue of novelty is quite distinct from that of true and first inventor, (*d*) for an invention may be a new manufacture within the Statute of Monopolies (*e*) but the patentee may not be the true and first inventor, in which case the patent would be void. The defendant is consequently entitled to have the question of newness of manufacture tried apart from that of newness of invention; (*f*) and a plea that the invention is not the proper subject-matter of letters patent does not raise the issue of novelty. (*g*)

In *Walton* v. *Potter* (*h*) it was pleaded that the invention was not a "new manufacture," and the Court held that this plea admitted the invention to be a "manufacture" within the meaning of the statute, and only put in issue the novelty. On the other hand, in *Spilsbury* v. *Clough* (*i*) it was held that a plea that the invention was not a "new manufacture" was bad, as it left it doubtful whether the objection was that the invention was not new, or that it was not a manufacture within the statute. But neither of these cases is to be considered as good law on the subject, for in *Bush* v. *Fox* (*k*) the House of Lords held that a plea to the effect that an invention is not a "new manufacture" puts in issue both the novelty of the invention and its being a manufacture; and in *Spencer* v. *Jack* (*l*) the Lords Justices, on appeal, ordered the questions of newness of invention and newness of manufacture to be tried separately.

Prior grant.

The issue of prior grant which is a permissible defence (*m*) must not be confounded with that of novelty. When a prior document is relied on for the purpose of attacking the novelty of the invention which forms the subject of the plaintiff's

(*a*) Hindmarch on Patents, p. 275.
(*b*) Walton *v.* Bateman, (1842) 1 W. P. C. 623.
(*c*) Miller *v.* Searle, (1893) 10 R. P. C. 106.
(*d*) Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.
(*e*) 21 Jac. I. c. 3.
(*f*) Spencer *v.* Jack, (1862) 3 De G. J. & S. 346; 11 L. T. N. S. 242; Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.
(*g*) Booth *v.* Kennard, (1856) 1 H. & N. 527.
(*h*) (1841) 1 W. P. C. 601, 611.
(*i*) (1842) 1 W. P. C. 255.
(*k*) (1856) Macr. P. C. 179.
(*l*) (1864) 3 De G. J. & S. 316; 11 L. T. N. S. 242.
(*m*) See p. 403.

patent, it is necessary to prove publication by the document; (*n*) when, however, the ground of attack is a prior grant in respect of the *same invention*, all that it is necessary to prove is that the alleged prior grant was in fact made in respect of the same invention before the grant to the plaintiff. The plaintiff is entitled in his reply to deny the validity of the alleged prior grant relied on by the defendant, and, it is submitted, if he do so, he may be required to give particulars of his objections to the validity of the alleged prior grant. (*o*) Defence.

It must be remembered that now patents are, in accordance with the statutory requirements of the Act of 1883, always dated and sealed as of the day of application, (*p*) and, further, by the express provisions of the statute, in the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on an earlier application. (*q*) In the event of more than one patent being sealed on concurrent applications, it is submitted, those in respect of applications of later date are made void *ab initio* by the sealing of a patent on an application of prior date. (*r*)

Of late years the defence of prior grant has been frequently raised, but the writer is not aware of any case in which it has succeeded.

Under the practice prior to the Act of 1883, insufficiency of the specification was one of the most frequent objections raised in patent actions. The reason of this was that formerly the letters patent contained a condition requiring the patentee within a stated period to file a specification ascertaining the nature of the invention, and in what manner the same was to be performed, under pain of forfeiting the grant altogether. (*s*) Insufficiency of specification.

The form of letters patent at present in use does not contain any condition (though it might do so) (*t*) avoiding the grant, if the specification, which is filed previously to the grant, is insufficient. As, however, insufficiency of the specification was a ground on which the repeal of a patent might at the commencement of the Act of 1883 have been obtained by *scire facias*, as being a failure to comply with one of the

(*n*) pp. 140-156 *ante*.
(*o*) See Vol. II. pp. 391, 393 *post*, and Brooks *v.* Lamplugh, (1898) 16 R. P. C. 45, for forms of pleadings.
(*p*) See Vol. II. p. 53 *ante*.
(*q*) *Ibid.*
(*r*) See Vol. II. p. 53.
(*s*) Arkwright *v.* Nightingale, (1785) 1 W. P. C. 61.
(*t*) 46 & 47 Vict. c. 57, s. 33.

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conditions of the grant, (*u*) it is still a ground of defence to an action for infringement under the present practice. (*x*)

Disconformity.

Deception of the Crown by obtaining a patent by means of a false representation was formerly a ground for a *scire facias*, (*y*) and, it is submitted, the Crown is deceived if there is a material difference between the provisional and complete specification; the patent must in such a case have been obtained in respect of an invention which was not foreshadowed in the provisional specification; (*z*) and the objection that there is disconformity is consequently a good defence to the validity of a patent. (*a*) Moreover, it may be said that the complete specification does not particularly describe and ascertain the nature of the invention, if it departs from the terms of the title or of the provisional specification, in which the nature of the invention must be described. It would consequently appear that evidence of a defect in the title and disconformity between the specification may be tendered under a plea of insufficiency. (*b*)

Fresh issues during the progress of the action.

The Court will at any time during the progress of an action for infringement allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before. (*c*) Thus, in one case, the plaintiff having altered his case from that originally set up, the defendant was at the trial allowed to amend his defence by adding a plea of want of subject-matter. (*d*) In another case, where the defendant at the trial asked for leave to amend his defence by adding a plea of invalidity on the ground of variance between the title and the claims, the Court refused to grant the leave, on the ground that it was asked for too late. (*e*)

Decision in a prior action.

**Estoppel.**—The fact that a patent has been questioned and upheld in a former action does not estop a person questioning it again in a subsequent action, when the parties to the second action are not the same as the parties to the first; and, though the plaintiff in both actions is the same, the Court

(*u*) p. 297 *ante*.
(*x*) 46 & 47 Vict. c. 57, s. 26, sub-s. 3.
(*y*) R. *v.* Arkwright, (1785) 1 W. P. C. 66.
(*z*) Curtis *v.* Platt, (1863) Griff. L. O. C. 53.
(*a*) 46 & 47 Vict. c. 57, s. 26, sub s. 3; see also p. 297 *ante*.
(*b*) Penn *v.* Bibby, (1866) L. R. 2 Ch. App. 127, 130; but see Derosne *v.* Fairie, (1835) 1 W. P. C. 161; Neilson *v.* Harford, (1841) 1 W. P. C. 312; Morgan *v.* Fuller (No. 1), (1866) R. R. 2 Eq. 297.
(*c*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9; R. S. C. (1883) Order xxviii.; p. 483 *post*.
(*d*) Crossthwaite *v.* Moorwood, (1894) 11 R. P. C. 558.
(*e*) Shrewsbury and Talbot S. T. Cab and Noiseless Tyre Co. *v.* Morgan, (1896) 13 R. P. C. 75.

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trying the second action is not bound by the decision in the former in favour of the plaintiff; for its operation is not *mutual* as between the parties to the second action, (*f*) and the evidence in the second action may be different to that in the former—*e.g.*, a prior user relied on as an anticipation may fail to defeat the patent from want of evidence in the first action, but be completely successful in view of further evidence adduced in the second action. (*g*) In second actions, however, the Court usually considers itself bound by the interpretation put on the specification by a Court of equal or superior jurisdiction in the first action when the facts as to prior knowledge are the same; (*h*) though, if the specification has to be reconstrued in the light of fresh facts as to prior knowledge, the Court would most probably not consider itself so bound. (*i*)

The fact that the patentee has been defeated in a prior action cannot be pleaded successfully as a bar to a subsequent action, (*k*) unless the patent was declared invalid in the prior action and the parties are the same when the matter is *res judicata*, (*l*) for until the patent is revoked, or lapsed by effluxion of time, a right is presumed to be in the patentee, and his remedy for an infringement of such right is by action on the patent. When the question of validity has been fought out to judgment, and a separate finding has been come to on the point, the matter is *res judicata* between the parties, and cannot be raised again in any fresh action between the same parties. It cannot be raised afresh even if the defendant is prepared with fresh objections as to validity which were not before the Court on the former occasion. When the question of validity is brought to trial it is the duty of the defendant to put his whole case before the Court, and if he does not do so it is his fault or misfortune. In other words, he cannot be permitted to bring his case as to validity piecemeal before the Court in a series of actions. (*m*) He could,

(*f*) Taylor on Evidence, 5th ed. vol. ii. p. 1444; Shedden *v.* A.-G., (1860) 30 L. J. (N. S.) Pr. & Mat. 217.

(*g*) Shaw *v.* Day, (1894) 11 R. P. C. 185; see, *e.g.*, Gammons *v.* Battersby, (1904) 21 R. P. C. 322, and Gammons *v.* Singer Manufacturing Co., (1904) 22 R. P. C. 129, 452.

(*h*) Edison *v.* Holland, (1888) 5 R. P. C. 459; 6 R. P. C. 243; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 367.

(*i*) p. 283 *ante*.

(*k*) Arkwright *v.* Nightingale, (1785) Dar. P. C. 52.

(*l*) Horrocks *v.* Stubbs, (1895) 12 R. P. C. 540; 13 R. P. C. 69; Shoe Machinery Co. *v.* Cutlan (No. 2), (1896) 13 R. P. C. 141.

(*m*) Shoe Machinery Co. *v.* Cutlan (No. 2), (1896) 13 R. P. C. 141.

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however, after action, petition for the revocation of the patent. (*n*)

When in the prior action the question of validity has been decided against the patentee, this fact may be pleaded by the defendant in the second action, on the ground that the matter is already *res judicata* between the parties.

In one case where the patentee was defeated on the validity of the patent on several grounds, including disconformity, and he then amended the specification, but did not remove the portions which affected the question of disconformity, and then commenced a fresh action, the Court of first instance held that the subject of the action was *res judicata*, and dismissed the action. On appeal, the Court of Appeal, without deciding whether the matter was *res judicata*, held that the true interpretation of a certain agreement between the parties was that the decision on the question of disconformity should be final between them, and dismissed the action on that ground. (*o*)

The fact that the actual defendant in the second action was —*e.g.*, by virtue of an indemnity—the virtual defendant in the first action does not operate as an estoppel, and the matter is not *res judicata* between the parties to the second action. (*p*)

Specification amended after prior adverse decision.

When the portions of the specification which affected the question of validity in a prior action have been entirely removed by amendment before the commencement of a subsequent action, the decision in the former action cannot, of course, be pleaded by the defendant as an estoppel against the plaintiff in the subsequent action. (*q*)

Admission of infringement.

A defendant who has once submitted to an injunction is estopped in a second action, or, on being attacked for a second infringement, from either directly or indirectly raising arguments against the validity of the patent. (*r*) On the other hand, where a defendant has, prior to action brought, stated—not in litigation *inter parties*—in howsoever a definite manner, that he has infringed, this fact does not raise any sort of estoppel against him in an action brought for the infringement of the patent. The question of infringement is one which must in such circumstances be determined quite apart from the defendant's previous statements, excepting in

(*n*) p. 306 *ante*.

(*o*) Horrocks *v.* Stubbs, (1895) 12 R. P. C. 540; 13 R. P. C. 69.

(*p*) Gammons *v.* Singer Manufacturing Co., (1904) 22 R. P. C. 459.

(*q*) Deeley's Patent, (1894) 11 R. P. C. 76.

(*r*) Moor *v.* Thomson, (1890) 7 R. P. C. 327.

so far as they may affect his credibility as a witness of truth or as an expert. (*s*)

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The defendant in an action for infringement may in consequence of his relationship to the plaintiff be estopped from denying the validity of the patent, *e.g.*, where he is a licensee under a licence granted by deed which contains a recital implying the validity of the patent; (*t*) for, the contract being by deed, the failure of the consideration is immaterial, and it is not competent to a defendant by plea to deny the effect of a deed which he has executed. (*u*) The incapacity of a licensee to deny the validity of a patent against the licensor terminates with the termination of the licence, and he is then in exactly the same position as any other member of the public against whom an action of infringement may be brought. (*x*) A revocable licence may be determined by due notice, and thus a licensee may, by proper notice given before action brought, determine the licence, and so turn himself from a licensee into a wrongdoer, and become entitled to dispute the validity of the patent in an action of infringement brought against him by his former licensor; (*y*) but a plea in a defence to the effect that the licence has been determined will not operate as a due notice of determination. (*z*)

Defendant a licensee.

Persons, other than licensees, may in consequence of their past conduct be estopped from denying the validity of the patent as against the plaintiff. Thus, a patentee who has assigned his patent is estopped from denying its validity in an action for infringement brought by the assignee. (*a*)

Defendant an assignor.

Although it is a sound principle of law that a grantor cannot derogate from his grant, yet the language of a specification must not be strained against an assignor who happens to be the original patentee and defendant in an action of infringement brought by the assignee; (*b*) and he is at liberty to show that the specification is not as wide as the plaintiff alleges. (*c*) Moreover, an assignor cannot be restrained from

(*s*) Osborne *v.* Board, (1896) 13 R. P. C. 748.

(*t*) Bowman *v.* Taylor, (1834) 2 A. & E. 278; 1 W. P. C. 292; Cutler *v.* Bower, (1848) 11 Q. B. 973; see Vol. II. p. 148.

(*u*) Smith *v.* Scott, (1859) 6 C. B. N. S. 771; 5 Jur. N. S. 1358; Hall *v.* Conder, (1857) 2 C. B. N. S. 22.

(*x*) Dangerfield *v.* Jones, (1865) 13 L. T. N. S. 142; Axmann *v.* Lund, (1874) L. R. 18 Eq. 330; Crossley *v.* Dixon, (1863) 10 H. L. C. 293.

(*y*) See Vol. II. pp. 150, 151.

(*z*) *Ibid.*

(*a*) Oldham *v.* Longmead, (1789) cited 3 T. R. 441; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162, 187; Heugh *v.* Chamberlain, (1877) 25 W. R. 742; but see Vol. II. pp. 115, 116.

(*b*) Hocking & Co. *v.* Hocking, (1889) 6 R. P. C. 69.

(*c*) *Ibid.*

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assisting, as a scientific witness or otherwise, the defendant in an action brought by the assignee. (*d*)

Defendant a former partner of the plaintiff.

A patentee who has worked the patent in partnership with his co-patentee, but has dissolved partnership and assigned the whole of his interest in the patent to his former partner, is estopped from denying the validity of the patent in an action of infringement at the instance of such former co-patentee. (*e*) But a person who has worked a patent in partnership with the patentee, and during the partnership asserted its validity against various infringers, but refrained from taking legal proceedings, is not estopped from disputing the patent in an action brought by the patentee after the termination of the partnership. (*f*)

Agreement may operate as an estoppel.

In *Baird* v. *Neilson* (*g*) it appeared that *Baird* had agreed with *Neilson* to put an end to litigation and pay a royalty for the use of *Neilson's* patented invention. Subsequently *Neilson* brought an action against *Baird* for specific performance of the agreement, and *Baird*, in a cross action, sought to deny that what he was doing was an infringement, but the House of Lords held that the very object of the agreement was to put an end to the question of the particular thing done by *Baird* being an infringement, and that he was therefore estopped from setting up the defence.

Where, on an action being brought to enforce an agreement, the defendants gave an undertaking to the patentee not to sell certain grates having a patent canopy, without marking them in an agreed manner, it was held, on a motion to commit them for breach of the agreement, which motion was by consent turned into a motion for an injunction, that they were estopped from denying the validity of the plaintiff's patent. (*h*)

Defendant may be estopped *from denying* validity of the patent on a motion for interlocutory injunction though not at the trial.

A defendant may be estopped from denying the validity of a patent on a motion for an interlocutory injunction, and yet not be so estopped at the trial.

Thus, where in a previous action judgment and costs had been given against the defendants, Lord *Hatherley*, then Vice-Chancellor *Wood*, on the hearing of a suit against the same defendants, for the infringement of the same patent, held that

(*d*) London and Leicester Hosiery Co., Ld. *v.* Griswold, (1886) 3 R. P. C. 250, 253.

(*e*) Chambers *v.* Crichley, (1864) 33 Beav. 374; Gouville *v.* Hay, (1903) 21 R. P. C. 49.

(*f*) Axmann *v.* Lund, (1874) L. R. 18 Eq. 330.

(*g*) 8 C. L. & F. 726.

(*h*) Crossthwaite *v.* Steel, (1888) 5 R. P. C. 220.

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if the plaintiffs had made an interlocutory application they would have been entitled to an injunction till the hearing; but, the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred. (*i*) And again, where it appeared that the patentee had formerly worked the patent in partnership with the defendants under an agreement reciting the patent, and during the partnership the defendants had joined the patentee as co-plaintiff in suits against various infringers, the same Judge held that, the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing the patent at law. (*j*)

Where it appeared that in a previous action tried in Scotland, and decided in favour of the plaintiff, the defendant had omitted to dispute the validity of the patent, he was not allowed to set up this defence on a motion for an interlocutory injunction in England. (*k*) But in an action for the infringement of a patent which had been declared valid in a previous arbitration between the plaintiff and defendant, the Court held that the defendant was not estopped from disputing it at the trial. (*l*)

Assignment by trustee in bankruptcy no estoppel against the patentee.

A bankrupt patentee is not estopped from denying the validity of the patent against a purchaser from his trustee in bankruptcy, if there is nothing to show that the purchaser has bought on the faith of any representation made by the patentee. (*m*)

Estoppel may operate against one only of several defendants.

When there is more than one defendant, an estoppel may affect only one of them. (*n*) Thus, in a case where it appeared that one defendant had, during the existence of a partnership between the plaintiff and the defendant, by his acts barred his right to dispute the validity of the patent against the plaintiff, the other defendant, who was not affected by the acts of his co-partner, was not estopped, in an action brought subsequent to the termination of the partnership, from disputing the patent. (*o*) But where two defendants, disputing

(*i*) Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107.

(*j*) Muntz *v.* Grenfell, (1842) 2 W. P. C. 88, 91.

(*k*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 214.

(*l*) Newall *v.* Elliott, (1863) 1 H. & C. 797.

(*m*) Cropper *v.* Smith, (1884) L. R. 26 Ch. D. 700, 706; 10 App. Cas. 249; 1 R. P. C. 81; 2 R. P. C. 17.

(*n*) Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107; Heugh *v.* Chamberlain, (1877) 25 W. R. 742.

(*o*) Heugh *v.* Chamberlain, (1877) 25 W. R. 742.

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in the same interest, sever their defence, and one delivers particulars disputing the validity of the patent, but the other omits to do so, the latter is entitled to the benefit of such particulars, if proved, (*p*) provided he is not otherwise estopped from denying the validity of the patent. (*q*)

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Must be delivered with the defence, or by order of the Court or a Judge, at any subsequent time.

It is enacted by the Patents, Designs, and Trade Marks Act, 1883, (*r*) that the defendant in an action for infringement must deliver with his statement of defence, or by order of the Court or a Judge at any subsequent time, particulars of any objections on which he relies in support thereof. And, if he disputes the validity of the patent, the particulars must state on what grounds he disputes it; and, if one of those grounds is want of novelty, they must state the time and place of the previous publication or user alleged by him.

Evidence limited by particulars.

It is also by the same statute (*s*) further enacted that at the hearing of an action for infringement no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged objection of which particulars have not been delivered. (*t*)

As we have seen, particulars of objections do not stand in the place of, and cannot go beyond, the pleas raised by the defence; (*u*) and it is to be noticed that the Act of 1883 requires far more detail in the particulars of objections than in the particulars of breaches complained of by the plaintiff. (*x*)

Time for pleading after delivery of particulars.

The party at whose instance particulars are delivered under a Judge's order has, unless the order otherwise provides, the same length of time for pleading after the delivery of the particulars that he had at the return of the summons; and an order for particulars does not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time. (*y*)

Costs of further and better particulars.

The party against whom an order for further and better particulars is made may be ordered to pay the costs of the

(*p*) Cropper *v.* Smith, (1885) L. R. 10 App. Cas. 249.

(*q*) Hough *v.* Chamberlain, (1877) 25 W. R. 742; Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107.

(*r*) s. 29. As to the disadvantages in giving an unnecessary multiplicity of objections, see Allen *v.* Oates, (1898) 15 R. P. C. 303.

(*s*) s. 29, sub-s. 4.

(*t*) See p. 454 *post*.

(*u*) p. 402 *ante*.

(*x*) pp. 395–401 *ante*.

(*y*) R. S. C. (1883) Order xix. r. 8; Boyd *v.* Farrar, (1888) 5 R. P. C. 33, 36.

application; (z) and if the party against whom the order is made does not comply with it, the proper course is for the other side to apply by summons in chambers to have the insufficient particulars struck out. (a)

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A defendant complying with an order for further and better particulars is not entitled to give *fresh* particulars without having obtained leave to amend, and if he does insert them they may be struck out by the plaintiff on summons. (b)

Fresh particulars cannot be given in compliance with an order for further and better particulars.

It was decided that the notice of objections required by 5 & 6 Will. IV. c. 83, s. 5, to be delivered by a defendant in an action for infringement were not conclusive at his peril, but the Court or a Judge, under their general jurisdiction, as well as under the statute, might order a further and fuller notice. (c)

Amendment of particulars of objections.

Under the Act of 1883, the Court or a Judge has power to order the amendment from time to time of the plaintiff's or defendant's particulars; (d) as also has the Court of Appeal; (e) and if they are insufficient or too general, the opposite party, if he means to object to them, should at once apply, by summons at chambers or a motion in Court, (f) for an order for further and better particulars; otherwise, where the particulars are too general, evidence within their literal meaning may be admitted. (g) In the words of *Mellish*, L.J.: "There is a very large difference between a case where a Judge has been applied to and has ordered further particulars, in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that if . . . wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a Judge for further particulars." (h)

If, however, the defendant delivers his objections fairly and

(z) Grover and Baker Sewing Machine Co. *v.* Wilson, W. N. (1870) p. 78; Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

(a) Flower *v.* Lloyd, (1877) 20 S. J. 860; Higgins' Digest, Supplement p. 78; Aktiebolaget Separator *v.* Dairy Outfit Co., (1896) 13 R. P. C. 725.

(b) Aktiebolaget Separator *v.* Dairy Outfit Co., (1896) 13 R. P. C. 725, 727.

(c) Bulnois *v.* Mackenzie, (1837) 1 W. P. C. 260.

(d) s. 29 (5).

(e) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530; Britain *v.* Hirsch, (1888) 5 R. P. C. 226; p. 396 *ante*; p. 483 *post*.

(f) Judicature Act, 1873, s. 39; Frearson *v.* Loe, (1878) 26 W. R. 138; R. S. C. (1883) Order xix. r. 7.

(g) Hull *v.* Bollard, (1856) 1 H. & N. 134; Curtis *v.* Platt, (1865) 35 L. J. N. S. Ch. 852, 868; Sugg *v.* Silber, (1876) L. R. 2 Q. B. D. 493.

(h) Sugg *v.* Silber, (1876) L. R. 2 Q. B. D. 495.

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honestly and does his best to give the plaintiff the information he is entitled to, it is not the province of the Court by ordering amendments to tie his hands so tight as to dictate to him in an early stage of the proceedings how exactly he is to frame his case, (*i*) since the object of the particulars is only to prevent surprise, to limit the scope of the inquiry and to prevent expense.

Particulars of objections may be amended any time by leave of the Court or a Judge.

It is competent for the defendant at any time during the progress of an infringement action, with the leave of the Court or a Judge (*k*) upon terms, (*l*) to raise a fresh issue, especially on the discovery of facts which could not with due diligence have been discovered before, (*m*) and he will be allowed to amend his particulars of objections accordingly, though he may be liable for the costs occasioned by any such amendment. (*n*)

The defendant may, even during the progress of the trial, obtain leave on short service of motion to amend his particulars, (*o*) if he can show that the fresh evidence he is desirous of adducing could not with due diligence have been discovered earlier; (*p*) but if an amendment be made late, though the defendant succeed in the action and the action is dismissed, it may be so dismissed without costs. (*q*)

The Court will not sanction an amendment, if, on the face of it, it appears that the fresh objection cannot be sustained. (*r*)

Particulars on a new trial.

Where a new trial is obtained the defendant is entitled to give particulars of objections which were not raised at the first trial. (*s*)

Terms usually imposed when leave is given to amend particulars of objections.

The Court has an absolute discretion to impose such terms as it thinks fit upon giving leave to amend the particulars. (*t*) When leave to amend particulars of objections is given, the Court generally imposes terms, and the usual order, with the object of putting the plaintiff in the same position as he would have been in if the particulars had originally been delivered

(*i*) Nettlefolds *v.* Reynolds, (1891) 8 R. P. C. 417, per Lindley, L.J.; see also Holliday *v.* Hippenstall, (1889) 6 R. P. C. 320.

(*k*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*l*) See *infra*.

(*m*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9; Otto *v.* Steel, (1885) 2 R. P. C. 139.

(*n*) Renard *v.* Levinstein, (1864) 13 W. R. 229; 11 L. T. N. S. 505; Daw *v.* Eley, (1865) L. R. 1 Eq. 38; Blakey *v.* Latham, (1889) 6 R. P. C. 29; Brown *v.* Hastie, (1904) 21 R. P. C. 446.

(*o*) *Ibid.*

(*p*) Moss *v.* Malings, (1886) L. R. 33 Ch. D. 603; Edison Electric Co. *v.* Sheppey, (1887) 4 R. P. C. 471; Blakey *v.* Latham, (1889) 6 R. P. C. 184.

(*q*) Allen *v.* Horton, (1893) 10 R. P. C. 412.

(*r*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9.

(*s*) Bovill *v.* Goodier, (1871) 36 L. J. N. S. Ch. 360.

(*t*) See Woolley *v.* Broad, (1892) 9 R. P. C. 429; Wilson *v.* Wilson, (1899) 16 R. P. C. 315.

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in their amended form, gives the plaintiff time within which to elect whether he will discontinue the action, and orders the defendant, in the event of discontinuance, to pay all costs incurred by the plaintiff since delivery of the original particulars of objections, and only allows the objections to be amended in the event of the plaintiff not electing to discontinue, and makes the cost of the application, and consequent on the amendment, the plaintiff's in any event. (*u*)

The fact that the plaintiff was aware of the existence of the fresh objection which the defendant seeks to raise will not in itself entitle the defendant to an order on any more favourable terms. (*x*)

Though the Court in giving leave to amend has an unfettered discretion as to terms, (*y*) it appears to be the practice to impose such conditions as will, in the event of the plaintiff electing to discontinue, secure to him his costs subsequent to the delivery of the particulars in the form on which issue was last joined. Thus in *Ehrlich* v. *Ihlee*, (*z*) where issue had not been joined on the first amended particulars of objection, the plaintiff was, in the event of his electing to discontinue, given his costs subsequent to the delivery of the original particulars. On the other hand, in *Wilson* v. *Wilson*, (*a*) where the plaintiff had elected to continue, and had joined issue on the amended particulars of objections, it was made a condition of reamendment that the plaintiff, if he should elect to continue after the reamendment, should have his costs subsequent only to the date of delivery of the particulars as first amended. In a case decided before the Act of 1883, where a defendant in compliance with an order of the Court had amended his particulars of objections, and made an application for leave to reamend them by inserting further specified instances of alleged prior use which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of, and consequent on, the reamendment were reserved; (*b*) and where a cause was in the paper for hearing,

(*u*) Baird *v.* Moule's Earth-closet Co., (1881) L. R. 17 Ch. D. 139; Edison Telephone Co. *v.* Indiarubber Co., (1881) L. R. 17 Ch. D. 137; Aveling *v.* Maclaren, (1881) L. R. 17 Ch. D. 139; Ehrlich *v.* Ihlee, (1887) 4 R. P. C. 115, 119; Darrar *v.* Purser, (1889) 6 R. P. C. 365; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68; Morris and Wilson & Co. *v.* Coventry Machinist's Co., (1891) 8 R. P. C. 353; [1891] 3 Ch. 419; Consolidated Pneumatic Tool Co. *v.* Churchill & Co., (1905) 22 R. P. C. 209.

(*x*) Ehrlich *v.* Ihlee, (1887) 4 R. P. C. 115.

(*y*) p. 414 *ante*.

(*z*) (1887) 4 R. P. C. 115.

(*a*) (1893) 16 R. P. C. 315.

(*b*) Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

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the defendant was, after giving notice to the plaintiff, allowed to give evidence, by affidavit, of prior user discovered after the cause was in the paper, but the terms imposed insured to the plaintiff an opportunity of filing affidavits in answer, and the costs of, and consequent on, the application were reserved. (*c*)

Order when plaintiff elects to continue before the terms of the order are settled.

When the plaintiff, at the hearing of an application by the defendant for leave to amend his particulars, elects to proceed with the action, or the leave to amend is obtained at the trial, and the terms of the order are reserved till the plaintiff makes his election and he elects to proceed, the order merely provides that the costs of the application, and all costs occasioned by the amendment, and costs unnecessarily caused to the plaintiff by reason of the amendment being made, shall be the plaintiff's in any event. (*d*)

Further evidence on appeal.

On an appeal the Court has power to receive further evidence, and to order an amendment of the particulars of objection for the purpose of admitting it; (*e*) but if the appeal is from a judgment after trial, this evidence, except as to matters subsequent to the judgment, can be admitted only on special grounds (*e.g.*, the party desiring to tender it has found a lost document), (*f*) and not without special leave. (*g*)

Particulars of objections must be precise and definite.

The particulars of objections must be precise and definite, and should not contain a long list of anticipations, of which only a few are relied on at the trial; (*h*) but they should give such information as will enable the plaintiff to make the necessary inquiries at any places named. (*i*)

Object of particulars of objections.

The Act of 1835 (*k*) was the first statute which specifically required the delivery of particulars of objections by the defendant to the plaintiff, and this was done, not to limit the defence, but to prevent the patent from being upset by any unexpected turn of the evidence, and to lessen the expense. (*l*) This object is similarly provided for by the Act of 1883. (*m*)

(*c*) Wilson *v.* Gaun, (1875) W. N. (1875) 78.

(*d*) Parker *v.* Maignen's Filtre Rapide Co., (1888) 5 R. P. C. 208; Badische Anilin und Soda Fabrik *v.* La Société Chemiques Usines du Rhône, (1897) 14 R. P. C. 875.

(*e*) Cropper *v.* Smith, (1884) 1 R. P. C. 81; 2 R. P. C. 17; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530. As to the practice in Scotland, see Brown *v.* Hastie, (1904) 22 R. P. C. 85.

(*f*) Hinde *v.* Osborne, (1885) 2 R. P. C. 45.

(*g*) R. S. C. (1883) Order lviii. r. 4.

(*h*) Thomson *v.* Batty, (1889) 6 R. P. C. 84.

(*i*) Per Parke, B., Palmer *v.* Cooper, (1853) 9 Exch. 236.

(*k*) 5 & 6 Will. IV. c. 83, s. 5.

(*l*) See remarks of Tindal, C.J., Fisher *v.* Dewick, (1838) 1 W. P. C. 267; Curtis *v.* Platt, (1863) 8 L. T. N. S. 657.

(*m*) s. 29, sub-s. 2; Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Nettlefold's *v.* Reynolds, (1891) 8 R. P. C. 417.

Particulars of Objections.

The particulars of objections must state clearly which individual claim or claims of the plaintiff's specification the defendant proposes to attack in respect of each objection. (*n*)

Particulars of disconformity.

A patent may be void on account of disconformity between the specifications, or in consequence of the claim being defective; (*o*) but, it is submitted, a defendant relying on either of these grounds cannot dispense with the necessity for delivering particulars of objections, for the Court will not undertake to decide as to the disconformity of the specifications or the validity of the claims without the evidence of witnesses, (*p*) which could not be given unless particulars had been previously delivered. (*q*)

If a defendant object that there is a disconformity between the specifications, he may be required to state in what the disconformity consists, or how the invention described in the complete differs from that described in the provisional specification. (*r*) So when it was stated that the invention described in the complete specification was different from that described in the provisional specification, and in particular the inventions described in certain pages and lines of the complete were not described in the provisional specification, the particular was held too wide, and the defendant was ordered to limit the allegation of variance to the particulars given. (*s*)

True and first inventor.

The objection that the patentee is not the true and first inventor does not raise the question of novelty generally, but only that some one other than the patentee was the true and first inventor, (*t*) and the defendant may now, probably, be required to state the name of the person alleged to be the true and first inventor, though this was not so under the practice prior to the Act of 1883. (*u*)

Subject-matter.

When it is objected that the invention is not subject-matter the reason should be definitely stated. When other objections fail the objection that the invention is not subject-matter can rarely be made out. (*x*)

Prior grant.

Also when an objection is directed to the issue of prior grant

(*n*) See, *e.g.*, Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co., (1900) 17 R. P. C. 277.

(*o*) Chap. v. *ante*.

(*p*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. App. 706; Longbottom *v.* Shaw, (1889) 6 R. P. C. 510.

(*q*) p. 412 *ante*.

(*r*) Anglo-American Brush Electric Light Corporation *v.* Crompton, (1886) L. R. 34 Ch. D. 152; Fisher *v.* Dewick, (1838) 1 W. P. C. 551 *n*.

(*s*) Heathfield *v.* Greenway, (1894) 11 R. P. C. 17.

(*t*) Thomson *v.* Macdonald & Co., (1890) 8 R. P. C. 5; Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.

(*u*) Russell *v.* Ledsam, (1843) 11 M. & W. 64.

(*x*) See per Esher, M.R., Edison-Bell Phonograph Corporation *v.* Smith and Young, (1894) 11 R. P. C. 398.

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it must state distinctly the grounds on which it is alleged that the patentee was not the first grantee, (*y*) and which of the plaintiff's claims are alleged to be included in the prior grant. (*z*)

Novelty.

Requisite details.

The Act of 1835 did not require any further detail in the defendant's particulars of objections than in the plaintiff's particulars of breaches, but the terms of the subsequent Act of 1852, (*a*) which are very similar to, though not quite so general as, the words of the Act of 1883, which regulates the present practice as regards particulars directed to the issue of want of novelty, required that the particulars of objection should state "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent."

Since the Act of 1883 requires greater detail in the particulars of objections than did the Acts of 1835 and 1852, it follows that words which were held to be too general under the latter Acts will be too general under the Act of 1883, which regulates the present practice in patent actions.

Must not be too general.

Particulars of objection will be too indefinite if, for instance, they allege as an anticipation a user by certain persons specified, and "*divers other persons*," (*b*) or "*by other persons* in London and Birmingham," (*c*) or "at Nottingham *and elsewhere*," (*d*) or "*by manufacturers generally* in London *and the vicinity*," (*e*) and in such cases the words in italics may be ordered to be struck out. The particulars of objection must state whether the whole of the invention is alleged to have been anticipated, or whether a portion only is old, (*f*) and, if the invention deals with complicated machinery or with several distinct machines, the particulars must state which particular machines, or which portion of the invention, has been anticipated. (*g*)

General public or common knowledge.

The defendant in an action for infringement frequently relies on the invalidity of the patent on the ground that the

(*y*) Rothwell *v.* Macintosh, (1894) 11 R. P. C. 274; Mica Insulator Co. *v.* Electrical Co., (1898) 15 R. P. C. 489.

(*z*) Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co., (1900) 17 R. P. C. 277.

(*a*) 15 & 16 Vict. c. 83, s. 41.

(*b*) Galloway *v.* Bleaden, (1839) 1 W. P. C. 268 *n.*; Fisher *v.* Dowick, (1838) 1 W. P. C. 551 *n.*

(*c*) Flower *v.* Lloyd, (1877) 20 S. J. 860.

(*d*) Jones *v.* Berger, (1843) 1 W. P. C. 544; Holland *v.* Fox, (1853) 1 C. L. R. 440.

(*e*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, (1891) 8 R. P. C. 321; p. 420 *post*.

(*f*) Fisher *v.* Dowick, (1838) 1 W. P. C. 264; Russell *v.* Ledsam, (1843) 11 M. & W. 647.

(*g*) Boyd *v.* Farrar, (1888) 5 R. P. C. 33.

subject-matter of the alleged invention was matter of general public knowledge before the date of the patentee's application. A defendant who relies on general public knowledge as an objection must be careful not to refer to specific specifications, or other publications, as merely showing the state of general public knowledge, otherwise he may incur the costs of amending his particulars by striking out all such references. It is neither necessary nor proper for him to state in his particulars of objections the books or publications which contain that knowledge, but such general public knowledge should be proved by ordinary evidence, with a reference to well-known books, if necessary. (*h*)

Particulars of Objections.

Particulars directed to prior general public knowledge—*i.e.*, common knowledge—will not authorise the defendant to give in evidence prior specifications or rare books or users as anticipations. Such publications must be referred to in separate particulars; and if this is not done the defendant will only be allowed to make the amendment necessary to admit the evidence on the usual terms. (*i*) That is to say, although it is not necessary to specify every publication which is relied on as common knowledge the defendant is not allowed, without amendment of the particulars, to refer to an isolated specification under the pretence that it goes merely to common knowledge, whereas, in fact, it has so close a bearing on the plaintiff's patent that it ought to have been included in the particulars of objections; (*k*) and the same principle applies equally to cases where it is sought to get in, on the ground of common knowledge alone, several prior documents which ought to have been included in the particulars of objections, (*l*) but it would appear that particulars are not necessary if the fact it is sought to prove is *bonâ fide* relied on only for the purpose of fixing the ambit

Prior specifications and rare books cannot be referred to under a plea of common knowledge.

(*h*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 556; Cole *v.* Squire, (1888) 5 R. P. C. 489; Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 302; Phillips *v.* Ivel Cycle Co., (1890) 7 R. P. C. 77; Thomson *v.* Macdonald, (1891) 8 R. P. C. 5; King Brown *v.* Anglo-American Brush Corporation, [1892] A. C. 367; 9 R. P. C. 313; Cassel Gold Co. *v.* Cyanide Gold Co., (1895) 12 R. P. C. 232.

(*i*) Edison Telephone Co. *v.* India Rubber Co., (1881) L. R. 17 Ch. D. 137; Peckover *v.* Rowland, (1893) 10 R. P. C. 118; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68; English and American Machinery Corporation *v.* Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 373; p. 414 *ante*.

(*k*) English and American Machinery Co. *v.* Union Boot and Shoe Machinery Co., (1894) 11 R. P. C. 373, 374.

(*l*) Peckover *v.* Rowland, (1893) 10 R. P. C. 118; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68.

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of a claim as distinct from disputing the validity of the patent. (*m*)

Distinction between issue of common knowledge and prior publication.

Common knowledge is really a different issue to prior publication, of which definite particulars must be given. Common knowledge goes to subject-matter and prior publication to novelty; and when common knowledge is pleaded it is not necessary to give particulars of it. (*n*) In framing a particular as to common knowledge care must be taken that it does not include or point to something of which a separate particular should be given, otherwise the plaintiff may be entitled to further and better particulars. (*o*) Thus, when the particular given was to the effect that "the alleged invention was not the subject-matter of valid letters patent, but was the mere analogous use and application to an old and well-known sewing machine of mechanical appliances and arrangements of parts well known and in common use in machines of a similar kind, and used for similar or analogous purposes, prior to the date of the said alleged Letters Patent," it was held not to be merely one of common knowledge, but to point to some particular mechanical appliance used in the machine as having been used previously to the date of the patent, and further and better particulars were ordered accordingly. (*p*)

A specification referred to in the particulars of objections as being an anticipation may be given in evidence at the trial on the points of common knowledge. (*q*)

Objection to general plea of want of novelty.

The general plea that the invention was not new is objectionable, as it may be said to be ambiguous in so far as it may go to general public knowledge or specific prior publications or users, of which detailed particulars are necessary. (*r*)

General user may be stated in general,

It may be that if the defendant relies on and states a general user in general terms—*e.g.*, the invention was previously to the patent in question used by persons engaged in the trade to which it refers, "*generally in London and the vicinity thereof*"—he is perfectly justified in so doing, and

(*m*) Appleby's Twin Roller Chain, Ld. *v.* Albert Eadie Chain, Ld., (1899) 16 R. P. C. 325; Holliday *v.* Heppenstall, (1889) 6 R. P. C. 326; Boxwell *v.* Cochran, (1895) 12 R. P. C. 169.

(*n*) Holliday *v.* Heppenstall, (1889) 6 R. P. C. 326; Boxwell *v.* Cochran, (1895) 12 R. P. C. 169.

(*o*) Chadburn *v.* Meehan, (1895) 12 R. P. C. 120; Birch *v.* Harrap, (1895) 12 R. P. C. 431.

(*p*) Birch *v.* Harrap, (1895) 12 R. P. C. 431.

(*q*) Sutcliffe *v.* Abbott, (1902) 20 R. P. C. 51.

(*r*) Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 585.

does not inflict any hardship on the plaintiff, for proof of one person is not sufficient to prove a general user, and the plaintiff in such a case cannot complain of generality of statement, for the more general it is the more the defendant must prove under it. (*s*) In such a case the plaintiff is entitled by means of interrogatories to obtain the names and addresses of such manufacturers, and the places and dates of user. (*t*) An allegation of general public user must not, however, be in too indefinite terms. Thus, in a case in which the defendant's particulars of objections alleged previous user of the invention by "*carriage-builders generally throughout Great Britain*," and also by "*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various others of the principal towns of Great Britain*," they were held to be insufficient. (*u*) On the other hand, an application which alleged the general user of an invention by a particular class of persons, consisting of lace makers at Nottingham, has been held to be sufficient. (*x*)

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but not too indefinite terms.

The Court will sometimes allow general words such as "amongst others," (*y*) or "amongst other instances," (*z*) to remain in the particulars of objections, but it will take care that the plaintiff shall not be taken by surprise at the trial. (*a*)

In one case the defendants by their particulars of objections alleged that the method described by the plaintiff in his specification had been in ordinary and common use for forty years prior to the date of the patent. In further answers to interrogatories they gave a description of the particular method they relied on to support their plea of general user. At the trial, evidence was given of another method which had been used at a large number of places, and which appeared to be a complete anticipation of the plaintiff's invention. The plaintiff objected that no particulars had been given of this, and asked that the case might stand over. *Kay*, J., held that the action must stand over, but at the plaintiff's risk as to costs, and that the defendants (whose

(*s*) Palmer *v.* Wagstaff, (1853) 8 Exch. 840; Jones *v.* Berger, (1843) 1 W. P. C. 547; Bentley *v.* Keighley, (1844) 7 M & G. 652; 8 Scott N. R. 372.

(*t*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, Ld., (1891) 8 R. P. C. 321.

(*u*) Morgan *v.* Fuller (No. 2), (1866) L. R. 2 Eq. 297.

(*x*) Jones *v.* Berger, (1843) 1 W. P. C. 549.

(*y*) Curtis *v.* Platt, (1863) 8 L. T. N. S. 657.

(*z*) Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

(*a*) Curtis *v.* Platt, (1863) 8 L. T. N. S. 657, judgment of Wood, V.C.

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witnesses had given many instances of this user) should be allowed to give particulars of further instances. The Judge refused an application to the effect that the plaintiff might have a certain time, after the delivery of the fresh particulars, to elect whether he would discontinue the action on paying costs up to the first delivery of particulars, but to get the subsequent costs. (*b*)

Specific prior users.

Where specific users are relied on the defendant is generally required to state the time and place of such users, (*c*) and to describe the thing alleged to have been used by a definite description, *e.g.*, by use of a *Wenham* lamp will not do, as that might be by any lamp made by *Wenham*. (*d*)

The particulars will be sufficient if they state definitely the kind of article, the prior sale, manufacturer, or user of which it is alleged anticipates the patent, the names of the alleged prior sellers, manufacturers, or users, and the dates. (*e*) The particulars must, however, state the mode in which the alleged prior user anticipates the invention. (*f*)

We have seen that the Act of 1852 required the particulars of objections, if prior user was relied on, to state "the place or places at or in which, and in what manner, the invention was alleged to have been used or published prior to the date of the letters patent;" (*g*) whereas the words of the Act of 1883 are to the effect that if one of the grounds on which the defendant disputes the validity of the patent is want of novelty he "must state the time and place of the previous publication or user alleged by him." (*h*)

In consequence of the similarity between the wording of these two statutes, the cases decided under the former are important, as bearing on the construction which will probably be placed on the latter enactment as occasion requires.

In *Flower* v. *Lloyd* (*i*) the Court of Appeal held that the particulars of objections could not be required to go beyond the words of the Act, and varied the order of the Court below,

(*b*) Pascall *v.* Toope, (1890) 7 R. P. C. 125.

(*c*) Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Boyd *v.* Horrocks, (1886) 3 R. P. C. 281; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 302; Philips *v.* Ivel Cycle Co., (1890) 7 R. P. C. 82; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17; Siemens *v.* Karo, (1891) 8 R. P. C. 376.

(*d*) Siemens *v.* Karo, (1891) 8 R. P. C. 376; Palmer *v.* Wagstaffe, (1853) 8 Ex. 840; Boyd *v.* Farrar, (1887) 5 R. P. C. 35; Sidebottom *v.* Fielden, (1891) 8 R. P. C. 272; Alliance Pure White Lead Syndicate *v.* MacIvor, (1891) 8 R. P. C. 321.

(*e*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*f*) Scott *v.* Hull Steam Fishing and Ice Co., (1896) 13 R. P. C. 206.

(*g*) p. 418 *ante*.

(*h*) s. 29 (3).

(*i*) (1877) 46 L. J. Ch. 746; 20 S. J. 860.

which required the defendants to state "the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which" the invention had been publicly practised in *England* before the date of the patent, by requiring the defendants to state "the place or places at or in which, and in what manner" the invention was known or publicly practised in *England* before the date of the patent. In pursuance of this order, the defendants delivered particulars alleging prior user by three persons, whose names and addresses were given, and by other persons in *Birmingham* and *London* respectively. On summons for better particulars, the Judge held them to be insufficient, and ordered the defendants to give the names and addresses of the other persons in *Birmingham* and *London* by whom the patented process had been previously used, and pointed out that if they could not give further information the words in italics were useless, and ought to be struck out.

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According to the practice under the Patents Act, 1883, as was the case under the Act of 1852, the plaintiff is entitled to the names and addresses (*i.e.*, the present residences) (*k*) of the persons by whom prior user was alleged to have been made, as well as the places where the prior user took place; (*l*) and, further, where the plaintiff or the defendant, as the case may be, makes out a proper case, the Court has jurisdiction to order interrogatories to be answered, notwithstanding the provision in the Act for the delivery of particulars. (*m*) The common practice is to ask for further and better particulars. (*n*) Where the defendants objected that there was a prior American patent which had been surrendered; that the invention had been published in certain journals of specified dates, and in sketches and drawings in the Patent Office Library; and also alleged prior user, it was held that better particulars ought to be given, specifying the date, name of patentee, and time of surrender of the alleged American patent, and the pages of the journals, also identifying the drawings, and the order as to prior user ought to be in the terms of *Flower* v. *Lloyd.* (*o*)

It is to be observed that the Act of 1852 required the *place*

Different requisites

(*k*) Palmer *v.* Cooper, (1853) 9 Exch. 236.

(*l*) Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629; General Electric Co., Ld. *v.* Safety Lift and Elevator Co., (1903) 21 R. P. C. 109.

(*m*) *Ibid.*

(*n*) See General Electric Co., Ld. *v.* Safety Lift and Elevator Co., (1903) 21 R. P. C. 114.

(*o*) Plimpton *v.* Spiller, (1877) 20 S. J. 859; see p. 422 *ante*.

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under Acts of 1852 and 1883 respectively.

and *manner*, &c., of prior publication to be stated in the particulars of objection, whereas the Act of 1883 requires a statement of the *time* and *place* of such prior publication. And it has been held that, if a defendant under the latter Act disputes the patent on the ground of want of novelty, he must state reasonably on what ground, in respect of want of novelty, he disputes it, and he must also state the time and place of the previous publications or user alleged by him. (*p*)

In *Curtis* v. *Platt*, (*q*) the particulars of objection, which were furnished under an order requiring a statement of "the place where, and the earliest date at which," certain alleged anticipating machines had been made, stated a list of thirteen persons and firms, and that, in all the cases, the user had been at the earliest from 1825 downwards; and, in answer to the contention that they ought to state in each instance the place at which the first machine had been made and the date of making, Lord *Hatherley*, then Vice-Chancellor *Wood*, ordered an amendment, on the ground that, as regarded the date of user and the place of user of the machines, the defendants were bound to give the plaintiff all the information they themselves possessed.

The defendants in this case were also ordered to amend an objection alleging prior publication in books, &c., with a mere general reference, by stating the particular work or document and the volume of that work in which the alleged prior publication was to be found. (*r*)

Requisites of a particular directed to publication by prior specifications or printed books.

A defendant who relies on prior specifications, (*s*) or printed books, (*t*) must point out, by reference to pages and lines, what portions of such specifications or books he relies on; (*u*) but it must be remembered that it is *primâ facie* for the defendant to say what portions he relies on, and against which of the plaintiff's claims each portion is to be used. (*x*) Where particulars of objection stated, with regard to a certain alleged anticipating specification, "the parts relied upon are the whole specification but more particularly" certain specified portions, an order was obtained requiring their amendment

(*p*) Fowler *v.* Gaul, (1886) 3 R. P. C. 247, 250; Boyd *v.* Horrocks, (1886) 3 R. P. C. 285; Darrah *v.* Purse, (1889) 6 R. P. C. 365.

(*q*) (1863) 8 L. T. N. S. 657.

(*r*) *Ibid.*

(*s*) Fowler *v.* Gaul, (1886) 3 R. P. C. 247.

(*t*) Harris *v.* Rothwell, (1886) 3 R. P. C. 243.

(*u*) See Grover and Baker Sewing Machine Co. *v.* Wilson, W. N. (1870) 78; Fisher *v.* Dewick, (1838) 1 W. P. C. 264; Plimpton *v.* Spiller, Higgins' Supplement, p. 79.

(*x*) See Edison-Bell Consolidated Phonograph, Ld. *v.* Columbia Phonograph Co., (1900) 18 R. P. C. 4.

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by striking out the words denoting reliance on the whole specification, but the defendant was held to be at liberty to specify other pages and lines beyond those already referred to. (*y*) A defendant is entitled to rely on the whole of a specification if necessary, and cannot be forced to point out special parts, unless it appears that no attempt at discrimination has been made. (*z*) When, however, specifications or other publications are relied on, and the whole is stated to be relied on, it is always in the discretion of the Court to see how far the defendant really does rely on the whole, and to order further particulars if it thinks fit; and each case must be considered on its own merits. (*a*) A defendant may be required to state in the particulars of objection, by means of a reference to the claiming clauses of the plaintiff's specification, what portion or portions of the invention or inventions, as the case may be, he alleges have been anticipated and published, (*b*) or have been the subject of a prior grant, (*c*) and he may be compelled to refer to pages and lines of any anticipating documents which he alleges as publications of any of the plaintiff's claims. (*d*)

Requisites of a particular directed to publication by a machine.

Where a specified machine was relied on, *Kay*, J., held it was not necessary to state which of the plaintiff's claims it infringed, as he must be taken to understand his own patent well enough to be able, when he saw the machine, to judge how far it was or was not an anticipation of his invention. (*e*) And objections which referred to certain specified machines as anticipations of particular claims in the specification were held sufficient, notwithstanding the fact that the owner of some of the machines refused to allow the plaintiff to inspect them, and the defendants were not sure whether some of the others were in existence. (*e*)

Requisites of a particular directed to insufficiency of specification.

If it be objected that the complete specification does not sufficiently describe and ascertain the invention and in what manner the same is to be performed, it is not sufficient for the particulars to state merely that the directions given are not

(*y*) Harris *v.* Rothwell, (1886) 3 R. P. C. 243.

(*z*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*a*) Siemens *v.* Karo, (1891) 8 R. P. C. 376.

(*b*) London and Leicester Hosiery Co. *v.* Higham, Lawson on Patents, 3rd ed. p. 610; Harris *v.* Rothwell, (1886) 3 R. P. C. 243; Fowler *v.* Gaul, (1886) 3 R. P. C. 247; Boyd *v.* Horrocks, (1886) 3 R. P. C. 258; Boyd *v.* Farrar, 5 R. P. C. 33, 36.

(*c*) Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co., (1900) 17 R. P. C. 277.

(*d*) Jones *v.* Berger, (1843) 1 W. P. C. 551 *n.*

(*e*) Boyd *v.* Farrar, (1888) 5 R. P. C. 33, 35.

Particulars of Objections.

sufficient to enable a workman skilled in the manufacture to which the patent relates to make a machine the subject of the invention, and if the defendant is in a position to give better particulars he must state in what respect the specification is insufficient. (*f*) But in a case under the Act of 1834 it was held that, if the plaintiff was content to accept as notice an objection that the specification was insufficient, any objection showing insufficiency at the trial might be taken. (*g*)

Also where the objection is that the specification is ambiguous and misleading it is necessary to state definitely in what respect it is alleged to be ambiguous and misleading. (*h*) Where the allegation is that the specification does not distinguish what is new from what is old the mere statement is sufficient. (*i*)

Greater detail is required under Act of 1883 than under the former practice.

The effect of the Act of 1883 and the recent cases is to require far greater detail in the particulars of objections than was formerly necessary, and particulars simply alleging that the specification does not describe the most beneficial method of practising the invention known to the patentee, (*k*) or that it is calculated to deceive, (*l*) or does not sufficiently set forth the nature of the invention, (*m*) or that the invention does not produce the effect stated, (*n*) which were held sufficient under the old practice, would most probably not be held so now.

Objection directed to non-payment of fees.

Under the practice prior to the Act of 1883, a defendant could, at the trial, take the objection that the patent was improperly stamped, without having raised it in the particulars. (*o*) It is, however, submitted that, if a defendant now desires to take the analogous objection that the patent is void for non-payment of duties, the particulars must refer to the fact.

(*f*) Crompton *v.* Anglo-American Brush Corporation, (1886) L. R. 35 Ch. D. 283; Leaf *v.* Topham, (1845) 14 M. & W. 146; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17; Heath *v.* Unwin, 1 W. P. C. 551 *n.*

(*g*) Neilson *v.* Harford, (1841) 1 W. P. C. 332.

(*h*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 391; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17.

(*i*) See, *e.g.*, Delta Metal *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C 170; Thomson *v.* Batty, (1888) 6 R. P. C. 88; Fisher *v.* Dewick, (1838) 1 W. P. C. 551 *n.*; Jones *v.* Berger, (1843) 5 M. & G. 208; Baker *v.* Kinnell, (1893) 9 R. P. C. 443.

(*k*) Jones *v.* Berger, (1843) 5 M. & G. 203; W. P. C. 546.

(*l*) Neilson *v.* Harford, (1841) 1 W. P. C. 324 *n.*

(*m*) Heath *v.* Unwin, (1842) 10 M. & W. 687.

(*n*) Jones *v.* Berger, (1843) 1 W. P. C. 551 *n.*

(*o*) Hindmarch on Patents, 438.

## Interlocutory Injunction.

Interlocutory Injunction.

If the plaintiff in a patent action, as is usually the case, desires to obtain an interlocutory injunction restraining the defendant from continuing the acts complained of, or commencing to commit threatened infringements, till the trial of the action, he ought to commence the action expeditiously on becoming aware of infringements or threats to infringe and apply to the Court, *ex parte*, or on notice, and in either case without delay. (*p*)

An application for an interlocutory injunction may be made to the Court or a Judge. (*q*) In the Chancery Division the usual course is to proceed by way of motion in Court, and in the King's Bench Division the usual course is to proceed by way of summons heard by the Judge in Chambers.

*Primâ facie* case must be established.

In order to obtain an interlocutory injunction it is necessary for the plaintiff, in addition to not being guilty of *laches*, to establish a *primâ facie* case of validity of the patent and of the fact of infringement. Where the plaintiff makes out a really strong *primâ facie* case upon these two points and is not guilty of *laches* an interim injunction is properly granted even though the defendant offers to keep an account. (*r*)

On an interlocutory application the Court avoids as far as possible expressing an opinion on the merits of the case, (*s*) and does not decide the question of validity unless the patent appears on the face of it so irretrievably and hopelessly bad that it could not possibly be supported. (*t*) The Court endeavours to keep things *in statu quo*. (*u*)

Former proceedings between the parties and a disputed compromise may constitute a bar to an interim injunction. (*x*)

Acquiescence.

Acquiescence is a bar to the right to an interim injunction. Thus, an interim injunction was dissolved by *Cottenham*, L.C., where it appeared that the plaintiff, about two years before he

(*p*) Bacon *v.* Jones, (1839) 4 My. & Cr. 436; Baxter *v.* Cooke, (1850) 1 Ir. Ch. R. 284; Bridson *v.* Benecke, (1849) 12 Beav. 1; Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Lister *v.* Norton, (1884) 1 R. P. C. 114; United Telephone Co. *v.* Equitable Telephone Co., (1888) 5 R. P. C. 235; Leonhardt *v.* Kellé, (1894) 11 R. P. C. 534.

(*q*) 46 & 47 Vict. c. 57, s. 30; Vol. II. p. 215.

(*r*) Dunlop Pneumatic Tyre Co. *v.* Hubbard Patents and Tyre Syndicate, Ld., (1902) 19 R. P. C. 546.

(*s*) Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*t*) Briggs *v.* Lardeux, (1884) 1 R. P. C. 126; Shillito *v.* Lannuth, (1885) 2 R. P. C. 1; Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38; Tadman *v.* Owens, (1894) 11 R. P. C. 349.

(*u*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 288.

(*x*) Roberts *v.* Graydon, (1903) 20 R. P. C. 578.

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applied to the Court, was aware that the defendants were at considerable expense in preparing and erecting apparatus for the purpose of using the patented invention, and never interfered to stop them, but permitted them to go on in the expectation that they would pay the royalties required.(*z*) Acquiescence also may at the trial of the action be a ground for granting damages instead of an injunction. (*a*)

The conduct of a plaintiff who knows of the existence of a patent of later date than his own for the same invention, but takes no steps to get it repealed, does not amount to acquiescence, unless the invention is actually put in practice under the subsequent patent. (*b*)

*Laches.*

Unexplained delay is a bar to an interlocutory injunction, both when the patent has not been previously contested (*c*) and when it has been established in prior proceedings. (*d*) In case of delay the defendant may be able to plead a growth of trade which would not have arisen but for the plaintiff's *laches*, and the Court will not interfere with it pending a final decision as to the validity of the patent and the fact of infringement. (*e*)

Thus, a plaintiff was held to be too late who applied on December 2 for an interim injunction in respect of infringement committed on November 13 and 23. (*f*)

And where the plaintiff knew in December what the defendant was doing, but did not move for an injunction till the following July, he was held too late, notwithstanding that he had obtained judgments by default in several earlier actions. (*g*) So, again, a plaintiff was too late where it appeared that he had known of the defendant's conduct for eleven months before moving. (*h*)

Delay in prosecuting a pending action.

Avoidable delay caused by the plaintiff in one pending action may be a sufficient ground for refusing an interlocutory

(*z*) Neilson *v.* Thompson, (1841) 1 W. P. C. 275, 285.

(*a*) Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

(*b*) Newall *v.* Wilson, (1852) 2 De G. M. & G. 282.

(*c*) Bacon *v.* Jones, (1839) 4 My. & Cr. 436; Baxter *v.* Coombe, (1850) 1 Ir. Ch. R. 284; Bridson *v.* Benecke, (1849) 12 Beav. 1, 3; Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Lister *v.* Norton, (1884) 1 R. P. C. 114; United Telephone Co. *v.* Equitable Telephone Co., (1888) 5 R. P. C. 235; Leonhardt *v.* Kallé, (1894) 11 R. P. C. 534; Dunlop Pneumatic Tyre Co. *v.* Pneumatic Tyre Co., (1897) 14 R. P. C. 263; Aluminium Co. *v.* Domeire, (1897) 15 R. P. C. 32.

(*d*) North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 21.

(*e*) *Ibid.* 17; p. 486 *post.*

(*f*) Greer *v.* Bristol Tanning Co., (1885) 2 R. P. C. 268.

(*g*) Edison-Bell Phonograph Corporation *v.* Hough, (1894) 11 R. P. C. 594; see also Actien Gesellschaft für Cartonagen Industrie *v.* Temler, (1899) 16 R. P. C. 447.

(*h*) Leonhardt *v.* Kallé, (1894) 11 R. P. C. 534.

injunction in subsequent actions where the defendants are willing to keep an account. (*i*)

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Delay may sometimes be satisfactorily explained.

Delay in some cases is capable of a satisfactory explanation, and then it is no longer a bar to the injunction.

Thus, where it appeared that the plaintiff had on several previous occasions established his patent, and there was a combination of persons against him interested in resisting his claims, in consequence of which he waited till he had established his patent again against one of the members of this combination before proceeding against the other members, his conduct was held to be no bar to an interlocutory injunction. (*k*)

Again, where the plaintiffs, in February, received notice from the solicitors to a company that the company was being formed for the purpose of manufacturing an article which might possibly be an infringement of the plaintiff's patent, and inspection was offered, the Court held that they were not too late in applying, in March, for an interlocutory injunction, the delay being sufficiently explained on the ground that they had been advised not to apply for it till the company had raised a substantial capital, and had actually commenced to manufacture the infringing article. (*l*) And an interim injunction was granted, when the plaintiff became aware of the infringement on March 23, but spent some time in making inquiries before giving the defendant notice to desist on May 8, and continued in correspondence with him till the bill was filed on July 7. (*m*)

A plaintiff is not to be held guilty of *laches* disentitling him to an interim injunction merely on the ground that the infringement was committed under the supposed protection of a patent, of the existence of which he had knowledge some time before the commencement of the action. (*n*)

Defendant working under a patent of his own.

But where a defendant contended that he was working under a patent of his own, which he maintained was valid, *Cottenham*, L.C., in refusing an interim injunction, said: "It would be rash in me if I were to give an opinion, coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If in a question so open to doubt as

(*i*) Welsbach Incandescent Gas Light Co. *v.* General Incandescent Co., (1901) 18 R. P. C. 533.

(*k*) Bovill *v.* Smith, (1867) W. N. 240.

(*l*) United Telephone Co. *v.* Equitable Telephone Association, (1888) 5 R. P. C. 233.

(*m*) Losh *v.* Hague, (1837) 1 W. P. C. 201.

(*n*) Osmund *v.* Hirst, (1885) 2 R. P. C. 265, 267.

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this I should interfere with the defendant I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiff. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering." (*o*)

Persons other than the defendant who could establish a case of *laches*.

Where as against the actual defendant there has been no *laches*, it cannot be contended in his favour that there are other persons or that the defendant even is merely the agent of such another person not a party to the action, who would have been able to establish a complete case of *laches* if the action had been brought against them or him.(*p*) But where the defendant is merely the customer of another, against whom there is a pending action in which an interlocutory injunction has been refused, on an undertaking to pay money into Court and keep an account, most probably the injunction will not be granted and the motion will be dismissed with costs on the ground that it ought not to have been made at all. (*q*)

*Ex parte* application for an interlocutory injunction.

The rule laid down by Lord *Eldon*, L.C., in *Hill* v. *Thompson*, (*r*) is that when an injunction is applied for *ex parte*, on the ground of violation of the rights to an invention secured by patent, it is incumbent on the party making the application to swear, at the time of making it, as to his belief that he is the original inventor; for, although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.

It is submitted that in the case of a plaintiff having a derivative title the above rule will be satisfied if he swears that in his belief the original patentee was the first and true inventor.

(*o*) Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157; 2 Coop. C. C. 41. See also Morgan *v.* Seaward, (1837) 1 W. P. C. 167; Muntz *v.* Vivian, (1840) 2 W. P. C. 87.

(*p*) Pneumatic Tyre Co. *v.* Warrilow, (1896) 13 R. P. C. 284.

(*q*) Pneumatic Tyre Co. *v.* Goodman, (1896) 13 R. P. C. 723.

(*r*) Hill *v.* Thompson, (1817) 1 W. P. C. 231; see also Sturtz *v.* De la Rue, (1828) 5 Russ. 322, 329; Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041; Whitton *v.* Jennings, (1860) 1 Dr. & Sm. 110; Mayer *v.* Spence, (1860) 1 J. & H. 87.

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Not only must a patentee applying for an *ex parte* injunction comply with the above-mentioned rule, but he must in all other respects exercise perfect good faith, and put the Court in possession of all the facts within his knowledge bearing on the question whether an injunction ought under the circumstances to be granted or not. (*s*)

Usual course on *ex parte* applications.

The Court does not commonly grant injunctions on *ex parte* applications, but the usual course is to make an order extending over a specified day, liberty being given to the applicant to serve short notice of motion for the day before that on which the order expires, and the applicant is required to give an undertaking to abide by the order of the Court as to any damages the defendant may be put to by reason of the interim order, such other terms being imposed upon him as the case may require. (*t*)

Validity of the patent is an important question on motion for interlocutory injunction.

The question of the validity of the patent, though not decided on an interlocutory application, is, and ought to be, an important consideration with the Court when determining whether or not to grant an interim injunction. (*u*)

*The Court will*, in the words of *Jessel*, M.R, "grant an injunction before the hearing, where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against himself, there is no reason to doubt the validity of the patent." (*x*)

If there is any *estoppel* against the defendant raising the question of the validity of the patent in the action, (*z*) of course it is treated as valid upon a motion for an interlocutory injunction.

Where the patent is recent and has not

The rule was laid down and acted upon previously to the Act of 1883, that an interim injunction will be refused where

(*s*) Dalglish *v.* Jarvie, (1850) 2 Mac. & G. 231; Curtis *v.* Cutts, (1839) 3 Jur. 34.

(*t*) Daniell's Chancery Practice, 6th ed. p. 1611; Moser *v.* Jones, (1893) 10 R. P. C. 368.

(*u*) Jackson *v.* Needle, (1884) 1 R. P. C. 174, 177; Bridson *v.* McAlpine, (1846) 8 Beav. 229, 230; Neilson *v.* Thompson, (1841) 1 W. P. C. 278.

(*x*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; S. C. 23 W. R. 464; see also Hill *v.* Thompson, (1817) 3 Mer. 622; S. C. 1 W. P. C. 229, 231; Universities of Oxford and Cambridge *v.* Richardson, (1806) 6 Ves. 689, 707; Stevens *v.* Keating, (1847) 2 W. P. C. 177; Hamar *v.* Plane, (1809) 14 Ves. 130; Bickford *v.* Skewes, (1837) 1 W. P. C. 211, 213; Electric Telegraph Co. *v.* Nott, (1847) 2 Coop. Ch. Cas. 41; Wilson *v.* Tindal, (1841) 1 W. P. C. 730; Renard *v.* Levinstein, (1864) 10 L. T. N. S. 34; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440.

(*z*) See p. 406 *ante*.

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been questioned an injunction is refused.

the patent is recent and its validity has not been established, (*a*) and this rule is still acted upon notwithstanding the investigation and protection afforded to the public by secs. 10 and 11 of the Act of 1883; (*b*) provided, of course, there is no *estoppel* preventing the question of the validity of the patent being raised *inter partes*. (*c*)

Presumption in favour of validity arises from long uninterrupted enjoyment.

An important factor is the strength of the presumption in favour of the validity of the patent. A presumption in favour of the validity of the patent may arise from long enjoyment, a prior action resulting in a declaration of validity, or other circumstances. Where there has been long enjoyment under a patent the presumption in favour of its validity is based on the consideration that it was in the power of anybody to have obtained the repeal of the patent by *scire facias* before 1884 and on petition for revocation since that date, yet no one has done so. (*d*)

Where it is established to the satisfaction of the Court that the plaintiff has been in long, active, (*e*) and uninterrupted (*f*) enjoyment of the patent, an interim injunction will be granted, notwithstanding that the validity of the patent may be doubtful; for if a party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; and possession under colour of title is ground enough to enjoin and to continue the injunction till it is proved that it is only colour and not real title; (*g*) provided that the enjoyment has been sufficiently long, and the patent is not on the face of it so irretrievably and hopelessly bad that it is clear it cannot be supported. (*h*)

Thus, where a patentee had been in possession of his exclusive privilege for several years, and a defect in the

(*a*) Caldwell *v.* Van Vlissengen, (1851) 9 Hare, 424; Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38; Jackson *v.* Needle, (1884) 1 R. P. C. 174, 177; Lister *v.* Norton, (1884) 1 R. P. C. 114; Holophane, Ld. *v.* Berend, (1897) 15 R. P. C. 19.

(*b*) Jackson *v.* Needle, (1884) 1 R. P. C. 117; Wapshare Tube Co. *v.* Hyde Imperial Rubber Co., (1901) 18 R. P. C. 374; Spencer *v.* Holt, (1902) 20 R. P. C. 144.

(*c*) See Wapshare Tube Co. *v.* Hyde Imperial Rubber Co., (1901) 18 R. P. C. 379.

(*d*) Stevens *v.* Keating, (1847) 2 W. P. C. 176; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440; Caldwell *v.* Van Vlissengen, (1851) Hare, 415, 424; Electric Telegraph Co. *v.* Nott, (1847) 2 Coop. Ch. Cas. 41; 46 & 47 Vict. c. 57, s. 26.

(*e*) See *supra*.

(*f*) *Ibid.*

(*g*) See judgment of Eldon, L.C., Universities of Oxford and Cambridge *v.* Richardson, (1806) 6 Ves. 706; Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Betts *v.* Menzies, (1857) 3 Jur. N. S. 357, 358; Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041.

(*h*) p. 433 *post*; Briggs *v.* Lardeur, (1884) 1 R. P. C. 126; Shillito *v.* Larmuth, (1884) 2 R. P. C. 1.

specification was suggested, the Court refused to allow the privilege to be disturbed until the question of title had been decided; (*i*) and an injunction has been granted in the face of a prior specification, which seemed to be fatal. (*k*)

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It is not necessary for the plaintiff, on motion for an interim injunction, to state that the patent has never been disputed, nor is the mere assertion that the patent is invalid sufficient to determine the Court to withhold the injunction. (*l*)

If the plaintiff relies on long enjoyment as entitling him to a presumption in favour of the validity of his patent on an application for an interim injunction, it is incumbent on him to show that he has actually used the invention. Thus, an injunction was refused where the plaintiff was only able to produce evidence of actual user at a recent period, notwithstanding that the patent was ten years old. (*m*)

It is also incumbent on the plaintiff to show that his enjoyment of the monopoly has been an uninterrupted one; (*n*) and it has been held that where the invention is of such a nature that it cannot be exercised without the licence of a prior patentee, the plaintiff's undisturbed enjoyment only commences from the expiration of the prior patent, and where this amounts to only one year the injunction must be refused. (*o*)

Length of uninterrupted active enjoyment sufficient to raise a presumption in favour of validity.

In regard to the length of uninterrupted and active enjoyment of the monopoly claimed under a patent which will establish a presumption in favour of the validity of the patent, and so entitle a plaintiff to an interim injunction, thirteen, (*p*) twelve, (*q*) eleven, (*r*) ten, (*s*) nine, (*t*) eight, (*u*) seven, (*x*) and six (*y*) years have, on different occasions, been held to be sufficient.

(*i*) Muntz *v.* Foster, (1843) 2 W. P. C. 93, 95.

(*k*) Losh *v.* Hague, (1837) 1 W. P. C. 201.

(*l*) Read *v.* Andrew, (1885) 2 R. P. C. 119, 122.

(*m*) Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*n*) Collard *v.* Allison, (1839) 4 My. & Cr. 487; Curtis *v.* Cutts, (1839) 8 L. J. N. S. Ch. 184; 2 Coop. C. C. 60; Hill *v.* Thompson, (1817) 3 Mer. 622.

(*o*) Hugh *v.* Magill, (1877) W. N. 62.

(*p*) Hamar *v.* Plane, (1809) 14 Ves. 130; Read *v.* Andrew, (1885) 2 R. P. C. 119; Stevens *v.* Keating, (1847) 2 W. P. C. 176.

(*q*) Neilson *v.* Thompson, (1841) 1 W. P. C. 277, 279.

(*r*) Wilson *v.* Tindal, (1841) 1 W. P. C. 730.

(*s*) Shillito *v.* Larmuth, (1884) 1 R. P. C. 1.

(*t*) Davenport *v.* Richard, (1865) 3 L. T. N. S. 503; Howes *v.* Webber, (1894) 11 R. P. C. 586.

(*u*) Betts *v.* Menzies, (1857) 3 Jur. N. S. 357; L. R. 3 Eq. 312.

(*x*) Stevens *v.* Keating, (1847) 2 W. P. C. 176; Osmond *v.* Hirst, (1885) 2 R. P. C. 265.

(*y*) Rothwell *v.* King, (1886) 3 R. P. C. 379; Bickford *v.* Skewes, (1837) 1 W. P. C. 211, 213; Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94.

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Three years were held sufficient under circumstances from which it appeared that, previously to the grant of the patent, many inventors had been endeavouring to obtain the result achieved by the patentee, who had since the grant sold, at considerable profits, numerous articles manufactured according to the invention without his monopoly being previously questioned; (*z*) though where the plaintiff's patent was three years old, but the works enabling him to carry on operations under it were not completed till one year before Bill filed, the injunction was refused. (*a*)

Where a patent was only two years old at the commencement of an action an interim injunction was obtained, but afterwards it was dissolved by the Lords Justices on appeal, *Knight Bruce*, L.J., saying, in reference to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant, in such a case, at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." (*b*) And in a more recent case two years' uninterrupted enjoyment was held insufficient to warrant the granting of an interlocutory injunction. (*c*)

Again, where a patent was a recent one and the only question as to its validity was one founded on an objection to the sufficiency of the specification, and it was proved that a competent workman, with no other assistance than the specification, could work the invention, an interlocutory injunction was refused. (*d*)

A patent which has been established is regarded as valid in an interlocutory application.

Where the validity of the patent has been established on previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application, regard its validity as sufficiently established by the previous proceedings to warrant the grant of an interim injunction, (*e*) if the infringement is clear, (*f*) or there is a

(*z*) Wheatstone *v.* Wilde, (1861) Griff. P. C. 247.

(*a*) Hill *v.* Thompson, (1817) 1 W. P. C. 232; 3 Mer. 622; see also Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 37.

(*b*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 177.

(*c*) British Tanning Co. *v.* Groth, (1889) 7 R. P. C. 1.

(*d*) Coles *v.* Baylis, (1886) 3 R. P. C. 178.

(*e*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440; Davenport *v.* Goldberg, (1865) 2 H. & M. 282; Nowall *v.* Wilson, (1852) 2 De G. M. & G. 282; Bovill *v.* Smith, (1867) W. N. p. 240; Bovill *v.* Goodier, (1866) L. R. 2 Eq. 200.

(*f*) Hayward *v.* The Pavement Light Co., (1884) 1 R. P. C. 207.

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*primâ facie* case of infringement, (*g*) and this notwithstanding that the defendant disputes the validity of the patent on a ground not raised in any of the previous proceedings. (*h*)

Where the plaintiff has established the validity of the patent but there is an appeal pending to the Court of Appeal or House of Lords, the Court considers the validity as established on the hearing of a subsequent motion for an interlocutory injunction; and the injunction may be obtained notwithstanding that the defendant offers to pay royalties pending the appeal. (*i*)

If it could be established to the satisfaction of the Court that the judgment in favour of the patent in a prior action was wrongly obtained, this fact would no doubt induce the Court to depart from the usual course of treating the question of validity as established; (*k*) though it has been held that a certificate of validity given in a prior action in which judgment was obtained by default or consent is ground for treating the validity as established on subsequent motion for interlocutory injunction. (*l*)

The fact that a plaintiff has succeeded in obtaining an interdict of a Scotch Court restraining a prior infringement in Scotland is sufficient *primâ facie* evidence of the validity of the patent to justify the grant of an interim injunction against a subsequent infringement in England. (*m*)

Where a patent had been the subject of an arbitration at the request of parties to a former action, and the arbitrator had given his award in favour of its validity, the Court, in a subsequent action of infringement against the same defendant, considered the patent sufficiently established by the arbitrator's award, and granted an interlocutory injunction. (*n*)

An interim injunction may be granted in a subsequent action, where it is shown by the plaintiff that he has established his patent on a former occasion, though against a different defendant; but the subsequent defendant will at the trial be in no way bound by the previous decision, and may contest the patent anew on the same or different evidence,

(*g*) Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 *n.*

(*h*) Newall *v.* Wilson, (1852) 2 De G. M. & G. 282; 19 L. T. 161; Heine *v.* Norden, (1904) 21 R. P. C. 513.

(*i*) Moser *v.* Sewell, (1893) 10 R. P. C. 365; Moser *v.* Jones, (1893) 10 R. P. C. 368.

(*k*) Pneumatic Tyre Co. *v.* Marwood, (1896) 13 R. P. C. 347.

(*l*) Edison-Bell Phonograph Corporation *v.* Bernstein, (1897) 14 R. P. C. 153.

(*m*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Stevens *v.* Keating, (1847) 19 L. J. N. S. Ex. 57; 2 W. P. C. 176, 177.

(*n*) Lister *v.* Eastwood, 26 L. T. 4.

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and he cannot be compelled to do so by presenting a petition for its revocation. (*o*) It is submitted that in such a case the Court will consider itself bound as to the interpretation of the specification by the construction put upon it by a Court of equal or superior jurisdiction. (*p*)

Interlocutory injunctions are usually refused where there is a real doubt as to infringement.

An interlocutory injunction is granted when the Court is satisfied that what the defendant has done, or threatens to do, is a mere invasion of the plaintiff's established right, and there is no *laches*. (*q*) Also when the sole question between the parties is the validity of the patent, (*r*) and there is a strong presumption or case in its favour; (*s*) but it is usually refused if there is a real doubt as to the fact of infringement considered apart from the question of title. (*t*)

Degree of the doubt as to infringement is an important factor.

In cases where there is not a strong *primâ facie* case upon the point of validity and also upon the point of infringement, it depends on the degree of doubt whether or not an injunction will be granted; and the Court will consider the degree of convenience or inconvenience to the parties caused by granting or refusing the injunction. (*u*) Thus, though there is a *bonâ fide* doubt as to infringement and the trade of the defendants is a new one likely to lead to the sale of a large number of the alleged infringing articles, it is more convenient, and less likely to produce irreparable damage, to stop him by injunction from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers; (*x*) and where there is evidence of long enjoyment, and consequently *primâ facie* evidence of title which

(*o*) Bovill *v.* Goodier (No. 2), (1866) L. R. 2 Eq. 195; Russell *v.* Barnsley, (1834) 1 W. P. C. 472; 2 Coop. Ch. Cas. 58; *but see* Davenport *v.* Goldberg, (1865) 2 H. & M. 286.

(*p*) Edison *v.* Holland, (1889) 6 R. P. C. 243, 249, 276; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; Patent Exploitation, Ld. *v.* American Electrical Novelty and Manufacturing Co., Ld., (1903) 20 R. P. C. 296; 22 R. P. C. 316; p. 469 *post*.

(*q*) Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 *n.*; Pneumatic Tyre Co. *v.* Warrilow, (1896) 13 R. P. C. 288.

(*r*) Neilson *v.* Thompson, (1841) 1 W. P. C. 277; Stevens *v.* Keating, (1847) 2 W. P. C. 179; Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157.

(*s*) p. 432 *ante*.

(*t*) Stevens *v.* Keating, (1847) 2 W. P. C. 177; Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157; Wood *v.* Cockerill, (1889) 2 Coop. Ch. Cas. 53; Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*u*) Bridson *v.* McAlpine, (1846) 8 Beav. 230; Thompson *v.* Hughes, (1890) 7 R. P. C. 71; Neilson *v.* Thompson, (1841) 1 W. P. C. 278; Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 290; see also Elwes *v.* Payne, (1870) L. R. 12 Ch. D. 468; Brooks *v.* Lycett's Saddle and Motor Accessories Co., Ld., (1903) 20 R. P. C. 575.

(*x*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286, 292; but see North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 17, where the defendant pleaded laches *plus* growth of his trade.

ought to be respected, (*y*) the Court will not consider the injury to the defendant, but will protect the plaintiff from the possible consequences of the market being flooded with articles manufactured in infringement of his patent, supposing him to be able to sustain it. (*z*) If it appears that an interim injunction would seriously prejudice the defendant, and not benefit the plaintiff, it will be refused. (*a*)

Interlocutory Injunction.

To obtain an injunction on an interlocutory application it is sufficient to show one clear instance of infringement, (*b*) or to make out a *primâ facie* case; (*c*) and the Court of Appeal is slow to interfere with the discretion of a Judge of first instance who is satisfied as to the existence of a *primâ facie* case. (*d*)

Affidavits made from information and belief should show the source of such information and belief, otherwise they will not have much weight with the Court, and will not be of much material help to the plaintiff in making out the necessary *primâ facie* case of infringement. (*e*)

Affidavits made from information and belief.

Where the defendant admitted that he had exhibited machines which to some extent were or had been infringements of the plaintiff's patent, the Court granted an injunction in general terms, but left open the question as to the particular machines. (*f*)

Although the Court has the power to grant an interlocutory injunction *simpliciter*, (*g*) it is the invariable practice not to do so, but to bind the plaintiff in an undertaking to indemnify the defendant, if it should ultimately turn out that the patent is bad and that the injunction ought, therefore, not to have been granted; (*h*) and the undertaking is equally required

Indemnity on behalf of the defendant is required from the plaintiff when an interlocutory injunction is granted.

(*y*) Stevens *v.* Keating, (1847) 2 W. P. C. 177; p. 432 *ante*.

(*z*) Davenport *v.* Jepson, (1862) 4 De G. F. & J. 448; Hamar *v.* Plane, (1809) 14 Ves. 130; Stevens *v.* Keating, (1847) 2 W. P. C. 177.

(*a*) Neilson *v.* Thompson, (1868) 1 W. P. C. 275, 286; Morgan *v.* Seaward, (1837) 1 W. P. C. 167; Thomson *v.* Hughes, (1890) 7 R. P. C. 71.

(*b*) United Telephone Co. *v.* Sharples, (1885) L. R. 29 Ch. D. 164, 169.

(*c*) Briggs *v.* Lardeur, (1884) 1 R. P. C. 128; Shillito *v.* Larmuth, (1885) 2 R. P. C. 1, 3; Anderson *v.* Patent Oxonite Co., Ld., (1886) 3 R. P. C. 279.

(*d*) Baker *v.* White, (1884) 1 Times R. 64.

(*e*) Saccharin Corporation *v.* The Chemical Dye and Drugs Co., (1898) 15 R. P. C. 53; *Re* The Young Manufacturing Co., [1900] 2 Ch. D. 753; Badische Anilin und Soda Fabrik, (1902) 19 R. P. C. 502.

(*f*) Edison-Bell Phonograph Corporation *v.* London Phonograph Co., (1894) 11 R. P. C. 193.

(*g*) Bacon *v.* Jones, (1839) 4 M. & C. 436; Wilson *v.* Tindal, (1841) 1 W. P. C. 730; Bickford *v.* Skewes, (1837) 1 W. P. C. 214; Tuck *v.* Silver, John. 218.

(*h*) Chappell *v.* Davidson, (1856) 8 D. M. & G. 1; Tuck *v.* Silver, John. 218; Wakefield *v.* Duke of Buccleuch, (1865) 11 Jur. N. S. 523; Graham *v.* Campbell, (1877) L. R. 7 Ch. D. 490; Muntz *v.* Greenfell, (1842) 2 W. P. C. 91; 2 Coop. Ch. Cas. 59; Moser *v.* Sewell, (1893) 10 R. P. C. 366; Moser *v.* Jones, (1893) 10 R. P. C. 368.

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where the patent has been established on former occasions, as where there has been no previous contest. (*i*)

Unexplained and unreasonable delay in making an application to enforce the undertaking to be answerable in damages induces the Court to refuse the application; (*k*) but the undertaking is not put an end to by the discontinuance, (*l*) or dismissal, (*m*) of the action.

The undertaking can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge; (*n*) and it may be entered into by, (*o*) and enforced against, a married woman. (*p*)

Inability on the part of the defendant to satisfy the plaintiff's claim.

Inability on the part of the defendant to satisfy the plaintiff's claim for damages in the event of defeat is a consideration which induces the Court to grant an interlocutory injunction. (*q*) Such presumption of inability may arise, for instance, from the fact that a defendant company is in liquidation. (*r*) If the defendant does not appear the injunction may be granted on affidavit as to validity, on the ground that the defendant not appearing the plaintiff may not be able to get an account. (*s*)

The motion is usually ordered to stand over till the trial if there is an independent case against an interlocutory injunction being granted.

Where there is an independent case, on any ground, against an interlocutory injunction being granted, the Court considers it better to order the motion to stand over till the trial, if the defendant asks for it, because, although when the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action; yet, where there is an independent case against a motion, so that the defendant may say, "If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any view to unnecessary expense," it is better, then, to order the motion to stand to the trial, without prejudice to any question. (*t*)

(*i*) United Telephone Co. *v.* Taskar, (1888) 5 R. P. C. 628, 633; Bovill *v.* Smith, (1867) W. N. 210.

(*k*) *Ex parte* Hall, (1883) L. R. 23 Ch. D. 644.

(*l*) Newcomen *v.* Coulson, (1877) L. R. 7 Ch. D. 764.

(*m*) Newby *v.* Harrison, (1861) 3 De G. F. & J. 287; Graham *v.* Campbell, (1877) L. R. 7 Ch. D. 490.

(*n*) Griffith *v.* Blake, (1884) L. R. 27 Ch. D. 474; Rothwell *v.* King, (1887) 4 R. P. C. 76.

(*o*) *Re* Prynce, (1885) W. N., p. 144.

(*p*) Hunt *v.* Hunt, (1884) 54 L. J. Ch. 289.

(*q*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 291; Nowall *v.* Wilson, (1852) 2 G. M. G. 282.

(*r*) Welsbach Incandescent Gas Light Co. *v.* Vulcan Incandescent Light Syndicate, (1901) 18 R. P. C. 279.

(*s*) Clarke *v.* Nichols, (1895) 12 R. P. C. 310.

(*t*) Per Chitty, J., Lister *v.* Norton, (1884) 1 R. P. C. 116.

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And in some circumstances—*e.g.*, where the patentee has agreed with the defendant not to oppose any company formed for the purpose of purchasing his invention—the Court will order the motion to stand to the trial notwithstanding that the defendant refuses to give an undertaking to keep an account.(*u*)

When an interlocutory injunction is refused the defendant is usually ordered to keep an account.

When an interim injunction is refused, either on the ground that the infringement is doubtful, or on the ground of delay, (*v*) the usual course is to order the defendant to keep an account. (*x*)

This order for an account may be made in different forms, as the circumstances of the case may require. (*y*)

In *Neilson* v. *Thompson*, the account was for the past as well as from the commencement of the infringement. (*z*) But in *Vidi* v. *Smith* (*a*) the Court held that a retrospective account should not be granted till final judgment. This is the most general form in which the order is made; (*b*) though in *Plimpton* v. *Malcolmson*, (*c*) and *Russell* v. *Cowley*, (*d*) the account was of "all moneys received or to be received" by the sale of the patented articles, and in *Beardsell* v. *Schwann* (*e*) the account was of the articles only. (*f*) In *Pneumatic Tyre Co.* v. *Friswell* (*g*) the defendant refusing to keep an account for fear of admitting the validity of the patent, the order was prefaced with the words "the defendant not admitting the validity, but on the other hand contending that the patent is invalid."

An interim injunction is not often granted when the defendant voluntarily offers to keep an account and the Court is satisfied that he will be sufficiently able to satisfy any claim the plaintiff may ultimately succeed in establishing against him; (*h*) or where the defendant offers not to use the alleged infringing article till trial, or further order. (*i*)

(*u*) British Tanning Co. *v* Groth, (1889) 7 R. P. C. 1.

(*v*) Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Neilson *v.* Thompson, (1841) 1 W. P. C. 286; Lister *v.* Norton, (1884) 1 R. P. C. 114.

(*x*) *Ibid.*; Bacon *v.* Jones, (1839) 4 My. & Cr. 436; Jackson *v.* Needle, (1884) 1 R. P. C. 176; Hill *v.* Thompson, (1817) 1 W. P. C. 232; 3 Mer. 662; Morgan *v.* Seaward, (1837) 1 W. P. C. 169.

(*y*) For common form of order, see Seton, 4th ed. p. 344.

(*z*) 1 W. P. C. 286.

(*a*) 3 E. & B. 969.

(*b*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286.

(*c*) Seton, 4th ed. p. 344.

(*d*) 1 W. P. C. 458.

(*e*) Seton, 3rd ed. p. 910.

(*f*) Hill *v.* Thompson, (1817) 3 Mer. 626; Jackson *v.* Needle, (1884) 1 R. P. C. 176.

(*g*) (1895) 13 R. P. C. 15.

(*h*) Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041; Copeland *v.* Webb, (1862) 11 W. R. 134; Jackson *v.* Needle, (1884) 1 R. P. C. 174; Lister *v.* Norton, (1884) 1 R. P. C. 114.

(*i*) Lyon *v.* Mayor, &c., of Newcastle-upon-Tyne, (1894) 11 R. P. C. 218.

Discovery.

Action not prosecuted with due diligence.

If the plaintiff does not prosecute the action with due diligence after obtaining an interim injunction, the defendant may apply to have the injunction dissolved. (*j*)

Order as to payment of money out of Court.

In the event of the defendant paying money into Court and the plaintiff being successful in the action the proper course is for the Court to order the money to remain in Court to abide the result of the inquiry as to damages, or the taking of the account and to be paid out to the plaintiff, or so much thereof as the plaintiff shall show he is entitled to. (*k*)

## Discovery and Inspection.

Interrogatories

**Discovery.**—Notwithstanding that in patent actions particulars must be delivered by both the plaintiff and the defendant, (*l*) either party may, by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties, provided that interrogatories which do not relate to any matters in question in the action shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness. (*m*)

must be limited to facts enabling the interrogating party to prove his case.

Interrogatories must be limited to facts, and an interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to administer interrogatories which inquire into the opposite parties' evidence, (*n*) nor is he entitled to answers to irrelevant questions (*o*)—*e.g.*, as to certain unsuccessful proceedings abroad for the infringement of a foreign patent in the possession of the plaintiff; (*p*) but in one case the plaintiff was ordered to answer as to the terms of a compromise in another action as being material. (*q*) Consequently, if the particulars of breaches are sufficient, the plaintiff will not be compelled to answer further questions as to the alleged infringements. (*r*)

(*j*) Stevens *v.* Keating, (1847) 2 W. P. C. 175.

(*k*) North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 17.

(*l*) 46 & 47 Vict. c. 57, s. 29.

(*m*) R. S. C. (1883) Order xxxi. r. 1; General Electric Co. (1900), Ld. *v.* Safety Lift and Elevator Co., (1903) 21 R. P. C. 109; Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629; Haddan's Patent, (1884) 54 L. J. N. S. Ch. 126; Finnigan *v.* James, (1874) L. R. 19 Eq. 72; Crossby *v.* Tomey, (1875) L. R. 2 Ch. D. 533; Saunders *v.* Jones, (1877), L. R. 7 Ch. D. 449.

(*n*) Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 169.

(*o*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 37; Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673; R. S. C. (1883) Order xxxi. r. 6.

(*p*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673, 679.

(*q*) Betts *v.* Neilson, W. N. (1866) p. 170.

(*r*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673, 679.

Discovery.

Thus the owner of letters patent for mechanical musical instruments brought an action for alleged infringement against the defendants, and delivered particulars of breaches, in which he complained generally of the infringement of the first claiming clause of the specification, and "in particular and by way of illustration" of a specific article sold by the defendants. The defendants delivered particulars of objections which alleged (*inter alia*) that the alleged invention was not the subject of a patent, but the new application of old machinery to an analogous purpose; that, as disclosed by the specification, it did not make any useful addition to the existing stock of public knowledge; and that the specification did not sufficiently distinguish the new from the old. The defendants also delivered interrogatories which in effect asked the plaintiff to admit the truth of the above-mentioned objections, or to state how he made them out not to be true. The plaintiff having declined to answer these interrogatories, the defendant took out a summons to compel him to do so. The summons was adjourned into Court, and the plaintiff, then consenting to answer the interrogatories as to subject-matter, and to amend the particulars of breaches by omitting the words "by way of illustration," it was held that no further answer should be ordered. (*s*)

The Court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case. (*t*) Thus, where the only plea raised by the defence was that the plaintiff was not the true and first inventor, the defendant was allowed to refuse to answer interrogatories as to the accuracy of the specification, the novelty of the process, and the fact of the infringement. (*u*)

Fishing interrogatories are not allowed.

Fishing interrogatories, which merely help one party to get at the other's evidence and see what he can make of it, are not allowed—*e.g.*, a plaintiff is not allowed to ask a defendant to state the names of the persons to whom he alleges he sold articles similar to the plaintiff's before the date of the patent; (*x*) though he may be required to state whether alleged anticipating machines mentioned in his objections are in existence, and the names and addresses of alleged prior users. (*y*)

(*s*) Ehrlich *v.* Ihlee, (1887) 5 R. P. C. 37.

(*t*) Bidder *v.* Bridges, (1885) L. R. 29 Ch. D. 29, 34.

(*u*) Young *v.* White, (1853) 17 Beav. 532.

(*x*) Daw *v.* Eley, (1865) 2 H. & M. 725.

(*y*) Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629.

**Discovery.**

Plaintiff and defendant have an equal right to discovery.

It has been stated that interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim. (*z*) This statement must, however, be taken as having been made in the first instance in reference to a particular case, and must not be taken as establishing the proposition that the defendant has a larger right of discovery than a plaintiff. No such proposition can be upheld in the face of the authorities which, on the contrary, establish that the rights of both plaintiff and defendant are equal in respect of discovery, *i.e.*, either party is entitled to a discovery of such material facts from the other as will enable him to make out *his case*, and not to a discovery of facts which relate exclusively to the manner in which the case of the other party is to be established, or to the evidence which relates exclusively to that case. (*a*)

Discovery which is a matter of indifference to the party against whom it is sought, or cannot help the interrogating party.

Where discovery is a matter of indifference to the party against whom it is sought, the Court does not weigh carefully the question of materiality or immateriality; still, where the nature of the discovery required is such that the giving of it may be prejudicial to such party, the Court takes into consideration the special circumstances of the case; on the one hand it takes care that the party desiring discovery obtains all which can be of use to him, on the other it protects the opposite party against undue inquisition into his affairs. (*b*)

And when a defendant's answer to an interrogatory cannot help the plaintiff to obtain a decree, but will only be of use to him if he obtains a decree, the Court has a discretion whether to oblige the defendant to answer before trial, and will not do so when compelling such discovery would be oppressive. (*c*) Thus, if the defendant denies infringement, but admits the possession of the infringing articles, he will not be compelled

(*z*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. 673; Lowndes *v.* Davies, (1834) 6 Sim. 468; Commissioners of Sewers *v.* Glasse, (1873) L. R. 15 Eq. 302.

(*a*) Bray on Discovery, pp. 467 and 468; Bovill *v.* Smith, (1866) L. R. 2 Eq. 459; Daw *v.* Eley, (1865) 2 H. & M. 725; Bidder *v.* Bridges, (1885) L. R. 29 Ch. D. 34, judgment of Kay, J.

(*b*) Moore *v.* Craven, (1874) L. R. 7 Ch. App. 94, 96; Simpson *v.* Charlesworth, (1866) W. N. p. 255; Daw *v.* Eley, (1865) 2 H. & M. 725; Rolls *v.* Isaacs, (1878) W. N. 37; Crossley *v.* Stewart, (1863) 1 N. R. 426; S. C. 7 L. T. N. S. 848; Craver *v.* Pinto Leite, (1871) 7 Ch. App. 90, 97; Orr *v.* Diaper, (1876) L. R. 4 Ch. D. 92.

(*c*) Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477; Swabey *v.* Sutton, (1863) 1 H. & M. 514; Fennesey *v.* Clark, (1888) L. R. 37 Ch. D. 184; Lister *v.* Norton, (1885) 2 R. P. C. 68; Bray on Discovery, p. 553.

to answer interrogatories which seek an account of all such articles in his possession, as well as discovery as to the purchase or hire of them, and an account of sales and profits. (*d*) Discovery.

Where a party interrogates as to facts tending to enable him to prove a particular issue, the party giving discovery will not be excused from answering fully on the ground that such answers cannot be of use to the party seeking it, if he fails to prove some other issue. (*e*)

The limitation as to answering interrogatories applies only to those relating to matters which depend on the part (or it may be the whole) of the case which will become immaterial if the case be not established, or are of such a nature that the party seeking the discovery is not entitled to it till his case is established by the judgment of the Court (*f*)—*e.g.*, where infringement is admitted and discovery is sought of the sales and profits made by trafficking in the infringing articles. (*g*) It does not protect a defendant who denies the plaintiff's title *in toto*, or alleges that the patent is invalid, from answering fully all interrogatories which are material. (*h*)

Subject to the above limitations, the old fixed and rigid rule that "he who answers at all must answer fully," guides the Court in deciding whether any particular answers given are sufficient, or whether any particular interrogatories are allowable or not. (*i*) Rule that "he who answers at all must answer fully."

In the event of the Court or a Judge granting leave to any party to administer interrogatories to any other party or parties the costs must in the first instance be secured by the party seeking such discovery in the manner prescribed by the Supreme Court Rules, 1883. (*k*) Cost of interrogatories must be secured.

As in the case of inspection, (*l*) so, when discovery is sought, if the party from whom it is sought objects to it or any part thereof, the Court or a Judge may, if satisfied that the right to the discovery sought depends on the determination of any issue or dispute in the cause, or that for any other reason it Objection on the ground that the right to discovery depends on the prior decision of an issue.

(*d*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 388; Rolls *v.* Isaacs, (1878) W. N. p. 37; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184.

(*e*) Foxwell *v.* Webster, (1863) 2 Dr. & Sm. 250.

(*f*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 391; Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477; Lister *v.* Norton, (1885) 2 R. P. C. 68.

(*g*) *Ibid.*

(*h*) Swinborne *v.* Nelson, (1852) 16 Beav. 416; Foxwell *v.* Webster, (1863) 3 N. R. 103; 9 Jur. N. S. 1189.

(*i*) Swinborne *v.* Nelson, (1852) 16 Beav. 416; Elmer *v.* Creasy, (1873) L. R. 9 Ch. App. 69; Saull *v.* Browne, (1874) L. R. 9 Ch. App. 364; Lister *v.* Norton, (1885) 2 R. P. C. 68.

(*k*) Order xxxi. rr. 25, 26, 27.

(*l*) p. 452 *post.*

Discovery.

is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the discovery, order that such issue or question be determined first, and reserve the question as to discovery. (*m*)

The Court under this rule will not in the exercise of its unfettered discretion allow a defendant to postpone answering questions as to facts which go to establish infringement till after the issue of validity is determined. (*n*)

Thus, where the plaintiff framed interrogatories on statements contained in the specification of his patent and asked the defendant step by step if he ever used the processes therein described, and the defendant after answering some of the interrogatories refused to answer others on the ground that the discovery sought depended on the determination of the question at issue—viz., the validity of the patent—and that the matters inquired into were not material at that stage of the action and were a trade secret, the Court held the defendant had shown no sufficient reason for his refusal to answer and made an order for further and better answers. (*o*)

Trade secrets and discovery.

As in the case of inspection (*p*) so with regard to discovery, the fact that the particular discovery sought would lead to the disclosure of the trade secrets of the opposite party will not deter the Court from granting it, if it is necessary in the interests of justice to enable the applicant to establish his case.

In such cases the Court endeavours, where possible, to protect the party compelled to disclose trade secrets, and will not order discovery beyond what is necessary to prove the case of the party seeking it.

Thus, where a defendant denied having infringed a patent for "improvements in preparing colouring matters for dyeing and colouring," although he was compelled to answer interrogatories as to whether he used certain ingredients mentioned in the specification, whether he added anything else, and whether the additions made any difference in the process, yet he was not obliged to disclose the nature and quantities of the additions. (*q*)

At the hearing of another case against the same defendant,

(*m*) R. S. C. (1883) Order xxxi. r. 20.

(*n*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136; Ashworth *v.* Roberts, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; Rawes *v.* Chance, (1890) 7 R. P. C. 275.

(*o*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136.

(*p*) p. 452 *post*.

(*q*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94.

evidence as to the defendant's secret process was taken *in camerâ*, and the Judge ordered the shorthand notes and all the printed copies thereof to be sealed up and impounded in Court until there should be an appeal, in which case the parties were to be at liberty to apply for the delivery out of Court of as many copies as they should want, or until, either by lapse of time or otherwise, it should be determined that there was to be no appeal, in which case any application might be made to the Court for the disposal of them as the parties should think fit. (*r*) Discovery.

There is, however, no hardship on the defendant in requiring him to state whether he has done what the specification says is to be done. If he answer No, but he has done something slightly different which might possibly be construed as an infringement, but which is a trade secret, the Court has ample power to protect the undue disclosure of such secret. (*s*)

Communications between a patentee and his patent-agent relative to the preparation of the specification are not privileged, and the patentee may be required to refer to them in answering interrogatories as documents in his possession. Thus, where the defendant interrogated the plaintiff as to documents in his possession relating to the preparation of the specification and the plaintiff refused to answer, stating as a reason for his refusal that the documents were confidential communications between himself and his solicitor (who was also his patent-agent) and counsel, the Court decided that the answer was insufficient, as not distinguishing communications between the plaintiff and his solicitor, and communications between him and his patent-agent, the former class of communications alone being privileged. (*t*) Communications between a patentee and his patent-agent.

And where an action was commenced in respect of the infringement of two patents for similar inventions, but discontinued as to one of such inventions, the plaintiff was nevertheless required to answer interrogatories as to communications relative to that patent between himself and his patent-agent, on the ground that such answer might be material to the validity of the patent for the other cognate invention. (*u*)

(*r*) Badische Anilin und Soda Fabrik v. Levinstein, (1883) L. R. 24 Ch. D. 176.

(*s*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 139.

(*t*) Moseley *v.* Victoria Rubber Co., (1886) 3 R. P. C. 351.

(*u*) *Ibid.*

Discovery.

Construction of documents.

Neither a plaintiff (*x*) nor a defendant (*y*) can be compelled to put a construction on the specification in answer to interrogatories.

When complete answer cannot be given without an ocular demonstration.

When a defendant, in answer to an interrogatory asking whether or not he was making articles identical with those manufactured by the plaintiff under the patent, and requiring him to state in what respects his articles differed from the plaintiff's, stated that he had for many years before the date of the patent applied to the articles in question the same treatment as was described in the specification, and that he now made articles which, save so far as his own method or process, adopted before the patent, was similar to that described in the specification of the plaintiff's patent, differed from the articles there described, but that it was impossible, without ocular demonstration, to show in what they differed, he was held to have given a sufficient answer. (*z*)

Names and addresses of alleged prior users.

When a defendant alleges prior user generally in a certain district he may be compelled to give the names and addresses of the manufacturers and the places and dates of user. (*a*)

Disclosure of processes used by an alleged infringer.

Where infringement has been alleged, anything showing, or tending to show, the fact of infringement may be required to be set out in answer to interrogatories. (*b*) Thus, where a plaintiff had been successful in actions against infringers and brought a subsequent action against another infringer, the defendant was compelled to answer whether the process used was the same as that used by one of the prior infringers; (*c*) and where the defendants denied infringement they were compelled to state, in answer to interrogatories, where they first manufactured, and to whom by name they first sold any, and what quantity, of the articles alleged by the plaintiff to be infringements, and by what process they were manufactured. (*d*)

Names and

Where infringement is admitted, the plaintiff is entitled to

(*x*) Wenham Co. *v.* Champion Gas Co., (1890) 8 R. P. C. 22.

(*y*) Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 169.

(*z*) Crossley *v.* Tomey, (1876) L. R. 2 Ch. D. 533; see also Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 227; 6 E. & B. 405.

(*a*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, (1891) 8 R. P. C. 321.

(*b*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 391; Lister *v.* Norton, (1885) 2 R. P. C. 68, 69; Rennard *v.* Levinstein, (1864) 10 L. T. N. S. 94; Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136; Ashworth *v.* Roberts, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; Rawes *v.* Chance, (1890) 7 R. P. C. 275.

(*c*) Bovill *v.* Smith, (1866) L. R. 2 Eq. 459, 461.

(*d*) Swinborne *v.* Nelson, (1853) 16 Beav. 416.

an answer to interrogatories asking for the names and addresses of the persons to whom the defendant's machines have been sold; (*c*) and where the defendant had, in answer to interrogatories, set forth the names and addresses of persons resident in England from whom he had received royalties for the use of machines which the plaintiff alleged were made in infringement of his patent, such defendant was ordered to give the names and addresses of persons resident abroad from whom royalties had been received by him in respect of machines made in England, on the ground that the answer might lead to the discovery of important facts relative to the infringement. (*f*)

Discovery.

addresses of defendant's customers.

A defendant will not be excused from giving the names and addresses of his customers on the ground that by so doing he may thereby expose them to actions for infringements. (*g*)

The same rules apply to the production of documents in patent cases as in other cases. The ordinary rule is that no order is made for the disclosure of documents until after a pleading has been delivered by the party desiring disclosure. (*h*)

Production of documents.

Where a defendant company sought to withhold from production certain letters which had passed between the officers of the company, and between them and other persons, together with reports relative to infringement and the validity of the plaintiff's claim, it was held that such documents were not privileged, and their production was ordered. (*i*)

Where it appeared that certain plaintiffs, before they became owners of the patent in respect of which they were suing, had, in various proceedings, either disputed, or made preparations for disputing, its validity, and the defendants applied for inspection of the documents relating to such proceedings, it was held that they were entitled to have inspection of all except such as the plaintiff should state on oath to come within such terms as counsel should agree on, *i.e.*, to have come into existence merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and

(*e*) Tetley *v.* Easton, (1856) 18 C. B. 643.

(*f*) Crossley *v.* Stewart, (1863) 1 N. R. 426; see also Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; Leather Cloth Co. *v.* Hirschfield, (1866) L. R. 1 Eq. 299.

(*g*) Tetley *v.* Easton, (1856) 18 C. B. 643; How *v.* McKernan, (1862) 30 Beav. 547; Bovill *v.* Cowan, (1867) W. N. p. 115.

(*h*) See Woolfe *v.* Automatic Picture Gallery, (1902) 19 R. P. C. 161.

(*i*) Westinghouse *v.* Midland Ry. Co., (1883) 48 L. T. N. S. 98, 462.

Discovery.

either as materials for briefs or for his advice or consideration. (*j*)

Documents not disclosed in original affidavit.

Where it appears probable from a document produced by the plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his original affidavit, the proper course is to apply for an order calling on him to make a further and better affidavit, and in particular to state whether he has not in his possession documents, which, from that which has been said by him on affidavit or from the documents he has produced, in all probability are in his possession. (*k*) Thus, a plaintiff who in his affidavit of documents referred to certain affidavits made in a previous action against different defendants, but omitted to schedule them, was ordered to make a further and better affidavit with particular reference to the affidavits filed in the previous action. (*l*)

Further affidavit of documents.

It is established that where an affidavit of documents has been made the opposite party cannot require a further affidavit to be made, if the affidavit is technically sufficient, unless he shows, either upon affidavit or from documents which are produced, or from the pleadings, or admissions in the pleadings of the party giving discovery, or from the very nature of the case (and as regards the nature of the case there must be very strong evidence to induce the Court to act), that there are, probably, in the possession of the party giving discovery documents other than those he has scheduled in his affidavit. There can be no cross-examination on an affidavit of documents which has been filed; but though the party requiring discovery cannot take any of the courses either as to cross-examination or without such evidence above referred to, on further affidavit, he may, with the leave of the Court, interrogate the party who has made an affidavit as to documents with reference to certain specific documents which he has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed. (*m*)

The Court may require an affidavit to the effect that the

(*j*) Haslam *v.* Hall, (1887) 5 R. P. C. 1; see also Southwark and Vauxhall Water Co. *v.* Quick, (1878) L. R. 3 Q. B. D. 315, 320; Anderson *v.* Bank of British Columbia, (1875) L. R. 2 Ch. D. 644.

(*k*) Per Cotton, L.J., Brown *v.* Sansom, (1888) 5 R. P. C. 585; Jones *v.* Monte Video Gas Co., (1880) L. R. 5 Q. B. D. 556.

(*l*) Brown *v.* Sansom, (1888) 5 R. P. C. 510.

(*m*) Judgment of Cotton, L.J., Edison *v.* Holland, (1888) 5 R. P. C. 216; see also Hall *v.* Truman, (1885) L. R. 29 Ch. D. 307: Rawes *v.* Chance, (1890) 7 R. P. C. 275.

application is not vexatious, or for the purpose of delay, but that it is made honestly for the purpose of obtaining discovery; but it is doubtful whether an affidavit as to the existence and nature of documents supposed to be in the possession of the party giving discovery and not included in the schedule to his original affidavit of documents is admissible. (*n*) Inspection.

Interrogatories as to documents not disclosed.

After one party has made a sufficient affidavit of documents the other party to the action will not be allowed to administer to him a general roving interrogatory as to documents in his possession, the effect of which would be to compel him to make a further affidavit. There are cases in which, after a sufficient affidavit as to documents, the Court will allow a party to deliver an interrogatory as to some specific document or documents, but whether this shall be allowed is a matter within the discretion of the Judge in each particular case, and though this decision can be appealed from, the Court of Appeal will not readily reverse it. (*o*)

Limited order for discovery of documents.

If an application is made at chambers for the usual order for discovery of documents, and a limited order only is asked for and obtained, no further order ought subsequently to be made by the Court of Appeal if the Judge has certified that he did not require argument in Court. (*p*)

Inspection is not a matter of right.

**Inspection.**—It sometimes happens that the plaintiff could not establish the infringement complained of without an inspection of the process or machinery which the defendant is actually using; or the defendant could not prove his innocence by showing that the patent is invalid or that he does not infringe, without a like inspection against the plaintiff. In such cases the Court has power, both under the Act of 1883 and under the Rules of the Supreme Court, to make an order for either party to be at liberty to inspect the other's process or machinery; but neither party can claim inspection as a matter of right; (*q*) and the Court will not allow it to be oppressive or to be carried beyond what is necessary in the interests of justice, (*r*) the object of inspection being to enable the Court to have the case properly tried, and to assist the Court in forming a right conclusion. (*s*)

Object of inspection.

(*n*) Edison *v.* Holland, (1888) 5 R. P. C. 216.

(*o*) Hall *v.* Truman, (1885) L. R. 29 Ch. D. 307.

(*p*) Thomson *v.* Hughes, (1890) 7 R. P C. 187.

(*q*) 46 & 47 Vict. c. 57, s. 30.

(*r*) Bovill *v.* Moore, (1815) Dav. P. C. 361; 2 Coop. Ch. Cas. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 458; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46.

(*s*) The Patent Type Founding Co. *v.* Walter, (1860) Johns. 727; Bovill *v.*

Inspection.

Thus, where a defendant was charged with infringing a patent for a sewing machine, and objected to an order for the inspection by the plaintiff of all sewing machines on his premises, on the ground that such order would be oppressive, he was allowed to verify on affidavit all the different kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's patent, and the order for inspection was confined to one of each class. (*t*) The defendant cannot be compelled to make an affidavit verifying the machines or processes he uses, if he has offered inspection. (*u*)

Evidence necessary to obtain an order for inspection.

Before the Court makes an order for inspection it will require to be satisfied that the inspection sought is necessary to the case of the party seeking, (*v*) or that the inspection is the only method of determining which of conflicting statements made by the parties is or are true. (*x*)

Thus, an application for an order for inspection by the plaintiff was refused where he omitted to state on affidavit that it was necessary to his case, and the defendant swore that he made several kinds of the article complained of, and that some of them did not resemble those described in the plaintiff's specification, and that in his belief the inspection was not required for the purposes of the action, but to gain information of his improvements. (*y*) Again, when the Court was of opinion that the defendant's acts, as alleged by the plaintiff, could not possibly amount to an infringement, an order for inspection was refused. (*z*) And an order for inspection was refused where the plaintiff alleged that certain apparatus used by the defendant was an infringement, and the defendant on the other hand denied infringement and gave a description of the apparatus used by him, which showed it to be different to the plaintiff's. The order was refused notwithstanding the allegation that the plaintiff had

Moore, (1815) 2 Coop Ch. Cas. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 459; Davenport *v.* Jepson, (1862) 1 N. R. 308; Pemberton, 4th ed. 484; Russell *v.* Crichton, (1837) 15 Decisions of Court of Session, 1st series, 1270; Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Cheetham *v.* Oldham, (1888) 5 R. P. C. 622.

(*t*) Singer Manufacturing Co. *v.* Wilson, (1865) 5 N. R. 505; 12 L. T. N. S. 140.

(*u*) Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*v*) Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Batley *v.* Kynock, (1874) L. R. 19 Eq. 90; Cheetham *v.* Oldham, (1888) 5 R. P. C. 617; Shaw *v.* Bank of England, (1852) 22 L. J. N. S. Ex. 26; Meadows *v.* Kirkman, (1860) 29 L. J. N. S. Ex. 205.

(*x*) Swain *v.* Edlin-Sinclair Tyre Co., (1903) 20 R. P. C. 435.

(*y*) Batley *v.* Kynock, (1874) L. R. 19 Eq. 91.

(*z*) Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46.

failed to make the apparatus, as described by the defendant, work at all. (*a*)

Inspection.

Plaintiff's affidavit on application for an order for inspection.

An affidavit made by the plaintiff on an application for an order for inspection should state that he has reason to believe that the process or machine used by the defendant is an infringement of his patent; (*b*) it should also show the grounds of such belief, (*c*) and in what the invention of the plaintiff consists. (*d*) If the plaintiff makes out a *primâ facie* case of infringement, and that inspection is necessary to enable him to prove it at the trial, an order will follow almost as matter of course, (*e*) but inspection will be limited to those machines and processes in respect of which a *primâ facie* case of infringement is made out. (*f*)

Inspection for the purpose of preparing pleadings.

In an action for infringement the plaintiff cannot, as a rule, be compelled to produce, or allow inspection of the patented machine or process at the instance of the defendant for the purpose of preparing the defence, since the specification should give sufficient information of what the invention is and the mode of performing it. (*g*)

When, however, the defendant alleges that he has in his possession apparatus which is an anticipation of the plaintiff's claim, and which was formerly used, an order for the production and inspection of such apparatus may be obtained at the instigation of the plaintiff. (*h*) But where certain defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars, and the plaintiff applied for an order for the production before trial of the articles to be proved by the specified persons, the Court refused the application, on the ground that there was no precedent for such an order, and that on principle it ought not to be made. (*i*)

Where the parties agree to an inspection without incurring the expense of obtaining an order of Court, the costs of such inspection will be allowed on taxation. (*j*)

(*a*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*b*) Shaw *v.* Bank of England, (1852) 22 L. J. N. S. Ex. 26.

(*c*) Germ Milling Co. *v.* Robinson, (1884) 1 R. P. C. 217.

(*d*) Meadows *v.* Kirkham, (1860) 29 L. J. N. S. Ex. 205.

(*e*) Singer Manufacturing Co. *v.* Wilson, (1865) 13 W. R. 560; 5 N. R. 505; Batley *v.* Kynock, (1874) L. R. 19 Eq. 90; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Cheetham *v.* Oldham, (1888) 5 R. P. C. 617.

(*f*) Cheetham *v.* Oldham, (1888) 5 R. P. C. 617.

(*g*) Crofts *v.* Peach, (1836) 1 W. P. C. 268.

(*h*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*i*) Garrard *v.* Edge, (1889) 6 R. P. C. 372.

(*j*) Ashworth *v.* English Card Clothing Co., Ltd. (A), (1904) 21 R. P. C. 353.

Inspection.

Power of the Court to enforce an order for inspection.

The Court is not dependent on its power to compel inspection by treating as a contempt a refusal to comply with an order. The order of the Court may authorise any person, for the purpose of inspection, to enter upon or into any land or building that may be necessary. (*k*)

Order may be made at any time.

An order for inspection may be made at any time during the progress of an action, and may be obtained on summons or on motion. (*l*)

Delay no bar.

Delay in asking for an order for inspection is no bar. (*m*)

Postponement of the question of inspection.

If the party from whom inspection is sought objects, the Court or a Judge may, if satisfied that the right to inspection depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the inspection, order that such issue or question be determined first and reserve the question as to the inspection. (*n*)

Conditions.

The order for inspection generally makes it a condition that reasonable notice be given to the parties against whom it is made, (*o*) and, if the inspection relates to machinery, that the machines be put to work (*p*) in the presence of persons named, (*q*) and further specifies the number of inspections that are to be allowed. (*r*)

Inspection against licensee not a party to the action.

A licensee not a party to the action cannot be compelled to give inspection in an action against his licensor, though the order be made. (*s*)

Trade secrets.

It is sometimes objected that an inspection if granted would lead to the disclosure of trade secrets, and damage the trade of the party against whom it is sought, but such an objection will not deter the Court from making an order if it appears to

(*k*) R. S. C. (1883) Order l. r. 3.

(*l*) Judicature Act, 1873, s. 39; R. S. C. (1883) Order liv. r. 12; Order lv. r. 15; Frearson *v.* Loe, (1878) 26 W. R. 138.

(*m*) The Patent Type Founding Co. *v.* Walter, (1860) Johns. 727.

(*n*) R. S. C. (1883) Order xxxi. r. 20.

(*o*) Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43; Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Flower *v.* Lloyd, Seton, 4th ed. p. 351; Russell *v.* Cowley, (1833) 1 W. P. C. 458; Davenport *v.* Jepson, (1862) 1 N. R. 173; Pemberton, 4th ed. 484, p. 236; Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*p*) Seton, 4th ed. p. 351; Beardsel, *v.* Schwann, Seton, 3rd ed. p. 910; Davenport *v.* Jepson, (1862) Pemberton, p. 484; Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 458.

(*q*) Russell *v.* Cowley, (1833) 1 W. P. C. 458; Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*r*) Heathfield *v.* Braby, Seton, 4th ed. p. 1661; Germ Milling Co. *v.* Robinson, (1885) 3 R. P. C. 11.

(*s*) Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11, 14.

be necessary in the interests of justice, (*t*) though the Court will endeavour to prevent an undue advantage being taken of secrets disclosed during an inspection. (*u*) Inspection.

In *Flower* v. *Lloyd*, (*x*) where inspection was resisted on the ground of disclosure of trade secrets, an arrangement was come to in the Court of Appeal whereby the defendant's works should be inspected by scientific men to be agreed upon, but not by the plaintiff.

In *Cheetham* v. *Oldham*, (*y*) the plaintiff, a rival manufacturer of the defendant, was himself allowed to take part in the inspection.

In *Plating Co.* v. *Farquharson*, (*z*) the Court made an order authorising inspection by a scientific expert, but bound him not to disclose his report on the facts or opinion obtained or arrived at by him, without the leave of the Court or a Judge, and, at the trial, the expert was not allowed to be called as a witness or cross-examined.

Where an independent inspector is appointed, he is usually required to "report to the Court upon the facts, and his opinion founded upon them." (*a*)

Where the defendant desired an inspection of machines not belonging to, but in the power of the plaintiff, and the Court thought that such inspection would be beneficial in the interests of justice, an order was made that the plaintiff should *bonâ fide* endeavour to procure the inspection desired, and report the result to the Court. (*b*) Things in the power of a party.

Besides granting inspection, the Court or a Judge has the power, which is frequently exercised, to authorise samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence. (*c*) Samples.

(*t*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 223; Russell *v.* Crichton, 15 Decisions of Court of Session, 1st series, 1270; Cheetham *v.* Oldham, (1888) 5 R. P. C. 617; Rylands *v.* Ashley's Patent (Machine Made) Bottle Co., (1890) 7 R. P. C. 175.

(*u*) Russell *v.* Crichton, (1837) 15 Decisions of Court of Session, 1st series, 1270; Flower *v.* Lloyd, Seton, 4th ed. p. 351; Plating Co. *v.* Farquharson, (1881) Griff. P. C. 187.

(*x*) (1876) W. N. 169.

(*y*) (1888) 5 R. P. C. 617.

(*z*) (1881) Griff. P. C. 187.

(*a*) The Plating Co. *v.* Farquharson, (1881) Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. p. 500; see also Hill *v.* Touts, *ibid.* 499.

(*b*) Rylands *v.* Ashley's Patent (Machine Made) Bottle Co., (1890) 7 R. P. C. 175.

(*c*) R. S. C. (1883) Order 1. r. 3; and also see 46 & 47 Vict. c. 57, s. 30; vol. ii. p. 215; Russell *v.* Cowley, (1833) 1 W. P. C. 459; The Patent Type Founding Co. *v.* Walter, (1860) Johns. 727; Plating Co. *v.* Farquharson, (1881) Griff. P. C. 187; The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 14; Cheetham *v.* Oldham, (1888) 5 R. P. C. 621.

Evidence.

Inspection of books.

It was held that the inspection authorised by the Act of 1852 (*d*) referred to an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not to an inspection of books; (*e*) and probably the same meaning must be attached to the word as used in sec. 30 of the Act of 1883, and an inspection of books would not be allowed on affidavit merely showing the possibility of discovering matters advantageous to the case of the party seeking it. (*f*)

Inspection when the action is founded solely on a threat to infringe.

An injunction may be obtained restraining a threatened infringement; (*g*) and in a case where it appeared that the defendant had entered into a contract to make certain paddle-wheels, which the plaintiffs alleged were a violation of their patent, an order was obtained from the Court authorising the plaintiffs and their witnesses to be at liberty to inspect at all seasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract. (*h*)

## Evidence.

Evidence when defendant does not appear at the trial.

If the defendant puts in a defence and does not appear at the trial, the plaintiff is not entitled to judgment without proof of his case: he must prove the grant and show that the specification is good on the face of it and also prove the infringement. (*i*)

Evidence not within the particulars.

By the Patents Act of 1852, (*k*) the evidence of both the plaintiff and the defendant was strictly confined to the particulars which had been given, and, therefore, if at the trial either party wished to give evidence not within them, the proper course was to apply at once for leave to amend, on the ground that fresh evidence had come to light since they were delivered. (*l*)

The Act of 1883 has somewhat enlarged the opportunities open to litigants of giving evidence at the trial by enacting that at the hearing no evidence shall, *except by the leave of the Court or a Judge*, be admitted in proof of any alleged

(*d*) s. 42.
(*e*) Vidi *v.* Smith, (1854) 3 E. & B. 969.
(*f*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 223.
(*g*) p. 384 *ante*.
(*h*) Morgan *v.* Seaward, (1835) 1 W. P. C. 169.
(*i*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261.
(*k*) s. 41.
(*l*) Daw *v.* Eley, (1861) L. R. 1 Eq. 38.

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infringement or objection of which particulars have not been delivered; (*m*) but it is not safe to rely on the Court granting the necessary leave, and subsequently, if a party desire to go outside his particulars on the ground that the evidence was discovered since they were delivered, or for any other reason, he should still apply for leave to amend, which will, however, not be granted unless he makes out a sufficient case, (*n*) and then only upon the usual terms. But the Court—*i.e.*, both the Court of first instance and the Court of Appeal—has undoubted discretion, under the Act of 1883, to admit evidence not within the particulars without requiring an amendment of the particulars. (*o*) Nevertheless, a party desirous of giving evidence upon a point not strictly within the particulars should not depend on the Court exercising its discretion in his favour at the trial, but should make a previous formal application. If a matter is not put in issue the party against whom the issue is not raised is not only not bound to come with evidence directed to that issue, but he is actually bound to come without it, for it would be incurring useless expense if he came with evidence not addressed to an existing issue. On the other hand, an application to amend the particulars at the trial upon a matter merely subsidiary, on which evidence would be called in any case, would probably be granted.

Discretionary power of the Court or a Judge to admit evidence not within the particulars.

The Court has an absolute discretion, unfettered by any rule of practice, in each case as to admitting evidence not covered by the particulars, either unconditionally or upon amendment of the particulars and on terms. (*p*) The Court only rarely exercises its power of admitting evidence of which particulars have not been delivered—*e.g.*, where not to do so would be to stultify the action of the Court. Thus, where the defendant pleaded that what he did was done under a patent granted to him prior to the plaintiff's patent, and then at the trial tendered evidence not included in the particulars to the effect that he himself had publicly used the very thing claimed by both patents years before the date of either, *Kay*, L.J., ordered an adjournment and granted leave to adduce the defendant's evidence of prior user within a certain time, though he was not asked to do so, and stated that if it were put in he would allow the plaintiff an opportunity of dealing

(*m*) s. 29 (4).

(*n*) Moss *v.* Malings, (1886) L. R. 33 Ch. D. 603; Renard *v.* Levinstein, (1864) 13 W. R. 229; 11 L. T. N. S. 505.

(*o*) Britain *v.* Hirsch, (1888) 5 R. P. C. 226; see also *infra*.

(*p*) See Woolley *v.* Broad, (1892) 9 R. P. C. 429; Wilson *v.* Wilson & Co., (1899) 16 R. P. C. 315.

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with it, otherwise there would be judgment for the defendant without costs. (*q*)

The discretionary power of the Court to admit evidence not within the particulars is quite independent of its power to allow an amendment of the particulars for the purpose of admitting fresh evidence. (*r*)

Particulars not objected to are construed widely.

When particulars have been delivered, and not objected to, such evidence may be given under them as their words are sufficiently wide to include; (*s*) and, however general they may be, if the evidence tendered is within their literal meaning, it will be admitted. (*t*)

Thus evidence of user in Cheshire was admitted under an objection which alleged that the invention had been publicly used in "corn mills"; (*u*) and where the particulars alleged infringement by manufacture and sale at divers times between specified dates and also two specified instances of sale, evidence of a third sale was allowed, the defendant having, by his interrogatories, admitted such a sale. (*x*) When, however, an order for amendment of the particulars of objection had not been complied with, evidence of an anticipating specification not given under the order was not admitted. (*y*)

Patentee who has assigned his interest is a competent witness.

A patentee who has assigned the whole of his interest is a competent witness for the assignee in any action he may bring for the infringement of the patent. (*z*) If the patentee has covenanted with the assignee in respect of the validity of the patent, he may have an interest in the event of a subsequent action in which the question of validity is raised, but his evidence would not be excluded, although his interest would be a matter to be taken into consideration as affecting his credit. (*a*)

Licensee may be a witness for the plaintiff,

A licensee is also a competent witness for the plaintiff in a patent action, (*b*) though he may be an interested one. (*c*)

(*q*) Hill *v.* Adams, (1893) 10 R. P. C. 102; see also Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68; Britain *v.* Hirsch, (1888) 5 R. P. C. 230; Peckover *v.* Rowland, (1893) 10 R. P. C. 118.

(*r*) Britain *v.* Hirsch, (1888) 5 R. P. C. 226; p. 455 *post*.

(*s*) Neilson *v.* Harford, (1841) 1 W. P. C. 331, 370.

(*t*) Hull *v.* Bollard, (1856) 1 H. & N. 134; Curtis *v.* Platt, (1866) 35 L. J. N. S. Ch. 852, 868; Sugg *v.* Silber, (1877) L. R. 2 Q. B. D. 495; Sykes *v.* Howarth, (1879) L. R. 12 Ch. D. 826; 48 L. J. N. S. Ch. 769; see also Adair *v.* Young, (1879) W. N. p. 8.

(*u*) Hull *v.* Bollard, (1856) 1 H. & N. 134.

(*x*) Sykes *v.* Howarth, (1879) L. R. 12 Ch. D. 826; 4 L. J. N. S. Ch. 769.

(*y*) Lister *v.* Leather, (1858) 3 Jur. N. S. 811.

(*z*) Bloxam *v.* Elsee, (1825) 1 C. & P. 563.

(*a*) 6 & 7 Vict. c. 85, s. 1; 14 & 15 Vict. c. 99, ss. 1 and 2.

(*b*) *Ibid.*

(*c*) *Ibid.*

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If the licensee is empowered to use the invention in consideration of a periodical payment or a payment in proportion to the extent of his user, he cannot have an interest in supporting the patent (unless the payments are merely nominal or not a full consideration for the privilege granted), but he may be interested in its destruction. If the licensee has paid a gross sum for an irrevocable licence, or has obtained it for any other consideration, he may have an interest in supporting the patent, for if the invention be thrown open to the public he cannot obtain any benefit from the licence.

though the action is brought for his own benefit.

Though the action be brought for the benefit of the licensee who has an exclusive licence for some particular district, he is a competent witness for the plaintiff, notwithstanding that he is a person "in whose immediate and individual behalf" the action is brought. (*d*)

Necessity for and the value of the evidence of experts.

In patent actions the testimony of experts frequently forms the chief part of the evidence submitted to the Court both in importance and in volume. The following remarks of the late Lord *Bowen* illustrate the great importance of the evidence of scientific men of repute in cases, such as patent actions, where it is the duty of the Court to inform itself as to the state of scientific knowledge at the date of the patent bearing upon the subject-matter of the dispute between the parties.

> "If we are to act in the present instance, one must fall back upon the opinions of experts, and I wish emphatically to state my view, that in a matter like the present, so far from thinking the opinions of experts unsatisfactory, it is to the opinion of experts that I myself should turn with the utmost confidence and faith. Courts of law and courts of justice are not fit places for the exercise of the inductive logic of science. Life is short; it is impossible to place endless time at the disposal of litigants; and the laws of evidence are based upon this very impossibility of prolonging inquiries to endless length. There is hardly a scientific theory in the world which, if we were to examine into it in law courts, might not take year after year of the whole time of a tribunal. Supposing, for a moment, one had brought in question the circular theory of storms, and were to propose before a tribunal like this to examine it, not by reference to the opinions of the most experienced persons who have made it a subject of study and investigation, but to inquire ourselves into all the special circumstances of storms, with which witnesses could favour us who had crossed the Atlantic or the Eastern seas, in order to form our opinion, assisted, no doubt, by

(*d*) 14 & 15 Vict. c. 99, ss. 1 and 2.

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scientific men, as to the circular theory of storms, with all the qualifications which might be adopted, and with all the definitions in which it might be embodied. Take another instance of a law which is very far from likely to be accepted by science, but most probably would be rejected as pure theory, and as utterly beyond reason. I believe there are many persons in India who endeavour to connect the existence of famine raging over tracts of country with spots on the sun. Supposing that theory were brought up in an English court of law, we should be bound to embark on an endless inquiry into all the instances in which spots on the sun had been found to be coincident with famines in India. The truth is, when you are dealing with scientific theories, it is hopeless for courts of law to do more than to take the evidence of scientific men, subject, no doubt, to cross-examination, which may or may not condescend to particular instances, which may be brought home to them to show, if it exists, the uncertainty of the grounds upon which their opinions are founded. The result of the admission of this evidence, assuming it, as I do, to be admissible, has been, in my judgment, to show that the endeavour to utilise such evidence launches us upon an inquiry fit only for the leisure of learned and scientific men, but for which the jury system and the judicial system are probably inadequate." (*e*)

Expert evidence is admissible to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, to show the particulars in which an alleged invention has been used by an alleged infringer or the real importance of any differences between the plaintiff's invention and the alleged infringement, and what are and what are not mechanical or chemical equivalents. But 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, which is familiar law, although often disregarded by counsel when examining witnesses. (*f*)

The Court always scrutinises very carefully—even with suspicion—expert evidence and experiments prepared expressly for the purposes of either party at the trial. (*g*)

(*e*) Fleet *v.* The Managers of the Metropolitan Asylums District (1886); Cunningham's "Life of Lord Bowen," p. 162. The observations of Jessel, M.R., in Thorn *v.* Worthington Skating Rink Co., (1876) L. R. 6 Ch. D. 415 *n.*, indicate the unsatisfactory nature of the expert evidence which is sometimes obtained and presented to the Court.

(*f*) See Brooks *v.* Steel, (1896) 14 R. P. C. 73; Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 186.

(*g*) Betts *v.* Neilson, (1868) L. R. 3

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Proof of the grant of the patent,

If the grant of the patent be denied, it must be proved by the production of the letters patent themselves or a copy thereof certified by the Comptroller and sealed with the seal of the Patent Office, (*h*) and no further proof is necessary.

The letters patent are only proof of the *purport* of the grant which they contain, the effect or operation of the grant being quite a different question. Although letters patent purport to grant a sole privilege to the patentee, it may be that the patent is for some reason illegal or void, and, if so, the patent is of no force, and the grant it purports to make has no operation, and consequently it is strictly correct to say that the King did not make such a grant as the plaintiff alleges, for a void grant is the same as no grant at all. (*i*) The letters patent merely prove the purport of the grant, and upon any dispute respecting the invention the specification must be read and considered as incorporated with the patent. (*k*)

and the scope of the invention claimed.

It is incumbent on the plaintiff to prove what the invention really is for which the patent was granted. The proper way to do this is to put in the specification, and neither the patentee nor any other witness can be called to prove what the real invention is, the question being one which can only be answered from a critical examination of the specification, (*l*) which must, however, be interpreted by the light of public knowledge at the date of the grant, external evidence of which is, therefore, admissible for the purpose of deciding between two possible constructions of a claim. (*m*) Evidence of the patentee cannot be tendered to show what effect was intended by the specification. (*n*)

Issue of true and first inventor.

If the defendant raises the issue that the patentee was not the true and first inventor, the *onus* of proof rests with him; (*o*) but it is usual for the plaintiff to tender *primâ facie* evidence to the effect that the patentee was the first person who

Ch. 433; Young *v.* Fernie, (1864) 4 Giff. 609; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 576; Crampton *v.* Patents Investment Co., (1888) 5 R. P. C. 382, 404.

(*h*) 46 & 47 Vict. c. 57, s. 89.

(*i*) Hindmarch, p. 440.

(*k*) Hornblower *v.* Boulton, (1799) 8 T. R. 102; Dav. P. C. 221; Crossley *v.* Beverley, (1829) 9 B. & C. 63.

(*l*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 717; Hinks *v.* Patent Safety Lighting Co., (1876) L. R. 4 Ch. D. 618; Brooks *v.* Steel, (1896) 14 R. P. C. 73; p. 339 *ante*.

(*m*) p. 286 *ante*.

(*n*) Kayo *v.* Chubb, (1887) 4 R. P. C. 289, 298.

(*o*) Young *v.* White, (1853) 22 L. J. Ch. 190; Minter *v.* Wells, (1834) 1 W. P. C. 129; Cornish *v.* Keene, (1835) 1 W. P. C. 507; Amory *v.* Brown, (1869) L. R. 8 Eq. 663; Harris *v.* Rothwell, (1887) 4 R. P. C. 229; Nickels *v.* Ross, (1849) 8 C. B. 679; Ward *v.* Hill, (1901) 18 R. P. C. 481.

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actually communicated the invention to the public. (*p*) This is usual done by calling the patentee himself, who claims to be the inventor; but when the patent was obtained on a communication from abroad, it is not necessary to call the foreign inventor. (*q*) It must not be forgotten that there is a sound distinction in the abstract between the issues of true and first inventor and novelty. (*r*)

Issue of subject-matter.

The decision of the issue raised by a plea that the alleged invention could not form the subject-matter of a valid patent rests more with a Judge than a jury. The plaintiff must give the specification in evidence, in order that the Judge may see what the alleged invention really is; and if there are terms of art involved, the jury, or Judge acting as a jury, must determine the meaning to be applied to them in the construction of the specification, which is the duty of the Court alone. (*s*) It should also be remembered that the ingenuity of any alleged invention—*i.e.*, whether there has been an exercise of the inventive faculty which will support the patent on the ground of subject-matter—is to be judged in the light of the state of public knowledge at the time it was made. (*t*) If the issues of subject-matter, novelty, and utility, or sufficiency of specification, have been decided on a previous occasion by a Court of co-ordinate or superior jurisdiction, the Court as a matter of convenience considers itself bound by the finding of the Court on the former occasion, so far as the same evidence is concerned, and will refuse to admit such evidence again. (*u*) *Of course, if different evidence is adduced on any of these* points, and there is no estoppel on the ground of the matter being *res judicata* between the parties, or from any other cause, the Court receives and gives effect to such fresh evidence. (*x*)

The plea of want of novelty does not put in issue the fact of the invention being a manufacture within the meaning of the Statutes of Monopolies for which a patent could be granted; (*y*) *i.e.*, it does not raise the issue of subject-matter. Another distinction between the issues of subject-matter and novelty is, that in order to consider subject-matter as distinguished from anticipation, a prior specification is not to

(*p*) p. 6 *ante*.
(*q*) Nettlefolds *v.* Reynolds, (1892) 9 R. P. C. 270; Badische Anilin und Soda Fabrik *v.* Levinstein.
(*r*) See p. 107 *ante*.
(*s*) p. 265 *ante*.
(*t*) p. 39 *ante*; Beavis *v.* Rylands Glass and Engineering Co., (1900) 17 R. P. C. 710; Patent Exploitation, Ld. *v.* Siemens Brothers, Ld., (1904) 21 R. P. C. 549.
(*u*) Slazenger *v.* Feltham, (1889) 6 R. P. C. 130.
(*x*) p. 406 *ante*.
(*y*) p. 22 *ante*.

be excluded merely because something therein disclosed would not work. (*z*)

When novelty is in issue plaintiff must give *primâ facie* evidence,

If the novelty of the invention be denied, the plaintiff must give *primâ facie* evidence that the invention had not been communicated to the public before the date of the patent. (*a*) In order to do this the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the subject-matter of the alleged invention if it had been published prior to the date of the patent, and who are able to testify that it was unknown to them. It is clear that only indirect evidence of novelty can be given, since it is impossible to examine every member of the public; but if the plaintiff calls witnesses who for some time before the date of the patent were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can swear that they were ignorant of it until after the date of the patent, this will be sufficient *primâ facie* evidence, and the *onus* of proving the negative will then be on the defendant. (*b*)

If the invention consist of several parts claimed separately, (*c*) or if several inventions have been comprised in the same patent, (*d*) it is incumbent on the plaintiff to give *primâ facie* proof of the novelty of all the parts, or all the inventions, as the case may be. (*e*)

after which the *onus* is on the defendant.

After the plaintiff has made a *primâ facie* case in respect of novelty, the *onus* is on the defendant of showing that the invention was public property at the date of the patent, and, consequently not new as to the public knowledge and use of it, (*f*) but the evidence of one witness may be quite sufficient to do this; (*g*) though, if an alleged prior use made a long time ago is relied on, the uncorroborated evidence of persons interested in defeating the patent ought

(*z*) See Beavis *v.* Rylands Glass and Engineering Co., (1900) 17 R. P. C. 711; p. 152 *ante*.

(*a*) Turner *v.* Winter, (1787) Dav. P. C. 153; Manton *v.* Manton, (1815) Dav. P. C. 348; Bovill *v.* Moore, (1815) Dav. P. C. 399; Galloway *v.* Bleaden, (1839) 1 W. P. C. 525; Cornish *v.* Keene, (1835) 1 W. P. C. 509.

(*b*) Cornish *v.* Keene, (1835) 1 W. P. C. 509; Manton *v.* Manton, (1815) Dav. P. C. 350, 353; Galloway *v.* Bleaden, (1839) 1 W. P. C. 526; Amory *v.* Brown, (1869) L. R. 1 Eq. 663; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416, 427.

(*c*) Manton *v.* Manton, (1815) Dav. P. C. 340, 341; Gibson *v.* Brand, (1841) 4 M. & G. 179; Gillett *v.* Wilby, (1839) 9 Car. & P. 334; Losh *v.* Hague, (1837) 1 W. P. C. 208.

(*d*) Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541; see Vol. II. p. 6.

(*e*) Chap. iii.

(*f*) Penn *v.* Jack, (1866) L. R. 2 Eq. 314; 14 W. R. 760; Minter *v.* Wells, (1834) 1 W. P. C. 129; Peroni *v.* Hudson, (1884) 1 R. P. C. 261.

(*g*) Badham *v.* Bird, (1888) 5 R. P. C. 238.

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not to carry the alleged prior use further than an experimental use. (*h*)

Documents as evidence of publication.

When a published document is alleged as an anticipation evidence should be called to explain it, if necessary. (*i*) But if the anticipation relied on is an English complete specification filed in the Patent Office no proof is required of further publication or its contents having been seen by the public, (*k*) for the second of two patents for the same invention must be bad in law. (*l*)

Where the want of novelty appears distinctly from a written document, it is for the Court, and not the jury, to determine the identity of the two supposed inventions, (*m*) aided as to the meaning of technical expressions by the finding of the jury, or the Judge acting as a jury. (*n*) But when a skilled workman, with the knowledge common to the trade at the date of the trial, produces in evidence a successful result, which he says he arrived at by following only the directions of an old and unused paper anticipation, the Courts weighs very carefully indeed such evidence before accepting it. (*o*)

Rebutting evidence may be given by the plaintiff on the issue of want of novelty.

Upon the issue of novelty the plaintiff is entitled to call evidence in reply for the purpose of rebutting that given by the defendant, on whom lies the *onus* of proving his case, (*p*) and such rebutting evidence is usually called at the close of the defendant's case. (*q*) Thus, at the hearing of an action where evidence had been admitted on behalf of the defendants which was not included under the particulars, the case was ordered to stand over, to allow the plaintiff an opportunity of rebutting such evidence, the defendants being allowed to amend their particulars. (*r*)

(*h*) Dick *v.* Tullis, (1896) 13 R. P. C. 149; Pneumatic Tyre Co. *v.* Marwood, (1897) 14 R. P. C. 240; p. 120 *ante*; but see Haskell Golf Ball Co. *v.* Hutchinson, (1905) 22 R. P. C. 478; 23 R. P. C. 301.

(*i*) Hocking *v.* Fraser, (1886) 3 R. P. C. 63; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; pp. 121–124 *ante*.

(*k*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 551, 557; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416, 428.

(*l*) Chap. ii.

(*m*) Bush *v.* Fox, (1856) 5 H. L. Cas. 707; Booth *v.* Kennard, (1857) 2 H. & N. 84; Hills *v.* London Gas Light Co., (1860) 5 H. & N. 312; Betts *v.* Menzies, (1862) 10 H. L. Cas. 134; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. Cas. 654; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 315.

(*n*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 134; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. Cas. 654; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 320.

(*o*) Defries *v.* Sharwood, (1897) 13 R. P. C. 313; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 573–576; p. 464 *post*.

(*p*) p. 461 *ante*.

(*q*) Penn *v.* Jack, (1866) L. R. 2 Eq. 314; Westley Richards & Co. *v.* Perkes, (1893) 10 R. P. C. 187.

(*r*) Blakey *v.* Latham, (1889) 6 R. P. C. 29, 36.

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Recalling witnesses.

A plaintiff, however, who has tendered evidence of novelty, and has had his attention called to a particular alleged anticipating document, cannot for the purpose of explaining its contents recall a witness in reply, who when he gave his evidence was acquainted with the document. (*s*) A plaintiff has been allowed, after the conclusion of all the evidence, but before judgment, which had been reserved, to give fresh evidence on a point relevant to the issue, which had not been "threshed out." (*t*)

A defendant cannot recall the plaintiff's witnesses, after the conclusion of the cross-examination, in order to put to them fresh instances of publication, unless it can be shown that such instances only came to the defendant's knowledge since the cross-examination, and could not, with due diligence, have been discovered earlier; (*u*) and similarly a plaintiff who has not required an affidavit of documents cannot recall a witness for the purpose of cross-examining him as to the effect or contents of a document disclosed during the trial, (*x*) and the defendant will not be allowed to give further evidence in answer to the rebutting evidence given by the plaintiff in reply, if the defendant's evidence has been summed up, or the Court is of opinion that the witnesses whom the defendant tenders should, if they have already given evidence, have been examined as to the point in question in chief, or, if they have not already given evidence, should have been called in chief and not in rejoindure. (*y*) In cases, however, where the interests of justice require it and the defendant has not been unduly lax in his observance of the rules as to the giving of evidence, the Court will allow him to tender evidence in rejoindure to the rebutting evidence given by the plaintiff.

Notice to admit documents.

If the defendant relies upon publication in a prior document, he should give the plaintiff notice to admit that the document was published prior to the date of the patent. If the publication of any document is not admitted, it must be proved by calling the librarian of the public library at which the book or document was before the date of the patent. (*z*)

Where an affidavit of documents had been required by the

(*s*) Tetley *v.* Easton, (1852) Mac. P. C. 61.

(*t*) Boyd *v.* Horrocks, (1888) 5 R. P. C. 557.

(*u*) Moss *v.* Malings, (1886) 3 R. P. C. 373; Sugg *v.* Bray, (1884) 54 L. J. Ch. 132.

(*x*) Sugg *v.* Bray, (1884) L. J. Ch. 132.

(*y*) Penn *v.* Jack, (1866) L. R. 2 Eq. 24.

(*z*) R. S. C. (1883) Order xxxii. r. 4.

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plaintiff, he was not allowed to recall one of the defendant's witnesses for the purpose of cross-examining him as to the contents of a report the defendant had received from a patent agent, which report was not produced, and was only referred to at a late stage of the trial. (*a*)

Models as evidence.

Models are similar to documentary evidence, and the Court will draw its own conclusions from them. (*b*) If a witness goes too far in his statements or admissions as to the effect of an alleged anticipation, and proved or admitted models are before the Court, the Court may be guided by the actual models themselves, notwithstanding the statements or admissions of the witness. (*c*)

When the difference between the patented article and an alleged disused prior anticipation is something apparently slight, but really important, the Court ought not to accept the evidence of a man who puts forward a perfected model as representing his idea of the alleged anticipation, when it appears that before making the model he saw the form patented, and made it with that knowledge evidently in his mind. Thus, *Jessel*, M.R., in the *Plimpton* skate case, (*d*) in effect, said, "I will not accept the evidence of any man who says that the drawing in the Patent Office is represented by a model if he has seen the real *Plimpton* skate."

It is, of course, a most improper thing for a party to make any alteration in the working power of a model once put in evidence, whether by cleaning or otherwise, unless it be done by permission of the Court, and upon notice to, and, if desired, in the presence of the other party, or his advisers. (*e*)

Proof of utility.

If the plea of want of utility is raised as an objection to the patent, the plaintiff must give *primâ facie* evidence to prove that the invention was useful to the public at the date of the grant. (*f*) It is important to do this, since the evidence of

(*a*) Sugg *v.* Bray, (1884) 54 L.J. N. S. Ch. 132.

(*b*) Seed *v.* Higgins, (1860) 8 H. L. Cas. 565; Westinghouse *v.* L. & Y. Ry. Co., (1884) 1 R. P. C. 245; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Winby *v.* Manchester, &c., Steam Tramways Co., (1891) 8 R. P. C. 63.

(*c*) Seed *v.* Higgins, (1860) 8 H. L. Cas. 565; Moore *v.* Bennett, (1884) 1 R. P. C. 137.

(*d*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 573-576.

(*e*) Winby *v.* Manchester, &c., Steam Tramways Co. (No. 2), (1891) 8 R. P. C. 63.

(*f*) Chap. iv., R. *v.* Arkwright, (1785) Dav. P. C. 135; Manton *v.* Parker, (1815) Dav. P. C. 327; Manton *v.* Manton, (1815) Dav. P. C. 333; Bovill *v.* Moore, (1815) Dav. P. C. 399; Minter *v.* Wells, (1834) 1 W. P. C. 129; Hill *v.* Thompson, (1817) 2 W. P. C. 237; Crane *v.* Price, (1842) 1 W. P. C. 411; Russell *v.* Cowley, (1835) 1 W. P. C. 467; Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541; Derosne *v.* Fairie, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476.

utility raises a presumption in favour of novelty and ingenuity. (*g*) Evidence.

If the defendant sets up a *primâ facie* case that the invention was not useful, the burden is then on the plaintiff to prove that it was useful. (*h*)

The fact that the defendant has attempted to infringe is itself evidence of utility. (*i*)

The degree of utility is quite immaterial under this issue; it is quite sufficient if the plaintiff can show that the invention was of *any* utility to the public. (*k*)

The question of utility must be determined with reference to the date of the patent. If it can be shown that it was then of some utility to the public, it is no objection that owing to more recent improvements it has since become useless; (*l*) and, if the patentee has obtained a subsequent patent for an improvement on a prior invention, it is not to be inferred that the prior invention was therefore useless. (*m*)

Each essential part of the invention must be shown to be useful; (*n*) for, if a material part is useless, the patent is void. (*o*)

It is not necessary that the utility of every part of an invention should be proved by actual trial; evidence of skilled persons to the effect that if tried it would answer may be sufficient. (*p*) Thus, in *Neilson* v. *Harford* (*q*) a question arose as to the utility of a certain vessel which according to the specification formed a material part of the invention. There was no evidence of any person having actually tried the vessel of the shape in question, but there was the evidence of scientific witnesses to the effect that it would answer, and the Judge who tried the case told the jury that if they were satisfied with that evidence it was quite sufficient to establish utility.

If the plaintiff proves that the invention as a whole is

(*g*) Lyon *v.* Goddart, (1893) 10 R. P. C. 121, 334, 343; 11 R. P. C. 354.

(*h*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 449.

(*i*) Lucas *v.* Miller, (1885) 2 R. P. C. 160; Reynolds *v.* Amos, (1886) 3 R. P. C. 215; United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 407; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 712.

(*k*) p. 164 *ante*.

(*l*) p. 162 *ante*.

(*m*) Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Elison *v.* Holland, (1889) 6 R. P. C. 277; Thompson *v.* Batty, (1889) 6 R. P. C. 100; p. 76 *ante*.

(*n*) p. 166 *ante*.

(*o*) Hill *v.* Thompson, (1818) 8 Taunt. 375; United Horseshoe and Nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

(*p*) pp. 164, 237 *ante*.

(*q*) (1841) 1 W. P. C. 295.

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useful, he is not bound to prove that each part of it possesses an equal amount of utility. (*r*)

Effect of user on the issue of utility.

The fact that an invention has not come into general use raises a strong presumption against its utility; (*s*) but it is not to be assumed from such evidence that the invention was not sufficiently useful to support a patent. The reason why an invention has not come into general use may be that immediately after the discovery an improvement upon it may have been produced, which, for commercial reasons, prevented the general adoption of the former invention. (*t*)

It is to be observed that a large sale of a patented article does not necessarily prove that it possesses the kind of utility which the patent law requires to support a patent—*i.e.*, that it is useful for the purpose in view, (*u*) or that it is novel. (*x*) The reason why the article has a large sale may be that it is well advertised, or got up in a manner likely to attract the purchasing public. (*y*) On the other hand, the fact that thousands of a patented article have been sold, and, in consequence of their superiority, others of a similar nature have become a drug in the market, may afford evidence of the utility of the patent. (*z*)

Proof of sufficiency of the specification.

The burden of giving some evidence of the sufficiency of the specification is upon the plaintiff, as was held by *Bullen*, J., in a case in which his Lordship is reported to have said: "I do not agree with the counsel who have argued against this rule in saying that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admits that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed

(*r*) pp. 161, 169, 237 *ante*; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 203.

(*s*) Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Simister's Patent, (1842) 1 W. P. C. 723; Morgan *v.* Windover, (1888) 5 R. P. C. 303; *Re* Bakewell's Patent, (1862) 15 Moo. P. C. 386; *Re* Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443.

(*t*) Badische Anilin und Soda Fabrik *v* Lovinstein, (1887) L. R. 12 App. Cas. 710, 712; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 313; Kurtz *v.* Spence, (1888) 5 R. P. C. 182; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 510; Edison *v.* Holland, (1888) 5 R. P. C. 283.

(*u*) pp. 162, 163 *ante*.

(*x*) pp. 31, 108 *ante*.

(*y*) Cole *v.* Saqui, (1888) 5 R. P. C. 489; 6 R. P. C. 41.

(*z*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437, 449; American Braided Wire Co. *v.* Thompson, (1888) 5 R. P. C. 113.

by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is incumbent on the defendant to falsify the specification." (*a*) Evidence.

A plea of the insufficiency of the specification puts the plaintiff to the necessity of giving evidence to the effect that the specification does particularly describe and ascertain the nature of the invention, and in what manner it is to be performed.

For the purpose of proving the sufficiency of the specification it is enough for the plaintiff to call workmen of ordinary intelligence engaged in the trade to which the invention relates who are able to state that they can or have actually performed the invention with no other aid than the specification. (*b*)

Under an issue of insufficiency of the specification the plaintiff must prove that it sufficiently describes and ascertains every part of the invention; that it is intelligible to persons of ordinary skill engaged in the trade to which the invention relates; and that the invention is capable of producing the effects specified. (c) If there are any technical terms or terms of art used in the specification which require explanation to make the description intelligible, evidence must be given of their meaning, but the plaintiff is not allowed to correct or explain any error or misdescription unless it be such that it could not possibly mislead. (*d*)

If the defendant can prove that there is anything material stated in the specification which is false (*e*) or calculated to mislead or puzzle a person who might attempt to follow its directions, the patent will be void. (*f*)

The construction of the specification is for the Court, aided by such facts as are admissible, to explain written documents. The ambit of a claim may be largely governed by the state of common knowledge at the date of the patent. (*g*) Evidence of such common knowledge, which is directed merely to fixing the ambit of a claim and not to the invalidity of the patent, is admissible without specification in the particulars of objection. (*h*) The evidence of scientific witnesses is only Proof of infringement.

(*a*) Turner *v.* Winter, (1787) Dav. P. C. 153; 1 T. R. 606.

(*b*) Cornish *v.* Keene, (1835) 1 W. P. C. 503; Shaw *v.* Jones, (1889) 6 R. P. C. 335; Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*c*) p. 164 *ante*.

(*d*) p. 288 *ante*.

(*e*) Bickford *v.* Skewes, (1841) 1 Q. B. 938; Lewis *v.* Marling, (1829) 10 B. & C. 22.

(*f*) pp. 202, 207, 217 *ante*.

(*g*) p. 355 *ante*.

(*h*) Appelby's Twin Roller Chain, (1899) 16 R. P. C. 325; Holliday *v.* Hopponstall, (1889) 6 R. P. C. 326; Boxwell *v.* Cochran, (1895) 12 R. P. C. 169; but see p. 419 *ante*.

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admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and if objected to ought to be rejected. (*i*)

When expert evidence is called for the purpose of explanation, and the first witness explains all that requires explanation, and is not broken down in cross-examination, there is no need to call further expert witnesses on the same points, and it is not admissible to do so. (*k*)

In order to substantiate the allegation of infringement, the plaintiff must prove that the defendant has used the art which forms the subject-matter of the patent, or that he has violated the patent privilege in the manner alleged in the statement of claim. The users or violations in respect of which relief is claimed must of course have taken place during the life time of the patent. (*l*)

And in order to make out his case it is not necessary that the plaintiff should prove that the defendant has used the whole of the art or invention comprised in the patent; it is sufficient to show that he has used any essential part of it. (*m*)

In the event of a patentee owning several patents which together control all known methods of producing a certain article, it may, obviously, be impossible to prove which particular patent has been infringed though it may be manifest that one or other must have been violated. In such a case, the Court would probably grant an injunction, but make an order as to damages suited to the facts of the particular case. (*n*)

The same rule applies to the infringement of all patents, whether they are "pioneer" or "master patents" or not—*i.e.*, in order to make out infringement it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is

(*i*) Seed *v.* Higgins, (1860) 8 H. L. C. 565; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 245.

(*k*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 116.

(*l*) See British Insulated Wire Co. *v.* Dublin United Tramway Co., (1899) 17 R. P. C. 14.

(*m*) Cornish *v.* Keene, (1835) 1 W. P. C. 501; Morgan *v.* Seaward, (1836) 1 W. P. C. 170; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Crane *v.* Price, (1842) 4 M. & G. 580; Hill *v.* Thompson, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; pp. 338–345 *ante*.

(*n*) Saccharin Corporation *v.* Quincy, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification. (*o*) Evidence.

Effect of prior construction of the specification by a Court of equal jurisdiction.

It is sometimes stated that the Court is bound by the construction put upon the specification by a Court of equal or superior jurisdiction in prior proceedings, but this statement is only partially true. When it is a matter of pure construction of the document itself, and the construction is not dependent upon a consideration of the external facts as to prior knowledge, (*p*) or when the conclusion depends on a consideration of external facts, but the materials before the Court are substantially the same as those considered in a previous action, (*q*) the Court, as a matter of convenience to itself, follows the construction adopted by a Court of equal jurisdiction as being a decision on a point of law; (*r*) but whether the claim is too wide is a question of fact which must be decided *de novo* in the light of any fresh evidence as to the state of public knowledge which may be adduced in any subsequent action; (*s*) and generally when the state of public knowledge at the date of the specification is a circumstance which may affect its true construction, (*t*) though a specification has been construed previously by a Court of equal or superior jurisdiction, the Court will consider and reconstrue the specification on a subsequent occasion, if it appears that the facts as regards public knowledge presented to the Court are materially different from those before the Court on the former occasion; (*u*) but new arguments are to be distinguished from and do not have the same effect in this matter as new facts do. (*x*) Further, the fact that a Court of equal jurisdiction has construed the specification with reference to a particular act complained of as an infringement will not

(*o*) Per Romer, J., Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 128.

(*p*) Edison *v.* Holland, (1889) 6 R. P. C. 276; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 367; Patent Exploitation *v.* American Novelty and Manufacturing Co., Ld., (1903) 20 R. P. C. 697.

(*q*) National Opalite Glazed Brick and Tile Co. *v.* Grand Hotel, Birmingham, (1891) 18 R. P. C. 249.

(*r*) p. 265 *ante*; Pneumatic Tyre Co., Ld. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1898) 16 R P. C. 55, 58, 59.

(*s*) Edison *v.* Holland, (1889) 6 R. P. C. 276; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 367; Patent Exploitation *v.* American Novelty and Manufacturing Co., Ld., (1903) 20 R. P. C. 697.

(*t*) pp. 283-284 *ante*.

(*u*) Pneumatic Tyre Co., Ld. *v.* Leicester Pneumatic Tyre and Automatic Valve Co., (1898) 16 R. P. C. 55, 58, 59.

(*x*) *Ibid.* 56.

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deter the Court on a subsequent occasion from considering the construction with reference to another and substantially different act alleged to be an infringement. (*y*)

Defendant himself a patentee.

The fact that the defendant has himself obtained a patent for what he is doing, is in itself no evidence of infringement, and the defendant is not placed thereby in any different position to any other member of the public. The question is what he has in fact done. (*z*)

Evidence must be given to the effect that the alleged infringement was not committed by an agent or under the licence of the patentee.

It must be proved strictly that the alleged infringing article was not made by the plaintiff, or any agent or licensee of the plaintiff. (*a*) Where the plaintiff omits to give this necessary evidence and merely proves the sale of the article by the defendant, an opportunity may be given him of perfecting the evidence, if he is able to do so, after his case is closed. (*b*) For instance, care must be taken in collecting evidence of infringement, that the article relied on as proof of infringement was not made by the alleged infringer under such circumstances that he can contend that what he did was as agent of or in accordance with the instructions of a properly authorised agent of the plaintiff and therefore no infringement. Thus in *Kelley* v. *Bachellor*, (*c*) where a patentee for the purpose of getting evidence of infringement sent an agent to a manufacturer and ordered an article to be made in a particular way which was within the patent, and then, after obtaining it, moved for an interim injunction, the Court dismissed the motion with costs on the ground that the defendant, having worked to the detailed orders of the plaintiff's agent, was not liable as an infringer. This case must be distinguished from one like *Dunlop Pneumatic Tyre Co.* v. *Neal*, (*d*) where the employment of the agent by the plaintiff was only for the purpose of seeing what the defendant would do under given circumstances. The defendant was by injunction restrained till trial from infringing. It appeared that he undertook to repair a worn-out patented article in such manner as practically to make a new one, and the contention that an old article was brought for repair by the plaintiff's agent failed on the ground that the agent had no authority to, and in fact did not, give any detailed

(*y*) Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 17 R. P. C. 147.

(*z*) Tweedale *v.* Ashworth, (1890) 7 R. P. C. 431.

(*a*) Betts *v.* Willmott, (1871) L. R. 6 Ch. 239; 25 L. T. N. S. 181.

(*b*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 389.

(*c*) (1893) 10 R. P. C. 289.

(*d*) (1899) 16 R. P. C. 247.

instructions but merely tested what the defendant would, at his own instigation, do under the circumstances.

If the defendant alleges a licence, it is open to the plaintiff to prove, if he is able to do so, that such licence was given under misapprehension and was therefore not effective. (*e*)

When it is sufficient for the plaintiff to make out a *primâ facie* case of infringement.

There are many cases in which it is impossible to ascertain what it is the defendant has done. Under such circumstances the proper course is for the plaintiff to make out a *primâ facie* case, and if the plaintiff makes out a *primâ facie* case which the defendant does not venture to answer, the Court will conclude that the alleged wrongful acts have been done in the manner which the plaintiff or his witnesses believe. (*f*) The defendant may, however, give evidence to show that what he has done does not amount to a user of the art protected by the patent. Thus he may prove that the articles complained of are substantially different to those described in the specification, or that they were manufactured according to a process different to that claimed by the patentee, and this will be a complete answer to the charge of infringement. (*g*)

If the patent is for a process only and does not include the manufactured article, the *onus* is on the plaintiff to show that the article alleged to have been manufactured in infringement has, in fact, been so made. (*h*) And similarly, if the patent is for the manufacture of any particular machine, the sale of an article made by the machine might be no proof of infringement.

If the plaintiff proves that the defendant has without authority (*i*) sold a patented article he makes out a *primâ facie* case of infringement, and throws the *onus* on the defendant of showing either that he was a licensee of the plaintiff, or that he bought the article from a person who was authorised by the plaintiff to manufacture and sell it. (*k*)

Evidence that a defendant gave an order in England, which order was executed in England, for the manufacture by a

(*e*) Edison-Bell Consolidated Phonograph Co. *v.* Rosenberg, (1899) 16 R. P. C. 608.

(*f*) Huddart *v* Grimshaw, (1803) Dav. P. C. 265; Hall *v.* Jarvis, (1822) 1 W. P. C. 100; Badische Anilin und Soda Fabrik *v.* Dawson, (1889) 6 R. P. C. 337, 396; Edison *v.* Woodhouse, judgment of Butt, J., (1886) 3 R. P. C. 167.

(*g*) Morgan *v.* Seaward, (1837) 1 W. P. C. 171; Walton *v.* Potter, (1841) 1 W. P. C. 585, 589.

(*h*) Palmer *v.* Wagstaffe, (1853) 8 Exch. R. 840; 22 L. J. N. S. Ex. 295; 9 Exch. R. 749; 23 L. J. N. S. Ex. 217.

(*i*) Betts *v.* Willmott, (1870) L. R. 6 Ch. 239.

(*k*) Badische Anilin und Soda Fabrik *v.* Dawson, (1889) 6 R. P. C. 387, 396; Gibson *v.* Brand, (1841) 1 W. P. C. 630.

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patented process of articles which were afterwards received by him, is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures things to be made may well be said to have made them himself. (*l*)

And in the absence of evidence to the effect that articles complained of may have been manufactured by a process different to that comprised in the patent, (*m*) the following facts are *primâ facie* evidence of infringement: similarity of structure in the patented article and the things produced by the defendant where a trade secret is alleged and there has been no inspection by the plaintiff; (*n*) the offering for sale of an article in the state produced by the application of a patented machine where it is proved that the defendant had one such machine in his possession. (*o*)

When a plaintiff must prove that an alleged infringing article was not made under his authority.

Under some circumstances, however, the *onus* is on the plaintiff of proving not merely the sale of the patented article, but, further, that it was not manufactured by himself or under his authority—*e.g.*, where a patentee has manufactories both in England and abroad. (*p*)

Defence that an alleged infringement is a secret process.

Where the defence was that the alleged infringement was an exercise by the defendant of a secret process he was allowed to refuse to answer questions on cross-examination which might disclose his process, and, at his election, evidence was taken *in camerâ* of what the alleged secret process really was, and the shorthand notes of such evidence were ordered to be impounded in Court until there should be an appeal, or until further order. (*q*)

Special provisions of the Act of 1883.

The Patents Act, 1883, contains special provisions with regard to the giving in evidence of, and the effect as evidence of, the seal of the Patent Office, (*r*) the Register of Patents, (*s*) Patent Office copies and certificates of specifications, disclaimers, and other documents or extracts from them, (*t*) and orders and certificates made by the Board of Trade. (*u*)

(*l*) Gibson *v.* Brand, (1841) 1 W. P. C. 631.

(*m*) The Cartsburn Sugar Refining Co. *v.* Sharp, (1884) 1 R. P. C. 181, 186.

(*n*) Huddart *v.* Grimshaw, (1803) 1 W. P. C. 91; Davenport *v.* Richard, (1860) 3 L. T. N. S. 503.

(*o*) Hall *v.* Jarvis, (1822) 1 W. P. C. 100.

(*p*) Betts *v.* Willmott, (1870) L. R. 6 Ch. App. Cas. 239; Société Anonyme, &c. *v.* Tilghman's, &c., Co., (1883) L. R. 25 Ch. D. 1.

(*q*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156, 170.

(*r*) s. 12, sub-ss. 2 and 84.

(*s*) s. 23, sub-s. 2.

(*t*) ss. 89 and 96.

(*u*) s. 102, sub-ss. 2 and 3; also Act of 1888, s. 25.

## TRIAL.

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Jurisdiction of the Courts.

Actions for infringements of patents may be brought in either division of the High Court of Justice, or in the Court of the County Palatine of Lancaster. (*x*) The County Courts have no jurisdiction to entertain an actiõn in which the validity of the patent is in question, because a patent is a franchise and under sec. 56 of the County Courts Act, 1888, a County Court has no cognisance of any action in which the title to any franchise is in question. Moreover a special jurisdiction was given to the High Court by secs. 28, 29, and 117, of the Patents Act, 1883, and it cannot be contended that the later County Courts Act, 1888, gave to County Courts an open jurisdiction in such actions. (*y*)

It is submitted that an action to recover royalties amounting to not more than a hundred pounds could be brought in a County Court, notwithstanding the fact that the ambit of the claim may be disputed by a licensee. (*z*)

Arbitration.

The provisions of the Arbitration Act, 1889, apply to patent actions equally as to other actions.

Trial is usually by the Court alone.

Infringement actions are, in accordance with the express provisions of the Patents Act, 1883, tried without a jury unless the Court directs otherwise. (*a*)

Patent actions are in rare cases tried by jury.

As a rule, patent actions do not require the intervention of a jury, and can be more satisfactorily disposed of by a Judge alone. (*b*) In the words of Lord *Selborne*, L.C., (*c*) "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well

(*x*) R. *v.* Judge of County Court of Halifax, (1891) 8 R. P. C. 344.

(*y*) *Ibid.* 338.

(*z*) Cutlan *v.* Dawson, (1896) 13 R. P. C. 710; 14 R. P. C. 249.

(*a*) 46 & 47 Vict. c. 57, s. 28.

(*b*) Bovill *v.* Hitchcock, (1868) L. R. 3 Ch. 417; Young *v.* Fernie, (1863) 1 De G. J. & S. 353; Downes *v.* Hughes & Co., (1880) 69 L. T. 150; Sugg *v.* Silber, (1874) L. R. 1 Q. B. D. 362.

(*c*) Patent Marine Inventions Co. *v.* Chadburn, L. R. 16 Eq. 447.

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decided by a Judge as by a jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the Judge. It very rarely happens, if it ever does, when a thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the Judge, the direction of the Judge."

*e.g.*, where there is an allegation of fraud.

An allegation of fraud may induce the Court to accede to a request for a jury. Thus in a case where the plaintiff opened fraud, but the defendant's counsel protested that this was not raised by the pleadings and asked for a jury, a trial by jury was allowed and the cause was directed to stand over for that purpose. (*d*)

Juries are rarely asked for now in patent cases, and it is submitted that only where there is an allegation of fraud (*e*) or libel (*f*) would a jury be allowed. (*g*)

Trial by jury cannot be had before a Judge of the Chancery Division of the High Court of Justice. (*h*) Actions commenced in the Chancery Division must be set down in the general list, if they are to be tried by a jury, to be tried by one of the Judges of the Common Law Division.

Trial with the aid of an assessor.

The Court has power to, and on the request of either party it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. (*i*)

In cases where an assessor is called in, the remuneration to be paid to him is determined by the Court, and paid in the same manner as the other expenses of the execution of the Act of 1883. (*k*)

When the case is tried with the assistance of an assessor it is proper for the assessor to furnish a written statement of his opinion to the Judge, and such statement may be read in the Court of Appeal for the reason that without it that Court might not be able to do justice between the parties. (*l*)

(*d*) Tangye *v.* Stott, (1865) 14 W. R. 128.

(*e*) Joseph Lucas, Ld. *v.* Miller, (1899) 17 R. P. C. 165.

(*f*) R. S. C. Order xxxvi. r. 2; Alfred Appleby's Twin Roller Chain, Ld. *v.* Albert Edio Chain, Ld., (1899) 16 R. P. C. 318.

(*g*) Since the Act of 1883 there are only six patent actions reported as having been tried with a jury—viz., Young *v.* Rosenthal, (1884) 1 R. P. C. 29; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229; Edge *v.* Harrison, (1891) 8 R. P. C. 74; Westley *v.* Tolley, (1894) 11 R. P. C. 602; Alfred Appleby's Twin Roller Chain, Ld. *v.* Albert Edio Chain, Ld., (1899) 16 R. P. C. 318; Joseph Lucas, Ld. *v.* Miller, (1899) 17 R. P. C. 165.

(*h*) Warner *v.* Murdoch, (1877) L. R. 4 Ch. D. 750.

(*i*) 46 & 47 Vict. c. 57, s. 28.

(*k*) *Ibid.* s. 28 (3). As to the effect of an assessor's opinion on the judgment of the Court, see The Beryl, L. R. 9 P. D. 137, 141; Hattersley *v.* Hodgson, (1904) 22 R. P. C. 229.

(*l*) Hattersley *v.* Hodgson, (1904) 22 R. P. C. 229.

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Trial of issues separately.

Before the repeal of Lord *Cairns'* Act (*m*) and Sir John *Rolt's* Act, (*n*) the practice had arisen in the Court of Chancery of directing in patent suits the trial of issues relative to the validity of the patent and to the fact of infringement, and, though those Acts are now repealed, (*o*) the jurisdiction which they established is not abolished, (*p*) but is exercised by both divisions of the High Court of Justice, (*q*) though it is not usual to try the issues of validity and infringement on different occasions.

The Court has the power to order any issue of fact in a patent action to be tried before an official referee, (*r*) and to order a trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in the opinion of the Court or a Judge, be tried with a jury, (*s*) or at any time to order any cause, matter, or issue to be tried by a Judge with a jury, or by a Judge sitting with assessors, or by an official referee or a special referee with or without assessors. (*t*)

If it appear to the Court or a Judge that the issues of fact in dispute in a patent action are not sufficiently defined, the parties may be directed to prepare issues, and, if the parties differ, such issues will be settled by the Court or a Judge; (*u*) but issues will not be directed unless the Court is satisfied that there is a real question to try, (*x*) and most probably not at all, if the motion is opposed by the plaintiff, (*y*) or is made after the disclosure of the plaintiff's evidence. (*z*)

If it appear to the Court or a Judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given of any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the Court or a Judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case or in such other manner as the Court or a Judge may

(*m*) 21 & 22 Vict. c. 27.
(*n*) 25 & 26 Vict. c. 42.
(*o*) 46 & 47 Vict. c. 49.
(*p*) Sayers *v.* Collyer, (1884) L. R. 28 Ch. D. 103, 108.
(*q*) 46 & 47 Vict. c. 57, s. 117.
(*r*) 36 & 37 Vict. c. 66, s. 57; Saxby *v.* Gloucester Waggon Co., W. N. (1880) p. 28.
(*s*) R. S. C. (1883) Order xxxvi. r. 5.
(*t*) *Ibid.* r. 7 a.
(*u*) R. S. C. (1883) Order xxxiii. r. 1; see Seton on Decrees, 4th ed. p. 347, for the form of issues.
(*x*) Davenport *v.* Phillipps, (1865) 5 N. R. 485.
(*y*) Henderson *v.* The Runcorn Soap and Alkali Co., W. N. (1868) p. 250; 19 L. T. N. S. 377.
(*z*) Roskell *v.* Whitworth, (1870) L. R. 5 Ch. App. Cas. 459.

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deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed. (*a*)

And, subject to the provisions of the first seven rules of Order xxxiv. of R. S. C. 1883, the Court or a Judge may, in any cause or matter, at any time, or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials, and in all cases may order that one or more issues of fact be tried before any other or others. (*b*)

The Court of Appeal will not readily interfere with a decision of the Court below as to the mode of trial. (*c*)

*Advantages of separate trial of issues.*

It is generally highly inconvenient to try the issues in a patent action separately or before different tribunals, (*d*) but sometimes great expense may be saved to the litigants by adopting this course. (*e*) An order for the trial of the issue of infringement by itself will not be granted, unless the validity of the patent is not only admitted, but admitted in unqualified terms. (*f*)

The following are instances in which special issues may be directed to be tried separately: Where it is alleged that the specification is ambiguous or vague such question of sufficiency of the specification may be determined separately and without evidence; (*g*) or where several users are alleged as anticipations of a patent all the evidence on one alleged user may be taken before going into the others. (*h*) Where, at the trial of an action on a patent which had been repeatedly established, and the Judge was of opinion that the sufficiency of the specification, the utility of the invention, and the fact of infringement had all been proved, he granted an injunction, but ordered an issue as to the novelty of the invention to be tried before a jury. (*i*) And where the plaintiff admitted that, if

(*a*) R. S. C. (1883) Order xxxiv. r. 2.
(*b*) R. S. C. (1883) Order xxxvi. r. 8.
(*c*) Bovill *v.* Hitchcock, (1868) L. R. 3 Ch. App. Cas. 417; Brooke *v.* Wigg, (1878) L. R. 8 Ch. D. 510, 517; Williams *v.* Guest, (1875) L. R. 10 Ch. App. Cas. 467; Ruston *v.* Tobin, (1878) L. R. 10 Ch. D. 558; Hunt *v.* Chambers, (1882) L. R. 20 Ch. D. 365; Wharton *v.* Boffin, W. N. (1883) p. 96; Saxby *v.* Gloucester Waggon Co., W. N. (1880) p. 28.
(*d*) Young *v.* Fernie, (1863) 1 De G. J. & S. 353.
(*e*) Kurtz *v.* Spence, (1888) 5 R. P. C. 170; Muirhead *v.* Commercial Cable Co., (1894) 11 R. P. C. 323.
(*f*) United Telephone Co. *v.* Mottershead, (1886) 3 R. P. C. 213.
(*g*) The Republic of Bolivia *v.* The National Bolivian Navigation Co., (1876) 24 W. R. 361, 362.
(*h*) Richardson *v.* Castrey, (1887) 4 R. P. C. 265.
(*i*) Bovill *v.* Goodier, (1866) L. R. 2 Eq. 195.

the defendant could prove the prior use of a certain article, the patent would be void, the defendant was allowed to call at once his evidence of such prior use, and the action was dismissed. (*k*) Trial.

Reference to a referee.

It is enacted by sec. 56 of the Judicature Act of 1873 that, subject to any Rules of Court, and to such right as existed at the date of the Act to have particular cases submitted to the verdict of a jury, any question arising in any cause or matter (other than a criminal proceeding by the Crown) before the High Court of Justice or before the Court of Appeal, may be referred by the Court or by any Divisional Court or Judge before whom such cause or matter may be pending for inquiry and report to any official or special referee, and the report of any such referee may be adopted wholly or partially by the Court, and may (if so adopted) be enforced as a judgment by the Court.

The power was exercised by *Pearson*, J., in *Badische Anilin und Soda Fabrik* v. *Levinstein*, (*l*) who directed certain experiments to be made by a special referee for the purpose of advising the Court; by the Court of Appeal in *Moore* v. *Bennett*, (*m*) where it was ordered that a special referee should make experiments to test the capability of a certain machine to cut brushes; by *Kay*, J., in *Edison* v. *Holland*, (*n*) where it was ordered that certain of the plaintiff's and defendant's witnesses should make experiments in the presence of a special referee, with a view of ascertaining the sufficiency of the complete specification; and by *Romer*, J., in *North British Rubber Co.* v. *Macintosh*, (*o*) where a reference to an independent expert was ordered on points on which the evidence was directly in conflict. The expert is in such a case usually furnished by the direction of the Court with printed shorthand notes, has access to all the exhibits, and is to be at liberty to make such experiments as he may think desirable. Counsel are at liberty to make observations on the expert's report and the expert then reads the observations and advises the Court.

In certain cases a sufficiently qualified expert could only be found amongst a class of persons who would be likely to have a bias against the patent—*e.g.*, rival manufacturers—and these circumstances induce the Court to

(*k*) Badham v. Bird, (1888) 5 R. P. C. 238.
(*l*) (1883) L. R. 24 Ch. D. 156.
(*m*) (1884) 1 R. P. C. 129, 133.
(*n*) (1888) 5 R. P. C. 459, 479.
(*o*) (1894) 11 R. P. C. 477.

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forego the assistance of an independent expert in such cases. (*p*)

Trial at assizes.

Any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the Judge or Judges to whom, or to whose division, the cause or matter is assigned, require the question or issue to be tried and determined at the assizes or at sittings to be held in Middlesex or London. (*q*)

The rules (*r*) also empower the Court to send an action for trial at assizes with the object of getting an early trial whenever on an application before trial for an injunction or other order it appears that the matter in controversy is one which can be most conveniently dealt with by an early trial without first going into the whole merits on affidavit or other evidence for the purpose of the application.

To whatever division of the High Court an action may be attached, if it has been ordered to be tried at the assizes the Judge has no power, except the interests of justice so require, to remit it for trial in London. (*s*)

Acceleration of trial.

Actions set down for trial in the Chancery Division may, upon the application of the plaintiff, even without the consent of the defendant, by order of the Court be advanced out of their turn for hearing if a proper reason be shown—*e.g.*, that delay would cause the loss of the object of the action. (*t*)

Where a plaintiff patentee of a chemical dye applied for the acceleration of the trial on the ground that new dyes were being continuously introduced and the trade in the patented dye could not be relied upon for long, and the defendant was offering the alleged infringing goods at reduced prices to the consequent detriment of the plaintiff's trade, the Court refused to expedite the trial for the reason that, if the plaintiff's case was well founded, he could get compensation in damages, and there was no ground, therefore, for giving him priority over other suitors. (*u*)

(*p*) Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 891.

(*q*) 36 & 37 Vict. c. 66, s. 29. The following actions were tried at assizes: Miller *v.* Searle, (1893) 10 R. P. C. 106; Legge *v.* Wakelan, (1893) 10 R. P. C. 379; Allen *v.* Duckett, (1893) 10 R. P. C. 397; Allen *v.* Horton, (1893) 10 R. P. C. 412; Westley *v.* Tolley, (1894) 11 R. P. C. 602; John Vasey, Ld. *v.* Walker, Mitchell & Co., (1899) 16 R. P. C. 596; Joseph Lucas, Ld. *v.* H. Miller & Co., (1899) 17 R. P. C. 165; Crossley *v.* Coates, (1904) 21 R. P. C. 282.

(*r*) S. C. R. (1883) Order l. r. 1 a.

(*s*) Fairbairn *v.* Household, (1885) 2 R. P. C. 195.

(*t*) S. C. R. (1883) Order xxxvi. r. 16 *n.*

(*u*) Farbenfabriken vorm F. Bayer & Co. *v.* Bowker, (1890) 8 R. P. C. 136.

Trial.

Where issues have been ordered to be tried, or questions of fact to be determined in any manner, the plaintiff may set down a motion for judgment as soon as such issues or questions have been determined. If he does not set down such a motion, and give notice thereof to the other parties within *ten days* after the right so to do has arisen, then, after the expiration of such ten days, any defendant may set down a motion for judgment, and give notice thereof to the other parties. (*x*) And where issues have been ordered to be tried, or questions of fact to be determined in any manner, and some only of such issues or questions of fact have been tried or determined, any party who considers that the result of such trial or determination renders the trial or determination of the others of them unnecessary, or renders it desirable that the trial or determination thereof should be postponed, may apply to the Court or a Judge for leave to set down a motion for judgment without waiting for such trial or determination. And the Court or a Judge may, if satisfied of the expediency thereof, give such leave upon such terms, if any, as shall appear just, and may give any directions which may appear desirable as to postponing the trial of the other issues of fact. (*y*)

Motion for judgment on determination of a separate issue.

Any party may at any stage of a cause or matter where admissions of fact have been made, either on the pleadings or otherwise, apply to the Court or a Judge for such judgment or order as upon such admissions he may be entitled to, without waiting for the determination of any other question between the parties; and the Court or a Judge may upon such application make such order, or give such judgment, as the Court or Judge may think fit. (*z*) If a plaintiff moves for judgment under this power on admissions in the pleadings, he is bound by statements made in the defence, and thus where a defendant admitted ten, but denied any further infringements, an inquiry as to damages was limited to the ten admitted infringements. (*a*)

Motion for judgment on an admission of fact.

If the defendant do not appear, the plaintiff may on motion obtain judgment and the usual certificates upon formal proof of his title and the fact of infringement. (*b*) In one case

Judgment when a defendant does not appear.

(*x*) R. S. C. (1883) Order xl. r. 7.

(*y*) R. S. C. (1833) Order xl. r. 8; Fernie *v.* Young, (1866) L. R. 1 H. L. 63; Macdougall *v.* General Sewage and Manure Co., (1875) W. N. 61; Tangye *v.* Stott, (1865) 14 W. R. 386.

(*z*) R. S. C. (1883) Order xxxii. r. 6.

(*a*) United Telephone Co. *v.* Donohoe, (1886) L. R. 31 Ch. D. 399.

(*b*) Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488; Edison United Phonograph Co. *v.* Young, (1894) 11 R. P. C. 489. Surprise may be a ground for a new trial: Incandescent Gas Light Co. *v.* New Incandescent Mantle Co., (1897) 15 R. P. C. 81; Brooks *v.* Lycett, (1903) 20 R. P. C. 390.

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where judgment went by default the Court refused to hear counsel on behalf of the defendant in another pending action on the same patent in which an order had been made that the first action should be treated as a test case and the judgment should bind the parties to the second action. (*c*) The defendant to the second action could no doubt under such circumstances get the order set aside upon proper motion to the Court.

When there are two defendants—*e.g.*, the manufacturer and a user, and one—*e.g.*, the user—puts in no defence and refuses to submit to judgment, the Court will not give leave to the plaintiff to set down the action on motion for judgment against such defendant, because the other defendant may be able to prove the patent void, in which case the first defendant would be entitled to the benefit of the decision. (*d*)

Judgment by consent.

If judgment is obtained by consent against a defendant, such defendant may withdraw his consent before the judgment has been entered, but he will not, except under very special circumstances, be allowed to do so, when he has stated that he will not require evidence to be filed in support of the plaintiff's application, and then seeks to allege a mistake of fact with regard to infringement. (*e*)

Certificates should be asked for at the conclusion of the trial.

Judgment may be obtained by consent in respect of part of the cause of action, and such consent may be given in the defence. (*f*)

At the conclusion of the trial counsel on behalf of the successful party should not omit to ask the Judge to certify his particulars as reasonable and proper and, if the plaintiff is the successful party, that the validity of the patent came in question. These certificates are most important on taxation. (*g*)

Documents and evidence not actually produced and given at the trial should not be inserted in the minutes of judgment. (*h*)

## Consolidation of Actions.

Actions may be consolidated,

When a patentee brings several actions on the same patent against different defendants, they may be consolidated, so that the validity of the patent and any other issues common

(*c*) Edison United Phonograph Co. *v.* Young, (1894) 11 R. P. C. 489.

(*d*) Actien Gesellschaft für Cartonnagen Industrie *v.* Remus, (1895) 12 R. P. C. 94.

(*e*) Pneumatic Tyre Co. *v.* Cash Cycle Co., (1897) 14 R. P. C. 177, 326.

(*f*) Badische Anilin und Soda Fabrik *v.* Hickson, (1904) 22 R. P. C. 63.

(*g*) pp. 518-531 *post*.

(*h*) Shoe Machinery Co. *v.* Cutlan (No. 2), (1896) 13 R. P. C. 395.

to all the actions may be tried once for all in one action; (*i*) and actions pending in the same division are now to be consolidated in the manner in use before the commencement of the Judicature Act, 1873, in the superior Courts of Common Law. (*j*)

New Trial.

Actions can only be consolidated at the instance of the defendants, (*k*) and at Common Law a plaintiff could not be bound without his consent by the result of one action, but could after an adverse verdict proceed with any of the others. (*l*)

but only at the instance of the defendants.

Where several actions are brought by different plaintiffs against the same defendants the Court will, on the application of the plaintiffs, make an order enlarging the time for taking the next step in several of the actions, and staying proceedings therein till after one has been tried as a test action. (*m*)

Several actions by different plaintiffs against the same defendant.

It was held at Common Law that a consolidation could be made as soon as the defendants had appeared, and before declaration; (*n*) and where the defendants to several actions, by a consolidation order, consented to be bound by the result of one action, and the defendant in that action, which was decided against him, neglected to appeal, it was held that a defendant to one of the other actions had no equity to be allowed to carry the case to a superior Court. (*o*)

Time when a consolidation order can be made.

## New Trial.

If, after the trial of a patent action, either party considers that he is entitled to a new trial, and desires to obtain one accordingly, the proper procedure is, if the action was tried with a jury, to apply by motion to the Court of Appeal; and, if the action was tried without a jury, the procedure is by appeal to the Court of Appeal. (*p*)

Procedure to obtain a new trial.

Where, after the reversal by the Court of Appeal of a judgment obtained by fraud, the respondents sought a rehearing of the appeal with fresh evidence, it was held that the Court

(*i*) Foxwell *v.* Webster, (1863) 4 De G. J. & S. 77; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 148, 389.

(*j*) R. S. C. (1883) Order xlix. r. 8.

(*k*) Lush's Practice, 3rd ed. 965; Amos *v.* Chadwick, (1876) L. R. 4 Ch. D. 869.

(*l*) Lush's Practice, 3rd ed. p. 965.

(*m*) Amos *v.* Chadwick, (1876) L. R. 4 Ch. D. 869; Bennett *v.* Lord Bury, (1880) L. R. 5 C. P. D. 339.

(*n*) Lush's Practice, 3rd. ed. p. 965.

(*o*) Thomas *v.* Winter, (1867) 17 L. T. N. S. 148.

(*p*) R. S. C. (1883) Order xxxix. r. 1; Hunt *v.* City of London Real Property Co., (1877) L. R. 3 Q. B. D. 19; Edison *v.* Shippey, (1887) 4 R. P. C. 473.

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had no jurisdiction to rehear the appeal, but that the proper course was an original action, analogous to a suit under the old practice to set aside a decree as obtained by fraud. (*q*)

## APPEAL.

Procedure.

All appeals of the Court of Appeal must be by way of rehearing, (*r*) and must be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion, is necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion must state whether the whole or part only of such judgment or order is complained of, and in the latter case must specify such part. (*s*)

It is not, under any circumstances, necessary for a respondent to give notice of motion by way of cross-appeal, but if a respondent intends, upon the hearing of the appeal, to contend that the decision of the Court below should be varied, he must, within eight days, or such time as may be specified by special order, give notice of such intention to any parties who may be affected by such contention. (*t*)

Power of Court of Appeal to order a new trial.

If, upon the hearing of an appeal, it appears to the Court of Appeal that a new trial ought to be had, the Court of Appeal has power, if it thinks fit, to order that the verdict and judgment shall be set aside, and that a new trial shall be had. (*u*)

Security for costs of appeal.

An appellant may be ordered to give security for the costs of the appeal; (*x*) and if such security is not given within a reasonable time, an order will, in the absence of extenuating circumstances, be made for the immediate dismissal of the appeal. (*y*)

If a respondent contends that the appellant ought to be ordered to give security for costs, he must apply to the

(*q*) Flower *v.* Lloyd, (1877) L. R. 6 Ch. D. 297.

(*r*) As to the effect of a finding of fact by the Judge of first instance on the Court of Appeal, see Haggenmacher *v.* Watson, (1897) 14 R. P. C. 634, judgment of Esher, M.R.; see also p. 485 *post*.

(*s*) R. S. C. (1883) Order lviii. r 1. As to service of notice of motion, and time within which appeals are allowed, see R. S. C. (1883) Order lviii. rr. 2–19.

(*t*) R. S. C. (1883) Order lviii. rr. 6 and 7.

(*u*) R. S. C. (1883) Order lviii. r. 5.

(*x*) R. S. C. (1883) Order lviii. r. 15.

(*y*) Washburn and Moen Manufacturing Co. *v.* Patterson, (1885) L. R. 29 Ch. D. 48; Owens' Patent, (1900) 17 R. P. C. 637; Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co., (1903) 20 R. P. C. 288.

appellant before moving the Court for such order, otherwise he will be liable to the costs of the application. (*z*) Appeal.

If a defendant becomes bankrupt, after setting down an appeal, the appeal cannot be proceeded with unless he give security for costs or the trustee in bankruptcy is made a party to the proceedings, (*a*) but on giving security for costs in such a case he is entitled to proceed with the appeal. (*b*)

It has been held not to be sufficient ground for postponing an appeal that the plaintiff was abroad, but desired to attend and instruct his counsel. (*c*) Postponement.

The Court of Appeal has power to admit evidence not given in the Court below, and may allow an amendment of the particulars for this purpose, (*d*) or in its discretion admit the fresh evidence, though it is not within the particulars originally delivered, without ordering an amendment of such particulars. (*e*) Fresh evidence on appeal.

An application for an order to allow further evidence on appeal is not likely to be successful unless the applicant can show a reasonable probability that, if the further evidence were given, a result might be looked for different to that arrived at by the Judge below. (*f*) For instance, where the Judge below decided that a patent was bad because two prior users were proved, the appellant was not allowed to give further evidence on appeal with reference to one of the prior users on the ground that the Appeal Court were of opinion that the further evidence did not affect the other prior user and that the decision of the Judge below was right as to that. (*g*) Again, an appellant will not be allowed to give further evidence on appeal, unless it can be shown that he could not have tendered the evidence at the hearing in the Court below, (*h*) or that the defendant has been misled, (*i*) though he would be allowed to cure a merely formal defect in his title. (*k*)

Where a party is allowed to adduce fresh evidence on appeal, on taxation, the costs of getting up such further

(*z*) Garrard *v.* Edge, (1890) 7 R. P. C. 139.

(*a*) United Telephone Co. *v.* Bassano, (1886) L. R. 31 Ch. D. 630.

(*b*) *Ibid.*

(*c*) Walker *v.* Hydrocarbon Syndicate, (1886) 3 R. P. C. 253.

(*d*) pp. 396, 413 *ante.*

(*e*) p. 455 *ante.*

(*f*) Gammons *v.* Singer Manufacturing Co., (1904) 22 R. P. C. 459.

(*g*) *Ibid.*

(*h*) Hinde *v.* Osborne, (1885) 2 R. P. C. 45; Walker *v.* Hydrocarbon Syndicate, (1886) 3 R. P. C. 253; Blakey *v.* Latham, (1889) 6 R. P. C. 184.

(*i*) American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C. 113, 118.

(*k*) Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61, judgment of Lindley, L.J.

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evidence is matter for the discretion of the Taxing Master in the usual way, but the costs of witnesses attending the appeal but not heard, should not be allowed. (*l*)

If the defendant's witnesses at the trial give evidence of anticipations not within the particulars, and the plaintiff chooses not to ask for an adjournment to consider them, the Court of Appeal will not allow fresh evidence to be adduced by the plaintiff with regard to them. (*m*) And if the defendant in the Court below does not call evidence, but elects to rest his case on the admissions of the plaintiff's witnesses, the Court of Appeal will refuse to allow him to call fresh evidence for the purpose of making out a case, which, in the opinion of the Court of Appeal differing from the Judge below, was not substantiated by such admissions. (*n*) In general the Court of Appeal will not accede to a request for leave to call fresh evidence when the application is substantially an attempt to retry the action on new materials. (*o*)

The cases in which an appellant is allowed to adduce fresh evidence in a patent action are, *e.g.*, where he is able to show that he could not have tendered the evidence in the Court below, (*p*) or where a party has been misled, (*q*) or he desires to cure a mere formal defect in his title, (*r*) or to produce a lost document, which has been found since the trial, (*s*) or there is some other special reason why the fresh evidence should be admitted to avoid an injustice being done. (*t*)

Issues abandoned below.

If a party in the Court below abandons an issue, the Court of Appeal will not allow it to be raised on appeal. Thus, where the plaintiff's witnesses admitted in the Court below that, if an alleged anticipation was in fact made prior to the patent as stated, it was a complete anticipation, and the plaintiff fought the case solely on the contention that the alleged anticipating machine was in fact not made, and at the same time charged the defendant with fraudulently altering it as originally constructed, the Court of Appeal refused to allow the appellant plaintiff to raise the question

(*l*) Leeds Forge Co., Ld. *v.* Deighton's Patent Flue and Tube Co., Ld., (1903) 20 R. P. C. 185.

(*m*) Barcroft *v.* Smith, (1897) 14 R. P. C. 172.

(*n*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 480.

(*o*) See Nadel *v.* Martin, (1903) 2 R. P. C. 721.

(*p*) Hinde *v.* Osborne, (1885) 2 R. P. C. 45; Walker *v.* Hydrocarbon Syndicate, (1886) 3 R. P. C. 253; Blakey *v.* Lathom, (1889) 6 R. P. C. 184.

(*q*) American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C. 113, 118.

(*r*) Nordenfelt *v.* Gardner, (1881) 1 R. P. C. 61.

(*s*) Hinde *v.* Osborne, (1885) 2 R. P. C. 45.

(*t*) *Ibid.*

that though the alleged anticipation in question was made as stated yet it was no anticipation in fact, and dismissed the appeal with costs. (*u*) Appeal.

Notwithstanding that the only question on appeal is the issue of infringement, the Appellate Court will consider the particulars of objection for the purpose of ascertaining the state of public knowledge at the date of the patent whereby to properly construe the ambit of the patentee's claim. (*x*) Particulars of objection when appeal is in respect of infringement only.

There is no presumption that the Court of Appeal or the House of Lords ought not to interfere with what the Judge of first instance has done with regard to matters of fact; but, on the contrary, the Appellate Court, in which both fact and law are open to review, is bound to pronounce such judgment as, in their view, ought to have been pronounced by the lower Court; and it is not competent to the Appellate Court to say that they would have pronounced a different judgment, if they had been Judges of first instance, but because the Judge has pronounced a certain judgment they will adhere to his decision. (*y*) Decisions on facts as well as law may be reversed on appeal.

The preceding paragraph must be taken, of course, as applicable only to cases which are originally tried without a jury, and the appeal is, consequently, not governed by the rules applicable to new trials after trial and verdict by a jury. Further, when there is a question of the relative credibility of different witnesses, the Court is always fully sensitive of the great advantages the Judge below has had in seeing and hearing such witnesses. (*z*) On the other hand, circumstances quite apart from manner and demeanour may show whether a statement is credible or not, and may well warrant the Appellate Court in differing from the Judge, even on a question of fact turning on the credibility of witnesses whom the Appellate Court has not seen. (*a*)

In *Parkinson* v. *Simon*, (*b*) the Court of Appeal stated a rule to the effect that when two distinct points have been argued in the Court below, and the Court of Appeal is obliged to dismiss the appeal on a consideration of one point alone, yet to render Decision of several points when one is sufficient.

(*u*) Westley, Richards & Co. v. Perkes, (1893) 10 R. P. C. 181, 382.

(*x*) Morris *v.* Young, (1895) 12 R. P. C. 455.

(*y*) Riekmann *v.* Thierry, (1897) 14 R. P. C. 105, 116; but see Haggenmacher *v.* Watson, (1897) 14 R. P. C. 634, judgment of Esher, M.R.

(*z*) See observations of Lindley, M.R., Coghlan *v.* Cumberland, [1895] 1 Ch. 704; and Esher, M.R., Haggenmacher *v.* Watson, (1897) 14 R. P. C. 634.

(*a*) *Ibid.*

(*b*) (1895) 11 R. P. C. 493; see also Deeley's Patent, (1896) 12 R P. C. 192, 197.

Perpetual Injunction.

further litigation between the parties more unlikely the Court will give a decision on the other point also. In the same case, however, the House of Lords (*c*) dismissed the appeal on the same ground as the Court of Appeal, but declined to express any opinion on the second point, and did not call upon the respondent's counsel to argue it. And during the argument their Lordships stated that the practice of giving decisions (which only amount to *dicta*) on issues not necessary to decide on appeal is not to be recommended, and will not be adopted by their Lordships' House.

Decision of Court of Appeal in absence of respondent.

A decision of the Court of first instance may be reversed by the Court of Appeal, notwithstanding the absence of a respondent who does not appear at the hearing in the Appellate Court. (*d*)

Interest on costs paid by successful appellant to respondent.

A judgment of the House of Lords for the appellant with costs involves the return by the respondent to the appellant of the costs paid by him together with interest, if any, paid by the appellant to the respondent, and interest at four per cent. from the Court of Appeal decision to the date of return after the House of Lords decision. (*e*)

## Perpetual Injunction.

Successful plaintiff is usually entitled to a perpetual injunction.

If at the trial of an action the plaintiff succeeds in conclusively (*f*) proving that the defendant has infringed, and the validity of the patent, together with the plaintiff's title, is established, one of the remedies to which he is usually entitled is a perpetual injunction (*g*) restraining the defendant from repeating the acts complained of during the continuance of the monopoly.

Injunction by consent.

And where the defendant is desirous and willing to consent to a perpetual injunction without bringing the action to a trial, it may be obtained, by the consent of both parties, on the hearing of the motion, (*h*) or by summons in chambers. (*i*) With the object of preventing misrepresentation, the Court, sometimes, prefers to accept the undertaking of the defendant instead of granting an injunction. (*k*) A

(*c*) 12 R. P. C. 403.

(*d*) Pneumatic Tyre Co. *v.* Caswell, (1896) 13 R. P. C. 375.

(*e*) Ashworth *v.* English Card Clothing Co., Ld., (1904) 21 R. P. C. 355.

(*f*) Hill *v.* Evans, (1862) 4 De G. F. & J. 288.

(*g*) Shelfa *v.* City of London Electric Lighting Co., [1895] 1 Ch. 287, 310, 311.

(*h*) Morrell *v.* Pearson, (1849) 12 Beav. 284.

(*i*) 46 & 47 Vict. c. 57, s. 30; Judicature Act, 1873, s. 39; Frearson *v.* Loe, (1877) 26 W. R. 138.

(*k*) See Dover *v.* New Townend Cycle Co., Ld., (1903) 21 R. P. C. 135; Badische Anilin und Soda Fabrik *v.* Spivey, (1904) 22 R. P. C. 65.

defendant is entitled to withdraw his consent to a perpetual injunction if it was given under mistake or surprise. (*l*)

**Perpetual Injunction.**

The Court does not invariably grant an injunction on proof of an invasion of the plaintiff's rights under the patent. An injunction does not in such circumstances follow as matter of course, but is in the discretion of the Court. (*m*)

**Injunction is not a matter of course.**

Usually the injunction restrains the defendant, his servants, agents, or workmen from infringing the patent; (*n*) but sometimes it is directed to the infringement of the patent in a particular way only—*e.g.*, by making a specific article complained of—if the plaintiff's rights are thereby sufficiently protected. (*o*)

Acquiescence on the part of the plaintiff may induce the Court to refuse an injunction and merely grant damages, or an account of profits. (*p*)

**Acquiescence.**

Though *laches* may disentitle a plaintiff to an interlocutory injunction, (*q*) yet delay to enforce a legal right does not prevent a person from bringing an action, provided it does not cause a statutory bar; (*r*) and, consequently, delay or acquiescence, which would prevent the plaintiff from succeeding on an interlocutory application, may be no bar to his right to a perpetual injunction at the trial, (*s*) and to damages or an account. (*t*)

In the event of proof of infringement of at least one of several patents of different dates (*e.g.*, governing all known methods of production of a certain article), but doubt as to which one has been infringed if one of the patents sued on expired before judgment, the Court will not grant an injunction; though it may allow an inquiry as to damages, which it would appear should be limited to acts done during the

(*l*) Elsas *v.* Williams, (1884) 1 Times Rep. 144.

(*m*) See Lord Cairn's Act, 21 & 22 Vict. c. 27; Shelfa *v.* City of London Electric Lighting Co., [1895] 1 Ch. 257, and Betts *v.* De Vitre, (1864) 11 Jur. N. S. 9; Geary *v.* Norton, 1 De G. & S. 4; Proctor *v.* Bayley, (1889) 6 R. P. C. 537; Lyon *v.* Goddard, (1893) 10 R. P. C. 135; Jenkins *v.* Hope, (1895) 13 R. P. C. 57; Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143.

(*n*) Setou, p. 352; see Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 359.

(*o*) See Dunlop Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 15 R. P. C. 389; 16 R. P. C. 16.

(*p*) Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

(*q*) pp. 427, 428 *ante*.

(*r*) Three Towers Banking Co. *v.* Maldoven, (1884) L. R. 27 Ch. D. 523; Wood *v.* Lambert, (1886) 3 R. P. C. 84.

(*s*) Fullwood *v.* Fullwood, (1878) L. R. 9 Ch. D. 176; Johnson *v.* Wyatt, (1863) 2 De G. J. & S. 18, 25; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; Bacon *v.* Spottiswoode, (1839) 1 Beav. 382; Aluminium Co. *v.* Domeiere, (1887) 15 R. P. C. 32.

(*t*) Bovill *v.* Crete, (1865) L. R. 1 Eq. 388.

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concurrency of all the patents sued on. (*u*) Where under similar circumstances all the patents sued on are current at the date of judgment an injunction and inquiry may be obtained, limited to the period covered by the oldest patent; (*x*) and an action so founded in Scotland has been held to be relevant. (*y*)

Expiry of the patent before conclusion of the action.

Generally speaking, the Court will not grant an injunction if the patent has expired before the commencement or during the course of an action; (*z*) but where it appeared that the patent would expire in a few days, and that the defendant had piratically manufactured a large stock of the patented article ready to throw on the market as soon as the monopoly was at an end, *Lyndhurst*, L.C., granted an injunction to restrain the sale of such articles both before and after the term limited by the grant of the patent. (*a*)

Absence of evidence of an intention to continue infringements.

Also, if the defendant has committed only one act of infringement and there is no evidence of an intention on his part to infringe again, the Court does not usually grant the plaintiff an injunction. Thus, where it was proved that the defendant was guilty of only one act of user, and the Judge was satisfied that the defendant had no intention of infringing again, the Court did not grant an injunction, but awarded a small sum by way of damages and gave the plaintiff liberty to apply for an injunction in case of necessity thereafter. (*b*) And where the defendant refused to submit to an injunction, but after writ issued and before statement of claim delivered offered to account for the profits made by the sale of infringing articles, to deliver up all such in his possession, to give a perpetual undertaking not to infringe, and to pay costs of the action, the Court held that the plaintiff was entitled to have his legal right recognised, but considering the smallness of the matter the defendant's undertaking not to manufacture or sell was sufficient and no injunction was granted, and the Court made certain provisions as to the costs of the action. (*c*)

(*u*) See Saccharin Corporation, Ld. *v.* Quincy, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

(*x*) Saccharin Corporation, Ld. *v.* Dawson, (1902) 19 R. P. C. 16.

(*y*) Saccharin Corporation, Ld. *v.* Ross, (1905) 22 R. P. C. 246.

(*z*) Betts *v.* Gallais, (1870) L. R. 10 Eq. 392; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; 35 L. J. Ch. 204; Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) 4 K. & J. 727; Smith *v.* L. & S. W. Ry. Co., (1854) Macr. P. C. 209; 23 L. J. Ch. 562; Kane *v.* J. Boyle & Co., (1901) 18 R. P. C. 325.

(*a*) Crossley *v.* Beverley, (1829) 3 Car & P. 513; 1 Russ. & M. 166 *n.*; 1 W. P. C. 119; see also Crossley *v.* Derby Gas Co., (1834) 4 L. J. Ch. 25.

(*b*) Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143.

(*c*) Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

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Where, after the plaintiff had obtained an interlocutory injunction, the defendant removed the alleged infringing parts from a machine, the plaintiff, at the trial, was awarded a perpetual injunction together with an account of profits and costs, on the ground that the defendant had, in fact, infringed, and had not submitted on the hearing of the interlocutory motion to the relief which the plaintiff asked for. (*d*)

Certain infringements may be exempted from injunction.

When an injunction is granted, if in the interests of justice it is desirable, certain infringements contemplated may be excluded from its operation. Thus, when the defendant had before trial accepted orders for infringing machines, and the plaintiff at the trial elected to take an account of profits in lieu of damages, the defendant agreeing to bring into the account any machines then under order, the Court granted an injunction, and made it operate immediately, but suspended its operation as to orders then accepted but not executed till the hearing of appeal, if notice of appeal should be given within three days of the drawing up of the order. (*e*) But where the infringing machines had been ordered since the commencement of the action, though they were not completed before judgment, no stay of the injunction was allowed. (*f*)

Stay of injunction pending an appeal.

It is not usual for the Court to stay the injunction. In special and important cases, however, when it is obvious that, if an appeal which will be made, is successful, the injury caused to the defendant by the injunction continuing would be great, without any corresponding advantage to the plaintiff, the Court will suspend the operation of the injunction, and possibly also the taking of an account or inquiry as to damages pending the appeal. (*g*)

Licence in lieu of injunction pending appeal.

Where the justice of the case requires it, the Court will, in lieu of a stay of the injunction, allow the defendant to go on with his business provided he accepts a licence from the plaintiff without prejudice to the appeal, and upon the undertaking of the plaintiff to return the royalties if he is unsuccessful in the appeal, and such relation between the parties should be made continuous to the decision of the House of Lords

(*d*) Edison-Bell Phonograph Corporation *v.* London Phonograph Co., (1894) 11 R. P. C. 471.

(*e*) Lyon *v.* Goddard, (1893) 10 R. P. C. 135; see also Ducketts *v.* Whitehead, (1895) 12 R. P. C. 191.

(*f*) Lyon *v.* Goddard (No. 2), (1893) 10 R. P. C. 348.

(*g*) North British Rubber Co. *v.* Macintosh, (1894) 11 R. P. C. 489; Franklin, Hocking & Co. *v.* Fraser, (1885) 3 R. P. C. 7; Young *v.* Morris, (1894) 11 R. P. C. 214; National Opalite Glazed Brick and Tile Syndicate *v.* Ceralite Syndicate, (1896) 13 R. P. C. 658.

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in the event of the plaintiff succeeding in the Court of Appeal and the defendant deciding to take the case to the Lords. (*h*)

Injunction to restrain threatened infringements.

Although no actionable infringement has been committed, and consequently there could be no claim to damages, yet, if there is an evident intention on the part of the defendant to infringe, the Court will grant an injunction. (*i*) Thus, where it appeared that the defendants had opposed the plaintiff's application for a patent, and had infringed it during the interval between the filing and acceptance of the specification, and also subsequently, the Court, though there was no actionable infringement, granted its injunction on the ground that there was an evident intention to infringe. (*k*)

Injunction becomes inoperative if the specification is amended.

If a plaintiff, after having obtained an injunction, amends the specification, the injunction becomes inoperative, and in the event of fresh infringements by the defendant the plaintiff must proceed *de novo*. (*l*)

Breach of injunction.

As a rule, the breach of an injunction of the Court is a contempt, which renders the party guilty of it liable to committal, and it is no answer for a defendant to say that he did not intend to commit the contempt, for if he has actually infringed after injunction he is guilty of contempt, (*m*) and none the less may he be guilty though only one act is relied on by the plaintiff who seeks his committal. (*n*)

Motion for committal.

In all cases of motion for committal, where the liberty of the subject is involved the strictest proof is necessary, both as regards the fact of infringement, (*o*) and that the defendant is a person enjoined by the injunction, or a person who, with knowledge of the injunction, has wilfully aided and abetted a person or persons enjoined, (*p*) and proper and accurate compliance with the rules relating to service. (*q*) The copy of the

(*h*) See Jandus Arc Lamp and Electric Co., Ld. *v.* Arc Lamp Co., (1905) 22 R. P. C. 298.

(*i*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48; Dowling *v.* Billington, (1890) 7 R. P. C. 191; The Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 342; see also pp. 384, 399 *ante*.

(*k*) Dowling *v.* Billington, (1890) 7 R. P. C. 191.

(*l*) Dudgeon *v.* Thompson, (1879) L. R. 3 App. Cas. 34.

(*m*) Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 288; Thompson *v.* Moore, (1889) 6 R. P. C. 426, 445; Farbenfabriken vorm F. Bayer *v.* Laporte, (1894) 11 R. P. C. 190; Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*n*) Welsbach Incandescent Gas Light Co., Ld. *v.* Keegan, (1899) 17 R. P. C. 44.

(*o*) Dick *v.* Haslam, (1891) 8 R. P. C. 196; Edison-Bell Phonograph Co. *v.* Smith, (1894) 11 R. P. C. 164.

(*p*) See Incandescent Gas Light Co. *v.* Sluce, (1900) 17 R. P. C. 173.

(*q*) R. S. C. (1883) Order lxvii. r. 1; Taylor *v.* Roe, 68 T. R. 213; *re* Evans, 9 T. R. 109; Hall *v.* Trigg, (1897) L. R. 2 Ch. at p. 222; Incandescent Gas Light Co. *v.* Morgan, (1889) 17 R. P. C. 44; Incandescent Gas Light Co. *v.* Riemer, (1900) 17 R. P. C. 378.

order served must be accurate in every particular. (r) A plaintiff desiring the committal of the defendant for breach of an interim or perpetual injunction must be careful to perfect his evidence before moving, for should he fail a subsequent application on the ground of better evidence, in respect of the same alleged breach, will most probably be refused in accordance with the maxim, *nemo debet bis vexari pro una et eadem causa.* (s) It is to be observed that there is a distinction between the procedure on attachment and committal. In the latter, which is the appropriate remedy when a defendant has done something which the Court has ordered him not to do and therefore applies to breach of an injunction in a patent case, service of the order is not absolutely necessary, and a defendant may be committed if the Court is satisfied that the order was brought to his knowledge, although not formally served upon him. In the case of attachment, which is the appropriate remedy where a defendant has failed to do something which the Court ordered him to do, the procedure requires the service of the order by producing the original or an office copy, and leaving an accurate copy with the person served. (t)

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The following circumstances illustrate the necessity for accurate proof of the fact of infringement. An injunction was granted, and the defendant undertook to continue a previous undertaking not to part with infringing articles in his possession or under his control in this country, and the plaintiff on motion to commit failed to show that certain articles alleged to have been parted with, in breach of the undertaking, were, in fact, in the possession of, or under the control of, the defendant on the date on which the injunction was obtained, the Court refused an order for committal, but gave no costs, on the ground that the circumstances were suspicious and the plaintiff was justified in bringing on the motion. (u)

There may be cases in which a breach of an injunction of the Court is not only justifiable but a positive duty. Thus, *James*, L.J., in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with

Breach of injunction may under certain circumstances be justifiable.

(r) *Re* Holt, (1879) L. R. 11 Ch. D. 168.

(s) See, *e.g.*, Badische Anilin und Soda Fabrik *v.* Thompson, (1904) 21 R. P. C. 469.

(t) R. S. C. (1883) Order lxvii. r. 1; see also re Holt, (1879) L. R. 11 Ch. D 168; Incandescent Gas Light Co. *v.* Sluce, (1900) 17 R. P. C. 173.

(u) Edison-Bell Phonograph Co. *v.* Smith, (1894) 11 R. P. C. 164.

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which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated —it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. And, for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter." (*x*)

It is doubtful whether, on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivering up of the infringing articles. (*y*)

Expiry of the patent is an answer to a motion for committal.

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that, since the injunction, the patent has expired, and that the acts complained of were done subsequently to such expiration, (*z*) or that, since the injunction was granted, the specification has been amended and so the injunction has become inoperative. (*a*)

Acts done since injunction granted, which are different in nature though similar to those in respect of which the injunction was granted.

When the defendant after injunction does something different to what he did before injunction, and the plaintiff wishes to restrain him on the ground that in the opinion of the plaintiff it is an infringement, the usual way to raise the question is by motion to commit, (*b*) or in the case of a limited company sequestration against the company and attachment against the directors. (*c*) In one such case, where it appeared that the article complained of was different

(*x*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 21; see also Basset *v.* Graydon, (1897) 14 R. P. C. 701.

(*y*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 67.

(*z*) Daw *v.* Eley, (1867) L. R. 3 Eq. 497.

(*a*) Dudgeon *v.* Thompson, (1879) L. R. 3 App. Cas. 34.

(*b*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch D. 286; Lancashire Explosives Co. *v.* Roburite Explosives Co, (1895) 13 R. P. C. 435.

(*c*) Hattersley *v.* Hodgson, (1904) 22 R. P. C. 229.

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from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but, upon the plaintiff giving an undertaking as to damages, granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal. (*d*) In another case (*e*) the Court, taking the view that the alteration made by the defendants was still an infringement of the patent, made an order for sequestration against the defendant company. And in other cases (*f*) the Court dismissed the motion with costs on the ground that what the defendant did was no infringement.

Contempt of Court.

Any publication which tends to influence the result of a pending suit is reprehensible, and may involve the writer in the consequences of a contempt of Court; (*g*) but if a party to the suit submits to have the matter discussed in the public papers and enters into the arena of public discussion he cannot afterwards complain that this has been done. (*h*) It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent, (*i*) or for subscriptions towards the expenses of an appeal. (*k*) But it is a contempt for either party by advertisements to issue a representation of an *ex parte* statement of proceedings in Court for the purpose of his own profit. (*l*)

Solicitor and client's costs.

Solicitor and client's costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff, (*m*) but not to a successful respondent. (*n*)

Where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the defendants were entitled to do what they did,

(*d*) Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 286.

(*e*) Hattersley *v.* Hodgson, (1904), 22 R. P. C. 229.

(*f*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1896) 13 R. R. C. 435; Schermutz *v.* Pain, (1901) 18 R. P. C. 529.

(*g*) Daw *v.* Eley, (1868) L. R. 7 Eq. 49; *In re* Cheltenham and Swansea Railway Carriage and Waggon Works, (1869) L. R. 8 Eq. 580; Brodribb *v.* Brodribb, (1886) L. R. 11 Pr. D. 66; Butler *v.* Butler, (1888) L. R. 13 Pr. D. 73.

(*h*) Daw *v.* Eley, (1868) L. R. 7 Eq. 61; British Vacuum Cleaner Co., Ld. *v.* Suction Cleaners, Ld., (1904) 21 R. P. C. 300.

(*i*) Plating Co. *v.* Farquharson, (1881) L. R. 17 Ch. D. 49.

(*k*) *Ibid.*

(*l*) Edlin *v.* Pneumatic Tyre and Brook's Cycle Agency (No. 2), (1893) 10 R. P. C. 317.

(*m*) Plating Co. *v.* Farquharson, (1881) L. R. 17 Ch. D. 49.

(*n*) *Ibid.*

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solicitor and client's costs were refused, but costs on the higher scale were given. (*o*)

## Account or Damages.

Account or damages may be awarded to a successful plaintiff,

**General.**—A plaintiff who succeeds in showing that his patent rights are valid and subsisting, and that they have been infringed, is usually entitled, not only to an injunction restraining the defendant from continuing the infringements complained of, but also to an account of profits made by the defendant by means of his wrongful acts, or damages against him in respect of the infringements committed. In England the Court will not allow an inquiry as to damages or an account of profits to be prosecuted till the plaintiff has established his title to the patent and the fact of infringement, (*p*) though this does not appear to be the invariable rule in Scotland. (*q*)

but he cannot have both against the same defendant,

An inquiry as to damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringement is thereby condoned. (*r*) A plaintiff therefore cannot have both an account and damages against the same defendant; he must choose one or the other; (*s*) and this rule applies to every case of infringement. (*t*)

though he may have an account against one defendant and damages against another.

As regards different defendants to the same action, or to consolidated actions, the plaintiff may have an account of profits against one of such defendants and damages against the other. (*u*) It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and there is no reason why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used, there is continuing damage. (*x*)

(*o*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 46, 68.

(*p*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 388; Rolls *v.* Isaacs, (1878) W. N. 37; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184.

(*q*) See Brown *v.* Evered, (1904) 21 R. P. C. 501.

(*r*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22, per Lord Westbury.

(*s*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22; Watson *v.* Holliday, (1882) 30 W. R. 747; Siddell *v.* Vickers, (1892) 9 R. P. C. 153, 162.

(*t*) De Vitre *v.* Betts, (1873) L. R. 6 H. L. 319; Vidi *v.* Smith, (1854) 3 E. & B. 969; Holland *v.* Fox, (1854) 3 E. & B. 977.

(*u*) Penn *v.* Bibby, Penn *v.* Fernie, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67; Boyd *v.* Tootle Broadhurst, &c., Co., (1894) 11 R. P. C. 175.

(*x*) Per Page Wood, V.C., Penn *v.* Bibby, Penn *v.* Jack, Penn *v.* Fernie, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277.

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When damages are preferable to an account of profits, and *vice versâ*.

When the action is brought in the early days of the patent, before the patentee has established a course of dealing in the patented article, the successful plaintiff would probably prefer an account of profits, because of the difficulty he would, under such circumstances, have in showing the damage he has sustained by the wrongful acts of the defendant. On the other hand, as a rule, when the plaintiff has an established course of business in the patented article, it is more to his interest to elect to take damages in lieu of an account of profits, because of the great difficulty there always is in taking the account of profits due to the infringement of patent rights. Thus Lord *Lindley*, then *Lindley*, L.J., in *Siddell* v. *Vickers*, (*y*) in stating his experience in matters of account, used the following words of warning: "I do not know any form of account which is more difficult to work out, or may be more difficult to work out, than an account of profits. One sees it—and I personally have seen a good deal of it—in partnership cases, when the capital of a deceased or out-going partner has been left in the trade; an account has been directed of the profits made in respect of capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any one source is extremely great—so great that accounts in any form very seldom result in anything satisfactory to anybody. The litigation is enormous, the expense great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so that in partnership cases, I confess, I never knew an account in that form worked out with satisfaction to anybody. I believe in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits." (*z*)

Distinction between an account of profits and an inquiry as to damages.

There is a well-marked distinction between an account of profits and an inquiry as to damages, which must not be lost sight of in dealing with particular cases, and which arises from the fact that there is no necessary relationship between the two. Thus in some cases the greater the profit made by the infringer the less may be the damages sustained by the

(*y*) (1892) 9 R. P. C. 162.

(*z*) See also Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 119; Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 471

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patentee, and in other cases the less the profit accruing to the infringer the greater the damage inflicted upon the patentee, *e.g.*, where the infringer undersells the patentee he may be satisfied with a very small profit with the object of ultimately getting the trade in his own hands, but the damage thereby inflicted upon the patentee may be very great. (*a*)

Order by agreement for payment of a proper royalty is sometimes preferable to an account or damages.

Where a plaintiff is not desirous of taking an inquiry as to damages it is sometimes well for the parties to agree to an order for an inquiry as to what would be a proper royalty, and that such sum should be accepted in lieu of damages. Such a course may save endless expense and time as against an account of profits in the ordinary way. (*b*)

Effect of delay in bringing the action.

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages, if the circumstances are such as to establish leave and licence on the part of the plaintiff, or that the plaintiff stood by and knowingly allowed the defendant to proceed and expend money in ignorance of the fact that he had rights and meant to assert them (*c*). The effect may be to bar the plaintiff's right altogether, (*d*) or limit it to damages or profits, made since the commencement of the action; (*e*) for it is a principle of equity that a party who claims a right shall not lie by, and, by his silence or acquiescence, induce another to go on expending his money and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained. (*f*)

Account or damages may be awarded notwithstanding that the plaintiff is not entitled to an injunction.

An account of profits or an inquiry as to damages may now be had, notwithstanding the fact that the plaintiff is not entitled to an injunction, *e.g.*, where the action is commenced or judgment is delivered after the expiration of the patent, (*g*) or there is proof of the infringement of at least one of several patents owned by the plaintiff and governing all known

(*a*) Per Chitty, J., Howard *v.* Tweedales, (1896) 13 R. P. C. 214.

(*b*) Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 471.

(*c*) Proctor *v.* Bennis, (1887) 4 R. P. C. 330.

(*d*) *Ibid.*; and see Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120; Harrison *v.* Taylor, (1865) 11 Jur. N. S. 408; Parrot *v.* Palmer, (1834) 3 M. & K. 632, 640.

(*e*) See Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103; Ford *v.* Foster, (1872) L. R. 7 Ch. App. Cas. 611, 627; Beard *v.* Turner, (1866) 13 L. T. N. S. 746.

(*f*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120; Parrot *v.* Palmer, (1834) 3 M. & K. 640.

(*g*) British Insulated Wire Co. *v.* Dublin United Tramway Co., (1899) 17 R. P. C. 14; Kane *v.* J. Boyle & Co., (1901) 18 R. P. C. 325; 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 66, s. 16; Betts *v.* Gallais, (1870) L. R. 10 Eq. 392; R. S. C. (1883) Order xv. r. 1; York *v.* Stowers, (1883) W. N. p. 174.

methods of production of a certain article but doubt as to the particular patent or patents infringed. (*h*) Formerly the Court of Chancery acted upon the rule that the right to an account was ancillary to the right to an injunction, and if an injunction could not be granted, *e.g.*, if the patent had expired before, (*i*) or during, (*k*) the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement, (*l*) the plaintiff could not have an account, (*m*) but must be left to his remedy at law, which consisted of damages, (*n*) except in the case of fraud. (*o*) Lord *Cairns'* Act empowered the Court of Chancery to award damages, and any division of the High Court is now entitled to award damages or grant an account of profits independently of any right on the part of the plaintiff to an injunction; (*p*) but, of course, subject to the provisions of the statute of limitations, and it would appear that the Court of the County Palatine of Lancaster has now a similar jurisdiction. (*q*)

Account or Damages—General.

When an account of profits or an inquiry as to damages is ordered the account or the inquiry, in the absence of provision to the contrary, extends to all infringements committed within six years before action brought (*r*) and goes up to the date of the assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is; (*s*) and articles manufactured for export must be brought into the inquiry. (*t*)

Account of profits or inquiry as to damages usually goes up to the assessment.

As a rule, where a plaintiff has become possessed of the patent by assignment, the assessment is only ordered from the date of the registration of the assignment. (*u*)

Assessment where the plaintiff is an assignee.

But where it appeared that the plaintiffs has taken over a

(*h*) Saccharin Corporation, Ld. *v.* Quincy, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

(*i*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 209; S. C. Kay, 417.

(*k*) Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) 4 K. & J. 727; but see Fox and Dellestable, (1866) 15 W. R. 194.

(*l*) Proctor *v.* Bayley, (1889) 6 R. P. C. 538.

(*m*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 203; Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) K. & J. 727.

(*n*) See Bailey *v.* Taylor, (1829) 1 Russ. & M. 73, 75; Parrott *v.* Palmer, (1834) 3 M. & K. 632, 642.

(*o*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 119.

(*p*) Elmore *v.* Pirrie, (1887) 57 L. T. N. S. 333; 46 & 47 Vict. c. 57, s. 30; Vol. II. p. 215; Sayers *v.* Collyer, (1884) L. R. 28 Ch. D. 108; R. S. C. (1883) Order xv. r. 1; York *v.* Stowers, (1883) W. N. 174.

(*q*) 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16.

(*r*) Davenport *v.* Rylands, (1365) L. R. 1 Eq. 308.

(*s*) R. S. C. (1883) Order xxxvi. r. 58; Fritz *v.* Hobson, (1880) L. R. 14 Ch. D. 542. As to ascertainment of damages in Queen's Bench Division, see R. S. C. (1885) Order xxxvi. r. 57.

(*t*) Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*u*) Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

Account or Damages—General.

their predecessors, they were held to be entitled, in estimating the damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired such business. (*x*)

Assessment does not extend to infringements committed within certain periods.

The account of profits or inquiry as to damages does not include anything due to infringements committed within certain periods of time unless the Court otherwise directs, viz.—

(1) Infringements prior to the publication of the complete specification. (*y*)

(2) Infringements prior to an amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge. (*z*)

(3) Infringements committed after a failure to make any payment in respect of keeping the patent on foot within the prescribed time and before the enlargement thereof. (*a*)

Time within which amount found due is to be paid.

The order for the account or inquiry as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified; (*b*) but sometimes the time within which such payment is to be made is reserved for further consideration, (*c*) and the costs of taking the account or instituting the inquiry are usually so reserved. (*d*)

Disclosure by the defendant of number of infringing articles sold and names and addresses of his customers and also prices.

On an account of profits or an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom and the prices at which he has sold them, in spite of the fact that he thereby exposes his customers to attack

(*x*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 417.

(*y*) p. 583; Vol. II.; p. 207 *ante*.

(*z*) Vol. II. pp. 78, 209; 46 & 47 Vict. c. 57, s. 20. *Semble* this section would include an account of profits as well as damages. In Wenham Gas Co. *v.* Champion Gas Lamp Co., (1890) 7 R. P. C. 313, the inquiry was limited to damages in respect of infringements since the date of amendment. In Hopkinson *v.* St. James's Electric Lighting Co., (1893) 10 R. P. C. 43, an account of profits was allowed from the date of the patent, the patentee having stated in evidence that he had framed the original claim in good faith with reasonable skill and knowledge. For form of Order, see Brooks *v.* Lycett, (1903) 20 R. P. C. 392.

(*a*) 46 & 47 Vict. c. 57, s. 17, sub-s. 4 (b); Vol. II. p. 208.

(*b*) Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 253; 11 W. R. 852; Young *v.* Fernie, Bovill *v.* Crate, Needham *v.* Oxley, Cunningham *v.* Colling, Seton, 4th ed. p. 355.

(*c*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7; Betts *v.* Noel, Seton 4th ed. p. 355; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Pemberton, 4th ed. p. 484.

(*d*) United Telephone Co. *v.* Fleming, (1886) 3 R. P. C. 282; United Telephone Co. *v.* Patterson, (1889) 6 R. P. C. 140.

from the plaintiff, and himself to a consequent loss of trade. (*e*) The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers. **Account or Damages—Account.**

When in the case of a defendant company in liquidation the order is drawn up in the usual form against the company only, a motion to commit the liquidator for non-compliance, notwithstanding that he was appointed before trial, will fail. (*f*)

**Account.**—When the plaintiff elects to take an account of profits he establishes a different relationship between himself and the defendant to that which exists between them on an inquiry as to damages. In the former case by electing to take an account of profits he condones the infringement, (*g*) and adopts that which was done by the defendant, (*h*) and claims for himself the profits made by the infringer from the use of the invention; in the latter case the defendant is treated all through the inquiry as a wrongdoer. Thus by electing to take an account it may be said that the plaintiff constitutes the defendant his agent as regards the acts whereby he, by the use of the invention, has made a profit or the reverse, and the question always is what in profit or loss was the result of the course of conduct actually pursued by the defendant, and not what might have been the profit had he pursued a different line of conduct. Consequently, the plaintiff is not entitled to an account of, and compensation for, the actual losses he may have sustained through the wrongful acts of the defendant; he is only entitled to an account and payment over to him of the actual profits, if any, derived from the defendant's use of the invention, (*i*) and, if the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit otherwise—*e.g.*, by the sale of articles not manufactured by a machine the subject-matter of the patent—is quite immaterial. (*k*) The true test

**Difference in relationship of the plaintiff to the defendant on the taking of an account to that which exists between them on an inquiry as to damages.**

(*e*) Murray *v.* Clayton, (1872) L. R. 15 Eq. 115; American Braided Wire Co. *v.* Thompson (No. 2), (1888) 5 R. P. C. 375; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 66; Leather-Cloth Co. *v.* Hirschfield, (1863) 1 H. & M. 295; Adair *v.* Young, (1879) L. R. 11 Ch. D. 136; 12 Ch. D. 13; Powell *v.* Birmingham Vinegar Brewery Co., (1896) 14 R. P. C. 1; Saccharin Corporation *v.* Chemical and Drugs Co., (1900) 17 R. P. C. 612.

(*f*) Saccharin Corporation *v.* Chemical and Drugs Co., (1900) 17 R. P. C. 743.

(*g*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22.

(*h*) American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 158.

(*i*) Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

(*k*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401.

Account or Damages—Account.

of comparison is to take the ratio of the profit derived when the invention was used to the profit which would have been derived had the defendant used that which, looking at all the circumstances of the case, he would most probably have used had he not illegally adopted the invention. (*l*)

Profits of defendant's business before infringement as well as since.

On the taking of the account the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a position to estimate what proportion of the total profits made by him since the commencement of the infringement is due to his wrongful acts. (*m*)

Extent of account of profits.

An inquiry as to profits made by an infringer extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim. (*n*)

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas-meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas-meters. (*o*)

It would appear that if the plaintiff desires an account of collateral profits he must prove that such profits have been received; (*p*) and an account will not be directed when it is clear that no profits whatever have been made. (*q*)

Production of books and administration of interrogatories.

When an order for an account of profits is made against a defendant, he may be compelled to produce his books, and interrogatories may be administered, notwithstanding a pending appeal. (*r*)

Bankruptcy of defendant.

In the bankruptcy of a defendant the amount found due on

(*l*) Siddell *v.* Vickers, (1892) 9 R. P. C. 152.

(*m*) Siddell *v.* Vickers, (1889) 6 R. P. C. 464.

(*n*) Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; United Horseshoe and Nuil Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401.

(*o*) Crossley *v.* Derby Gaslight Co., (1829) 1 W. P. C. 119; see also Household Co. *v.* Neilson, (1843) 1 W. P. C. 697 *n.*

(*p*) Bacon *v.* Spottiswoode, (1839) 1 Beav. 382.

(*q*) Bergmann *v.* McMillan, (1881) L. R. 17 Ch. D. 423; Sanitas Co. *v.* Condy, (1887) 4 R. P. C. 530.

(*r*) Saxby *v.* Easterbrook, (1872) L. R. 7 Ex. 207.

an account of profits made by the infringement of a patent can be proved, as it is a liquidated debt. (*s*)

Account or Damages—Damages.

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the amount to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument, (*t*) though no deduction is allowed in respect of the defendant's property in the patented part. (*u*) Consequently, where the plaintiff elects to claim profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention. (*x*)

Plaintiff in the habit of supplying on royalty articles consisting of patented and non-patented parts.

**Damages.**—Before Lord *Cairns'* Act there was no jurisdiction in the Court of Chancery to give damages, and the old form of decree always gave the plaintiff an account of profits, but by Lord *Cairns'* Act jurisdiction was conferred on the Court to give damages, and in *Hills* v. *Evans* (*y*) Lord *Westbury* pronounced a decree giving the plaintiff both damages and profits, which course was held to be wrong in *Neilson* v. *Betts* (*z*) and *De Vitre* v. *Betts*, (*a*) in which the House of Lords settled finally that the successful plaintiff in an action of infringement of a patent is entitled, at his election, to damages or an account of profits, but not to both, which is the state of the law now. (*b*) This relief may be obtained in either division of the High Court, (*c*) or in the Court of the County Palatine of Lancaster. (*d*)

Damages in lieu of an account of profits.

Before a plaintiff can be entitled to an inquiry as to damages, it is incumbent on him to show that he has in fact sustained some damage which is not merely nominal, (*e*) *i.e.*, the plaintiff must show that he has sustained pecuniary loss, and, as far

(*s*) Watson *v.* Holliday, (1882) 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 543; Bankruptcy Act, (1883) s. 37.

(*t*) United Telephone Co. *v.* Walker, (1887) 5 R. P. C. 61, 63.

(*u*) *Ibid.*; see p. 509 *post.*

(*x*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 412.

(*y*) (1862) 4 De G. F. & J. 288.

(*z*) (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317.

(*a*) (1873) 6 H. L. 319; 21 W. R. 705.

(*b*) Per Lindley, L.J., Siddell *v.* Vickers, (1892) 9 R. P. C. 162.

(*c*) p. 497 *ante.*

(*d*) p. 497 *ante.*

(*e*) Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 39; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; Sanitas Co. *v.* Condy, (1887) 4 R. P. C. 530; Cole *v.* Saqui, (1888) 5 R. P. C. 489, 496; Webb Lamp Co. *v.* Atkinson, (1902) 19 R. P. C. 599.

Account or Damages—Damages.

as the nature of the case may permit, the amount of that loss. (*f*) Sometimes, however, it may be evident that the plaintiff has sustained substantial damage, though it is not possible to fix any sum as to the exact quantum. In such cases it is proper and the practice of the Courts, by guesswork to award such a sum as from the circumstances of the case appears fair. (*g*) Thus, by way of illustration, if it can be proved that the necessary consequence of an injurious act, *e.g.*, infringement of a patent, is to damage the reputation of the patented article or process, and so to interfere with its general and extended use, very substantial damages might be recovered, though it might be impossible to put a figure on the loss. (*h*)

Assessment is not affected by amount accepted from non-litigants.

The rate at which the plaintiff has accepted compensation for damages from non-litigants does not govern the assessment of the amount recoverable by action from the defendant. (*i*)

Measure of damages.

The measure of damages to which a successful plaintiff is entitled is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts, (*k*) *i.e.*, the question is by how much would the plaintiff have been better off if there had been no infringement, (*l*) and the essential principle should always be borne in mind that the action is one not to punish the infringer, but to compensate the patentee, (*m*) and the Court properly compensates him with a liberal hand at the expense of the wrongdoer. (*n*) Thus, the whole moneys which an infringer has contracted to pay to a third party for the supply of a definite number of infringing articles (some of which have not been delivered) do not form the measure of damage sustained by the patentee, since he is only entitled to damages in respect of such articles as have actually been delivered. (*o*) The plaintiff is not entitled

(*f*) Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1898) 15 R. P. C. 406; 16 R. P. C. 215.

(*g*) See Ungar *v.* Sugg, (1891) 8 R. P. C. 388; 9 R. P. C. 117.

(*h*) See Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1898) 15 R. P. C. 406; 16 R. P. C. 212, 215.

(*i*) Boyd *v.* Tootal Broadhurst, &c., Co, (1894) 11 R. P. C. 175.

(*k*) United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67; Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1899) 16 R. P. C. 212, 214.

(*l*) Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 175; Penn *v.* Jack, (1867) L. R. 5 Eq. 81; 37 L. J. Ch. 136; Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1899) 16 R. P. C. 212, 214.

(*m*) See Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1899) 16 R. P. C. 215.

(*n*) *Ibid.*; British Motor Syndicate, Ld. *v.* John Taylor & Son, Ld., (1899) 17 R. P. C. 189, 723.

(*o*) British Insulated Wire Co. *v.* Dublin United Tramways Co., (1899) 17 R. P. C. 14.

Account or Damages—Damages.

to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation, (*p*) though he may be entitled to a substantial sum in respect of damage to the reputation of his patented article or process. (*q*)

It is, therefore, clearly important to establish what is the plaintiff's usual course of dealing with the invention—*e.g.*, the price at which he usually sells the patented article, or the amount of royalties he generally accepts from licensees authorised to use the invention.

Damages when it is not the plaintiff's usual course of business to grant licences.

When the patentee of machinery, who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods as those made by the patented machine and in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention. (*r*)

If a part only of the actual article sold by the defendant is an infringement and the article sold by the defendant is of a substantially cheaper and lower grade than that usually manufactured and sold by the plaintiff under the patent, the Court ought in estimating the quantum of damage by no means to conclude that all the sales effected by the defendant would have been, but for the wrongful acts of the defendant, effected by the plaintiff at the price he charges for the higher grade article or at all. In such circumstances the Court is obliged to arrive at and adopt the best conclusion it can, upon the facts of the case, as to what quantity of the patented articles the plaintiff has been prevented from selling in consequence of the infringing articles being put upon the market and so

(*p*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 410, 416; 5 R. P. C. 260.

(*q*) See *supra*.

(*r*) See Lord Watson's judgment in United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 413; 5 R. P. C. 267.

Account or Damages—Damages.

determine the quantum of profit which the wrongful acts of the defendant have prevented the plaintiff from realising. (*s*)

In *Gavioli* v. *Shepherd*, (*t*) in which case the defendant was the user and not the manufacturer of the infringing article, the Court came to the conclusion upon the facts that, if he had not bought the cheap infringing article, he would not have bought the plaintiff's more costly article, and, therefore, the plaintiff had not suffered any damage at all. In this case the order was in the form "whether any and what damages have been sustained or incurred by the plaintiff, &c.," and not in the usual form, "what damages the plaintiff has sustained." (*u*) It is submitted, nevertheless, that some damage should have been found due—if necessary by guesswork (*v*)—since every unlicensed user must be a damage to the patentee. (*x*)

In *Dunlop Pneumatic Tyre Co.* v. *Green* (*y*) it appeared that the defendant, who was a manufacturer of bicycles, supplied the plaintiffs' patented tyre with second grade machines, and it was proved that the plaintiffs supplied their tyre with all grades of machines. Under these circumstances the Court refused to interfere with the finding of the master, which awarded a substantial sum as the measure of damage.

In estimating the amount of damages to which a successful plaintiff is entitled, the Court recognises that every sale without licence of a patented article must be a damage to the patentee, and the inquiry is in the form, "what damage the plaintiff has sustained," not "what damage, if any." In the case of infringement of trade mark all the world are entitled to make the article, but not to brand it with the plaintiff's mark; but in the case of a patent every manufacture or sale of the article is necessarily a damage to the patentee. (*z*) The actual profit derived by the defendant is not in all cases necessarily the measure of the plaintiff's loss, for it cannot always be ascertained with arithmetical precision what, in the ordinary course of business, would have been the amount of the plaintiff's sales and profits. When the product of the patented process or machinery or the patented article itself is a new and special article which cannot be successfully

(*s*) Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co., (1899) 16 R. P. C. 209, 212, 215, 216; Dunlop Pneumatic Tyre Co. v. Gunn, (1900) 17 R. P. C. 234.

(*t*) (1899) 17 R. P. C. 157.

(*u*) p. 502 *ante*.

(*v*) See p. 502 *ante*.

(*x*) See *infra*.

(*y*) (1900) 17 R. P. C. 234.

(*z*) See per Page Wood, V.C. Davenport v. Rylands, (1865) L.R. 1 Eq. 308

imitated without using the invention, the process of estimation is comparatively simple; but, on the other hand, it is quite the reverse when this is not the case. An allowance is made to the plaintiff in respect of loss of sales caused by the defendant's competition, and at the same time the defendant is entitled to strike off a moderate percentage as representing sales due to increased activity in the trade produced by the rivalry of two competitors, if that is the relationship of the parties. (*a*)

Account or Damages—Damages.

If a patentee whose patent is being infringed reduces the price at which he sells the patented articles, in order to be able to undersell the infringer, although in an action for damages he may be entitled to the benefit of all sales made by the infringer as if they were made by himself, so that he will get all the profit so made by the infringer, yet he will not be entitled to recover the difference between the original and reduced price, when the reduction is not a natural and direct consequence of the infringer's acts, and is therefore too remote. (*b*)

Reduction of price by the plaintiff.

But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price. (*c*) A reduction, however, may be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price, as also by reason of his business connection. (*d*)

When it is the plaintiff's usual course of business to grant licences, the measure of damage becomes the loss of royalties sustained by him through the defendant's acts; that is to say, the profit rent and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time. (*e*) Since the plaintiff deems himself fully compensated

Damages when it is the plaintiff's usual course of business to grant licences.

(*a*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 413, 417; Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494; Penn *v.* Jack, (1866) L. R. 5 Eq. 81; Alexander *v.* Henry, (1895) 12 R. P. C. 360.

(*b*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401; 5 R. P. C. 260.

(*c*) American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 47, 152; (1890) W. N. 68; L. R. 44 Ch. D. 274; Alexander *v.* Henry, (1895) 12 R. P. C. 360.

(*d*) *Ibid.*

(*e*) United Telephone Co. *v.* Walker, (1889) 4 R. P. C. 63; English and American Machinery Co. *v.* Union

Account or Damages—Damages.

by the usual royalty charged in cases in which he has granted a licence, such sum is the proper measure of compensation where the manufacture or use has been carried on without his leave. (*f*)

And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user. (*g*) And, further, it cannot always be taken for granted that the licences which it is presumed the plaintiff would have granted, had the defendant not infringed, would have been in force till the expiration of the patent; with regard to the duration of such supposed licences, the Court must make the best estimate it can, having regard to all the circumstances of the case, *e.g.*, the average duration of licences granted by the plaintiff about the time the defendant's acts were committed. (*h*)

A patentee who has obtained an injunction cannot be compelled to accept from an infringer desirous of continuing the use of the invention the same royalties he accepts from other and licensed users. (*i*)

Damages may be recovered either against a manufacturer or a user, or both, until the full amount has been recovered.

Damages for infringement may be recovered against either a manufacturer or a user, or both, until the full measure of damage, which is the total loss of the profit which the plaintiff would have made had the infringing machine been supplied by him, has been recovered. (*k*)

For example, if a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines; (*l*) and the acceptance by the plaintiff of *agreed*

Boot and Shoe Machine Co., (1895) 13 R. P. C. 64; see Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Tyre Co., (1898) 15 R. P. C. 405; 16 R. P. C. 212.

(*f*) See Penn *v.* Jack, (1867) L. R. 5 Eq. 83.

(*g*) *Ibid.* 81.

(*h*) English and American Machinery Co. *v.* Union Boot and Shoe Machinery Co., (1895) 13 R. P. C. 64.

(*i*) Penn *v.* Bibby, (1866) L. R. 3 Eq. 310, 312; Penn *v.* Jack, (1867) L. R. 5 Eq. 81.

(*k*) Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; Penn *v.* Jack, (1867) L. R. 5 Eq. 81; United Telephone Co. *v.* Walker, (1889) 4 R. P. C. 63; United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 408; American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 47, 152; Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 175; British Motor Syndicate *v.* John Taylor & Sons, (1900) 17 R. P. C. 728.

(*l*) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305, 312; British Motor Syndicate *v.* John Taylor & Sons, (1900) 17 R. P. C. 728.

damages from an infringing manufacturer of the patent article in respect of *his* wrongful acts, does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not necessarily make the article "free" in the hands of a purchaser; (*m*) but if the damages payable by a manufacturer under an order against him are calculated upon the basis that he is to be held liable for the full loss caused to the patentee by the manufacture and sale of the infringing articles in question such articles do become "free" in the hands of purchasers from the manufacturer, who cannot be subjected to any liability in respect of them. (*n*) A plaintiff's right to damages against a defendant user is not affected by the fact that the user had no notice of the patent; (*o*) such a user cannot be heard to say that, if he had had notice of the patent, he might have bought articles other than those which infringe the patent and which would have done as well for him. (*p*)

Account or Damages—Damages.

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the defendant would be allowed to give evidence on this point in reduction of damages. (*q*)

Damages in respect of infringements committed on the strength of a judgment adverse to the patent.

It is open to question whether a Judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a Judge and jury. (*r*)

Reference of inquiry to a Judge and jury.

Where the plaintiff in an action for the infringement of a patent claimed the costs of a former action against the same defendant, which it was alleged was discontinued owing to false evidence on the part of the defendant, the Court held that the proper course was to strike out those paragraphs of the statement of claim which referred to the costs of the former action, and to leave the plaintiff at liberty to bring a separate action in respect of them, and intimated that such action ought to be brought in the Queen's Bench Division. (*s*)

Costs of a former discontinued action.

(*m*) United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 63, 67.
(*n*) See *ibid.*
(*o*) Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 147.
(*p*) *Ibid.*
(*q*) p. 334 *ante*; Arkwright *v.* Nightingale, (1785) 1 W. P. C. 61.
(*r*) American Braided Wire Co. *v.* Thompson, (1888) 5 R. P. C. 696.
(*s*) United Telephone Co. *v.* Tasker, (1889) 6 R. P. C. 38.

Destruction or Delivery up of Infringing Articles.

Where damages, though claimed in the pleadings, were by an oversight not asked for at the trial, special leave was given, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages. (*t*)

Omission to ask for damages at the trial.

## Destruction or Delivery to Plaintiff of Infringing Articles.

Power of the Court to order the destruction or delivery to the plaintiff of infringing articles.

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or damages at his option, a successful plaintiff in an action for infringement may under the present practice obtain an order of the Court directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him, (*u*) or that they shall be delivered up or destroyed. (*x*) It is to be observed that the practice of the Court in granting orders for the delivering up or destruction of the defendant's goods is of modern growth and does not rest upon any statutory penalty of forfeiture for infringement. No forfeiture of goods can rest upon a grant of letters patent. (*y*) Some authorities have thought it doubtful whether the Court has jurisdiction to make an order for the delivering up of the defendant's goods to the plaintiff, and argued that a defendant whose goods are compulsorily taken or destroyed by the plaintiff, though under an order of the Court, has a right of action under sec. 4 of the Statute of Monopolies in respect of an illegal forfeiture. It is submitted, however, that this view is erroneous, first, because sec. 4 of the Statute of Monopolies does not apply to patents granted after the date of that Statute, (*z*) and, secondly, because the Court in ordering the delivery up to the plaintiff of the defendant's goods does not

(*t*) Edison *v.* Holland, (1888) 5 R. P. C. 483.

(*u*) Betts *v.* De Vitre, (1865) 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9, 217; Seton, 4th ed. p. 354; Washburn and Moen Manufacturing Co. *v.* Patterson, (1884) 1 R. P. C. 157, 162; Tangye *v.* Stott, (1865) 14 W. R. 386; Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 67; Otto *v.* Steel, (1886) 3 R. P. C. 109, 120; Emperor of Austria *v.* Day, (1861) 3 De G. F. & J. 217; Young *v.* Fernie, (1866) L. R. 1 H. L. 63; Pemberton 4th ed. p. 484; Edison *v.* Holland, (1888) 5 R. P. C. 483.

(*x*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 176; Plimpton *v.* Malcolmson, Seton, 4th ed. p. 354.

(*y*) Waltham *v* Austin, 8 Co. Rep. 125a, 127b; 2 Inst. 47; Horne *v.* Ivy, 1 Sid. 441; 1 Vent. 47; Hastings' Patent, Noy, 183.

(*z*) See Peck *v.* Hindes, (1898) 15 R. P. C. 113; 14 Times L. R. 164.

Destruction or Delivery up of Infringing Articles.

proceed on the footing that the order passes the property in the goods from the defendant to the plaintiff, but makes the order as a protection to the patentee against the goods being used by the defendant who has been found guilty of an intention to use them. As was stated by *Cotton*, L.J., in *Vavasseur v. Krupp*, (*a*) "the property in articles which are made in violation of a patent is, notwithstanding the privilege of the patentee, in the infringer if he would otherwise have the property in them. The Court in a suit to restrain the infringement of a patent does not proceed on the footing that the defendant proved to have infringed has no property in the articles; but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights—not on the footing that there is no property in the defendant. The Court cannot proceed to give that relief and interfere with the articles unless it has before it the person entitled to the articles in question, and has as against the person power to adjudicate that the articles are made or used in infringement of the plaintiff's rights."

In a case where the statement of claim prayed for the delivery up and destruction of all infringing articles in the power or control of the defendants, *Bacon*, V.C., declined to make the order at the trial, but reserved the question for consideration after an account of profits had been taken. (*b*)

Form of order.

The order for delivery up or destruction usually fixes a time within which the infringing articles are to be delivered up or destroyed. (*c*)

When an infringing article is composite.

Where a defendant is found to have infringed a patent for an invention consisting of a new combination of old parts, the Court will probably grant an injunction restraining the user of the infringing machines, but refuse to order their destruction, on the ground that the parts may be separated and used for other purposes, and the order will give liberty to the plaintiff to mark the infringing machines so as to be able to follow them at any time. (*d*)

(*a*) (1878) L. R. 9 Ch. D. 360.

(*b*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7.

(*c*) Otto *v.* Steel, (1886) 3 R. P. C. 120; Washburn and Moen Manufacturing Co. *v.* Patterson, (1884) 1 R P. C. 191.

(*d*) Needham *v.* Oxley, (1878) 8 L. T. N. S. 604; 11 W. R. 852; Pemberton, 4th ed. p. 485; Seton, 4th ed. pp. 352, 353.

Costs.

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse. (*e*) Also where the infringing part was a portion of a complicated apparatus the defendant was not ordered to deliver up the whole machine on his undertaking to remove the infringing part. (*f*)

Loss caused to defendant.

The destruction of an infringing article may cause a loss to the defendant considerably greater than the cost of such infringing article, as, for example, where the infringing article is used in combination with other things which do not infringe, and the article cannot be detached without destroying the whole machine—*e.g.*, the filament in an *Edison* incandescent electric lamp which was held to infringe the *Cheesborough* patent, and an order for the destruction of which was obtained. (*g*) This loss is part of the risk an infringer incurs when he invades a patentee's right. (*h*)

## Costs.

Discretion of Court or Judge.

Subject to the Judicature Acts and the Supreme Court Rules, 1883, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the Court or Judge, provided that where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court, shall for good cause otherwise order. (*i*) Consequently the costs of an action for infringement of a patent are in the discretion of the Judge of any division of the Supreme Court in which the action is tried.

If either party desires that certain costs should be disallowed, he should apply accordingly to the Judge at the trial. The taxing master rightly allows costs which fall within the Judge's order—*e.g.*, the plaintiff's costs occasioned by the defence of a defendant against whom the action was settled

(*e*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) L. R. 26 Ch. D. 766, 776.

(*f*) Automatic Weighing Machine Co. *v.* Feasby, (1893) 10 R. P. C. 442.

(*g*) Edison *v.* Holland, (1888) 5 R. P. C. 459, 483.

(*h*) United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*i*) R. S. C. (1883) Order lxv. r. 1.

before trial are payable by another defendant against whom judgment is obtained with costs for the plaintiff. (*k*) Costs.

On taxation, however, no costs will be allowed to either party in respect of any particular which the Court or a Judge has not certified as being reasonable and proper. (*l*) And in case the plaintiff succeeds in an action in respect of a patent, the validity of which has been certified by the Court or a Judge to have been questioned in a former action for infringement, he is entitled to have his full costs, charges, and expenses, as between solicitor and client, unless the Court or a Judge trying the case certifies that he ought not to have the same. (*m*) Necessity for certificate of particulars, and validity.

In the words of Sir George *Jessel*, M.R.: "Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it." (*n*)

As we have seen, a plaintiff is not bound to apply to the defendant for the relief he seeks before commencing action, (*o*) and ignorance on the part of the defendant is no defence to an action for infringement. (*p*) Neither of these grounds will determine the Court to refuse the plaintiff his costs, if he succeeds in the action and is not otherwise disqualified. (*q*) Ignorance does not exempt from liability to pay costs.

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court or such other relief as may When defendant admits and undertakes to discontinue infringement.

(*k*) Badische Anilin und Soda Fabrik *v.* Hickson, (1906) 23 R. P. C. 149.

(*l*) 46 & 47 Vict. c. 57, s. 29, sub-s. 6; Vol. II. p. 215; Longbottom *v.* Shaw, (1889) 6 R. P. C. 513. This provision does not apply to the Court of the County Palatine of Lancaster, as that Court is not a Court within the meaning of 46 & 47 Vict. c. 57, s. 29 (6); see Vol. II. p. 215 *post*.

(*m*) 46 & 47 Vict. c. 57, s. 31; Vol. II. p. 215.

(*n*) Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 504.

(*o*) p. 386 *ante*.

(*p*) p. 336 *ante*.

(*q*) Wittman *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231; Burgess *v.* Hateley, (1859) 26 Beav. 249; Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 504; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Collins *v.* Walker, (1859) 7 W. R. 222.

Costs.

be necessary. (*r*) In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period. (*s*)

Where the plaintiff failed to prove infringement, though the defendant admitted a discontinued infringement before action and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action. (*t*)

A defendant who admits infringement must, in order to escape costs, if the plaintiff proceeds to an injunction, not merely promise not to repeat the infringement, but he must admit and offer to pay the amount of his liability. Thus, where a defendant had merely promised not to repeat the infringement, the plaintiff was held to be entitled not only to an injunction but to his costs of the suit. (*u*)

Again, defendants, who merely offered to remove certain infringing portions of a machine but gave no promise not to use them again and did not offer to pay the costs of the action already incurred, were ordered to pay the costs the plaintiff was put to in order to obtain an injunction. (*x*) And in an action in the Palatine Court, where infringing machines had been disused for five years previous to the commencement of the action, and had been removed from the defendants' premises, the plaintiffs obtained their costs on proof of the infringement, which was denied, and this although there was no threat on the part of the defendants to renew the infringement. (*y*) The Court of Appeal, however, held that in the absence of any evidence of an intention on the defendants' part to continue the wrongful acts an injunction ought not to have been granted, and dismissed the action, but, owing to the defendants' conduct of their case, without costs in the Court below, although they gave the defendants the costs of their successful appeal. (*z*)

When plaintiff's conduct is oppressive.

Oppressive conduct on the part of the plaintiff will induce the Court to deprive him of his costs, even though he succeed in the action. Thus, where a defendant at the hearing

(*r*) p. 386 *ante*.

(*s*) Burgess *v.* Hateley, (1859) 26 Beav. 249; Geary *v.* Norton, (1846) 1 De G. & S. 9, 12; Fradella *v.* Weller, (1831) 2 Russ. & M. 247; Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; Colburn *v.* Simms, (1843) 2 Hare, 543; Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

(*t*) Fletcher *v.* Glasgow Gas Co., (1887) 4 R. P. C. 386.

(*u*) Geary *v.* Norton, (1846) 1 De G. & S. 9.

(*x*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117.

(*y*) Proctor *v.* Bayley, (1889) 6 R. P. C. 106.

(*z*) 6 R. P. C. 538.

submitted to a perpetual injunction, and it appeared that the defendant had ignorantly infringed the patent, but had previously to the commencement of the action offered to deliver up to the plaintiff all profits he had made by selling the infringing articles, and to sell all such articles remaining in his possession to the plaintiff at a fair valuation, but the plaintiff nevertheless continued the action, the Court gave him no costs. (*a*)

Costs—Discontinuance.

**Discontinuance.**—Where the plaintiff seeks leave by summons or otherwise to discontinue the action, the Court imposes such terms as to costs as under the circumstances seem reasonable. (*b*) Leave of the Court to discontinue is not necessary before delivery of defence, nor after the receipt thereof before taking any other proceeding in the action save any interlocutory application, but the plaintiff is bound to pay the defendant's costs. (*c*) Where the plaintiff discontinues rightly without the necessity for leave after the delivery of defence, the Court will not certify the particulars of objections unless the circumstances are such that the Court can say it knows enough about the case to justify it in doing so. (*d*)

When plaintiff discontinues action.

The omission by the plaintiff to deliver a reply when due, and his permitting the defendant to give notice of trial is not "taking any other proceeding in the action" within the meaning of R. S. C., Order xxvi. r. 1.

A plaintiff who discontinues is entitled to commence a fresh action against the same defendant in respect of the same cause of action, unless it be a term of an order allowing discontinuance that no such fresh action shall be brought. (*e*) An application to stay the taxation of the costs in a first action till after the trial of a second action would only be acceded to under exceptional circumstances. (*f*)

A defendant cannot withdraw his defence, or any part thereof, without leave upon terms as to costs and otherwise. (*g*)

(*a*) Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595.

(*b*) Boake, Roberts & Co. *v.* Stevenson, (1894) 12 R. P. C. 228; Wilcox and Gibbs' Sewing Machine Co. *v.* Janes, (1897) 14 R. P. C. 523; Bethell *v.* Gage, (1897) 14 R. P. C. 699; Chamberlain and Hookham, Ld. *v.* Mayor, &c., of Huddersfield, (1901) 18 R. P. C. 454; Kerr *v.* Crompton, (1901) 19 R. P. C. 9; Brooks *v.* Lycett, (1902) 19 R. P. C. 166.

(*c*) R. S. C., Order xxvi. r. 1.

(*d*) Ashworth *v.* Horsfall, (1903) 21 R. P. C. 48; Wilcox and Gibbs' Sewing Machine Co. *v.* Janes, (1897) 14 R. P. C. 523; L. R. [1897] 2 Ch. 71.

(*e*) Haskell Golf Ball Co., Ld. *v.* Hutchison, (1905) 22 R. P. C. 208; Haskell Golf Ball Co. *v.* Hutchison (No. 2), (1905) 22 R. P. C. 477; cf. Consolidated Pneumatic Tool Co., Ld. *v.* Churchill & Co., Ld., (1905) 22 R. P. C. 209.

(*f*) *Ibid.*

(*g*) *Ibid.*

Costs—Separate Issues. Apportionment.

**Separate Issues.**—It is provided by R. S. C., 1883, Order LXV. r. 2, that where issues of fact and law are raised upon a claim or counterclaim the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event. This rule does not apply to an action founded on infringement of patent right only. It applies to cases in which there are distinct causes of action, *e.g.*, where action is brought in respect of an alleged infringement of patent right and a passing off. (*h*)

Strictly speaking, there is only one issue in an action of infringement, viz., whether the defendant has infringed the plaintiff's legal right; (*i*) but it is customary to speak of the separate questions of validity and infringement on the assumption of validity as distinct issues. It is in this sense that the above questions are described in the following pages as separate issues.

Issues abandoned at the trial.

The costs of issues raised by either party, but abandoned at the trial, are usually given against the party who raised them; (*j*) though this rule does not necessarily apply where a party fights an issue till late in the trial and then gives it up on the ground that he is willing to depend upon some other issue. (*k*)

Apportionment of costs.

**Apportionment.**—In considering the question of the apportionment of costs in patent cases, it will be well to divide the decisions into two classes—

I. Those in which the validity of the patent was either not contested, or was established.

II. Those in which the patent was declared invalid.

I. *Where the plaintiff succeeds in upholding the validity of the patent, but fails to prove the fact of infringement, it appears to be the general rule that the Court will apportion the costs.*

Thus, in a case in which the plaintiff succeeded on the question of validity, and the defendant on that of infringement, *Bacon*, V.C., apportioned the costs, saying: "The costs of the suit, as far as relates to the futile attempt to dispute the plaintiff's right to a patent invention, must be borne by the

(*h*) See Haskell Golf Ball Co. *v.* Hutchison, (1906) 23 R. P. C. 129.

(*i*) See Haskell Golf Ball Co. *v.* Hutchison, (1904) 22 R. P. C. 130.

(*j*) Thompson *v.* The American Braided Wire Co., (1889) 4 R. P. C. 316.

(*k*) New Inverted Incandescent Gas Lamp Co., Ld. *v.* Globe Light, Ld., (1905) 22 R. P. C. 439, 440.

defendant. The costs of the plaintiff's futile attempt to restrain the defendant from doing that which I think by law he is entitled to do, his patent not being an imitation or piracy of the plaintiff's, the plaintiff must pay him, and the one set of costs must be set off against the other." (*l*)

Costs—Apportionment.

In an action brought for the infringement of two separate patents, the jury found some of the issues affecting the validity of the patents for the plaintiff and others for the defendant, and it was finally ordered "that the costs be left to abide the event of the several findings for the plaintiff and the defendant company respectively, in respect of the said two letters patent, and that the said costs be taxed on the higher scale, and that the plaintiff do recover nothing against the defendants, save and except the costs of the issues on which he has obtained judgment, and that, save as aforesaid, the defendant company do recover their costs of suit from the plaintiff. (*m*)

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs, which were incurred by reason of the defendant disputing the validity of the patent. (*n*) In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side. (*o*)

In an action in which the defendants appealed from a judgment for the plaintiff with costs, and the taxed costs were by consent paid into court pending an appeal, the Court of Appeal, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the appeal with costs. On a subsequent application by the defendants for the repayment of the costs paid by them into Court, the Vice-Chancellor of the Palatine Court held that the plaintiff was not entitled to an apportioned part of these costs, attributable to points other than infringement, on which he had succeeded at the trial; and that the costs must be paid out of court without waiting for the result of an appeal to the House of Lords. (*p*)

(*l*) Simmonds *v.* Hitchman, (1885) L. R. 29 Ch. D. 417; see also Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297; see also Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776, 777.

(*m*) Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 254.

(*n*) Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61, 75.

(*o*) Needham *v.* Johnson, (1884) 1 R. P. C. 49, 59.

(*p*) Boyd *v.* Horrocks, (1889) 6 R. P. C. 528.

Costs—Apportionment.

Where the House of Lords reversed the decision of the Court below on the issue of validity, and held that the patent was good, but upheld the finding that the defendant had not infringed, the appeal was dismissed, but no costs were given. (*q*)

In an action which was dismissed, on the ground of no infringement, without going into the validity of the patent, and costs were given to the defendant, but no certificate was asked for as to the reasonableness and propriety of the particulars of objections, (*r*) the plaintiff sought, without success, by taking out a summons to review the taxation, to set off the costs he had incurred by obtaining evidence to meet the defendant's objections. (*s*) The plaintiff's contention was that the defendant's particulars were "improper, vexatious, or unnecessary" within the meaning of R. S. C., Order LXV. rr. 7, 27, sub-r. 20, and that he was, therefore, entitled to the costs occasioned by them. The Court, however, held that the taxing-master had rightly disallowed the defendant's costs of his particulars of objection, not because they were "improper, vexatious, or unnecessary," but simply because there had been no certificate, and it was a condition precedent, before the plaintiff could succeed, that he should show the costs of such particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

Sometimes when the plaintiff succeeds on the issue of validity, but fails on the issue of infringement, though the plaintiff gets the chief part of the costs relative to validity, yet he does not get them all. The costs of some of the particulars of objections may be given to the defendant on the ground that such particulars were reasonable and proper and necessary for the purpose of defining the ambit of the claim. (*t*)

The proper form of order when the plaintiff is given the costs of the issue of validity, and the defendant the general costs of the action, was discussed in *Shoe Machinery Co.* v. *Cutlan*. (*u*)

(*q*) Moore *v.* Bennett, (1884) 1 R. P. C. 129.

(*r*) See p. 518 *post*.

(*s*) Garrard *v.* Edge, W. N. (1890) pp. 43, 68.

(*t*) Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 128.

(*u*) (No. 2), (1896) 13 R. P. C. 148, 398; see also Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 775, 776; White *v.* Hartley, (1902) 20 R. P. C. 265.

II. *There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement.*

Costs—Apportionment.

The Court has a discretion in the matter which is exercised according to the circumstances of each case. (*x*) It is proper for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues; but the Court will not apportion the costs of issues which have never been heard in consequence of a decision having been come to at the outset of the case against the validity of the patent. (*y*)

In some cases where the defendant has impeached the patent on more than one ground, but has not been successful on all, and the plaintiff has succeeded on the issue of infringement, the costs of the issues affecting the validity of the patent on which the defendant has failed have been given to the plaintiff, and the other costs of the action to the defendant. (*z*)

A rule was stated by *Fry*, J., in *Wegman* v. *Corcoran*, (*a*) to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik* v. *Levinstein*. (*b*) In this case *Bowen*, L.J., said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very

(*x*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289, 300, 303.

(*y*) Blakey *v.* Latham, (1889) 6 R. P. C. 184, 190.

(*z*) Pooley *v.* Pointon, (1885) 2 R. P. C. 167; Lawrence *v.* Perry, (1885) 2 R. P. C. 179; Lawrie *v.* Baker, (1885) 2 R. P. C. 213; Lister *v.* Norton, (1886) 3 R. P. C. 199.

(*a*) (1879) 27 W. R. 357.

(*b*) (1885) L. R. 29 Ch. D. 366, 418, 420.

Costs—Certificates as to Particulars.

reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense." (*c*)

This rule is by no means universally followed. (*d*) Some Judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case, (*e*) or that the costs of the issue were trifling, (*f*) or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad. (*g*) In one case where the infringement was admitted and the defendant succeeded on the ground of want of novelty he was awarded the costs of the anticipations proved and the plaintiff the costs of the issue of infringement, but no other costs. (*h*)

Certificate of particulars is necessary on taxation.

**Certificates as to Particulars.**—It is provided by sec. 29 sub-s. 6 of the Act of 1883 (*i*) that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

When the Court simply gives the successful party the costs of the action, it becomes the duty of the taxing-master to tax the costs just as he would tax the costs of any other action except that he must not allow costs in respect of those particulars as to which no certificate has been given, and this principle must be applied to the taxation of the costs of

(*c*) (1885) L. R. 29 Ch. D. 419; see also Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 162; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1894) 11 R. P. C. 638; 12 R. P. C. 258, 303; Haslam *v.* Hall, (1888) 5 R. P. C. 23; Kane *v.* Guest, (1899) 16 R. P. C. 443.

(*d*) See, *e.g.*, Haskell Golf Ball Co. *v.* Hutchison, (1905) 22 R. P. C. 479; 23 R. P. C. 301.

(*e*) Guilbert-Martin *v.* Kerr, (1887) 4 R. P. C. 23.

(*f*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289.

(*g*) Edison *v.* Holland, (1888) 5 R. P. C. 483; Blakey *v.* Latham, (1888) 6 R. P. C. 29; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*h*) Bennington *v.* Hill, (1891) 8 R. P. C. 327; cf. Westley Richards *v.* Perkes, (1893) 10 R. P. C. 194; see also Kane *v.* Guest, (1899) 16 R. P. C. 443.

(*i*) Vol. II. p. 215.

expert evidence and proof of facts not admitted upon notice to admit. (*k*)

**Costs—Certificates as to Particulars.**

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted that he may obtain it afterwards on summons in chambers, (*l*) or on motion in Court; (*m*) but he will be cast in the costs of such summons or motion. (*n*)

**Omission to ask for certificate at the trial.**

In the event of the Court of Appeal reversing the decision of the Court below, the Court of Appeal has power to and will grant a certificate as to proof of, or the reasonableness and propriety of, the particulars. (*o*) Where the Court of Appeal reversed the decision of the Court below as to the validity of a patent, and granted a certificate as to some of the particulars of objections, *Cotton*, L.J., said, in reference to sec. 29 of the Act of 1883: "I do not think that the Court of Appeal is the Court pointed at in that section, nor that the Judge in the Court of Appeal is the Judge pointed at; it must mean the Judge of the High Court who hears the matter originally, or a Divisional Court of the High Court. But in the Court of Appeal we ought to make such order as in our opinion the Judge who heard the case ought to have made—the Judge from whom the appeal is. In this case we thought he ought to have dismissed the action, and then, of course, he ought to have considered what particulars were proven, or reasonable and proper. In our opinion we ought to do that, as he has not done it, and could not do it, having regard to the conclusion at which he arrived. That has really been done in several patent cases which have been before this branch of the Court, and, that being so, we ought in our opinion to grant a certificate stating what particulars were reasonable and proper." (*p*)

**Power of Court of Appeal and House of Lords to grant a certificate of particulars.**

The House of Lords on the same principle has a similar jurisdiction. (*q*)

The Court of the County Palatine of Lancaster is not a Court, nor is the Vice-Chancellor a Judge within the meaning of sec. 29 sub-s. 6 of the Act of 1883, (*r*) but it must be

**Court of the County Palatine of Lancaster.**

(*k*) See Haskell Golf Ball Co. *v.* Hutchison, (1906) 23 R. P. C. 129.

(*l*) Judicature Act, 1873, s. 39; R. C. S. (1883) Order xlv. rr. 2, 17, 18; Order liv. r. 1.

(*m*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 145.

(*n*) Duckett *v.* Sankey, (1899) 16 R. P. C. 359.

(*o*) Cole *v.* Saqui, (1889) 6 R. P. C. 41, 45; Humpherson *v.* Syer, (1887) 4 R. P. C. 416.

(*p*) Cole *v.* Saqui, (1889) 6 R. P. C. 45.

(*q*) Morris *v.* Young, (1895) 12 R. P. C. 465.

(*r*) Proctor *v.* Sutton Lodge Chemical Co., (1888) 5 R. P. C. 184.

**Costs—Certificates as to Particulars.**

remembered that his Honour has power over the costs of particulars irrespective of any certificate. (*s*) It is his Honour's practice to certify the particulars in respect of which the parties are to receive costs or otherwise. (*t*)

Certificate as to particulars is granted in two distinct cases.

It is to be observed that the Act of 1883 (*u*) provides that the Court may grant the certificate as to particulars in two distinct cases—*i.e.*, (1) when the particulars have been proven, and (2) where in the opinion of the Court or a Judge they were reasonable and proper. Neither party to an action of infringement can, whether the action is brought to trial or is discontinued at an earlier stage, be allowed the costs of his particulars on taxation except he is provided with the certificate of the Court or a Judge as to them; (*x*) except the action be *discontinued under such circumstances that the leave of the* Court is necessary under R. S. C., Order XXVI., and the Court makes payment of costs of particulars as though they had been certified a condition of leave to discontinue. (*y*) The provisions of sec. 29 of the Act of 1883 as to certificates of particulars are different in this respect to those of the somewhat analogous section of the repealed Act of 1852, which were only applicable when there had been an actual trial in Court, and, consequently, under that Act, when the action was discontinued, or judgment was allowed to go by default, or the action was dismissed for want of prosecution, no certificates were given, but the costs of particulars were dealt with in the ordinary way. (*z*) Now, however, in all cases when the Court has not the materials necessary to enable it to grant the certificate, the successful party is, consequently, deprived of the costs of his particulars. (*a*) The power of the Court to grant the certificate on the ground that the particulars were reasonable and proper applies as well to the particulars of

(*s*) Parnell *v.* Mort, Liddell & Co., (1885) L. R. 29; Ch. D. 325; 2 R. P. C. 55; Garnett *v.* Bradley, (1878) L. R. 3 App. Cas. 944.

(*t*) Cheetham *v.* Oldham, (1890) 7 R. P. C. 124; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 240; Parnell *v.* Mort, Liddell & Co., (1885) L. R. 29 Ch. D. 325; 2 R. P. C. 55; see also 53 & 54 Vict. c. 23, s. 3.

(*u*) s. 29, sub-s. 6.

(*x*) Middleton *v.* Bradley, (1895) 12 R. P. C. 390.

(*y*) Chamberlain and Hookham *v.* Mayor, &c., of Huddersfield, (1901) 18 R. P. C. 457; Kerr *v.* Crompton, (1901) 19 R. P. C. 9.

(*z*) Batly *v.* Kynock, (1875) L. R. 20 Eq. 632; Rothwell *v.* King, (1887) 4 R. P. C. 397; Greaves *v.* The Eastern Counties Ry. Co., (1859) 1 E. & E. 961; 28 L. T. Q. B. 290; Stevens *v.* Keating, (1850) 1 Mac. & G. 659.

(*a*) Middleton *v.* Bradley, (1895) 12 R. P. C. 390; Mandleberg *v.* Morley, (1893) 11 R. P. C. 1; 12 R. P. C. 35; Wilcox and Gibbs' Sewing Machine Co. *v.* Janes, (1897) 14 R. P. C. 524; New Invented Incandescent Gas Lamp Co., Ld. *v.* General Incandescent Co., Ld., (1905) 22 R. P. C. 614.

breaches as to the particulars of objections. (*b*) And where a defendant admits infringement and the validity of the patent is established the Court will certify the particulars of breaches. (*c*)

Costs—Certificates as to Particulars.

The question arises whether, when the action is actually brought to a trial, but the case of the plaintiff breaks down on account of the patent being clearly proved to be void, or on an admission of one of the plaintiff's witnesses, (*d*) or on the evidence offered by the defendant, or because the plaintiff offers no evidence, (*e*) and the defendant is consequently not afforded an opportunity of proving his particulars, the Court can give a certificate that such particulars were reasonable and proper, and so enable him to obtain the costs of them. (*f*) The rule is that the Court will only certify with regard to such of the particulars as the materials before the Court at the time the certificate is asked for enable it to say have either been proven or are reasonable and proper, (*g*) and where the Court disposes of the action on one point it will not hear the case further for the purpose of deciding whether the other particulars should be certified or not, (*h*) nor will it act in a subsequent case upon a decision as to similar particulars certified by the Court in a prior case between different parties. (*i*)

Certificate when action is not tried out on all the issues raised.

Rule that Court will only certify such particulars as the materials before the Court enable it to say are reasonable and proper.

The working of this rule in practice is well illustrated by the course pursued by the Court under the various circumstances hereafter detailed. Where the plaintiff's particulars alleged four distinct breaches, but no evidence was given as to one of them, and the plaintiff obtained the costs of the action, the certificate was confined to the particulars which had been proved. (*k*) Where the plaintiffs failed in their action on the ground of the invalidity of the patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to

(*b*) Kane *v.* Guest, (1899) 16 R. P. C. 443.

(*c*) British Motor Traction Co. *v.* Sherrin, (1901) 18 R. P. C. 275.

(*d*) The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 254.

(*e*) American Steel and Wire Co. *v.* W. T. Glover & Co., Ld., (1902) 19 R. P. C. 111; Acetylene Illuminating Co. *v.* United Alkali Co., [1902] 1 Ch. 494.

(*f*) Longbottom *v.* Shaw, (1888) 5 R. P. C. 497; (1889) 6 R. P. C. 143.

(*g*) Mandleberg *v.* Morley, (1895) 12 R. P. C. 35, and cases there referred to; Middleton *v.* Bradley, (1895) 12 R. P. C. 390; Wilcox and Gibbs' Sewing Machine Co. *v.* Janes, (1897) 14 R. P. C. 524; Bethell *v.* Gage, (1897) 14 R. P. C. 699; New Inverted Incandescent Gas Lamp Co., Ld. *v.* General Incandescent Co., Ltd., (1905) 22 R. P. C. 614; but see p. 523 *post*.

(*h*) Boyd *v.* Horrocks, (1889) 6 R. P. C. 162; Longbottom *v.* Shaw, (1889) 6 R. P. C. 143; Mandleberg *v.* Morley, (1895) 12 R. P. C. 35.

(*i*) New Inverted Incandescent Gas Lamp Co., Ld. *v.* General Incandescent Co., Ld., (1905) 22 R. P. C. 614.

(*k*) Cole *v.* Saqui, (1888) 5 R. P. C. 489, 497.

Costs—Certificates as to Particulars.

go into their defence, and the Judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the Judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches. (*l*) And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court. (*m*)

In a somewhat recent case, where the plaintiff's first witness admitted in cross-examination that what the patentee and also the defendant actually did was not the alleged invention claimed and the case broke down accordingly, the witness was, by permission of the Judge, recalled and asked a further general question with reference to all the particulars of objections, and, upon his answer, the Judge certified as to all the particulars. (*n*) Where the action was dismissed with costs, because the plaintiff did not offer any evidence, the Judge refused to certify as to the particulars of objections. (*o*) And similarly, where at the trial the plaintiffs abandoned their case as to several patents sued on, but proceeded on one patent, the Court refused to certify as to the particulars relative exclusively to the abandoned patents. (*p*) Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was dismissed without the defendants being called on, *Kay*, J., refused to give a certificate with regard to the particulars of objections, but gave costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections. (*q*) On

(*l*) The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 254.

(*m*) Griffin *v.* Foaver, (1889) 6 R. P. C. 396; see also Albo-Carbon Light Co. *v.* Kidd, (1887) 4 R. P. C. 535; Oddy *v.* Smith, (1888) 5 R. P. C. 503; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 162; Siddal and Hilton, Ld. *v.* Wood, (1904) 21 R. P. C. 232.

(*n*) Pegamoid, Ld. *v.* British Leather-Cloth Manufacturing Co., Ld., (1901) 18 R. P. C. 317. See also Cooper Patent Anchor Rail Joint Co., Ld. *v.* London County Council, (1906) 23 R. P. C. 296.

(*o*) American Steel and Wire Co. *v.* W. T. Glover & Co., Ld., (1902) 19 R. P. C. 112.

(*p*) Acetylene Illuminating Co. *v.* United Alkali Co., [1902] 1 Ch. 494.

(*q*) Rowcliffe *v.* The Longford Wire, Iron, and Steel Co., (1887) 4 R. P. C. 281, 288.

Costs—Certificates as to Particulars.

the other hand, in another case, where the same learned Judge at the end of the plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply. (*r*) On taxation of the costs in the latter case the taxing-master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses; but the Judge, on summons, varied the master's order by disallowing those costs, on the ground that the words of the Act are precise, and that as no certificate had been granted at the trial they could not be allowed. (*s*) *Kay*, J., in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be, in such a case as this, or in a similar case like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification." (*t*) Since these remarks were uttered there have been cases (*u*) in which the Court, being satisfied on the materials before it, has granted the certificate as to particulars of objections, though judgment was obtained before the defendant had an opportunity of giving any evidence; and the certificate has been given in chambers by *Stirling*, J., after discontinuance, where he was satisfied on the documents that the particulars of objections were reasonable and proper. (*x*)

A certificate that the plaintiff's particulars of breaches were reasonable and proper has been given in several cases where judgment was entered for the plaintiff in default of appearance

(*r*) Longbottom *v.* Shaw, (1888) 5 R. P. C. 497, 502.

(*s*) Longbottom *v.* Shaw, (1889) 6 R. P. C. 510; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563; (1890) 7 R. P. C. 139; but see Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

(*t*) (1889) 6 R. P. C. 513.

(*u*) Heyes *v.* Hallmark, (1891) 9 R. P. C. 25; Lees *v.* West London Cycle Stores, (1892) 9 R. P. C. 300; Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 463, 585; Mandleberg *v.* Morley, (1895) 12 R. P. C. 35; 64 L. J. Ch. 245; Pegamoid, Ld. *v.* British Leather Cloth Co., Ld., (1901) 18 R. P. C. 317.

(*x*) Lee *v.* Wigan, &c., Co., (1895) L. 568, not reported, see Annual Practice (1906), p. 887.

Costs—Certificates as to Particulars.

by the defendant. (*y*) A certificate as to particulars of objections was given in the Palatine Court where the defendant moved to dismiss the action for want of prosecution, and there was affidavit evidence sufficient to satisfy the Court that the particulars were reasonable. (*z*) When the defendant does not appear or does not defend, the Courts incline to act on the assumption that the defendant's conduct amounts to an admission that as against him the plaintiff's statements must be taken to be correct, and the particulars, or such of them as can be dealt with on this assumption, are reasonable and proper. (*y*)

Particulars not proved under a specific objection but necessary to determination of another issue.

There is the authority of the Court of Appeal for the statement that notwithstanding that the party giving particulars has not an opportunity of proving, or fails to prove the specific objection under which the detailed particulars may be ranged, it is the practice of the Court, owing to the difficulty of doing justice as regards costs in any other way, to certify such particulars as are material to the decision of some other issue in the action. (*b*) Thus the certificate has been given as to some of the defendant's objections, though the patent was not held invalid on the special grounds alleged, because such particulars were necessary for the purpose in one case of defining the ambit of the plaintiff's claim, (*c*) and in another case, for the purpose of deciding the issue of disconformity between the specifications. (*d*) And a certificate has been given where the issue of invalidity was abandoned by the defendant late in the trial and he was successful on the issue of non-infringement. (*e*)

Action in respect of several patents.

When the action is brought in respect of the infringement of several patents, and succeeds as to some but fails as to others, the Court will certify as to the particulars on which either party has succeeded, but will refuse to certify as to the particulars on which he failed. (*f*)

(*y*) Pneumatic Tyre Co. *v.* J. Parr & Co., W. N. (1896) 88; Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488; Brooks *v.* Hall, (1903) 21 R. P. C. 29; Saccharin Corporation, Ld. *v.* Skidmore, (1903) 21 R. P. C. 31; Saccharin Corporation, Ld. *v.* Hay, (1905) 22 R. P. C. 212.

(*z*) Bates *v.* Horsfall, (1905) 22 R. P. C. 519.

(*b*) See Castner-Kellner Alkali Co., Ld. *v.* Commercial Development Co., Ld., [1899] 1 Ch. 803; 16 R. P. C. 275.

(*c*) Jardine *v.* King, Mendham & Co., (1896) 13 R. P. C. 428; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 128; see also Osmonds *v.* Balmoral Cycle Co., (1898) 15 R. P. C. 522.

(*d*) Castner-Kellner Alkali Co., Ld., *v.* Commercial Development Co., Ld., [1899] 1 Ch. 803; 16 R. P. C. 275.

(*e*) New Inverted Incandescent Gas Lamp Co., Ld. *v.* Globe Light Co., Ld., (1905) 22 R. P. C. 431.

(*f*) Brooks *v.* Lamplugh, (1897) 15 R. P. C. 33.

Costs—Certificate of Validity.

**Certificate of Validity.**—It is provided by sec. 31 of the Act of 1883 that "in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same." (*g*)

Effect of certificate of validity given in a prior action.

The certificate may be given notwithstanding the fact that the patent has expired at the date of the judgment. (*h*)

Threats action.

As we have seen, (*i*) the validity of the patent may be called in question in an action brought to restrain the continuance of threats of proceedings in respect of infringements, but it is doubtful whether a certificate can be given in such an action under the above power. (*k*)

Petition for revocation.

Under the Act of 1852, which authorised the Court to certify that the validity of the patent had been questioned, and provided that in a subsequent (*l*) suit or action touching such patent a plaintiff armed with the certificate of the Court given in a previous action might recover treble costs, if he was successful, it was enacted that such certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent. (*m*) It is to be observed, however, that there is no corresponding provision made by the Act of 1883 or any subsequent Act with regard to the certificate in reference to a petition for revocation of the patent, which is the modern substitute for the proceeding by *scire facias*. (*n*)

Power of Court of Appeal and House of Lords and Court of the County Palatine of Lancaster to grant a certificate of validity.

It is submitted that the Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question, though it is not a "Court" within the meaning of the section. It is the duty of the Court of Appeal to make such order as the Judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below on the question of validity, it is presumed that a certificate would be granted, on the ground that the finding should have

(*g*) 46 & 47 Vict. c. 57, s. 31. For forms of Certificate, see Seton, 4th ed. p. 1661; Pemberton, 4th ed. p. 482.

(*h*) Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

(*i*) p. 384 *ante*.

(*k*) p. 328 *ante*.

(*l*) Bovill *v.* Hadley, (1864) 17 C. B. N. S. 435.

(*m*) 15 & 16 Vict. c. 83, s. 43.

(*n*) p. 291 *ante*.

Costs—Certificate of Validity.

been the other way. (*o*) The House of Lords also for the same reason has a similar jurisdiction. (*p*)

Should the Court of Appeal or House of Lords not grant the certificate, application for one may be made to the Judge of the Court below who tried the case. (*q*) In a case under the old Acts the Court of Appeal refused a certificate, but gave the appellant leave to apply to the Judge below. (*r*)

The Court of the County Palatine of Lancaster is not a Court within the meaning of the Act of 1883, (*s*) but it is submitted that the Chancery of Lancaster Act, 1890, (*t*) gives power to the Vice-Chancellor, or the Court of Appeal on appeal from his judgment, to grant a certificate entitling the plaintiff to solicitor and client's costs if successful in a subsequent action.

Omission to ask for certificate of validity at the trial.

If a certificate that the validity of the patent was called in question is not asked for at the trial, it may probably be obtained by subsequent summons in chambers, (*u*) or on motion in Court. (*x*)

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies. (*y*)

It seems that the grant of a certificate is discretionary in the Court or Judge. (*z*)

But in a case in which the result of the judgment was that the patent was invalid as regarded one claim, but that if the specification could be amended by omitting that claim the patent would be valid as to the remainder, *Stephen*, J., granted a certificate that the validity had come in question, but made no reference to the finding on the point, and his Lordship stated that he could not refuse to certify the fact of the validity having been questioned. (*a*) It must be observed that in the case last referred to the decision of *Stephen*, J., was to the effect that the patent was valid to a certain extent, and the case is no authority for the proposition that the certificate should be given when the Court merely decides that the patent

(*o*) R. S. C. (1883) Order lviii. r. 4; Cole *v.* Saqui, (1889) 6 R. P. C. 45; Humpherson *v.* Syer, (1887) 4 R. P. C. 416.

(*p*) Morris *v.* Young, (1895) 12 R. P. C. 465.

(*q*) Cropper *v.* Smith, 2 R. P. C. 61.

(*r*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35.

(*s*) Proctor *v.* Sutton Lodge Chemical Co., (1888) 5 R. P. C. 184.

(*t*) 53 & 54 Vict. c. 23, s. 3.

(*u*) Judicature Act, 1873, s. 39; R. S. C. (1883) Orders liv. and lv.

(*x*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 145.

(*y*) Haslam *v.* Hall, (1888) L. R. 20 Q. B. D. 491; (1888) 5 R. P. C. 144; Cropper *v.* Smith, (1885) 2 R. P. C. 63.

(*z*) 46 & 47 Vict. c. 57, s. 31.

(*a*) Haslam *v.* Hall, (1888) 5 R. P. C. 28; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113, 120; Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 892.

is bad and gives no decision as to what would be the result of an amendment of the specification. In such a case it would appear clear that the certificate should be refused. (*b*)

**Costs—Certificate of Validity.**

Certificate when no evidence on issue of validity is offered.

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was offered, and judgment was entered for the plaintiff by consent; (*c*) but where the defendant offered evidence against the novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given. (*d*)

And under the Act of 1883, where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, *Kay*, J., holding that sec. 31 of the Act of 1883 only applied when the patent is established in a case contested in Court, refused to grant a certificate; (*e*) and *Buckley*, J., under similar circumstances, adopted the same course, (*f*) though on a subsequent occasion, where the defendant appeared by counsel at the trial but took no part in it, he granted the certificate, (*g*) and under like conditions *Farwell*, J., permitted the plaintiff to give evidence shortly as to the validity of the patent, and then granted the certificate. (*h*) *Kekewich*, J., in the absence of authority to the contrary, granted the certificate, (*i*) and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. And *Day*, *Farwell*, and *Channell*, JJ., and the Irish Master of the Rolls, in more recent cases, followed the course adopted by *Kekewich*, J. (*k*) Also, where a case was settled by a compromise between the parties, *Collins*, J., granted the certificate on the ground that the validity had undoubtedly been brought in question, though the parties had arranged

(*b*) See Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1902) 19 R. P. C. 234.

(*c*) Stocker *v.* Rodgers, (1843) 1 Car. & K. 99.

(*d*) Gillett *v.* Wilby, (1839) 1 W. P. C. 270.

(*e*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261, 263; Stocker *v.* Rodgers, (1843) 1 Car. & K. 99.

(*f*) Webb Lamp Co. *v.* Atkinson, (1902) 19 R. P. C. 599.

(*g*) Consolidated Pneumatic Tool Co. *v.* Churchill & Co., (1905) 22 R. P. C. 367.

(*h*) Chadburn's (Ship) Telegraph Co. *v.* Robinson, (1905) 22 R. P. C. 468.

(*i*) Haydock *v.* Bradbury, (1887) 4 R. P. C. 74.

(*k*) Edison-Bell Phonograph Corporation *v.* Edison Phonograph Co., (1893) 11 R. P. C. 33; Acetylene Illuminating Co. *v.* Midland Acetylene (Parent) Syndicate, (1900) 17 R. P. C. 534; Welsbach Incandescent Gas Light Co. *v.* Krumm, (1901) 18 R. P. C. 211; Welsbach Incandescent Gas Light Co. *v.* John McGrady & Co., (1901) 18 R. P. C. 51.

Costs—Certificate of Validity.

between themselves how it was to be decided, (*l*) and *Cozens-Hardy*, J., granted the certificate where the issue of validity was raised on the pleadings, but no evidence on that issue was offered at the trial. (*m*) *Byrne*, J., on the other hand, refused the certificate where the issue was raised and denied on the pleadings, but judgment for an injunction was given by consent. (*n*)

Certificate of validity may be given though plaintiff fails on the issue of infringement.

It is not necessary that the plaintiff should be completely successful in the action to obtain a certificate of validity. The certificate has been given in many cases where the plaintiff, though successful on the issue of validity, has failed on that of infringement. (*o*)

Certificate where defendant admits validity on a certain construction of the specification.

There does not appear to be any case in which a certificate of validity has been given where the defendant has admitted the validity of the patent upon a certain specific construction of the specification, found by the Court to be the true construction, which excludes the alleged infringement from the claim; and in such a case it is submitted that no certificate would be given. (*p*) If, however, the defendant should, besides admitting validity. subject to a proviso as to construction, alternatively plead invalidity upon another construction, and succeed with reference to the special construction without arguing his case upon the other construction, it is submitted the Court might grant the certificate, though the case of validity was not contested in Court. (*q*)

Certificate of validity should be pleaded in a subsequent action.

Where a certificate of validity has been granted in a previous action, it will not usually be granted again at the conclusion of a subsequent action. (*r*) And if it is desired to claim solicitor and client's costs, the certificate ought, strictly speaking, to be pleaded in the subsequent action, though they may be given if the writ and statement of claim ask for them. (*s*)

Meaning of "subsequent action."

An action commenced but not determined at the time a certificate in another action is obtained is not a subsequent

(*l*) Delta Motal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 247.

(*m*) Leeds Forge Co. *v.* Deighton's Patent Flue and Tube Co., (1901) 18 R. P. C. 233.

(*n*) Claughton *v.* Foster, (1903) 21 R. P. C. 17.

(*o*) Tweedale *v.* Ashworth, (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776; Morrison *v.* Asplen, (1904) 21 R. P. C. 557.

(*p*) Morris *v.* Young, (1895) 12 R. P. C. 464, 465.

(*q*) Haydock *v.* Bradbury, (1887) 4 R. P. C. 74; Edison-Bell Phonograph Corporation *v.* Edison Phonograph Co., (1893) 11 R. P. C. 33; Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 247; Morris *v.* Young, (1895) 12 R. P. C. 465.

(*r*) Edison *v.* Holland, (1888) 6 R. P. C. 285.

(*s*) Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488.

Costs—Certificate of Validity.

action for infringement within the meaning of sec. 31 of the Act of 1883, and the plaintiff cannot claim solicitor and client's costs on the production of the certificate and record of the first determined action. (*t*)

Under the Act of 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order or final judgment," and the plaintiff was not entitled to full costs. (*u*) It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within sec. 31 of the Act of 1883, and, therefore, under the present practice the plaintiff could not on the strength of a certificate of validity claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction. (*x*)

Solicitor and client costs are not always given though a certificate of validity has been obtained in a prior action.

It is to be noticed that the Act of 1883 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is, in a subsequent action on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court or a Judge trying the action certifies that he ought not to have the same.* Therefore, it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have solicitor and client costs, notably if it is proved that the first action was collusive (*y*) or vexatious, (*z*) or the defendant is otherwise able to discharge the burden which is on him of showing cause why he should not pay solicitor and client costs. (*a*)

(*t*) Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 480; Saccharin Corporation *v.* Anglo-Continental Chemical Works, (1900) 17 R. P. C. 320; [1901] 1 Ch. 417; Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; Bovill *v.* Hadley, (1864) 17 C. B. N. S. 435.

(*u*) Bovill *v.* Goodier, (1866) Griff. L. O. C. 49.

(*x*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 46, 48.

(*y*) Davenport *v.* Rylands, (1865) L. R. 1 Eq. 309.

(*z*) Proctor *v.* Sutton Lodge Chemical Works, (1888) 5 R. P. C. 184.

(*a*) United Telephone Co. *v.* Patterson, (1889) 6 R. P. C. 142; United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 339.

Costs—Certificate of Validity.

The intention seems to be to protect patentees from being harassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action, or there are other substantially new questions to be decided with reference to the patent or the specification.

For instance, where a certificate as to validity had been obtained, *Pearson*, J., in a subsequent action, refused to give full solicitor and client costs on the ground that the patent was attacked on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity, specifying to what extent the patent had been questioned. (*b*) But *Romer*, J., gave solicitor and client costs where in the subsequent action the patent was unsuccessfully contested on a point of ambiguity of specification which was not raised on the former occasion; (*c*) and *Byrne*, J., gave solicitor and client costs in a subsequent action on the express ground that the defendant had contested the ambit of the patent. (*d*)

In a case under the Act of 1852, where the validity of the patent was subsequently contested on different grounds, Lord *Hatherley*, then Vice-Chancellor *Page Wood*, refused to give solicitor and client costs, on the ground that the former action was not conclusive as to the validity of the patent, for, after the plaintiff had obtained the judgment of the House of Lords in his favour, the Court of Queen's Bench directed a new trial, which, however, did not take place, in consequence of a compromise between the parties. (*e*)

Solicitor and client costs when defendant does not dispute validity.

The fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not necessarily induce the Court to deprive a plaintiff who holds a certificate of validity of full solicitor and client costs; (*f*) but, on the other hand, the plaintiff, though armed

(*b*) Otto *v.* Steel, (1886) 3 R. P. C. 109, 120.

(*c*) Automatic Weighing Machine Co. *v.* Fearby, (1893) 10 R. P. C. 447; see also Dunlop Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., (1898) 15 R. P. C. 389; 16 R. P. C. 16.

(*d*) Dunlop Tyre Co. *v.* Wilson, (1900) 17 R. P. C. 336.

(*e*) Betts *v.* De Vitre, (1864) 11 Jur. N. S. 11.

(*f*) The United Telephone Co. *v.* Pattinson, (1889) 6 R. P. C. 140; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; Pneumatic Tyre Co. *v.* West London Rubber and Tyre Co., (1898) 15 R. P. C. 129; Fabriques de Produits Chemique de Thaun et de Malhouse *v.* Lafitte, (1899) 16 R. P. C. 61; Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 16 R. P. C. 354; Saccharin Corporation *v.* Dawson, (1902) 19 R. P. C. 172.

with a certificate that the validity of his patent was questioned in a prior action, will not be awarded full solicitor and client costs in a subsequent action where the only question raised is one of infringement, and the necessity for the subsequent action arises, in the opinion of the Court, from the lax manner in which the patentee's specification was drawn, (*g*) or the specification being clear, the defendant has a plausible case on non-infringement; (*h*) or there are other special reasons which induce the Court, in the exercise of its discretion, not to allow solicitor and client costs. (*i*)

Costs—Public Authority. Party and Party Costs. Experts' Fees.

**Public Authority.**—A public authority party to an action of infringement, if successful, is, under the provisions of the Public Authorities Protection Act, 1893, entitled to solicitor and client costs, if the provisions of that Act apply. (*k*) The provisions of the Act extend not only to a public body acting as principals in the execution of an Act of Parliament or public duty or authority, but also to the individual subordinates carrying out their mandates. (*l*)

**Party and Party Costs.**—It is of great importance to litigants who are unsuccessful that they should not be oppressed by having to pay an excessive amount of costs; and it is a rule that the costs chargeable under a taxation, as between party and party, are only those necessary to enable the adverse party to conduct the litigation; any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them. (*m*)

Party and party costs.

**Experts' Fees.**—When scientific evidence is necessary, proper fees to experts will be allowed; (*n*) but only the fees of experts which relate to qualifying to give evidence in the particular case and to attendance in Court for the purpose of giving

Scientific evidence and experts' fees.

(*g*) Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 480; Automatic Weighing Machine Co. *v.* National Exhibitions Association, (1891) 8 R. P. C. 352.

(*h*) Saccharin Corporation *v.* Dawson, (1902) 19 R. P. C. 172.

(*i*) See Welsbach Incandescent Gas Light Co. *v.* Daylight Incandescent Mantle Co., (1899) 16 R. P. C. 354. In this case the point that the subsequent action was necessitated by the lax manner in which the patentees' specification was drawn was not urged upon the Court. The defendant appealed upon the whole case, and the appeal was allowed with costs in the Court of Appeal and below, 17 R. P. C. 141.

(*k*) See Chamberlain and Hookham, Ld. *v.* Mayor, &c., of Bradford, (1900) 17 R. P. C. 762; Chamberlain and Hookham, Ld. *v.* Mayor, &c., of Huddersfield, (1901) 18 R. P. C. 456; Harrop *v.* Mayor of Ossett, [1898] 1 Ch. 525; North Metropolitan Tramways Co. *v.* London County Council, [1898] 2 Ch. 145; British Thomson-Houston Co. *v.* Mayor of Manchester, (1903) 20 R. P. C. 471.

(*l*) Bostock *v.* Ramsey Urban District Council, [1900] 1 Q. B. 357.

(*m*) Smith *v.* Buller, (1874) L. R. 19 Eq. 475.

(*n*) *Ibid.* 473; Batley *v.* Kynock, (1875) L. R. 20 Eq. 632; Musgrave *v.* Hicks, (1886) 3 R. P. C. 49.

Costs—Drawings and Models. Three Counsel. Shorthand Notes.

evidence should be allowed. Fees which relate to experiments performed to educate an expert apart from the special case should be disallowed. (*o*)

Drawings and models.

**Drawings and Models.**—An allowance may also be made in respect of the preparation of drawings or models when they are required; (*p*) but the Court will not order such drawings and models to be given up to the party ordered to pay the costs of them. (*q*) If the drawings and models are not really necessary, no allowance will be made in respect of them on taxation—*e.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them. (*r*)

Three Counsel.

**Three Counsel.**—The costs of three counsel may sometimes be allowed it, (*s*) but this should only be done when the case is one of multifarious issues and matters on which different minds might be properly employed, as it were dividing the labour among counsel, they should not be allowed in cases, though of great difficulty, where it is necessary for each counsel to get up the whole case. (*t*)

Shorthand notes.

**Shorthand Notes.**—A Judge has no power in the absence of arrangement to order shorthand notes of the evidence to be taken. (*u*) Where shorthand notes are taken it is the usual and proper course for the parties to agree beforehand that the costs of them shall be costs in the cause, or to make some other mutual arrangement as to them. When this is not done the Court will sometimes give the costs of the shorthand notes as part of the costs in the action, and the

(*o*) Leonardt *v.* Kallé, (1895) 12 R. P. C. 306.

(*p*) Batley *v.* Kynock, (1875) L. R. 20 Eq. 632; Musgrave *v.* Hicks, (1886) 3 R. P. C. 49; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221.

(*q*) Horrocks *v.* Stubbs, (1886) 3 R. P. C. 241.

(*r*) Smith *v.* Buller, (1875) L. R. 19 Eq. 473.

(*s*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Light Co., (1896) 13 R. P. C. 347; Mounet *v.* Beck, (1897) 14 R. P. C. 850; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 875; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 892; Palmer Tyre, Ld. *v.* Pneumatic Tyre Co., (1899) 16 R. P. C. 496; Bradford Dyers Association *v.* Bury, (1901) 19 R. P. C. 127; Patent Exploitation, Ld. *v.* American Novelty and Manufacturing Co., Ld., (1903) 20 R. P. C. 704; Haskell Golf Ball Co. *v.* Hutchison, (1905) 22 R. P. C. 478; 23 R. P. C. 301; Farbenfabriken vormals Friedrich Bayer *v.* Chemische Fabrik von Heyden, (1905) 22 R. P. C. 501.

(*t*) Leonardt *v.* Kallé, (1895) 12 R. P. C. 306.

(*u*) Hillcary *v.* Taylor, (1887) L. R. 36 Ch. D. 262; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 129. As to the relationship between Judges notes and shorthand notes, see Gammons *v.* Singer Manufacturing Co., (1904) 22 R. P. C. 129.

necessary application should be made at the trial. (*x*) But such an order is only made in exceptional cases. (*y*)

Costs—Inquiry as to Damages. Costs on Higher Scale.

The costs of a shorthand note of a judgment appealed from will generally be allowed by the Court of Appeal. (*z*)

**Inquiry as to Damages.**—Where a plaintiff succeeds in obtaining an inquiry as to damages or an account of profits, and also obtains the general costs of the action, the Court, as a rule, will not give the costs of the inquiry as well as general costs of the action, but will reserve them, in order that the Judge before whom the inquiry is directed may have full control over the costs, and see that they are not unreasonably exaggerated. (*a*)

Inquiry as to damages.

But where an undertaking and inquiry as to damages is directed on a successful application for an interim injunction, the usual order provides for the costs, (*b*) and they are not generally reserved. (*c*)

It is the duty of the officer of the Court before whom an inquiry as to damages or an account of profits is heard to take notes of the evidence, and if shorthand notes are taken no costs of them will in the absence of agreement between the parties be allowed. (*d*)

**Costs on Higher Scale.**—It is provided (*e*) that costs on the higher scale may be allowed either generally in any cause or matter, or as to the costs of any particular application made or business done, in any cause or matter, if on special grounds arising out of the nature and importance or the difficulty or urgency of the case, the Court or a Judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or

Costs on the higher scale.

(*x*) Earl De La Warr *v.* Miles, (1881) L. R. 19 Ch. D. 80; Bowen *v.* Centaur Cycle Co., (1891) 8 R. P. C. 113; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 333; Incandescent Gas Light Co. *v.* Sunlight Gas Lamp Co., (1896) 13 R. P. C. 346; Monnet *v.* Beck, (1897) 14 R. P. C. 850; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 875; Castner-Kellner Alkali Co. *v.* Commercial Development Corporation, (1899) 16 R. P. C. 275; Palmer Tyre Co., Ld. *v.* Pneumatic Tyre Co., Ld., (1899) 16 R. P. C. 496.

(*y*) *Ibid.*; Kelly *v.* Bayles, 18 L. R. 13 Ch. D. 693.

(*z*) Collyer *v.* Isaacs, (1882) 45 L. T. N. S. 567; 30 W. R. 71; London and South-Western Ry. Co. *v.* Groom, (1881) L. R. 20 Ch. D. 589; Woodward *v.* Sansom, (1887) 4 R. P. C. 178.

(*a*) Stark *v.* Midland Ry. Co., (1881) L. R. 16 Ch. D. 81; United Telephone Co. *v.* Fleming (No. 2), (1886) 3 R. P. C. 282; Moss *v.* Malings, (1886) 3 R. P. C. 379; United Telephone Co. *v.* Faulkner, (1886) 3 R. P. C. 282 *n.*; Cole *v.* Saqui, (1888) 5 R. P. C. 497; Needham *v.* Oxley, Seton, 4th ed. p. 353.

(*b*) Burdett *v.* Hay, (1863) 4 De G. J. & S. 41; Seton, 4th ed. p. 172.

(*c*) Rothwell *v.* King (No. 2), 4 P. O. B. 76.

(*d*) Unguar *v.* Sugg, (1892) 9 R. P. C. 113.

(*e*) S. C. R. (1883) Order lxv. r. 9.

Costs—Costs on Higher Scale.

matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order; or if the taxing officer, under directions given him for that purpose by the Court or a Judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid.

Costs on the higher scale may be given by the Court of Appeal, although refused by the Court below; but the Court of Appeal does not usually allow them, there being no special reason for doing so. (*f*)

Where an action was of a complicated nature, the Court, considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing-master to allow all or any part of the plaintiff's costs on the higher scale if he thought fit; (*g*) and costs on the higher scale have been allowed in many patent cases, on the ground that the case of the successful party being of exceptional difficulty has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models, (*h*) whether the patent has been previously supported or not; though costs on the higher scale have been refused where complications of the case were due to the unfortunate wording of both an original and an amended specification, (*i*) and in many other cases.

Where costs on the higher scale have been asked for, on the ground that the defendant submitted to an injunction, (*k*) or that important questions were raised, (*l*) or that the defendant did not appear at the trial, (*m*) they have been refused; and it would appear that the fact that the damages claimed

(*f*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 310.

(*g*) Fraser *v.* Province of Brescia Steam Tramways Co., (1887) 56 L. T. N. S. 771; 3 Times R. 587.

(*h*) Westinghouse *v.* L. & Y. Ry. Co., (1884) 1 R. P. C. 103; Easterbrook, F. G. W. Ry. Co., (1885) 2 R. P. C. 212; Watling *v.* Stevens, (1886) 3 R. P. C. 43; Otto *v.* Steel, (1886) 3 R. P. C. 120; Wenham *v.* May, (1887) 4 R. P. C. 310; Kaye *v.* Chubb, (1887) 4 R. P. C. 289; Ellington *v.* Clark, (1888) 5 R. P. C. 528; Edison *v.* Holland, (1888) 5 R. P. C. 459; Blakey *v.* Latham, (1889) 6 R. P. C. 29; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 475; Tweedale *v.* Ashworth, (1890) 7 R. P. C. 426; Farbenfabriken vorm F. Bayer & Co., (1891) 8 R. P. C. 389; Hopkinson *v.* St. James's and Pall Mall Electric Light Co., (1892) 10 R. P. C. 46; Edison-Bell Phonograph Co. *v.* Smith, (1894) 11 R. P. C. 161; Hookham *v.* Johnson, (1897) 14 R. P. C. 525; Haskell Golf Ball Co. *v.* Hutchison, (1905) 22 R. P. C. 478; but see Leonardt *v.* Kallé, (1895) 12 R. P. C. 120.

(*i*) Wenham Gas Co. *v.* Champion Gas Lamp Co., (1890) 7 R. P. C. 313.

(*k*) Hudson *v.* Osgerby, (1884) 32 W. R. 566.

(*l*) Grafton *v.* Watson, (1884) 51 L. T. N. S. 141; Cardiff Steamship Co. *v.* Barwick, (1885) 53 L. T. N. S. 56.

(*m*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261.

amount to a large sum is not sufficient reason for directing the costs to be taxed on the higher scale. (*n*)

Stay Pending Appeal.

Where an application is made at the trial for costs on the higher scale which is refused, the question may be reserved till after the taxation, and liberty given to apply, so that the successful party may have an opportunity of showing that he has suffered an injustice, if such be the fact, by the taxation having been made on the lower scale. (*o*)

## Stay Pending Appeal.

Stay is not usual.

If the party who has been unsuccessful in a patent action intends to enter notice of appeal he may sometimes succeed in obtaining an order from the Court staying the proceedings on the judgment till the hearing and determination of the appeal, (*p*) though a stay is by no means the general rule. (*q*)

Application for a stay.

The application must in the first instance be made to the Court below and not to the Appellate Court; (*r*) but if the Court below refuse to make an order staying proceedings, an application may be made to the Appellate Court, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below. (*s*)

Circumstances which induce the Court to grant a stay.

Sometimes, pending an appeal, the Court in its discretion will grant a stay of an injunction on the undertaking of the defendant to keep an account, (*t*) or will grant a stay for a time sufficient to allow of the defendant giving notice of appeal and making an application to the Court of Appeal to stay the injunction or to advance the appeal and stay the injunction till the hearing; (*u*) and where there is a special

(*n*) Spettigue's Trusts, (1884) 32 W. R. 385; The Horace, (1884) L. R. 9 P. D. 86.

(*o*) Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 282, 404.

(*p*) Adair *v.* Young, (1879) L. R. 11 Ch. D. 136; Woodward *v.* Sansom, (1886) 3 R. P. C. 366; Humpherson *v.* Syer, (1887) 4 R. P. C. 189; Proctor *v.* Bennis, (1887) 4 R. P. C. 363; Otto *v.* Steel, (1886) 3 R. P. C. 121.

(*q*) Edge *v.* Johnson, (1892) 9 R. P. C. 142; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 483.

(*r*) *Otto v.* Lindford, (1880) L. R. 18 Ch. D. 394; Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305.

(*s*) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305.

(*t*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7; North British Rubber Co. *v.* Gormully, Jeffery & Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283.

(*u*) Leeds Forge Co. *v.* Deighton's Patent Flue and Tube Co., (1901) 18 R. P. C. 240.

**Stay Pending Appeal.**

reason (*x*) the Court, in view of an appeal, orders the taxation of costs, and, if the appeal is not heard before the completion of the taxation, the money to be paid over on the personal undertaking of the solicitor to return it in the event of the appeal succeeding; (*y*) but though this is frequently done it is not the usual order, (*z*) and the refusal of a solicitor to give an undertaking, in the absence of an order, is not a special circumstance entitling the unsuccessful party to a stay. (*a*) Neither is it usual to stay an inquiry as to damages or the taking of an account pending an appeal, (*b*) though frequently a stay is granted in respect of an order for the delivery up or destruction of the defendant's goods. (*c*)

**Costs of application for a stay.**

Usually the costs of an application for an order to stay proceedings have to be borne by the party making it in any event; (*d*) but sometimes they are made costs in the appeal. (*e*) Where the plaintiffs obtained a judgment granting a perpetual injunction restraining infringement and an account of profits, and the defendant entered an appeal, and moved for an order staying proceedings under the order for an account, the Court thought that, under the circumstances, the proper course was to advance the appeal, but as the plaintiff thereby obtained a benefit the costs of the application should be costs in the appeal. (*f*)

(*x*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1897) 14 R. P. C. 590.

(*y*) Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 10.

(*z*) Per Lindley, L.J., Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 418.

(*a*) John Vasey, Ld. *v.* Walker, Mitchell & Co., (1899) 606.

(*b*) Chadburn *v.* Mechan, (1895) 12 R. P. C. 135; Evans and Taunton, Ld. *v.* Hoskin and Sowell, Ld., (1901) 21 R. P. C. 682; Hyam *v.* Terry, (1880) 29 W. R. 32.

(*c*) English and American Machinery Co. *v.* Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 142; Howes *v.* Webber, (1895) 12 R. P. C. 470.

(*d*) Cooper *v.* Cooper, (1875) L. R. 2 Ch. D. 493; Merry *v.* Nickalls, (1873) L. R. 8 Ch. App. Cas. 205.

(*e*) Adair *v.* Young, (1879) 11 Ch. D. 6.

(*f*) Adair *v.* Young, (1879) L. R. 11 Ch. D. 136.

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